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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/6/4, 4 Add.1, 5, 5 Add.1, 7, 8 and 9, prepared for the sixth session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which will be held in Geneva from May 3 to 7, 2004.

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

April 6, 2004

Enclosures: documents PCT/R/WG/6/4, 4 Add.1, 5, 5 Add.1, 7, 8 and 9

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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

Sixth Session
Geneva, May 3 to 7, 2004

“MISSING PART” REQUIREMENTS

Document prepared by the International Bureau

INTRODUCTION

1. 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/1/5.¹
2. Among the PLT-related proposals contained in document PCT/R/WG/1/5 were proposals to conform the PCT “missing part” requirements to those of the PLT (see document PCT/R/WG/1/5, Annex I). However, due to time constraints, a number of the proposals contained in document PCT/R/WG/1/5, including those related to “missing part” requirements, could not be discussed during the first session of the Working Group. Rather, the Working Group desired to give priority to those matters “which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of

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.

complexity involved and to workload implications for Offices and Authorities,” in particular, proposals concerning restoration of the right of priority and relief when time limits were missed, especially the time limit for entering the national phase (see the first session summary by the Chair, document PCT/R/WG/1/9, paragraph 21(v)).

3. 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 PCT “missing part” requirements 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).

4. 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 “missing part” requirements 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).

5. Further revised proposals relating to “missing part” requirements prepared by the International Bureau were considered by the Working Group at its fourth and fifth session. 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).

6. The Working Group’s discussions at its last (fifth) session (see document PCT/R/WG/5/13, paragraphs 83 to 104) are outlined in the following paragraphs:

“83. Discussions were based on document PCT/R/WG/5/8.

“84. 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, noting particularly that certain delegations considered that it would be necessary to include a reservation provision in respect of the effect in the national phase for their countries (see paragraph 91, below).

“Rule 4

“85. One representative of users expressed concern about possible unintended consequences of the proposed inclusion in the request under Rule 4.18 of a pre-printed statement that the contents of the earlier application(s) the priority of which was claimed were incorporated by reference. The representative suggested that the applicant be given the opportunity to omit the statement, noting that the applicant, in certain cases, may have good reasons not to have the whole contents of the earlier applications automatically incorporated by reference into the later filed application.

“86. Suggestions as to how to address that concern included the possibility of limiting the incorporation by reference to drawings contained in the earlier application so as to avoid a possible conflict with Article 14(2) and the possibility of requiring the applicant to check a box in the request to take advantage of the incorporation by reference of the earlier application.

“87. The Working Group, noting that the concern would only be relevant in very few cases, agreed that it would be preferable to retain a provision providing for the automatic incorporation by reference of the earlier application, but somehow limited to the purpose of possible subsequent inclusion of missing parts into the later filed application, including the case where the missing part included matter which was new in the application in question but which was completely contained in the earlier application.

“88. Several delegations and representatives of users questioned the need for formal confirmation of the “incorporation by reference” statement under Rule 4.18 and suggested that it may be sufficient to further amend that Rule so as to clarify that the “incorporation by reference” (rather than the statement) was for the purposes of Rule 20.5(e); the expiration of the time limit under Rule 20.5(e) for the furnishing of missing parts would thus automatically result in the incorporation by reference ceasing to have effect.

“89. One representative of users suggested replacement of the specific reference in Rule 4.18 to Rule 20.5(e) with a more general reference as to the purpose of making such statement (such as, for the purposes of incorporation by reference of missing parts completely contained in the earlier application) so as to ensure that the statement would also be effective in the national phase before designated Offices.

“90. One delegation expressed its concern that the proposed incorporation by reference could be considered to conflict with the disclosure requirements under Article 5 and suggested that an amendment of the Treaty may be required. Another delegation expressed its general concern about the introduction into the PCT, by way of amendments to the Regulations, of the concept of incorporation by reference, since, in its view, the concept would not be supported by any of the provisions of the Treaty and could thus be introduced only by revision of the Treaty itself.

“91. Some delegations suggested that a transitional reservation provision be added so as to allow Contracting States whose national law was not compatible with the envisaged amendments of the PCT Regulations not to apply those amendments for as long as such incompatibility existed.

“92. Following a suggestion by the Secretariat, the Working Group agreed that possibilities should be explored as to whether the proposed incorporation by reference could be extended to cover the contents of such earlier application for the purposes of overcoming Article 11(1) defects (such as missing claims or a missing description).

“*Rule 20*

“93. One delegation noted that the proposals in respect of missing parts in Rule 20 were not consistent with its national law.

“94. One delegation suggested that the contents of Rule 20.4(b) should be moved to Rule 20.3.

“95. One delegation suggested that Rule 20.5(b) be split into two paragraphs, one dealing with the situation where the missing part was submitted before, and the other after, an international filing date had been accorded. Such a change would result in further simplification of the Rule and, in certain situations, would also afford more time to applicants to meet the requirements under the Rule.

“96. One delegation proposed that the applicant should be required to submit a certified copy instead of a simple copy of the earlier application within the same time limit within which the missing part must be furnished. A representative of users noted that in many cases it would not be possible to obtain such a copy within that time limit.

“97. The Working Group noted that, under the corresponding provisions in PLT Rule 2.4, a Contracting Party could require that a simple copy be filed within the same time limit as that for furnishing the missing part and, in addition, that a certified copy be filed within a time limit of not less than four months from the date of the invitation to furnish such copy.

“98. The Working Group invited the Secretariat to consider whether a similar option was needed in Rule 20.5, taking account of the fact that Rule 17 already required a certified copy of the priority document to be submitted within 16 months from the priority date.

“99. In this context, several delegations and representatives of users suggested that a certified copy of the earlier application should not be required under Rule 20.5 in the situations covered by Rule 17.1(b) and (b-bis).

“100. Two delegations suggested that the requirement under proposed Rule 20.5(e)(iii) that the missing part be completely contained in the earlier application should be deleted since, in some cases, such a check would be difficult for the receiving Office to perform, for example, where a translation of the earlier application was required or technical evaluation was necessary. This suggestion was opposed by two other delegations, noting that this matter had been fully discussed in the context of the corresponding provision in PLT Rule 2(4)(iv) and pointing to the fact that, under the PLT, the procedure might be applied by Offices as a purely clerical check (see PLT Note R2.04).

“101. One delegation suggested that the International Searching Authority rather than the receiving Office should be responsible for checking whether the missing part was completely contained in the earlier application, as this check would not necessarily be purely clerical, in particular where the earlier application was in a different language.

“102. In the course of the discussion, the Working Group noted that Note 5.21 on PLT Article 5(6)(b) expressly stated that, where it was subsequently determined, for example, in the course of substantive examination, that the missing part was not completely contained in the earlier application, the Office may rescind the filing date and re-date the application. However, no similar sanction appeared to exist under the PCT. One representative of users suggested that, in the case of an international application, non-compliance with the requirement that the missing part be completely contained in the earlier application could be dealt with in the national phase under national law provisions relating to added matter. Alternatively, the procedure under Rule 82*ter* could be extended to cover such cases. One delegation suggested that a review procedure analogous to that proposed in respect of restoration of priority (review only in case of reasonable doubts) could be considered.

“103. The Working Group invited the Secretariat to study the matter further. The Working Group agreed to defer further consideration of the appropriate time limits (one or two months) under Rules 20.3(d), 20.5(c) and 26.2.

“104. One representative of users suggested that the time limits under those Rules should all be two months for consistency with the PLT. One delegation stated that it could accept a two month time limit under Rule 20.3(d) since the international filing date had not yet been accorded at that time, but still favored a one month time limit under the other two provisions.”

7. Annex I to the present document contains revised texts of the proposals related to “missing part” requirements contained in the Annex to document PCT/R/WG/5/8. The proposals have been further revised so as to take into account the discussions and agreements reached at the fifth session of the Working Group as summarized in paragraph 6, above. 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). The main features of the draft proposals are outlined in the following paragraphs.

CONFORM PCT “MISSING PART” REQUIREMENTS TO THOSE OF THE PLT

Structure of Rule 20

8. In the context of “missing part” requirements, it is proposed to revise Rule 20 so as to move to the Administrative Instructions matters of detail related to the stamping of dates, etc., and to leave the Rule to deal with the more significant question of the according of the international filing date under Article 11. 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 and which date to accord as the international filing date: Rule 20.1 as amended would deal with general questions concerning the according of an international filing date; Rule 20.2 as amended would deal with the “positive determination” under Article 11(1), that is, the according of the international filing date; Rule 20.3 as amended would deal with the invitation to correct

Article 11 defects and subsequent compliance with Article 11(1) requirements; Rule 20.4 as amended would deal with the “negative determination” under Article 11, that is, the refusal to accord an international filing date; Rule 20.5 as amended would deal with the subsequent furnishing of “missing parts” and its effect on the international filing date; Rule 20.6 would deal with the case where a “missing element” (the description or the claims are missing from the international application) or a missing part is completely contained in an earlier application the priority of which is claimed (see paragraphs 10 to 12, below); Rule 20.7 would deal with the applicable time limits for the furnishing of a correction, or of a missing element or missing part; finally, Rule 20.8 would deal, as at present, with the question of errors by the receiving Office in issuing an invitation to correct defects under Article 11(1).

International filing date where missing part is filed

9. Under PLT Article 5(6)(a), later submission (within certain time limits) of a missing part of the description or a missing drawing results in according as the filing date the date on which the Office has received the missing part of the description or the missing drawing, or the date on which all the filing date requirements are complied with, whichever is later. The same principle is applied under the PCT where sheets (description, claims, drawings) pertaining to the same application are not received on the same day. However, while the Treaty (PCT Article 14(2)) expressly deals with the case of missing drawings, neither the Treaty nor the Regulations specifically deal with the according (or correction) of an international filing date where sheets other than missing drawings are received later than the date on which papers were first received. This matter is expressly dealt with only in the Administrative Instructions (see Section 309 of the Administrative Instructions) and in the Receiving Office Guidelines (see paragraphs 200 to 207 of the Receiving Office Guidelines). In order to clarify the procedure, it is proposed to deal with this important matter in the Regulations (rather than in the Administrative Instructions and the Receiving Office Guidelines) and to amend Rule 20 accordingly (see Rule 20.5 as proposed to be amended).

International filing date where description or claims are missing but contained in earlier application; or where missing part is completely contained in earlier application

10. The two main differences between the filing date requirements of the PLT and those of the PCT are:

(a) under the PLT, the applicant can, for the purposes of the filing date of the application, replace the description and any drawings by a reference to a previously filed application (see PLT Article 5(7) and PLT Rule 2(5)) (“missing elements”); there is no equivalent provision in the PCT;

(b) under the PLT, the applicant can rectify the omission, at the time of filing, of a part of the description or of a drawing without loss of the filing date if the application claims the priority of an earlier application and the missing part of the description or the missing drawing is completely contained in that earlier application (see PLT Article 5(6) and PLT Rule 2(3) and (4)) (“missing parts”); there is no equivalent provision in the PCT.

11. While, in previous sessions, the Working Group had agreed, as was suggested in document PCT/R/WG/2/6, not to proceed, until a future session of the Working Group, with proposals to align the PCT filing date requirements in respect of “missing elements” to those of the PLT but to focus the discussions on the filing date requirements in respect of “missing parts,” the Working Group, at its fifth session, agreed that that possibilities should be

explored as to whether the proposed incorporation by reference discussed in the context of “missing parts” could be extended to cover the contents of such earlier application for the purposes of overcoming Article 11(1) defects (“missing elements,” such as missing claims or a missing description) (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 92).

12. Upon consideration, it is proposed to amend the PCT Regulations by adding a new Rule 20.6 so as to allow the applicant, by way a reference to an earlier application, not only to rectify the omission, at the time of filing, of certain parts of the international application (incorporation by reference of “missing parts,” similar to the provision under PLT Article 5(6)) without loss of the filing date, but also to allow the applicant to replace the part which on the face of it appears to be a description or the part which on the face of it appears to be a claim or claims for the purposes of the international filing date (incorporation by reference of “missing elements,” similar to the provision under PLT Article 5(7) in respect of the description and any drawings).

