

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

First Session (1st Extraordinary)
Geneva, April 10 to 14, 1978

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly of the International Patent Cooperation (PCT) Union (hereinafter referred to as "the Assembly") held its first (extraordinary) session in Geneva from April 10 to 14, 1978.
2. Up to the date of the opening of the session, 18 States (hereinafter referred to as "member States") had deposited their instruments of ratification of, or accession to, the PCT with the Director General of WIPO. The following 12 member States were represented at the session: Brazil, Cameroon, France, Germany (Federal Republic of), Luxembourg, Madagascar, Senegal, Soviet Union, Sweden, Switzerland, United Kingdom and United States of America. The following six member States were not represented at the session: Central African Empire, Chad, Congo, Gabon, Malawi and Togo.
3. Pursuant to the decision referred to in paragraph 33 below, the following 12 States participated in the session as special observers: Australia, Austria, Canada, Denmark, Finland, Hungary, Ireland, Japan, Netherlands, Norway, Romania and Spain, whereas the following five States were represented by observers: Algeria, German Democratic Republic, Italy, Portugal, and Uruguay.
4. Pursuant to the said decision, two intergovernmental organizations, the European Patent Organisation and the African Intellectual Property Organization (OAPI), participated as

special observers and one such organization, the Interim Committee of the Community Patent, as observer.

5. Pursuant to the said decision, the following ten non-governmental organizations were represented by observers: Committee of National Institutes of Patent Agents (CNIPA), Council of European Industrial Federations (CEIF), European Federation of Industrial Property Representatives of Industry (FEMIP), Inter-American Association of Industrial Property (ASIPI), International Association for the Protection of Industrial Property (AIPPI), International Federation of Inventors Associations (IFIA), International Federation of Patent Agents (FICPI), Pacific Industrial Property Association (PIPA), Union of European Patent Attorneys and Other Representatives Before the European Patent Office (UNEPA) and Union of Industries of the European Community (UNICE).

6. The number of participants was about 90. The list of participants is contained in Annex I to this Report.

OPENING OF THE SESSION

7. The session was opened by the Director General of WIPO, Dr. Arpad Bogensch, who also presided during the adoption of the agenda and the Rules of Procedure and the election of officers. In welcoming the participants, the Director General underlined the great significance of the first session of the Assembly in the history of the Patent Cooperation Treaty. He extended a special welcome to the Guests of Honor (Mr. J. Bob van Benthem, Professor George H. C. Bodenhausen, Mr. Denis Ekani, Dr. Kurt Haertel, Dr. Albrecht Krieger, Professor François Savignon and Mr. William E. Schuyler, Jr) who had accepted his invitation to be present at the session, extended to them in recognition of their outstanding contributions in connection with the establishment and bringing into force of the PCT. The opening address by the Director General appears as Annex II to this Report.

8. The Delegation of the Federal Republic of Germany (Guest of Honor, Dr. Albrecht Krieger) expressed, in the name of its Government, satisfaction at the entry into force of the PCT and the convening of the first session of the Assembly. The Delegation, recalling that its country was the second State to meet, with its ratification, the conditions for entry into force of the PCT contained in Article 63(1) of the Treaty, expressed its hope and concern that further States would become party to the Treaty at an early date and thus make it applicable on a truly world-wide scale. The Delegation expressed its appreciation of the excellent preparatory work bringing about the establishment and entry into force of the PCT and its gratitude and congratulations to all those in WIPO and in the participating countries who had helped to make this project a success. In this context he paid particular tribute to the outstanding contribution of Director General Dr. Arpad Bogensch, the spiritual father of this Treaty. He also referred to the essential role of the efficient staff of WIPO, mentioning specially the excellent work of Deputy Director General Dr. Klaus Pfanner. The Delegation hoped, furthermore, that the Treaty would meet the aims expressed in the original recommendation of the Executive Committee of the Paris Union in 1966, of making more economic, quicker and more effective the protection of inventions throughout the world for the benefit of inventors, the general public and Governments, and make a substantial contribution to the development of technological progress. The Delegation, also recalling the priority which its country gave to participation in international political and economic cooperation, underlined the importance of the PCT, particularly the possibilities offered under

it for international and international-type search and international preliminary examination for the developing countries as well as the possibilities provided under Chapter IV for facilitating acquisition by them of technology. The Delegation also underlined the importance it attached to the coordination of the systems provided under the PCT and under the European Patent Convention, particularly bearing in mind that the European Patent Office would be more closely integrated into the system of the PCT in the performance of its functions as an International Searching and International Preliminary Examining Authority.

9. The Delegation of the United States of America (Guest of Honor, William E. Schuyler, Jr.) paid a tribute to the role played in the establishment of the PCT from its inception by Dr. Arpad Bogsch, now Director General of WIPO. Recalling that the signing of the PCT in Washington in 1970 had been a major step since it had involved the reaching of agreement in an extremely complex situation, the first session of the Assembly marked a second major step, since such a session was the consequence of several nations having adopted the PCT. The session signified the launching of what it was hoped would be a long and successful venture. The auspices for such success were present in the fact that the PCT would play its role within the framework of the Paris Convention--perhaps the longest and most successful multinational Treaty. The third major step, the acceptance of the new system by the users who would make it work, was still to be achieved and was not wholly within the control of the States represented at the Assembly. But what was in the power of those States was that the terms on which the PCT may be used by applicants are reasonable. Furthermore, adequate publicity should be given to all aspects of the PCT, including the fact that it would operate in coordination with the European Patent system, as had already been noted by the Delegation of the Federal Republic of Germany, and that it was the first Convention in the field of intellectual property to have included in it preferential provisions for the benefit of developing countries. It was clearly predictable that the PCT would be one of the most important factors in favor of the developing countries in the transfer and receipt of technology as well as in the development of their capacity to generate their own technology. Once a full appreciation of the facilities offered by the PCT was attained, it was to be expected that through it there would be an increase in the membership of developing countries in both the Paris Convention and the PCT.

10. The Delegation of Switzerland extended its congratulations on the occasion of a historic first session of the PCT Assembly, in particular to the Director General, both for his outstanding personal contribution in bringing about this important new Treaty, and in his capacity as the Head of an Organization which, with its excellent staff, had shown a high degree of efficiency in preparing the Treaty and enabling its rapid implementation after its entry into force. The Delegation recalled that the importance its country attached to the PCT had been demonstrated by Switzerland being one of the first countries to ratify. There was little need to highlight the advantages of the PCT for inventors in the member States and for the member States themselves, particularly such States which were developing countries, since the benefits to be gained from a system in which formalities examination, search and substantive examination would only be required once spoke for themselves. The information services will be of substantial benefit to the developing countries and the Delegation therefore hoped that the PCT would have all the success which it deserved and that all those participating in and using the system will obtain the advantages it was devised to offer.

11. The Representative of the European Patent Organisation, noting the special observer status provided for that Organisation in the Assembly, and speaking both in his capacity as President of the European Patent Office and as a Guest of Honor, conveyed his

congratulations to the member countries and to the Director General and staff of WIPO on the occasion of the holding of the first session of the Assembly and the entry into force of the PCT. The Representative expressed the strong desire of his Office for close cooperation with the International Bureau both in view of the role which the European Patent Office was expected to play in the framework of the PCT and also because the activities of both Organizations under the PCT and the European Patent Convention, following upon careful nurturing by national delegations, would be taken up on precisely the same day. Noting that, on both sides, the staff had made strenuous preparations for their tasks, the Representative pointed out that the systems for which the two Organizations would be responsible were in no way obligatory for the applicants and that it would be necessary for both systems to demonstrate their value in comparison with what had existed previously. In this, fortunately, they were not competing against each other since the two systems were complementary, the PCT providing a world-wide filing basis and the European patent system thereafter enabling the granting, on a common basis, of patents for countries in its regional group.

12. The Delegation of Austria recalled its participation in the setting up of the PCT, a Treaty which, in its view, constituted an important factor in the protection of inventions and the encouragement of innovations on a world-wide basis. It paid tribute to the outstanding role played by the Guests of Honor, but in particular by the Director General whose great personal merits in connection with this Treaty were well-known. It also referred to the excellent work and untiring efforts of the staff of WIPO, mentioning in this context in particular the Deputy Director General responsible for the implementation of the PCT, Dr. Pfanner, and his immediate collaborators. The Delegation also noted that the amendment of its national patent law in 1973 enabled the Austrian Patent Office to carry out isolated patent searches and render assistance to developing countries in accordance with an agreement concluded with WIPO, and that this possibility had been enlarged by a recent amendment of that law which now provided for the carrying out of isolated preliminary examination for the grant of patents as well. The Delegation said that the Austrian Patent Office intended to continue those services in its capacity as an International Searching and International Preliminary Examining Authority after the entry into force for Austria of the Treaty. It therefore wished that the Austrian Patent Office should be appointed in those capacities at the present session, on condition that Austria ratifies the PCT, an event which was expected in the very near future, so that the Austrian Patent Office would be able to start these activities immediately after the PCT becomes applicable to it. The Delegation of Austria stressed furthermore the readiness of the Austrian Patent Office, in the case of its appointment as International Searching and Preliminary Examining Authority by the Assembly, to act as such under the PCT in favor of developing countries. The Austrian Patent Office was in the position to use in this context English, French and German as working languages. The Austrian Patent Office was ready not only to conclude appropriate agreements with all interested developing countries for that purpose, but also to continue its activities in the framework of the WIPO Technical Assistance Program in favor of all developing countries.

13. The Delegation of Sweden noted that gratitude was due to the United States of America for its initial launching in 1966 of the idea of the PCT which proved itself to be a valid basis for the historic step towards the further international cooperation manifested by the first session of the PCT Assembly. The Delegation's gratitude and warm congratulations also went to the Director General whose great skill and untiring efforts had resulted in the present Treaty and the new-born Union. The importance of the contributions of many Delegations could not be over-emphasized. Without the cooperative spirit of all participating countries, the PCT would never have been brought into existence. Emphasizing that the Swedish

Government had, from the very beginning, favored a world-wide patent cooperation treaty, the Delegation noted that, furthermore, the PCT was regarded as an important link between countries of different social and economic systems as well as between industrialized and developing countries. The Delegation of Sweden underlined the necessity to serve patent applicants in the Nordic countries who otherwise would not enjoy their own facilities with regard to language and traditions with a PCT Authority. The Swedish Government also saw an important role for the Swedish Patent Office in connection with assistance to developing countries. It was convinced that the PCT would provide a powerful instrument to the developing countries to improve their patent documentation standards and, in this regard, it was important to recognize that the PCT did not take away part of the sovereignty of countries served by a PCT Authority. On the contrary, a developing country would be placed in a position to form, even with minimum resources of its own, its own judgment as to whether or not a patent should be granted. This would be an important step towards developing a patent system in the developing countries which could serve their particular needs. The Swedish Patent Office, as a prospective International Authority under the PCT, was ready to render its services and to receive and process international applications in the four Nordic languages as well as in English, and, eventually, in the light of applicants' preferences and forthcoming cooperation with the developing countries also in French, German and Spanish.

14. The Delegation of the Soviet Union drew attention to the enormous and useful work carried out during the preparatory period of the PCT both in national Offices and by the staff of the International Bureau. The State Committee for Inventions and Discoveries of the USSR Council of Ministers had always tried to make a useful contribution to the preparatory work. The Delegation agreed with what had been said by previous Delegations on the merits of all who had participated in it. Figuratively speaking, the preparatory work had been towards the creation of the "launching ground" and a preparation for the "launch" itself. The first session of the Assembly should give the green light for the start or, at least, determine its date. It should not be expected that the way would be smooth and easy, especially at the beginning. In particular, there were problems of languages in the PCT procedure, as had been already mentioned. Although there would be these, and probably also other, problems, they could be solved with a real spirit of cooperation and a constructive approach which had characterized the work of all the preparatory bodies of the PCT. The Delegation hoped that this first complicated stage of the course would be completed successfully and pledged, for its part, a full contribution to the solution of problems.

15. The Delegation of the United Kingdom associated itself with the warm expression of gratitude by the Delegations which had already spoken, for the work of the Director General and his staff in bringing events to the point highlighted by the first session of the Assembly, the importance of which its Government fully appreciated. The PCT had real and practical importance to research-based industry as well as a substantial political significance. The present session of the Assembly would, in a sense, put the finishing touches to the preparatory work carried out following the Washington Conference which has set a splendid example of international cooperation. The Delegation hoped that the PCT would afford the expected advantages to industries and inventors throughout the world, including the developing countries, and wished it great success to this end.

16. The Delegation of Luxembourg recalled that its country, although not large, had been one of the first to ratify the PCT. Although the Delegation foresaw many problems in the months ahead, they could undoubtedly be solved with the adoption of a practical approach. In this

regard, the Delegation had always had a high regard for the efficiency of the International Bureau and, moreover, had appreciated the cooperation which it had received.

17. Noting that its country's instrument of ratification of the PCT had not yet been deposited, but nevertheless could be expected to be deposited in a short time, the Delegation of Japan expressed its strong desire to be regarded by the Assembly, to the extent possible, as if it were a member State, since, on March 31, 1978, the Bill for the ratification of the PCT had been approved by the Japanese Diet and, moreover, the Bill for the national legislation implementing the PCT and enabling the Japanese Patent Office to act as an International Searching and Preliminary Examining Authority, had been approved by the Japanese House of Representatives on April 7, 1978. The instrument of ratification would be deposited by the Government of Japan as soon as possible after the Bill had been passed by the other House of the Japanese Diet. The Delegation declared that the services of the Japanese Patent Office as an International Searching and Preliminary Examining Authority were offered, subject to it being appointed by the Assembly as such an Authority, to all nationals and residents of the countries of Asia that would be party to the PCT, on the same conditions as these services would be available to its own nationals.

18. The Delegation of France, after expressing its great satisfaction with the progress shown by the first session of the Assembly, an event which it considered to be outstanding in the long history of industrial property, said that it was able, through the Head of the Delegation, who was also the Chairman of the Administrative Council of the European Patent Organisation, to assure the Assembly of the close cooperation of that Organisation within the framework of the PCT. Great credit was due to both the Director General and his predecessor, Guest of Honor, Professor Bodenhausen. Activities under the PCT and the European Patent Convention would be complemented and reinforced by the simultaneous entry into force of the two Conventions. Moreover, the newly established European Patent Organisation would be greatly helped in broadening more rapidly its relations with the developing countries by the possibility that would be open to it within the framework of the PCT.

19. The Delegation of Italy said that it wished to be associated with the well merited praise that had been directed to the founding fathers of the PCT who had produced a historic document. Its country had signed the Treaty at the time and considered it with great attachment. The procedure for ratification by Italy was developing quickly, the Italian Senate having already approved the Bill for the ratification of the PCT as well as the corresponding Bills for other industrial property conventions. The ratification of the PCT by its Government was expected within a short period. The full support of its competent authorities in the implementation of the PCT in Italy was assured once the ratification of the PCT by Italy has been achieved.

20. The Delegation of Finland expressed gratitude to the Director General, Dr. Arpad Bogsch, and Deputy Director General, Dr. Klaus Pfanner, under whose guidance the International Bureau was carrying out activities concerning the PCT, in which the Delegation was closely interested. The Delegation was able to inform the Assembly that preparations for ratification of the PCT by its country were sufficiently advanced to enable this to take place in the first half of 1979.

21. The Delegation of the Netherlands expressed its desire to join the other Delegations in paying tribute to the International Bureau in paving the way for the first session of the

Assembly. In particular, the Delegation wished to mention the eminent role played by the Director General and the work which had been carried out through the Interim Committees over a period of eight years. The Director General had actively participated in that work on many occasions throughout that time, along with Deputy Director General Dr. Klaus Pfanner. Recently, Deputy Director General Dr. Felix Sviridov had participated as well. The Delegation had been impressed both by the fact that the results achieved in Committee work had always been based on thinking which had been originated in the staff of the International Bureau and by the enormous amount of work which had been done. The long period of parallel elaboration of both the PCT and the European Patent Organisation procedures had been characterized by cooperation and the avoidance of duplication of work. It also informed the Assembly that the ratification of the PCT by its country was expected to take place before the end of the year. The time required was normal having regard to its national parliamentary procedures and should not be regarded as showing in any way a lack of interest in the PCT.

22. The Delegation of Norway said that its country had always taken a positive attitude to the PCT and that the preparations for the ratification of the Treaty were in their final phase. A proposal containing the draft of the necessary national legislation, together with a recommendation to ratify the PCT, was expected to be put before its Parliament in the near future. The Delegation expected that Norway would be a member of the PCT in 1979. The Delegation congratulated the Director General and his staff for the excellent results they had achieved. It was convinced that the PCT would be of great mutual benefit to all its Contracting States and expressed the wish that the Treaty be ratified by all member States of the Paris Convention for the Protection of Industrial Property.

23. The Representative of AIPPI said that his Organization was extremely grateful to WIPO, and especially to its Director General, Dr. Arpad Bogsch, for the spirit of cooperation which had always enabled the views of the interested circles to be heard and taken into account on questions concerning the implementation of the PCT. This had been particularly important since the success of the PCT procedure depended on industries making use of the possibilities it provided to them. The Representative also paid tribute to the former Comptroller-General of the United Kingdom Patent Office, Mr. Edward Armitage, who was unfortunately unable to be present at the session but who deserved to be specially commended for his merits in connection with the preparation of the Treaty. In view of the long tradition of his Organization in the field of industrial property, the Representative felt confident that he was speaking on behalf of all of the private circles in wishing every success in the future operations of the PCT.

24. Supporting the interventions of other Delegations, the Delegation of Spain said that it highly appreciated the role played by the Director General of WIPO, Deputy Director General Dr. Klaus Pfanner and by the staff of the International Bureau as well as by the Guests of Honor of the Assembly, and thanked them for their incalculable contribution to the elaboration of the PCT procedure and for the numerous documents prepared by the International Bureau to ensure the coming into force of the PCT. Stressing the advantages and facilities offered by the PCT procedure, the Delegation, nevertheless, pointed out that certain changes of its national patent legislation were necessary to adapt this legislation to the PCT and other international treaties before its country would be able to become a party to the Treaty.

25. The Delegation of Brazil said that its country considered the PCT to represent a landmark in the field of the protection of industrial property and was firmly convinced that the PCT

would bring about favorably balanced advantages for all Contracting States. Moreover, Brazil hoped that the PCT would increase the cooperation it enjoyed with developed countries and would help Brazilian inventors to participate in the development of technology. It considered the PCT to be one of the most important advances for Patent Offices all over the world. Recalling Brazil's ratification of the Paris Convention in 1884 and that of the PCT in early 1978, the Delegation expressed the wish that WIPO would continue to play its role of a large forum where all problems of industrial and intellectual property could be treated, adding its best wishes to the Director General for the success of the PCT.

26. The Delegation of Hungary noted that its country had participated in the PCT project from the very beginning, and was among the countries that had signed the Treaty in 1970 in Washington. It had always been convinced of the future effectiveness of the PCT in the field of protection of industrial property. After the coming into force of the PCT and its functioning, its Government would be in a more favorable position than before to form its attitude on the question of ratification so that it was to be hoped that in the near future, and not later than next year, its Government would take a positive position on that question. In the meantime, the Delegation of Hungary would be actively and willingly contributing to the practical implementation of the aims set out in the PCT.

27. The Delegation of Algeria said that it wished the PCT every success and that its country would participate in PCT activities as before. Algeria was also among those countries that had signed the PCT in 1970 in Washington and the possibility of ratification of the PCT was now under the close consideration of its Government. The patent information and technical assistance services foreseen under Chapter IV of the Treaty were considered a particular advantage to developing countries.

28. The Delegation of Portugal expressed its desire to be fully associated with the congratulatory expressions of the other Delegations.

ADOPTION OF THE RULES OF PROCEDURE OF THE ASSEMBLY

29. The Assembly adopted, as its Rules of Procedure, the draft Rules of Procedure contained in Annex I of document PCT/A/I/2. The Rules of Procedure adopted by the Assembly are contained in Annex III to this Report.

ELECTION OF OFFICERS

30. The Assembly unanimously elected Mr. D. Ekani (Cameroon) as Chairman and Mr. P. Braendli (Switzerland) and Mr. L. Komarov (Soviet Union) as Vice-Chairmen

31. Mr. E. M. Haddrick, Head, PCT Division, WIPO, acted as Secretary of the Assembly.

ADOPTION OF THE AGENDA

32. The Assembly adopted as its agenda the draft agenda contained in document PCT/A/I/1.Rev., subject to the deletion, upon the proposal of the Director General of item 9

and to bringing forward item 13 on the copyright protection of PCT publications as item 6 and renumbering the other items accordingly.

ADMISSION OF SPECIAL OBSERVERS AND OBSERVERS

33. The Assembly decided to admit to its sessions, as special observers or observers, the States and organizations appearing in Annex II of document PCT/A/I/2. The said States and organizations are set out in Annex IV to this Report.

QUESTIONS RELATED TO COPYRIGHT PROTECTION OF PCT PUBLICATIONS

34. Discussions were based on paragraphs 21 to 26 of document PCT/A/I/2 and Annex XIV thereto.

35. The Delegation of France, speaking also in the name of the Administrative Council of the European Patent Organisation, said that the claim of the International Bureau of WIPO to receive royalties on the basis of a copyright held by it in certain PCT publications would introduce a notion of copyright hitherto unknown. That notion was incompatible with the basic principles of patent law requiring the disclosure of inventions contained in patent applications in order that they may become part of the state of the art, and free access, uninhibited by any copyright, to patent documents publishing such inventions. Moreover, the Delegation of France, speaking in the name of its country only, was of the opinion that the international conventions on copyright did not provide for a copyright for the International Bureau in such official publications, since protection under the said conventions was available only where works were protected under national law. In France, as in most countries, official publications were not the subject of copyright.

36. The Delegations of the United States of America, Norway, Portugal, Germany (Federal Republic of) and Brazil supported the statement made by the Delegation of France whereas the Delegations of the United Kingdom and the Netherlands supported the general tenor of that statement.

37. The Director General said that he could not accept the view that Protocol 2 of the Universal Copyright Convention did no more than assure protection to works of the kind protected by national laws. If this were the case, there would be no need of the said Protocol since such works would, then, already be protected on the basis of the fact that they were first published in a Contracting State (Switzerland). In any case, and quite independently of copyright considerations, it would be in the interest of the member States if the national Offices supplying copies of international applications for a price would remit to the International Bureau a portion of such price. The income resulting therefrom for the International Bureau would reduce the need for contributions by Governments to the International Bureau. Furthermore, there seemed to be no reason why commercial publishers should have a free ride. Denying or reducing the revenues that were contemplated in the calculations of the PCT Working Group on Budgetary Questions would certainly delay, and possibly delay ad infinitum, the reaching of the break-even point in the PCT budget of WIPO with the consequence that member States would have to continue to cover the yearly deficits.

38. In the ensuing discussion, the Delegations of France, the United Kingdom and the Netherlands said that a different position could possibly be taken in relation to publications other than the PCT pamphlet, containing the published international application. According to certain statements, publications such as the Gazette, the Guides, classified abstracts and the like could be protected. The Delegation of the United Kingdom proposed that, in order to prevent unauthorized commercial copying, copyright protection should be enforced against commercial firms for all kinds of PCT publications, even for the pamphlet. What was essential in the view of this Delegation was to ensure that Patent Offices were, within the framework of their tasks, just as free to copy PCT pamphlets as they were with respect to national patent documents, the said framework of tasks being understood in the extended sense of including information services through the Offices themselves or through associated libraries.

39. The Delegations of Germany (Federal Republic of), the United States of America and the Netherlands pointed to the practical difficulties that would be encountered in administering solutions based on payments to the International Bureau on the basis of fees paid in individual cases by persons wishing to obtain copies. The Delegation of the Netherlands added, however, that it might view favorably a solution involving the payment of lump sum amounts by Offices fixed on the basis of the number of international applications reproduced by each Office. The Delegation of the United States of America stated that it was opposed to any action being taken by the International Bureau, including the affixing of a copyright notice, in order to obtain and enforce copyright protection for the PCT pamphlet.

40. The Delegation of the Federal Republic of Germany, supported by the Delegation of France, noted that in the case of the Gazette certain material such as treaties and legislation would not in any case enjoy copyright protection.

41. In conclusion, the Assembly did not approve the proposals contained in paragraph 25 of document PCT/A/I/2 and it decided that no copyright notice should be placed on pamphlets publishing international applications, or any part thereof as referred to in PCT Rule 48, and that no copyright of the International Bureau, even if existing, should be enforced in respect thereof.

42. The Delegation of the Federal Republic of Germany, supported by the Delegations of the United Kingdom and France, stated that, in its view, the limitation of the decision referred to in the preceding paragraph to pamphlets did not entail a decision on the question of copyright in other PCT publications, including the Gazette. Whether such copyright existed, depended on the contents of the relevant publication and on national law.

43. The Director General said that the International Bureau would, naturally, implement the decisions of the Assembly; he also said that such decisions would probably entail financial consequences for the member States since they would have to cover the deficits.

APPOINTMENT OF INTERNATIONAL SEARCHING AUTHORITIES AND
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES AND APPROVAL OF
THE AGREEMENTS BETWEEN THOSE AUTHORITIES AND THE INTERNATIONAL
BUREAU

44. Discussions were based on documents PCT/A/I/3 to 8, containing initialled texts of draft Agreements between the International Bureau and the prospective International Searching and International Preliminary Examining Authorities and a related proposal by the Government of the Federal Republic of Germany (Annex II of document PCT/A/I/5)

General

45. The Assembly adopted the procedure suggested by the International Bureau for the approval of the draft Agreements submitted to it, their signature by both parties and the appointments of the Authorities under Articles 16(3) and 32(3) of the PCT to be made by the Assembly. In considering the draft Agreements, the Assembly followed the numerical order of the preparatory documents containing the said draft Agreements.

46. When considering the draft Agreements, the Assembly discussed the question of the number of copies of published international applications, of the Gazette and of each other PCT publication of general interest published by the International Bureau to be furnished by it free of charge to International Searching or Preliminary Examining Authorities and to national Offices, in accordance with PCT Rule 87. The Assembly noted in this context with approval a declaration of the Director General according to which the International Bureau would interpret Rule 87 in the sense that an Authority acting as a receiving Office, as an International Searching Authority and as an International Preliminary Examining Authority has the right to obtain a total of 5 free copies of PCT publications and that the United States Patent and Trademark Office, in view of the ongoing active consideration of its becoming an International Preliminary Examining Authority, shall be treated as such for that purpose.

47. The Assembly noted declarations by the Delegations of Sweden, Austria and the United States of America that their Patent Offices, when appointed as International Searching Authority and--in the case of the Patent Offices of Austria and Sweden--as International Preliminary Examining Authority, were ready, subject to the satisfactory conclusion of negotiations, to act in that capacity for Brazil. Furthermore, the Assembly noted the declaration by the Delegations of Austria and Sweden that the Patent Offices of the said countries, once appointed as International Searching and Preliminary Examining Authority, would be ready to act in that capacity for the African Intellectual Property Organization.

Agreement between the Royal Patent and Registration Office of Sweden and the International Bureau in relation to the establishment and functioning of the Royal Patent and Registration Office of Sweden as an International Searching and International Preliminary Examining Authority

48. Discussions were based on document PCT/A/I/3, Annex I.

49. Upon the proposal by the Delegation of Sweden, the Assembly approved the following modifications with respect to Article 3 and Annex A:

(i) Article 3(1)(ii) was amended to read as follows:

“any State indicated in Annex A of this Agreement,”

(ii) in Annex A the following new item 1 was inserted:

“The States specified for the purposes of Article 3(1)(ii) of the Agreement are the States, regarded as a developing country in conformity with the established practice of the General Assembly of the United Nations, with which Sweden, in accordance with its obligations undertaken within the framework of the European Patent Organisation, has concluded an agreement for that purpose”;

(iii) the title of Annex A was amended accordingly.

50. Upon an intervention of the Delegation of Norway, it was agreed that Article 3(1) of the draft Agreement, which specifies that “the Authority undertakes to act as an International Searching Authority for all international applications filed with the receiving Offices of,” should not be interpreted to mean that a given receiving Office could not specify other Authorities if it had this possibility.

51. The draft Agreement, amended as proposed by the Delegation of Sweden, was approved by the Assembly.

52. The Delegation of Finland expressed its satisfaction at the approval of the said draft Agreement. It added that the use of the Finnish language by the Swedish Patent Office acting as an International Searching Authority and as an International Preliminary Examining Authority would facilitate the ratification of the PCT by Finland.

Agreement between the United States Patent and Trademark Office and the International Bureau Concerning the Functions of the United States Patent and Trademark Office in the Capacity of an International Searching Authority

53. Discussions were based on documents PCT/A/I/3, Annex II and PCT/A/I/3 Corr.

54. The Assembly approved the draft Agreement, subject to the deletion of paragraphs (2) and (3) of Article 12 and the replacement of Annex C as indicated in document PCT/A/I/3 Corr.

Agreement between the Patent Office of the United Kingdom and the International Bureau in relation to the functioning of the Patent Office of the United Kingdom as an International Preliminary Examining Authority

55. Discussions were based on document PCT/A/I/4.

56. The Assembly approved the draft Agreement as contained in document PCT/A/I/4.

Agreement between the International Bureau and the European Patent Organisation in relation to the establishment and functioning of the European Patent Office as an International Searching and International Preliminary Examining Authority

57. Discussions were based on document PCT/A/I/5, Annex I.

58. The Assembly approved the draft Agreement, subject to the deletion of Article 16.

59. The Delegation of the Netherlands, referring to discussions which had taken place between the Netherlands Patent Office and the European Patent Office with respect to the use by the European Patent Office of the Dutch language when acting as an International Searching Authority, said that, although the European Patent Office was prepared to carry out searches on international applications filed in Dutch, it declared not to be in a position to take the responsibility of preparing or checking the English translations of such applications prepared in accordance with PCT Rule 48.3(b) for the purpose of international publication.

60. Since the possibility of filing international applications in the Dutch language would be of great importance for nationals and residents of the Netherlands once this country would, later this year, become a Contracting State of the PCT, the Delegation of the Netherlands requested clarification as to the interpretation of PCT Rule 48.3(b). In its opinion, that Rule permitted to contract out the work connected with the translation, or to use translations provided by the applicant (which it was sure that Netherlands applicants would be only too glad to supply), provided that the ultimate responsibility for the translation remained with the International Searching Authority. The Delegation of the Netherlands also expressed the opinion that, as a matter of policy, the European Patent Office and other International Searching Authorities should cover as many languages as their facilities permit and if necessary broaden their language facilities for that purpose.

61. The International Bureau expressed the view that PCT Rule 48.3(b), and in particular the words "The translation shall be prepared under the responsibility of the International Searching Authority" should not be interpreted to mean that the work involved should always be carried out by the International Searching Authority itself. However, the ultimate responsibility for the said translation, particularly with respect to its accuracy, would rest with that Authority. On the other hand, any broadening of the language coverage of the International Searching Authorities would be welcome.

62. The representative of the European Patent Organisation underlined that the language facilities of the European Patent Office would permit the carrying out of searches in the Dutch language but were not sufficient to assume the task of preparing or checking the English translation of International applications filed in Dutch. Consequently the problems raised in connection with the possibility by the EPO acting as an International Searching Authority of international applications filed in Dutch would only be removed if PCT Rule 48.3(b) could be interpreted so as to permit the International Searching Authority to use, for the purposes of that Rule, an English translation prepared by the applicant and to be relieved from the checking of the said translation. Such considerations would also be applicable to other languages and any extension of the language coverage of an International Searching Authority would be greatly facilitated by such an interpretation of PCT Rule 48.3(b).

63. The International Bureau said that PCT Rule 48.3(b) did not allow the International Searching Authority to require the applicant to prepare an English translation of the international application. However, there was nothing in the PCT that would prevent the International Searching Authority or the receiving Office to accept an English translation submitted by the applicant himself. This, then, would be used by the International Searching Authority, but would not relieve it from its responsibility under the said Rule.

64. The Assembly concluded that PCT Rule 48.3(b) should be interpreted as stated by the International Bureau. The question of the use of the Dutch language by the EPO as an International Searching Authority was a matter to be further discussed within the framework of the European Patent Organisation.

Agreement between the Patent Office of Japan and the International Bureau in relation to the establishment and functioning of the Patent Office of Japan as International Searching and International Preliminary Examining Authority

65. Discussions were based on document PCT/A/I/6.

66. The Delegation of Japan confirmed the desire of the Japanese Patent Office to be appointed by the Assembly, at its first session, as an International Searching and International Preliminary Examining Authority despite the fact that Japan had not yet ratified the PCT, this is in order to be able to begin its activity as an International Authority immediately upon entry into force of the Treaty for Japan without having to wait for a decision by the Assembly in a subsequent session. The Delegation again affirmed the declaration made at the opening of the session that the Japanese Patent Office would act as an International Authority not only for nationals and residents of Japan but also for nationals and residents of Asian countries party to the PCT (see paragraph 17 of this Report).

67. The Assembly approved the draft Agreement contained in Annex I to document PCT/A/I/6 and noted the Protocol of Agreement contained in Annex II, line 4 of page 3 of the said Annex being amended, upon a proposal by the Delegation of Japan, to read as follows “Have agreed to record the following.”

Agreement between the Federal Minister for Trade, Commerce and Industry of Austria and the International Bureau in relation to the establishment and functioning of the Austrian Patent Office as an International Searching and International Preliminary Examining Authority

68. Discussions were based on document PCT/A/I/7.

69. The Delegation of Austria expressed the willingness of the Austrian Patent Office to be appointed as an International Searching and International Preliminary Examining Authority, even though Austria had not yet ratified the PCT. Since it was expected that Austria would ratify the PCT during the period between the first and the second session of the Assembly, the Assembly was invited to appoint at its first session the Austrian Patent Office as an International Searching and International Preliminary Examining Authority in order to enable it to begin its activities as such immediately upon entry into force of the Treaty for Austria without having to wait for a decision by the Assembly in a subsequent session. The Delegation also stressed the importance for developing countries of the role to be played by the Austrian Patent Office, particularly within the framework of Chapter IV of the PCT.

70. The Assembly approved the draft Agreement contained in Annex I to document PCT/A/I/7, subject to an amendment to Annex A of the Agreement, as proposed by the Delegation of Austria to the effect that in paragraphs 1 and 3 of the said Annex the following words were added: “with which Austria, in accordance with its obligations undertaken within the framework of the European Patent Organisation, has concluded an Agreement for that

purpose.” The Assembly also noted the Protocol of Agreement contained in Annex II to document PCT/A/I/7.

Agreement between the State Committee for Inventions and Discoveries of the USSR Council of Ministers and the International Bureau in relation to the functioning of the State Committee for Inventions and Discoveries of the USSR Council of Ministers as an International Searching and International Preliminary Examining Authority

71. Discussions were based on document PCT/A/I/8.

72. The Assembly approved the draft Agreement contained in the Annex to the said document, subject to an amendment of Article 11, as proposed by the Delegation of the Soviet Union, to the effect that the words “one of the languages” in the third line of that Article be changed to read “the languages.”

Appointment

73. The Assembly noted that the following Agreements and Protocols of Agreements relating to the establishment and functioning of the offices concerned as an International Searching and/or International Preliminary Examining Authority were signed on April 11, 1978 (listed in the sequence of the preparatory documents submitted to the Assembly):

(i) the Agreement between the Royal Patent and Registration Office of Sweden and the International Bureau;

(ii) the Agreement between the United States Patent and Trademark Office and the International Bureau;

(iii) the Agreement between the Patent Office of the United Kingdom and the International Bureau;

(iv) the Agreement between the International Bureau and the European Patent Organisation;

(v) the Protocol of Agreement between the Patent Office of Japan and the International Bureau;

(vi) the Protocol of Agreement between the Federal Minister for Trade, Commerce and Industry of Austria and the International Bureau;

(vii) the Agreement between the State Committee for Inventions and Discoveries of the USSR Council of Ministers and the International Bureau;

74. The Assembly thereupon made the following appointments:

(i) As International Searching and Preliminary Examining Authorities:

(a) the Patent Office of Austria (as from the date on which the Agreement attached to the Protocol of Agreement referred to above will be signed and Austria will become bound by the PCT);

(b) the Patent Office of Japan (as from the date on which the Agreement attached to the Protocol of Agreement referred to above will be signed and Japan will become bound by the PCT);

(c) the State Committee for Inventions and Discoveries of the USSR Council of Ministers;

(d) the Royal Patent and Registration Office of Sweden (as from May 17, 1978, the date on which Sweden will become bound by the PCT);

(e) the European Patent Office;

(ii) As an International Searching Authority:

(f) the United States Patent and Trademark Office;

(iii) As an International Preliminary Examining Authority:

(g) the Patent Office of the United Kingdom.

Gradual application of International Preliminary Examination as far as the European Patent Office is concerned

75. Discussions were based on document PCT/A/I/5 and, in particular, Annex II thereto.

76. The Delegation of the Federal Republic of Germany introduced its proposal contained in Annex II of document PCT/A/I/5.

77. The Assembly took the following decision:

“The Assembly of the International Patent Cooperation (PCT) Union,

“Considering the Agreement concluded between the International Bureau of the World Intellectual Property Organization and the European Patent Organisation in as far as it concerns international preliminary examination,

“Considering Article 65(l) of the Patent Cooperation Treaty,

“Notes that in respect of international applications for which the European Patent Office would be the only competent International Preliminary Examining Authority, demands for international preliminary examination will be accepted by the European Patent Office as from the dates which result from the application of the provisions of the said Agreement.”

FIXING THE DATE FROM WHICH INTERNATIONAL APPLICATIONS MAY BE
FILED AND THE DATE FROM WHICH DEMANDS FOR INTERNATIONAL
PRELIMINARY EXAMINATION MAY BE SUBMITTED

78. Discussions were based on document PCT/A/I/2.

79. The Assembly fixed June 1, 1978, as the date from which international applications may be filed and demands for international preliminary examination may be submitted.

AMENDMENTS TO THE REGULATIONS UNDER THE PATENT COOPERATION
TREATY (PCT)

80. Discussions were based on documents PCT/A/I/2 (paragraphs 10 to 13 and Annexes III, IV and V thereof), and PCT/A/I/9, prepared by the International Bureau, and on a proposal by the Delegation of Sweden for the amendment of Rule 48.3 as contained in document PCT/A/I/10. Amendments to Rules in the Regulations in which fees are prescribed are dealt with separately in paragraphs 88 to 97 of this Report and the proposal relating to Rule 48.3 in paragraphs 100 and 101 of this Report.

Rule 4.4(c)

81. The Assembly agreed to adopt the amendment to this Rule as proposed by the International Bureau in the light of a communication received from the United States Patent and Trademark Office and as contained in document PCT/A/I/9.

Rules 4.10(d), 11.6(a) and (b), and 11.13(a)

82. The Assembly agreed to adopt the draft amendments to these Rules as set out in Annex III of document PCT/A/I/2.

Rule 32bis: Withdrawal of the Priority Claim

83. The Assembly agreed to adopt a new Rule 32bis relating to the withdrawal of the priority claim as set out in Annex III of document PCT/A/I/2.

Rules 48.2(a)(v) and 48.3(c)

84. The Assembly agreed to adopt the draft amendments to these Rules as set out in Annex III of document PCT/A/I/2.

Rules 58.2, 58.3 and 61.1(b)

85. The Assembly agreed to adopt the draft amendments to these Rules as set out in Annex V of document PCT/A/I/2.

Rule 74bis: Notification of Withdrawal under Rule 32

86. The Assembly agreed to adopt a new Rule relating to notification to the International Preliminary Examining Authority of withdrawals under Rule 32 as set out in Annex III of document PCT/A/I/2.

Rules 86.3 and 86.4

87. The Assembly agreed to adopt the draft amendments to these Rules as set out in Annex III of document PCT/A/I/2.

Amendments relating to fees (Rules 15.2 and 57.2)

88. In accordance with a wish expressed by the PCT Preparatory Committee, the International Bureau drew to the attention of the Assembly paragraphs 11 and 12 of document PCT/A/I/2 dealing with matters concerning the amounts of certain fees and the prices of certain PCT publications, it being understood, in particular, that the decision adopted by the Assembly in relation to the level of fees would be applied by the International Bureau in relation to the prices of certain PCT publications.

89. The Delegation of Switzerland said that it was agreeable to the lower level of fees for an initial period of one year but was firmly opposed to the use of two currencies, since the PCT budget was expressed in Swiss francs and a large proportion of the expenses of the International Bureau would be incurred in that currency. Any weakening of the US dollar would cause a serious deficit in the budget. Moreover, applicants would choose whichever was the weaker of the two currencies. In these circumstances, the Delegation favored the use only of Swiss francs.

90. The Delegation of France said that, in view of the declarations of the Director General in this connection, it supported the Delegation of Switzerland. Lowering the level of fees adopted by the PCT Working Group on Budgetary Questions by 40% would not involve a great risk. Fundamental objections of a legal nature had, however, to be raised against expressing the amounts of the fees in two currencies. While a choice of either of the currencies at present appearing in the Regulations could meet those objections, the reasons given by the Delegation of Switzerland in relation to the currency in which the expenses were incurred made it logical to use Swiss francs.

91. The Delegations of the Netherlands and the United Kingdom supported the views expressed by the Delegations of Switzerland and France.

92. The Delegation of the United States of America underlined the importance to applicants in its country of avoiding administrative complications and uncertainty which would be caused to applicants if they should be confronted with the need to follow exchange rate variations for the purposes of paying filing fees. Possible losses due to expressing the fees in US dollars, even for those who considered that this would occur, would be of minimal significance. At least for an initial period, the system of two currencies, adopted in 1970, should be maintained.

