

WIPO



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MATTERS CONCERNING THE PCT UNION: REGULATIONS

Proposal by the United States of America

The present document contains comments and further proposals, submitted by the United States of America, in relation to proposals for amendment of the PCT Regulations made in documents PCT/A/XXIV/6 and 7.

**Compilation of Proposals From the United States of America
Concerning PCT Regulations
Documents PCT/A/XXIV/6 and 7**

New language from the US is in **bold underline**, deleted language is **~~bold strikethrough~~**.

Original language from WIPO is in regular text, underlined or stricken through, as presented in the original documents.

***Changes to Document PCT/A/XXIV/6
Annex I***

Rule 12

New paragraph (f):

- (f) **Where a translation of the international application has been furnished, such translation shall be accompanied by a statement that the translation has been reviewed by the applicant and is an accurate translation of the international application as originally filed.**

Rule 19

19.4 Transmittal to the International Bureau as Receiving Office

(a) Where an international application is filed with a national Office which acts as a receiving Office under the Treaty **by an applicant who is a resident or national of a Contracting State**, but [...] {reinsert language proposed to be deleted}

Rule 23

23.1 Procedure

(a) **Where no translation under Rule 12.3(a) is required, the** search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau unless no search fee has been paid. In the latter case, it shall be transmitted promptly after payment of the search fee.

(b) **Where a translation of the international application is furnished under Rule 12.3, a copy of that translation and of the request, which together shall be considered to be the search copy under Article 12(1), shall be transmitted by the receiving Office to the International Searching Authority, unless no search fee has been paid. In the latter case, it shall be transmitted promptly after payment of the search fee.**

Rule 47

47.3 *Languages*

(b) Where the language in which the international application is published is different from the language in which it was filed, the International Bureau shall furnish to any designated Office, upon the request of that Office ~~in relation to a specified international application~~, a copy ~~of that application~~ in the language in which it was filed.

Changes to Document PCT/A/XXIV/6
Annex II

89bis.1 International Applications

(c) The Administrative Instructions shall ~~contain detailed~~ **define the** requirements in relation to the filing and processing of international applications filed, in whole or in part, in electronic form. ~~for example, in relation to the acknowledgment of the receipt of such international applications, the according of an international filing date, the physical requirements for such international applications and the consequences of non-compliance with those requirements, the signature of documents, and the operation of Article 12 in relation to the home copy, the record copy and the search copy, and may contain different requirements for such international applications filed in different languages.~~

[COMMENT: It is envisaged that the Administrative Instructions may initially provide for the electronic filing of only certain elements of the international application (such as the request). Details to be covered would include, for example, the format **and requirements** of the request **when provided** in electronic form ~~and as a computer printout~~, **the acknowledgement of receipt of an application through electronic means, the according of an international filing date to an application received through electronic means or in an electronic format**, provisions for electronic “signature,” **the operation of Article 12 in relation to the home copy, the record copy and the search copy when in an electronic form**, procedures for making changes to the international application, provisions for the mailing and labelling of computer diskettes **or other permanent storage media**, ~~information on how to obtain any authorized electronic filing software~~, etc. These provisions would be supplemented once on-line filing (through the Internet or otherwise) becomes available.]

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

[New paragraph (f)]

(f) Where the applicant has provided or transmitted a document in electronic form but part or all of the electronic form of the document is illegible or the transmission is determined to have not been successful, the document shall be treated as not having been received to the extent that the document is illegible or the transmission was not successful. The national Office or intergovernmental organizations shall promptly notify the applicant of the failure in provision or transmission of the electronic form of the document, if possible.

[COMMENT: Proposed Rule 89bis.1(f) would provide for those instances where the electronic submission was garbled, could not be opened, or was not successfully received. The rule parallels existing Rule 92.4(c) which governs documents received by telegraph, facsimile, teleprinter or the like.]

Rule 93

93.4 Reproductions

[Change only to comment]

*[COMMENT : Rule 93.4 permits records, copies and files to be kept as reproductions rather than in their original form (which presently is always on paper). The present limitation in Rule 93.4 to photographic reproductions, which could be on paper or in another form such as microfilm, has become out of date in the light of technological advances which have facilitated the storage of records and files on computer **readable media** disks, **such as** optical **or magnetic** disks or in microform. In addition, Rule 93.4 should take into account proposed new Rule 89bis which would provide for the possibility of filing international applications in electronic form. It is therefore proposed that Rule 93.4 be amended to add provisions allowing for storage as electronic or other reproductions.]*

Changes to Document PCT/A/XXIV/6
Annex III

Rule 44.10 *Priority Claim*

(a) ~~The~~ Any declaration referred to in Article 8(1) (“priority claim”) shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(iii) where the earlier application is a national application **and not a regional application**, the country party to the Paris Convention for the Protection of Industrial Property in which it was filed;

Rule 26bis26bis.1 *Correction or Addition of Priority Claim*

(d) Priority claims more than one year from the international filing date are not considered for purposes of Rule 26bis.1.