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

13. In the context of “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).

14. 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 PART” REQUIREMENTS

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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.

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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. See also the Comment on proposed new Rule 20.6, below.]

(d) [No change]

4.2 to 4.17 [No change]

4.18 Statement for the Purposes of Incorporation by Reference

The request may contain a statement that, if an element referred to in Article 11(1)(iii)(d) or (e) or a part of the application referred to in Rule 20.6(b)(i) to (iii) is missing from the international application, the same element or part contained in an earlier application the priority of which is claimed in the international application is, subject to compliance with the requirements of Rule 20.6, incorporated by reference in the international application.

[COMMENT: See proposed new Rule 20.6, below. See also paragraphs 10 to 12 in the Introduction to this document, and the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 85 to 89 and 92. It is proposed to include the statement under Rule 4.18 as a pre-printed text in the request form, resulting in the automatic incorporation by reference of the earlier application, limited to the purpose of possible subsequent inclusion of a missing element or missing part into the later filed international application. In order to avoid possible unintended consequences, the statement expressly states that a missing element or part shall only be incorporated by reference in the international application if the requirements of Rule 20.6 are complied with (including the requirement that, within the applicable time limit, the applicant furnishes the missing element or part under Rule 20.6 and submits a request under Rule 20.6). It is also proposed that the statement should not be restricted to the purposes of Rule 20.6 but should, instead, be in general terms so as to ensure that it would also be effective in the national phase before designated Offices.]

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.

[Rule 4.18, continued]

(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]

12.2 *Language of Changes in the International Application*

(a) to (c) [No change]

(d) Any missing part furnished by the applicant under Rule 20.5(b) or 20.6(b) and any missing element furnished by the applicant under Rule 20.6(b) shall be in the language in which the international application is filed or, where a translation of the international application is required under Rule 12.3(a), 12.4(a) or 55.2(a), in both the language of the application and the language of that translation.

12.3 *Translation for the Purposes of International Search*

(a) and (b) [No change]

(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 8 in the Introduction to 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.

~~(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) [No change] Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers comply with 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 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).

(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 determination under Article 11(1) is positive, the receiving Office shall stamp ~~on~~ the request as prescribed by the Administrative Instructions. ~~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 8 in the Introduction to this document.]

(b) [No change] 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 ~~20.6~~ Correction Under Article 11(2) ~~Invitation to Correct~~

(a) The invitation to correct under Article 11(2)(a) shall specify the requirement provided for under Article 11(1) which, in the opinion of the receiving Office, has not been fulfilled.

[COMMENT: Renumbering and clarification only.]

(b) The receiving Office shall send the invitation promptly. In the invitation, the receiving Office shall invite ~~mail the invitation to~~ the applicant, at his option:

(i) to furnish the required correction; or

(ii) where applicable, to make a request in accordance with Rule 20.6(b);

and to make observations, if any, within the applicable time limit under Rule 20.7. ~~and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction. The time limit shall not be less than 10 days, and shall not exceed one month, from the date of the invitation.~~ If that ~~such~~ time limit expires after the expiration of 12 months ~~one year~~ from the filing date of any application whose priority is claimed, the receiving Office shall ~~may~~ call this circumstance to the attention of the applicant.

[Rule 20.3(b), continued]

[COMMENT: It is proposed to amend paragraph (b) so that the invitation would refer to the possibility of making a request under proposed new Rule 20.6(b) for the incorporation by reference of the missing element as well as that of furnishing a correction (by way of furnishing the missing element). It is also proposed to change the term “one year” to “12 months” for consistency with Rule 4.10(a)(i) and Article 4C(1) of the Paris Convention.]

(c) Where one or more of the requirements under Article 11(1) are not complied with on the date of receipt of the purported international application but are complied with on a later date falling within the applicable time limit under Rule 20.7, the international filing date shall, subject to Rule 20.6, be that later date and the receiving Office shall proceed as provided in Rule 20.2.

[COMMENT: See PLT Article 5(4). It is proposed to add new paragraph (c) so as to clarify the procedure with regard to the according of the international filing date in case of subsequent compliance with Article 11(1) requirements, in particular in view of proposed new Rule 20.6 (according of the international filing date in the case that the description or the claims are missing from the international application but are contained in an earlier application the priority of which is claimed; see proposed new Rule 20.6, below).]

(d) Any correction under Article 11(2) or any request in accordance with Rule 20.6(b) received by the receiving Office after the expiration of the applicable time limit under Rule 20.7 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 comply with the requirements under Article 11(1).

[Rule 20.3(d), continued]

[COMMENT: Transferred from previously proposed Rule 20.4(b) (as suggested in at the fifth session of the Working Group; see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 94) and further amended so as to also refer to the receipt by the receiving Office of a request under Rule 20.6(b) for the incorporation by reference of a missing element (missing description or missing claim or claims). In the case of a correction being furnished, the date of receipt of the correction would be accorded as the international filing date even if the required correction was received after the expiration of the applicable time limit under Rule 20.7.]

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

~~(a)~~ If the receiving Office does not, receive, within the applicable time limit under Rule 20.7, a correction under Article 11(2) or a request in accordance with Rule 20.6(b), within the prescribed time limit, receive a reply to its invitation to correct, or if a the correction or a request has been received ~~offered by the applicant but the application~~ still does not fulfill the requirements provided for under Article 11(1), the receiving Office ~~it~~ shall:

[COMMENT: Rule 20.4 as proposed to be amended now also refers to the request under Rule 20.6(b) for the incorporation by reference of a missing element (missing description or missing claim or claims). At the fourth session of the Working Group, one delegation suggested that this provision should also cover cases in which no observations from the applicant were received by the receiving Office within the applicable time limit (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 55). However, it is not proposed to follow this suggestion since Article 11(2) refers only to the filing and the receipt of the “required correction.” Rule 20.8 (see below) would apply should the receiving Office, on the basis of the applicant’s “observations,” realize that it has erred in issuing an invitation to correct since the requirements under Article 11(1) were fulfilled when the papers were first received.]

(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;~~;~~

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 55. Upon further consideration, it is not any longer proposed to amend item (i) so as to align the terminology with that used in PLT Article 5(4)(b).]

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

[Rule 20.4, continued]

(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.

20.5 Missing Part of Description, Claims or Drawings

(a) Where, in determining whether the papers purporting to be an international application comply with the requirements under Article 11(1), the receiving Office finds that any of the parts of the application referred to in paragraph (b) appears to be missing from the international application, it shall promptly invite the applicant, at his option:

(i) to furnish the missing part; or

(ii) where applicable, to make a request in accordance with Rule 20.6(b);

and to make observations, if any, within the 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 this circumstance to the attention of the applicant.

[COMMENT: Under paragraph (a) as proposed to be amended, the receiving Office would be required, where applicable (that is, where the international application claims the priority of an earlier application), to also invite the applicant to make a request under proposed new Rule 20.6(b) for the incorporation by reference of the missing part.]

(b) Paragraph (a) shall apply where any of the following parts of the application appears to be missing from the international application:

(i) a part, but not all, of the description;

(ii) one or more, but not all, of the claims, or a part thereof;

[Rule 20.5(b), continued]

(iii) one or more, or all, of the drawings, or a part thereof.

[COMMENT: Items (i) to (iii) have been further amended to simplify the drafting, while still putting it beyond doubt as to the cases in which it applied, that is, in the case of a missing part of the description, a missing part of a claim or of the claims (including the case where an entire claim was missing), and a missing part of a drawing or of the drawings (including the case where an entire drawing was missing, or where all drawings were missing).]

(c) Where the applicant furnishes to the receiving Office a missing part referred to in paragraph (b)(i) to (iii), whether in response to an invitation under paragraph (a) or otherwise, on or before the date on which all of the requirements of Article 11(1) are complied with, that part shall be included in the international application.

[COMMENT: See the Comment on paragraph (d), below.]

(d) Where the applicant furnishes to the receiving Office a missing part referred to in paragraph (b)(i) to (iii), whether in response to an invitation under paragraph (a) or otherwise, after the date on which all of the requirements of Article 11(1) are complied with but within the applicable time limit under Rule 20.7, that part shall be included in the international application and, subject to Rule 20.6, the international filing date shall be corrected to the date on which the receiving Office received that missing part; the receiving Office shall promptly notify the applicant and the International Bureau accordingly.

[Rule 20.5(c), continued]

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 56 and the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 95. As suggested by one delegation (see the summary of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 95), in order to further simplify proposed new Rule 20.5, previously proposed paragraph (b) has been split into two paragraphs (now proposed new paragraphs (c) and (d)).]

(e) The applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (d), 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. The receiving Office shall promptly notify the applicant and the International Bureau accordingly.

[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*. This paragraph is now restricted to the case in which the receiving Office has, in accordance with paragraph (d), corrected the international filing date, consequential on the proposed division of previously proposed paragraph (b) into proposed new paragraphs (c) and (d) (see above).]

20.6 Incorporation by Reference of Missing Elements or Parts

(a) Where:

(i) on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the international application claims the priority of an earlier application and contains a statement for the purposes of incorporation by reference under Rule 4.18; and

(ii) an element of that earlier application is the same as, respectively, an element referred to in Article 11(1)(iii)(d) or (e) or a part referred to in Rule 20.5(b)(i) to (iii) that is missing from the international application;

that element or part shall, on the request of the applicant in accordance with paragraph (b), be considered to have been contained in the international application on that date and the receiving Office shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

[COMMENT: See the summary of the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 85 to 92, and paragraphs 10 to 12 in the Introduction to this document. See also Rule 4.18 as proposed to be amended, above. The purpose of the provisions that the missing element or missing part shall be considered to be 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 is to provide a legal basis for according as the international filing date the date on which all the requirements of Article 11(1) are complied. In the case of any missing drawing, the fact that any drawing is considered to be included 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 provides a legal basis for according that date, and not the date on which the missing drawing is received by the receiving Office, as the international filing date, since provisions of Article 14(2) would then not be applicable to that drawing.]

[Rule 20.6, continued]

(b) A request under paragraph (a) shall be submitted to the receiving Office within the applicable time limit under Rule 20.7 and shall be accompanied by:

(i) sheets embodying the missing element or missing part;

(ii) a copy of the earlier application, unless that earlier application was filed with the receiving Office in its capacity as a national Office or is available to the receiving Office in the form of a priority document in accordance with Rule 17.1;

[COMMENT: See PLT Rule 2(4)(i). See also the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 96 to 99.]

(iii) where the earlier application is not in the same language accepted by the receiving Office under Rule 12.1(a) for the international application, a translation of the earlier application into that language;

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

(iv) in the case of a missing part, an indication as to where the missing part is contained in the earlier application.

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

[Rule 20.6, continued]

(c) In respect of any request under paragraph (a), the applicant shall furnish to the receiving Office, within the time limit under Rule 17.1(a), the priority document relating to the earlier application, unless that priority document has already been filed with, or is available to, the receiving Office in accordance with Rule 17.1. *[To be added: Consequences of non-compliance with this paragraph.]*

[COMMENT: See PLT Rules 2(4)(ii) and 2(5)(b)(ii). See also the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 96 to 99. In view of the practical difficulties experienced by applicants in obtaining certified copies of earlier applications from certain Offices, it does not appear realistic to prescribe a time limit which is shorter than the time limit under Rule 17.1(a) for submitting such certified copies in respect of a priority claim (the time limit under Rule 17.1(a) is, in effect, the date of international publication of the international application concerned). The Working Group may wish to consider what the consequences of non-compliance with the requirements under paragraph (c) should be: correction (“missing part”) or cancellation (missing element”) of the international filing date after the expiration of the time limit under Rule 17.1(a), that is, in effect, after international publication? Or should the decision as to correction or cancellation of the international filing date be left to the designated Offices, to be taken in the national phase, noting 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? Under PLT Rules 2(4)(ii), non-compliance with the requirement to furnish a priority document within a certain time limit would have the consequence that the filing date would be corrected to be the date on which the missing part is received by the Office, and not the date on which all filing date requirements were fulfilled. Under PLT Rule 2(5)(b)(ii) (“missing element”), non-compliance with that requirement would have the consequence that the applicant could not, for the purposes of the filing date, replace the missing element with a reference to an earlier application the priority of which is claimed.]