93. The Delegation of the Federal Republic of Germany supported the proposals of the International Bureau, underlining that a main consideration was that the expression of the fees in two currencies was not a new solution and that to use a single currency would involve the change of a decision of principle taken by the Washington Conference in 1970. Moreover, it

was to be understood that the solution adopted would apply for a transitional period of one year.

94. The Delegation of Brazil supported the position taken by the Delegation of the Federal Republic of Germany.

95. On a question raised by the Delegation of the United Kingdom, the Director General said that the applicant would not have a choice between the two currencies since, according to PCT Rule 15.3(b), the receiving Office prescribed the currency of payment and would probably choose its national currency. It was expected that this solution would be adopted by each receiving office in the framework of the system of handling of fees proposed by the International Bureau and to be agreed upon between the receiving Offices and the International Bureau. Naturally, if an Office wanted to allow applicants to pay in a foreign currency, nothing in the PCT prevented it from doing so. According to the said system, the table of fees published by each receiving Office would stipulate the amounts applicants would have to pay. The receiving Offices were free to choose the currency on the basis of which they wanted their equivalent schedule of fees to be established. The receiving Office itself did not incur any risk since its obligation was merely to transfer to the International Bureau whatever amounts it had received and any gains or losses would belong to or be borne by the International Bureau.

96. The Delegation of Switzerland, pointing to the fact that at present the exchange rate between the US dollar and the Swiss franc is at 1.80, said that, while maintaining its main proposal, it could accept as a compromise the adjustment of the amounts indicated in US dollars to this present exchange rate, if the expression of the fee in US dollars was maintained. This proposal was supported by the Delegation of Japan. However, the Delegation of Japan preferred the use only of Swiss francs to make easier the handling of fees by the receiving Office. After further discussions, the proposal of the Delegation of Switzerland was adopted by the Assembly. The Delegation of France maintained, however, its objections of principle against the use of two currencies.

97. The Assembly agreed to adopt the following fees in Rules 15.2 and 57.2:

basic fee:	US\$ 165.00 or 300 Swiss francs
supplement per sheet over 30:	US\$ 3.00 or 6 Swiss francs
designation fee:	US\$ 40.00 or 80 Swiss francs
handling fee:	US\$ 50.00 or 96 Swiss francs

98. It was agreed that the amounts of the fees fixed in the Regulations in US dollars and Swiss francs are to be considered only as a basis on which the amount of the fees in the various national currencies (other than US dollars and Swiss francs) are fixed by the Director General after consultation with the country of each currency. Such agreement is based on an interpretation of Rule 15.3(b) and similar provisions of the Regulations which vest the right of expressing fees in national currencies in the receiving Offices. The said amounts are the rounded up or rounded down equivalents of the amounts indicated in the Regulations. The Director General was asked to propose to the next session of the Assembly a revision of the relevant provisions of the Regulations so that they spell out this interpretation. The Assembly

noted the following amounts of fees fixed in the applicable currencies, it being understood that it was not an obligation in the future to submit similar information to the Assembly with a view to their being noted by it:

Country Currency	PCT FEES			
	Basic	Supplement per sheet over 30 sheets	Designation	Handling
	Rule 15.2(a)(i)	Rule 15.2(a)(ii)	Rule 15.2(b)	Rule 57.2(a)
Brazil Cruzeiros	2900	50	720	900
France French Francs	735	14	180	225
Germany (Federal Republic of) Deutsche Mark	325	6	80	100
Luxembourg Luxembourg Francs	5060	90	1250	1560
Soviet Union Roubles	110	2	30	35
Sweden Swedish Kronor	740	14	185	230
United Kingdom Pounds Sterling	83	1.5	21	25

99. In conclusion, the Assembly amended the Rules referred to in paragraph 81 to paragraph 97 above, as set out in Annex V of this Report.

Proposal for the amendment of Rule 48.3

100. The Delegation of Sweden, introducing its proposal for the amendment of Rule 48.3, as contained in document PCT/A/I/10, stressed the heavy burden, placed on certain International Searching Authorities by the requirements of Rule 48.3(b), of carrying the responsibility for translations into English of applications filed in languages other than the five languages specified in that Rule. This burden could negatively affect the attractiveness of the PCT for applicants not wishing to use one of the languages in more worldwide use. In most cases an English translation will anyhow appear in the national (regional) phase in a few months after the publication and it will only rarely occur that the international application be processed in this phase without a translation into at least one of the languages enumerated in Rule 48.3. As the costs of translation had increased enormously in the past five to ten years, everything should be tried to avoid unnecessary translations. However, taking into consideration the earlier discussions concerning the use of the Dutch language for international applications (see paragraphs 59 to 64 of this Report), it might be worthwhile to await practical experience on the subject before a substantial debate on this subject could be entered into. For this reason, the Delegation withdrew its proposal at this time.

101. The Assembly noted the withdrawal of the said proposal.

ESTABLISHMENT OF THE COMMITTEE FOR TECHNICAL COOPERATION;
APPOINTMENT OF ITS MEMBERS; ADOPTION OF ITS RULES OF PROCEDURE

102. Discussions were based on document PCT/A/I/2.

103. The Assembly adopted the draft decisions concerning the PCT Committee for Technical Cooperation (PCT/CTC) as set out in Annex VI of document PCT/A/I/2. The text of the decisions adopted by the Assembly is contained in Annex VI of this Report.

104. The Assembly also adopted the Rules of Procedure of the PCT Committee for Technical Cooperation (PCT/CTC) as set out in Annex VII of document PCT/A/I/2. The text of the Rules of Procedure adopted by the Assembly is contained in Annex VII of this Report.

ESTABLISHMENT OF THE COMMITTEE FOR TECHNICAL ASSISTANCE;
APPOINTMENT OF ITS MEMBERS; ADOPTION OF ITS RULES OF PROCEDURE

105. Discussions were based on document PCT/A/I/2.

106. The Assembly adopted the draft decisions concerning the PCT Committee for Technical Assistance (PCT/CTA) as set out in Annex VIII of document PCT/A/I/2. The text of the decisions adopted by the Assembly is contained in Annex VIII of this Report.

107. The Assembly also adopted the Rules of Procedure of the PCT Committee for Technical Assistance (PCT/CTA) as set out in Annex IX of document PCT/A/I/2. The text of the Rules of Procedure adopted by the Assembly is contained in Annex IX of this Report.

ESTABLISHMENT OF THE COMMITTEE FOR ADMINISTRATIVE AND LEGAL
MATTERS; ADOPTION OF ITS RULES OF PROCEDURE

108. Discussions were based on document PCT/A/I/2.

109. The Assembly adopted the draft decisions concerning the PCT Committee for Administrative and Legal Matters (PCT/CAL) as set out in Annex X of document PCT/A/I/2. The text of the decisions adopted by the Assembly is contained in Annex X to this Report.

110. The Assembly also adopted the Rules of Procedure of the PCT Committee for Administrative and Legal Matters (PCT/CAL) as set out in Annex XI of document PCT/A/I/2. The text of the Rules of Procedure adopted by the Assembly is contained in Annex XI to this Report.

111. The Delegation of the Netherlands, referring to a need to avoid an overlap between the mandates of PCT/CTC and PCT/CAL, said that, in its understanding of the delimitation of the mandates of the said two Committees, PCT/CTC would, particularly in view of the fact that it would be closely associated with the Permanent Committee on Patent Information, deal only with patent documentation matters in the framework of the PCT even though the provisions of the PCT concerning PCT/CTC would allow for an interpretation giving to it a broader jurisdiction. All matters not purely relating to documentation would be within the mandate of PCT/CAL. With respect to the Guidelines for International Search and the Guidelines for

International Preliminary Examination, this would mean that, while the Guidelines for International Preliminary Examination are exclusively within the mandate of PCT/CAL, the competence was divided between PCT/CTC and PCT/CAL, as far as the Guidelines for International Search were concerned. Those Guidelines would be within the mandate of PCT/CTC as far as matters of documentation were concerned, whereas all other matters in the said Guidelines would be within the competence of PCT/CAL. Such delimitation of the mandate of the two Committees would correspond to the decisions taken last year when establishing the Permanent Committee on Patent Information and would avoid an overlap between the mandates of the two newly established PCT Committees.

112. Upon a statement by the Director General confirming the interpretation given by the Delegation of the Netherlands, the Chairman stated the agreement of the Assembly with that interpretation.

CONSULTATIONS WITH THE RECEIVING OFFICES AND THE INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES RELATING TO THE ADMINISTRATIVE INSTRUCTIONS

113. On the occasion of the present session of the Assembly, consultations were held with the receiving Offices and the International Searching and Preliminary Examining Authorities relating to the Administrative Instructions, as provided in PCT Rule 89.2(a). The results of such consultations, as reflected in the following paragraphs, were noted by the Assembly on the basis of a report by the Director General.

114. Consultations were based on the Administrative Instructions as contained in document PCT/INT/2 and, as far as Annex F of the said document was concerned, on the French version of the forms provided by the International Bureau for the purpose of the consultations. A printed version of the Administrative Instructions, excluding the forms contained in Annex F other than the four “printed” forms, was also made available; this version contained the following changes from the Administrative Instructions as contained in document PCT/INT/2, resulting, mainly, from the amendments of the Regulations:

(i) In Section 102(b), reference to form PCT/RO/126 was deleted from the list of mandatory forms (previously under the subheading “Other Forms”) in accordance with the decision of the PCT Interim Advisory Committee for Administrative Questions at its 1977 session;

(ii) The footnote previously indicated against Section 108(a) was deleted;

(iii) The footnote previously indicated at the end of the text of Section 110 was deleted;

(iv) Section 407(d) was amended, having regard to new Rule 86.4(b), and a footnote added;

(v) A footnote was added to Annex F indicating the inclusion only of the four printed forms;

(vi) Printed forms: The change indicated in Circular No. 21 from the Director General relating to the appointment of agents was included in the Request form (PCT/RO/101) and the Demand form PCT/IPEA/401);

(vii) The search report form was rearranged as agreed to by the PCT Interim Advisory Committee for Administrative Questions at its 1977 session.

115. During the consultations, it was noted in connection with the Request form (PCT/RO/101), that an indication would have to be provided for permitting applicants to specify the International Searching Authority for carrying out international search on those kinds of international applications for which several International Searching Authorities are competent in accordance with PCT Rule 35.2(a)(ii).

116. Furthermore, during the consultations, information was provided by the International Bureau as to a limited number of small modifications in a certain number of forms, arising from the amendments of the Regulations adopted by the Assembly. It was noted that master copies of the said forms, reflecting the amendments were already available for those Offices wishing to print the forms, or certain forms themselves and that the forms in their final form now to be published by the International Bureau would reflect those modifications.

117. It was understood in the consultations and noted by the Assembly that the promulgation of the Administrative Instructions by the Director General in accordance with PCT Rule 89.2(a) would be upon the understanding that, as regards Section 103(a), as long as a receiving Office does not yet have available forms in the language of the international application, the applicant may use for the purposes of his international application forms available from the receiving Office in another language and the receiving Office and the competent International Searching and Preliminary Examining Authority may also use forms in that language for the purposes of their communications with the applicant.

118. The Assembly noted that, in light of the favorable advice of the receiving Offices and the International Searching and Preliminary Examining Authorities relating to the Administrative Instructions, the Director General would now, in application of PCT Rules 89.2(a) and 89.3, promulgate the Administrative Instructions and publish them in the first issue of the Gazette to appear on May 1, 1978, fixing June 1, 1978 as their date of entry into force.

PUBLISHED ITEMS OF NON-PATENT LITERATURE AGREED UPON BY INTERNATIONAL SEARCHING AUTHORITIES FOR THE PURPOSES OF THE PCT MINIMUM DOCUMENTATION

119. The Director General informed the Assembly of the conclusions reached at the meeting of the International Searching Authorities, convened by him for the purpose of these Authorities agreeing upon the published items of non-patent literature which would, upon publication by the International Bureau, form part of the minimum documentation by virtue of Rule 34.1(b)(iii). The consultations were based on document PCT/INT/I, which contained a PCT minimum list of non-patent literature, together with changes to the entries contained in the Annex to the said document which the Director General had communicated to all the prospective International Searching Authorities prior to the meeting. All of the International Searching Authorities appointed at the session of the Assembly had participated in the

discussions and had unanimously agreed upon the items. The International Bureau would publish in the Gazette the relevant parts of the said document, thereby establishing the published items of non-patent literature pertaining to the minimum documentation. The Assembly noted the statement of the Director General.

CLOSING OF THE SESSION

120. At the closing meeting of the Assembly, the Delegation of Japan expressed its gratitude to the Assembly and to the International Bureau for their cooperation and understanding due to which the Japanese Patent Office had been appointed as an International Searching and Preliminary Examining Authority during the session. Noting that, during the session, the Bill for the national legislation implementing the PCT had made further progress in the procedure before the House of Counsellors of the national Diet and thus, that parliamentary approval for both the PCT and the national laws had virtually been obtained, the Delegation said that it was convinced that the PCT would come into effect for Japan on October 1, 1978. At the same time, the Japanese Patent Office could start to act as an International Searching and Preliminary Examining Authority. The Delegation underlined the firm intention of Japan to cooperate fully with the other member countries and with the International Bureau within the framework of the PCT and bearing in mind, in particular, the offer of the services of the Japanese Patent Office in the interests of the nationals and residents of Asian countries.

121. The Delegation of Austria also expressed its gratitude for the appointment of the Austrian Patent Office as an International Searching and Preliminary Examining Authority. The Delegation said that its country was situated at the meeting point of different economic, social and political systems, and that it had endeavored in the past, and would continue in the future, to direct its efforts to serving as a bridge connecting such systems. Its country would be pleased to ratify the PCT since the PCT would promote international cooperation in the field of industrial property, notwithstanding the differences in the economic and political systems of its member States. The Delegation said, furthermore, that its country would continue its efforts in the interests of the developing countries, not only within the framework of its national programs, but also in relation to WIPO programs, particularly under the PCT.

122. The Delegations of Austria and the United States of America expressed on behalf of all Delegations gratitude to the Chairman who, with outstanding ability and a profound understanding of the questions considered by the Assembly, had guided it through its first session. The Chairman, in turn, thanked the Delegations for the honor done to him in appointing him to the chair and the spirit of cooperation in which the deliberations of the Assembly had taken place.

123. The Assembly unanimously adopted this Report on April 14, 1978.

[Annexes I to XI follow]

ANNEX I/ANNEXE I

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS

(in the English alphabetical order of the names of the States)
(dans l'ordre alphabétique anglais des noms des Etats)

I. MEMBER STATES/ETATS MEMBRES

BRAZIL/BRESIL

Dr. U. Q. CABRAL, President, Instituto Nacional da Propriedade Industrial, Rio de Janeiro

CAMEROON/CAMEROUN

M. D. EKANI, Directeur Général, Organisation Africaine de la Propriété Intellectuelle, Yaoundé

FRANCE

M. G. VIANES, Directeur, Institut national de la propriété industrielle, Paris

M. F. SAVIGNON, Professeur associé, Université des Sciences juridiques, Strasbourg

M. P. GUERIN, Attaché de direction, Institut national de la propriété industrielle, Paris

M. A. NEMO, Conseiller, Mission permanente, Genève

GERMANY (FEDERAL REPUBLIC OF)/ALLEMAGNE (REPUBLIQUE FEDERALE D')

Dr. A. KRIEGER, Ministerialdirektor, Federal Ministry of Justice, Bonn

Dr. E. HÄUSSER, President, German Patent Office, Munich

Dr. M. DEITERS, Ministerialdirigent, Federal Ministry of Justice, Bonn

Mr. U. C. HALLMANN, Leitender Regierungsdirektor, German Patent Office, Munich

Mr. A. SCHÄFERS, Regierungsdirektor, Federal Ministry of Justice, Bonn

Mr. N. HAUGG, Regierungsdirektor, German Patent Office, Munich

Dr. A. MÜHLEN, First Secretary, Permanent Mission, Geneva

LUXEMBOURG

M. J.-P. HOFFMANN, Directeur du Service, Service de la Propriété Industrielle, Luxembourg

MADAGASCAR

M S. RABEARIVELO, Conseiller, Mission permanente de Madagascar, Genève

SENEGAL

M. P. CRESPIEN, Conseiller, Mission permanente du Sénégal, Genève

SOVIET UNION/UNION SOVIETIQUE

Mr. L. KOMAROV, Deputy Chairman, State Committee for Inventions and Discoveries of the USSR Council of Ministers, Moscow

Mr. E. BURYAK, Head, International Patent Cooperation Division, All-Union Research Institute of the State Patent Examination, Moscow

Mr. S. EGOROV, First Secretary, Permanent Mission, Geneva

SWEDEN/SUEDE

Mr. G. BORGGÅRD, Director General, Royal Patent and Registration Office, Stockholm

Mr. L. JONSON, Chief of Legal Affairs, Ministry of Trade, Stockholm

Mr. U. JANSSON, Examiner, Royal Patent and Registration Office, Stockholm

SWITZERLAND/SUISSE

M. P. BRAENDLI, Directeur, Bureau fédéral de la propriété intellectuelle, Berne

M. R. KÄMPF, Chef de Section, Bureau fédéral de la propriété intellectuelle, Berne

UNITED KINGDOM/ROYAUME-UNI

Mr. R. BOWEN, Assistant Comptroller, The Patent Office, London

Mr. E. F. BLAKE, Senior Examiner, The Patent Office, London

Mr. D. CECIL, First Secretary, Permanent Mission, Geneva

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Delegate

Mr. L. F. PARKER, Acting Commissioner of Patents and Trademarks, United States Patent and Trademark Office, Department of Commerce, Washington, D.C.

Alternate Delegate

Mr. H. D. HOINKES, International Patent Specialist, Office of Legislation and International Affairs, United States Patent and Trademark Office, Department of Commerce, Washington, D.C.

Advisors

Mr. D. W. BANNER, Commissioner Designate, United States Patent and Trademark Office, Department of Commerce, Washington, D.C.

Mr. G. R. CLARK, Vice-President, Sunbeam Corporation, Chicago, Illinois

Mr. L. O. MAASSEL, Patent Procedure Specialist, Office of the Assistant Commissioner for Patents, United States Patent and Trademark Office, Department of Commerce, Washington, D.C.

Mr. W. E. SCHUYLER, Jr., Intellectual Property Owners Inc., Washington, D.C.

Mr. I. A. WILLIAMSON, Jr., First Secretary, Permanent Mission, Geneva

II. SPECIAL OBSERVERS/OBSERVATEURS SPECIAUX

AUSTRALIA/AUSTRALIE

Mr. F. J. SMITH, Commissioner of Patents, Patent Office, Canberra

Mr. D. B. FITZPATRICK, Vice-President, Institute of Patent Attorneys of Australia, Melbourne

AUSTRIA/AUTRICHE

Dr. O. LEBERL, President, Austrian Patent Office, Director General, Industrial Property Section, Federal Ministry of Trade, Commerce and Industry, Vienna

Mr. H. QUERNER, First Secretary, Permanent Mission, Geneva

CANADA

Mr. E. W. BOWN, Patent Examiner, Canadian Patent Office, Hull, Quebec

DENMARK/DANEMARK

Mr. K. SKJØDT, Director, Patent Office, Copenhagen

Ms. D. SIMONSEN, Head of Department, Patent Office, Copenhagen

FINLAND/FINLANDE

Mr. E. TUULI, Director General, Patent and Registration Board, Helsinki

Mr. P. SALMI, Head of the Patent Department, Patent and Registration Board, Helsinki

HUNGARY/HONGRIE

Mr. E. TASNÁDI, President, National Office of Inventions, Budapest

Mr. G. PUSZTAI, Head of Department, National Office of Inventions, Budapest

IRELAND/IRLANDE

Mr. J. QUINN, Controller of Patents, Patents Office, Dublin

JAPAN/JAPON

Mr. Z. KUMAGAI, Director General, Japanese Patent Office, Tokyo

Mr. H. IWATA, Director General, 4th Examination Department, Japanese Patent Office, Tokyo

Mr. Y. HASHIMOTO, Appeal Examiner-in-Chief, Appeal Department, Japanese Patent Office, Tokyo

Mr. K. HATAKAWA, Director, Industrial Property Division, Japan Trade Center, Düsseldorf, Germany (Federal Republic of)

NETHERLANDS/PAYS-BAS

Mr. J. DEKKER, President, Patent Office, Rijswijk

Dr. S. de VRIES, Deputy Member, Patents Council, Patent Office, Rijswijk

NORWAY/NORVEGE

Mr. A. GERHARDSEN, Director General, Norwegian Patent Office, Oslo

Mr. O. OS, Head of Division, Norwegian Patent Office, Oslo

ROMANIA/ROUMANIE

Dr. V. TUDOR, Conseiller, Mission permanente, Genève

SPAIN/ESPAGNE

Dr. A. VILLALPANDO MARTINEZ, Director General, Registro de la Propiedad Industrial, Madrid

Sr. J. DELICADO MONTERO-RIOS, Director, Departamento Estudios y Asuntos Internacionales Registro da la Propiedad Industrial, Madrid

EUROPEAN PATENT OFFICE/L'OFFICE EUROPEEN DES BREVETS

Mr. J. B. van BENTHEM, President, European Patent Office, Munich

M. J. STAEHELIN, Vice-président, Office européen des brevets, Munich

Dr. U. SCHATZ, Directeur principal, Office européen des brevets, Munich

M. J. A. H. van VOORTHUIZEN, Directeur, Office européen des brevets, Rijswijk

M. J.-F. MEZIERES, Secrétaire du Conseil d'Administration, Office européen des brevets, Munich

OFFICE OF THE AFRICAN INTELLECTUAL PROPERTY ORGANIZATION (OAPI)/L'OFFICE DE L'ORGANISATION AFRICAINE DE LA PROPRIETE INTELLECTUELLE (OAPI)

M. D. EKANI, Directeur Général, Organisation Africaine de la Propriété Intellectuelle, Yaoundé

III. OBSERVERS/OBSERVATEURS

States/Etats

ALGERIA/ALGERIE

Mlle L. ZEBDJI, Chef adjoint du département des inventions, Institut algérien de normalisation et de propriété industrielle, Alger

Mme F. BOUZID, Chef du département des marques, dessins et modèles, Institut algérien de normalisation et de propriété industrielle, Alger

GERMAN DEMOCRATIC REPUBLIC/REPUBLIQUE DEMOCRATIQUE ALLEMANDE

Ms. C. MICHEEL, Third Secretary, Permanent Mission, Geneva

ITALY/ITALIE

Sr. S. SAMPERI, Directeur du Bureau national des brevets, Ministère de l'Industrie et du Commerce, Rome

Sr. I. PAPINI, Delegato per gli Accordi di Proprieta Intellettuale, Ministero Affari Esteri, Rome

Sr. M. F. PINI, First Secretary, Permanent Mission, Geneva

PORTUGAL

M. R. SERRÃO, Directeur des Services, Instituto Nacional da Propriedade Industrial, Lisbonne

URUGUAY

Sr. A. MOERZINGER, Third Secretary, Permanent Mission, Geneva

Intergovernmental Organizations
Organizations intergouvernementales

INTERIM COMMITTEE OF THE COMMUNITY PATENT/COMITE INTERIMAIRE
POUR LE BREVET COMMUNAUTAIRE

M. G. A. U. M. van GREVENSTEIN, Directeur-Général, Comité intérimaire pour le brevet communautaire, Bruxelles

Mr. K. MELLOR, Administrator, Interim Committee of the Community Patent, Brussels

International Non-Governmental Organizations
Organisations internationales non-gouvernementales

COMMITTEE OF NATIONAL INSTITUTES OF PATENT AGENTS (CNIPA)/COMITE
DES INSTITUTS NATIONAUX D'AGENTS DE BREVETS

Mr. C. G. WICKHAM, Chartered Institute of Patent Agents, London, United Kingdom

COUNCIL OF EUROPEAN INDUSTRIAL FEDERATIONS (CEIF)/CONSEIL DES
FEDERATIONS INDUSTRIELLES D'EUROPE

Mr. M. van DAM, Patent Agent, Eindhoven, Netherlands

EUROPEAN FEDERATION OF INDUSTRIAL PROPERTY REPRESENTATIVES OF
INDUSTRY/FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN
PROPRIETE INDUSTRIELLE (FEMIP)

Dr. C. GUGERELL, Scherico Ltd., Lucerne, Switzerland

INTER-AMERICAN ASSOCIATION OF INDUSTRIAL PROPERTY
(ASIPI)/ASSOCIATION INTERAMERICAINE DE LA PROPRIETE INDUSTRIELLE

Mr. D. MERRYLEES, Chartered Patent Agent, Rio de Janeiro, Brazil

INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY/ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE LA
PROPRIETE INDUSTRIELLE (AIPPI)

Mr. G. R. CLARK, International Patent and Trademark Association, Chicago, Illinois, United States of America

INTERNATIONAL FEDERATION OF INVENTORS ASSOCIATIONS
(IFIA)/FEDERATION INTERNATIONALE DES ASSOCIATIONS D'INVENTEURS

Mr. S. E. ANGERT, Engineer, Stockholm, Sweden

Mr. P. FELDMANN, Engineer, Opfikon-Glattbrugg, Switzerland

INTERNATIONAL FEDERATION OF PATENT AGENTS/FEDERATION
INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE (FICPI)

M. E. GUTMANN, Conseil en propriété industrielle, Paris, France

M. G. E. KIRKER, Ingénieur-conseil en propriété industrielle, Genève, Suisse

PACIFIC INDUSTRIAL PROPERTY ASSOCIATION (PIPA)

Mr. D. J. MUGFORD, Chief Patent and Trademark Counsel, Bristol-Myers Company, New York, United States of America

UNION OF EUROPEAN PATENT ATTORNEYS AND OTHER REPRESENTATIVES
BEFORE THE EUROPEAN PATENT OFFICE (UNEPA)/UNION DES CONSEILS
EUROPEENS EN BREVETS ET AUTRES MANDATAIRES AGREES AUPRES DE
L'OFFICE EUROPEEN DES BREVETS

Dr. U. KADOR, Patentanwalt, Munich, Germany (Federal Republic of)

UNION OF INDUSTRIES OF THE EUROPEAN COMMUNITY/UNION DES
INDUSTRIES DE LA COMMUNAUTE EUROPEENNE (UNICE)

Dr. R. KOCKLÄUNER, Patent Assessor, Hoechst AG, Wiesbaden, Germany (Federal Republic of)

IV. OFFICERS/BUREAU

Chairman/Président:	M. D. EKANI (Cameroon/Cameroun)
Vice-Chairmen/Vice-présidents:	Mr. P. BRAENDLI (Switzerland/Suisse) Mr. L. KOMAROV (Soviet Union/Union soviétique)
Secretary/Secrétaire:	Mr. E. M. HADDRICK (WIPO/OMPI)

V. INTERNATIONAL BUREAU OF WIPO
BUREAU INTERNATIONAL DE L'OMPI

Dr. A. BOGSCH, Director General/ Directeur général

Mr. K. PFANNER, Deputy Director General/Vice-directeur général

Mr. F. A. SVIRIDOV, Deputy Director General/Vice-directeur général

Mr. E. M. HADDRICK, Head, PCT Division/Chef de la Division “PCT”

Mr. J. FRANKLIN, Head, Administrative Section, PCT Division/Chef de la Section administrative, Division “PCT”

Mr. V. TROUSSOV, Senior Counsellor, PCT Division/Conseiller principal, Division “PCT”

Mr. N. SCHERRER, Counsellor, PCT Division/Conseiller, Division “PCT”

Mr. D. BOUCHEZ, Technical Counsellor, PCT Division/Conseiller technique, Division “PCT”

Mr. Y. GYRDYMOV, Technical Counsellor, PCT Division/Conseiller technique, Division “PCT”

Mr. A. OKAWA, Consultant, PCT Division/Consultant, Division “PCT”

[Annex II follows]

ANNEX II

OPENING SPEECH
of
Dr. Arpad Bogisch
Director General of the
World Intellectual Property Organization (WIPO)

Honorable Delegates,
Esteemed Guests of Honor,
Ladies and Gentlemen,

I have the honor to open the first session of the Assembly of the International Patent Cooperation Union, also called the PCT Union.

This meeting is an event of great significance in the history of the Patent Cooperation Treaty since it marks the occasion on which what, until now, has been a mere plan becomes a living reality.

The plan was drawn up in Washington in 1970 at the Diplomatic Conference which adopted the Patent Cooperation Treaty.

The main substantive work of that Conference was carried out in what was called Main Committee I. It was presided over by Mr. William Schuyler, then Commissioner of Patents of the United States of America. He is here today in two capacities: as a guest of honor invited by me and as a delegate of his country. His merits in connection with the Patent Cooperation Treaty are both great and numerous. Not only was he the Chairman of Main Committee I and not only did he have a decisive role in preparing the Washington Conference, but he also played a decisive part in bringing about the ratification of the Treaty by the United States. Indeed, in this matter, the views of private circles in the United States, including in particular those of the American Bar Association, were determinative, and it is thanks in a large measure to Bill Schuyler that these views were favorable and so articulated that the US Congress acted favorably both as to the ratification of the Treaty and as to the adoption of the necessary implementing legislation.

The other main committee of the Washington Diplomatic Conference, Main Committee II, was presided over by Mr. Bob van Benthem, then President of the Netherlands Patent Office. He, too, is here in two capacities: as a guest of honor, in recognition of the eminent role he played in bringing the PCT into existence, and as the representative of the European Patent Office, of which he is now the President. In his new capacity, Bob van Benthem's merits in connection with the Patent Cooperation Treaty still prevail, close cooperation between his Office and the organs of the Patent Cooperation Treaty being indispensable for the smooth functioning of the latter. He has already given many proofs of his readiness to contribute to such cooperation.

Mr. Denis Ekani, Director General of the African Industrial Property Office, represented that Office in the Washington Diplomatic Conference. His Office acts as the industrial property office of twelve African countries. At Washington, he was the representative of the only regional patent office in the world. His attitude then and ever since has pointed the way to constructive cooperation between a regional system and a worldwide system such as that

which the Patent Cooperation Treaty is intended to represent. It is largely thanks to his continued constructive attitude that the first ratifications of the Treaty came from African countries members of his Organization. Thus, the role played by our guest of honor, Mr. Denis Ekani, was of the utmost importance in making the Treaty operational.

May I now greet, as guest of honor and delegate of the Federal Republic of Germany, Mr. Albrecht Krieger. His merits in the field of international cooperation in matters of industrial property are well known and have frequently placed his country in the forefront of that field. It is to a great extent because of the personal merit of Albrecht Krieger that, among all the European countries, his was the first to ratify the Patent Cooperation Treaty. This event was of decisive significance for the acceptance and entry into force of the Patent Cooperation Treaty.

Mr. François Savignon is also a guest of honor. It was he, in fact, who led the French Delegation in the Washington Diplomatic Conference. He was then the Director of the French National Institute of Industrial Property. In that position, and in his present position as professor and director of an Institute at the Strasbourg University specially devoted to work for developing countries, François Savignon's interest in and merits in connection with international cooperation have been and continue to be of the highest order.

It is a pleasure to be able to greet here as a guest of honor Mr. Kurt Haertel. He is usually considered to be the main artisan of the European Patent Conventions, and rightly so. But his role in the Washington Diplomatic Conference, as a delegate of the Federal Republic of Germany, was also extremely active and important: it was Kurt Haertel who saw to it, among other things and with the help of fellow Europeans, that the Patent Cooperation Treaty and the European Patent Conventions would be not only compatible but also complementary.

I have kept for the end of the list of our guests of honor Professor George Bodenhause. Not because his were the smallest merits--on the contrary, in actual fact--but because, as the former Director General of the World Intellectual Property Organization, he is still, in some ways, not only a guest but also a host. The success of the Washington Diplomatic Conference was, to a great extent, the result of foresight and courage on the part of what was then called BIRPI, which he directed at that time. Foresight, because he recognized the need for and the feasibility of such a far-reaching international system as that provided for by the Patent Cooperation Treaty. Courage, because doubts about the Treaty's feasibility and criticism of the proposed solutions were never lacking. Without the perseverance and the imperturbability of George Bodenhause, without his diplomatic skill and his awareness of what was needed in practice--after all he was a practicing lawyer before assuming the direction of BIRPI--the preparatory work leading to the Washington Diplomatic Conference would probably never have been completed. The Patent Cooperation Treaty was prepared and adopted at a time when Professor Bodenhause was at the helm of BIRPI, and I congratulate him today when one of the most important accomplishments of his tenure has become a reality.

Ladies and Gentlemen, I hope you will forgive me for having dwelt for a few minutes on the merits of our guests of honor. Naturally, there were and are many other persons--most of you here today, in fact--who had the great merit of making the Patent Cooperation Treaty an institution which will really function. May I thank and congratulate each and every one of you, for this new instrument and this new institution are achievements you can be proud of. Your devotion to them will, I have no doubt, make the governments, the inventors and the

industry of your countries grateful to you. And I hope that this gratitude will give you much satisfaction in your work.

Now that you are on the point of making a new start to this work, and on behalf of the World Intellectual Property Organization, may I express my ardent wishes for its entire success.

[Annex III follows]

RULES OF PROCEDURE OF THE ASSEMBLY OF THE
INTERNATIONAL PATENT COOPERATION (PCT) UNION

Rule 1: Application of the General Rules of Procedure

The Rules of Procedure of the Assembly of the International Patent Cooperation (PCT) Union shall consist of the General Rules of Procedure of WIPO, supplemented and amended by the provisions set forth hereinafter.

Rule 2: Special Observers

(1) The following shall be invited as “special observers” to all sessions of the Assembly:

- (i) States not members of the PCT Union which contribute to the budget of the PCT Union,
- (ii) intergovernmental authorities having the power to grant patents effective in one or more States members of the PCT Union.

(2) Special observers shall have the same rights in the sessions of the Assembly as States members of the Assembly, except the right to vote.

Rule 3: Draft Agenda

The draft agenda of each session shall be drawn up by the Director General. In the case of ordinary sessions, such draft shall follow the instructions of the Executive Committee once the Executive Committee is established (see PCT Articles 53(9) and 54(6)(a)). In the case of extraordinary sessions, the said draft shall include the item or items mentioned in the request referred to in Article 53(11)(c) of the Patent Cooperation Treaty.

Rule 4: Publication of the Report

The report on the work of each session, or a summary drawn up by the International Bureau, shall be published in the Gazette of the PCT Union and in the reviews of the World Intellectual Property Organization La Propriété industrielle and Industrial Property.

[Annex IV follows]

ANNEX IV

SPECIAL OBSERVERS AND OBSERVERS

Special Observers

- (i) the States not members of the PCT Union which contribute to the budget of the PCT Union, that is at present: Australia, Austria, Belgium, Canada, Cuba, Denmark, Egypt, Finland, Hungary, Iran, Ireland, Israel, Japan, Netherlands, Norway, Philippines, Romania, Spain, Yugoslavia (19)
- (ii) the European Patent Office
- (iii) the Office of the African Intellectual Property Organization (OAPI)

Observers

- (i) all States members of the Paris Union which are not members of the PCT Union and which have no special observer status,
- (ii) the following intergovernmental organizations
 - United Nations (UN)
 - Council for Mutual Economic Assistance (CMEA)*
 - Commission of the European Communities (CEC)*
 - Interim Secretariat for the Community Patent Convention*
- (iii) the following International non-governmental organizations:
 - Asian Patent Attorneys Association (APAA)
 - Committee of National Institutes of Patent Agents (CNIPA)
 - Council of European Industrial Federations (CEIF)
 - European Federation of Agents of Industry in Industrial Property (FEMIP)
 - European Industrial Research Management Association (EIRMA)
 - Inter-American Association of Industrial Property (ASIPI)
 - International Association for the Protection of Industrial Property (AIPPI)
 - International Chamber of Commerce (ICC)
 - International Federation of Inventors' Associations (IFIA)
 - International Federation of Pharmaceutical Manufacturers Associations (IFPMA)
 - International Federation of Patent Agents (FICPI)
 - Licensing Executives Society (International) (LES)
 - Pacific Industrial Property Association (PIPA)
 - Union of European Patent Attorneys and Other Representatives Before the European Patent Office (UNEPA)
 - Union of Industries of the European Community (UNICE)

[Annex V follows]

* Where the agenda of the session contains one or more specific items which, in the opinion of the Director General, is of special and direct interest to this Organization, the invitation will be extended to it to attend during the discussion of that specific item or those specific items.

ANNEX V

AMENDMENTS TO THE REGULATIONS
UNDER THE PATENT COOPERATION TREATY
(PCT)

Adopted by the Assembly of the International
Patent Cooperation (PCT) Union on April 14, 1978

TABLE OF AMENDMENTS

Rule 4.4(c)	Amended
Rule 4.10(d)	Amended
Rule 11.6(a)	Amended
Rule 11.6(b)	Amended
Rule 11.13(a)	Amended
Rule 15.2(a)	Amended
Rule 15.2(b)	Amended
Rule 32 <i>bis</i> .1	New rule added
Rule 48.2(a)	Amended
Rule 48.3(c)	Amended
Rule 57.2(a)	Amended
Rule 57.2(b)	Amended
Rule 58.2	New rule added
Rule 58.3	New rule added
Rule 61.1(b)	Amended
Rule 74 <i>bis</i> .1	New rule added
Rule 86.3(a)	Amended
Rule 86.3(b)	New rule added
Rule 86.4(a)	Amended
Rule 86.4(b)	New rule added

Rule 4

The Request (Contents)

4.4 Names and Addresses

(c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. It is recommended to indicate any telegraphic and teleprinter address and telephone number.

4.10 Priority claim

(d) If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated. If the applicant fails to act accordingly within 1 month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled *ex officio*. The receiving Office effecting the correction or cancellation shall notify the applicant accordingly and, if copies of the international application have already been sent to the International Bureau and the International Searching Authority, that Bureau and that Authority. If the correction or cancellation is effected by the International Bureau, the latter shall notify the applicant and the International Searching Authority accordingly.

Rule 11

Physical Requirements of the International Application

11.6 Margins

(a) The minimum margins of the sheets containing the request, the description, the claims, and the abstract, shall be as follows:

top: 2 cm

left side: 2.5 cm

right side: 2 cm

bottom: 2 cm

(b) The recommended maximum, for the margins provided for in paragraph (a), is as follows:

top: 4 cm

left side: 4 cm

right side: 3 cm

bottom: 3 cm

11.13 Special Requirements for Drawings

(a) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colorings.

Rule 15 The International Fee

15.2 Amounts

(a) The amount of the basic fee shall be:

(i) if the international application contains not more than 30 sheets: US \$165.00 or 300 Swiss francs,

(ii) if the international application contains more than 30 sheets: US \$165.00 or 300 Swiss francs plus US \$3.00 or 6 Swiss francs per sheet in excess of 30 sheets.

(b) The amount of the designation fee for each designated State or each group of designated States for which the same regional patent is sought shall be: US \$40.00 or 80 Swiss francs.

Rule 32bis Withdrawal of the Priority Claim

32bis.1 Withdrawals

(a) The applicant may withdraw the priority claim made in the international application under Article 8(1) at any time before the international publication of the international application.

(b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one or more or all of them.

(c) Where the withdrawal of the priority claim, or, in the case of more than one such claim, the withdrawal of any of them, causes a change in the priority date of the international application, any time limit which is computed from the original priority date and which has not already expired shall be computed from the priority date resulting from that change. In the case of the time limit of 18 months referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the withdrawal is effected during the period of 15 days preceding the expiration of that time limit.

(d) For any withdrawal under paragraph (a), the provisions of Rule 32.1(c) and (d) and Rule 74bis.1 shall apply *mutatis mutandis*.

Rule 48

International Publication

48.2 Contents

- (a) The pamphlet shall contain:
- (i) a standardized front page,
 - (ii) the description,
 - (iii) the claims,
 - (iv) the drawings, if any,
 - (v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a); the publication of the international search report in the pamphlet shall, however, not be required to include the part of the international search report which contains only matter referred to in Rule 43 already appearing on the front page of the pamphlet,
 - (vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4.

48.3 Language

(c) If the international application is published 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), and the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

Rule 57

The Handling Fee

57.2 Amount

(a) The amount of the handling fee shall be US \$50.00 or 96 Swiss francs augmented by as many times the same amount as the number of languages into which the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau.

(b) Where, because of a later election or elections, the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau into one or more additional languages, a supplement to the handling fee shall be payable and shall amount to US \$50.00 or 96 Swiss francs for each additional language.

Rule 58
The Preliminary Examination Fee

58.2 Failure to pay

(a) Where the preliminary examination fee fixed by the International Preliminary Examining Authority under Rule 58.1(b) is not paid as required under that Rule, the International Preliminary Examining Authority shall invite the applicant to pay the fee or the missing part thereof within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the prescribed time limit, the preliminary examination fee will be considered as if it had been paid on the due date.

(c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.

58.3 Refund

The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted under Rule 57.4(c), Rule 58.2(c) or Rule 60.1(c), and the International Bureau shall promptly publish such information.

Rule 61
Notification of the Demand and Elections

61.1 Notifications to the International Bureau, the Applicant, and the International Preliminary Examining Authority

(b) The International Preliminary Examining Authority shall promptly inform the applicant in writing of the date of receipt of the demand. Where the demand has been considered under Rules 57.4(c), 58.2(c) or 60.1(c) as if it had not been submitted, the International Preliminary Examining Authority shall notify the applicant accordingly.

Rule 74bis
Notification of Withdrawal under Rule 32

74bis.1 Notification of the International Preliminary Examining Authority

If, at the time of the withdrawal of the international application or of the designation of all designated States under Rule 32.1, a demand for international preliminary examination has already been submitted and the international preliminary examination report has not yet issued, the International Bureau shall promptly notify the fact of withdrawal, together with the date of receipt of the notice effecting withdrawal, to the International Preliminary Examining Authority.