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

(b) If, in response to an invitation under paragraph (a), the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim so as to comply with the requirements of Rule 4.10, **that priority claims which do not fall within the period of one year preceding the international filing date and priority claims based upon national applications filed in countries not party to the Paris Convention for the Protection of Industrial Property** shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly. **All other priority claims objected to under paragraph (a) which are not corrected within the time limit will remain as indicated by the applicant.**

Changes to Document PCT/A/XXIV/6
Annex IV

13bis.4 References: Time ~~of~~ Limit for Furnishing Indications

(d) The International Bureau shall notify the applicant of the date on which it received any indication furnished under paragraph (a), and

(i) if the indication ~~was~~ **is** received before the technical preparations for international publication have been completed, **the pamphlet published under Rule 48 shall indicate that the date on which the indications were received and the indications made, and include the essence of any such indication, in the pamphlet published under Rule 48;**

(ii) if the indication ~~was~~ **is** received after the technical preparations for international publication have been completed, **the International Bureau shall notify the designated Offices of the that date on which the indications were received and the indications made and the essence of any such indication to the designated Offices.**

Rule 48

48.2 Contents

(a) The pamphlet shall contain:

(viii) ~~the essence of~~ any indications in relation to a deposited ~~microorganism~~ biological material furnished under Rule 13bis separately from the description, together with an indication of the date on which the International Bureau received such indications.

Changes to Document PCT/A/XXIV/7
Annex I

Rule 5

5.2 Nucleotide and/or Amino Acid Sequence Disclosure

(a) Where the international application contains disclosure of a nucleotide and/or amino acid sequence, the description shall contain a listing of the sequence complying with the standard ~~prescribed by~~ provided for in the Administrative Instructions and presented as a separate part of the description (“sequence listing part”) in accordance with that standard; ~~provided that no such listing is required of any sequence referred to in the description as forming part of the prior art.~~

(b) Where the sequence listing part of the description contains any free text matter which is not presented using the language-neutral vocabulary as defined in the standard provided for in the Administrative Instructions, that free text matter shall also appear in the main part of the description in the language thereof.

Rule 1212.1 ~~Admitted~~ Languages Accepted for the Filing of International Applications

(d) Notwithstanding paragraph (a), any text matter contained in the sequence listing part of the description shall preferably be presented using the language-neutral vocabulary as defined in the standard provided for in the Administrative Instructions. Any such text matter which is not so presented shall preferably be in English. ~~Paragraph (c) shall apply only where the International Searching Authority has declared, in a notification addressed to the International Bureau, that it accepts to search international applications on the basis of the translation referred to in paragraph (c).~~

[COMMENT: It is understood that the use of a language-neutral vocabulary in relation to certain elements of a sequence listing, in combination with freedom to elaborate, as needed, other descriptive information concerning a sequence listing (“free text”) will permit the complete description of a sequence listing. The standard to be annexed to the Administrative Instructions would contain a definition of the term “language-neutral vocabulary” (scientific terms as prescribed by the leading sequence data banks: “DDBJ/EMBL/GenBank Feature Table” (DNA sequences) and “SWISS PROT Feature Table” (protein sequences)). Any “free text” appearing in the sequence listing part of the description (preferably in English) would have to be repeated in the main part of the description in the language thereof (see Rule 5.2(b)).]

Rule 13ter**13ter.1 Sequence Listing for International Authorities**

(b) Any sequence listing, which, pursuant to paragraph (f), does not form part of the international application, furnished under paragraph (a) shall be accompanied by a statement to the effect that the listing does not include matter which goes beyond the disclosure in the international application as filed. Where no such statement is furnished, the International Searching Authority shall invite the applicant to furnish it within a time limit which shall be reasonable under the circumstances. If the applicant fails to furnish the required statement accordingly, the sequence listing shall be considered not to have been furnished.

Rule 49**49.5 Contents of and Physical Requirements for the Translation**

(a-bis) No designated Office shall require the applicant to furnish it with a translation of any text matter contained in the sequence listing part of the description where such sequence listing part complies with which is presented using the language neutral vocabulary as defined in the standard provided for in the Administrative Instructions as referred to in Rule 12.1(d) or, if the description complies with Rule 5.2(b), of any text matter contained in that part which is not so presented.

Changes to Document PCT/A/XXIV/7
Annex II

Rule 86

86.7 Translation and Making Accessible of Abstracts

In addition to its publication in the pamphlet under Rule 48, the abstract of each international application shall be made accessible in English and French ~~to anyone on the Internet, on CD-ROM or~~ by ~~other~~ electronic ways and means specified in the Administrative Instructions. The necessary translations shall be ensured in English and French. The International Bureau shall also ensure that the making accessible by electronic ways and means shall be effected on the same date, or promptly after the date, on which the pamphlet containing the international application is or was published.

Document PCT/A/XXIV/7
Annex III

Rule 5353.7 *Election of States*

(a) **If the demand can reasonably be construed** ~~The demand shall be considered to~~ contain an indication that all designated States, including any State whose designation is confirmed under Rule 4.9(c), whether before or after the demand is made, and which are bound by Chapter II of the Treaty (“eligible States”) are elected, **then the demand shall be considered to elect all eligible States**, except for any State expressly not elected. ~~The demand shall indicate at least one Contracting State, from among those States which are designated and are bound by Chapter II of the Treaty (“eligible States”), as an elected State.~~

Rule 5454.2 *Right to Make a Demand* ~~Two or More Applicants~~

~~If there are two or more applicants, the~~ The right to make a demand under Article 31(2)(~~a~~) shall exist if the applicant making the demand or, if there are two or more applicants, at least one of ~~the applicants making the demand~~ them is (i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II. ~~, or (ii) a person entitled to make a demand under Article 31(2)(b) and the international application has been filed as provided in the decision of the Assembly.~~

Rule 9494.1 ~~Obligation to Furnish~~ *Access to the File Held by the International Bureau*

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file, except those documents that are confidential under Article 38 other than any document referred to in Rule 94.2.

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