[Rule 20.6, continued]

(d) 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 receiving Office, paragraphs (a) to (d) shall not apply to 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). It is proposed to add transitional reservation provision which would allow Contracting States whose national law, as applied by the receiving Office, was not compatible with the envisaged amendments of the PCT Regulations not to apply those amendments for as long as such incompatibility existed. Note, however, that a Contracting State could only take advantage of such transitional 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 national Office) which were not compatible with the proposed amendments of the PCT Regulations.]

20.7 Time Limit for Correcting Defects or Adding Missing Elements or Missing Parts

The applicable time limit for the purposes of Rule 20.3(b) or (c), 20.5(a) or (c), or 20.6(b) shall be:

(i) where an invitation under Rule 20.3(b) or 20.5(a) in relation to the defect, missing element or missing part concerned 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.

[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). 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 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 complied with, as was suggested during the fifth session of the Working Group (Paper No. 3). 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 *Error by the Receiving Office*

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

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraphs 46 and 71. Since the provisions under proposed Rule 20.5 concerning the time limits for furnishing a missing part and concerning the according of the international filing date are the same in both situations (that is, the situation where the receiving Office realized itself that it had made an error and the situation where the error had been pointed out to the receiving Office by the applicant), a split into two separate provisions, as suggested by one delegation at the fourth session of the Working Group, would appear to provide no benefit.]

~~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, invite the applicant, under Article 14(1)(b), 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 time limit [applicable](#) 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 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 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.

(b) Where the applicant has furnished a missing part to the receiving Office under Rule 20.5(b)(i) and the receiving Office has accorded, in accordance with Rule 20.6, the date on which all the requirements of Article 11(1) are complied with as the international filing date, a designated Office shall not review the decision of the receiving Office to accord that date as the international filing date, unless it may reasonably doubt that the missing part is completely contained in the earlier application as required under Rule 20.6. In the latter 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. If, after considering any such observations, the receiving office finds that the missing

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

part was not completely contained in the earlier application, it may treat the international application as if the international filing date was the date on which the receiving Office received that missing part in accordance with Rule 20.5(b)(i).]

[COMMENT: See the summary of the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraphs 102 and 103). See also 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).]

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

“MISSING PART” REQUIREMENTS

RULE 20 “CLEAN” COPY⁴

<u>Rule 20 [“clean” copy] International Filing Date</u>	2
<u>20.1 Determination Under Article 11(1)</u>	2
<u>20.3 Correction Under Article 11(2)</u>	3
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<u>20.8 Error by the Receiving Office</u>	10

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 comply with 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 determination under Article 11(1) is positive, the receiving Office shall stamp the request as prescribed by the Administrative Instructions.

(b) 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 Correction Under Article 11(2)

(a) The invitation to correct under Article 11(2)(a) shall specify the requirement provided for under Article 11(1) which, in the opinion of the receiving Office, has not been fulfilled.

(b) The receiving Office shall send the invitation promptly. In the invitation, the receiving Office shall invite the applicant, at his option:

(i) to furnish the required correction; or

[Rule 20.3(b) [“clean” copy], continued]

(ii) where applicable, to make a request in accordance with Rule 20.6(b);

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 this circumstance to the attention of the applicant.

(c) Where one or more of the requirements under Article 11(1) are not complied with on the date of receipt of the purported international application but are complied with on a later date falling within the applicable time limit under Rule 20.7, the international filing date shall, subject to Rule 20.6, be that later date and the receiving Office shall proceed as provided in Rule 20.2.

(d) Any correction under Article 11(2) or any request in accordance with Rule 20.6(b) received by the receiving Office after the expiration of the applicable time limit under Rule 20.7 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 comply with the requirements under Article 11(1).

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 under Article 11(2) or a request in accordance with Rule 20.6(b), or if a correction or a request has been received but the application still does not fulfill the requirements provided for under 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 Part of Description, Claims or Drawings

(a) Where, in determining whether the papers purporting to be an international application comply with the requirements under Article 11(1), the receiving Office finds that any of the parts of the application referred to in paragraph (b) appears to be missing from the international application, it shall promptly invite the applicant, at his option:

(i) to furnish the missing part; or

(ii) where applicable, to make a request in accordance with Rule 20.6(b);

and to make observations, if any, within the 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 this circumstance to the attention of the applicant.

(b) Paragraph (a) shall apply where any of the following parts of the application appears to be missing from the international application:

(i) a part, but not all, of the description;

(ii) one or more, but not all, of the claims, or a part thereof;

(iii) one or more, or all, of the drawings, or a part thereof.

[Rule 20.5 [“clean” copy], continued]

(c) Where the applicant furnishes to the receiving Office a missing part referred to in paragraph (b)(i) to (iii), whether in response to an invitation under paragraph (a) or otherwise, on or before the date on which all of the requirements of Article 11(1) are complied with, that part shall be included in the international application.

(d) Where the applicant furnishes to the receiving Office a missing part referred to in paragraph (b)(i) to (iii), whether in response to an invitation under paragraph (a) or otherwise, after the date on which all of the requirements of Article 11(1) are complied with but within the applicable time limit under Rule 20.7, that part shall be included in the international application and, subject to Rule 20.6, the international filing date shall be corrected to the date on which the receiving Office received that missing part; the receiving Office shall promptly notify the applicant and the International Bureau accordingly.

(e) The applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (d), 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. The receiving Office shall promptly notify the applicant and the International Bureau accordingly.

20.6 Incorporation by Reference of Missing Elements or Parts

(a) Where:

(i) on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the international application claims the priority of an earlier application and contains a statement for the purposes of incorporation by reference under Rule 4.18; and

(ii) an element of that earlier application is the same as, respectively, an element referred to in Article 11(1)(iii)(d) or (e) or a part referred to in Rule 20.5(b)(i) to (iii) that is missing from the international application;

that element or part shall, on the request of the applicant in accordance with paragraph (b), be considered to have been contained in the international application on that date and the receiving Office shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

(b) A request under paragraph (a) shall be submitted to the receiving Office within the applicable time limit under Rule 20.7 and shall be accompanied by:

(i) sheets embodying the missing element or missing part;

(ii) a copy of the earlier application, unless that earlier application was filed with the receiving Office in its capacity as a national Office or is available to the receiving Office in the form of a priority document in accordance with Rule 17.1;

[Rule 20.6(b) [“clean” copy], continued]

(iii) where the earlier application is not in the same language accepted by the receiving Office under Rule 12.1(a) for the international application, a translation of the earlier application into that language;

(iv) in the case of a missing part, an indication as to where the missing part is contained in the earlier application.

(c) In respect of any request under paragraph (a), the applicant shall furnish to the receiving Office, within the time limit under Rule 17.1(a), the priority document relating to the earlier application, unless that priority document has already been filed with, or is available to, the receiving Office in accordance with Rule 17.1. *[To be added: Consequences of non-compliance with this paragraph.]*

(d) 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 receiving Office, paragraphs (a) to (d) shall not apply to 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.

20.7 Time Limit for Correcting Defects or Adding Missing Elements or Missing Parts

The applicable time limit for the purposes of Rule 20.3(b) or (c), 20.5(a) or (c), or 20.6(b) shall be:

(i) where an invitation under Rule 20.3(b) or 20.5(a) in relation to the defect, missing element or missing part concerned 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.

20.8 Error by the Receiving Office

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

[End of Annex II and of document]

WIPO



PCT/R/WG/6/4 Add.1

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Sixth Session
Geneva, May 3 to 7, 2004

“MISSING PART” REQUIREMENTS:

REVISED PROPOSALS CONCERNING RULES 4.18 AND 20

Document prepared by the International Bureau

REVISED PROPOSALS

1. Document PCT/R/WG/6/4 contains proposals designed to align procedures under the Patent Cooperation Treaty (PCT) with those under the Patent Law Treaty (PLT) in cases where elements or parts of an international application are missing. On reflection, it appears that the provisions of Rule 20 as proposed to be amended would benefit from further rationalization, taking into account the broader range of circumstances covered by it in comparison with the existing text of the Rule. Revised proposed amendments of Rule 20, and also (consequentially) of Rule 4.18, are presented in the Annex to the present document.
2. By and large, the revised proposals do not differ in their legal effect from those contained in document PCT/R/WG/6/4. Rather, it is intended to set out the various steps to be taken in a more logical and transparent way, reducing duplication of passages in the drafting, and avoiding circuitous references.
3. A more detailed explanation of the proposed revised general structure of Rule 20 appears in the following paragraphs. Certain changes in the proposed procedures themselves, as distinct from the drafting of the provisions, are explained further below. References to particular provisions are, except where otherwise specified, to those set out in the Annex.

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Proposed amendments set out in document PCT/R/WG/6/4 relating to Rules other than Rules 4.18 and 20 would in general be maintained, subject to future review if it is decided to proceed with the revised proposals concerning Rules 4.18 and 20.

Revised Structure of Rule 20

4. Certain procedures relating to “missing elements” (the entire description or claims) and “missing parts” (of the description, claims or drawings, including completely missing drawings), are substantially the same in the Annex as in document PCT/R/WG/6/4, although in that document they appear in separate and differently worded provisions. Those procedures are all dealt with in the Annex in a more uniform way, in relation to both missing elements and missing parts, in Rule 20.3 (concerning invitations to correct) and Rule 20.5 (concerning incorporation by reference).

5. The making of a final (positive or negative) determination under Article 11(1) must await the conclusion, where applicable, of other procedures relating to the late furnishing, or incorporation by reference, of missing elements and missing parts. That final determination therefore seems to be better placed towards the end of Rule 20; see Rules 20.6 and 20.7 as they appear in the Annex.

6. A clear distinction is made 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) (missing elements – description and claims). Invitations to correct the former are dealt with in the Annex in Rule 20.2 and invitations to correct the latter, together with invitations relating to missing parts, in Rule 20.3.

7. The incorporation by reference of missing elements and of missing parts follows the same general principles and procedures. The provisions concerned are therefore proposed in the Annex to be combined in Rule 20.5.

8. The consequences of furnishing missing elements in cases where they cannot be incorporated by reference are different from the consequences in relation to missing parts. The inclusion of missing elements always affects the according of a filing date and is thus left, in the Annex, to Rule 20.6 (relating to positive determinations under Article 11(1)) and Rule 20.7 (relating to negative determinations under Article 11(1)). The inclusion of missing parts may or may not affect the filing date, and is dealt with in Rule 20.4.

9. The opportunity has been taken to co-locate in Rule 20.6 certain provisions which all relate to the making of a positive determination under Article 11(1). Rule 20.6(a) to (c) are in substance the same as Rule 20.2(a) to (c) in document PCT/R/WG/6/4. Rule 20.6(b) and (d) are the same in substance as, respectively, Rules 20.3(c) and 20.7(e) in document PCT/R/WG/6/4.

Changed Procedures in Comparison with Document PCT/R/WG/6/4

10. As a result of making a distinction between different kinds of defects under Article 11(1)(1) (see paragraph 6, above), the content of the invitation sent to the applicant is different in the two cases. Under Rule 20.2, the applicant is invited to correct defects under Article 11(1)(i), (ii) and (iii)(a) to (c) by way of furnishing a correction under Article 11(2).

Under Rule 20.3, the applicant is invited to make any of several possible responses in connection with missing elements or missing parts. The possible responses include furnishing a correction under Article 11(2), furnishing the missing part (for inclusion in the application under Rule 20.4), and making a request under Rule 20.5 (for the incorporation by reference of the missing element or missing part). Under both of Rules 20.2 and 20.3, the applicant is also invited to make observations.

11. It does not appear to be necessary, in the context of the revised Rule 20.3, to complicate the drafting by spelling out that a missing part of the claims includes the case where one or more entire claims are missing, and that a missing part of the drawings includes the case where one or more entire drawings are missing. If the matter is felt to be in need of clarification, that could be done by way of an understanding to be expressed by the Assembly at the time of the adoption of the amended Rule.