Rule 86
The Gazette

86.3 Frequency

(a) Subject to paragraph (b) the Gazette shall be published once a week.

(b) For a transitional period after the entry into force of the Treaty terminating upon a date fixed by the Assembly, the Gazette may be published at such times as the Director General considers appropriate having regard to the number of international applications and the amount of other material to be published.

86.4 Sale

(a) Subject to paragraph (b), the subscription and other sale prices of the Gazette shall be fixed in the Administrative Instructions.

(b) For a transitional period after the entry into force of the Treaty terminating upon a date fixed by the Assembly, the Gazette may be distributed on such terms as the Director General considers appropriate having regard to the number of international applications and the amount of other material published therein.

[Annex VI follows]

ANNEX VI

DECISIONS CONCERNING THE PCT COMMITTEE FOR
TECHNICAL COOPERATION (PCT/CTC)

The Assembly of the PCT Union, at its first session held from April 10 to 14, 1978, adopts the following decisions:

1. With reference to PCT Article 56(1) and (2), the Assembly hereby establishes the PCT Committee for Technical Cooperation (PCT/CTC) and appoints, in addition to the ex-officio members according to PCT Article 56(2)(b), all States members of the PCT Union as members of the said Committee, it being understood that the appointment of any State which will become a member of the PCT Union in the future shall take effect on the date on which such State becomes a member of the PCT Union. Finally, the Assembly decides that once the number of States members of the PCT Union reaches 30, it will, in its session following such an event, reconsider the question of the composition of the said Committee.
2. With reference to PCT Article 56(8), the Assembly decides that it will itself establish and, where necessary in the future, amend the Rules of Procedure of the PCT Committee for Technical Cooperation (PCT/CTC).
3. With reference to its decision under PCT Article 56(8), the Assembly hereby establishes the Rules of Procedure of the PCT Committee for Technical Cooperation as set out in Annex VII.
4. With reference to the decision taken by the Executive Committee of the Paris Union and the WIPO Coordination Committee in their September 1977 sessions, establishing the WIPO Permanent Committee on Patent Information (WIPO/PCPI), in which it was agreed, inter alia, that the meetings of PCT/CTC “shall be joint” with those of WIPO/PCPI, “it being understood that the activities of the said Committees will be coordinated and it being further understood that, where decisions are made by [PCT/CTC]..., only the members of [PCT/CTC]...should vote” (AB/VIII/16, Annex B, Decision, paragraph 4), and recommending that the Assembly of the PCT Union “endorse the above measures,” the Assembly decides to endorse the measures in question.

[Annex VII follows]

RULES OF PROCEDURE OF THE PCT COMMITTEE
FOR TECHNICAL COOPERATION (PCT/CTC)

Rule 1: Application of the General Rules of Procedure

The PCT Committee for Technical Cooperation (PCT/CTC, hereinafter referred to as “the Committee”), being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, supplemented and amended by the provisions set forth hereinafter.

Rule 2: Special Observers

(1) States and intergovernmental authorities not members of the Committee which have the status of special observer in the PCT Assembly shall be invited as “special observers” to all sessions of the Committee.

(2) Special observers shall have the same rights in the sessions of the Committee as States members of the Committee, except the right to vote.

Rule 3: Joint Meetings with the WIPO Permanent Committee on Patent Information

The meetings of the Committee shall be joint with those of the WIPO Permanent Committee on Patent Information, it being understood that the activities of the two Committees shall be coordinated and that, where decisions are made by the Committee, only the members of the Committee shall vote.

[Annex VIII follows]

ANNEX VIII

DECISIONS CONCERNING THE PCT COMMITTEE FOR
TECHNICAL ASSISTANCE (PCT/CTA)

The Assembly of the PCT Union, at its first session held from April 10 to 14, 1978, adopts the following decisions:

1. With reference to PCT Article 51(1) and (2)(a), the Assembly hereby establishes the PCT Committee for Technical Assistance (PCT/CTA) and elects all States members of the PCT Union as members of the said Committee, it being understood that the election of any State which will become a member of the PCT Union in the future shall take effect on the date on which such State becomes a member of the PCT Union. Finally, the Assembly decides that once the number of States members of the PCT Union reaches 30, it will, in its session following such an event, reconsider the question of the composition of the said Committee.
2. With reference to PCT Article 51(5), the Assembly decides that it will itself establish and, where necessary in the future, amend the Rules of Procedure of the PCT Committee for Technical Assistance (PCT/CTA).
3. With reference to its decision under PCT Article 51(5), the Assembly hereby establishes the Rules of Procedure of the PCT Committee for Technical Assistance as set out in Annex IX.
4. With reference to the decision taken by the Executive Committee of the Paris Union and the WIPO Coordination Committee in their September 1977 sessions, establishing the WIPO Permanent Committee on Patent Information (WIPO/PCPI), in which it was agreed, inter alia, that the meetings of PCT/CTA “shall be joint” with those of the WIPO Permanent Committee for Development Cooperation Related to Industrial Property, “it being understood that the activities of the said Committees will be coordinated and it being further understood that, where decisions are made by [PCT/CTA]..., only the members of [PCT/CTA]... should vote” (AB/VIII/16, Annex B, Decision, paragraph 4), and recommending that the Assembly of the PCT Union “endorse the above measures,” the Assembly decides to endorse the measures in question.

[Annex IX follows]

RULES OF PROCEDURE OF THE PCT COMMITTEE
FOR TECHNICAL ASSISTANCE (PCT/CTA)

Rule 1: Application of the General Rules of Procedure

The PCT Committee for Technical Assistance (PCT/CTA, hereinafter referred to as “the Committee”), being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, supplemented and amended by the provisions set forth hereinafter.

Rule 2: Special Observers

(1) States not members of the Committee which have the status of special observer in the PCT Assembly, as well as intergovernmental authorities which have such a status, shall be invited as “special observers” to all sessions of the Committee.

(2) Special observers shall have the same rights in the sessions of the Committee as States members of the Committee, except the right to vote.

Rule 3: Observers

The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested international non-governmental organizations to attend the sessions of the Committee in an observer capacity.

Rule 4: Joint Meetings with the WIPO Permanent Committee for Development Cooperation Related to Industrial Property

The meetings of the Committee shall be joint with those of the WIPO Permanent Committee for Development Cooperation Related to Industrial Property, it being understood that the activities of the two Committees shall be coordinated and that, where decisions are made by the Committee, only the members of the Committee shall vote.

[Annex X follows]

DECISIONS CONCERNING THE PCT COMMITTEE FOR
ADMINISTRATIVE AND LEGAL MATTERS (PCT/CAL)

The Assembly of the PCT Union, at its first session held from April 10 to 14, 1978, adopts the following decisions:

1. With reference to PCT Article 53(2)(a)(viii), the Assembly hereby establishes the PCT Committee for Administrative and Legal Matters (PCT/CAL) and appoints all States members of the PCT Union and the International Searching and Preliminary Examining Authorities as members, it being understood that, where any such Authority is the national Office of a State member of the PCT Union, that State shall not be additionally represented on the Committee. It is also understood that the appointment of any State which will become a member in the future shall take effect on the date on which such State becomes a member of the PCT Union.
2. The Assembly decides that it will itself establish and, where necessary in the future, amend the Rules of Procedure of the PCT Committee for Administrative and Legal Matters (PCT/CAL).
3. with reference to its decision concerning the establishment and amendment of the Rules of Procedure of the PCT Committee for Administrative and Legal Matters, the Assembly hereby establishes those Rules of Procedure as set out in Annex XI.

[Annex XI follows]

RULES OF PROCEDURE OF THE PCT COMMITTEE FOR
ADMINISTRATIVE AND LEGAL MATTERS (PCT/CAL)

Rule 1: Composition

The PCT Committee for Administrative and Legal Matters (PCT/CAL, hereinafter referred to as “the Committee”) shall have as members the States members of the PCT Union and the International Searching and Preliminary Examining Authorities, it being understood that, where any such Authority is the national Office of a State member of the PCT Union, that State shall not be additionally represented on the Committee.

Rule 2: Terms of Reference

The Committee shall deal with matters concerning

- (i) the relationship between the International Bureau on the one hand and the applicants, the receiving Offices, the designated Offices, the elected Offices, the International Searching Authorities and the International Preliminary Examining Authorities on the other hand,
- (ii) the relationship between the applicants on the one hand and the receiving Offices, the designated Offices, the elected Offices, the International Searching Authorities and the International Preliminary Examining Authorities on the other hand,
- (iii) the relationship between the receiving Offices, the designated Offices and the elected Offices on the one hand and the International Searching Authorities and the International Preliminary Examining Authorities on the other hand,
- (iv) fees, forms, procedures and publications under the PCT,
- (v) other administrative and legal questions concerning the application of the PCT.

Rule 3: Application of the General Rules of Procedure

The Committee, being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, supplemented and amended by the provisions set forth hereinafter.

Rule 4: Special Observers

- (1) States not members of the Committee which have the status of special observer in the PCT Assembly, as well as intergovernmental authorities which have such a status and which are not members of the Committee, shall be invited as “special observers” to all sessions of the Committee.
- (2) Special observers shall have the same rights in the sessions of the Committee as members of the Committee, except the right to vote.

Rule 5: Observers

The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested organizations to attend the sessions of the Committee in an observer capacity.

Rule 6: Working Groups

The Committee may, with the approval of the Assembly, set up working groups for the purposes of dealing with specific questions. It shall decide their composition, terms of reference, duration and rules of procedure.

[End of Annex and of Document]

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PCT/A/III/5

ORIGINAL: English/French

DATE: October 3, 1978

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Second Session (1st Ordinary) Geneva, September 25 to October 3, 1978

REPORT

Adopted by the Assembly

Opening of the Session

1. See the General Report, Chapter I,* and, as concerns the participants and officers, Annex I of the present report.

Agenda

2. See the General Report, Chapter II.*

Officers

3. The Assembly unanimously elected Mr. Valentin Bykov (Soviet Union) as Chairman and H.E. Martin Nzue Nkoghe (Gabon) and Mr. Paul Braendli (Switzerland) as Vice-Chairmen.

Observers

4. See the General Report, Chapter IV.*

* The General Report is contained in document AB/IX/19.

Past Activities

5. See the General Report, Chapter V.*

Contributions and Working Capital Funds

6. See the General Report, Chapter VII.*

Financial Regulations; Auditors; Working Capital Fund

7. See the General Report, Chapter VIII.*

Program and Budget

8. See the General Report, Chapter X.*

PCT Regulations

9. Questions relating to the fixing of fees. Discussions were based upon document PCT/A/II/2.

10. In introducing the amendments proposed in the above-mentioned document, the Director General recalled that when the Assembly fixed the amounts of the international fee (Rule 15) and the handling fee (Rule 57) in its first session (April 1978), he had been asked to propose to the present session a revision of the relevant provisions of the Regulations which would spell out the interpretation of those Rules adopted by the Assembly at the said first session according to which the amounts of the fees fixed in the Regulations in US dollars and Swiss francs are to be considered only as a basis on which the amount of the fees in other applicable national currencies other than the US dollar and the Swiss franc are to be fixed by the Director General after consultation with the country of each such currency. The proposal which he made in the said document, which contained drafts of Rules 15.1, 15.2, 15.3, 16.1(b) and 57, was intended to carry out the instructions of the Assembly. The Director General stated that, in the intervening period since the said first session, there had been a decline of about 16.6 per cent in the value of the US dollar in relation to the Swiss franc and that all other currencies in which the fees fixed under the PCT were at present being paid had sustained about the same decline in value in relation to the Swiss franc. He would therefore propose at a later stage of the discussion the maintaining of the amounts fixed in currencies other than the Swiss franc at the time of the said first session and the realignment of the amount prescribed in the Regulations in Swiss francs with the amount prescribed in US dollars. The amount of the fees in yen, which had been agreed by him with the Japanese Patent Office but which had yet to come into effect, could be lowered. Such a solution would apply at least for the remainder of the period until the Spring of 1979, when it had previously been agreed that the level of fees would be reviewed and could be changed.

11. In response to a question by the Delegation of the United States of America as to the nature of the consultations which were envisaged in the proposed amendments, for the purpose of fixing, on the basis of amounts established by the Assembly in Swiss francs, the amounts of the fees in other currencies specified by the receiving Offices, it was agreed that there would be thorough consultations between the Director General and the Offices concerned which were most likely to result in an understanding, on the basis of which the Director General would fix the amounts. It was noted, in this regard, that, since the proposals

would require that the amounts in a currency other than the Swiss franc would be the equivalent, in round figures, of the amounts established in Swiss francs by the Assembly, there was not much room for substantive negotiation as to the amounts to be fixed and thus little ground for apprehension as to the outcome of such consultations which would mainly be directed to arriving at rounded-off figures.

12. Several delegations noted that the proposal of the Director General whereby Rules 15 and 57.2 would be amended so that the amounts of the fee would no longer be contained in the Regulations themselves but would be established in Swiss francs by a decision of the Assembly and then be published in the Gazette, would result in a lowering to two-thirds of the required majority for taking decisions by the Assembly concerning fees. While being prepared to accept that the amounts of the fees would no longer appear in the text of the Rules themselves, they were not prepared to forego the security afforded by the provisions of the Treaty in relation to the majority of three-fourths required for effecting a change in the amounts of the fees specified in the Regulations. An alternative means, possibly by including the amounts in an Annex which would be an integral part of the Regulations and to which the higher majority for amendments to the Regulations would apply, would have to be found.

13. The Delegations of the United States of America, the United Kingdom and France suggested that, in addition to the proposed fixing of new amounts of fees whenever the exchange rate between the Swiss franc and any other currency in which amounts of fees were fixed would differ by more than 10 percent from the rate previously applied, provision should be made for a periodic, possibly annual, review of the amounts of fees fixed in currencies other than the Swiss franc. This would enable the amounts of fees in such other currencies to be reviewed which would allow to remedy the undesirable situation that a currency might, for a significant period, differ by a substantial percentage (although lower than 10 percent) from the exchange rate applicable at the time the amounts in that currency were fixed.

14. The Delegations of the United States of America, Luxembourg and France, as well as the Observer of UNICE, said that the proposed minimum period of fifteen days from notification in the Gazette of the new amounts fixed in currencies other than Swiss francs after which such new amounts would come into effect, was insufficient to enable their administrations to give effect to changes in the amounts of fees fixed in their currencies and would cause difficulties for applicants and their professional representatives in taking into account the new amounts. The International Bureau said that the proposal of the Director General envisaged consultations as to the time at which changes would be notified and, thereafter, take effect.

15. The International Bureau could, as alternatives to what had been proposed, consider provisions under which either a maximum period after publication in the Gazette was specified for the coming into effect of the new amounts as well as a minimum period or the time at which the change took effect would be subject to agreement between the Director General and the Office concerned, provided that an ultimate time limit of two months from the publication of the new amounts in the Gazette would apply to their coming into effect.

16. The representative of the EPO, referring to the practice of the European Patent Office of fixing the amount of the international search fee not only in one currency, but in the currencies of all of its member States, suggested that the proposed amendment of Rule 16.1(b) be modified to take into account this situation.

17. The Delegation of the Netherlands noted, and the International Bureau agreed, that any modifications to be made to the proposal of the Director General concerning Rule 15 would,

where applicable, also have to be made in relation to the Director General's proposals concerning Rules 16.1(b) and 57.2.

18. In response to a question raised by the Observer of CEIF, the International Bureau confirmed that, in the application of Rule 15.4(a) in the case of a change in the amounts of fees, the amount which would apply in the case dealt with in the second sentence of the said rule would be that applying on the date of receipt of the international application. The Assembly noted with approval the statement of the International Bureau.

19. The Assembly invited the International Bureau to present to it revised drafts of the relevant Rules directed to satisfying the difficulties which Delegations had raised in connection with the principle that the amounts of fees would be established by a decision of the Assembly and not specified in the Regulations. The International Bureau was also asked to give consideration to the possibility of preparing a text which would provide for a review of fees on a periodic basis and also to take into account the fixing by the EPO of the amount of the international search fee in more than one currency.

20. The Assembly noted, however, on the basis of a statement by the International Bureau to that effect, that, having regard to the extremely short time set aside for the consideration of substantive questions at the present session of the Assembly, the shortness of time remaining and the complexities which have been found in attempting to meet the wishes of the Assembly, it was not possible for the Assembly to complete its consideration of the Director General's proposals at the present session.

21. The Director General made the proposal that the Assembly should, as an interim measure until its next session, merely amend those Rules which fix the amounts of fees so as to adjust the amounts in Swiss francs to those expressed in US dollars, taking into account the present rate of exchange. He added that this adjustment would have relatively small budgetary implications, taking into account the present low number of international applications filed and the envisaged review of the situation at the Spring 1979 session of the Assembly.

22. The Delegations of the United States of America, Germany (Federal Republic of), France, Switzerland, the Netherlands and the representative of the EPO supported the proposal of the Director General.

23. The Director General added that, if his proposal was adopted, there was no need to adjust the amounts fixed in currencies other than the US dollar and the Swiss franc for the time being, except for the possible lowering of the amounts in yen.

24. The Delegation of Japan said that it was its understanding that the changing by the Assembly at its present session of the amounts in Swiss francs of international fees fixed under Rules 15 and 57 did not affect the application of the amounts of those fees in yen previously established by consultation between the Director General of WIPO and the Japanese Patent Office until such time as new amounts of those fees in yen would be fixed and a date for entry into effect would be determined by further consultations between the Director General and the Japanese Patent Office. The International Bureau confirmed the understanding of the Delegation of Japan. The Assembly took note of the said understanding.

25. The Assembly adopted the new amounts of the fees in Swiss francs indicated below for Rules 15.2 and 57.2:

Basic fee:	250 Swiss francs
Supplement per sheet over 30 sheets:	4.50 Swiss francs
Designation fee:	60 Swiss francs
Handling fee:	75 Swiss francs.

26. The Assembly amended accordingly the amounts of fees expressed in Swiss francs in Rules 15.2(a)(i) and (ii) and (b) and 57.2(a) and (b) with effect on and from October 3, 1978. These Rules, as amended by the Assembly, are set out in Annex II to the present Report.

27. Amendment of Rule 15.1. Discussions were based on Part I of document PCT/A/II/3.

28. The Assembly agreed to adopt, with effect on and from October 3, 1978, the amendment of Rule 15.1(ii) set out in paragraph 4 of document PCT/A/II/3 which would take into account, for the purposes of the calculation of designation fees, a "double designation," in an international application, of certain Contracting States, namely, as a State for which a national patent is desired, and also as a State for which a European patent is desired. The Assembly noted that this amendment and a related modification of the Administrative Instructions submitted for consultations with the interested Offices (see paragraphs 51 to 54 below and Section 203**bis** (new) referred to in Annex III of this report) clarified the obligation of the applicant, in the case of such "double designation," to pay one designation fee in respect of the designation of the State for the purposes of a national patent and another fee for the designation of that State for the purposes of a European patent, provided that, where more than one State is designated for the purposes of a European patent, only one fee would be payable in respect of the several designations of States for the purposes of a European patent.

29. The Rule, as amended by the Assembly, is set out in Annex II to the present Report.

30. Interpretation of Rule 47.2. Discussions were based on Part II of document PCT/A/II/3.

31. In introducing this question, the International Bureau said that it was its intention to use, for the purposes of communicating the international application to the designated Offices under Article 20, the pamphlet which it would print for the purposes of publishing the international application under Rule 48.1(a). This procedure would be far more economical in that it would avoid the additional work which would be involved if a separate copy were prepared by other means for the purposes of the communication and would enable the communication to be more easily administered by the International Bureau. Moreover, the quality of the reproduction of the international application in the pamphlet would be of a higher standard than if other means of reproduction available to it were to be used. The interpretation of Rule 47.2, which the International Bureau was proposing for adoption by the Assembly, could be drawn from an interpretation of that Rule and Rule 48. The International Bureau said that, in certain exceptional circumstances, it might have to reproduce the international application as a whole, or certain parts of it. For example, in the case of the amendment of the claims under Article 19, it might have to add a copy of the amendments to

the pamphlet for the purpose of communication if the publication of the amended claims would be too late.

32. In response to a question from the Delegation of Japan as to the application of the proposed interpretation in the case where the language in which the international application was published was different from that in which it was filed, the International Bureau said that, under Rule 47.3, the International Bureau was required primarily to communicate the international application in its language of publication. The designated Offices, nevertheless, had the option, under the said Rule, of specially requesting the communication of the international application in the language in which it was filed or in both the language in which it was published and the language in which it was filed. The communication in the language in which the application was filed would, in the event of such a request, be one of the exceptional cases to which it had already referred.

33. The Delegation of the United States of America said that it could not fully agree with the interpretation proposed by the International Bureau. In its view, a designated Office which was prepared to accept a copy of the pamphlet as the communication under Article 20, should be regarded as the exception rather than as the rule. What designated Offices were entitled to receive under Article 20 was the international application together with the international search report. In its view, the obligations of the International Bureau under Article 20 would not be satisfied by a mere communication of the pamphlet. The Delegation felt that the carefully prescribed physical requirements as to international applications contained in the PCT provided an assurance to the designated Offices as to the physical characteristics of the international applications which they would receive. In this regard, it was to be noted that the pamphlet would be printed recto-verso, whereas the prescribed physical requirements specified that only one side of the sheet should be used. Moreover, the request, which was a prescribed part of the international application, was not included as such in the pamphlet. Not all elements of information contained in the request would be reproduced in the pamphlet. The United States Patent and Trademark Office did not wish to receive an international application which was printed recto-verso and which did not include all the information contained in the request.

34. The Delegation of the Federal Republic of Germany said that it shared the concern of the Delegation of the United States of America both from a viewpoint of the lack of necessary data contained in the request and also as regards the difficulties connected with the use of a pamphlet printed recto-verso for Patent Office purposes.

35. The Delegation of the United Kingdom said that it could accept the pamphlet for the purposes of communication under Article 20 subject to the exceptions which had been noted and especially those which might arise from the need to meet time limits.

36. The representative of the EPO said that the European Patent Office could accept the use of the pamphlet, to the extent possible, for the purposes of the communication under Article 20, subject to its receiving those parts of the request necessary to provide the bibliographic information not contained on the front page of the pamphlet. It also had some reservations concerning the quality of the drawings which it would receive.

37. The Observer of CEIF said that he saw difficulties in the fact that the pamphlet did not set out all of the bibliographic data contained in the request. Moreover, the check list, prescribed by the Regulations and included on the request form, was not reproduced in the pamphlet. The acceptability of the pamphlet as a communication was important to applicants having regard

to the provisions of Article 22 which would require the applicant to furnish a copy of the international application to the designated Offices where the communication by the International Bureau under Article 20 had not been completed by the time the requirements of Article 22 would apply.

38. Replying to the questions which had been raised, the International Bureau recalled that the idea of using the pamphlet for the communication of the international application, under Article 20, was not new; indeed, the suggestion had been first made even before the Washington Diplomatic Conference and had been consistently maintained by the International Bureau. The most important concerns militating in favor of using the pamphlet for communication were that this form of communication allowed important economies to be made, facilitated and streamlined the administrative procedure and constituted a safer system than individual reproduction of the international application. The International Bureau was only aware of one item of bibliographic information which was of interest to the designated Offices and which did not, at present, appear on the front page of the pamphlet. If the lack of necessary data on the front page was an obstacle to the acceptance of the pamphlet for communicating the international application, steps could easily be taken to overcome that obstacle. So far as drawings were concerned, it was felt that, having regard to the different methods which would be used in the case of the printing of the pamphlet and the separate reproduction of the international application if it were not possible to use the pamphlet for communication of the application, the designated Offices would receive reproductions of a higher quality if they were to accept the pamphlet. It was true that the pamphlet did not reproduce the request as such and, indeed, reproduced the bibliographic data in a form which would take into account actions taken during the international phase, for example, corrections invited by the receiving Office, but from an Office viewpoint this would be an advantage as against the receipt of a request form which would have been subject to correction in the international phase. Moreover, the PCT system gave to the receiving Offices, supported by notifications as to formal deficiencies from the International Searching Authorities and the International Bureau, responsibilities in relation to matters of formalities which removed the need for the designated Offices to go into these questions. This was evidenced by the fact that on certain questions the receiving Office was given the responsibility of making final decisions. Since the pamphlet reflected the results of the performance of these responsibilities, the designated Offices would be better served by receiving the pamphlet rather than the request. As regards the wish to receive the communication under Article 20 in a reproduction on one side only, there was no provision in the PCT obliging the International Bureau to provide the copies prepared for communication in that form. The omission of the check list was of no legal significance since, even though it was required to appear on the request form, it was not one of the items which form part of the request. While appreciating the concerns and practical needs of the designated Offices from a practical viewpoint, acceptance of the proposed interpretation by the designated Offices was of supreme importance, having regard to the concern, already expressed by the Observer of CEIF, that the applicant should have an assurance that the communication by the International Bureau was accepted by the designated Office as satisfying the requirements of Articles 20 and 22.

39. After further discussion of this question, the International Bureau stated that there was no unanimous acceptance of its proposed interpretation by the Assembly in so far as difficulties had been found by certain delegations in accepting a communication which did not contain the request or which could involve the acceptance of printed matter on both sides of the sheet. The Assembly noted that the question required further study since, due to lack of time, the questions raised by certain delegations could not be considered in more detail and resolved at the present session.

40. In conclusion, the Assembly noted a statement by the International Bureau that it would continue to study the question during the period up to the next session of the Assembly in the Spring of 1979, for which the International Bureau might present further proposals in that matter. In that period, the International Bureau would, on a transitional basis, apply the interpretation of Rule 47.2 which it had proposed, it being understood, however, that any designated Office expressing a wish to receive, for the purposes of the communication under Article 20, a copy of the request in addition to the pamphlet or a copy of the pamphlet printed on one side only, or both, would receive the communication in a manner meeting those wishes.

41. The Delegation of the United States of America indicated, and the International Bureau noted, the wish of the United States Patent and Trademark Office to receive, if the pamphlet is used for the purpose of the communication under Article 20, a copy with sheets printed on one side only as well as a copy of the request in respect of each international application so communicated to it.

42. Interpretation of Rule 48.3(b). Discussions were based upon Part II of document PCT/A/II/3.

43. In introducing this question, the Director General said that the International Bureau recommended to the Assembly the adoption of the interpretation of this Rule which it was putting before the Assembly for its consideration at the request of the EPO. The proposal for the adoption of this interpretation followed a previous discussion at the first session of the Assembly. The adoption of the proposed interpretation was supported by the Delegations of Germany (Federal Republic of), Sweden, Switzerland and the United Kingdom.

44. In response to a question from the Delegation of Japan whether it would not be better to amend the Rule, the International Bureau said that, in its view, the proposed interpretation was supported by both the text and the philosophy of the PCT. In particular, the Rule was directed to the distribution of tasks under the PCT system and was not intended to give rise to a right to damages to third parties. An amendment was therefore not necessary.

45. In conclusion, the Assembly adopted the following interpretation of the said Rule:

“1. PCT Rule 48.3(b) does not prevent the International Searching Authority from leaving the preparation of the required translation to the applicant and/or to the receiving Office, provided that the International Searching Authority ensures to have the translation ready in time to permit the communication under PCT Article 20 by the prescribed date, or, if the international publication is due at an earlier date than the said communication, to permit international publication by the prescribed date.

“2. PCT Rule 48.3(b) contains no ground for the applicant or third parties to hold the International Searching Authority liable for damages caused by inaccuracy of the translation.”

46. The Delegation of the Netherlands expressed its appreciation of the adoption of this interpretation which, by opening to residents and nationals of the Netherlands the possibility of filing international applications in the Dutch language, had removed one of the few obstacles remaining in the way of ratification of the PCT by the Netherlands.

Official Texts

47. Upon a proposal by the International Bureau, the Assembly designated Arabic as a language in which the Director General shall establish, under Article 67(1)(b), an official text of the PCT.

48. The Delegation of Italy suggested to the Assembly that it should also designate Italian as a language in which an official text of the PCT shall be established under Article 67(1)(b). Approval of the ratification by Parliament and by the President of the Republic had already been obtained and the Government of Italy intended, within the shortest time, to deposit the instrument of ratification of the PCT with the Director General. The Government of Italy attached the greatest importance to the establishment of an official text of the PCT in the Italian language. The Delegation of Italy recalled, in this context, that an Italian translation of the PCT had already been published in 1975 by WIPO and that this translation could be used as the basis for establishing an official text.

49. The International Bureau proposed, on the basis of the declaration made by the Delegation of Italy, that the necessary decision be made by the Assembly designating Italian as a language in which the Director General shall establish an official text of the PCT under Article 67(1)(b). On the basis of such a decision, the International Bureau would take the necessary steps for the establishment of the said official text, including consultations with the Governments of the two countries using Italian as an official language, namely Italy and Switzerland, and with a view to preparing an updated version of the 1975 translation, taking into account the amendments made so far to the Regulations.

50. The Assembly, thereupon, designated Italian as a language in which the Director General shall establish, under Article 67(1)(b), an official text of the PCT and noted the intention of the International Bureau to enter into consultations with, and seek the assistance of, the Governments of Italy and Switzerland with a view to preparing an agreed updated translation which would then be used as a basis for the decision of the Director General.

Consultations with the Receiving Offices and the International Searching and Preliminary Examining Authorities Relating to Modifications of the Administrative Instructions

51. On the occasion of the present session of the Assembly, consultations were held with the receiving Offices and the International Searching and Preliminary Examining Authorities relating to the Administrative Instructions, as provided in Rule 89.2(a).

52. The consultations concerned proposals by the Director General for modifications of the Administrative Instructions, relating to changes in several Sections of, and new Sections to be inserted in, the Administrative Instructions (concerning Sections 201, 203~~bis~~, 317, 412 and 502) and for changes relating to Annex C, Appendix II of the Administrative Instructions and to form PCT/RO/101 ("Request") and the Annexes thereto, as well as to forms PCT/IB/301 ("Notification of Receipt of Record Copy"), PCT/IB/302 ("Notification of Designation"), PCT/IB/308 ("Notification Informing the Applicant of the Communication of the International Application to the Designated Offices"), PCT/IB/331 ("Notification of Election") and PCT/IB/332 ("Information Concerning Elected Offices Notified of their Election") annexed to the said Administrative Instructions. For the proposed modifications, reference is made to Part III of document PCT/A/II/3.

53. The consultations resulted in the decision of the Director General to make the proposed modifications of the Administrative Instructions referred to above, subject to some amendments resulting from proposals made during the consultations. The said amendments, as well as certain observations made during the consultations, are reflected in Annex III to this Report. Part III of document PCT/A/II/3, as modified by Annex III to this Report, contains the full text of the modifications of the Administrative Instructions referred to above, as decided by the Director General.

54. The Assembly noted the results of the consultations and the intention of the Director General to proceed to the promulgation of the modifications referred to above with effect from their publication in the Gazette. The Assembly also noted that, as regards forms to be used by the International Bureau which were the subject of the consultations, the International Bureau would apply the changes provisionally in advance of such promulgation. The Assembly noted, furthermore, that several of the suggestions, made during the consultations, relating to certain forms used by the International Bureau, were not taken up by the Director General for the modifications made at this stage but would be the subject of further study by the International Bureau.

Report on Printing of Pamphlets Publishing International Applications

55. The Assembly was informed by the International Bureau that about 190 record copies of international applications had been received up to mid-September, i.e., during the first three and a half months of PCT operations. Although some increase of the number of filings per month could be expected from the imminent entry into force of the PCT for Japan, the number of applications to be published in the first half of 1979 would stay at a rather low level. Consequently, the tenders received from a number of printing firms for the printing of PCT publications, which were based on much higher figures of pamphlets of international applications to be published, could not be used. It was much more economical for the low number foreseen to do the printing of pamphlets in-house and it was, therefore, the intention of the Director General to proceed accordingly at least as long as the situation did not change substantially. This would also allow the International Bureau to gain experience. In this framework, work would be undertaken in studying the possibility of recording the contents of the front pages of the pamphlets on an electronic memory so that Gazette entries could be generated from that memory and indexes generated automatically. A report on the experience with the said printing activities would be provided at the next session of the Assembly.

56. The Assembly noted this information provided by the International Bureau with approval.

Adoption of the Report of the Session

57. This Report was unanimously adopted on October 3, 1978.

[Annexes follow]

ANNEXE I

ANNEX I

LISTE DES PARTICIPANTS ET BUREAUX
LIST OF PARTICIPANTS AND OFFICERS

LISTE DES PARTICIPANTS
LIST OF PARTICIPANTS

I. ETATS MEMBRES DE L'UNION PCT
STATES MEMBERS OF THE PCT UNION

(dans l'ordre alphabétique français des noms des Etats)
(in the French alphabetical order of the names of the States)

ALLEMAGNE (REPUBLIQUE FEDERALE D')/GERMANY (FEDERAL REPUBLIC OF)

Erich HAEUSSER, President, German Patent Office, Munich

Ulrich C. HALLMANN, Leitender Regierungsdirektor, German Patent Office, Munich

BRESIL/BRAZIL

Ubirajara QUARANTA CABRAL, Président, Institut national de la propriété industrielle,
Ministère de l'industrie et du commerce, Rio de Janeiro

ETATS-UNIS D'AMERIQUE/UNITED STATES OF AMERICA

Michael K. KIRK, Director, Office of Legislation and International Affairs, Patent and
Trademark Office, Department of Commerce, Washington

Lee SCHROEDER, Industrial Property Specialist, Office of Legislation and International
Affairs, Patent and Trademark Office, Department of Commerce, Washington

FRANCE

Georges Richard YUNG, Chargé de mission a la direction, Institut National de la Propriété
industrielle, Paris

JAPON/JAPAN

Zenji KUMAGAI, Director General, Patent Office, Ministry of International Trade and
Industry, Tokyo

Toyomaro YOSHIDA, Counsellor for International Affairs, General Administration
Department, Patent Office, Ministry of International Trade and Industry, Tokyo

LUXEMBOURG

Jean-Pierre HOFFMANN, Directeur, Service de la propriété industrielle, Ministère de l'économie nationale, Luxembourg

MADAGASCAR

Solofo RABEARIVELO, Conseiller, Mission permanente, Genève

ROYAUME-UNI/UNITED KINGDOM

Edward Frederick BLAKE, Principal Examiner, Patent Office, London

SENEGAL

Abdou DIARRA, Conseiller technique, Ministère du développement industriel et de l'artisanat, Dakar

SUEDE/SWEDEN

Claes UGGLA, Chairman, Court of Patent Appeals, Stockholm

SUISSE/SWITZERLAND

Roger Kämpf, Chef de section, Bureau fédéral de la propriété intellectuelle, Berne

Jean-Marc SALAMOLARD, Juriste, Bureau fédéral de la propriété intellectuelle, Berne

UNION DES REPUBLIQUES SOCIALISTES SOVIETIQUES/UNION OF SOVIET SOCIALIST REPUBLICS

Valentin BYKOV, Deputy Chairman, USSR State Committee for Inventions and Discoveries, Moscow

Larissa TCHOBANIAN, Expert, External Relations Department, USSR State Committee for Inventions and Discoveries, Moscow

II. OBSERVATEURS SPECIAUX/SPECIAL OBSERVERS

AUSTRALIE/AUSTRALIA

F. SMITH, Commissioner of Patents, Patent, Trade Marks and Designs Office, Canberra

BELGIQUE/BELGIUM

Jacques DEGAVRE, Conseiller adjoint, Ministère des affaires économiques, Bruxelles

DANEMARK/DENMARK

Dagmar SIMONSEN, Chief of Division, Patent Office, Copenhagen

ESPAGNE/SPAIN

Ernesto RUA BENITO, Jefe del Servicio de Estudios, Registro de la Propiedad Industrial, Madrid

FINLANDE/FINLAND

Ragnar MEINANDER, Counsellor of Government, Ministry of Education, Helsinki

Auri Heikki RISKU, Patent Agent, Patent Agents' Association in Finland, Helsinki

IRLANDE/IRELAND

Joe QUINN, Controller of Patents, Designs and Trade Marks, Patents Office, Dublin

NORVEGE/NORWAY

Arne Georg GERHARDSEN, Director General, Patent Office, Oslo

PAYS-BAS/NETHERLANDS

Jacob DEKKER, Président, Office des brevets, Rijswijk

Huib J.G. PIETERS, Conseiller en propriété industrielle, Ministère des Affaires Economiques, Den Haag

OFFICE EUROPEEN DES BREVETS (OEB)/EUROPEAN PATENT OFFICE (EPO)

J.C.A. STAEHELIN, Vice-Président, Office européen des brevets, Munich

III. ETATS OBSERVATEURS/OBSERVER STATES

BULGARIE/BULGARIA

Bogomil TODOROV, Minister Plenipotentiary, Ministry of Foreign Affairs, Sofia

ITALIE/ITALY

Italo PAPINI, Ministre plénipotentiaire, Délégué aux accords pour la propriété intellectuelle, Ministère des Affaires étrangères, Rome

REPUBLIQUE DEMOCRATIQUE ALLEMANDE/GERMAN DEMOCRATIC REPUBLIC

Dieter SCHACK, Head, Department of International Cooperation, Office for Inventions and Patents, Berlin

TCHECOSLOVAQUIE/CZECHOSLOVAKIA

Jaroslav PROŠEK, Head, Trademarks Department, Office for Inventions and Discoveries, Prague

IV. ORGANISATIONS INTERGOUVERNEMENTALES
INTERGOVERNMENTAL ORGANIZATIONS

CONSEIL D'ASSISTANCE ECONOMIQUE MUTUELLE (CAEM)/COUNCIL FOR
MUTUAL ECONOMIC ASSISTANCE (CMEA)

Igor TCHERVIAKOV, Conseiller, Moscou

SECRETARIAT DU COMITE INTERIMAIRE POUR LE BREVET
COMMUNAUTAIRE/SECRETARIAT OF THE INTERIM COMMITTEE FOR THE
COMMUNITY PATENT

J. Frederic FAURE, Administrateur, Bruxelles

Keith MELLOR, Administrateur, Bruxelles

V. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE LA PROPRIETE
INDUSTRIELLE (AIPPI)/ INTERNATIONAL ASSOCIATION FOR THE PROTECTION
OF INDUSTRIAL PROPERTY (AIPPI)

Maurice MATHEZ, F. Hoffmann-La Roche & Cie., S.A., Bâle

CONSEIL DES FEDERATIONS INDUSTRIELLES D'EUROPE (CEIF)/COUNCIL OF
EUROPEAN INDUSTRIAL FEDERATIONS (CEIF)

Martin VAN DAM, Patent Agent, Eindhoven

FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN
PROPRIETE INDUSTRIELLE (FEMIP)/ EUROPEAN FEDERATION OF AGENTS OF
INDUSTRY IN INDUSTRIAL PROPERTY (FEMIP)

Christian GUGERELL, International Patent Department, Scherico Ltd., Lucerne

FEDERATION INTERNATIONALE DES ASSOCIATIONS DES INVENTEURS
(IFIA)/INTERNATIONAL FEDERATION OF INVENTORS' ASSOCIATIONS (IFIA)

Paul FELDMANN, Engineer, Opfikon

FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE
(FICPI)/INTERNATIONAL FEDERATION OF PATENT AGENTS (FICPI)

Ernest GUTMANN, Ingénieur-conseil en propriété industrielle, Paris

G.E. KIRKER, Ingénieur-conseil en propriété industrielle, Genève

UNION DES INDUSTRIES DE LA COMMUNAUTE EUROPEENNE (UNICE)/UNION
OF INDUSTRIES OF THE EUROPEAN COMMUNITY (UNICE)

Reinhard KOCKLÄUNER, Patent Assessor, Hoechst AG, Wiesbaden

VI. BUREAUX/OFFICERS

Président/Chairman: Valentin BYKOV (Union soviétique/Soviet Union)

Vice-présidents/ Martin NZUE NKOGHE (Gabon)

Vice-Chairmen: Paul BRAENDLI (Suisse/Switzerland)

VII. BUREAU INTERNATIONAL DE L'OMPI
INTERNATIONAL BUREAU OF WIPO

Dr. A. BOGSCH, Directeur général/Director General

Klaus PFANNER, Vice-directeur général/Deputy Director General

E. Murray HADDRICK, Chef de la Division "PCT"/Head, PCT Division

Jordan FRANKLIN, Chef de la Section administrative, Division "PCT"/Head, Administrative
Section, PCT Division

Vitaly TROUSSOV, Conseiller principal, Division "PCT"/Senior Counsellor, PCT Division

Normando SCHERRER, Conseiller, Division "PCT"/Counsellor, PCT Division

Daniel BOUCHEZ, Conseiller technique, Division "PCT"/Technical Counsellor, PCT
Division

Akira OKAWA, Conseiller, Division "PCT"/Counsellor, PCT Division

[L'annexe II suit/
Annex II follows]

ANNEX II

Rule 15
The International Fee

15.1 Basic Fee and Designation Fee

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau ("international fee") consisting of

(i) a "basic fee," and

(ii) as many "designation fees" as there are States designated in the international application for which a national patent is sought, provided that, where a regional patent is sought for certain designated States, only one designation fee shall be due for such purpose.

15.2 Amounts

(a) The amount of the basic fee shall be:

(i) if the international application contains not more than 30 sheets: US\$165.00 or 250 Swiss francs,

(ii) if the international application contains more than 30 sheets: US\$165.00 or 250 Swiss francs plus US\$3.00 or 4.50 Swiss francs per sheet in excess of 30 sheets.

(b) The amount of the designation fee for each designated State or each group of designated States for which the same regional patent is sought shall be: US\$40.00 or 60 Swiss francs.

Rule 57
The Handling Fee

57.2 Amount

(a) The amount of the handling fee shall be US\$50.00 or 75 Swiss francs augmented by as many times the same amount as the number of languages into which the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau.