12. Rule 20.6(c) in document PCT/R/WG/6/4 included a requirement that the applicant must, in connection with a request for incorporation by reference of missing elements or missing parts, furnish the relevant priority document. In effect, that provision did little more than restate, in different words and in a different context, the obligation which applies in any event under Rule 17.1. On further consideration, it seems preferable to avoid restating the requirement that Rule 17.1 be complied with and, rather, to spell out the consequence of non-compliance with Rule 17.1 in the context of the Rule concerning incorporation by reference (Rule 20.5 in the present document). That consequence, as expressed in revised Rule 20.5(c), would be that a designated Office may, in the national phase, disregard the incorporation by reference. That is parallel to the consequence already provided by existing Rule 17.1(c), namely, the disregarding of the priority claim itself, and Rule 20.5(c) also imports *mutatis mutandis* the safeguards for applicants that are contained in existing Rule 17.1(c) and (d).

13. Rule 20.8 as set out in the Annex, relating to time limits under Rule 20, is the same in substance as Rule 20.7 in document PCT/R/WG/6/4, but a proviso has been added relating to the late furnishing of corrections and requests for incorporation by reference. The substance of that proviso appeared in document PCT/R/WG/6/4 as Rule 20.3(d), but it seems more appropriate to include it in Rule 20.8.

14. The Working Group is invited to consider the revised proposals relating to Rules 4.18 and 20 contained in the Annex.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

“MISSING PART” REQUIREMENTS:

REVISED PROPOSALS CONCERNING RULES 4.18 AND 20¹

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¹ The revised proposals contained in this Annex are presented only as a “clean copy” without highlighting of changes in comparison with either the existing text of Rules 4.18 and 20 or with the proposals contained in document PCT/R/WG/6/4. However, footnotes are included to indicate the location of corresponding provisions in document PCT/R/WG/6/4.

Rule 4

The Request (Contents)

4.1 to 4.17 [As in document PCT/R/WG/4]

4.18 *Statement for the Purposes of Incorporation by Reference*²

The request may contain a statement that, if an element or a part of the application referred to in Rule 20.3(i) or (ii) is missing from the international application, the same element or part contained in an earlier application the priority of which is claimed in the international application is, subject to compliance with the requirements of Rule 20.5(a) and (b), incorporated by reference in the international application.

4.19 [As in document PCT/R/WG/4]

² Rule 4.18 is the same as Rule 4.18 in document PCT/R/WG/6/4 except for changes consequential on the revised drafting of Rule 20.

Rule 20

International Filing Date

20.1 *Determination Under Article 11(1)*³

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

³ The text of Rule 20.1 is the same as Rule 20.1 in document PCT/R/WG/6/4.

*20.2 Invitation to Correct Defects Under Article 11(1)(i), (ii) and (iii)(a) to (c)*⁴

Where, in determining whether the papers purporting to be an international application comply with the requirements of Article 11(1), the receiving Office finds that any of the requirements of Article 11(1)(i), (ii) or (iii)(a) to (c) are not met, it shall promptly invite the applicant to furnish the required correction under Article 11(2) and to make observations, if any, within the applicable time limit under Rule 20.8. 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.

⁴ Rule 20.2 derives from Rule 20.3(a) and (b) in document PCT/R/WG/6/4, but is restricted in its scope to defects under Article 11(1)(i), (ii) and (iii)(a) to (c), leaving defects under Article 11(1)(iii)(d) and (e) to be dealt with in Rule 20.3. See paragraphs 6 and 10 in the main body of the present document.

20.3 *Invitation in Connection with Missing Elements Under Article 11(1)(iii)(d) and (e) or Missing Parts of Description, Claims and Drawings*⁵

Where, in determining whether the papers purporting to be an international application comply with the requirements of Article 11(1), the receiving Office finds that any of the following elements or parts are or appear to be missing:

- (i) an element referred to in Article 11(1)(iii)(d) or (e);

- (ii) a part 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;

it shall promptly invite the applicant, as applicable and at the applicant's option, to furnish the missing element by way of a correction under Article 11(2), to furnish the missing part or to make a request under Rule 20.5, and to make observations, if any, within the applicable time limit under Rule 20.8. 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.

⁵ Rule 20.3, insofar as it relates to missing parts, derives from Rule 20.5 in document PCT/R/WG/6/4. Insofar as it relates to missing elements, the subject matter of Rule 20.3 was not dealt with in express terms in document PCT/R/WG/6/4, but rather was covered in that document by Rule 20.3(a) and (b). See paragraphs 4, 6 and 10 in the main body of the present document.

20.4 *Later Furnishing of Missing Parts of Description, Claims and Drawings*⁶

(a) Where the applicant, whether in response to an invitation under Rule 20.3 or otherwise, furnishes to the receiving Office a missing part referred to in Rule 20.3(ii):

- (i) on or before the date on which all of the requirements of Article 11(1) are complied with, that part shall be included in the international application;
- (ii) after the date on which all of the requirements of Article 11(1) are complied with but within the applicable time limit under Rule 20.8, that part shall be included in the international application and, subject to Rule 20.5, the international filing date shall be corrected to the date on which the receiving Office received it.

The receiving Office shall promptly notify the applicant and the International Bureau accordingly.

(b) Where the international filing date has been corrected under paragraph (a)(ii), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (a), 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. The receiving Office shall promptly notify the applicant and the International Bureau accordingly.

⁶ Rule 20.4 derives from Rule 20.5(c) to (e) in document PCT/R/WG/6/4.

20.5 *Incorporation by Reference of Missing Elements and Missing Parts*⁷

(a) Where:

- (i) on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the international application claims the priority of an earlier application and contains a statement under Rule 4.18 for the purposes of incorporation by reference; and
- (ii) an element or a part of that earlier application is the same as, respectively, an element or a part referred to in Rule 20.3(i) or (ii) that is missing from the international application;

that element or part shall, on the request of the applicant in accordance with paragraph (b), be considered to have been contained in the international application on that date and the receiving Office shall promptly notify the applicant and the International Bureau accordingly.

⁷ Rule 20.5(a), (b) and (d) corresponds to Rule 20.6(a), (b) and (d) in document PCT/R/WG/6/4. The text of Rule 20.5(c) is new, but is intended to deal with the same issue as that raised in document PCT/R/WG/6/4 in connection with Rule 20.6(c). See paragraphs 7 and 12 in the main body of the present document.

[Rule 20.5, continued]

(b) A request under paragraph (a) shall be submitted to the receiving Office within the applicable time limit under Rule 20.8 and shall be accompanied by:

(i) sheets embodying the missing element or missing part;

(ii) a copy of the earlier application, unless that earlier application was filed with the receiving Office in its capacity as a national Office or is, before the expiration of that time limit, available to the receiving Office in the form of the priority document;

(iii) where the earlier application is not in the same language accepted by the receiving Office under Rule 12.1(a) for the international application, a translation of the earlier application into that language;

(iv) in the case of a missing part, an indication as to where the missing part is contained in the earlier application.

(c) Where the requirements of none of paragraphs (a), (b) and (b-*bis*) of Rule 17.1 are complied with, a designated Office may disregard the operation of paragraph (a) of this Rule, provided that Rule 17.1(c) and (d) shall apply *mutatis mutandis*.

[Rule 20.5, continued]

(d) 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 the receiving Office, those paragraphs shall not apply to 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.

20.6 *Positive Determination Under Article 11(1)*⁸

(a) If the determination under Article 11(1) is positive, the receiving Office shall stamp the request as prescribed by the Administrative Instructions.

(b) 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).

(d) Where one or more of the requirements of Article 11(1) are not complied with on the date of receipt of the purported international application but are complied with on a later date falling within the applicable time limit under Rule 20.8, the international filing date shall, subject to Rule 20.5, be that later date and the receiving Office shall proceed as provided in paragraphs (a) to (c) of this Rule.

⁸ Rule 20.6(a) to (c) corresponds to Rule 20.2(a) to (c) in document PCT/R/WG/6/4. Rule 20.6(d) corresponds to Rule 20.3(c) in that document. Rule 20.6(e) corresponds to Rule 20.8 in document PCT/R/WG/6/4.

[Rule 20.6, continued]

(e) 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 Rule 20.2 or 20.3 since the requirements of Article 11(1) were fulfilled when the papers were received, it shall proceed as provided in paragraphs (a) to (c) of this Rule.

20.7 *Negative Determination Under Article 11(1)*⁹

If the receiving Office does not receive, within the applicable time limit under Rule 20.8, a correction under Article 11(2) or a request in accordance with Rule 20.5(a) and (b), or if such a correction or request 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.

⁹ Rule 20.7 corresponds to Rule 20.4 in document PCT/R/WG/6/4.

20.8 *Time Limit for Correcting Defects or Furnishing or Incorporating Missing Elements or Missing Parts*¹⁰

The applicable time limit referred to in Rules 20.2, 20.3, 20.4(a)(ii), 20.5(b), 20.6(d) and 20.7 shall be:

- (i) where an invitation under Rule 20.2 or 20.3, 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 request under Rule 20.5, 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 20.7(i) shall be taken into account in determining whether the papers purporting to be an international application comply with the requirements under Article 11(1).

[End of Annex and of document]

¹⁰ The chapeau and items (i) and (ii) of Rule 20.8 correspond to Rule 20.7 in document PCT/R/WG/6/4. The proviso at the end of Rule 20.8 derives from Rule 20.3(d) in that document. See paragraphs 12 and 13 in the main body of the present document.

WIPO



PCT/R/WG/6/5

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Sixth Session
Geneva, May 3 to 7, 2004

CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

Document prepared by the International Bureau

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

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

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

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

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.

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

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

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

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

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

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

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

AMENDMENTS OF RULE 16BIS.1

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

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

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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 16bis

Extension of Time Limits for Payment of Fees

16bis.1 Invitation by the Receiving Office

(a) Where, by the time they are due under Rules 14.1(c), 15.4 and 16.1(f), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the international filing fee and the search fee, the receiving Office shall, [subject to paragraph \(d\)](#), invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

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

(b) *[Remains deleted]*

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

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

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

(i) and (ii) [No change]

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

(e) [No change] Any payment received by the receiving Office before that Office makes the applicable declaration under Article 14(3) shall be considered to have been received before the expiration of the time limit referred to in paragraph (a).

16bis.2 [No change]

Rule 53

The Demand

53.1 to 53.8 [No change]

53.9 *Statement Concerning Amendments*

(a) [No change]

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

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

(c) [No change]

Rule 69

Start of and Time Limit for International Preliminary Examination

69.1 *Start of International Preliminary Examination*

(a) to (c) [No change]

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

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

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

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

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

(e) [No change]

69.2 [No change]

[End of Annex and of document]

WIPO



PCT/R/WG/6/5 Add.1

ORIGINAL: English

DATE: March 31, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Sixth Session
Geneva, May 3 to 7, 2004

FURTHER CONSEQUENTIAL AMENDMENT

Document prepared by the International Bureau

1. The Annex to this document contains a proposal to amend Rule 4.6(a), consequential on the amendments adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10, Annex V).

2. *The Working Group is invited to consider the proposal contained in the Annex to this document.*

[Annex follows]

E

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

FURTHER CONSEQUENTIAL AMENDMENT

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

Rule 4

The Request (Contents)

4.1 to 4.5 [No change]

4.6 *The Inventor*

(a) Where Rule 4.1(a)(iv~~(v)~~) or (c)(i) applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them.

[COMMENT: The proposed amendment of paragraph (a) is consequential on the amendment of Rule 4.1(a) (deletion of item (iv) and consequential renumbering of previous item (v) as item (iv)) as adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004.]

(b) and (c) [No change]

4.7 to 4.18 [No change]

[End of Annex and of document]

WIPO



PCT/R/WG/6/7

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DATE: March 24, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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

Sixth Session
Geneva, May 3 to 7, 2004

PCT REFORM: FAST TRACK¹

Proposals submitted by the European Patent Office (EPO)

1. At the initial meeting of the Committee on Reform of the PCT in May 2001, emphasis was placed on processing reform proposals in as efficient a manner as possible and to that end a Working Group (WG) was established to consider proposals, report to the Committee and from there to the Assembly (see document PCT/R/1/26, paragraph 67 *et seq.*). While this method of working has enabled considerable progress to be reached in the reform exercise to date, it has become apparent in recent meetings of the WG that progress can become stalled whenever it is necessary to devote more time than anticipated to points of drafting and/or finer points of detail.

2. While these aspects of the reform exercise are of course essential, it is suggested that the very limited time available for oral discussion in the WG sessions should not be given over to these matters, or at least a balance must be struck between facilitating substantive discussion of proposals which appear on the WG agenda and points related more to drafting. The fact that agenda points have had to be postponed in previous meetings is testament to the need to prioritize the time available during the WG sessions.

¹ The present document reproduces the contents of document PCT/R/WG/5/12, which was submitted to the fifth session of the Working Group, held in Geneva from November 17 to 21, 2003. Having regard to the time available, discussions on that document were deferred until this session (see the summary of the fifth session of the Working Group by the Chair, document PCT/R/WG/5/13, paragraphs 158 to 160).

3. The EPO therefore advocates greater use of the electronic forum, in advance of the WG sessions especially in relation to drafting matters. If proposals are posted well in advance of the meetings this would allow the International Bureau to incorporate drafting suggestions or at least to compile a list of such suggestions for consideration by the WG. It may also be useful to consider the establishment of a subcommittee devoted to drafting matters. A concern here may be that all delegations will insist on participation, however, it is suggested that the WG may well feel that a smaller subcommittee would be a more appropriate and more efficient forum for discussion of such matters, subject of course to the deliberations and conclusions of the subcommittee being transparent and open to review by the WG itself.

4. An offshoot of this suggestion would be that proposals which are purely on a working level and unlikely to arouse any political sensibilities or to be controversial from a substantive point of view might be posted on the electronic forum and if no objections are voiced put directly to the PCT Assembly for adoption. This would avoid the problem of useful proposals not being implemented promptly simply because time to consider them had run out in the WG. Once again, concerns about proposals being put to the Assembly in haste would be met because any delegation would remain free to object to the submission of a particular proposal without oral discussion in the WG. There is no suggestion to depart from the existing convention that proposals are forwarded on the basis of consensus in the WG and Committee.

5. *The Working Group is invited to consider the proposals contained in this document.*

[End of document]

WIPO



PCT/R/WG/6/8

ORIGINAL: English

DATE: April 2, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Sixth Session
Geneva, May 3 to 7, 2004

INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

Document prepared by the International Bureau

BACKGROUND

1. During its third session, the Working Group discussed proposals for a possible 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, while it would be within the competence of the Working Group, 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).¹

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. For the fourth session of the Working Group, the International Bureau had prepared a proposal to amend Rule 48 so as to require the International Bureau, on request of 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 is 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, discussions on this proposal were deferred until the fifth session of the Working Group.

3. At the fifth session of the Working Group, discussions on the proposals to amend Rule 48 were again deferred, following an explanation by the International Bureau that further study and consultation was needed. The Working Group's discussions at its fifth session are outlined in document PCT/R/WG/5/13, paragraphs 15 to 17, reproduced in the following paragraphs:

“PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT

“15. Discussions were based on document PCT/R/WG/5/1, Annex III.

“16. The Secretariat explained that further study and consultation was needed before a revised proposal providing for publication of translations of an international application furnished by the applicant could be prepared. The revised proposal should take into account, in particular, the implications of provisions in national laws relating to prior art effect of international applications.

“17. The Working Group agreed to revert to the matter at its next session.”

4. The Annex to this document contains revised proposals, taking into account the comments received on previous draft proposals. The main features of the revised proposals are outlined in the following paragraphs.

INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

5. International publication and communication to designated Offices of the international application in more than one language would be beneficial for the protection of rights of the applicant under the national law of certain designated States, for example, 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.

6. It is thus proposed to amend the PCT Regulations so as to allow for the international publication of the international application in more than one language. Under the Regulations as proposed to be amended, the applicant would be permitted to furnish, for the purposes of international publication, one or more translations of the international application (other than the request and any sequence listing part) into one or more additional languages of publication, different from the “usual” language of publication of the international application. Where the applicant furnishes such a translation, with a time limit of 17 months from the priority date, the international application would be published in both the “usual” language of publication and the additional language of publication, that is, the language of the translation furnished by the applicant.

7. In order to achieve the intended prior art effect, any translation into an additional language of publication furnished by the applicant for the purposes of international publication would have to comply with the physical requirements referred to in Rule 11 to the extent necessary for the purpose of reasonably uniform publication, and would have to be accompanied by a translation into the same language of the following elements:

(i) any amendment under Article 19 and any statement filed under Article 19(1) filed prior to the furnishing of the translation into the additional language of publication;

(ii) 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) requested prior to the furnishing of the translation into the additional language of publication;

(iii) any indications in relation to deposited biological material referred to in Rule 13*bis*.4 furnished, separately from the description, prior to the furnishing of the translation into the additional language of publication.

8. As regards the permitted languages into which the international application is to be translated, it is proposed to limit those languages to the “languages of publication” as referred to in present Rule 48.2(a), so as to enable the International Bureau to establish, for the purposes of international publication, a standardized front page in the language of the translation.

9. As regards the inclusion in the translation of certain rectifications of “obvious errors” in the international application, note that the present draft is based on present Rule 91. Rules 12 and 48 as proposed to be amended would have to be further amended should the Working Group agree to amend the provisions of the PCT Regulations dealing with the rectification of obvious errors, as proposed in document PCT/R/WG/6/3.

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

[Annex follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

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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.

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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) to (d) [No change]

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), 12.4(a) or 55.2(a), or where a translation of the international application has been furnished under Rule 12.5(b), any such indication shall be filed in both the language of the application and the language of that translation.

[COMMENT: It is proposed to add new Rule 12.1(*bis*) 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 13bis.4 separately from the description are to be filed. Furthermore, it is proposed to provide that those indications are also to be furnished in the additional language of publication where the applicant has furnished a translation of the international application under Rule 12.5(b).]

12.2 *Language of Changes in the International Application*

(a) [No change] Any amendment of the international application 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 application shall be in the language in which the application is filed, provided that:

(i) [No change] 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 the language of the application and the language of translation;

(ii) where a translation of the international application has been furnished under Rule 12.5, rectifications referred to in Rule 91.1(e)(ii) shall be filed in the language of the application and the language of that translation;

(iii) ~~(ii)~~ where a translation of the request is required under Rule 26.3ter(c), rectifications referred to in Rule 91.1(e)(i) need only be filed in the language of that translation.

[COMMENT: It is proposed to amend paragraph (b) so to ensure that any rectification of an obvious error in the international application (other than the request) requested by the applicant after the furnishing of a translation of the international application under proposed new Rule 12.5(b) is furnished in the language of that translation (any rectification of an obvious error requested by the applicant prior to the furnishing of a translation under Rule 12.5 would have to be translated into the language of that translation and furnished together with that translation under proposed new Rule 12.5(e) (see below)).]

[Rule 12.2, continued]

(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, [12.4](#), [12.5](#) or 55.2(a), or in a translation of the request furnished under Rule 26.3~~ter~~(c), shall be in the language of the translation.

[COMMENT: 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. Note that this proposed amendment is not related to the proposed amendments concerning international publication in multiple languages and 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 also 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) to (e) [No change]

12.4 Translation for the Purposes of International Publication

(a) to (e) [No change]

12.5 Additional Translations for the Purposes of International Publication

(a) The applicant may, within the time limit under paragraph (f), request that the international application be published in one or more languages of publication, in addition to that in which it is to be published under Rule 48.3(a) or (b).

(b) A request under paragraph (a) shall be sent to the International Bureau and shall be accompanied by:

(i) a translation of the international application into each additional language concerned, except for a language into which a translation has already been furnished under Rule 12.3;

(ii) a special publication fee whose amount shall be fixed in the Administrative Instructions.

(c) Paragraph (b) shall not apply to the request nor to any sequence listing part of the description.

(d) The International Bureau shall check any translation furnished under paragraph (b) 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 publication, and shall invite the applicant to correct any defect within the time limit under paragraph (f). If the necessary correction is not submitted within that time limit, the request under paragraph (a) shall be considered not to have been made.

[Rule 12.5, continued]

(e) A translation furnished under paragraph (b) shall be accompanied by a translation into the same language of:

(i) any amendment under Article 19 and any statement under Article 19(1) filed prior to the furnishing of any translation under paragraph (b);

(ii) any rectification of an obvious error referred to in Rule 91.1(e)(ii) requested prior to the furnishing of any translation under paragraph (b);

(iii) any indication in relation to deposited biological material referred to in Rule 13bis.4 furnished prior to the furnishing of any translation under paragraph (b).

(f) The time limit referred to in paragraphs (a) and (c) shall be:

(i) where the applicant does not make a request for early publication under Article 21(2)(b), subject to paragraph (g), 17 months from the priority date;

(ii) where the applicant does make such a request, the time when the technical preparations for international publication have been completed.

[COMMENT: See paragraphs 5 to 8 in the Introduction to this document.]

[Rule 12.5, continued]

(g) Any translation of a rectification of an obvious error referred to in paragraph (e)(ii) furnished after the expiration of the time limit referred to in paragraph (f)(i) 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: 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. However, as regards the translation of any rectification of an obvious error, it is proposed to, in effect, extend that 17-month period 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 (note 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)). Paragraphs (f) and (g) would have to be further amended should the Working Group agree to amend the provisions of the PCT Regulations dealing with the rectification of obvious errors, as proposed in document PCT/R/WG/6/3.]

Rule 26

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

26.1 to 26.3bis [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, 26.3bis, 26.5 and 29.1 shall apply *mutatis mutandis*.

[COMMENT: The proposed amendments are consequential on the proposed addition of new Rule 48.3(b-bis) (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 title 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 addition of new Rule 48.3(b-*bis*) (see below). Note that, where the applicant requests publication of the international application in an additional language of publication under Rule 12.5, the applicant would not be required to furnish a translation of the title as established by the International Searching Authority under Rule 37, noting that a title not established by the applicant but by the International Searching Authority would usually not have any prior art effect.]

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 addition of new Rule 48.3(b-*bis*) (see below). Note that, where the applicant requests publication of the international application in an additional language of publication under Rule 48.3(b-*bis*), the applicant would not be required to furnish a translation of the abstract as corrected or established by the International Searching Authority under Rule 38, noting that an abstract not established by the applicant but by the International Searching Authority would usually not have any prior art effect.]

(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 addition of new Rule 48.3(b-*bis*) (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) and, where a translation of the international application has been furnished under Rule 12.5, in the language of that translation ~~of publication~~.

[COMMENT: It is proposed to amend Rule 46.3 so to ensure that any amendment under Article 19 furnished by the applicant after the furnishing of a translation of the international application under proposed new Rule 12.5(b) is furnished in the language of that translation (any amendment under Article 19 furnished by the applicant prior to the furnishing of a translation under Rule 12.5 would have to be translated into the language of that translation and furnished together with that translation under proposed new Rule 12.5(e) (see above)).]

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) and, where a translation of the international application has been furnished under Rule 12.5, in the language of that translation. The statement 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.

[Rule 46.4, continued]

[COMMENT: It is proposed to amend Rule 46.4 so to ensure that any statement under Article 19(1) furnished by the applicant after the furnishing of a translation of the international application under proposed new Rule 12.5(b) is furnished in the language of that translation (any statement under Article 19(1) furnished by the applicant prior to the furnishing of a translation under Rule 12.5 would have to be translated into the language of that translation and furnished together with that translation under proposed new Rule 12.5(e) (see above)).]

(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 the language in which it is published under Rule 48.3(b-bis).