(b) Where, because of a later election or elections, the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau into one or more additional languages, a supplement to the handling fee shall be payable and shall amount to US\$50.00 or 75 Swiss francs for each additional language.

[Annex III follows]

Amendments made to the Proposals of the Director General during Consultations with the receiving Offices and the International Searching and Preliminary Examining Authorities relating to Modifications of the Administrative Instructions

1. In this Annex, any reference to “Rule” is to a Rule of the Regulations under the Patent Cooperation Treaty (PCT), to “Section” is to a Section of the Administrative Instructions under the PCT, to “Annex” is to an Annex of the Administrative Instructions and to “form” is to a form annexed to those Administrative Instructions.

2. The following paragraphs reproduce the modifications of the Administrative Instructions only to the extent that the Director General amended his original proposals in the light of the consultations. The modifications not reproduced here were decided upon by the Director General in the form set out in Part III of document PCT/A/II/3.

Section 201(b)

3. Text as contained in document PCT/A/II/3 without amendment.

Section 203bis

4. Text as contained in document PCT/A/II/3 without amendment.

Section 317

5. Text as contained in document PCT/A/II/3, subject to replacing the words, “in the right hand margin adjacent to the designation so enclosed within square brackets,” by “in the margin” to provide greater flexibility to the receiving Office in indicating the deletion of a designation.

Section 412

6. The new Section 412 reads as follows:

“Section 412

“Fee for Copies of Certain Documents

“(a) The International Bureau shall make a charge of 6 Swiss francs to designated and elected Offices for a copy of any document cited in the international search report requested under Rule 44.3(c) or any document cited in the international preliminary examination report requested under Rule 71.2(c).

(b) When mailing by air is requested the actual cost of such mailing shall be additionally charged. ”

7. With respect to the proposed fee of 3 Swiss francs for copies of the priority document requested under Rule 17.2(a) (see Section 412 in paragraph 14 of document PCT/A/II/3), the representatives of several of the Offices being consulted requested the deletion of the proposed fee and none of the Offices being consulted spoke in favor of retaining that fee. The representative of the United States Patent and Trademark Office suggested, in this context, that, since the amount of the proposed fee was not large, it should be included in the designation fee. The representative of the Swiss Intellectual Property Office suggested that fees of such small amount were not practical because their administration would cost more than the revenue they produce; it was for this consideration that his Office objected to the proposed fee.

8. The International Bureau said that a separate fee was proposed because the possibility of a copy of the priority document being requested would not exist when the priority of an earlier application was not claimed and, in any event, would only apply when a request was made by the designated Office for the supply of the copy. It was too early to consider augmenting the designation fees in general for that purpose since only experience would show the number of cases in which a copy of the priority document would have to be supplied. A different level of the designation fee, depending on whether a copy of the priority document would be requested, was neither possible nor practical.

[9. In conclusion, the Director General stated that, in view of the objections raised during the consultations, he would, for the time being, promulgate the new Section 412 without the inclusion of the said fee but would revert to the matter at a later date either by taking up his original proposal or by making a new proposal on a different basis. Before doing so, a study would be made which would take into account the observations made during the consultations and the results of practical experience as to the situations and number of cases in which copies were requested and as to the number of Offices which made such requests not on a case-by-case but on an automatic basis.]

Section 503

10. Text as contained in document PCT/A/II/3 without amendment.

Annex C of the Administrative Instructions

11. Text as contained in document PCT/A/II/3 without amendment.

Form PCT/RO/101

12. The heading of Box II will read as follows:

“II. APPLICANT² (The data concerning each applicant named in Box IX must appear in this box or, to the extent that space is insufficient, in the supplemental box.) Additional information is contained in supplemental box. ☐”

13. In the heading of Box IX, the following text will be added:

“Where this box is used, all applicants indicated in Box II must be indicated in this box. Only applicants indicated in Box II can be indicated in this box.”

14. Furthermore, in Box IX “Name of Applicant” will be replaced by “Names of Applicants” and, in Box X, “Name of Inventor” will be replaced by “Names of Inventors. ”

15. Note 18 will be completed by the following sentences:

“Where Box IX is used, only those applicants may be indicated in it which are also indicated in Box II. All the applicants appearing in Box II must also be indicated in Box IX.

“Where the United States of America is one of the designated States, the applicant or applicants named in respect of the United States of America must be the inventor or inventors.”

Annex to Form PCT/RO/101

16. The proposal contained in paragraph 18 of document PCT/A/II/3 will be implemented with the proviso that the reverse side of the sheet will not be used.

Forms PCT/IB/301, 302, 308, 331 and 332

17. As contained in Annexes I to V of document PCT/A/II/3, subject to the correction of small errors of typing and presentation.

[End of Annex III and of document]

WIPO



PCT/A/III/11

ORIGINAL: English

DATE: May 1, 1979

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Third Session (2nd Extraordinary)
Geneva, April 25 to May 1, 1979

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly of the International Patent Cooperation (PCT) Union (herein- after referred to as “the Assembly”) held its third session (2nd extraordinary) in Geneva from April 25 to May 1, 1979.
2. The following 15 member States were represented at the session: Austria, Brazil, Denmark, France, Germany (Federal Republic of), Japan, Luxembourg, Madagascar, Netherlands, Romania, Soviet Union, Sweden, Switzerland, United Kingdom and United States of America.
3. The following six States participated in the session as special observers: Australia, Canada, Finland, Hungary, Norway and Spain, whereas the following four States were represented by observers: Czechoslovakia, Italy, Mexico and Niger.
4. One intergovernmental organization, the European Patent Organisation (EPO), participated in the session as a special observer and the following five international non-governmental organizations were represented by observers: Council of European Industrial Federations (CEIF), European Federation of Industrial Property Representatives of Industry (FEMIP), International Federation of Inventors Associations (IFIA), International Federation of Patent Agents (FICPI) and Union of Industries of the European Community (UNICE).

5. The number of participants was about 60. The list of participants is contained in Annex I to this Report.

OFFICERS OF THE SESSION

6. The Officers of the PCT Assembly are Mr. Valentin Bykov (Soviet Union), Chairman, and Messrs. H. E. Martin Nzue Nkoghe (Gabon) and Paul Braendli (Switzerland), Vice-Chairmen; Messrs. Bykov and Nkoghe were not present at the session. The session was chaired by Mr. Paul Braendli except for its closing meeting at which, in the absence of Mr. Braendli, Mr. Dieter Hoinkes (United States of America) acted as ad hoc Chairman.

7. Mr. E. M. Haddrick, Head, PCT Division, WIPO, acted as Secretary of the Assembly.

OPENING OF THE SESSION; ADOPTION OF THE AGENDA

8. In opening the session, the acting Chairman expressed the satisfaction of the Assembly at the fact that Australia, Monaco, the Netherlands and Romania had deposited instruments of ratification of the PCT since the second session of the Assembly in September/October 1978.

9. The Assembly adopted its agenda as contained in document PCT/A/III/1.Rev.

LEVEL OF FEES AND PRICES; FINANCIAL CONTRIBUTIONS

10. The Secretariat introduced document PCT/A/III/5 which proposed that the Assembly fix the fees, and note the raising of the price of the pamphlets and the Gazette, to the level which was contemplated before the entry into force of the PCT (see document PCT/A/III/5, paragraph 1) and which would be approximately 100% higher than the amount of the fees and prices in force at the present time.

11. Whereas it was generally considered that it was desirable that the fees and prices be set at a level which would produce an income for the PCT Union completely covering the expenses of that Union--that is, which would make the PCT Union "self supporting"--most of the Delegations which spoke on the subject expressed the view that an increase of approximately 100% at the present time would carry with it the danger that the number of international applications filed and PCT publications sold would, because of such a sudden and substantial increase in the fees and prices, be considerably less than the numbers expected and necessary for making the PCT Union self supporting. Invoking such considerations, the Delegations of Japan, Switzerland, the United Kingdom, the Soviet Union, Germany (Federal Republic of), France and Luxembourg proposed that the fees and prices should not be increased to the extent proposed by the International Bureau but to a lesser extent; some of the said Delegations made precise proposals as to the extent of the increases, none of them exceeding 50%. The Delegation of the United States of America urged the International Bureau to reduce the expenses so that it should be possible to completely cover them from the income that can be produced with the present fees and prices; the Secretariat responded that this was not possible since it already worked in the most economical way it was able to devise and with an understaffing that could not be prolonged. Several Delegations, in particular those

of the Soviet Union and the United States of America, asked that the Secretariat furnish detailed calculations in justification of the current expenses and the forecasts of the International Bureau in relation to the situation of the PCT; the Secretariat responded that the calculations developed in that respect by the PCT working Group on Budgetary Questions when planning the budgets of the PCT for 1978, 1979 and 1980, were still generally valid and that an experience longer than the present (merely ten months long) experience in the administration of the PCT operations was necessary for intelligently revising those calculations; consequently, the Director General agreed that the secretariat carry out and report on such a detailed calculation to the September 1980 session of the Assembly.

12. In view of the wish of the great majority of the Delegations to see the fees and prices raised as soon as practicable but to a much lesser extent than proposed in document PCT/A/III/5, the International Bureau made a new proposal, contained in document PCT/A/III/8. According to that proposal, the fees should be raised by 30% in Swiss francs as from July 1, 1979, and the prices by the same percentage as from January 1, 1980.

13. The Delegation of the United States of America stated that it would have preferred no increases whatsoever and, instead, the reduction of the expenses and proposed to leave any decision to the September 1979 session of the Assembly.

14. The Delegations of Switzerland, France, the United Kingdom, Sweden, the Netherlands, Romania, Austria, Germany (Federal Republic of), Luxembourg and Japan expressly approved the new proposal of the International Bureau, although the Delegations of the United Kingdom, Switzerland and the Netherlands said that they would have preferred a somewhat higher increase than 30%.

15. In conclusion, the Assembly, without opposition, decided to raise the fees (by approximately 30% as expressed in Swiss currency) as from August 1, 1979, as set forth in the Schedule of Fees, attached to the Regulations, which is contained in Annex II of this Report.* At the same time, the Assembly

(i) noted that the Director General would raise the prices of the pamphlets and the Gazette by approximately 30%, when expressed in Swiss francs, as from January 1, 1980,

(ii) decided that, barring unforeseen circumstances, it would let the new fees and prices remain in effect until the end of 1980 and that, at the latest in September 1980, the Assembly would examine the question of fees, prices and deficit-covering contributions,

(iii) authorized the International Bureau to cover, provisionally, from a loan, any deficit arising before the end of 1980 and not covered by the deficit-covering contributions already voted (see document PCT/A/III/5, paragraph 1).

16. The Assembly noted that the deficit likely to accumulate by the end of 1980 and not covered by the deficit-covering contributions already voted would be approximately 1,600,000 francs and authorized the Director General to ask the Assembly of the Madrid

* After having consulted with the representatives of the receiving Offices and the International Authorities, the Director General established the corresponding amounts in currencies other than Swiss currency (see Annex III to this Report) with effect from August 1, 1979.

Union to give a loan of that amount to the PCT Union. The PCT Union would pay the same interest on the loan as the Swiss Confederation pays to the Madrid Union on the amounts placed by that Union with the Swiss Confederation (3.75% per annum at the present time).

17. The Assembly also noted the contents--forecasts under certain assumptions for the years 1981 and 1982--of paragraph 4 of document PCT/A/III/8. It also noted the statement of the Director General according to which he would propose the voting of contributions to cover the repayment of the loan referred to in the preceding paragraph only if the repayment cannot be effected from the normal income (that is, other than contributions) of the PCT Union within a reasonable time after 1980, and that he would propose the voting of contributions to cover any deficit which may arise after 1980 only in connection with the fixing of the fees and prices applicable after 1980, that is, when the Assembly will fix such fees at its September 1980 session.

AMENDMENT OF THE PCT REGULATIONS

Amendments relating to fees

18. Discussions were based on documents PCT/A/III/2, 7 and 9.

19. Following a detailed discussion of the proposals of the International Bureau as contained in document PCT/A/III/2, and the proposals made by the Delegation of France, as contained in document PCT/A/III/7, and a consideration of the draft texts prepared by the International Bureau at the request of the Assembly, as contained in document PCT/A/III/9, the Assembly adopted, with effect on and from August 1, 1979, the amendments to Rules 15.1, 15.2, 15.3, 15.4, 15.5, 16.1, 57.1, 57.2, 57.3, 57.4, 57.5 and 57.6, and new Rule 96 and the Schedule of Fees referred to therein, as set out in Annex II.

20. The Assembly established in the following terms the directives referred to in Rules 15.2(d), 16.1(d) and 57.2(e), it being understood that, in the light of experience, the Assembly may at any time modify these directives:

(1) At the time of each ordinary session of the Assembly, the Director General shall proceed to the consultations referred to in Rules 15.2(b) and 57.2(c) and shall establish the amounts of the fees in currencies other than Swiss francs according to the exchange rates applicable on the first day of that session, so that their amounts correspond to the amounts of the fees expressed in Swiss currency. Where such adjustment would only slightly affect the income of the International Bureau, the Director General may decide not to proceed with it. Unless otherwise decided by the Assembly, any adjustment under this paragraph shall enter into force on the first day of the calendar year subsequent to the ordinary session referred to above.

(2) Where for more than 30 consecutive days, the exchange rate between Swiss currency and any other currency is by at least 5% higher, or by at least 5% lower, than the last exchange rate applied, any interested Office or Authority, using that currency may ask the Director General to newly establish the amount of the fees in that currency according to the exchange rate prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly, as provided in Rules 15.2(d) and 57.2(e).

(3) Where for more than 30 consecutive days, the exchange rate between Swiss currency and any other currency is by at least 10% higher, or by at least 10% lower, than the last exchange rate applied, the Director General shall, after consultation with the interested Office or Authority using that currency and as provided in Rules 15.2(d) and 57.2(e), as the case may be, newly establish the amount of fees in that currency according to the exchange rate prevailing on the day preceding the day on which the consultation is initiated by the Director General. Where such adjustment would only slightly affect the income of the International Bureau, the Director General may decide not to proceed with it.

(4) As far as the establishment of the search fee of any International Searching Authority in any currency other than the currency or currencies fixed by that Authority is concerned, the provisions of paragraphs (1) to (3) shall, to the extent applicable, be applied *mutatis mutandis*.

21. In the course of the establishment of the directives, the Delegation of the United Kingdom noted that it, and at least one other Delegation, had been of the view that in determining whether an exchange rate had exceeded a percentage for more than 30 days, an average exchange rate over that period should be used but, in view of the understanding stated at the beginning of paragraph 20, did not insist on any change at the present time.

22. The Assembly noted a statement by the Representative of the European Patent Organisation (EPO) that it was understood that the provisions under Rule 16.1(b) for consultations between only the receiving Office and the Director General would not preclude that where an International Searching Authority itself had to fix equivalent amounts of its search fee in several currencies, consultations should take place between that Authority and the Director General with a view to facilitating the application of similar principles in both cases.

23. The Assembly decided that the directives set forth in paragraph 20 would go into effect as from August 1, 1979.

Amendments relating to communication under Article 20

24. Discussions were based on paragraphs 4 to 8 of document PCT/A/III/4 concerning an interpretation of Rule 47.2 and paragraphs 9 to 12 concerning a proposed amendment of Rule 47.1(b) contained in the Annex to that document.

25. The Assembly discussed the interpretation of Rule 47 according to which the International Bureau uses, to the extent possible, copies of the pamphlet published under Rule 48.1(a) for the purposes of communications under Article 20. In the discussion the Representative of the EPO said that its Office was ready to accept the pamphlet for the purposes of the communication under Article 20 on the condition that the Office received four copies. The Delegation of the United States of America indicated that its Office could not accept the pamphlet for the said purpose since the pamphlet was printed on both sides of the sheet and as a designated Office should, in any event, receive a copy of the request. While no other Delegation which spoke said that it could not accept the pamphlet for the purposes of the communication, some supported the view that the designated Offices should receive a copy of the request particularly since the front page of the pamphlet does not reproduce all items of bibliographic data contained in the request. The Delegation of the Soviet Union said that it had asked for a copy of the request in very limited circumstances involving a special

situation concerning the inventor but otherwise fully accepted the pamphlet for the purposes of communication.

26. In response to a question from the Representative of CEIF concerning the use of a copy of the pamphlet by the applicant when he is required, under Article 22, to send a copy of the international application to the designated Office, the International Bureau said that, in practice, this question would arise only if the designated Office concerned had waived the requirements for communication under Article 20 with a view to obliging the applicant to provide a copy of the application. In practice, no problem arose since the two Offices which had made such a waiver had also requested, under Rule 47.1(e), that the copies of the documents which the International Bureau would have sent to that Office, be sent by it to the applicant. These copies were sent with the notice it sends to the applicant to indicate the designated Offices to which the communication has been effected. The Offices concerned had accepted the copy of the pamphlet which the International Bureau sends to the applicant for this purpose.

27. In response to a question by the Delegation of Japan, the International Bureau said that a separate power of attorney submitted in connection with an International application did not form part of the communication under Article 20. The only apparent purpose for asking for a copy of this document would be to check the proper signing of the application but it was provided in Article 27(2) that the designated Office could require the confirmation of the international application by the signature of the applicant where it had been originally signed by an agent. If the designated Office should have any doubts, it should act under the faculty provided by Article 27(2).

28. After it was proposed to adopt the new Rule 47.2(c) contained in Annex II, the International Bureau indicated that, in the interests of obtaining acceptance of uniform administrative procedures, it would be prepared to print copies of the pamphlet on one side of the sheet only for the purposes of communication to the designated Offices if the proposed amendment were adopted. Also it would be prepared to study with those Offices wishing to receive a copy of the request to see whether, by making additions to the bibliographic information contained on the front page of the pamphlet, all Offices could accept the pamphlet alone for the purposes of communication.

29. The Assembly adopted the new Rule 47.2(c) set out in Annex II with effect on and from May 1, 1979. At the same time, the Assembly decided to recommend, in the light of the declaration of the International Bureau, that all designated Offices accept the pamphlet as sufficient for the purposes of communication under Article 20 and to invite the International Bureau to contact the Offices of those Contracting States which had indicated an interest in different bibliographical data being included on the front page of the pamphlet in order to determine their needs and to see if they could be satisfied by a restructuring of the pamphlet. The International Bureau should report on the results of its enquiries to the next session of the Assembly.

30. In response to a question from the Delegation of Japan as to the interpretation of Rule 47.3, the International Bureau said that it was required primarily to communicate the international application in its language of publication. The designated Offices, nevertheless, had the option, under the said Rule, of specially requesting the communication of the international application in the language in which it was filed or in both the language in which it was published and the language in which it was filed. The International Bureau would, of

course, for those Offices making a special request to that effect, communicate a special copy of the international application in the language of filing in those cases where the pamphlet was an English translation of the original application. For the time being, this question could arise with respect to applications filed in the Danish, Dutch or Swedish languages. It was hoped that the designated Offices would show restraint and only require the International Bureau to make and send copies where there was a real need for them.

31. The Assembly considered the proposal of the International Bureau for the amendment of Rule 47.1 (b). Upon the proposal of several Delegations, the assembly decided to amend Rule 47.1(b) in a form in which, instead of maintaining the existing time limits and merely permitting the International Bureau to delay communication to the time of international publication, communication upon international publication and at the latest by the end of the 19th month after the priority date would be the main principle. The Assembly then adopted the amendment of the said Rule set out in Annex II, with effect on and from May 1, 1979.

Other amendments to the Regulations

32. Having regard to the lack of time for it to consider the other amendments of the PCT Regulations contained in the Annex to document PCT/A/III/4 and relating to Rules 18, 32^{ter}, 54 and 74^{ter}, and considering that those amendments were mainly concerned with communications between the PCT Authorities, the Assembly decided to defer consideration of the other proposed amendments until its next session, at which the International Bureau might present them again, if it so wished, together with other amendments, if any, which it thought desirable for it to present to that session.

Proposals for possible amendments to the Regulations under the PCT and the Regulations under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

33. This item of the agenda was considered in a joint session with the Interim Advisory Committee for the Preparation of the Entry Into Force of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (Budapest Treaty), under the chairmanship of the Chairman of the Assembly. Discussions were based on documents PCT/A/III/3 and BP/IAC/II/2.

34. Rule 13bis.1(a) and (b) of the PCT Regulations. The Delegations of the United Kingdom and the United States of America said that the problems dealt with in paragraphs (a) and (b) of draft Rule 13bis.1 were exclusively a matter for national law, as they related to sufficiency of disclosure. Moreover the draft might, if it were adopted, mislead the applicant, leading him to believe that compliance with the formalities provided for in paragraph (b) would automatically protect him against rejection of the application, whereas in fact that could at best be true in the international phase, but certainly not in the national phase. Both Delegations added that the applicant had in any case to comply with national requirements, in particular those concerning the time of deposit and the time at which reference to the deposit should be made in the application. They further said that paragraph (b) of draft Rule 13bis.1, which provided that certain indications, such as the indication of the name of the depositary institution and that of the date of receipt of the microorganism by that institution, could be furnished after the filing of the international application, was in conflict with their national law, and that a rule of the PCT should not override provisions of national law on matters of substantive law. However, the Delegation of the United Kingdom agreed that it would

perhaps be necessary to include a provision in the PCT Regulations to cover the case of international applications relating to microbiological inventions, and the Delegation of the United States of America said that it would be ready to cooperate in finding an acceptable solution enabling the inclusion of such a provision in the PCT Regulations.

35. The Delegation of France said that it did not have any formal objection to the inclusion of Rule 13*bis* in the PCT Regulations, but that it had doubts as to the need for such a provision.

36. The Delegation of Japan expressed misgivings concerning the last sentence of paragraph (b) of draft Rule 13*bis*.1. In Japan the furnishing of the three indications referred to in that sentence was required at the time of filing the application, as it concerned substantive conditions of patentability, and the application was rejected if the indications were furnished not at the time of the application but only later.

37. The Delegations of Switzerland, the Federal Republic of Germany, Sweden, Norway, Spain, Denmark, the Netherlands, Finland and Hungary and the Representative of the European Patent Organisation, said that in their opinion it was very useful and, in the view of certain of those Delegations, even necessary, to have a provision on the lines of the proposed Rule 13*bis* in the PCT Regulations. The Delegation of the Netherlands expressed, however, its preference for a wording of Rule 13*bis*.1(b) which would not prescribe any time limit. The Delegation of Switzerland in particular expressed the view that draft Rule 13*bis* contained provisions concerning the form and content of the international application, and that to that extent the PCT overrode national law. It added that, if the PCT Regulations did not contain such provisions, applicants would be in danger of being unable to use the PCT for their applications relating to microbiological inventions. The Secretariat subscribed to the statement made by the Delegation of Switzerland.

38. The Delegation of the Soviet Union said that it was advisable to include provisions on international applications relating to microbiological inventions in the PCT Regulations, but that, in the light of the discussion, it found it difficult to accept the wording proposed for Rule 13*bis*.1(a).

39. The Delegation of Sweden said that paragraph (b) of draft Rule 13*bis*.1 could be so worded as to include the maximum of the possible requirements of designated States; moreover, the last sentence of the paragraph should be deleted or should refer only to the accession number of the deposit.

40. Rule 13*bis*.1(c) of the PCT Regulations. The Delegations of the United Kingdom and Sweden said that they saw no reason for including draft Rule 13*bis*.1(c) in the PCT Regulations.

41. The Representative of IFPMA expressed doubts as to the inclusion of draft Rule 13*bis*.1(c) in the PCT Regulations, as that draft provision did not seem to meet the same needs as Rule 11.1 of the Budapest Treaty Regulations.

42. Rule 13*bis*.2 of the PCT Regulations. The Delegation of the United States of America had doubts as to the usefulness of the reference to the Budapest Treaty in Rule 13*bis*.2.

43. The Delegation of Sweden felt it would be useful if the International Bureau were to publish in the PCT Gazette the full list of depositary institutions recognized by each PCT member State.

44. Rule 13bis.3 of the PCT Regulations. The Delegation of France stated that the first sentence of draft Rule 13bis.3 meant that no sample of a deposited microorganism could be communicated to a third party during the period between international publication and the start of the national phase, whereas under French law the applicant could, under certain conditions, enjoy provisional protection as from international publication, but that the microorganism had to be made available to the person in respect of whom the applicant wished to enjoy such provisional protection.

45. The Secretariat, supported by the Delegation of Switzerland, observed that during the period of time from international publication to the start of the national phase there was no competent authority to authorize the furnishing of a sample of the microorganism. The Delegation of Switzerland added that, in order to enjoy provisional protection in France during the period in question, the applicant had himself to authorize the furnishing of a sample to the third party concerned.

46. In answer to a question by the Delegation of the United Kingdom, the Secretariat explained that the first sentence of the English version of draft Rule 13bis.3 ought to be reworded to make it clear that the reference to Rule 13bis.1 concerned the microorganism and not the furnishing of samples.

47. The Delegation of Sweden pointed out that draft Rule 13bis.3 was possibly not in harmony with draft Rule 13bis.1(c) since the latter permitted samples of deposited microorganisms to be furnished prior to the date stipulated by draft Rule 13bis.3 as the moment before which samples could not be furnished.

48. Rule 11 of the Budapest Treaty Regulations. The Delegation of the United Kingdom considered that there was no real necessity for amending Rule 11.1 of the Budapest Treaty Regulations as proposed to extend its application to the designated Offices under the PCT and that this question should be regulated by national law.

49. Future procedure. It was unanimously agreed that the time was not yet ripe to take decisions on the proposed new Rule 13bis of the PCT Regulations or on any amendments to Rule 11 of the Budapest Treaty Regulations, and that the following procedure should be applied:

(i) all member States of the PCT Union and all member States of the Interim Advisory Committee for the Preparation of the Entry Into Force of the Budapest Treaty would be invited to submit to the International Bureau by August 1, 1979, written comments on the proposals for a new Rule 13bis of the PCT Regulations and on the proposals for amendments to Rule 11 of the Budapest Treaty Regulations, contained in Annex A to documents PCT/A/III/3 and BP/IAC/II/2; the same invitation would be extended to the EPO. The comments should, in particular, state very clearly the elements of the above-mentioned proposals deemed unacceptable because they were considered to be the exclusive domain of substantive law reserved for national legislation;

(ii) the International Bureau should write a special letter to the International Searching Authorities and to the International Preliminary Examining Authorities to ask them to state, by August 1, 1979, also, whether and, if so, when they might have need of samples of microorganisms;

(iii) in the light of the comments received, the International Bureau should endeavor to draw up new proposals;

(iv) subsequently, the PCT and Budapest Treaty Working Group should be convened by the Director General of WIPO with the task of drawing up new proposals on the basis of the debates recorded in this report and of any new proposals by the International Bureau. In addition to the intergovernmental organizations concerned, the international non-governmental organizations representing the interested circles should be invited, exceptionally, to the Working Group's session, as had been done for its first session;

(v) the proposals drawn up by the above-mentioned Working Group would be submitted to a subsequent session of the PCT Assembly and the Interim Committee meeting once more in joint session.

Other matters discussed during consideration of amendments

50. In the course of the discussion of the level of fees and various amendments to the Regulations, it was suggested that the International Bureau should consider ways to facilitate the use of the PCT by applicants. The Representative of UNICE said that he was disappointed that the potential of the PCT, which was sometimes said by potential users to be too complicated, had not yet been put to full use by them. Efforts should be undertaken by all concerned, the Contracting States, the International Bureau and the organizations representing users of the system, to define and overcome the obstacles to the full use of the PCT. Lack of sufficient information was one of the problems to be considered. The level of fees was another important factor in this context. A further problem was that the geographical coverage of the system so far had not been sufficient to enable the PCT to be regarded by users as being as natural a procedure as using the Paris Convention itself, notwithstanding the fact that the PCT had been the greatest advance since the adoption of that Convention.

51. The Director General said that thought had already been given to the assembling of information specific to the national laws of Contracting States which would facilitate the entry of the national phase by applicants. This information could possibly be published in some connection with the PCT Applicant's Guide. Certain Delegations said that attention should be given to simplifying some of the provisions governing the processing of applications by applicants. The Director General said that many of the provisions which were sometimes categorized as complexities had been included with a view to providing sufficient guarantees to the applicant. The Assembly invited the Director General to keep under review questions affecting the use of the PCT system by applicants, to proceed with the proposed work relating to national requirements and to invite both the Governments and the international organizations representing the users of the PCT system to make specific proposals which could lead to a simplification of the system without necessitating a revision of the Treaty and without prejudicing the safeguards contained in the PCT for applicants.

APPOINTMENT OF THE AUSTRALIAN PATENT OFFICE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY AND APPROVAL OF THE AGREEMENT BETWEEN THAT OFFICE AND THE INTERNATIONAL BUREAU

52. Discussions were based on document PCT/A/III/6, containing the initialled text of a draft Agreement between the International Bureau and the Patent Office of the Government of Australia and copies of an Exchange of Notes between the International Bureau and the Australian Permanent Mission in Geneva.

53. The Delegation of Australia recalled that its country's association with the Patent Cooperation Treaty had begun with the early preparations for the conclusion of the Treaty and had continued through the Washington Diplomatic Conference to the present time. Its country had always recognized the potential of the PCT for the rationalization of patent procedures in the interests of both applicants and Patent Offices and, in this respect, its enormous potential as an aid to the development of patent systems in developing countries, as well as its potential for the facilitation of the international transfer of technology to the benefit of all countries. The full potential of the PCT would, however, only be realized when most countries, whether developing or developed, were members and, for this reason, its Government believed that to delay in joining the Treaty was tantamount to delaying its success.

54. It had been decided by the Government of Australia that it would seek the appointment of its Patent Office as an International Searching Authority and International Preliminary Examining Authority. In doing so, it had taken into account present and foreseeable needs for such services in the South East Asia/South Pacific region, the population of which equalled that of other regions served by more than one such PCT Authority and having regard to the advantages of the regionalization of such activities. At the present time, there was no PCT Authority in the whole of the Southern hemisphere. If the Office should be appointed, it would offer its facilities as a PCT Authority also to the developing countries. In this regard it had in mind particularly the developing countries of South East Asia and the South Pacific, if they should wish, in due course, to use those facilities.

55. The Australian Patent Office was comparable, in terms of its national functions and responsibilities, with some other national Patent Offices which had been appointed as PCT Authorities. It was a Patent Office which followed in a long tradition of examining Offices, the first such Office in Australia having been established more than 130 years ago and the present Office itself having taken over, at the time of the Australian Federation, the functions of that and other such offices and having itself performed such functions for over 75 years. The Office had a staff which greatly exceeded, in terms of numbers of qualified staff and language facilities, the PCT minimum requirements. The Office had the required PCT minimum documentation.

56. The Delegation added that it was the intention of its Government to introduce into its national Parliament the legislation necessary for implementation of the PCT and for its Patent Office to function as an International Searching and Preliminary Examining Authority. Present planning was based on all legal requirements being met in time to enable the Treaty to come into operation in Australia on January 1, 1980. Thus, it was expected that the necessary legislation would be introduced in Parliament by June and passed not later than August of this year.

57. The Chairman stated that the appointment was sought before the deposit of the instrument of accession and before the signature of the Agreement with the International Bureau contained in Annex I to document PCT/A/III/6. The Assembly could, therefore, make the requested appointment subject to the conditions specified in paragraph 8 of the said document.

58. The Delegation of the Netherlands said that it welcomed the prospective accession by Australia to the PCT and that it would be useful and desirable to have another International Searching and Preliminary Examining Authority in Australia's part of the world. However, even though it was confident that the Patent Office of Australia would be in a position to fulfil its obligations at the time the proposed appointment would take effect, more information should be supplied as to compliance with the PCT minimum requirements. In the case of previous appointments, more information had been available through the participation of the Offices concerned in the PCT Interim Committee for Technical Cooperation.

59. The Delegation of Australia said that the Patent Office of its country had 140 examiners and, in addition, a further 80 technically qualified members on its staff. Its documentation greatly exceeded the PCT minimum in terms of coverage and arrangements for proper access to it for purposes of search under the PCT had been in the process of being completed for some time. These and other organizational arrangements had been and would be continued in order to assure the proper performance of the functions of the Office in full compliance with the requirements of the PCT by the time the proposed appointment would take effect. The Assembly could be confident that its country would not have undertaken the commitments made in the draft Agreement and Exchange of Notes unless it was sure of meeting them fully by the time of entry into force of the Treaty for Australia.

60. Upon questions raised by the Delegations of the Netherlands and France as to whether the Committee for Technical Cooperation should be convened in order to seek its advice before making the proposed appointment, the Assembly, as in the case of the previous appointments of International Searching Authorities and International Preliminary Examining Authorities made by it, did not consider it necessary to seek the advice of that Committee.

61. The Delegations of the Soviet Union, Austria, the United Kingdom, Japan, Romania and Germany (Federal Republic of) supported the proposed appointment and the approval of the draft Agreement.

62. The Assembly decided,

(i) to approve the Agreement between the Patent Office of the Government of Australia and the International Bureau contained in Annex I to document PCT/A/III/6,

(ii) to note the Exchange of Notes contained in Annex II to the said document, and

(iii) to appoint the said Office as an International Searching Authority and International Preliminary Examining Authority for a period of ten years from the date of entry into force of the Agreement referred to above, it being understood that such appointment will only take effect when both of the following conditions are fulfilled:

(a) the said draft Agreement has been signed by both parties without modification of the text approved by the Assembly, according to the intention of both parties reflected in the Exchange of Notes contained in Annex II and subject only to the exception referred to in that Exchange of Notes;

(b) the Government of Australia deposits its instrument of accession to the PCT.

PARTICIPATION OF SPAIN IN THE PCT

63. The Delegation of Spain made a declaration in which it said that, although its country had not signed the PCT, it nevertheless did not wish to be separated, in the long run, from such an important Treaty. Consequently, Spain had sought participation in the Interim Committees and had made voluntary contributions to the PCT budget while the PCT was still not yet in force. The competent Spanish Authorities had considered, at a meeting with the Director General in the previous year in Madrid, possible solutions to language questions which would facilitate Spain's accession to the PCT. These solutions would probably lead to proposals for changes to the PCT Regulations. At present, the Spanish industrial property administration was preparing proposals to the Spanish Government on accession to the PCT and the necessary amendments of the national legislation. Once these preparations had been completed, more precise indications would be given to the Assembly concerning concrete proposals relating to Spain's full participation in the Treaty.

ADOPTION OF THE REPORT

64. The Assembly unanimously adopted this Report at its closing meeting on May 1, 1979.

[Annexes follow]

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS

(in the English alphabetical order of the names of the States)
(dans l'ordre alphabétique anglais des noms des Etats)

I. MEMBER STATES/ETATS MEMBRES

AUSTRIA/AUTRICHE

Dr. O. LEBERL, President, Austrian Patent Office, Vienna

BRAZIL/BRESIL

Mr. A. WESTPHALEN, Counsellor, Permanent Delegation, Geneva

DENMARK/DANEMARK

Mr. K. SKJØDT, Director, Patent and Trademark Office, Copenhagen

Mrs. D. SIMONSEN, Head of Division, Patent and Trademark Office, Copenhagen

FRANCE

M. P. GUERIN, Attaché de direction, Institut national de la propriété industrielle, Paris

GERMANY (FEDERAL REPUBLIC OF) /ALLEMAGNE (REPUBLIQUE FEDERALE D')

Mr. U. C. HALLMANN, Leitender Regierungsdirektor, German Patent Office, Munich

JAPAN/JAPON

Mr. K. MATSUIE, Engineer General, Japanese Patent Office, Tokyo

Mr. S. UEMURA, First Secretary, Permanent Mission, Geneva

LUXEMBOURG

M. J.-P. HOFFMANN, Directeur, Service de la propriété industrielle, Luxembourg

MADAGASCAR

M. S. RABEARIVELO, Conseiller, Mission permanente, Genève

NETHERLANDS/PAYS-BAS

Mr. J. DEKKER, President, Netherlands Patent Office, Rijswijk

Mr. H. PIETERS, Advisor on Industrial Property, Ministry of Economic Affairs, The Hague

Mr. J. TAK, Extraordinary Member of Patent Board, Netherlands Patent Office, Rijswijk

ROMANIA/ROUMANIE

M. I. MARINESCU, Directeur adjoint, Office d'Etat pour les inventions et les marques,
Bucarest

Dr. V. TUDOR, Conseiller, Mission permanente, Genève

SOVIET UNION/UNION SOVIETIQUE

Mr. L. KOMAROV, First Deputy Chairman, USSR State Committee for Inventions and
Discoveries, Moscow

Mr. E. BURYAK, Head, International Patent Cooperation Division, All-Union Research
Institute of State Patent Examination, Moscow

Mr. K. SAENKO, Counsellor, Permanent Mission, Geneva

SWEDEN/SUEDE

Mr. G. BORGGÅRD, Director General, Royal Patent and Registration Office, Stockholm
Mr. S. LEWIN, Deputy Director General, Royal Patent and Registration Office, Stockholm
Mrs. B. SANDBERG, Legal Advisor, Royal Patent and Registration Office, Stockholm

SWITZERLAND/SUISSE

M. P. BRAENDLI, Directeur, Office fédéral de la propriété intellectuelle, Berne
M. R. KÄMPF, Chef de section, Office fédéral de la propriété intellectuelle, Berne

UNITED KINGDOM/ROYAUME-UNI

Mr. R. BOWEN, Assistant Comptroller, Patent Office, London
Mr. A. J. NEEDS, Principal Examiner, Patent Office, London

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Mr. H. D. HOINKES, Legislative and International Patent Specialist, United States Patent and Trademark Office, Washington D.C.
Mr. L. MAASSEL, Patent Procedure Specialist, United States Patent and Trademark Office, Washington, D.C.

II. OBSERVERS/OBSERVATEURS

AUSTRALIA/AUSTRALIE

Dr. L. THOMPSON, Ambassador, Permanent Mission, Geneva
Mr. F. J. SMITH, Commissioner of Patents, Patent Office, Canberra
Ms. H. FREEMAN, First Secretary, Permanent Mission, Geneva

CANADA

Mr. E. W. BOWN, Patent Examiner, Bureau of Intellectual Property, Department of Consumer and Corporate Affairs, Hull, Quebec

CZECHOSLOVAKIA/TCHÉCOSLOVAQUIE

Mr. J. CIZEK, Second Secretary, Permanent Mission, Geneva

FINLAND /FINLANDE

Mr. P. SALMI, Head, Patent Department, National Board of Patents and Registration, Helsinki

HUNGARY/HONGRIE

Dr. Z. SZILVASSY, Vice-President, National Office of Inventions, Budapest
Mrs. E. PARRAGH, Counsellor, National Office of Inventions, Budapest

ITALY/ITALIE

M. I. PAPINI, Ministre plénipotentiaire, Délégué aux accords pour la propriété intellectuelle, Ministère des affaires étrangères, Rome
M. S. SAMPERI, Directeur, Office Central des brevets, Ministère de l'Industrie et du Commerce, Rome
Mlle M. PUGLISI, Deuxième secrétaire, Mission permanente, Genève

MEXICO/MEXIQUE

Sra O. REYES-RETANA, Ministro Consejero, Misión permanente, Ginebra
Sra M. F. IZE de CHARRIN, Attaché, Misión permanente, Ginebra

NIGER

Mr. I. FOUKORI, Chef de Division, Ministère des affaires économiques, du commerce et de l'industrie, Direction de l'industrie et de l'artisanat, Niamey

NORWAY/NORVEGE

Mr. A. G. GERHARDSEN, Director General, The Norwegian Patent Office, Oslo
Mr. P. T. LOSSIUS, Deputy Director General, The Norwegian Patent Office, Oslo
Mr. I. LILLEVIK, Head of Division, The Norwegian Patent Office, Oslo

SPAIN/ESPAGNE

Sr. J. DELICADO MONTERO-RIOS, Director, Departamento Estudios y Relaciones Internacionales, Registro de la Propiedad Industrial, Madrid
Sr. J. M. GARCIA OYAREGUI, Director, Departamento de Patentes y Modelos, Registro de la Propiedad Industrial, Madrid

III. INTERGOVERNMENTAL ORGANIZATIONS
ORGANISATIONS INTERGOUVERNEMENTALES

EUROPEAN PATENT ORGANISATION (EPO)/ORGANISATION EUROPEENNE DES BREVETS (OEB)

Dr. U. SCHATZ, Directeur principal, Direction des Affaires internationales, Office européen des brevets, Munich
Mme L. GRUSZOW, Administrateur, Direction des Affaires internationales, Office européen des brevets, Munich

IV INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS
ORGANISATIONS INTERNATIONALES NON-GOUVERNEMENTALES

COUNCIL OF EUROPEAN INDUSTRIAL FEDERATIONS (CEIF)/CONSEIL DES FEDERATIONS INDUSTRIELLES D'EUROPE (CIFE)

Mr. M. van DAM, Patent Agent, Eindhoven, Netherlands

EUROPEAN FEDERATION OF INDUSTRIAL PROPERTY REPRESENTATIVES OF INDUSTRY/FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN PROPRIETE INDUSTRIELLE (FEMIP)

Dr. C. GUGERELL, International Patent Department, Scherico Ltd., Lucerne, Switzerland

INTERNATIONAL FEDERATION OF INVENTORS ASSOCIATIONS (IFIA)/FEDERATION INTERNATIONALE DES ASSOCIATIONS D'INVENTEURS

Mr. P. FELDMANN, Engineer, Opfikon-Glattbrugg, Switzerland

INTERNATIONAL FEDERATION OF PATENT AGENTS/FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE (FICPI)

M. E. GUTMANN, Conseil en brevets d'invention, Cabinet Plasseraud, Paris, France

UNION OF INDUSTRIES OF THE EUROPEAN COMMUNITY/UNION DES
INDUSTRIES DE LA COMMUNAUTE EUROPEENNE (UNICE)

Mr. C. G. WICKHAM, Chairman, Industrial Property Panel, Confederation of British
Industry, London, United Kingdom

Dr. R. KOCKLÄUNER, Patent Assessor, Hoechst AG, Wiesbaden, Germany (Federal.
Republic of)

V. OFFICERS/BUREAU

Acting Chairman/Président par intérim: M. P. BRAENDLI (Switzerland/Suisse)
Secretary/Secrétaire: Mr. E. M. HADDRICK (WIPO/OMPI)

VI. INTERNATIONAL BUREAU OF WIPO/
BUREAU INTERNATIONAL DE L'OMPI

Dr. A. BOGSCH, Director General
Mr. K. PFANNER, Deputy Director General
Mr. M. PEREYRA, Head, Administrative Division
Mr. E. M. HADDRICK, Head, PCT Division
Mr. J. FRANKLIN, Deputy Head, PCT Division
Mr. D. BOUCHEZ, Head, PCT Publications Section
Mr. M. LAGESSE, Head, Budget and Systems Section
Mr. N. SCHERRER, Head, PCT Fees, Sales and Statistics Section
Mr. V. TROUSSOV, Senior Counsellor, PCT Division
Mr. A. OKAWA, Counsellor, PCT Examination Section

[Annex II follows/
L'annexe II suit]

ANNEX II

Rule 15
The International Fee

15.1 Basic Fee and Designation Fee

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau (“international fee”) to be collected by the receiving Office and consisting of,

- (i) a “basic fee,” and
- (ii) as many “designation fees” as there are national patents and regional patents sought by the applicant in the international application, except that, where Article 44 applies in respect of a designation, only one designation fee shall be due.

15.2 Amounts

- (a) The amounts of the basic fee and of the designation fee are as set out in the Schedule of Fees.
- (b) The amounts of the basic fee and of the designation fee shall be established, for each receiving Office which, under Rule 15.3, prescribes the payment of those fees in a currency or currencies other than Swiss currency, by the Director General after consultation with that Office and in the currency or currencies prescribed by that Office (“prescribed currency”). The amounts in each prescribed currency shall be the equivalent, in round figures, of the amounts in Swiss currency set out in the Schedule of Fees. They shall be published in the Gazette.
- (c) Where the amounts of the fees set out in the Schedule of Fees are changed, the corresponding amounts in the prescribed currencies shall be applied from the same date as the amounts set out in the amended Schedule of Fees.
- (d) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish new amounts in the prescribed currency according to directives given by the Assembly. The newly established amounts shall become applicable two months after the date of their publication in the Gazette, provided that the interested Office and the Director General may agree on a date falling during the said two-month period in which case the said amounts shall become applicable for that Office from that date.

15.3 Mode of Payment

The international fee shall be payable in the currency or currencies prescribed by the receiving Office, it being understood that, when transferred by the receiving Office to the International Bureau, the amount transferred shall be freely convertible into Swiss currency.

15.4. Time of Payment

- (a) Subject to paragraph (c) , the basic fee shall be due on the date of receipt of the international application.

(b) Subject to paragraph (c), the designation fee shall be paid on the date of receipt of the international application or on any later date prior to the expiration of one year from the priority date.

(c) The receiving Office may permit applicants to pay either the basic fee or the designation fee or both of the fees later than on the dates provided for in paragraphs (a) and (b), provided that:

(i) permission shall not be given to pay the basic fee or the designation fee later than one month after the date of receipt of the international application;

(ii) permission may not be subject to any extra charge.

Such later payment of the said fees shall be without loss, in the case of the basic fee, of the international filing date, or, in the case of the designation fee, of the designations to which the payment relates.

15.5 Partial Payment

(a) Where the amount of the international fee received by the receiving Office is not less than that of the basic fee and at least one designation fee but less than the amount required to cover the basic fee and all the designations made in the international application, the amount received shall be applied as follows:

(i) to cover the basic fee, and

(ii) to cover as many designation fees as, after deduction of the basic fee, may be covered in full by the amount received in the order indicated in paragraph (b).

(b) The order in which the said amount shall be applied to the designations shall be established as follows:

(i) where the applicant indicates to which designation or designations the amount is to be applied, it shall be applied accordingly but, if the amount received is insufficient to cover the designations indicated, it shall be applied to as many designations as are covered by it in the order chosen by the applicant in indicating the designations;

(ii) to the extent that the applicant has not given the indications under item (i), the amount or the balance thereof shall be applied to the designations in the order in which they appear in the international application;

(iii) where the designation of a State is for the purposes of a regional patent and provided that the required designation fee is, under the preceding provisions, available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.

15.6 [No change]

Rule 16

The Search Fee

16.1 Right to Ask for a Fee

(a) [No change]

(b) The search fee shall be collected by the receiving Office. The said fee shall be payable in the currency or currencies prescribed by that Office (“the receiving Office currency”) , it being understood that, if any receiving Office currency is not that, or one of those, in which the International Searching Authority has fixed the said fee (“the fixed currency or currencies”), it shall, when transferred by the receiving Office to the International Searching Authority, be freely convertible into the currency of the State in which the International Searching Authority has its headquarters (“the headquarters currency”). The amount of the search fee in any receiving Office currency, other than the fixed currency or currencies/shall be established by the Director General after consultation with that Office. The amounts so established shall be the equivalents, in round figures, of the amount established by the International Searching Authority in the headquarters currency. They shall be published in the Gazette.

(c) Where the amount of the search fee in the headquarters currency is changed, the corresponding amounts in the receiving Office currencies, other than the fixed currency or currencies, shall be applied from the same date as the changed amount in the headquarters currency.

(d) Where the exchange rate between the headquarters currency and any receiving Office currency, other than the fixed currency or currencies, becomes different from the exchange rate last applied, the Director General shall establish the new amount in the said receiving Office currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that any interested receiving Office and the Director General may agree on a date falling during the said two-month period in which case the said amount shall become applicable for that Office from that date.

(e) Where, in respect of the payment of the search fee in a receiving Office currency, other than the fixed currency or currencies, the amount actually received by the International Searching Authority in the headquarters currency is less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

(f) As to the time of payment of the search fee, the provisions of Rule 15.4 relating to the basic fee shall apply.

16.2: [No change]

16.3: [No change]

Rule 47
Communication to Designated Offices

47.1 Procedure

- (a) [No change]
- (b) Such communication shall be effected promptly after the international publication of the international application and, in any event, by the end of the 19th month after the priority date. Where the time limit under Rule 46.1 has not expired when the communication is effected and the International Bureau has neither received amendments from the applicant nor a declaration that the applicant does not wish to make amendments before the International Bureau, the International Bureau shall/at the time of the communication, notify the applicant and the designated Offices accordingly; it shall, immediately after receipt, communicate any amendment received subsequently to the designated Offices and notify the applicant accordingly. Where, under Article 17(2) (a), the International Searching Authority has made a declaration that no international search report will be established, the communication shall be effected, unless the international application is withdrawn, within 1 month from the date on which the International Bureau has been notified of the said declaration by the International Searching Authority; such communication shall be accompanied by an indication of the date of the notification sent to the applicant under Article 17(2) (a).

(c) [No change]

(d) [No change]

(e) [No change]

47.2 Copies

(a) [No change]

(b) [No change]

(c) Except to the extent that any designated Office notifies the International Bureau otherwise, copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20.

Rule 57
The Handling Fee

57.1 Requirement to Pay

(a) Each demand for international preliminary examination shall be subject to the payment of a fee for the benefit of the International Bureau ("handling fee") to be collected by the International Preliminary Examining Authority to which the demand is submitted.

(b) Where, because of a later election or elections, the international preliminary examination report must, in application of Article 36(2), be translated by the International

Bureau into one or more additional languages, a “supplement to the handling fee” shall be collected by the International Bureau.

57.2 Amounts of the Handling Fee and the Supplement to the Handling Fee

(a) The amount of the handling fee is as set out in the Schedule of Fees. The amount payable in any particular case shall be the amount as so set out, increased by as many times the same amount as the number of languages into which the international preliminary examination report must, in application of Article 36(2), be translated by the International Bureau.

(b) The amount of the supplement to the handling fee is as set out in the Schedule of Fees. The amount payable in any particular case shall be the amount as so set out, multiplied by the number of additional languages referred to in Rule 57.1(b).

(c) The amount of the handling fee shall be established for each International Preliminary Examining Authority which, under Rule 57.3(c) , prescribes the payment of the handling fee in a currency or currencies other than Swiss currency, by the Director General after consultation with that Authority and in the currency or currencies prescribed by that Authority ("prescribed currency"). The amount in each prescribed currency shall be the equivalent, in round figures, of the amount of the handling fee in Swiss currency set out in the Schedule of Fees. The amounts in the prescribed currencies shall be published in the Gazette.

(d) Where the amount of the handling fee set out in the Schedule of Fees is changed, the corresponding amounts in the prescribed currencies shall be applied from the same date as the amount set out in the amended Schedule of Fees.

(e) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new amount in the prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that the interested International Preliminary Examining Authority and the Director General may agree on a date falling during the said two-month period in which case the said amount shall become applicable for that Authority from that date.

57.3 Time and Mode of Payment

(a) The handling fee shall be due at the time the demand is submitted.

(b) Any supplement to the handling fee shall be due at the time the later election is submitted.

(c) The handling fee shall be payable in the currency or currencies prescribed by the International Preliminary Examining Authority to which the demand is submitted, it being understood that, when transferred by that Authority to the International Bureau, it shall be freely convertible into Swiss currency.

(d) Any supplement to the handling fee shall be payable in Swiss currency.

57.4 Failure to Pay (Handling Fee)

(a) Where the handling fee is not paid as required, the International Preliminary Examining Authority shall invite the applicant to pay the fee within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the prescribed time limit, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the fee, unless, under Rule 60.1(b), a later date is applicable.

(c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.

57.5 Failure to Pay (Supplement to the Handling Fee)

(a) Where the supplement to the handling fee is not paid as required, the International Bureau shall invite the applicant to pay the supplement within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the prescribed time limit, the later election shall be considered as if it had been received on the date on which the International Bureau receives the supplement, unless, under Rule 60.2(b), a later date is applicable.

(c) If the applicant does not comply with the invitation within the prescribed time limit, the later election shall be considered as if it had not been submitted.

57.6 Refund

In no case shall the handling fee, or the supplement to the handling fee, be refunded.

Rule 96
The Schedule of Fees

96.1 Schedule of Fees Annexed to Regulations

The amounts of the fees referred to in Rules 15 and 57 shall be expressed in Swiss currency. They shall be specified in the Schedule of Fees which is annexed to these Regulations and forms an integral part thereof.

SCHEDULE OF FEES

Kind of Fee	Amount	
1. <u>Basic Fee:</u> (Rule 15.2(a))		
if the international application contains not more than 30 sheets	325	Swiss francs
if the international application contains more than 30 sheets	325	Swiss francs plus 6 Swiss francs for each sheet in excess of 30 sheets
2. <u>Designation Fee:</u> (Rule 15.2(a))	78	Swiss francs
3. <u>Handling Fee:</u> (Rule 57.2(a))	100	Swiss francs
4. <u>Supplement to the Handling Fee:</u> (Rule 57.2(b))	100	Swiss francs

[Annex III follows]

ANNEX III

Equivalent Amounts of Fees Established by
the Director General Following Consultations with Receiving Offices*

Country Currency	Basic Fee	Supplement for each sheet over 30 sheets	Designation Fee	Handling Fee
Switzerland Swiss franc	325	6	78	100
Austria Austrian Schilling	2650	50	635	815
Denmark Danish Kroner	1000	19	240	Not applicable
France French franc	825	15	200	Not applicable
Germany, (Federal Republic of) Deutsche Mark	360	7	86	110
Japan Yen	41300	800	9900	12700
Luxembourg, Luxembourg franc or Belgian franc	5750	105	1380	Not applicable
Malawi Kwacha	155	3	37	**
Netherlands Dutch Guilder	390	7	95	120
Soviet Union Rouble	126	2.30	30	39
Sweden Swedish Kronor	830	15	200	255
United Kingdom Pound Sterling	92	1.70	22	28
United States of America US dollar	190	3.50	45	Not applicable

[End of Annex and of document]

* No equivalent amount established in Cruzeiros; fees in that currency are collected in the exact equivalents of Swiss currency on the day of payment.

** To be paid in currency of the competent International Preliminary Examining Authority.

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PCT/A/IV/3

ORIGINAL: English/French

DATE: October 22, 1979

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Fourth Session (2nd Ordinary) Geneva, September 24 to October 2, 1979

REPORT

Adopted by the Assembly

1. The agenda of this session was approved as contained in document PCT/A/IV/1.Rev.
2. The list of Officers elected at the beginning of this session and the list of the participants in this session are contained in Annex A of the General Report (document AB/X/32).
3. The decisions on each of the items of the said agenda are recorded in the said General Report.
4. This Report was unanimously adopted on October 2, 1979.

[End of document]

WIPO



PCT/A/IV/1.Rev.

ORIGINAL: English

DATE: August 31, 1979

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Fourth Session (2nd Ordinary)

Geneva, September 24 to October 2, 1979

DRAFT AGENDA

Prepared by the Director General

1. Opening of the session by the Chairman of the WIPO General Assembly
See document AB/X/1.Rev.
2. Adoption of the agenda
See the present document.
3. Election of the Officers
(WIPO General Rules of Procedure, Rule 9)
A Chairman and two Vice-Chairmen must be elected. The outgoing Officers are: Mr. V. Bykov (Soviet Union), Chairman, and Mr. M. Nzue Nkoghe (Gabon) and Mr. P. Braendli (Switzerland), Vice-Chairmen. The States members of the PCT Union are listed in document AB/X/1.Rev.
4. Adoption of amendments to the WIPO General Rules of Procedure
(WIPO General Rules of Procedure, Rule 56)
See document AB/X/6.
5. Admission of observers
(PCT, Article 53(2)(a)(ix))
See document AB/X/17.
6. Review and approval of the reports and activities of the Director General concerning the PCT Union; approval of the final accounts of the PCT Union
(PCT, Article 53(2)(a)(iv) and (vi))
See documents AB/X/3, 4.
7. Adoption of measures, including amendment of the Patent Cooperation Treaty, concerning the periodicity of the programs and budgets and of the ordinary sessions of the Assembly
(PCT, Article 61(2))
See document AB/X/5.

8. Determination of the program and adoption of triennial (1980 to 1982) or biennial (1980 and 1981) budget of the PCT Union; consideration of other matters raised in document AB/X/2
(PCT, Article 53(2)(a)(vi))
See document AB/X/2.
9. Consideration of arrears in contributions and related questions
(PCT, Article 57(5)(e))
See documents AB/X/18 and 22.
10. Designation of auditors
(PCT, Article 57(9))
See document AB/X/9.
11. Consideration of the form and contents of reports on meetings organized by the International Bureau
See document AB/X/10.
12. Confirmation of the establishment of the WIPO Permanent Committee on Patent Information
(PCT, Article 53(2)(a)(viii))
See document AB/X/14.
13. Adoption of the report of the session
14. Closing of the session by the Chairman

[Annex follows]

ANNEX

RULES OF PROCEDURE OF THE ASSEMBLY OF THE
INTERNATIONAL PATENT COOPERATION (PCT) UNION

Rule 1: Application of the General Rules of Procedure

The Rules of Procedure of the Assembly of the International Patent Cooperation (PCT) Union shall consist of the General Rules of Procedure of WIPO, supplemented and amended by the provisions set forth hereinafter.

Rule 2: Special Observers

(1) The following shall be invited as “special observers” to all sessions of the Assembly:

(i) States not members of the PCT Union which contribute to the budget of the PCT Union,

(ii) intergovernmental authorities having the power to grant patents effective in one or more States members of the PCT Union.

(2) Special observers shall have the same rights in the sessions of the Assembly as States members of the Assembly, except the right to vote.

Rule 3: Draft Agenda

The draft agenda of each session shall be drawn up by the Director General. In the case of ordinary sessions, such draft shall follow the instructions of the Executive Committee once the Executive Committee is established (see PCT Articles 53(9) and 54(6)(a)). In the case of extraordinary sessions, the said draft shall include the item or items mentioned in the request referred to in Article 53(11)(c) of the Patent Cooperation Treaty.

Rule 4: Publication of the Report

The report on the work of each session, or a summary drawn up by the International Bureau, shall be published in the Gazette of the PCT Union and in the reviews of the World Intellectual Property Organization La Propriété industrielle and Industrial Property.

[End of Annex and of document]

WIPO



PCT/A/V/17

ORIGINAL: English/French

DATE: June 16, 1980

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Fifth Session (3rd Extraordinary) Geneva, June 9 to 16, 1980

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly of the International Patent Cooperation (PCT) Union (hereinafter referred to as "the Assembly") held its fifth session (3rd extraordinary) in Geneva from June 9 to 16, 1980.
2. The following 19 Contracting States were represented at the session: Australia, Austria, Brazil, Denmark, France, Germany (Federal Republic of), Hungary, Japan, Liechtenstein, Luxembourg, Madagascar, Netherlands, Norway, Romania, Soviet Union, Sweden, Switzerland, United Kingdom, United States of America.
3. The following six States participated in the session as observers: Finland, Italy, Niger, Spain, Turkey and Zaire.
4. One intergovernmental organization, the European Patent Organisation (EPO), and the following ten international non-governmental organizations, were represented by observers: Council of European Industrial Federations (CEIF), Committee of National Institutes of Patent Agents (CNIPA), European Federation of Agents of Industry in Industrial Property (FEMIP), International Association for the Protection of Industrial Property (IAPIP), International Chamber of Commerce (ICC), International Federation of Inventors' Associations (IFIA), International Federation of Patent Agents (FICPI), International

Federation of Pharmaceutical Manufacturers Associations (IFPMA), Union of European Practitioners in Industrial Property (UNION) and Union of Industries of the European Community (UNICE).

5. The number of participants was about 60. The list of participants is contained in Annex I to this Report.

OFFICERS OF THE SESSION

6. The Assembly appointed Mr. Jean-Louis Comte (Switzerland) as acting Chairman in the absence of Mr. Harvey J. Winter (United States of America), Chairman and Mr. Ivan Nayashkov (Soviet Union), Vice-Chairman.

7. Mr. E. M. Haddrick, Director, PCT Division, WIPO, acted as Secretary of the Assembly.

OPENING OF THE SESSION; ADOPTION OF THE AGENDA

8. The Acting Chairman expressed, on behalf of the Assembly, satisfaction at the fact that, in the period since its preceding session in September/October 1979, Norway, Liechtenstein and Australia had become parties to the PCT and that, in a short time, the PCT would also enter into force for Hungary and the Democratic People's Republic of Korea, both of which had deposited the necessary instruments of ratification or accession.

9. The Assembly adopted its agenda as contained in document PCT/A/V/1.Rev., subject to the inclusion, at the request of the Delegation of Japan, of an additional item *6bis* covering any other business arising during the session.

AMENDMENTS TO THE PCT REGULATIONS

10. Discussions of amendments other than those referred to in paragraphs 33 to 36 below, were based on documents PCT/A/V/3, 4, 4 Corr./Add., 5 and 5 add.

11. The Assembly noted the papers submitted by organizations representing users of the PCT system indicating their views on necessary changes in the system and its implementation contained in document PCT/A/V/3.

12. Following the discussion of the proposals contained in documents PCT/A/V/4, 4 Corr./Add., 5 and 5 Add., the Assembly adopted, with effect on and from October 1, 1980, the amendments to (including, where applicable, deletions affecting) Rules 4.1(b)(ii), 4.8(b), 4.10(b), 4.11, 10.1(b), 10.1(c), 11.2(d), 11.12, 11.13(j), 13.2, 15.5, 17.1, 18.5, 19.2, 22.5, 30.1, 41, 46.2, 47.1(c), 54.4, 55.1, 57.4(b), 57.5(b), 60.1(b), 60.2(b), 80.6, 90.3(a) and 92.1(b) and to the Schedule of Fees and new Rules 11.10(d), 16*bis*, 20.3*bis*, 90.3(d), 91.2, 92.1(c), 92.4 and 92*bis*, as set out in Annex II.

13 With regard to proposals to amend Rule 22.3, as contained in document PCT/A/V/4, page 43 and PCT/A/V/5, page 7, the Assembly decided, following an exhaustive discussion of all issues involved leading to substantive approval of the proposals, that, since the time limit

under Rule 88.4 of the PCT Regulations was not respected, it should defer taking a decision to adopt the proposed amendments until its next session. The Assembly also agreed unanimously that, considering the exhaustive discussion which had taken place, the formal adoption of the proposed amendments at the next session of the Assembly should take place without reopening of the discussion on the proposals and that no new communication of the proposals to that next session was necessary in order to comply with Rule 88.4, to the extent the proposals were not amended.

14. The Assembly approved the decisions of the International Bureau, reflected in document PCT/A/V/4, not to propose amendments to certain Rules of the PCT Regulations in implementation of some suggestions made by certain organizations representing users of the PCT system.

15. The Assembly decided not to adopt certain other proposals made by the International Bureau for amendments to the PCT Regulations either based on suggestions made by interested organizations or put forward upon the initiative of the International Bureau having regard to its own experience in operations under the PCT. These proposals were contained in documents PCT/A/V/4, 5 and 5 Add. and relate to those Rules of the PCT Regulations not listed in paragraph 12 above in respect of which proposals were made in those documents.

16. The amendment to Rule 4.1(b)(ii) was adopted by the Assembly as a consequential amendment in view of amendments adopted to Rules 4.11 and 41.1.

17. In adopting the amendment to Rule 4.10(b), the Assembly noted an objection by the Delegation of Japan.

18. In the course of a discussion of Rule 4.15 in respect of which the International Bureau had decided not to propose an amendment, the Delegation of the United States of America confirmed that the request of an international application designating the United States of America could be signed on behalf of the inventor as applicant for purposes of that country by his agent or other representative within the meaning of Rule 2.1. In the case of signature by an agent, a power of attorney was required. The power of attorney could be either a general power of attorney or a separate power of attorney relating to the particular case. Where the power of attorney was missing, it could be supplied later. No problem would arise under the national law from the fact that the power of attorney was executed after the filing of the application.

19. New Rule 11.10(d) was adopted rather than the proposal of the International Bureau to adopt a new Rule 11.2(e), as proposed in document PCT/A/V/4, page 29. The amendment to Rule 11.13(j) was adopted in order to align that provision with new Rule 11.10(d), both of which Rules constitute exceptions of a similar nature to Rule 11.2(d).

20. In adopting the amendments to Rule 13.2, the Assembly noted that the amendments to Rule 13.2(i) and (ii) were not of substance but of a mere drafting nature and intended to achieve harmonization between Rule 13.2 and the corresponding provisions of the Implementing Regulations under the European Patent Convention.

21. When adopting new Rule 16*bis*, the Assembly noted the declaration of the International Bureau that once a year it would report on its experience of the operation of the new Rule and the costs and receipts in connection therewith.

22. In the course of the adoption of the amendments to Rule 17.1, it was agreed that the International Bureau would study the possibility of the inclusion in the request form of a check box which would enable the applicant to request the receiving Office to prepare and transmit the priority document to the International Bureau.

23. In the course of the discussion of the proposed amendment to Rule 19.1(a), not adopted by the Assembly, the Assembly noted a suggestion by the Representative of CEIF to allow, where the applicant had erroneously filed with a receiving Office not competent for his international application, a transfer of his application to the competent receiving Office without loss of filing date and asked the International Bureau to study that question further.

24. In the course of the discussion of the proposed amendment to Rule 22.3(a), contained in document PCT/A/V/4, page 43, it was noted that a consequential amendment would be required to Rule 22.2(e), changing the reference “14 months” to “15 months” since the period of “14 months” in Rule 22.2(e) was aligned to the period of “14 months” under Rule 22.3(a).

25. In the course of the discussion of the proposed amendment to Rule 22.3(b), on which decision was deferred (see paragraph 13 above), the Assembly noted a suggestion by the Representative of CNIPA that appropriate amendments to Rules 22.3(b) and 82 should be proposed by the International Bureau for the next session of the Assembly, ensuring that Rule 82 would in future apply also to mailings by a national Office or intergovernmental organization and in particular to the transmittal of the record copy by the receiving Office, and taking into account any consequential amendments in Rule 82 resulting from the amendment of Rule 22.3(b).

26. In the course of its consideration of the amendment to Rule 46.2, the Assembly was informed by the Delegation of Japan that the form for presentation of a copy or a translation of an amendment filed under Article 19(1) which must be used in the procedure before the Japanese Patent Office requires the indication of the date of receipt of the amendment by the International Bureau. The Delegation of the United States of America informed the Assembly that the applicant did not need to know the date of receipt of amendments under Article 19(1) by the International Bureau for the purposes of completing the oath or declaration of the inventor in the procedure before the United States Patent and Trademark Office. Although the date of receipt of an amendment under Article 19(1) by the International Bureau is preferred, the date of mailing of such an amendment is acceptable in the oath or declaration. In order to accommodate the requirement of the national procedure in Japan, and also because it was important to the applicant to know whether the amendments were received within the prescribed time limit and thus would form part of the international application which might have to be translated for the purposes of the designated Offices, the Assembly decided to adopt the proposed amendment under which the applicant is informed of the date of receipt of amendments under Article 19(1).

27. In the course of its consideration of the amendments to Rule 47.1(c), the Assembly noted a statement made by the International Bureau in response to a question from the Representative of the European Patent Office that the communication provided for in Article 20 takes place, in the sense referred to in Article 22(1), at the date of sending the communication by the International Bureau to each designated Office and was not in any sense conditional upon actual receipt by such Office. The Assembly further noted that the Swedish Patent Office would be in a position to follow the agreed procedure only once, after a short transitory period needed to implement the necessary adaptation of the legislation, the Swedish patent law has been amended accordingly.

28. Following a discussion of a proposed amendment to Rule 51.1 for the purpose of aligning the time limits referred to in Articles 25(1)(c) and 25(2)(a) with the applicable time limit under Article 22(1) and (3), the Assembly, while in principle agreeing to the substance of the proposed amendment, decided to defer the decision until a later session in 1981 or 1982. This conclusion was reached, as the national laws of certain of the Contracting States now provided time limits in accordance with the present text of Rule 51.1, and appropriate amendment of these provisions would have to be awaited before a decision could be taken. The International Bureau was asked to keep the matter under review and to propose the amendment again for consideration by a subsequent session of the Assembly.

29. Following a discussion of a proposed amendment to Rule 69.1(a) to permit the time limit for the establishment of the international preliminary examination report to be extended to expire one year after the start of international preliminary examination where a request for such extension is made by the applicant, the Assembly, basically agreeing with the principle of allowing an extension on request of the applicant, invited the International Bureau to study further the question of finding an appropriate solution to the problem. In doing so, it should consult with the International Preliminary Examining Authorities. One of the questions to be studied was whether it was desirable to provide for the possibility of extending the period for a reply by the applicant to a written opinion from such Authority under Rule 66.2(d). Furthermore, the International Bureau should study whether the form of the international preliminary examination report could be improved so that the usefulness of the report would be increased and whether, in particular, the requirement of saying “yes” or “no” in all cases could not be modified to accommodate cases where completion of the examination of a particular question would prolong the international procedure unduly beyond the 25th month, thus reducing the chances for the report to be taken into account in the national phase.

30. During consideration of the amendment adding paragraph (d) to Rule 90.3, the Delegation of the United States of America said that, in future, the United States Patent and Trademark Office would accept general powers of attorney for the filing of international applications. The statement indicating the contrary in the PCT Applicant’s Guide (Annex M2) could, therefore, now be removed. The Assembly agreed that use of a standard form such as that provided in the said Annex M2 was advantageous. The International Bureau said that it was willing to send, upon request, copies of the power of attorney form to all interested Offices. In adopting the amendment, the Assembly noted an objection of the Delegation of Japan.

31. During the discussion of new Rule 91.2, the Assembly agreed that, the ex officio correction, without formal request by the applicant, of obvious errors of transcription by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau was already permitted under Rule 91.1, thus obviating the need for a specific provision enabling such correction. The International Bureau was asked to study the possibility of including any provisions in the Administrative Instructions dealing with the procedure for such corrections which might be considered useful to achieve a uniform practice.

32. During the discussion of new Rule 92.4, the Assembly agreed that, until the entry into force of this Rule, the present practice of all Offices and Authorities concerning the acceptance of documents by telegraph and teleprinter, etc., would be maintained.

Joint Session with the Budapest Treaty Interim Advisory Committee

33. Discussions concerning certain amendments to the PCT Regulations were also held in a joint session with the Interim Advisory Committee for the preparation of the entry into force of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, presided over by the acting Chairman of the PCT Assembly, acting also in his capacity as Chairman of the session of the said Interim Advisory Committee.

34. Discussions were based on documents PCT/A/V/2 and 7, the International Bureau having withdrawn, in view of an earlier decision of the Assembly with respect to Rule 49.3, document PCT/A/V/2 Add.

35. Following the said discussion, the Assembly adopted, with effect from January 1, 1981, new Rule 13*bis* and the amendments to Rules 49.3 and 76.3 (the latter being consequential upon the amendment of Rule 49.3), set out in Annex II.

36. The report of the discussions of the joint session relating to the amendment of the Regulations under the Budapest Treaty on the International Deposit of Microorganisms for the Purposes of Patent Procedure is contained in document BP/IAC/III/8.

QUESTIONS CONCERNING THE USE OF THE PCT SYSTEM

37. Discussions were based on documents PCT/A/V/6, 6 Add. 1 and 6 Add. 2.

38. The only matters discussed were those questions raised in document PCT/A/V/6 concerning the international and national phases, the other questions, dealt with in documents PCT/A/V/6 Add. 1 and Add. 2, being deferred to a later session (see paragraph 55 below).

39. The Assembly noted that, as far as the international phase was concerned, solutions had been provided during the present session by way of new Rule 16*bis* and new Rule 47.1(c) which should help to alleviate some of the difficulties foreseen in Part I of the said document, that is, as regards oversights in the payment of fees and in the communication of the international application to the designated Offices. Furthermore, the approval as to substance, while deferring the formal decision in view of Rule 88.4 to the next session, of the proposal to amend Rule 22.3 to extend the time limit for the transmittal by the receiving Office to the International Bureau would, once finally adopted, go a long way to alleviate concerns with regard to the transmittal of the record copy.

40. Another proposal of the International Bureau also referred to in the document under consideration, namely to exclude the obligation to translate claims included in the application as filed which had been deleted or amended by the applicant still in the international phase under Article 19(1), however, had not been accepted by the Assembly. In this connection, the International Bureau stated that the observer delegations present at the session, representing the interested circles, had not expressed themselves in favor of the proposal, although the proposal was based on representations made by those circles and was intended to remove an important uncertainty for the applicant when entering the national phase.

41. The Assembly noted statements, tending to contribute to the solutions of the problems under consideration, of the following Delegations made during the discussions of document PCT/A/V/6:

(a) The Delegation of Luxembourg said that a modification of the national law was under preparation and that its country's waiver of the communication under Article 20 would be withdrawn when the relevant decree was amended.

(b) The Delegation of the United States of America said that its acceptance of Rule 47.1(c) effectively removed the problem indicated in the document under consideration with regard to communication under Article 20.

(c) The Delegation of Austria explained that the requirement of the Austrian patent law to receive a copy of the international application even where communication has taken place was considered to be fulfilled by the receipt of the pamphlet from the International Bureau. Consequently, the applicant was no longer required to furnish a copy of the international application to the Austrian Patent Office as designated Office.

(d) The Delegation of the Soviet Union said that amendments to the claims of international applications requesting protection by patent in the Soviet Union would be accepted within the time limit referred to in Rule 52.1 even where they were not of a restrictive nature only.

42. The Assembly noted furthermore the response of several delegations to the other questions raised in the document under discussion concerning the provisions of their laws affecting the entry into the national phase or the processing of the international application in that phase. These interventions are not referred to in this Report, as they did not lead to any discussion or conclusion by the Assembly.

43. On a question raised during the discussion, the Assembly noted a statement by the Delegation of Japan that, under its national law, a request for the purpose of alleging privileged disclosure would have to be made at the time of filing the international application and in the Japanese language (irrespective of the receiving Office where filing might take place) in order for the applicant to benefit from the relevant provision of the national law for the examination of his application during the national phase.

COMPUTERIZATION OF THE ADMINISTRATIVE MANAGEMENT BY WIPO OF INTERNATIONAL APPLICATIONS UNDER THE PCT

44. Discussions were based on document PCT/A/V/8.

45. The Assembly noted the recommendation of the PCT Management and Budget Consultants Group which the Assembly had established at its fourth (second ordinary) session in September-October 1979 that a computerized system be introduced in respect of certain aspects of the management of international applications under the PCT and that the Assembly should authorize the commitment of funds necessary for the introduction of a computerized system having regard to the economies expected to be derived from such a system.

46. The Assembly decided to authorize the International Bureau to commit funds in 1980, as requested in document PCT/A/V/8, for the purpose of computerizing certain aspects of the management of international applications under the PCT.

DEVELOPMENT OF THE PCT UNION

47. Discussions were based on document PCT/A/V/9.

Promotion of Acceptance of the PCT

48. The Assembly noted a declaration made by the Delegation of Finland, according to which its Government intended to deposit its instrument of ratification of the PCT on July 1, 1980, without making a reservation for Chapter II. In that case, Finland would become bound by the Treaty on October 1, 1980, and would possibly be the 30th Contracting State of the PCT.

49. The Assembly noted a declaration by the Delegation of Spain, stating that the industrial property administration of Spain was engaged in preparatory work concerning accession to the PCT, that a major problem to be considered was the question of acceptance of PCT applications in the Spanish language and that, once the necessary draft legislation was completed, it would be submitted to Parliament for approval.

50. The Assembly noted a declaration by the Delegation of Italy expressing the hope that the preparations for the ratification of the PCT would soon be terminated so that Italy could become a Contracting State of the PCT.

51. The Assembly, noting a report of the International Bureau on the present state of membership of the Treaty, adopted unanimously the Resolution contained in Annex III

Regional Treaties

52. The Assembly noted a report by the International Bureau referring to the three regional patent treaties of which certain States, members of the PCT Union, were parties, namely the European Patent Convention, the Libreville Agreement and the Switzerland/Liechtenstein Patent Treaty, and pointing to certain disadvantages flowing from the fact that, with respect to two such treaties, the European Patent Convention and the Libreville Agreement, certain States members of the regional treaty are not also party to the PCT. This presented particular problems to the users of the PCT system in the case of Belgium and Italy, who are party to the European Patent Convention but not to the PCT, since an applicant using the PCT to obtain a European patent could not do so for Belgium and Italy. The need to file separately for Belgium and Italy had been frequently described as one of the major obstacles against wider cumulative use of the PCT and the European Patent Convention and as a drawback for the attractiveness of the PCT system. In view of the character of the OAPI patent as a unitary patent effective in all Contracting States, these problems were less felt with respect to the Libreville Agreement but existed there as well. The International Bureau stressed the particular desirability of all States, which were now party to the European Patent Convention or would become party in the future, to become also party to the PCT, underlining especially the importance of early ratification of the Treaty by Belgium and Italy as an important contribution to facilitating patent protection at the international level and making the PCT system more viable.

53. The Assembly, on the basis of the report of the International Bureau and the ensuing discussion, took note of the situation which resulted from the fact that not all member States of certain regional patent treaties were also members of the PCT Union. The Assembly noted, furthermore, the disadvantages resulting therefrom for the applicants since the latter could not fully benefit from the advantages to be obtained by using the PCT system and the regional system by filing a single application, disadvantages which make it desirable for the users of the system that the said States adhered as soon as possible to the Treaty.

Chapter II of the PCT

54. The Assembly considered the question of acceptance of Chapter II of PCT on the basis of a report of the International Bureau on the present state of the said acceptance which underlined the particular importance for developing countries of full implementation of the Treaty, including its Chapter II, by all countries. In conclusion of the ensuing discussion, the Assembly noted the present state of acceptance of Chapter II of the Treaty and expressed its interest in the acceptance of Chapter II by all Contracting States.

DEFERRAL OF CONSIDERATION OF CERTAIN ITEMS

55. Due to lack of time, the Assembly decided to defer until a later session its consideration of documents PCT/A/V/6 Add. 1 and Add. 2, prepared by the International Bureau and also, with the concurrence of the Delegation of Sweden, of document PCT/A/V/10, and, with the concurrence of the Delegation of Japan, of documents PCT/A/V/11 and 12.

56. The Assembly noted a statement by the Representative of CEIF supported by the Representative of CNIPA, expressing the satisfaction of the interested circles over the fact that considerable progress had been made during the present session in achieving changes in the PCT Regulations which would increase the confidence of applicants in the PCT system, referring in particular to the provisions included in new Rule 16*bis*, in amended Rule 47.1(c) and in Rule 80.6. He added that it was important that the momentum achieved should be continued in the period ahead. In this regard, it was desirable that the International Bureau study the possibility of the introduction into the PCT of provisions for the general correction of errors and for the restitution of the rights of applicants where those rights have been lost.

CONSULTATIONS WITH THE RECEIVING OFFICES AND THE INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES RELATING TO THE ADMINISTRATIVE INSTRUCTIONS

57. On the occasion of the present Assembly, consultations were held with the receiving Offices and the International Searching and Preliminary Examining Authorities relating to the Administrative Instructions, as provided in PCT Rule 89.2(a).

58. The consultations were based on the proposed amendments to the Administrative Instructions as contained in documents PCT/A/V/4, 4 Corr./Add. and 5. The Assembly was informed about the said consultations which resulted in approval of the text and the modified forms as contained in Annex IV of this report and the deletion of Section 306 consequential to the new Rule 92*bis* which required an amendment of Part 1 of the Administrative Instructions by adding the new Section 111. The Assembly noted that the modified Administrative

Instructions would now be promulgated by the Director General fixing October 1, 1980, as their date of entry into force.

59. Due to lack of time, a discussion was not possible of the desirability of revision of the Request Form (form PCT/RO/101), referred to in document PCT/A/V/4 Corr./Add., page 2. It was agreed, however, that this question, as well as the question raised by the United States Patent and Trademark Office (concerning the date indicated on any replacement sheet under Section 308(b) of the Administrative Instructions), in respect of which the International Bureau had undertaken to find a solution meeting the desires expressed by that Office with regard to printing the indication in the pamphlet, would be studied by the International Bureau. In the latter case, it was noted during the consultations and by the Assembly that the International Bureau would implement the solution without a need for further consultation.

60. The Assembly adopted this Report unanimously
at its closing meeting on June 16, 1980.

[Annexes follow]

ANNEX I/ANNEXE I

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS

(in the English alphabetical order of the names of the States)
(dans l'ordre alphabétique anglais des noms des Etats)

I. MEMBER STATES/ETATS MEMBRES

AUSTRALIA/AUSTRALIE

Mr. F. J. SMITH, Commissioner of Patents, Australian Patent Office, Canberra

Mr. D. B. FITZPATRICK, President, The Institute of Patent Attorneys of Australia, Melbourne

Mr. D. A. FRECKLETON, Australian Manufacturers' Patent, Industrial Designs, Copyright and Trade Marks Association, Melbourne

Ms. Helen FREEMAN, First Secretary, Australian Permanent Mission, Geneva

AUSTRIA/AUTRICHE

Mr. H. MARCHART, Senior Counsellor, Austrian Patent Office, Vienna

BRAZIL/BRESIL

M. A. G. BAHADIAN, Conseiller, Délégation permanente du Brésil, Genève

Mr. G. R. COARACY, Director, Technological Documentation and Information Center, National Institute of Industrial Property, Rio de Janeiro

Mrs. M. M. R. MITTELBACH, Vice-Director, Patent Department, National Institute of Industrial Property, Rio de Janeiro

DENMARK/DANEMARK

Mrs. D. SIMONSEN, Head of Division, Patent and Trademark Office, Copenhagen

Mr. J. DAM, Head of Section, Patent and Trademark Office, Copenhagen

FRANCE

M. G. VIANES, Directeur, Institut national de la propriété industrielle, Paris

M. P. GUERIN, Attaché de direction, Institut national de la propriété industrielle, Paris

GERMANY (FEDERAL REPUBLIC OF)/ALLEMAGNE (REPUBLIQUE FEDERALE D')

Mr. U. C. HALLMANN, Leitender Regierungsdirektor, German Patent Office, Munich

HUNGARY/HONGRIE

Dr. Z. SZILVASSY, Vice-President, National Office of Inventions, Budapest

Mrs. E. PARRAGH, Counsellor, National Office of Inventions, Budapest

JAPAN/JAPON

Mr. I. SHAMOTO, Director General, Fourth Examination Department, Japanese Patent Office, Tokyo

Mr. Y. MASUDA, United Nations Bureau, Ministry of Foreign Affairs, Tokyo

Mr. S. UEMURA, First Secretary, Permanent Mission, Geneva

LIECHTENSTEIN

M. A. F. GERLICZY-BURIAN, Chef de l'Office pour les Relations Internationales, Vaduz

LUXEMBOURG

M. F. SCHLESSER, Adjoint du directeur, Service de la propriété industrielle, Luxembourg

MADAGASCAR

M. S. RABEARIVELO, Conseiller, Mission permanente, Genève

NETHERLANDS/PAYS-BAS

Mr. J. DEKKER, President, Netherlands Patent Office, Rijswijk

Dr. S. de VRIES, Deputy Member of the Patents Council, Netherlands Patent Office, Rijswijk

NORWAY/NORVEGE

Mr. P. T. LOSSIUS, Deputy Director General, Norwegian Patent Office, Oslo

Mr. I. LILLEVIK, Head of Section, Patent Department, Norwegian Patent Office, Oslo

ROMANIA/ROUMANIE

M. I. MARINESCU, Directeur adjoint, Office d'Etat pour les inventions et les marques, Bucarest

M. T. MELESCANU, Premier secrétaire, Mission permanente, Genève

SOVIET UNION/UNION SOVIETIQUE

Mr. L. KOMAROV, First Deputy Chairman, USSR State Committee for Inventions and Discoveries, Moscow

Mr. E. BURYAK, Head, Department of the All-Union Research Institute of State Patent Examination, Moscow

M. K. SAENKO, Conseiller, Mission permanente, Genève

SWEDEN/SUEDE

Mr. L. TERSMEDEN, Legal Adviser, Ministry of Justice, Stockholm

Mr. L. G. BJÖRKLUND, Head, Patent Department, Royal Patent and Registration Office, Stockholm

Mrs. B. SANDBERG., Head of International Section, Royal Patent and Registration Office, Stockholm

SWITZERLAND/SUISSE

M. J.-L. COMTE, Directeur suppléant, Office fédéral de la propriété intellectuelle, Berne

M. R. KÄMPF, Chef de Section, Office fédéral de la propriété intellectuelle, Berne

M. M. LEUTHOLD, Chef de division, Office fédéral de la propriété intellectuelle, Berne

UNITED KINGDOM/ROYAUME-UNI

Mr. D. F. CARTER, Superintending Examiner, Patent Office, London

Mr. C. G. M. HOPTROFF, Senior Examiner, Patent Office, London

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Mr H. D. HOINKES, Legislative and International Patent Specialist, United States Patent and Trademark office, Washington, D.C.