[COMMENT: The proposed amendments are consequential on the proposed addition of new Rule 48.3(b-bis) (see below). Note that, in accordance with Rule 93bis (“communication on request”), 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) [No change]

47.4 [No change]

Rule 48

International Publication

48.1 *Form*

- (a) The international application shall be published as part ~~in the form~~ of a pamphlet.

[COMMENT: It is proposed to amend paragraph (a) so as to clarify that the pamphlet is not identical to, but only contains, among other elements, the published international application. Without such an amendment, it would appear that the translation under proposed new Rule 12.5 would have to contain all elements contained in the pamphlet as listed in Rule 48.2.]

- (b) [No change]

48.2 *Contents*

- (a) to (e) [No change]

(f) If the claims have been amended under Article 19, the pamphlet ~~publication~~ 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: Clarification only.]

[Rule 48.2, continued]

(g) [No change]

(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 pamphlet shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after such amendments, either the pamphlet (containing the claims as amended) will be republished or a statement reflecting all the amendments will be published in the language in which the international application is published under Rule 48.3(a) or (b) and, where applicable, in the language in which it is published under Rule 48.3(b-bis). 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.

(i) [No change]

(j) Where the international application is published in an additional language under Rule 48.3(b-bis), the pamphlet shall include, in that additional language, the elements referred to in paragraphs (a)(i) to (iv), (vi) and (viii), and, subject to Rule 48.3(b-ter), paragraph (f), of this Rule.

48.3 *Languages of Publication*

(a) [No change] If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.

(b) [No change] If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 or 12.4, that application shall be published in the language of that translation.

(b-bis) Where the applicant requests, under Rule 12.5, publication of the international application in one or more additional languages and the requirements of that Rule are, subject to paragraph (b-ter), complied with, the international application shall be published in that language or those languages in addition to the language provided for under paragraph (a) or (b) of this Rule.

(b-ter) Where the requirements of Rule 12.5 are not complied with because the applicant did not furnish a translation of any amendment under Article 19 or any statement under Article 19(1) as required under Rule 12.5(e)(i), the international application shall nevertheless be published in accordance with paragraph (b-bis). In such a case, any consequences of non-compliance with the requirement under Rule 12.5(e)(i) shall be as provided by the national law applicable by the designated Office.

[COMMENT: Paragraph (b-ter) is designed to recognize that Article 19 amendments may not be proceeded with for the purposes of the national phase, either in connection with the affording of provisional protection (cf. Article 29) or in connection with the prior art effect of international applications (cf. Article 64(4)).]

[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 paragraph (c) are consequential on the proposed addition of new Rule 48.3(b-*bis*) (see below).]

48.4 to 48.6 [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 addition of new Rule 48.3(b-*bis*) (see below).]

55.2 *Translation of International Application*

(a) Where neither the language in which the international application is filed nor the language in which the international application is published under Rule 48.3(a) or (b) 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 addition of new Rule 48.3(b-*bis*) (see below).]

[Rule 55.2, continued]

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

(ii) [No change] a language of publication.

(b) to (d) [No change]

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 addition of new Rule 48.3(b-*bis*) (see below).]

(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 addition of new Rule 48.3(b-*bis*) (see below).]

Rule 74

**Translations 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 addition of new Rule 48.3(b-*bis*) (see below).]

[End of Annex and of document]

WIPO



PCT/R/WG/6/9

ORIGINAL: English

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Sixth Session
Geneva, May 3 to 7, 2004

IMPROVING THE QUALITY OF INTERNATIONAL SEARCHES

Document prepared by the International Bureau

BACKGROUND

1. At its fourth and fifth sessions, the Working Group gave preliminary consideration to options for future development of international search and examination (see documents PCT/R/WG/4/7 and PCT/R/WG/5/9 and the summaries by the Chair in document PCT/R/WG/4/14, paragraphs 82 to 91 and document PCT/R/WG/5/13, paragraphs 112 to 127). Most delegations considered that the effects of the new enhanced international search and preliminary examination system should be assessed before considering further fundamental changes to the international search and examination system. However, a number of delegations expressed an interest in exploring possible measures which might improve the quality and usefulness of international search and examination reports separately from the question of what effect those reports might have.

2. If national Offices are to make effective use of international search and preliminary examination reports, the quality and completeness of reports and the degree of confidence which can be placed in them are important issues. It is also necessary that it be feasible for the International Authorities to establish such reports within the required timescale (in line with the needs of both applicants and third parties), with high quality and at a reasonable cost.

3. This document considers the possibility of introducing further features into the search procedure under the PCT, to permit a more complete retrieval of relevant prior art during the international phase. As a consequence, written opinions and international preliminary reports on patentability prepared by International Authorities would become more effective, since they would have additional prior art on which to assess whether claimed inventions appear to be novel and to involve an inventive step.

SUPPLEMENTARY SEARCHES BY OTHER INTERNATIONAL SEARCHING AUTHORITIES

Policy Benefits of Increased Searching

4. The Committee on Reform of the PCT (“the Committee”), at its first session, considered the possibility of allowing applicants the option of requesting international searches by more than one International Searching Authority (see document PCT/R/1/26, paragraphs 109 to 146). At that time, a number of States considered that such searches (“supplementary international searches”) would add considerable value to the international procedure for applicants, national Offices and third parties alike. From the Member States’ point of view, it is clear that proper consideration of a wider range prior art must be beneficial to the extent that it reduces the risk of granting patents which are invalid because of disclosures which might not have been considered by the main International Searching Authority. This may be of particular concern in the case of inventions in fields which are not currently well documented by patent publications or other matter which falls within the PCT minimum documentation.

5. On the other hand, it is also necessary to consider whether the degree to which the search may be improved is proportionate to the expense and effort which would be involved. Concern was expressed by some States, during the above-mentioned first session of the Committee, at possible unnecessary duplication of work, particularly in view of the workload difficulties of some Authorities. However, it was noted that supplementary international searches could be complementary, rather than duplicative. For example, it may sometimes be desirable for international searches performed by the European Patent Office or the United States Patent and Trademark Office to be supplemented by a supplementary international search performed by the Japan Patent Office, the Russian Agency for Patents and Trademarks or the Spanish Patent and Trademark Office, respectively, of their Japanese, Russian or Spanish language collections, since most Authorities are required to search patent documents in these languages only if English language abstracts are available, and they would generally use primarily such abstracts for search purposes, rather than the original documents. Furthermore these Authorities may have access to non-patent documents which might be overlooked by the primary International Searching Authority because they were not in, or accompanied by an abstract in, an official language of that Authority.

6. The Annex contains a preliminary draft of possible amendments of the Regulations, designed to illustrate how a system of supplementary international searches might be implemented.

Possible System as Seen by Applicant

7. From the point of view of the applicant, this system would involve simply:

(a) in the request, choosing the primary International Searching Authority (if more than one is competent) and specifying any further Authorities from which supplementary international searches are desired;

(b) paying the appropriate fees and furnishing any translations of the international application necessary for the Authorities to conduct the international search or supplementary international searches;

(c) if the primary International Searching Authority finds that unity of invention is lacking, paying any additional fees requested (assuming it is desired that the additional inventions be searched).

8. The international search report and written opinion would be transmitted to the applicant at the same time as at present, followed later by the supplementary international search reports and, if new prior art is found, written opinions. It is assumed in this draft proposal that most applicants would prefer to receive the results of each search as soon as it becomes available, rather than waiting several months beyond the current time (and almost always until after international publication) to receive all the search results together in a single document.

Possible System in Greater Detail, Including Actions Transparent to Applicants

9. In more detail, explaining the actions of each of the authorities and individuals concerned, the system would involve the following actions and features:

– *Authorities Prepared to Provide Supplementary International Searches*

(a) Each International Searching Authority which is prepared to provide supplementary international searches (a “participating” Authority) notifies the International Bureau to that effect, including notification of any limitations on the circumstances in which it is prepared to carry out such supplementary international searches, beyond that of the subject matter which the Authority is not required to search under Rule 39.1 (for example due to a temporary limited capacity to carry out such supplementary international searches in certain fields of technology).

– *Request, Fees and Translations*

(b) The applicant includes, in the request under Rule 4, a request that one or more supplementary international searches be carried out, and indicates the participating Authority or Authorities from which such searches are desired.

(c) The request for one or more supplementary international searches is subject to a an additional component in the international filing fee (to cover publication and translation costs; this would be set out in the Schedule of Fees and is not included in this draft proposal) and to a supplementary search fee for the benefit of each participating Authority concerned.

(d) The receiving Office checks whether any translation is required by a particular International Searching Authority and, if necessary, invites the applicant to furnish one. It then transmits the request (which includes the request for supplementary international search) to each participating Authority concerned, together with a copy (or translation) of the international application.

– *Establishing, Transmitting and Publishing the Supplementary International Searches*

(e) The International Bureau transmits the international search report and written opinion of the primary International Searching Authority, as soon as they have been established, to each participating Authority concerned.

(f) The participating Authorities concerned each establish a supplementary international search report within three months of receipt of the last of the necessary documents from the receiving Office and International Bureau. This will typically be around 19 months after the priority date: too late to be published in or with the pamphlet, but in time to permit consideration by the applicant of the results, and to file amendments under Article 34 (if a demand for international preliminary examination is made) following such consideration, before any international preliminary examination commences. Any supplementary international search reports which are available in time for international publication are included in the pamphlet; the others are published together as a further document once all are available.

(g) The participating Authority is not required to establish a supplementary international search in respect of subject matter for which it is not required to establish international searches under Article 17(2).

(h) The primary purpose of the supplementary international search is to find documents in languages in which the Authority concerned has a particular skill and which might not have been consulted by the primary International Searching Authority. As a result, the supplementary international search usually covers only documents in the collection of the Authority concerned which are in an official language of that Authority and do not form part of the minimum documentation (since the latter material should already have been considered by the primary International Searching Authority). The main exception to this would be that the supplementary international search covers those parts of the minimum documentation which are in an official language of the Authority concerned where it is likely that the primary International Searching Authority will have searched those parts on the basis of English-language abstracts only (as would be common for Japanese, Russian and Spanish language documents, for example; see paragraph 5 and the comment under proposed Rule 45bis.4(b)).

(i) To avoid uncertainty from conflicting views from two Authorities at the same stage, the supplementary report does not re-cite any document which has been cited by the primary International Searching Authority (including apparently “equivalent” patent publications, unless relevant further disclosure is found in such a family member).

– *Unity of Invention*

(j) To avoid complication and uncertainty, each participating Authority concerned accepts the opinion of the primary International Searching Authority concerning unity of

invention (see also paragraph 10, below): where the primary International Searching Authority finds unity of invention, the supplementary international search covers all claims (subject to other limitations, such as those in respect of subject matter); where a lack of unity is found, the supplementary international search is established only on the first invention identified unless additional fees are paid before the supplementary international search is commenced.

– *Supplementary Written Opinions*

(k) If, but only if, the participating Authority concerned discovers further relevant documents, it also establishes a supplementary written opinion, covering only the question of novelty and inventive step in relation to those further documents (in combination with documents already cited in the international search report if necessary). Like the supplementary international search report not re-citing documents from the primary international search report (see item (i), above), this avoids duplication and the uncertainty which would be caused if differing opinions on the same subjects were provided both at the same stage. This supplementary written opinion is appended to the written opinion of the primary International Searching Authority before that opinion is either considered by the International Preliminary Examining Authority during international preliminary examination or else used by the International Bureau in establishing the contents of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty).

– *Effect on International Preliminary Examination*

(l) The time limit for making the demand under Rule 54*bis*.1(a) (if desired), and hence for starting international preliminary examination under Rule 69.1(a) (unless the applicant requests an earlier start), is not less than one month from the date of transmittal to the applicant of a copy of the supplementary international search report and of any supplementary written opinion by the participating Authority.

(m) Where a supplementary international search discovers prior art which was not included in the international search report, it is not necessary, merely because of that, for the International Preliminary Examining Authority to issue a written opinion before establishing the international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty) since the relevance of that prior art will have been indicated in a supplementary written opinion.