Mr. L. MAASSEL, Patent Procedure Specialist, United States Patent and Trademark Office, Washington, D.C.

II. OBSERVERS/OBSERVATEURS

FINLAND/FINLANDE

Mr. P. SALMI, Head of Patent Department, National Board of Patents and Registration, Helsinki

ITALY/ITALIE

Prof. G. CAGGIANO, Legal Adviser, Consiglio Nazionale Delle Ricerche, Rome

NIGER

Mr. H. ALOU, Fonctionnaire au Ministère des affaires étrangères et de la coopération, Niamey

SPAIN/ESPAGNE

Sr. J. M. GARCIA OYAREGUI, Director, Departamento de Patentes y Modelos, Madrid

Sr. A. CASADO CERVINO, Jefe, Servicio de Relaciones Internacionales, Departamento de Estudios y Relaciones Internacionales, Madrid

TURKEY/TURQUIE

M. E. TÜMER, Conseiller, Mission permanente, Genève

ZAIRE

M. K. LUANDA, Chef de Division de la propriété industrielle, Département de l'économie nationale, industrie et commerce, Kinshasa

III. INTERGOVERNMENTAL ORGANIZATIONS
ORGANISATIONS INTERGOUVERNEMENTALES

EUROPEAN PATENT ORGANISATION/ORGANISATION EUROPEENNE DES BREVETS

Dr. J. STAEHELIN, Vice-président, Office européen des brevets, Munich

Mr. G. D. KOLLE, Principal Administrator, European Patent Office, Munich

Mr. E. SIMON, Director, European Patent Office, Munich

IV. NON-GOVERNMENTAL ORGANIZATIONS
ORGANISATIONS NON-GOUVERNEMENTALES

COUNCIL OF EUROPEAN INDUSTRIAL FEDERATIONS (CEIF)/CONSEIL DES FEDERATIONS INDUSTRIELLES D'EUROPE (CIFE)

Dr. J. L. BETON, Chairman, Patents Committee, Trade Marks, Patents and Designs Federation, London, United Kingdom

COMMITTEE OF NATIONAL INSTITUTES OF PATENT AGENTS/COMITE DES
INSTITUTS NATIONAUX D'AGENTS DE BREVETS (CNIPA)

Mr. R. P. LLOYD, Member of Council, Chartered Institute of Patent Agents,
London, United Kingdom

EUROPEAN FEDERATION OF AGENTS OF INDUSTRY IN INDUSTRIAL
PROPERTY/FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN
PROPRIETE INDUSTRIELLE (FEMIP)

Dr. F. A. JENNY, Board member and Chairman of Working Group on European and
PCT Patent Practice, Basel, Switzerland

Dr. G. TASSET, Manager, Patents Department, Smith Kline-RIT, Rixensart,
Belgium

Dr. C. GUGERELL, International Patent Department, Scherico Ltd., Lucerne,
Switzerland

INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY (IAPIP)/ ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE
LA PROPRIETE INDUSTRIELLE (AIPPI)

Mr. G. R. CLARK, Membre d'honneur, Vice-Président, Sunbeam Corporation, Chicago,
Etats-Unis d'Amérique

Dr. G. TASSET, Manager, Patents Department, Smith Kline-RIT, Rixensart,
Belgium

INTERNATIONAL CHAMBER OF COMMERCE (ICC)/CHAMBRE DE COMMERCE
INTERNATIONALE (CCI)

Mr. R. HERVE, Directeur général, Bureau Gevers S.A., Bruxelles, Belgique

INTERNATIONAL FEDERATION OF INVENTORS' ASSOCIATIONS/FEDERATION
INTERNATIONALE DES ASSOCIATIONS DES INVENTEURS (IFIA)

Mr. S.-E. ANGERT, Vice-President, IFIA, Djursholm, Sweden

INTERNATIONAL FEDERATION OF PATENT AGENTS/FEDERATION
INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE (FICPI)

Mr. H. BARDEHLE, Patent Attorney, Munich, Federal Republic of Germany

INTERNATIONAL FEDERATION OF PHARMACEUTICAL MANUFACTURERS
ASSOCIATIONS (IFPMA)/ FEDERATION INTERNATIONALE DE L'INDUSTRIE DU
MEDICAMENT (FIIM)

Dr. G. TASSET, Manager, Patents Department, Smith Kline-RIT, Rixensart, Belgium

UNION OF EUROPEAN PRACTITIONERS IN INDUSTRIAL PROPERTY/UNION DES
PRATICIENS EUROPEENS EN PROPRIETE INDUSTRIELLE (UNION)

M. G. E. KIRKER, Ingénieur-conseil en propriété industrielle, Genève, Suisse

UNION OF INDUSTRIES OF THE EUROPEAN COMMUNITY/UNION DES
INDUSTRIES DE LA COMMUNAUTE EUROPEENNE (UNICE)

Dr. R. KOCKLÄUNER, Zentrale Patentabteilung, Hoechst AG, Frankfurt an Main, Federal
Republic of Germany

Mr. C. G. WICKHAM, Chairman, Industrial Property Panel, Confederation of British
Industry, London, United Kingdom

V. OFFICERS/BUREAU

Acting Chairman/Président par interim: M. J.-L. COMTE (Switzerland/Suisse)

Secretary/Secrétaire: Mr. E. M. HADDRICK (WIPO/OMPI)

VI. INTERNATIONAL BUREAU OF WIPO
BUREAU INTERNATIONAL DE L'OMPI

Dr. A. BOGSCH, Director General

Mr. K. PFANNER, Deputy Director General

Mr. E. M. HADDRICK, Director, PCT Division

Mr. J. FRANKLIN, Deputy Head, PCT Division

Mr. B. BARTELS, Head, PCT Legal and General Section

Mr. D. BOUCHEZ, Head, PCT Publications Section

Mr. N. SCHERRER, Head, PCT Fees, Sales and Statistics Section

Mr. V. TROUSSOV, Senior Counsellor, PCT Legal and General Section

Mr. A. OKAWA, Counsellor, PCT Examination Section

Miss F. SIMON, Consultant, PCT Legal and General Section

[Annex II follows/
L'annexe II suit]

ANNEX II

AMENDMENTS TO THE REGULATIONS UNDER THE PCT

Rule 4

The Request (Contents)

4.1 Mandatory and Optional Contents; Signature

(a) [No change]

(b) The request shall, where applicable, contain:

(i) a priority claim,

(ii) a reference to any earlier international, international-type or other search,

(iii) choices of certain kinds of protection,

(iv) an indication that the applicant wishes to obtain a regional patent and the names of the designated States for which he wishes to obtain such a patent,

(v) a reference to a parent application or parent patent.

(c) [No change]

(d) [No change]

4.2 [No change]

4.3 [No change]

4.4 [No change]

4.5 [No change]

4.6 [No change]

4.7 [No change]

4.8 Representation of Several Applicants Not Having a Common Agent

(a) [No change]

(b) If there is more than one applicant and the request does not refer to an agent representing all the applicants and it does not comply with the requirement of designating one of the applicants as provided in paragraph (a), the common representative shall be the applicant first named in the request who is entitled to file an international application with the receiving Office with which the international application was filed (Rule 19.1(a)).

4.9 [No change]

4.10 Priority Claim

(a) [No change]

(b) If the request does not indicate both

(i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, at least one country for which it was filed, and

(ii) the date on which it was filed,

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made except where, resulting from an obvious error of transcription, the indication of the said country or the said date is missing or is erroneous; whenever the identity or correct identity of the said country, or the said date or the correct date, may be established on the basis of the copy of the earlier application which the receiving Office receives before it transmits the record copy to the International Bureau, the error shall be considered as an obvious error.

(c) [No change]

(d) [No change]

(e) [No change]

4.11 Reference to Earlier Search

If an international or international-type search has been requested on an application under Article 15(5) or if the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application, the request shall contain a reference to that fact. Such reference shall either identify the application (or its translation, as the case may be) in respect of which the earlier search was made by indicating country, date and number, or the said search by indicating, where applicable, date and number of the request for such search.

4.12 [No change]

4.13 [No change]

4.14 [No change]

4.15 [No change]

4.16 [No change]

4.17 [No change]

Rule 10

Terminology and Signs

10.1 Terminology and Signs

(a) [No change]

(b) Temperatures shall be expressed in degrees Celsius, or also expressed in degrees Celsius, if first expressed in a different manner.

(c) [Deleted]

(d) [No change]

(e) [No change]

(f) [No change]

10.2 [No change]

Rule 11

Physical Requirements of the International Application

11.1 [No change]

11.2 Fitness for Reproduction

(a) [No change]

(b) [No change]

(c) [No change]

(d) Subject to Rule 11.10(d) and Rule 11.13(j), each sheet shall be used in an upright position (i.e., the short sides at the top and bottom).

11.3 [No change]

11.4 [No change]

11.5 [No change]

11.6 [No change]

11.7 [No change]

11.8 [No change]

11.9 [No change]

11.10 Drawings, Formulae, and Tables, in Text Matter

(a) [No change]

(b) [No change]

(c) [No change]

(d) Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position thereon; sheets on which tables or chemical or mathematical formulae are presented sideways shall be so presented that the tops of the tables or formulae are at the left side of the sheet.

11.11 [No change]

11.12 Alterations, Etc.

Each sheet shall be reasonably free from erasures and shall be free from alterations, overwritings, and interlineations. Non-compliance with this Rule may be authorized if the

authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

11.13 Special Requirements for Drawings

(a) [No change]

(b) [No change]

(c) [No change]

(d) [No change]

(e) [No change]

(f) [No change]

(g) [No change]

(h) [No change]

(i) [No change]

(j) The different figures shall be arranged on a sheet or sheets without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet.

(k) [No change]

(l) [No change]

(m) [No change]

(n) [No change]

11.14 [No change]

11.15 [No change]

Rule 13

Unity of Invention

13.1 [No change]

13.2 Claims of Different Categories

Rule 13.1 shall be construed as permitting, in particular, one of the following three possibilities:

(i) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the said product, and the inclusion in the same international application of an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the product, and the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the process.

13.3 [No change]

13.4 [No change]

13.5 [No change]

Rule 13bis

Microbiological Inventions

13bis.1 Definition

For the purposes of this Rule, “reference to a deposited microorganism” means particulars given in an international application with respect to the deposit of a microorganism with a depositary institution or to the microorganism so deposited.

13bis.2 References (General)

Any reference to a deposited microorganism shall be made in accordance with this Rule and, if so made, shall be considered as satisfying the requirements of the national law of each designated State.

13bis.3 References: Contents; Failure to Include Reference or Indication

(a) A reference to a deposited microorganism shall indicate,

(i) the name and address of the depositary Institution with which the deposit was made;

(ii) the date of deposit of the microorganism with that institution;

(iii) the accession number given to the deposit by that institution; and

(iv) any additional matter of which the International Bureau has been notified pursuant to Rule 13bis.7(a)(i), provided that the requirement to indicate that matter was published in the Gazette in accordance with Rule 13bis.7(c) at least two months before the filing of the international application.

(b) Failure to include a reference to a deposited microorganism or failure to include, in a reference to a deposited microorganism, an indication in accordance with paragraph (a), shall have no consequence in any designated State whose national law does not require such reference or such indication in a national application.

13bis.4 References: Time of Furnishing Indications

If any of the indications referred to in Rule 13bis.3(a) is not included in a reference to a deposited microorganism in the international application as filed but is furnished by the applicant to the International Bureau within 16 months after the priority date, the indication shall be considered by any designated Office to have been furnished in time unless its national law requires the indication to be furnished at an earlier time in the case of a national application and the International Bureau has been notified of such requirement pursuant to Rule 13bis.7(a)(ii), provided that the International Bureau has published such requirement in the Gazette in accordance with Rule 13bis.7(c) at least two months before the filing of the international application. In the event that the applicant makes a request for early publication under Article 21(2)(b), however, any designated Office may consider any indication not furnished by the time such request is made as not having been furnished in time. Irrespective

of whether the applicable time limit under the preceding sentences has been observed, the International Bureau shall notify the applicant and the designated Offices of the date on which it has received any indication not included in the international application as filed. The International Bureau shall indicate that date in the international publication of the international application if the indication has been furnished to it before the completion of technical preparations for international publication.

13bis.5 References and Indications for the Purposes of One or More Designated States; Different Deposits for Different Designated States; Deposits with Depositary Institutions other than Those Notified

(a) A reference to a deposited microorganism shall be considered to be made for the purposes of all designated States, unless it is expressly made for the purposes of certain of the designated States only; the same applies to the indications included in the reference.

(b) References to different deposits of the microorganism may be made for different designated States.

(c) Any designated Office shall be entitled to disregard a deposit made with a depositary institution other than one notified by it under Rule 13bis.7(b).

13bis.6 Furnishing of Samples

(a) Where the international application contains a reference to a deposited microorganism, the applicant shall, upon the request of the International Searching Authority or the International Preliminary Examining Authority, authorize and assure the furnishing of a sample of that microorganism by the depositary institution to the said Authority, provided that the said Authority has notified the International Bureau that it may require the furnishing of samples and that such samples will be used solely for the purposes of international search or international preliminary examination, as the case may be, and such notification has been published in the Gazette.

(b) Pursuant to Articles 23 and 40, no furnishing of samples of the deposited microorganism to which a reference is made in an international application shall, except with the authorization of the applicant, take place before the expiration of the applicable time limits after which national processing may start under the said Articles. However, where the applicant performs the acts referred to in Articles 22 or 39 after international publication but before the expiration of the said time limits, the furnishing of samples of the deposited microorganism may take place, once the said acts have been performed. Notwithstanding the previous provision, the furnishing of samples from the deposited microorganism may take place under the national law applicable for any designated Office as soon as, under that law, the international publication has the effects of the compulsory national publication of an unexamined national application.

13bis.7 National Requirements: Notification and Publication

(a) Any national Office may notify the International Bureau of any requirement of the national law,

(i) that any matter specified in the notification, in addition to those referred to in Rule 13*bis*.3(a)(i), (ii) and (iii), is required to be included in a reference to a deposited microorganism in a national application;

(ii) that one or more of the indications referred to in Rule 13*bis*.3(a) are required to be included in a national application as filed or are required to be furnished at a time specified in the notification which is earlier than 16 months after the priority date.

(b) Each national Office shall notify the International Bureau a first time before entry into force of this Rule and then each time a change occurs of the depositary institutions with which the national law permits deposits of microorganisms to be made for the purposes of patent procedure before that Office or, if the national law does not provide for or permit such deposits, of that fact.

(c) The International Bureau shall promptly publish in the Gazette requirements notified to it under paragraph (a) and information notified to it under paragraph (b).

Rule 15

The International Fee

15.1 [No change]

15.2 [No change]

15.3 [No change]

15.4 [No change]

15.5 [Deleted]

15.6 [No change]

Rule 16bis

Advancing Fees by the International Bureau

16bis.1 Guarantee by the International Bureau

(a) Where, by the time they are due under Rule 14.1(b), Rule 15.4(a) or (c) and Rule 16.1(f), the receiving Office finds that in respect of an international application no fees were paid to it by the applicant, or that the amount paid to it by the applicant is less than what is necessary to cover the transmittal fee, the basic fee and the search fee, the receiving Office shall charge the amount required to cover those fees, or the missing part thereof, to the International Bureau and shall consider the said amount as if it had been paid by the applicant at the due time.

(b) Where, by the time it or they are due under Rule 15.4(b) or (c), the receiving Office finds that in respect of an international application the payment made by the applicant is insufficient to cover the designation fees necessary to cover all the designations, the receiving Office shall charge the amount required to cover those fees to the International Bureau and shall consider that amount as if it had been paid by the applicant at the due time. .

(c) The International Bureau shall transfer from time to time to each receiving Office an amount which is expected to be necessary for covering any charges that the receiving Office has to make under paragraphs (a) and (b). The amount and the time of such transfers shall be determined by each receiving Office according to its own wish. The charging of any amount under paragraphs (a) and (b) shall not require any advance notice to, or any agreement by, the International Bureau.

(d) Each month, the receiving Office shall inform the International Bureau of the charges, if any, made under paragraphs (a) and (b).

16bis.2 Obligations of the Applicant, etc.

(a) The International Bureau shall promptly notify the applicant of any amount by which it was charged under Rule 16bis.1(a) and (b) and shall invite him to pay to it, within one month from the date of the notification, the said amount augmented by a surcharge of 50%, provided that the surcharge will not be less, and will not be more, than the amounts indicated in the Schedule of Fees. The notification may refer to the charges made both under Rule 16bis.1(a) and (b) or, at the discretion of the International Bureau, there may be two separate notifications, one referring to charges made under Rule 16bis.1(a), the other referring to charges made under Rule 16bis.1(b).

(b) If the applicant fails to pay, within the said time limit, to the International Bureau the amount claimed, or pays less than what is needed to cover the transmittal fee, the basic fee, the search fee, one designation fee and the surcharge, the International Bureau shall notify the receiving Office accordingly and the receiving Office shall declare the international application withdrawn under Article 14(3)(a) and the receiving Office and the International Bureau shall proceed as provided in Rule 29.

(c) If the applicant pays, within the said time limit, to the International Bureau an amount which is more than what is needed to cover the fees and surcharge referred to in

paragraph (b) but less than what is needed to cover all the designations maintained, the International Bureau shall notify the receiving Office accordingly and the receiving Office shall apply the amount paid in excess of what is needed to cover the fees and surcharge referred to in paragraph (b) in an order which shall be established as follows:

(i) where the applicant indicates to which designation or designations the amount is to be applied, it shall be applied accordingly but, if the amount received is insufficient to cover the designations indicated, it shall be applied to as many designations as are covered by it in the order chosen by the applicant in indicating the designations;

(ii) to the extent that the applicant has not given the indications under item (i), the amount or the balance thereof shall be applied to the designations in the order in which they appear in the international application;

(iii) where the designation of a State is for the purposes of a regional patent and provided that the required designation fee is, under the preceding provisions, available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.

The receiving Office shall declare any designation not covered by the amount paid withdrawn under Article 14(3)(b) and the receiving Office and the International Bureau shall proceed as provided in Rule 29.

(d) The receiving Office shall not return to the International Bureau any amount that it has charged to that Bureau for covering the transmittal fee.

(e) Where the international application is considered withdrawn, any amount charged to the International Bureau, other than the amount needed to cover the transmittal fee and the search fee transferred by the receiving Office to the International Searching Authority, shall be returned by the receiving Office to the International Bureau.

(f) Where the international application is considered withdrawn, any search fee charged by the receiving Office and transferred to the International Searching Authority shall be transferred by that Authority to the International Bureau unless the said Authority has already started the International search.

(g) Where paragraph (c) applies, the amount charged by the receiving Office to the International Bureau for designations which, as a consequence of the application of the order under that paragraph, are not maintained, shall be returned to the International Bureau by the receiving Office.

16bis.3 Notifications

(a) Any receiving Office may exclude the application of Rules 16bis.1 and 16bis.2 by a written notification to that effect given to the International Bureau by September 1, 1980. Such notification may be withdrawn at any time. The International Bureau shall publish all such notifications and withdrawals in the Gazette.

(b) Former Rule 15.5* remains applicable in respect of any receiving Office giving a notification under paragraph (a)

* Former Rule 15.5 Partial Payment

(a) Where the amount of the international fee received by the receiving Office is not less than that of the basic fee and at least one designation fee but less than the amount required to cover the basic fee and all the designations made in the international application, the amount received shall be applied as follows:

(i) to cover the basic fee, and

(ii) to cover as many designation fees as, after deduction of the basic fee may be covered in full by the amount received in the order indicated in paragraph (b).

(b) The order in which the said amount shall be applied to the designations shall be established as follows:

(i) where the applicant indicates to which designation or designations the amount is to be applied, it shall be applied accordingly but, if the amount received is insufficient to cover the designations indicated, it shall be applied to as many designations as are covered by it in the order chosen by the applicant in indicating the designations;

(ii) to the extent that the applicant has not given the indications under item (i), the amount or the balance thereof shall be applied to the designations in the order in which they appear in the international application;

(iii) where the designation of a State is for the purposes of a regional patent and provided that the required designation fee is, under the preceding provisions available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.

Rule 17

The Priority Document

17.1 Obligation to Submit Copy of Earlier National Application

(a) Where the priority of an earlier national application is claimed under Article 8 in the international application, a copy of the said national application, certified by the authority with which it was filed (“the priority document”), shall, unless already filed with the receiving Office together with the international application, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date or, in the case referred to in Article 23(2), not later than at the time the processing or examination is requested. Where submitted to the receiving Office, the priority document shall be transmitted by that Office to the International Bureau together with the record copy or promptly after having been received by that Office. In the latter case, the receiving Office shall indicate to the International Bureau the date on which it received the priority document.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to transmit the priority document to the International Bureau. Such request shall be made not later than the expiration of the applicable time limit referred to under paragraph (a) and may be subjected by the receiving Office to the payment of a fee. The receiving Office shall, promptly after receipt of such request, and, where applicable, the payment of such fee, transmit the priority document to the International Bureau with an indication of the date of receipt of such request.

(c) If the requirements of neither of the two preceding paragraphs are complied with, any designated State may disregard the priority claim.

(d) The International Bureau shall record the date on which the priority document has been received by it or by the receiving Office. Where applicable, the date of receipt by the receiving Office of a request referred to under paragraph (b) shall be recorded as the date of receipt of the priority document. The International Bureau shall notify the applicant and the designated Offices accordingly.

17.2 [No change]

Rule 18

The Applicant

18.1 [No change]

18.2 [No change]

18.3 [No change]

18.4 [No change]

18.5 [Deleted]

Rule 19

The Competent Receiving Office

19.1 [No change]

19.2 Several Applicants

If there are several applicants, the requirements of Rule 19.1 shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national.

19.3 [No change]

Rule 20

Receipt of the International Application

20.1 [No change]

20.2 [No change]

20.3 [No change]

20.3bis Manner of Carrying Out Corrections

The Administrative Instructions prescribe the manner in which corrections required under Article 11(2)(a) shall be presented by the applicant and the manner in which they shall be entered in the file of the international application.

20.4 [No change]

20.5 [No change]

20.6 [No change]

20.7 [No change]

20.8 [No change]

20.9 [No change]

Rule 22

Transmittal of the Record Copy

22.1 [No change]

22.2 [No change]

22.3 [No change]

22.4 [No change]

22.5 Documents Filed with the International Application

Any power of attorney and any priority document filed with the international application referred to in Rule 3.3(a)(ii) shall accompany the record copy; any other document referred to in that Rule shall be sent only at the specific request of the International Bureau. If any document referred to in Rule 3.3(a)(ii) which is indicated in the check list as accompanying the international application is not, in fact, filed at the latest by the time the record copy leaves the receiving Office, that Office shall so note on the check list and the said indication shall be considered as if it had not been made.

Rule 30

Time Limit under Article 14(4)

30.1 Time Limit

The time limit referred to in Article 14(4) shall be 4 months from the international filing date.

Rule 41

Earlier Search other than International Search

41.1 Obligation to Use Results; Refund of Fee

If reference has been made in the request, in the form provided for in Rule 4.11, to an international-type search carried out under the conditions set out in Article 15(5) or to a search other than an international or international-type search, the International Searching Authority shall, to the extent possible, use the results of the said search in establishing the international search report on the international application. The International Searching Authority shall refund the search fee, to the extent and under the conditions provided for in the agreement under Article 16(3)(b) or in a communication addressed to and published in the Gazette by the International Bureau, if the international search report could wholly or partly be based on the results of the said search.

Rule 46

Amendment of Claims Before the International Bureau

46.1 [No change]

46.2 Dating of Amendments

The date of filing of any amendment shall be recorded by the International Bureau, which shall also notify the applicant of the date and indicate the date in any publication or copy issued by it.

46.3 [No change]

46.4 [No change]

46.5 [No change]

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) [No change]

(b) [No change]

(c) The International Bureau shall send a notice to the applicant indicating the designated Offices to which the communication has been effected and the date of such communication. Such notice shall be sent on the same day as the communication. Each designated Office shall be informed, separately from the communication, about the sending and the date of mailing of the notice. The notice shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notice.

(d) [No change]

(e) [No change]

47.2 [No change]

47.3 [No change]

Rule 49

Languages of Translations and Amounts of Fees
under Article 22(1) and (2)

49.1 [No change]

49.2 [No change]

49.3 Statements under Article 19; Indications under Rule 13bis.4

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13bis.4 shall be considered part of the international application.

Rule 54

The Applicant Entitled to Make a Demand

54.1 [No change]

54.2 [No change]

54.3 [No change]

54.4 [Deleted]

Rule 55

Languages (International Preliminary Examination)

55.1 The Demand

The demand shall be in the language of the international application or, when a translation is required under Rule 55.2, in the language of that translation, provided that the International Preliminary Examining Authority may permit the demand to be in any language specified in the agreement concluded between the International Bureau and that Authority.

55.2 [No change]

Rule 57

The Handling Fee

57.1 [No change]

57.2 [No change]

57.3 [No change]

57.4 Failure to Pay (Handling Fee)

(a) [No change]

(b) If the applicant complies with the invitation within the one-month time limit, the handling fee shall be considered as if it had been paid on the due date.

(c) [No change]

57.5 Failure to Pay (Supplement to the Handling Fee)

(a) [No change]

(b) If the applicant complies with the invitation within the one-month time limit, the supplement to the handling fee shall be considered as if it had been paid on the due date.

(c) [No change]

57.6 [No change]

Rule 60

Certain Defects in the Demand or Elections

60.1 Defects in the Demand

(a) [No change]

(b) If the applicant complies with the invitation within the prescribed time limit, the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted contained at least one election and permitted the international application to be identified; otherwise the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

(c) [No change]

(d) [No change]

60.2 Defects in Later Elections

(a) [No change]

(b) If the applicant complies with the invitation within the prescribed time limit, the later election shall be considered as if it had been received on the actual filing date, provided that the later election as submitted contained at least one election and permitted the international application to be identified; otherwise, the later election shall be considered as if it had been received on the date on which the International Bureau receives the correction.

(c) [No change]

60.3 [No change]

Rule 76

Languages of Translations and Amounts of Fees
under Article 39(1); Translation of Priority Document

76.1 [No change]

76.2 [No change]

76.3 Statements under Article 19; Indications under Rule 13bis.4

For the purposes of Article 39 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13bis.4 shall be considered part of the international application.

76.4 [No change]

Rule 80

Computation of Time Limits

80.1 [No change]

80.2 [No change]

80.3 [No change]

80.4 [No change]

80.5 [No change]

80.6 Date of Documents

(a) Where a period starts on the day of the date of a document or letter emanating from a national Office or intergovernmental organization, any interested party may prove that the said document or letter was mailed on a day later than the date it bears, in which case the date of actual mailing shall, for the purposes of computing the period, be considered to be the date on which the period starts. Irrespective of the date on which such a document or letter was mailed, if the applicant offers to the national Office or intergovernmental organization evidence which satisfies the national Office or intergovernmental organization that the document or letter was received more than 7 days after the date it bears, the national Office or intergovernmental organization shall treat the period starting from the date of the document or letter as expiring later by an additional number of days which is equal to the number of days which the document or letter was received later than 7 days after the date it bears.

(b) Any receiving Office may exclude the application of paragraph (a) by a written notification to that effect given to the International Bureau by September 1, 1980. Such notification may be withdrawn at any time. The International Bureau shall publish all such notifications and withdrawals in the Gazette.

80.7 [No change]

Rule 90

Representation

90.1 [No change]

90.2 [No change]

90.3 Appointment

(a) Appointment of any agent, or of any common representative within the meaning of Rule 4.8(a), shall be effected by each applicant, at his choice, either by signing the request in which the agent or common representative is designated or by a separate power of attorney (i.e., a document appointing an agent or common representative).

(b) [No change]

(c) [No change]

(d) A general power of attorney may be deposited with the receiving Office for purposes of the processing of the international application as defined in Rule 90.2(d). Reference may be made in the request to such general power of attorney, provided that a copy thereof is attached to the request by the applicant.

90.4 [No change]

Rule 91

Obvious Errors of Transcription

91.1 [No change]

91.2 Manner of Carrying Out Rectifications

The Administrative Instructions prescribe the manner in which rectifications of obvious errors of transcription shall be made and the manner in which they shall be entered in the file of the international application.

Rule 92

Correspondence

92.1 Need for Letter and for Signature

(a) [No change]

(b) If the requirements provided for in paragraph (a) are not complied with, the applicant shall be informed as to the non-compliance and invited to remedy the omission within a time limit fixed in the invitation. The time limit so fixed shall be reasonable in the circumstances; even where the time limit so fixed expires later than the time limit applying to the furnishing of the paper (or even if the latter time limit has already expired), it shall not be less than 10 days and not more than one month from the mailing of the invitation. If the omission is remedied within the time limit fixed in the invitation, the omission shall be disregarded; otherwise, the applicant shall be informed that the paper has been disregarded.

(c) Where non-compliance with the requirements provided for in paragraph (a) has been overlooked and the paper taken into account in the international procedure, the non-compliance shall be disregarded.

92.2 [No change]

92.3 [No change]

92.4 Use of Telegraph, Teleprinter, etc.

(a) Notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraph (b), below, any document (including any drawing) subsequent to the international application may be sent by telegraph or teleprinter or other like means of communication producing a printed or written document. Any such document so sent shall be considered to have been submitted in a form complying with the requirements of the said Rules on the day on which it was communicated by the means mentioned above, provided that, within 14 days after being so communicated, its contents are furnished in that form; otherwise, the telegraphic, teleprinter or other communication shall be considered not to have been made.

(b) Each national Office or intergovernmental organization shall promptly notify the International Bureau of any means referred to in paragraph (a) by which it is prepared to receive documents referred to in that paragraph. The International Bureau shall publish the information so received in the Gazette as well as information concerning the means referred to in paragraph (a) by which the International Bureau is prepared to receive any such document. Paragraph (a) shall apply with respect to any national Office or intergovernmental organization only to the extent the said information has been so published with respect to it. The International Bureau shall publish, from time to time, in the Gazette, changes in the information previously published.

Rule 92bis

Changes in Certain Indications in the Request or the Demand

92bis.1 Recording of Changes by the International Bureau

The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request or demand:

- (i) person, name, residence, nationality or address of the applicant,
- (ii) person, name or address of the agent, the common representative or the inventor.

92bis.2 Notifications

(a) The International Bureau shall give notifications concerning changes recorded by it:

(i) to the receiving Office where the change has been recorded on the request of the applicant,

(ii) as long as the international search report or the declaration referred to in Article 17(2) has not yet issued, to the International Searching Authority,

(iii) until the expiration of the time limit referred to in Article 22(1), to the designated Offices,

(iv) as long as the international preliminary examination report has not yet issued, to the International Preliminary Examining Authority,

(v) until the expiration of the time limit referred to in Article 39(1)(a), to the elected Offices.

(b) A copy of each notification sent under paragraph (a) shall be sent to the applicant by the International Bureau.

SCHEDULE OF FEES

<u>Fees</u>	<u>Amounts</u>
1. <u>Basic Fee:</u> (Rule 15.2(a)) if the international application contains not more than 30 sheets	325 Swiss francs
if the international application contains more than 30 sheets	325 Swiss francs plus 6 Swiss francs for each sheet in excess of 30 sheets
2. <u>Designation Fee:</u> (Rule 15.2(a))	78 Swiss francs
3. <u>Handling Fee:</u> (Rule 57.2(a))	100 Swiss francs
4. <u>Supplement to the Handling Fee:</u> (Rule 57.2(b))	100 Swiss francs
<u>Surcharges</u>	
5. <u>Surcharge for late payment:</u> (Rule 16bis.2(a))	Minimum: 200 Swiss francs Maximum: 500 Swiss francs

[Annex III follows]

ANNEX III

Resolution

The Assembly of the International Patent Cooperation Union
(PCT Union)

Noting that the membership in the PCT Union is open to the States which are members of the Paris Union for the Protection of Industrial Property,

Being Convinced that the participation in the PCT Union of as many States as possible of the Paris Union is in the interests of those States and their industries,

Resolves to:

(1) Invite those States members of the Paris Union which are not members of the PCT Union to take, at an early date, the steps necessary to become members of the PCT Union;

(2) Request the International Bureau, on occasions when it appears appropriate to do so, to bring this resolution to the notice of States members of the Paris Union which are not members of the PCT Union.

[Annex IV follows]

ANNEX IV

AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS
UNDER THE PCT

Section 106

Common Agent for Several Applicants

(a) [Existing text of Section 106]

(b) Where the international application is filed with reference to a general power of attorney not signed by all the applicants, it shall be sufficient for the purpose of appointment of a common agent under Rule 90.3, if the request or a separate power of attorney is signed by the applicant, who did not sign the general power of attorney.

Section 111

Changes in Certain Indications in the Request and the Demand

Any request for the recording of any changes referred to under Rule 92*bis* shall be signed by the applicant or, if the receiving Office requested such change, by the receiving Office. The request shall clearly identify the indications the change of which is requested.

Section 204

Headings of the Parts of the Description

The headings referred to in Rule 5.1(c) should be as follows:

- (i) for matter referred to in Rule 5.1(a)(i), “Technical Field;”
- (ii) for matter referred to in Rule 5.1(a)(ii), “Background Art;”
- (iii) for matter referred to in Rule 5.1(a)(iii), “Disclosure of Invention;”
- (iv) for matter referred to in Rule 5.1(a)(iv), “Brief Description of Drawings;”
- (v) for matter referred to in Rule 5.1(a)(v), “Best Mode for Carrying Out the Invention”,
or, where appropriate, “Mode(s) for Carrying Out the Invention”;
- (vi) for matter referred to in Rule 5.1(a)(vi), “Industrial Applicability.”

Section 205

Numbering of Claims upon Amendment

(a) Any claim submitted after the filing date of the international application and which is not identical with the claims previously appearing in the international application shall, at the choice of the applicant, be submitted either:

(i) as an amended claim, in which case, it shall bear the same number as the previous claim it amends; that number shall be followed by the word “(amended)” or its equivalent in the language of the international application; or

(ii) as a new claim, in which case it shall bear the next number after the highest previously numbered claim; that number shall be followed by the word “(new)” or its equivalent in the language of the international application; where the consecutive order of claims requires that a new claim be given a number lower than the highest previously numbered claim, the claims following the new claim shall be renumbered;

any new number shall be followed by the words “(Original claim No.)” or an equivalent of these words in the language of the international application and an indication of the original number of the renumbered claim.

(b) [No change]

Section 306

[Deleted]

ANNEX F TO THE ADMINISTRATIVE INSTRUCTIONS

FORMS

Form PCT/RO/101 (Request and Fee Calculation Sheet): page 3 of this form, as modified, appears on page 9 of this Annex.

Form PCT/ISA/210 (International Search Report): an additional (optional) sheet for this form called “(Extra Sheet)” appears on page 10 of this Annex.

SUPPLEMENTAL BOX... USE THIS BOX IF ANY OF THE BOXES IS NOT LARGE ENOUGH TO CONTAIN INFORMATION TO BE FURNISHED. INDICATE THE BOXES CONTINUED IN THIS BOX BY THEIR (ROMAN) NUMERALS AND TITLE (e.g.: "II. APPLICANT (CONTINUED)")

XI. SIGNATURE OF APPLICANT ²⁰

XII. CHECK LIST (To be filled in by the Applicant) ²¹

A. This international application contains the following number of sheets:

1. request	sheets
2. description	sheets
3. claims	sheets
4. abstract	sheets
5. drawings	sheets
Total	sheets

C. Figure number **of the drawings (if any) is suggested to accompany the abstract for publication.**

D. Drawings (To be filled in by the receiving Office)

☐ **No Drawings** ²²

B. This international application as filed is accompanied by the items checked below:

1. ☐	separate signed power of attorney
2. ☐	priority document
3. ☐	receipt (e.g. revenue stamps) for the fees paid
4. ☐	cheque for the payment of fees
5. ☐	international search report
6. ☐	international-type search report
7. ☐	document in evidence of fact that applicant is successor in title of inventor
8. ☐	other document (specify)

(The following is to be filled in by the receiving Office)

1. Date of actual receipt of the purported international application:

2. Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application:

3. Date of timely receipt of the required corrections under Article 11 of the PCT:

(The following is to be filled in by the International Bureau)

Date of receipt of the record copy:

International Application No.

III. DOCUMENTS CONSIDERED TO BE RELEVANT (CONTINUED FROM THE SECOND SHEET)		
Category *	Citation of Document, ¹⁶ with indication, where appropriate, of the relevant passages ¹⁷	Relevant to Claim No. ¹⁸

WIPO



PCT/A/VI/5

ORIGINAL: English/French

DATE: October 10, 1980

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Sixth Session (4th Extraordinary) Geneva, September 22 to 26, 1980

REPORT

Adopted by the Assembly

Opening of the Session

1. See the General Report, Chapter I (document AB/XI/9).

Agenda

2. See the General Report, Chapter II (document AB/XI/9).

PCT Regulations

3. Discussions were based on documents PCT/A/VI/2 and 2.Corr.
4. The Assembly, having noted its decision taken at its fifth session (third extraordinary) held in Geneva, from June 9 to 16, 1980, to adopt at its present session the amendments to Rule 22.3 considered at the said fifth session, adopted the amendment to paragraph (a) of the said Rule contained in the Annex to document PCT/A/VI/2, as modified by document PCT/A/VI/2.Corr., and deleted paragraph (b) of the said Rule. The amendments and deletion appear in the Annex to this Report.
5. The Assembly, taking into account the conclusion reached at the said fifth session as to the need to amend Rule 22.2(e) as a consequence of the amendment of Rule 22.3(a), adopted

the amendment to Rule 22.2(e) contained in the Annex to document PCT/A/VI/2. The amendment appears in the Annex to this Report.

6. The Assembly, noting the views expressed at its said fifth session as to the desirability of ensuring that Rule 82 would apply to mailings by a national Office or intergovernmental organization and, in particular, to the transmittal of the record copy by the receiving Office and taking into account the interpretation which should be given to Rules 82.1(a) and 82.2(a) (following upon the deletion of Rule 22.3(b) and the references thereto in Rules 82.1(a) and 82.2(a) as set out in paragraphs 7 and 8 of document PCT/A/VI/2, adopted the amendments to the said Rules contained in the Annex to the said document. The amendments appear in the Annex to this Report.

7. The Assembly decided that the amendments and the deletion, referred to in paragraphs 4 to 6, above, shall enter into effect on January 1, 1981.

8. Furthermore, the Assembly, having endorsed the interpretation given by the International Bureau to Rule 80.6(b) adopted by the Assembly at its said fifth session, as set out in paragraph 11 of document PCT/A/VI/2, amended the first sentence thereof, with a view to avoiding doubts as to its effect, by adding the words “the second sentence of” before the reference therein to “paragraph (a).” The Assembly decided that the said amendment should enter into effect on the same day as the said Rule 80.6(b), namely, October 1, 1980. The amendment appears in the Annex to this Report.

9. Finally, the Assembly, having regard to its decision referred to in paragraph 19(v) of document AB/XI/9 to fix new amounts for *inter alia* the fees contained in the Schedule of Fees annexed to the Regulations, replaced, with effect on and from January 1, 1981, the said Schedule by the Schedule of Fees contained in the Annex to this Report.

Financial Matters

10. See the General Report, Chapter VI (document AB/XI/9).

“PCT International Meeting”

11. Discussions were based on document PCT/A/VI/3 and an oral declaration by the Delegation of Japan according to which Japan would, in the event of a decision being made deciding to hold the proposed meeting in Tokyo, bear the local costs associated with its organization and the costs of simultaneous interpretation in the English and French languages.

12. Several Delegations expressed their gratitude to the Government of Japan for its initiative in proposing the meeting and for offering to act as its host.

13. The Director General thanked the Government of Japan for this welcome initiative and said that it was highly desirable to have this meeting in Tokyo and that, thanks to the generous offer of the host Government, the meeting would not cause significant expenses for WIPO.

14. The Assembly having noted that the proposed meeting, which would be concerned mainly with questions affecting the activities of the International Searching and International Preliminary Examining Authorities, would derive benefit from being hosted by an Office appointed to act in that capacity by the Assembly, accepted with thanks the offer of the

Government of Japan for the hosting of the meeting by the Japanese Patent Office and decided to hold the meeting in Tokyo in the second half of 1981.

Proposal to Amend Rule 72.1(a)

15. The Assembly took note of a request made by the Delegation of Brazil, supported by the Delegation of Portugal, that Rule 72.1(a) be amended to include a reference to the Portuguese language. The Delegation of Brazil informed the meeting of an opinion on the requirements of the Brazilian Legal Code with regard to documents intended to have a legal effect in Brazil which had been given by the Legal Advisor to the national Office of Brazil. The Assembly decided that the question be included on the agenda of its next extraordinary session in 1981.

Adoption of the Report of the Session

16. This report was unanimously adopted on September 26, 1980.

[The Annex follows]

Rule 22
Transmittal of the Record Copy

22.1 [No change]

22.2 Alternative Procedure

(a) [No change]

(b) [No change]

(c) [No change]

(d) [No change]

(e) Where the receiving Office does not hold the record copy at the disposal of the applicant by the date fixed in paragraph (d), or where, after having asked for the record copy to be mailed to him, the applicant has not received that copy at least 10 days before the expiration of 13 months from the priority date, the applicant may transmit a copy of his international application to the International Bureau. This copy (“provisional record copy”) shall be replaced by the record copy or, if the record copy has been lost, by a substitute record copy certified by the receiving Office on the basis of the home copy, as soon as practicable and, in any case, before the expiration of 15 months from the priority date.

22.3 Time Limit under Article 12(3)

(a) The time limit referred to in Article 12(3) shall be:

(i) where the procedure under Rule 22.1 or Rule 22.2(c) applies, 15 months from the priority date;

(ii) where the procedure under Rule 22.2(d) applies, 14 months from the priority date, except that, where a provisional record copy is filed under Rule 22.2(e), it shall be 14 months from the priority date for the filing of the provisional record copy, and 15 months from the priority date for the filing of the record copy.

(b) [Deleted]

22.4 [No change]

22.5 [No change]

Rule 80
Computation of Time Limits

80.1 [No change]

80.2 [No change]

80.3 [No change]

80.4 [No change]

80.5 [No change]

80.6 Date of Documents

(a) [No change]

(b) Any receiving Office may exclude the application of the second sentence of paragraph (a) by a written notification to that effect given to the International Bureau by September 1, 1980. Such notification may be withdrawn at any time. The International Bureau shall publish all such notifications and withdrawals in the Gazette.

80.7 [No change]

Rule 82
Irregularities in the Mail Service

82.1 Delay or Loss in Mail

(a) Any interested party may offer evidence that he has mailed the document or letter 5 days prior to the expiration of the time limit. Except in cases where surface mail normally arrives at its destination within 2 days of mailing or where no airmail service is available, such evidence may be offered only if the mailing was by airmail. In any case, evidence may be offered only if the mailing was by mail registered by the postal authorities.

(b) [No change]

(c) [No change]

82.2 Interruption in the Mail Service

(a) Any interested party may offer evidence that on any of the 10 days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.

(b) [No change]

Schedule of Fees

<u>Fees</u>	<u>Amounts</u>
1. Basic Fee: (Rule 15.2(a)) if the international application contains not more than 30 sheets	432 Swiss francs
if the international application contains more than 30 sheets	432 Swiss francs plus 8 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	104 Swiss francs
3. Handling Fee: (Rule 57.2(a))	133 Swiss francs
4. Supplement to the Handling Fee: (Rule 57.2(b))	133 Swiss francs
<u>Surcharges</u>	
5. Surcharge for late payment: (Rule 16bis.2(a))	Minimum: 200 Swiss francs Maximum: 500 Swiss francs

[End of Annex
and of document]

WIPO



PCT/A/VII/15
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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Seventh Session (5th Extraordinary) Geneva, June 29 to July 3, 1981

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly of the International Patent Cooperation (PCT) Union (hereinafter referred to as "the Assembly") held its seventh session (5th extraordinary) in Geneva from June 29 to July 3, 1981.
2. The following 20 Contracting States were represented at the session: Australia, Austria, Brazil, Congo, Denmark, Finland, France, Germany (Federal Republic of), Hungary, Japan, Liechtenstein, Luxembourg, Netherlands, Norway, Romania, Soviet Union, Sweden, Switzerland, United Kingdom, United States of America.
3. The following five States participated in the session as observers: Iraq, Italy, Niger, Spain and Zaire.
4. Two intergovernmental organizations, the African Intellectual Property Organization (OAPI) and the European Patent Organisation (EPO), and the following eight international non-governmental organizations, were represented by observers: Asian Patent Attorneys Association (APAA), Committee of National Institutes of Patent Agents (CNIPA), European Federation of Agents of Industry in Industrial Property (FEMIP), Inter-American Association of Industrial Property (ASIPI), International Association for the Protection of Industrial Property (IAPIP), International Federation of Inventors' Associations (IFIA), International

Federation of Patent Agents (FICPI) and Union of Industries of the European Community (UNICE).

5. The number of participants was about 60. The list of participants is contained in Annex I to this Report.

OFFICERS OF THE SESSION

6. The Assembly appointed Mr. J. Dekker (Netherlands) as acting Chairman in the absence of Mr. H. J. Winter (United States of America), Chairman, and Mr. I. Nayashkov (Soviet Union), Vice-Chairman.

7. Mr. E. M. Haddrick, Director, PCT Division, WIPO, acted as Secretary of the Assembly.

OPENING OF SESSION; ADOPTION OF THE AGENDA

8. The session was opened, on behalf of the Director General, by Mr. K. Pfanner, Deputy Director General of WIPO.

9. The Assembly adopted its agenda as contained in document PCT/A/VII/1.Rev. with the addition, under item 3(c) thereof, of a reference to document PCT/A/VII/13.

AMENDMENTS TO THE PCT REGULATIONS

Amendments Other Than to the Schedule of Fees

10. Discussions were based on documents PCT/A/VII/2, 3, 6, 11 and 13.

11. Following the discussion of the proposals contained in document PCT/A/VII/2, and 11 and consequential upon the results of the consultations which had taken place on the modification of the "Request" form (see paragraphs 73 to 76, below), the Assembly adopted, with effect on and from October 1, 1981, amendments to Rules 3.3(a), 4.1(c), 4.4(c) and (d) and 4.6(b). The text of the amendments is set out in Annex II to this Report.

12. In the course of the discussions concerning the proposed amendment of Rule 91.1, there was general sympathy with the underlying principle of the proposal of the International Bureau to permit the rectification of errors occurring in the request according to a less stringent test than in the case of errors occurring in the description, claims and drawings. A number of Delegations of States and intergovernmental organizations (hereinafter referred to as "Delegations") and the Representatives of the international non-governmental organizations (hereinafter referred to as "NGO Representatives") expressed also agreement with the proposal of the International Bureau as drafted in a modified version prepared by the International Bureau in the light of the discussions, while views were divided on the question of whether a special provision, excluding the omission of designations from rectification, was required.

13. A number of Delegations and NGO Representatives supported furthermore the intention underlying the drafts prepared by the International Bureau to align the provisions of Rule 91 with Rule 88 of the Implementing Regulations to the European Patent Convention. In this context, the International Bureau drew attention to the fact that already the provisions on certain non-rectifiable omissions in the present text (Rule 91.1(c)), and even more so an amendment excluding omission of designations from rectification, had no counterpart in the Implementing Regulations to the European Patent Convention, so that the PCT would continue to be, or would become, more stringent than the European system on that question.

14. The Delegations expressing concern about the admission of corrections in certain cases of erroneous omission of designations, resulting from the original draft amendment submitted by the International Bureau, stated that in their opinion this would lead to recognition of “later designations” in certain cases. Later designations, however, should not be allowed in any circumstances. Consequently, they were in favor of amending Rule 91.1 in a way that would exclude rectification of omissions of designations from rectification. Those Delegations added, however, that they were not opposed to the rectification of designations made which were erroneously defective. Other Delegations expressed the opinion that the amendment proposed by the International Bureau in its original version would not lead to allowing later designations as one of the conditions for the rectification was that a designation, which was demonstrably intended at the time of filing, was erroneously omitted from the request. Consequently, those Delegations were not in favor of the amendment referred to above tending to exclude all omissions of designations from rectification. Several Delegations were also concerned, on the other hand, about possible *e contrario* arguments as regards the question of rectification of other kinds of omissions if omitted designations *per se* were expressed to be not rectifiable. The NGO Representatives declared that already the present text of Rule 91.1(c), excluding rectification in all cases of omission of elements or sheets of the international application, was objectionable from the point of view of the users of the PCT system. This objection applied even more to the proposed extension of that Rule to the exclusion of omissions of designations from rectification.

15. In view of prevailing differences of opinion, a majority of Delegations was in favor of deferring a decision to a later session of the Assembly. The Chairman concluded that a deferment of the decision to the next session of the Assembly was inevitable in view of the fact that time did not permit at this session to resolve the remaining differences of opinion.

16. In the course of the adoption of the amendment to Rule 3.3(a), the proposal to delete this Rule and to transfer its contents to the Administrative Instructions, as contained in document PCT/A/VII/11, was withdrawn by the Delegation of Switzerland upon the understanding that the proposal would be included in the study by the International Bureau referred to in paragraphs 54 to 63, below.

17. The amendment of Rule 4.4(d) was adopted to allow the applicant or the common representative to indicate a second address (in Box No. IV of the “Request” form) which would be used for the sending of notices. It was envisaged that advantage could be taken of this possibility, in particular, by corporations wishing to have correspondence addressed to their patent departments while wishing to retain their headquarters address for other purposes.

18. The proposals for amendment of Rules 4.7 and 4.8 and a new Rule 4.10*bis*, contained in document PCT/A/VII/2, Annex B, were withdrawn by the International Bureau.

19. The Assembly decided that the matter raised by the proposed amendment of Rule 34 contained in document PCT/A/VII/6 should be studied first by the Committee for Technical Cooperation. A large majority of Delegations found the proposal useful and expressed general sympathy with its aim. The Assembly noted in this context a declaration by the Delegation of the United States of America that it could not accept the proposed amendment with the consequence that the amendment could not be adopted since the requirement of Rule 88.3 would not be fulfilled.

20. The Assembly considered the correction of the French text of Rule 92.4(b), as contained in document PCT/A/VII/13, and adopted the proposed French text as set out in Annex II to the French version of this Report.

Amendment of the Schedule of Fees

21. Discussions were based on document PCT/A/VII/8.

22. The Assembly fixed the amounts of the fees as proposed in document PCT/A/VII/8 with effect on and from January 1, 1982, and accordingly amended with effect on and from that date, the Schedule of Fees annexed to the PCT Regulations. The Assembly also decided that, for the purpose of fixing new amounts in currencies other than Swiss francs, the rates of exchange between such currencies and Swiss francs on October 1, 1981, shall be used. The amended Schedule of Fees is set out in Annex II to this Report.

23. The Delegations of Brazil and Romania declared that, while not objecting to the Schedule of Fees as now agreed upon, they were in general in favor of lower fees for nationals of developing countries. The application of this principle to the PCT would promote accession to PCT by developing countries and its use by such countries. That question should be studied with a view to taking a decision at a later stage on the occasion of a reconsideration of PCT fees. The Delegation of the United States of America said that its established position was that reductions of amounts of fees could only be considered on the basis of the individual economic situation of applicants but not on the basis of nationality. The Assembly noted a statement by the International Bureau, that the said question would be studied in the framework of the general study referred to in paragraphs 54 to 63, below.

24. The Assembly noted, furthermore, a proposal by the Delegation of the EPO to study the desirability of allowing, for a transitory period following the entry into force of new amounts of fees, supplementary payments by applicants who erroneously made their payment on the basis of the old amounts of fees, thus preserving their rights. The question of the possible adoption of such transitory provisions should be included into the study referred to in paragraphs 54 to 63, below.

Mailing Costs of the International Bureau

25. In the course of the discussions concerning the fixing of new amounts of the PCT fees, the International Bureau said that the report of the PCT Management and Budget Consultants Group, which had met recently to consider the PCT budget, had expressed concern about the PCT mailing costs (see document PCT/MBCG/II/5).

26. The PCT Management and Budget Consultants Group had expressed the view that savings could be achieved if some national Offices which received several copies of the

pamphlet by air mail would agree to accept one copy by airmail and the rest by surface mail. The Group had also suggested that savings could be achieved if Offices were not to place blanket requests for copies of priority documents.

27. The International Bureau said that even if the national Offices which at present had blanket requests would wait until it was certain that the application had entered the national phase before requesting a copy of the priority document, considerable savings could be achieved. Another way of achieving savings would be if Offices would agree to receive the Article 20 communication copy of the international application by a lower category of mailing, such as printed matter. In effect, this would mean that the Offices would agree to accept the risk that the communication copy might take longer to reach them than at present.

28. The Assembly noted that the International Bureau would communicate with the Offices whose cooperation would be necessary if savings were to be achieved as suggested by the PCT Management and Budget Consultants Group.

INTERPRETATION OF ARTICLE 9 OF THE PCT

29. The discussion was based on document PCT/A/VII/3.

30. The Assembly adopted the interpretation that Article 9 is not concerned with the capacity in which a person who as applicant files an international application is acting when filing the application. In other words, even if, in fact, the applicant is acting in a representative capacity (e.g., the applicant is a person who is administering the estate of a deceased person or is a person in whom the law vests property and/or rights of another person in a particular situation, such as in the case of the insanity of the person properly entitled) it is not for the receiving Office to attempt to go behind the person who is the applicant and to treat some other person as being the applicant when it is determining the right to file the international application (Article 9 and Rules 4.8 and 18.4) or the competent receiving Office (Articles 10 and 11(1)(i) and Rule 19.1(a)) by reference to the nationality or residence of the applicant.

31. The Assembly noted a statement by the Delegation of Japan that it could not associate itself with the decision of the Assembly since, under the Japanese legal system, a person acting in a representative capacity would not be entitled to be the applicant (i.e., would not be entitled to exercise in his own name the rights of the represented person). In this context, the attention of the Delegation of Japan was drawn to the fact, that in view of this situation, it would seem that Japan was not concerned by the interpretation referred to above.

32. The Assembly also noted a statement by the Delegation of the United States of America that, in accordance with its national law, a person who was not the actual inventor could be accepted as the applicant by the United States of America as a designated State only in cases where that person was legally entitled to act on behalf of a deceased or mentally incapacitated inventor.

THE PCT INTERNATIONAL MEETING (TOKYO)

33. Discussions were based on document PCT/A/VII/9.

34. The Assembly took note of the Report of the PCT International Meeting (document PCT/TIM/I/13) held in Tokyo from May 25 to 29, 1981, and of the intention of the International Bureau to follow up in due course all matters discussed during the said meeting which required further action and were not specifically referred to in document PCT/A/VII/9.

Translation of Documents Cited in the International Search Report

35. The Assembly endorsed the views expressed in the Report (document PCT/TIM/I/13, paragraphs 21 to 23) as to the importance of including in international search reports as much patent family information as is feasible under the circumstances and avoiding in the national phase the requiring of translations of references cited in the international search report. Placing the applicant who follows the PCT route in a less favorable position than applicants who do not follow that route should in particular be avoided. The action proposed by the International Bureau to make appropriate recommendations to the designated and elected Offices as well as to the International Searching Authorities was endorsed.

The Usefulness of International Search Reports in the National Phase

36. The Assembly noted the conclusions reached by the PCT International Meeting (document PCT/TIM/I/13 paragraphs 32 and 33) as to the usefulness of the international search report and endorsed the intention of the International Bureau to bring the conclusions to the attention of all designated and elected Offices. This would include, in particular, stressing the importance of the international search report for the avoidance of duplication of search effort by the designated Offices and the need to reflect, as far as possible, economies made in the national procedure in certain benefits for the applicant, e.g., reduction of national fees or acceleration of the procedure for the grant of the patent.

37. In this context, the Delegation of the EPO stated that continued efforts would be required towards further harmonization of search methods and quality of search and indicated the readiness of the EPO to participate in such efforts in both multilateral and bilateral cooperation.

Announcing of Certain Facts in the Gazette

38. The Assembly endorsed the interpretation of Rule 48.6 and of Rules 29.2 and 51.4 according to which it would suffice if the information required under Rules 29.2 and 51.4 would be supplied by the designated and elected Offices on an annual basis in the form of statistical data. The Assembly noted the intention of the International Bureau to send a circular to all Offices concerned outlining the manner in which, the period for which and the date by which such data will be required to be given. The combined data would then be published in the PCT Gazette.

Usefulness of International Preliminary Examination Reports for the National Phase

39. The Assembly noted the conclusions reached in the Report (document PCT/TIM/I/13, paragraph 43) as to the usefulness of the international preliminary examination report and endorsed the action proposed by the International Bureau. This action will consist of bringing the conclusions reached by the PCT International Meeting to the attention of all elected Offices and of stressing the importance of the international preliminary examination report for

the avoidance of duplication of examination effort by the elected Offices and also the need to reflect, as far as possible, economies made in the national procedure in certain benefits to the applicant, for instance, through an appropriate reduction of national fees or the acceleration of the procedure for the grant of the patent.

Extension of Time Limit for Establishment of International Preliminary Examination Report and Change of the Provision of Rule 70.6

40. The Assembly considered the views expressed in paragraphs 45 to 49 of the Report (document PCT/TIM/I/13).

41. The Assembly adopted the view expressed in the Report that no extension of the time limit for a reply to a written opinion (Rule 66.2(d)) was required since the present text of the said Rule was flexible enough to give the applicant sufficient time for a reply.

42. After considering whether the time limit for the establishment of the international preliminary examination report (Rule 69.1(a)) should be extended in special cases (upon express request by the applicant and provided that the International Preliminary Examining Authority thinks fit, on the basis put forward by the applicant, to allow an extension) the Assembly invited the International Bureau to study further the question of an amendment to Rule 69.1(a) and to prepare a proposal for its consideration at a subsequent session.

43. The Assembly agreed that Rule 70.6 dealing with the statement under Article 35(2) contained in the international preliminary examination report would not require to be amended in such a way as to allow the possibility of explanations to be given in cases where a positive statement under Article 35(2) could only be made if the claim were to be amended. A modified international preliminary examination report form (form PCT/IPEA/409) which the Director General intended to promulgate (see paragraph 45, below) would provide sufficient possibilities for giving explanations of such a nature that, where a claim was patentable only in an amended version, the applicant or the elected Office could easily identify the required amendment, without the need for the Authority to propose a revised version of the claim, which was considered not to be desirable.

Amendments to Sections 503, 505 and 507 of the Administrative Instructions

44. The Assembly noted the intention of the Director General to modify Sections 503, 505 and 507 of the Administrative Instructions as set out in Annex II to the Report (document PCT/TIM/I/13).

Modifications of Certain Forms Related to International Search and Preliminary Examination

45. The Assembly noted that amended Forms (referred to in paragraphs 36 to 41 and 56 of the Report (document PCT/TIM/I/13)) would be promulgated in due course.

46. The Assembly noted a statement by the Delegation of Romania that, since it had had no time to consider the document before the Assembly, it would reserve its position.

APPLICATIONS OF NATIONAL REMEDIES FOR PRESERVING THE RIGHTS OF APPLICANTS

47. Discussions were based upon document PCT/A/VII/5, containing a proposal submitted by the Royal Patent and Registration Office of Sweden which had been before the Assembly at its 5th session (document PCT/A/V/10) but had been deferred due to a lack of time. The proposal concerned the application, in favor of PCT applicants, of provisions which can be availed of by national applicants to preserve their rights which might otherwise be jeopardized in the case of error and the treatment, in the application by national Offices of measures available in the case of official mistakes, of a mistake by any of the PCT Authorities as if it were a mistake of the national Office.

48. A majority of the Delegations as well as the NGO Representatives and the International Bureau made statements expressing their firm interest in and support for the general objective to which the proposal was directed.

49. Several Delegations indicated that their PCT implementing laws fully satisfied the objectives of the proposal. Some Delegations, while supporting the objectives in principle, felt that there was a need for further study to identify the particular cases in which the proposal would apply.

50. The NGO Representatives and the International Bureau underlined the importance of consideration being given to implementing in national laws the possibility, provided under Article 24(2), for the designated Offices to continue international applications in effect even where this was not required under the provisions of Article 25. This was of importance in relation to the possible late transmission of the record copy to the International Bureau which was one of the reasons frequently cited against the use of the PCT system (although among the roughly 9,500 international applications filed so far, there was no such case).

51. The International Bureau also underlined the importance of the application of national provisions which could preserve the rights of applicants in the case of a failure to meet the time limit for entry into the national phase. There were instances where Contracting States only applied their national remedies once the applicant had successfully entered the national phase. This was contrary to Article 48(2)(a) which required that Contracting States shall excuse, for reasons admitted under the national laws, any delay in meeting a time limit and this included the case of the performance of the acts necessary to enter the national phase since the national remedies must be available as from the international filing date.

52. Some Delegations referred specifically to the importance of the proposal that, in applying national remedies which cover “official mistakes,” a mistake by any PCT authority should be taken into account. The Delegation of Japan said, however, that it doubted whether it could accept such a proposal since it would seem to be based upon the principle of joint responsibility amongst PCT Authorities which that Delegation found it difficult to accept.

53. In conclusion, the Assembly noted with approval the objectives of the proposal submitted by the Royal Patent and Registration Office of Sweden, urged all PCT Offices and authorities to seek to achieve them and invited the International Bureau to include the question in its study of the PCT (see paragraphs 54 to 63, below).

STUDY OF THE PCT BY THE INTERNATIONAL BUREAU

54. Discussions were based on document PCT/A/VII/4, containing a memorandum setting out a proposal of the Government of Sweden, document PCT/A/VII/11, containing a proposal submitted by the Delegation of Switzerland, and document PCT/A/VII/11.Add., containing a communication by the Delegation of France supporting the proposal made by the Delegation of Switzerland. Following the Introduction of the proposals by the Delegations of Sweden and Switzerland, the Assembly discussed them together.

55. The Delegation of Sweden, stating its continued full support for the PCT and its objectives and its recognition of the fact that the PCT had proven its practical value in the past years, explained that its proposal for a study of the PCT by the International Bureau was not directed towards a basic revision of the system; its intention was to facilitate the achievement of the objectives of the PCT in order to promote the wide use which the PCT deserved. It recalled that the objectives of the PCT included simplifying and making more economical the obtaining of protection for inventions and also assisting the developing countries. The study should seek to simplify further the obtaining of protection for inventions through the use of the PCT with a view to increasing its use. The study should find out what the problems were at present that gave rise to suggestions that the procedure was too complex and suggest solutions to them.

56. A great number of Delegations supported the Swedish proposal. All agreed that it was not intended to question either the purposes of the PCT or the proven usefulness and adequacy of the general principles on which the PCT was based or of the principle of distribution of functions over various Offices and Authorities through which the PCT system operates. This was important to bear in mind since the PCT, during the first three years of its operations, had proven to be a very useful and effective means of cooperation in the patent field, and since one should not create the impression that it needed basic substantive changes. It was also agreed that the study should aim at achieving a simplification of the system for both users and Offices as well as the PCT Authorities, having regard to practical problems revealed by experience in its operation, and at increasing the attractiveness of the system for the users. Several Delegations said that the situation of the developing countries should be taken into account in the study in order to allow those countries to derive full benefit from participating in the PCT system and thus promote accession by those developing countries not yet party to the Treaty. Some Delegations said that the study should be limited to reviewing the Regulations and Administrative Instructions and should not extend to the Articles of the Treaty, since this could lead to a revision of the Treaty and imply the convening of a Diplomatic Conference to revise the Treaty, which was considered premature so soon after its entry into force. Moreover, a revision of the Treaty at this stage could affect the credibility of the system with the users and States wishing to adhere. Other Delegations and NGO Representatives said that the study could not be carried out properly if any such limitations were imposed in advance and that, in particular, the consideration of Articles of the Treaty should not be excluded, the more so as certain of the repeatedly stated problems could probably only be solved by an appropriate revision of some of those Articles. It was also stated that there was a need to include in the study the implementation of the PCT system in the Contracting States of the PCT and, in particular, potential pitfalls and difficulties for the user when entering the national phase, and that ways and means should be found to ensure direct application by all countries of the amendments made to the Regulations by the Assembly. In this context, attention was drawn to the usefulness of assistance by the

Contracting States and the users of the system in providing material relevant for purposes of the study.

57. The Delegation of Switzerland introduced its proposal by explaining that provisions in the PCT Regulations which it was not necessary to retain therein and which could be transferred to the Administrative Instructions should, after a study by the International Bureau to identify them, be transferred to the Administrative Instructions. The proposal was intended to enable changes to be made affecting the PCT procedure without burdening national authorities, particularly in those countries where amendments to the PCT Regulations had to be reproduced in the official journal containing national legislation. This would not only ease the burden on the national authorities, but should allow greater flexibility in making changes to the PCT procedure.

58. A number of Delegations, in addition to the Delegation of France which had previously expressed its support in writing, expressed strong support for the proposal of the Delegation of Switzerland.

59. The Chairman suggested that the study of the proposal of the Delegation of Switzerland should be carried out in combination with the study proposed by the Government of Sweden. In studying the implications of the proposal of the Delegation of Switzerland, one should apply care and prudence and not only examine what could be transferred to the Administrative Instructions, but also what the implications of such transfer in terms of advantages or disadvantages for the users could be. In general, one should not overestimate the benefit for the users of a transfer of otherwise unchanged provisions from the Regulations to the Administrative Instructions.

60. In conclusion, the Assembly decided to entrust to the International Bureau the study proposed by the Government of Sweden, together with the study necessary to implement the proposal of the Delegation of Switzerland. For the carrying out of the combined study, the following conclusions were reached:

A. As to the proposal of the Government of Sweden:

(i) it was understood that the study would be based on experience to date of applicants who have filed applications under the PCT and of the Offices and the PCT Authorities, including the International Bureau, in processing such applications;

(ii) the study should establish the needs of the users and the Offices and Authorities implementing the PCT with respect to simplifying and improving its practical implementation, identify any complexities and pitfalls in the procedure and propose solutions which would make the system more attractive and less onerous for the users and the Offices;

(iii) the study should be directed primarily to a review of the PCT Regulations and Administrative Instructions but should not exclude, where necessary, consideration of relevant Articles of the Treaty while avoiding proposals for a basic revision of the Treaty changing its fundamental structure. Proposals requiring revision of the Treaty should be clearly identified as such and, where various solutions could be found to a problem, the solution not requiring revision should be given preference;

(iv) it was understood in that context that the Assembly would, in any event, consider the results of the study, so that the decision not to exclude the Treaty from the study did not prejudice the eventual decision as to whether changes in the Treaty as well as in the Regulations and Administrative Instructions should be undertaken to achieve the benefits expected to be derived as a result of the study;

(v) the study should also deal with problems concerning the national phase of the PCT procedure;

(vi) specific problems of the developing countries with respect to the implementation of the Treaty should be taken into account in the general context of the study;

(vii) the proposals made, or to be made, by the users of the system, including those contained in documents PCT/A/VII/12 and 12.Add., should be taken into account for the preparation of the study.

B. As to the proposal of the Delegation of Switzerland:

(i) proposals for the transfer of provisions from the Regulations to the Administrative Instructions should only be made with respect to provisions not affecting the applicant or national law and should therefore be limited to provisions such as those dealing with the communications among Offices and PCT Authorities;

(ii) proposals for transfer should take into account the need for completeness and easy comprehension of the provisions in both texts;

(iii) the implications of a transfer in terms of advantages and disadvantages for the users should be considered before making proposals, keeping the overall objective of the combined study in mind.

61. The Delegation of France felt, for its part, that the study referred to in paragraph 60A(iii) should, as a general rule, avoid any proposal for revision of the Treaty and not only its basic revision.

62. The International Bureau stated its preparedness to undertake the combined study entrusted to it by the Assembly. As far as that part of the study deriving from the proposal of the Swedish Government was concerned, the International Bureau intended to draw on the experience of the Offices and authorities involved in the operation of the PCT system as well as that of the PCT applicants, especially through the organizations representing the interested circles. The study should be done as quickly as possible but would necessarily take some time to be carried out and probably the Committee for Administrative and Legal Matters would be convened to consider and advise upon the preliminary conclusions of the International Bureau before the results of the study would be presented to the Assembly.

63. The Assembly expressed the desire that, as far as possible, further changes of the Regulations should now await the outcome of the study. It agreed, however, that, in view of the fact that the study would be wide-ranging with a view to finding a comprehensive solution to problems affecting the PCT procedure, and that a certain degree of delay would occur before changes resulting from it would be made, necessary changes in the PCT Regulations,

which might come to notice during the time occupied by the study and could not await its results, would nevertheless have to be considered and decided upon.

Proposals from Organizations Representing PCT Users for Further Improvements in the PCT System

64. The Assembly, having noted documents PCT/A/VII/12 and 12.Add., containing proposals from organizations representing PCT users, decided that the proposals should be considered within the framework of the study to be undertaken by the International Bureau, referred to in paragraphs 54 to 63, above.

OPERATION OF RULE 16BIS

65. The Assembly noted an oral report given by the International Bureau that the charging to it of amounts required to cover fees not paid to receiving Offices by applicants within the prescribed time limit had occurred only in a few cases (less than 20) and that, in many cases, the procedure under Rule 16bis was, in any event, not complete. The International Bureau was therefore not in a position to give a substantive report on the operation of the system established by Rule 16bis at the present session. The Assembly noted the statement of the International Bureau.

DEVELOPMENT OF THE PCT UNION

66. Discussions were based on document PCT/A/VII/10.

Promotion of Acceptance of the PCT

67. The Assembly noted an intervention by the Delegation of Spain expressing the continued interest of its country in the consideration, in close contact with the International Bureau, of certain questions, in particular relating to the use of the Spanish language, bearing upon its possible accession to the PCT. The International Bureau, referring to the ongoing discussions with Spain in cooperation with the European Patent Office, expressed its continued willingness to assist in resolving those problems. The Chairman, noting the urgency and importance of that matter in view of its bearing on the participation of Spain and the Latin American countries of Spanish language in the PCT system, said that these considerations should be pursued with priority and outside the study referred to in paragraphs 54 to 63, above.

68. The Assembly, noting the report of the International Bureau on the present state of membership of the Treaty, confirmed unanimously the resolution previously adopted by it at its 5th session and reproduced in Annex III.

Regional Treaties

69. The Assembly, on the basis of the report of the International Bureau, reaffirmed its position, taken at its said 5th session, at which it “took note of the situation which resulted from the fact that not all member States of certain regional patent treaties were also members of the PCT Union and, in this regard, noted, furthermore, the disadvantages resulting

therefrom for the applicant since the latter could not fully benefit from the advantages to be obtained by using the PCT system and the regional system by filing a single application, disadvantages which make it desirable for the users of the PCT system that the said States adhered as soon as possible to the Treaty.”

Chapter II of the PCT

70. The Assembly, on the basis of a report by the International Bureau, noted that, following the withdrawal by France of its reservation excluding the application of Chapter II, only six of the 30 Contracting States party to the PCT continued to maintain such reservations, and renewed the expression of its interest, formulated at its said 5th session, in the acceptance of Chapter II by all Contracting States.

COMPOSITION OF THE COMMITTEE FOR TECHNICAL COOPERATION (PCT/CTC) AND THE COMMITTEE FOR TECHNICAL ASSISTANCE (PCT/CTA)

71. Discussions were based on document PCT/A/VII/7.

72. The Assembly decided that:

(1) with regard to the PCT Committee for Technical Cooperation,

(a) all Contracting States, in addition to the *ex officio* members according to PCT Article 56(2)(b), shall, until the ordinary session of the Assembly in 1985, be members of the said Committee, provided that the said Committee continues, until that time, to meet in joint sessions with the WIPO Permanent Committee on Patent Information and the membership of the latter remains unrestricted,

(b) the Assembly will, in the event that the said Committee ceases, before that time, to meet in joint sessions with the WIPO Permanent Committee on Patent Information or the membership of the latter Committee ceases to be unrestricted, reconsider, at its next session following such event, the question of the composition of the said Committee;

(2) with regard to the PCT Committee for Technical Assistance,

(a) all Contracting States shall, until the ordinary session of the Assembly in 1985, be members of the said Committee, provided that the said Committee continues, until that time, to meet in joint sessions with the WIPO Permanent Committee on Development Cooperation Related to Industrial Property and the membership of the latter remains unrestricted,

(b) the Assembly will, in the event that the said Committee ceases, before that time, to meet in joint sessions with the WIPO Permanent Committee on Development Cooperation Related to Industrial Property or the membership of the latter Committee ceases to be unrestricted, reconsider, at its next session, the question of the composition of the said Committee.

CONSULTATIONS RELATING TO THE ADMINISTRATIVE INSTRUCTIONS

73. On the occasion of the present session of the Assembly, consultations were held with the Offices which are the PCT receiving Offices concerning the "Request" form (Annex F of the Administrative Instructions) and related Sections of the Administrative Instructions, as provided in PCT Rule 89.2(a). The results of such consultations, as reflected in the following paragraphs, were noted by the Assembly on the basis of a report by the International Bureau.

74. The consultations were based on the proposed modifications set out in document PCT/A/VII/2. The Assembly was informed that the said consultations had resulted in the approval of a revised "Request" form (form PCT/RO/101), amendments of Sections 201, 202 and 203 and the deletion of Section 206 of the Administrative Instructions. The revised "Request" form is set out in Annex IV of this Report and the modifications to the Sections of the Administrative Instructions are set out in Annex V of this Report.

75. At the suggestion of the USSR State Committee for Inventions and Discoveries, and with the support of other Offices and the NGO Representatives, the revised "Request" form would include, in addition to the four sheets originally proposed by the Director General of WIPO, a "continuation sheet" containing four sub-boxes for the indication of additional persons in Box III. This would allow an easy and uniform indication of the required data in case of more than three applicants and/or inventors. The inclusion of this sheet as part of the "Request" form would be optional for the receiving Offices (who could, if they wished, not provide such a sheet to applicants) and for the applicants who could, even where the sheet was provided, choose instead to use the Supplemental Box.

76. The Assembly noted that the modified "Request" form and the modified Administrative Instruction would be promulgated by the Director General with October 1, 1981, as the date of their entry into force. An updated version of the second sheet of the "Request" form (containing the listing of the PCT Contracting States for the purpose of the designations being indicated) would be issued from time to time depending on changes in the PCT Contracting States.

77. The Assembly decided that, for a transitory period expiring on March 31, 1982, the present version of the "Request" form could still be used by applicants. The use of the present "Request" form after that date would have no effect on the international filing date but would result in the invitation by the receiving Office to the applicant to furnish the request on the new form as set out in Annex IV.

78. The Assembly also noted that the consultations resulted in the approval of providing for the possibility of indicating on the Fee Calculation Sheet a request to deduct the fees from a deposit account (if the receiving Office concerned provided for such accounts to be established) and that the International Bureau would study the possibility of including on the bottom of the Fee Calculation Sheet a box for the indication of an amount due for the preparation of a copy of a priority document by the receiving Office. The International Bureau stated that the new Fee Calculation Sheet would be prepared and promulgated as soon as possible.

CLOSING STATEMENTS

79. At the close of the session, Deputy Director General Mr. R. Pfanner informed the Assembly that the Director of the PCT Division, Mr. E. M. Haddrick, had resigned from his post with effect from October 31, 1981. He underlined the important contribution made by Mr. Haddrick in connection with the development of the PCT system and extolled his merits during the preparatory period prior to the entry into force of the Treaty and during the first years of practical operations under the PCT. It was with regret that the International Bureau saw the departure of Mr. Haddrick.

80. The Chairman, speaking on behalf of the Assembly, thanked Mr. Haddrick for the outstanding work which, thanks to his excellent qualifications and his extensive knowledge, he was able to perform in this important position for the benefit of the PCT system and expressed the Assembly's best wishes for his personal and professional future.

81. The Assembly adopted this Report unanimously
at its closing meeting on July 3, 1981.

[Annexes follow]

ANNEX I/ANNEXE I

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS

(in the English alphabetical order of the names of the States)
(dans l'ordre alphabétique anglais des noms des Etats)

I. MEMBER STATES/ETATS MEMBRES

AUSTRALIA/AUSTRALIE

Mr. C. H. FRIEMANN, Deputy Commissioner of Patents, Australian Patent Office,
Canberra

AUSTRIA/AUTRICHE

Dr. J. FICHTE, Vice-President, Austrian Patent Office, Vienna

BRAZIL/BRESIL

M. A. G. BAHADIAN, Conseiller, Mission permanente, Genève

Mrs. M. M. R. MITTELBAACH, Vice-Director, Patent Department, National Institute of
Industrial Property, Rio de Janeiro

Miss A. R. HOLANDA CAVALCANTI, Assistant to Patent Director for International
Affairs, National Institute of Industrial Property, Rio de Janeiro

CONGO

M. E. KOULOUFOUA, Chef du Bureau des Brevets et Marques, Ministère de l'Industrie,
Antenne Nationale de propriété Industrielle, Brazzaville

M. D. NKOUNKOU, Chef de Division des Organisations internationales du système des
Nations Unies, Ministère de la Coopération, Brazzaville

DENMARK/DANEMARK

Mrs. D. SIMONSEN, Chief of Division, Patent and Trademark Office, Copenhagen

Mr. J. DAM, Head of Section, Patent and Trademark Office, Copenhagen

FINLAND/FINLANDE

Mr. T. KIVI-KOSKINEN, Director General, National Board of Patents and Registration,
Helsinki

Mr. V. SORALAHTI, Attaché, Permanent Mission, Geneva

FRANCE

M. G. J. VIANES, Directeur de l'Institut national de la propriété industrielle, Paris

M. P. GUERIN, Attaché de direction, Institut national de la propriété industrielle, Paris

M. J. VERONE, Division administrative des brevets, Institut national de la propriété industrielle, Paris

GERMANY (FEDERAL REPUBLIC OF)/ALLEMAGNE (REPUBLIQUE FEDERALE D')

Mr. U. C. HALLMANN, Leitender Regierungsdirektor, German Patent Office, Munich

Mr. H. WESENER, Leitender Regierungsdirektor, German Patent Office, Munich

HUNGARY/HONGRIE

Dr. Z. SZILVASSY, Vice-President, National Office of Inventions, Budapest

Mrs. E. PARRAGH, Counsellor, National Office of Inventions, Budapest

JAPAN/JAPON

Mr. I. SHAMOTO, Director General, Department of Appeal, Japanese Patent Office, Tokyo

Mr. S. UEMURA, First Secretary, Permanent Mission, Geneva

Mr. M. FUJIOKA, Deputy Director, General Administration Division, Japanese Patent Office, Tokyo

LIECHTENSTEIN

Comte A. F. de GERLICZY-BURIAN, Chef de l'Office pour les relations internationales, Vaduz

LUXEMBOURG

M. F. SCHLESSER, Inspecteur, Ministère de l'Economie, Service de la propriété industrielle, Luxembourg

NETHERLANDS/PAYS-BAS

Mr. J. DEKKER, President, Netherlands Patent Office, Rijswijk

Mr. S. de VRIES, Deputy Member of the Patents Council, Netherlands Patent Office, Rijswijk

NORWAY/NORVEGE

Mr. P. T. LOSSIUS, Deputy Director General, Norwegian Patent Office, Oslo

Mr. I. LILLEVIK, Head of Section, Patent Department, Norwegian Patent Office, Oslo

ROMANIA/ROUMANIE

Mr. P. GAVRILESCU, Troisième secrétaire, Ministère des Affaires étrangères de la Roumanie, Bucarest

SOVIET UNION/UNION SOVIETIQUE

Mr. L. KOMAROV, First Deputy Chairman, USSR State Committee for Inventions and Discoveries, Moscow

Mr. E. BURYAK, Head, International Patent Cooperation Department, All-Union Research Institute of the State Patent Examination, Moscow

M V. POLIAKOV, Troisième secrétaire, Mission permanente, Genève

SWEDEN/SUEDE

Mr. S. NORBERG, Under-Secretary for Legal Affairs, Ministry of Commerce, Stockholm

Mr. E. TERSMEDEN, Legal Adviser, Ministry of Justice, Stockholm

Mr. L. BJÖRKLUND, Head, Patent Department, Royal Patent and Registration Office, Stockholm

Mrs. B. SANDBERG, Head, International Section, Royal Patent and Registration Office, Stockholm

SWITZERLAND/SUISSE

M. R. KÄMPF, Chef de Section, Office fédéral de la propriété Intellectuelle, Berne

M. M. LEUTHOLD, Chef de division, Office fédéral de la propriété intellectuelle, Berne

UNITED KINGDOM/ROYAUME-UNI

Mr. D. F. CARTER, Superintending Examiner, Industrial Property and Copyright Department, Patent Office, London

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Mr. H. D. HOINKES, International and Legislative Patent Specialist, United States Patent and Trademark Office, Washington, D.C.

Mr. L. O. MAASSEL, Patent Practice and Procedure Specialist, United States Patent and Trademark Office, Washington, D.C.