International Applications Where Lack of Unity of Invention is Found

10. With regard to international applications where a lack of unity of invention is found, it seems essential that the primary International Searching Authority's opinion on unity of invention be accepted for the purposes of the supplementary international searches; a system where each participating Authority concerned reviewed the matter while still at the search stage would be untenable. Where the primary International Searching Authority invited the applicant to pay additional fees under Rule 40 for the search of one or more additional inventions, it would also invite the applicant to pay equivalent fees to any participating Authorities concerned, who would conduct their supplementary international searches to the extent that fees had been paid prior to the commencement of the supplementary international search, as described in paragraph 9(j), above.

UPDATING THE SEARCH DURING INTERNATIONAL PRELIMINARY EXAMINATION

11. Another reason that the international search may not be complete is because of the time at which it is performed. The international search typically takes place around 15 months from the priority date of the international application. If the application's priority date is valid, this is usually adequate for determining novelty and inventive step in relation to the prior art defined by Rule 64.1, since only written disclosures made available to the public before the "relevant date" may be considered for this purpose. However, in most Contracting States, patent documents published after that date may also be relevant to novelty and/or inventive step if they have an earlier priority date. This can be extremely important in fast-moving technologies.

12. Rules 33, 64.3 and 70.10 make some provision for such documents to be covered by the international search and to be reported in the international preliminary report on patentability. However, at the time when the international search is performed, these documents may not yet have been published, or for other reasons might not have become available in the International Authority's search collection. If the search were updated later on, during any international preliminary examination which may be carried out, to discover documents which may not have been available to the International Searching Authority at the time of the international search, it might eliminate the need for an equivalent check to be made by individual States and allow relevant documents to be brought to the attention of applicants at a point where appropriate amendments can still be made and examined centrally, if so desired. This would make the international preliminary report on patentability by the International Preliminary Examining Authority more useful for both applicants and elected Offices, especially Offices without the capacity to perform such checks themselves.

13. Draft Rule 66.1*ter*, shown in the Annex, illustrates how searches might be updated within the international phase by the International Preliminary Examining Authority while conducting the international preliminary examination.

14. This aspect of the system would not require any new actions on behalf of the applicant. According to this draft rule, the international search would be updated by the International Preliminary Examining Authority for every international application for which international preliminary examination is demanded. By this stage, all relevant documents would usually be in the search documentation available to the International Preliminary Examining Authority, so that it should not be necessary for elected Offices to repeat this process in the national phase, at least to the extent that patent documents relevant to a Contracting State (or equivalents from the patent family) are held by that Authority.

15. 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:¹

SUPPLEMENTARY INTERNATIONAL SEARCHES

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¹ 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.

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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_a.

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

[COMMENT: Item (iv) would be included only if the proposals in document PCT/R/WG/6/1, relating to restoration of the right of priority, proceed at the same time as the present amendments.]

(v) a request for one or more supplementary international searches as provided in

Rule 45bis.1.

4.2 to 4.18 [No change]

Rule 11

Physical Requirements of the International Application

11.1 *Number of Copies*

(a) [No change]

(b) Any receiving Office may require that the international application and any of the documents referred to in the check list (Rule 3.3(a)(ii)), except the receipt for the fees paid or the check for the payment of the fees, be filed in two or three copies. Any receiving Office may further require that an additional copy of the international application be filed for each International Searching Authority from which a supplementary international search is requested under Rule 45bis.1. In ~~that~~ those cases, the receiving Office shall be responsible for verifying the identity of the second and ~~the third~~ any further copies with the record copy.

11.2 to 11.14 [No change]

Rule 12

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

12.1 to 12.3 [No change]

12.3bis Translation for the Purposes of Supplementary International Search Under Rule 45bis

(a) Where the language in which the international application is filed or any translation furnished under Rule 12.3(a) or 12.4(a) is not a language accepted by an International Searching Authority that is to carry out a supplementary international search under Rule 45bis, the applicant shall furnish to the receiving Office a translation of the international application into a language which is accepted by that Authority, prior to the expiration of whichever of the following period expires later:

(i) three months from the date of receipt of the international application by the receiving Office; or

(ii) nine months from the priority date.

[Rule 12.3bis(a), continued]

[COMMENT: The translation for supplementary international search is not needed as early as that for the international search (which must be furnished within one month from the date of receipt of the international application by the receiving Office), but should be available to the Authority concerned by the time that the international search report would normally be established under Rule 42.1, so that the supplementary international search can be started promptly, especially in the case where the full priority 12 months has been used and international publication is imminent.]

(b) Paragraph (a) shall not apply to the request nor to any sequence listing part of the description.

[COMMENT: Modeled on Rule 12.3(b).]

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

(i) to furnish the required translation within the time limit under paragraph (a);

(ii) in the event that the required translation is not furnished within the time limit under paragraph (a), to furnish it and to pay, where applicable, the late furnishing fee referred to in paragraph (e), within one month from the date of the invitation or four months from the date of receipt of the international application by the receiving Office, whichever expires later.

[COMMENT: Modeled on Rule 12.3(c)]

[Rule 12.3bis, continued]

(d) Where the receiving Office has sent to the applicant an invitation under paragraph (c) and the applicant has not, within the applicable time limit under paragraph (c)(ii), furnished the required translation and paid any required late furnishing fee, the request for supplementary international search shall be considered withdrawn and the receiving Office shall so declare. Any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence shall be considered to have been received before the expiration of that time limit.

[COMMENT: Modeled on Rule 12.3(d).]

(e) The furnishing of one or more translations after the expiration of the time limit under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of one late furnishing fee equal to 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

[COMMENT: Modeled on Rule 12.3(e). The procedures for checking receipt of translations and accepting late payments are closely modeled on those for the translation for the purposes of international search under Rule 12.3. In line with the proposals in respect of late furnishing fees for different formats of sequence listings (See PCT/R/WG/6/2), it seems appropriate to require only one (if any) fee where several translations for the purposes of supplementary international search are furnished late. However, given the very different time limits under Rules 12.3(a) and 12.3bis(a), the furnishing of translations for the international search and any supplementary international searches should be considered separate procedures within the receiving Office and this late furnishing fee may therefore be required in addition to any late furnishing fee in respect of a translation for the purposes of the primary international search.]

12.4 [No change]

Rule 16

The Search Fee

16.1 [No change]

16.1bis Supplementary Search Fee

(a) Each International Searching Authority which notifies the International Bureau under Rule 45bis.8 that it is prepared to carry out supplementary international searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out the supplementary international search and the other tasks specified under Rule 45bis.

[COMMENT: Modeled on Rule 16.1(a).]

(b) Rules 16.1(b) to (f) shall apply to the supplementary search fee *mutatis mutandis*.

16.2 *Refund*

(a) The receiving Office shall refund the search fee and any supplementary search fees to the applicant:

[Rule 16.2(a), continued]

- (i) if the determination under Article 11(1) is negative,
- (ii) if, before the transmittal of the search copy to the International Searching Authority, the international application is withdrawn or considered withdrawn, or
- (iii) if, due to prescriptions concerning national security, the international application is not treated as such.

(b) Any supplementary search fees paid shall also be refunded if, before the transmittal of the record copy to the International Bureau, the corresponding request for supplementary international search is withdrawn or considered not to have been made.

16.3 *Partial Refund*

Where the international application claims the priority of an earlier international application which has been the subject of an international search or supplementary international search by the same International Searching Authority, that Authority shall refund the search fee or supplementary search fee paid in connection with the later international application to the extent and under the conditions provided for in the agreement under Article 16(3)(b), if the international search report or supplementary international search report on the later international application could wholly or partly be based on the results of the international search effected on the earlier international application.

[Rule 16.3, continued]

[COMMENT: The agreement would make clear that the refunds would be available only to the extent that the search conducted on the earlier international application had the appropriate scope. Little or no discount would be expected on a new full international search in the event that the International Searching Authority had previously carried out only a supplementary international search, which would have considered a narrower range of prior art.]

Rule 16bis

Extension of Time Limits for Payment of Fees

16bis.1 Invitation by the Receiving Office

(a) Where, by the time they are due under Rules 14.1(c), 15.4, ~~and~~ 16.1(f), and 16.1bis, the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the international filing fee, ~~and~~ the search fee, and any supplementary search fees, the receiving Office shall, subject to paragraph (d), invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

[COMMENT: The reference to paragraph (d) is a clarification unrelated to the issue of supplementary international searches, explained in document PCT/R/WG/6/5.]

(b) [Remains deleted]

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

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

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

(ii) proceed as provided in Rule 29.

(c-bis) In the case referred to in paragraph (c) and subject to paragraph (e), if the insufficiency in the amount paid relates only to a supplementary search fee, the request for supplementary international search for which the fee has not been paid shall be considered not to have been made and the receiving Office shall so declare.

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

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

16bis.2 [No change]

[COMMENT: To avoid complicating the procedure before the receiving Office, payment, including late payment, of supplementary search fees is subject to the same timetable as the payment of the international search fee. However, failure to pay in full the fees relating to the supplementary international search results only in the request for supplementary international search being considered withdrawn, not the international application itself. The proposed amendment of “(d)” to “(e)” in Rule 16bis.1(c) is to correct an existing error (see document PCT/R/WG/6/5).]

Rule 40

Lack of Unity of Invention (International Search)

40.1 *Invitation to Pay*

(a) The invitation to pay additional fees provided for in Article 17(3)(a) shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention and shall indicate the amount to be paid.

(b) Where the request includes a request under Rule 45bis.1 that a supplementary international search be carried out by one or more International Searching Authorities, the invitation to pay additional fees shall also include an invitation to pay additional fees in respect of each supplementary international search and shall indicate the number of additional fees which are to be paid if the supplementary international searches are to be established in respect of the parts of the international application which do not relate to the invention first mentioned in the claims.

40.2 *Additional Fees*

(a) [No change] The amount of the additional fee due for searching under Article 17(3)(a) shall be determined by the competent International Searching Authority.

(b) [No change] The additional fee due for searching under Article 17(3)(a) shall be payable direct to the International Searching Authority.

[Rule 40.2, continued]

(b-bis) Paragraphs (a) and (b) shall apply *mutatis mutandis* to additional fees payable in respect of supplementary international searches to be performed under Rule 45bis by an International Searching Authority that has notified the International Bureau that it will carry out such supplementary international searches.

[COMMENT: Each International Searching Authority which has notified the International Bureau under Rule 45bis.1(b) that it will carry out supplementary international searches sets the level of additional fees which would be payable in respect of extending such supplementary searches to inventions beyond the first one. The additional fees are payable directly to each International Searching Authority concerned.]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protest shall be examined by a three-member board or other special instance of the International Searching Authority or any competent higher authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. The result of such examination shall be transmitted to any International Searching Authority from which a supplementary international search has been requested under Rule 45bis.1, which shall refund, to the appropriate extent, any additional fees paid to it. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

[Rule 40.2, continued]

(d) and (e) [No change]

40.3 *Time Limits*

(a) The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant's address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.

(b) The time limit for paying any additional search fees in respect of a supplementary international search requested under Rule 45bis shall be one month from the date of transmittal to the applicant of the international search report. Any payment received by the International Searching Authority which is to carry out the supplementary international search before that Authority begins the supplementary international search shall be considered to have been received before the expiration of that time limit.

[COMMENT: It is not necessary for the applicant to pay the additional fees in respect of supplementary international searches until they are due to be started (see draft Rule 45bis.3(c)).]

Rule 45bis

Supplementary International Searches

45bis.1 Request for Supplementary International Searches

The request may include a request that a supplementary international search be carried out by one or more International Searching Authorities specified in the request for supplementary international search, other than the International Searching Authority which is to carry out the international search under Article 16(1), having notified the International Bureau under Rule 45bis.8 that it will carry out such searches.

[COMMENT: It is only possible to request a supplementary international search from an International Searching Authority which has notified the International Bureau that it will carry out such supplementary international searches.]

45bis.2 Transmittal of the Supplementary Search Copy, Translation, Sequence Listing and International Search Report

(a) One copy of the international application (“supplementary search copy”) shall be transmitted to each Authority carrying out a supplementary international search. Rules 23 and 25 shall apply *mutatis mutandis* except that references to Rule 12.3(a) shall be read as references to Rule 12.3bis(a).

[COMMENT: Modeled on Article 12(1). As with the normal search copy, the receiving Office transmits along with the request either the description, claims, drawings and abstract as filed, or else the translation furnished for the purposes of the supplementary international search. The International Searching Authority acknowledges receipt of the supplementary search copy. Note that the request part of the international application contains the request for supplementary international search.]

[Rule 45bis.2, continued]

(b) The International Bureau shall, upon receipt of the international search report or declaration under Article 17(2)(a) and of the written opinion from the International Searching Authority, transmit that report or declaration and written opinion to each Authority carrying out a supplementary international search.

45bis.3 Commencement of Supplementary International Search

(a) Subject to paragraphs (b) and (c), the Authority carrying out a supplementary international search shall commence that search promptly on receipt of the last of the documents specified in Rule 45bis.2.

(b) If the Authority carrying out a supplementary international search finds that the international application is subject to a limitation notified under Rule 45bis.8, it may declare the request for supplementary international search withdrawn and promptly:

(i) notify the applicant and the International Bureau accordingly; and

(ii) refund the supplementary search fee, including any additional fees which may have been paid in response to an invitation under Rule 40.1(b).

[Rule 45bis.3(b), continued]

[COMMENT: The applicant's right to a refund under this paragraph extends only to the case where the supplementary international search is not made because of a restriction of which the International Bureau has been notified under Rule 45bis.8 and not because of a declaration equivalent to that under Article 17(2) (see also proposed Rule 45bis.4(c), below). The Authority concerned, rather than the International Bureau, makes this declaration since a determination as to whether or not the subject matter to be searched falls within the limitation is not a matter for the International Bureau. Also, by this stage it is in any case necessary for the International Searching Authority to make the necessary refund since the fees will have been transmitted by the receiving Office (Rule 16.2, above, provides for the refund of supplementary search fees by the receiving Office where the international application or the request for supplementary international search is withdrawn or considered not to have been made before the record copy is transmitted to the International Bureau).]

(c) Where the International Searching Authority has issued an invitation to pay additional fees under Article 17(3), the Authority carrying out a supplementary international search shall not begin the supplementary international search before the earlier of:

- (i) one month from the date of transmittal to the applicant of the international search report, or
- (ii) the date on which it receives one or more additional fees in response to the invitation under Rule 40.1(b)

unless the applicant indicates that no additional fees will be paid and requests an earlier start.

[COMMENT: The supplementary international search does not begin until the applicant has had an opportunity to file any additional fees in respect of the supplementary international search.]

[Rule 45bis, continued]

45bis.4 Supplementary International Search

(a) Subject to paragraphs (b) to (d), the Authority carrying out a supplementary international search shall endeavor to discover as much of the relevant prior art, further to that discovered in the international search, as its facilities permit. Rule 33 shall apply *mutatis mutandis*.

[COMMENT: Modeled in part on Article 15(4).]

(b) The Authority carrying out a supplementary international search shall not be required to consult the minimum documentation specified under Rule 34.

[COMMENT: The primary purpose of the supplementary international search is to find documents in languages in which the Authority concerned has a particular skill, which the International Searching Authority is not likely to have consulted. Consequently, the minimum documentation does not need to form a part of the supplementary international search, except for those parts which are in an official language of the Authority concerned, where it is likely that the International Searching Authority would have searched those parts on the basis of abstracts only (as would be common for Japanese and Russian language collections, for example). Further guidance on the appropriate extent of the supplementary international search would be set out in the International Search and Preliminary Examination Guidelines.]

(c) For the purposes of the supplementary international search, Article 17(2) and Rules 13^{ter}.1 and 39 shall apply *mutatis mutandis*.

[Rule 45bis.4(c), continued]

[COMMENT: The Authority is not required to conduct a supplementary international search in respect of subject matter or unclear applications for which it would not be required to conduct an international search. It may also request sequence listings in an appropriate electronic format if necessary.]

(d) If the International Searching Authority considered that the international application does not comply with the requirement of unity of invention under Rule 13, the Authority carrying out a supplementary international search shall establish the supplementary international search report on those parts of the international application which relate to the invention first mentioned in the claims as identified by the International Searching Authority (“main invention”) and on any parts of the international application in respect of which additional supplementary search fees have been paid in response to an invitation under Rule 40.1(b).

45bis.5 Supplementary International Search Report

(a) The Authority carrying out a supplementary international search shall establish a supplementary international search report or make a declaration under Rule 45bis.4(c) that no supplementary international search report will be established, within 3 months of receipt of the supplementary search copy from the International Bureau.

[COMMENT: Modeled in part on Rule 42.1]

(b) For the purposes of establishing the supplementary international search report, Rule 43 shall apply *mutatis mutandis*, subject to paragraph (c).

[Rule 45bis.5, continued]

(c) The supplementary international search report shall not contain the citation of any document which was cited in the international search report, unless that document is considered relevant to the question whether the claimed invention involves an inventive step having regard also to one or more other documents which were discovered during the supplementary international search and which were not cited in the international search report.

[COMMENT: The supplementary international search report should not merely duplicate citations which appeared in the international search report; the International Search and Preliminary Examination Guidelines would it make clear that this extends to “equivalent” patent publications, unless there is found to be a material difference between the family members. Furthermore it is not desirable for the Authority concerned to take a different view to the International Searching Authority in a report which is part of the international search process. Further assessment of the prior art already cited is the responsibility of the International Preliminary Examining Authority.]

45bis.6 Supplementary Written Opinion

(a) If the supplementary international search report contains the citations of one or more documents considered to be relevant prior art under Rule 64, the Authority carrying out the supplementary international search shall, at the same time as it establishes the supplementary international search report, establish a supplementary written opinion as to whether, in the light of the prior art disclosed in those documents, the claimed invention appears to be novel and involve an inventive step.

[COMMENT: There seems little purpose in establishing a supplementary written opinion if no new citations are found. The Form covering the transmittal of the supplementary international search report would indicate whether or not a supplementary written opinion had been established.]

[Rule 45bis.6, continued]

(b) For the purposes of establishing the supplementary written opinion, [Articles 33(2) to (5), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.6 to 70.10, 70.14 and 70.15(a)] shall apply *mutatis mutandis*.

[COMMENT: The Articles and Rules listed within the square brackets are a subset of those referred to in Rule 43*bis*, dealing with the questions of novelty, inventive step, how to report on claims which are not searched and examined, and format and language of report. The list of provisions which should apply *mutatis mutandis* would, of course, need to be carefully reviewed depending on the requirements of any system of supplementary international search which was adopted.]

45bis.7 Transmittal and Effect of the Supplementary International Search Report, Written Opinion, etc.

(a) The Authority carrying out the supplementary international search shall, on the same day, transmit one copy of the supplementary international search report under Rule 45bis.5(a), and any supplementary written opinion under Rule 45bis.6, or of the declaration under Rule 45bis.4(c) that the Authority carrying out the supplementary international search considers that a situation referred to under Article 17(2)(a) exists, to the International Bureau and one copy to the applicant.

[COMMENT: Modeled in part on Rule 44.1.]

[Rule 45bis.7, continued]

(b) Except where the context indicates otherwise, the supplementary international search report and any supplementary written opinion shall be treated in the same way as the international search report and the written opinion established by the International Searching Authority respectively, and the same rules shall apply.

[COMMENT: The supplementary international search reports and supplementary written opinions are forwarded to the International Preliminary Examining Authority for use together with the primary international search report and written opinion of the International Searching Authority. Alternatively, if no demand is filed, the supplementary written opinions are incorporated into the international preliminary report on patentability (Chapter I of the PCT) when this is established by the International Bureau under Rule 44bis.]

(c) The establishment of a supplementary international search report shall not, subject to Rule 54bis.1(a)(ii), affect the date on which the international search report is considered to have been established or transmitted to the applicant, in particular for the purpose of time limits.

[COMMENT: While it seems appropriate to extend the period for filing a demand until after all supplementary international search reports and written opinions have been established, this is not the same as the establishment of the primary international search report and written opinion and does not appear to justify extending the time limit until three months after the last of the supplementary reports and opinions have been transmitted – see Rule 54bis.1.]

[Rule 45bis, continued]

45bis.8 International Searching Authorities Competent for Supplementary International Search

Each International Searching Authority which is prepared to carry out supplementary international searches shall notify the International Bureau accordingly. Any such notification may set out limitations on the applications or subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: Authorities may limit the availability of such supplementary international searches to particular fields of technology, for example to exclude fields for which an Authority may not have sufficient capacity at the time, or where an Authority wished to specialize in fields of technology in which it has a particular expertise. The notification could be amended at a later stage to introduce or remove such limitations as necessary.]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (iv) [No change]

(v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a) and any supplementary international search reports; the publication of the international search report in the pamphlet shall, however, not be required to include the part of the international search report or the part of any supplementary international search reports which contains only matter referred to in Rule 43 already appearing on the front page of the pamphlet,

(vi) to (x) [No change]

(b) to (f) [No change]

[Rule 48.2, continued]

(g) If, at the time of the completion of the technical preparations for international publication, the international search report [or any supplementary 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)(c)(i)), the pamphlet shall contain, in place of the international search report [or the supplementary international search report concerned](#), 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 [or the supplementary international search report](#) (when it becomes available) will be separately published.

[COMMENT: the Administrative Instructions would make clear that a late international search report should be published as soon as it becomes available, but that where several supplementary international search reports are not available at the time of completion of technical preparations for international publication, these should all be published together once all are available.]

(h) to (i) [No change]

48.3 to 48.6 [No change]

[COMMENT: Current Rule 48.4 provides for a special publication fee where the applicant requests publication under Articles 21(2)(b) and 64(3)(c)(i) and the international search report or declaration referred to in Article 17(2)(a) is not yet available. Since the supplementary international search reports will frequently not be available in time for international publication, the additional component of the international filing fee (see paragraph 9(c) of the Introduction to this document) will take into account the cost of separate publication and consequently there is no need to also collect the special publication fee only because a supplementary international search report is not available.]

Rule 54bis

Time Limit for Making a Demand

54bis.1 Time Limit for Making a Demand

(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires ~~later~~ the latest:

(i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1, or of the declaration referred to in Article 17(2)(a); ~~or~~

(ii) where a supplementary international search has been requested under Rule 45bis.1(a), one month from the date of transmittal to the applicant of the, or if more than one, the last, such supplementary international search report and supplementary written opinion (if any), established under Rule 45bis.5 and 45bis.6, or of a declaration under Rule 45bis.4(c) that the Authority carrying out the supplementary international search considers that a situation referred to under Article 17(2)(a) exists; or

(iii) 22 months from the priority date.

(b) [No change]

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 [No change]

66.1bis *Written Opinion of the International Searching Authority*

(a) [No change] Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43bis.1 shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a).

(b) An International Preliminary Examining Authority may notify the International Bureau that paragraph (a) [and Rule 45bis.7\(b\)](#) shall not apply to the procedure before it in respect of written opinions established under Rule 43bis.1 and [Rule 45bis.6](#) by the International Searching Authority or Authorities specified in the notification, provided that such a notification shall not apply to cases where the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority. the International Bureau shall promptly publish any such notification in the Gazette.

[COMMENT: Where a supplementary written opinion concerning a new relevant document has been established by an International Searching Authority whose main written opinion would be considered to be the first written opinion of the International Preliminary Examining Authority, it is not necessary for the International Preliminary Examining Authority to establish a further written opinion simply because that document was not included in the main written opinion.]

[Rule 66.1, continued]

(c) and (d) [No change]

66.1ter Updating the Search

The International Preliminary Examining Authority shall endeavor to discover as much of the relevant prior art as its facilities permit which it considers may not yet have been available to the International Searching Authority at the time that the international search report was established. Rule 33 shall apply *mutatis mutandis*.

[COMMENT: New Rule modeled in part on Article 15(4).]

66.2 to 66.9 [No change]

[End of Annex and of document]