II. OBSERVERS/OBSERVATEURS

IRAQ

Mrs. H. WAFOR, Assistant Manager, Planning Board, Central Organization for Standardization and Quality Control, Industrial Property Division, Baghdad

ITALY/ITALIE

Prof. S. SAMPERI, Directeur, Office central des brevets, Rome

NIGER

Mlle H. A. DIALLO, Chargée des questions de la propriété industrielle, Ministère des Mines et Industries, Direction de l'Industrie, Niamey

SPAIN/ESPAGNE

Sr. A. CASADO CERVINO, Jefe, Servicio Relaciones Internacionales, Registro de la Propiedad Industrial, Madrid

Sr. A.-C. ORTEGA LECHUGA, Jefe, Servicio Examen, Clasificación de Patentes y Modelos, Registro de la Propiedad Industrial, Madrid

ZAIRE

Mme E. ESAKI-KABEYA, Première secrétaire, Mission permanente, Genève

III. INTERGOVERNMENTAL ORGANIZATIONS ORGANISATIONS INTERGOUVERNEMENTALES

AFRICAN INTELLECTUAL PROPERTY ORGANIZATION/ORGANISATION AFRICAINNE DE LA PROPRIETE INTELLECTUELLE (OAPI)

M. D. EKANI, Directeur général, Yaoundé

EUROPEAN PATENT ORGANISATION (EPO)/ORGANISATION EUROPEENNE DES BREVETS (OEB)

M. U. SCHATZ, Directeur principal, Office européen des brevets, Munich

M. G. D. KOLLE, Chef de la Section "Affaires internationales I", Office européen des brevets, Munich

IV. NON-GOVERNMENTAL ORGANIZATIONS
ORGANISATIONS NON-GOUVERNEMENTALES

ASIAN PATENT ATTORNEYS ASSOCIATION/ASSOCIATION ASIATIQUE
D'EXPERTS JURIDIQUES EN BREVETS (APAA)

Mr. T. YAMAGUCHI, Patent Attorney, Member of Japanese Group of AIPPI, Tokyo, Japan

COMMITTEE OF NATIONAL INSTITUTES OF PATENT AGENTS/COMITE DES
INSTITUTS NATIONAUX D'AGENTS DE BREVETS (CNIPA)

Mr. R. P. LLOYD, Member of Council, The Chartered Institute of Patent Agents, London, United Kingdom

EUROPEAN FEDERATION OF AGENTS OF INDUSTRY IN INDUSTRIAL
PROPERTY/FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN
PROPRIETE INDUSTRIELLE (FEMIP)

Dr. F. A. JENNY, Vice-President, c/o Patent Department, CIBA-GEIGY AG, Basel, Switzerland

INTER-AMERICAN ASSOCIATION OF INDUSTRIAL PROPERTY/ASSOCIATION
INTERAMERICAINE DE LA PROPRIETE INDUSTRIELLE (ASIPI)

Dr. F. FERRO, Member, Buenos Aires, Argentina

INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY (IAPIP)/ ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE
LA PROPRIETE INDUSTRIELLE (AIPPI)

Mr. G. R. CLARK, Membre d'honneur, Vice-President, Sunbeam Corporation, Chicago, United States of America

INTERNATIONAL FEDERATION OF INVENTORS' ASSOCIATIONS/FEDERATION
INTERNATIONALE DES ASSOCIATIONS DES INVENTEURS (IFIA)

Mr. C. P. FELDMANN, Vice-President, Glattbrugg, Switzerland

INTERNATIONAL FEDERATION OF PATENT AGENTS/FEDERATION
INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE (FICPI)

M. H. BARDEHLE, Secrétaire général adjoint, Munich, République fédérale d'Allemagne

UNION OF INDUSTRIES OF THE EUROPEAN COMMUNITY/UNION DES
INDUSTRIES DE LA COMMUNAUTE EUROPEENNE (UNICE)

Mr. C. G. WICKHAM, Chairman, Industrial Property Panel, Confederation of British Industry, London, United Kingdom

V. OFFICERS/BUREAU

Acting Chairman/Président par intérim:	Mr. J. L. DEKKER (Netherlands/Pays-Bas)
Secretary/Secrétaire:	Mr. E. M. HADDRICK (WIPO/OMPI)

VI. INTERNATIONAL BUREAU OF WIPO
BUREAU INTERNATIONAL DE L'OMPI

Mr. K. PFANNER, Deputy Director General

Mr. E. M. HADDRICK, Director, PCT Division

Mr. M. LAGESSE, Acting Director, Administrative Division

Mr. J. FRANKLIN, Deputy Head, PCT Division

Mr. B. BARTELS, Head, PCT Legal Section

Mr. D. BOUCHEZ, Head, PCT Publications Section

Mr. N. SCHERRER, Head, PCT Fees, Sales and Statistics Section

Mr. V. TROUSSOV, Senior Counsellor, PCT Legal Section

Mr. A. OKAWA, Counsellor, PCT Examination Section

[Annex II follows
L'annexe II suit]

ANNEX II

AMENDMENTS TO THE REGULATIONS UNDER THE PCT

Rule 3

The Request (Form)

3.1 [No change]

3.2 [No change]

3.3 Check List

(a) The printed form shall contain a list which, when filled in, will show:

(i) [No change]

(ii) whether or not the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a document relating to the payment of fees, and any other document (to be specified in the check list);

(iii) [No change]

(b) [No change]

3.4 [No change]

Rule 4

The Request (Contents)

4.1 Mandatory and Optional Contents; Signature

(a) [No change]

(b) [No change]

(c) The request may contain

(i) indications concerning the inventor where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application,

(ii) a request to the receiving Office to transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office.

(d) [No change]

4.2 [No change]

4.3 [No change]

4.4 Names and Addresses

(a) [No change]

(b) [No change]

(c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. It is recommended to indicate any telegraphic and teleprinter address and telephone number of the agent or common representative or, in the absence of the designation of an agent or common representative in the request, of the applicant first named in the request.

(d) For each applicant, inventor, or agent, only one address may be indicated, except that, if no agent has been appointed to represent the applicant, or all of them if more than one, the applicant or, if there is more than one applicant, the common representative, may indicate, in addition to any other address given in the request, an address to which notifications shall be sent.

4.5 [No change]

4.6 The Inventor

(a) [No change]

(b) If the applicant is the inventor, the request, in lieu of the indication under paragraph (a), shall contain a statement to that effect.

(c) [No change]

4.7 to 4.17 [No change]

SCHEDULE OF FEES

<u>Fees</u>	<u>Amounts</u>
1. Basic Fee: (Rule 15.2(a))	
if the international application contains not more than 30 sheets	527 Swiss francs
if the international application contains more than 30 sheets	527 Swiss francs plus 11 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	127 Swiss francs
3. Handling Fee: (Rule 57.2(a))	162 Swiss francs
4. Supplement to the Handling Fee (Rule 57.2(b))	162 Swiss francs
<u>Surcharges</u>	
5. Surcharge for late payment: (Rule 16bis.2(a))	Minimum: 200 Swiss francs Maximum: 500 Swiss francs

[Annex III follows]

ANNEX III

Resolution

The Assembly of the International Patent Cooperation Union
(PCT Union)

Noting that the membership in the PCT Union is open to the States which are members of the Paris Union for the Protection of Industrial Property,

Being Convinced that the participation in the PCT Union of as many States as possible of the Paris Union is in the interests of those States and their industries,

Resolves to:

(1) Invite those States members of the Paris Union which are not members of the PCT Union to take, at an early date, the steps necessary to become members of the PCT Union;

(2) Request the International Bureau, on occasions when it appears appropriate to do so, to bring this resolution to the notice of States members of the Paris Union which are not members of the PCT Union.

[Annex IV follows]

ANNEX IV

Contents

Request Form

- (1) First sheet (recto only)
- (2) Continuation sheet (recto only)
- (3) Second sheet (recto only)
- (4) Supplemental sheet (recto only)
- (5) Last sheet (recto only)

Notes to Request Form

- (6) 1 sheet (recto-verso)

**INTERNATIONAL APPLICATION
UNDER THE
PATENT COOPERATION TREATY**

REQUEST

**THE UNDERSIGNED REQUESTS THAT THE PRESENT
INTERNATIONAL APPLICATION BE PROCESSED
ACCORDING TO THE PATENT COOPERATION TREATY**

(The following is to be filled in by the receiving Office)

**INTERNATIONAL
APPLICATION No.:**

**INTERNATIONAL
FILING DATE:**

(Stamp)

Name of receiving Office and "PCT International Application"

Applicant's or Agent's File Reference
(indicated by applicant if desired)

Box No. I TITLE OF INVENTION

Box No. II APPLICANT (WHETHER OR NOT ALSO INVENTOR); DESIGNATED STATES FOR WHICH HE/SHE/IT IS APPLICANT. Use this box for indicating the applicant or, if there are several applicants, one of them. If more than one person (includes, where applicable, a legal entity) is involved, continue in Box No. III.

The person identified in this box is (check one only): ☐ applicant and inventor* ☐ applicant only

Name and address:**

Telephone number:
(including area code)

Telegraphic address:

Teleprinter address:

Country of nationality:

Country of residence:***

The person identified in this box is *applicant* for the purposes of (check one only):

☐ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the "Supplemental Box"

Box No. III FURTHER APPLICANTS, IF ANY; (FURTHER) INVENTORS, IF ANY; DESIGNATED STATES FOR WHICH THEY ARE APPLICANTS (IF APPLICABLE). A separate sub-box has to be filled in in respect of each person (includes, where applicable, a legal entity). If the following two sub-boxes are insufficient, continue in the "Supplemental Box," (giving there for each additional person the same indications as those requested in the following two sub-boxes) or by using a "continuation sheet."

The person identified in this sub-box is (check one only): ☐ applicant and inventor* ☐ applicant only ☐ inventor only*

Name and address:**

If the person identified in this sub-box is *applicant* (or *applicant and inventor*), indicate also:

Country of nationality:

Country of residence:***

and whether that person is *applicant* for the purposes of (check one only):

☐ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the "Supplemental Box"

The person identified in this sub-box is (check one only): ☐ applicant and inventor* ☐ applicant only ☐ inventor only*

Name and address:**

If the person identified in this sub-box is *applicant* (or *applicant and inventor*), indicate also:

Country of nationality:

Country of residence:***

and whether that person is *applicant* for the purposes of (check one only):

☐ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the "Supplemental Box"

* If the person indicated as "applicant and inventor" or as "inventor only" is not an *inventor* for the purposes of all the designated States, give the necessary indications in the "Supplemental box."

** Indicate the name of a natural person by giving his/her family name first followed by the given name(s). Indicate the name of a legal entity by its full official designation. In the address, include both the postal code (if any) and the country (name).

*** If residence is not indicated, it will be assumed that the country of residence is the same as the country indicated in the address.

PCT/A/VII/15
Annex IV, page 3

Sheet number.....

Box No. III CONTINUATION (IF REQUIRED) FURTHER APPLICANTS, IF ANY; (FURTHER) INVENTORS, IF ANY; DESIGNATED STATES FOR WHICH THEY ARE APPLICANTS (IF APPLICABLE). A separate sub-box has to be filled in in respect of each person (includes, where applicable, a legal entity).	
The person identified in this sub-box is (check one only): ☐ applicant and inventor* ☐ applicant only ☐ inventor only* Name and address:**	
If the person identified in this sub-box is <i>applicant</i> (or <i>applicant and inventor</i>), indicate also: Country of nationality: Country of residence:*** and whether that person is <i>applicant</i> for the purposes of (check one only): ☐ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the "Supplemental Box"	
The person identified in this sub-box is (check one only): ☐ applicant and inventor* ☐ applicant only ☐ inventor only* Name and address:**	
If the person identified in this sub-box is <i>applicant</i> (or <i>applicant and inventor</i>), indicate also: Country of nationality: Country of residence:*** and whether that person is <i>applicant</i> for the purposes of (check one only): ☐ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the "Supplemental Box"	
The person identified in this sub-box is (check one only): ☐ applicant and inventor* ☐ applicant only ☐ inventor only* Name and address:**	
If the person identified in this sub-box is <i>applicant</i> (or <i>applicant and inventor</i>), indicate also: Country of nationality: Country of residence:*** and whether that person is <i>applicant</i> for the purposes of (check one only): ☐ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the "Supplemental Box"	
The person identified in this sub-box is (check one only): ☐ applicant and inventor* ☐ applicant only ☐ inventor only* Name and address:**	
If the person identified in this sub-box is <i>applicant</i> (or <i>applicant and inventor</i>), indicate also: Country of nationality: Country of residence:*** and whether that person is <i>applicant</i> for the purposes of (check one only): ☐ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the "Supplemental Box"	
* If the person indicated as "applicant and inventor" or as "inventor only" is not an <i>inventor</i> for the purposes of all the designated States, give the necessary indications in the "Supplemental box."	
** Indicate the name of a natural person by giving his/her family name first followed by the given name(s). Indicate the name of a legal entity by its full official designation. In the address, include both the postal code (if any) and the country (name).	
*** If residence is not indicated, it will be assumed that the country of residence is the same as the country indicated in the address.	
If this continuation sheet is not used, it need not be included in the Request.	

Sheet number

Box No. IV AGENT (IF ANY) OR COMMON REPRESENTATIVE (IF ANY); ADDRESS FOR NOTIFICATIONS (IN CERTAIN CASES) A common representative may be appointed only if there are several applicants and if no agent is or has been appointed; the common representative must be one of the applicants.

The following person (includes, where applicable, a legal entity) is hereby/has been appointed as agent or common representative to act on behalf of the applicant(s) before the competent International Authorities:

Name and address, including postal code and country (if the space below is used instead for an address for notifications*, check here ☐):

Telephone number:
(including area code)

Telegraphic address:

Teleprinter address:

Box No. V DESIGNATION OF STATES; POSSIBLE CHOICE OF EUROPEAN PATENT; POSSIBLE CHOICES OF CERTAIN KINDS OF PROTECTION OR TREATMENT. Where the name of a State is followed by two check boxes, either or both of the boxes may be checked. The checking of both boxes results in both a European and a national patent being requested for the same State. Designation of Switzerland includes designation of Liechtenstein (and vice-versa).

The following States are hereby designated:***		European Patent	National Patent (if other national title or treatment desired, specify)**
AT	Austria	☐	☐ **
AU	Australia	☐	☐ **
BR	Brazil	☐	☐ **
CH and LI	Switzerland and Liechtenstein	☐	☐
DE	Federal Republic of Germany	☐	☐ **
DK	Denmark	☐	☐
FI	Finland	☐	☐
FR	France	☐	[no national title available]
GB	United Kingdom	☐	☐
HU	Hungary	☐	☐
JP	Japan	☐	☐ **
KP	Democratic People's Republic of Korea	☐	☐
LU	Luxembourg	☐	☐ **
MC	Monaco	☐	☐ **
MG	Madagascar	☐	☐
MW	Malawi	☐	☐ **
NL	Netherlands	☐	☐
NO	Norway	☐	☐
RO	Romania	☐	☐
SE	Sweden	☐	☐
SU	Soviet Union	☐	☐ **
US	United States of America	☐	☐ **
EP	all PCT Contracting States for which a European patent may be requested	☐	**** these States are those listed above whose names are preceded by the codes AT, CH and LI, DE, FR, GB, LU, NL and SE and (specify names of any others)
OA	OAPI (Cameroon, Central African Republic, Chad, Congo, Gabon, Senegal, Togo)	☐	OAPI Patent (if other OAPI title desired, specify)**

Space reserved for designating countries which become party to the PCT after the issuance of the present form (October 1, 1981):

- * An address for the sending of notifications for a sole applicant or for a common representative may be indicated if no agent has been appointed to represent the applicant or, if there are several applicants, all of them.
- ** If another kind of protection or a title of addition is desired or if, in the United States of America, treatment as a continuation or a continuation in part is desired, indicate according to the instructions given in the Notes to Box No. V.
- *** The applicant's choice of the order of the designations may be indicated by checking the boxes of the designated States with sequential arabic numerals (see also the Notes to Box No. V).
- **** When this box is checked, none of the other boxes in the column "European patent" should be checked.

Sheet number.....

Supplemental Box. Use this box in the following cases:

(i) *if more than three persons are involved as applicants and/or inventors*; in such case, write "Continuation of Box No. III" and indicate for each additional person the same type of information as required in Box No. III;

(ii) *if, in Box No. II or any of the sub-boxes of Box No. III, the indication "the States indicated in the 'Supplemental Box,' is checked*; in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the applicant(s) involved and, next to (each) such name, the country or countries (or EP or OA, if applicable) for the purposes of which he/she/it is applicant;

(iii) *if, in Box No. II or any of the sub-boxes of Box No. III, a person indicated as "applicant and inventor" or "inventor only" is not inventor for the purposes of all designated States or for the purposes of the United States of America*; in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the inventor and, next to such name, the country or countries (or EP or OA, if applicable) for the purposes of which the named person is inventor;

(iv) *if there is more than one agent and their addresses are not the same*; in such case, write "Continuation of Box No. IV" and indicate for each additional agent the same type of information as required in Box No. IV;

(v) *if, in Box No. V, the name of any country (or OAPI) is accompanied by the indication "patent of addition," "certificate of addition," or "inventor's certificate of addition," or if, in Box No. V, the name of the United States of America is accompanied by an indication "Continuation" or "Continuation in part"*; in such case, write "Continuation of Box No. V" and the name of each country involved (or OAPI), and after the name of each such country (or OAPI), the number of the parent title or parent application and the date of grant of parent title or filing of parent application;

(vi) *if there are more than three earlier applications whose priority is claimed*; in such case, indicate "Continuation of Box No. VI" and indicate for each additional earlier application the same type of information as required in Box No. VI;

(vii) *if, in any of the Boxes, the space is insufficient to furnish all the information*; in such case, write "Continuation of Box No. ..." [indicate the number of the Box] and furnish the information in the same manner as required according to the captions of the Box in which the space was insufficient.

If this Supplemental Box is not used, this sheet need not be included in the Request.

Sheet number.....

Box No. VI PRIORITY CLAIM (IF ANY). The priority of the following earlier application(s) is hereby claimed:			
Country (country in which it was filed if national application; one of the countries for which it was filed if regional or international application)	Filing Date (day, month, year)	Application No.	Office of Filing (fill in only if the earlier application is an international application or a regional application)
(1)			
(2)			
(3)			
(Letter codes may be used to indicate country and/or Office of filing)			
When the earlier application was filed with the Office which, for the purposes of the present international application, is the receiving Office, the applicant may, <i>against payment of the required fee</i> , ask the following:			
☐ the receiving Office is hereby requested to prepare and transmit to the International Bureau a certified copy of the above-mentioned earlier application/of the earlier applications identified above by the numbers (insert the applicable numbers)			
Box No. VII EARLIER SEARCH (IF ANY). Fill in where a search (international, international-type or other) by the International Searching Authority has already been requested (or completed) and the said Authority is now requested to base the international search, to the extent possible, on the results of the said earlier search. Identify such search or request either by reference to the relevant application (or the translation thereof) or by reference to the search request.			
International application number or number and country (or regional Office) of other application:		International/regional/national filing date	
Date of request for search:		Number (if available) given to search request:	
Box No. VIII SIGNATURE OF APPLICANT(S) OR AGENT			
If the present Request form is signed on behalf of any applicant by an agent, a separate power of attorney appointing the agent and signed by the applicant is required. If in such case it is desired to make use of a general power of attorney (deposited with the receiving Office), a copy thereof must be attached to this form.			
Box No. IX CHECK LIST (To be filled in by the Applicant)			
This international application contains the following number of sheets:		This international application as filed is accompanied by the items checked below:	
1. request _____	sheets	1. ☐ separate signed power of attorney	
2. description _____	sheets	2. ☐ copy of general power of attorney	
3. claims _____	sheets	3. ☐ priority document(s) (see Box No. VI)	
4. abstract _____	sheets	4. ☐ receipt of the fees paid or revenue stamps	
5. drawings _____	sheets	5. ☐ cheque for the payment of fees	
Total _____ sheets		6. ☐ request to charge deposit account	
Figure number of the drawings (if any) is suggested to accompany the abstract for publication.		7. ☐ other document (specify)	
(The following is to be filled in by the receiving Office)			
1. Date of actual receipt of the purported international application:			
2. Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application:			
3. Date of timely receipt of the required corrections under Article 11 of the PCT:			
4. Drawings ☐ Received ☐ No Drawings			
(The following is to be filled in by the International Bureau)			
Date of receipt of the record copy:			

NOTES TO THE REQUEST FORM (PCT/RO/101)

These Notes are intended to facilitate the filling in of the request form. For authentic information, see the text of the Patent Cooperation Treaty and the texts of the Regulations and the Administrative Instructions under that Treaty. (See also the **PCT Applicant's Guide**, a publication of WIPO.) In case of discrepancy between these Notes and the said texts, the latter are applicable.

"Article" refers to Articles of the Treaty, "Rule" refers to Rules of the Regulations and "Section" refers to Sections of the Administrative Instructions.

MANDATORY AND OPTIONAL CONTENTS OF THE REQUEST

"The request shall contain:

- (i) a petition [*already pre-printed on the request form*],
- (ii) the title of the invention,
- (iii) indications concerning the applicant and the agent, if there is an agent,
- (iv) the designation of States,
- (v) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application." (Rule 4.1(a))

"The request shall, where applicable, contain:

- (i) a priority claim,
- (ii) a reference to any earlier international, international-type or other search,
- (iii) choices of certain kinds of protection,
- (iv) an indication that the applicant wishes to obtain a regional patent and the names of the designated States for which he wishes to obtain such a patent,
- (v) a reference to a parent application or parent patent." (Rule 4.1(b))

"The request may contain:

- (i) indications concerning the inventor where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application,
- (ii) a request to the receiving Office to transmit the priority document to the International Bureau where the application whose priority was claimed was filed with the national Office or intergovernmental authority which is the receiving Office." (Rule 4.1(c))

"The request shall be signed." (Rule 4.1(d))

NOTES TO BOX No. I

Title of Invention. "The title of the invention shall be short (preferably from two to seven words when in English or translated into English) and precise." (Rule 4.3)

NOTES TO BOXES No. II and III

Applicant. "The request shall indicate the name, address, nationality and residence of the applicant or, if there are several applicants, of each of them." (Rule 4.5(a))

Different Applicants for Different Designated States. "The international application may indicate different applicants for the purposes of different designated States, provided that, in respect of each designated State, at least one of the applicants indicated for the purposes of that State is entitled to file an international application according to Article 9 [i.e., is a national or resident of a Contracting State]." (Rule 18.4(a)) *Where the United States of America is one of the designated States the applicant or applicants named in respect of the United States of America must be the inventor or inventors.*

Inventor. "The request shall contain the name of and other prescribed data concerning the inventor where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application " (Article 4(1)(v)) "Where Rule 4.1(a)(v) applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them." (Rule 4.6(a)) "If the applicant is the inventor, the request, in lieu of the indication under paragraph (a), shall contain a statement to that effect (Rule 4.6(b))" "..... Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for that State not later than at the expiration of 20 months from the priority date." (Article 22(1))

Names. "Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s)." (Rule 4.4(a)) "Names of legal entities shall be indicated by their full, official designations." (Rule 4.4(b))

Addresses. "Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any.

Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. It is recommended to indicate any telegraphic and teleprinter address and telephone number in respect of the agent or common representative or, in the absence of the designation of an agent or common representative in the request, of the applicant first named in the request." (Rule 4.4(c)) "For each applicant, inventor, or agent, only one address may be indicated....." (Rule 4.4(d)) *See, however, the Notes to Box No. IV as to the indication, in that Box, in certain cases, of an "address for notifications" for the applicant.*

Nationality. "The applicant's nationality shall be indicated by the name of the State of which he is a national." (Rule 4.5(b))

Residence. "The applicant's residence shall be indicated by the name of the State of which he is a resident." (Rule 4.5(c))

Names of States. "The name of any State referred to in the request shall be indicated by the full name of the State or by a generally accepted short title which, if the indications are in English or French shall be as appears in Annex A [i.e., Annex A to the Administrative Instructions under the PCT; the pre-printed names of PCT Contracting States appearing in Box No. V of the request form are in accordance with the said Annex A]." (Section 201(a), first sentence)

NOTES TO BOX No. IV

Agent or Common Representative. *When listing several agents, list first the agent to whom it is desired that any correspondence shall be addressed. (See Section 108)* "If agents are designated, the request shall so indicate, and shall state their names and addresses." (Rule 4.7) "If there is more than one applicant and the request does not refer to an agent representing all the applicants ("a common agent"), the request shall designate one of the applicants who is entitled to file an international application according to Article 9 [i.e., is a national or resident of a Contracting State] as their common representative." (Rule 4.8(a))

Appointment of Agent or Common Representative. "Appointment of any agent, or of any common representative within the meaning of Rule 4.8(a), shall be effected by each applicant, at his choice, either by signing the request in which the agent or common representative is designated or by a separate power of attorney (i.e., a document appointing an agent or common representative)." (Rule 90.3(a)) "Where the international application is filed with reference to a general power of attorney not signed by all the applicants, it shall be sufficient for the purpose of appointment of a common agent under Rule 90.3, if the request or a separate power of attorney is signed by the applicant, who did not sign the general power of attorney." (Section 106(b))

Address for Notifications. *An address to which notifications may be sent to the (sole) applicant or the common representative, when no agent has been appointed, may be indicated in Box No. IV instead of the name and address of an agent:* "For each applicant, only one address may be indicated except that, if no agent has been appointed to represent the applicant, or all of them if more than one, the applicant or, if there is more than one applicant, the common representative, may indicate, in addition to any other address given in the request, an address to which notifications may be sent." (Rule 4.4(d))

For Names (including Names of States) and Addresses, see Notes to Boxes Nos. II and III.

NOTES TO BOX No. V

Designation of States. "Contracting States shall be designated in the request by their names." (Rule 4.9) *Note that after filing further designations cannot be made.*

The checking of the boxes of the designated States by means of sequential arabic numerals will be taken as indicating the applicant's choice of the order of the designations; if another form of checking is used, the order will be taken as that in which the checked boxes appear on the form. This order will only have any significance if the amount received for the designation fees is insufficient to cover all the designations. In that case, the amount received will be applied in payment of the fees for the designations following the said order. (See Section 208 and Rules 16bis.2(c) and 16bis.3(b))

Where one or more States are designated twice (once for the purposes of a European patent and once for the purposes of a national patent), one designation fee must be paid in respect of the European patent and as many designation fees must be paid in respect of the national patents as there are designated States. (See Section 203bis and Rule 15.1(ii))

Possible Choices of Certain Kinds of Protection or Treatment. *If, in any country where that is possible, instead of a patent, a national title other than a patent is desired, write after the box of that country, the name of the title, that is, "petty patent" (available in Australia), "utility model" (available in Brazil, the Federal Republic of Germany, Japan and OAPI) or "inventor's certificate" (available in the Soviet Union). Where, in the Federal Republic of Germany (only country in which these possibilities exist), in addition to a patent, a utility model is also desired, write, after the box of that country "and utility model" or, where subsidiarily to a patent a utility model is desired, write, after the said box "and auxiliary utility model". (See Section 202)*

Where, in respect of any country where that is possible, it is desired that the application be treated as an application for a certain title "of addition" or as an application for a continuation or a continuation in part, write after the box of that country, the appropriate words, that is, "patent of addition" (available in Australia, Austria, the Federal Republic of Germany, Japan, Malawi, Soviet Union), "certificate of addition" (available in Luxembourg, Monaco, OAPI), "inventor's certificate of addition" (available in the Soviet Union), "continuation" or "continuation in part" (both available in the United States of America). If any of these indications is used, indicate in the "Supplemental Box" the country for which such treatment is desired, the number of the parent title or parent application and the date of grant of the parent title or the date of filing of the parent application, as the case may be.

For Names of States, see Notes to Boxes Nos. II and III.

NOTES TO BOX No. VI

Priority claim "The declaration [containing the priority claim] shall be made in the request; it shall indicate:

- (i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, the country or countries for which it was filed,
- (ii) the date on which it was filed,
- (iii) the number under which it was filed, and
- (iv) when the earlier application is a regional or an international application, the national Office or intergovernmental organization with which it was filed." **Rule 4.10(a)**

"If the request does not indicate both

- (i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, at least one country for which it was filed, and
- (ii) the date on which it was filed,

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made " **(Rule 4.10(b))**

"If the application number of the earlier application is not indicated in the request but is furnished by the applicant to the International Bureau prior to the expiration of the 16th month from the priority date, it shall be considered by all designated States to have been furnished in time " **(Rule 4.10(c), first sentence)**

Certified Copy of Earlier Application. "Where the priority of an earlier national application is claimed under Article 8 in the international application, a copy of the said national application, certified by the authority with which it was filed ("the priority document"), shall, unless already filed with the receiving Office together with the international application, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date or, in the case referred to in Article 23(2), not later than at the time the processing or examination is requested " **(Rule 17.1(a), first sentence)** "Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to transmit the priority document to the International Bureau. Such request shall be made not later than the expiration of the applicable time limit referred to under paragraph (a) and may be subjected by the receiving Office to the payment of a fee " **(Rule 17.1(b))**

Dates. "Any date in the international application, or used in any correspondence emanating from International Authorities relating to the international application, shall be indicated by the Arabic number of the day, by the name of the month, and by the Arabic number of the year." **(See Section 110)**

NOTES TO BOX No. VII

Earlier Search. "If an international or international-type search has been requested on an application under Article 15(5) or if the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search,

other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application, the request shall contain a reference to that fact. Such reference shall either identify the application (or its translation, as the case may be) in respect of which the earlier search was made by indicating country, date and number, or the said search by indicating, where applicable, date and number of the request for such search." **(Rule 4.11)**

For Dates, see Notes to Box No. VI.

NOTES TO BOX No. VIII

Signature. The signature **(Rule 4.1(d))** must be that of the applicant (if there are several applicants all must sign **(Rule 4.15)**); however, the signature may be that of the agent **(Rule 2.1)** where there is attached to the request a separate power of attorney appointing the agent or the copy of a general power of attorney already in the possession of the receiving Office. The typing of the name of each person signing the Request below the signature is recommended; similarly, an indication of the capacity in which the person signs is recommended if such capacity is not obvious from a reading of the Request.

For Power of Attorney and General Power of Attorney, see Notes to Box No. IX.

NOTES TO BOX No. IX

Check List (in general, see **Rule 3.3**)

Power of Attorney. "The power of attorney may be submitted to the receiving Office or the International Bureau." **(Rule 90.3(b))** "If the separate power of attorney is not signed or is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered nonexistent unless the defect is corrected." **(Rule 90.3(c))**

General Power of Attorney. "A general power of attorney may be deposited with the receiving Office for purposes of the processing of the international application as defined in Rule 90.2(d). Reference may be made in the request to such general power of attorney, provided that a copy thereof is attached to the request by the applicant." **(Rule 90.3(d))**

Optional Sheet. The optional sheet containing indications concerning deposited microorganisms may, in most cases, be listed as an "other document." This is not the case if Japan is designated since the optional sheet is accepted in that case only if included in the sheets of the description.

NOTES TO "SUPPLEMENTAL BOX"

Different Inventors for Different (Groups of) Designated States. "The request may, for different designated States, indicate different persons as inventors where, in this respect, the requirements of the national laws of the designated States are not the same. In such a case, the request shall contain a separate statement for each designated State or group of States in which a particular person, or the same person, is to be considered the inventor, or in which particular persons, or the same persons, are to be considered the inventors." **(Rule 4.6(c))**

Parent Application or Grant. "If the applicant wishes his international application to be treated, in any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, he shall identify the parent application or the parent patent, parent inventor's certificate, or parent utility certificate to which the patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, if granted, relates. For the purposes of this paragraph Article 2(ii) shall not apply." **(Rule 4.13)** "If the applicant wishes his international application to be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application, he shall so indicate in the request and shall identify the parent application involved." **(Rule 4.14)**

ANNEX V

MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

Section 201

Names of States: Cancellation of Designations

(a) The name of any State referred to in the request shall be indicated either by the full name of the State or by a generally accepted short title which, if the indications are in English or French, shall be as appears in Annex A. If the name is inserted in the request by the applicant for the purpose of designating that State, the receiving Office, or the International Bureau where the receiving Office fails to do so, shall insert, preferably before the name of the State, the two-letter country code identifying the State, as appears in Annex B.

(b) [No change]

Section 202

Kind of Protection

(a) Where the applicant wishes his application to be treated in any designated State as an application not for a patent but for the grant of another kind of protection referred to in Article 43, he shall make the indication in the request referred to in Rule 4.12(a) by inserting the words “inventor’s certificate,” “utility certificate,” “utility model” (or “petty patent” for Australia), “patent of addition,” “certificate of addition,” “inventor’s certificate of addition” or “utility certificate of addition,” or their equivalent in the language of the international application, immediately after the indication of the said State.

(b) Where, in respect of the designation of the Federal Republic of Germany, the applicant is seeking two kinds of protection under Article 44, he shall make the indication referred to in Rule 4.12(b) by inserting, immediately after the indication of the Federal Republic of Germany and in the language of the international application, one of the two following indications:

(i) “and utility model”;

(ii) “and auxiliary utility model.”

Section 203

Regional Patents

(a) If the applicant wishes to obtain a regional patent in respect of any designated State and the request form does not contain preprinted indications permitting the applicant to make the indication in the request referred to in Rule 4.1(b)(iv), the applicant shall make the said indication by inserting the words “regional patent,” or their equivalent in the language of the international application, immediately after the indication of the said State or, where an indication has been made under Section 202, after that indication, provided that:

(i) where Article 4(1)(ii), third clause, applies, and not all the States party to the regional treaty have been designated, the international application shall be treated as if all those States had been designated and as if the designations of all such States contained the said words, whether the said designations contained an indication of the wish to obtain a regional patent or, according to Article 4(1)(ii), fourth clause, are to be treated as containing such indication;

(ii) where the national law of any designated State contains a provision as referred to in Article 45(2), the International Bureau shall, according to Article 4(1)(ii), fourth clause, treat the designation as if it contained the said words even where the applicant failed to indicate them.

(b) The applicant may, instead of the words “regional patent” referred to in paragraph (a), use other words to the same effect; such words may include a reference to a patent to be granted by the European Patent Office under the Convention on the Grant of European Patents done at Munich on October 5, 1973 (“European patent”), where the regional patent which the applicant wishes to obtain is a European patent.

(c) An indication, in respect of the designation of Liechtenstein or Switzerland, or both, of the wish to obtain a regional patent shall be taken as indicating a wish to obtain a European patent in respect of those States, whereas the absence of any indication of the wish to obtain a regional patent in respect of such a designation shall be taken as indicating a wish to obtain a patent granted by the Swiss Intellectual Property Office in respect of those States.

Section 206

[Deleted]

[End of document]

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PCT/A/VIII/2

ORIGINAL: English/French

DATE: December 7, 1981

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Eighth Session (3rd Ordinary) Geneva, November 16 to 24, 1981

REPORT

Adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XII/1. Rev.): 1, 2, 3, 4, 5, 6, 14, 16, 19, 22 and 23.
2. The report on the said items is contained in the General Report.

[End of document]

WIPO



PCT/A/IX/3

ORIGINAL: English

DATE: September 10, 1982

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Ninth Session (6th Extraordinary) Geneva, September 10, 1982

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly of the International Patent Cooperation Union (PCT Union) (hereinafter referred to as "the Assembly") held its ninth session (6th extraordinary) in Geneva on September 10, 1982.
2. The following 19 Contracting States were represented at the session: Australia, Austria, Belgium, Brazil, Denmark, Finland, France, Germany (Federal Republic of), Japan, Liechtenstein, Luxembourg, Monaco, Netherlands, Norway, Soviet Union, Sweden, Switzerland, United Kingdom and United States of America.
3. The following four States, members of the International Union for the Protection of Industrial Property (Paris Union), participated in the session as observers: Ivory Coast, Mexico, Republic of Korea and Trinidad and Tobago.
4. One intergovernmental organization, the European Patent Organisation (EPO), and the following three international non-governmental organizations were represented by observers: Committee of National Institutes of Patent Agents (CNIPA), International Association for the Protection of Industrial Property (IAPIP) and International Federation of Industrial Property Attorneys (FICPI).

5. The list of participants is contained in Annex I to this report.

OPENING OF THE SESSION

6. The Chairman, Mr. G. Borggård (Sweden), opened the session of the Assembly.
7. Mr. F. Curchod (WIPO) acted as Secretary of the session.

ADOPTION OF THE AGENDA

8. The Assembly adopted the agenda of its session as contained in document PCT/A/IX/1.

AMENDMENT OF THE SCHEDULE OF FEES ANNEXED TO THE PCT REGULATIONS

9. Discussions were based on document PCT/A/IX/2, on the updated version of its Annex II which was distributed at the opening of the session and on a statement by the Director General.
10. In his statement, the Director General proposed that the fees be increased by 7.5% with effect as of January 1, 1983, and that the need for any deficit-covering contributions for 1984 and thereafter as well as the level of fees for 1984 and thereafter be considered at the next ordinary session of the Assembly to be held in September 1983.
11. In making that proposal, the Director General said that, on the basis of certain assumptions, including the assumption that the fees would be increased by 10% for 1984 and by another 10% for 1985, the accumulated deficit by the end of 1984 would be approximately 1,000,000 Swiss francs and that one should plan to absorb that deficit from the profits foreseen for 1985 and 1986 and that, if those assumptions were confirmed by facts, it would not be necessary to ask for deficit-covering contributions in addition to those already decided upon for 1983.
12. Although several delegations said that the new proposal of the Director General should have been made earlier to allow better preparation for the meeting, all delegations, with one exception, favored the proposal of the Director General to increase the fees by 7.5% with effect as of January 1, 1983. However, the Delegation of the United Kingdom, while agreeing that an increase lower than 22%, as originally proposed, was desirable, abstained from approving the newly proposed percentage. The Delegations of Belgium, France, Monaco and the Soviet Union approved the increase of 7.5% in the firm expectation that no further contributions would be required after 1983. It was generally agreed that everything should be done in order to avoid deficit-covering contributions after 1983.
13. Several delegations urged the International Bureau to make every effort in rationalizing its procedures under the PCT with a view to keeping expenditures to a minimum.
14. The Director General said that the International Bureau would continue to make every effort to keep the expenditures at a minimum but added that the actual costs were determined,

to the largest extent, by outside factors such as inflation, printing and mailing costs, and that a significant impact of computerization on savings could be expected only if the number of international applications filed each year increased substantially. As far as the income was concerned, both the amounts of the fees and the number of international applications had a decisive influence. As to the latter, the International Bureau would continue its propaganda for the use of the PCT, which, naturally, required some investment, and its efforts to make the PCT more attractive to applicants, which, to a large extent, depended on the improvements to the PCT Regulations under discussion.

15. The Delegations of Brazil, the Ivory Coast and Trinidad and Tobago, referring to a discussion concerning preferential conditions for developing countries with respect to PCT fees which took place at the seventh session of the Assembly in 1981 (see document PCT/A/VII/15, paragraphs 23 and 56), stressed the need for making the PCT more attractive for developing countries, in particular by allowing lower fees for the use of the PCT by nationals of such countries. They further referred to the usefulness of the technical services and technical assistance of the PCT to developing countries. They expressed the desirability of establishing preferential arrangements which would increase the attractiveness of the Treaty to developing countries. They saw the need to balance the value of the PCT to developed countries, which were producers and owners of technology, as well as to developing countries, which were consumers of patented technology.

16. The Director General said that the International Bureau was fully aware of the importance of lower fees for developing countries, particularly as far as the fees for international search and international preliminary examination were concerned since they constituted the major part of the fees to be paid by applicants. He expressed the hope that the International Searching and Preliminary Examining Authorities would find the necessary means, particularly with the help of a financing of their expenses connected with the establishment of reports for applications filed by nationals of developing countries through national or regional general development aid resources. In view of the number of international applications that would be involved, the needed amounts would, in absolute figures, be very modest.

17. The Assembly amended, with effect as of January 1, 1983, the Schedule of Fees annexed to the PCT Regulations. The amended Schedule of Fees is set out in Annex II to this report. The Assembly decided that the equivalent amounts in other currencies would, in respect of all currencies concerned, be established on the basis of the exchange rates applicable in Switzerland on October 1, 1982.

18. The Assembly unanimously adopted this report on September 10, 1982.

[Annexes follow]

ANNEX I/ANNEXE I

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS/

I. MEMBER STATES/ETATS MEMBRES

AUSTRALIA/AUSTRALIE

Mr. K. WIDDOWS, First Secretary, Permanent Mission, Geneva

AUSTRIA/AUTRICHE

Mr. N. MARTERER, Vice-President, Austrian Patent Office, Vienna

BELGIUM/BELGIQUE

M. P. CEUNINCK, Secrétaire d'administration, Service de la propriété industrielle, Ministère des affaires économiques, Bruxelles

BRAZIL/BRESIL

Mr. E. CORDEIRO, Second Secretary, Permanent Mission, Geneva

DENMARK/DANEMARK

Mr. J. DAM, Head of Section, Patent and Trademark Office, Copenhagen

FINLAND/FINLANDE

Mrs. E. HÄKLI, Head of Section, National Board of Patents and Registration, Helsinki

FRANCE

Mlle G. RAJOT, Juriste, Institut national de la propriété industrielle, Paris

GERMANY (FEDERAL REPUBLIC OF)/ALLEMAGNE (REPUBLIQUE FEDERALE D')

Mr. U.C. HALLMANN, Leitender Regierungsdirektor, German Patent Office, Munich

JAPAN/JAPON

Mr. H. GOTO, Office Director, International Application Office, First Application Division, First Examination Department, Japanese Patent Office, Tokyo

Mr. S. ONO, First Secretary, Permanent Mission, Geneva

LIECHTENSTEIN

Comte A.F. de GERLICZY-BURIAN, Chef de l'Office pour les relations internationales, Vaduz

LUXEMBOURG

M. F. SCHLESSER, Inspecteur près du service de la propriété industrielle, Ministère de l'économie, Luxembourg

MONACO

M. E. FRANZI, Directeur du commerce, de l'industrie et de la propriété industrielle, Monaco

NETHERLANDS/PAYS-BAS

Mr. S. de VRIES, Deputy Member of the Patents Council, Netherlands Patent Office, Rijswijk

NORWAY/NORVEGE

Mr. P.T. LOSSIUS, Deputy Director General, Norwegian Patent Office, Oslo

Mr. I. LILLEVIK, Head of Section, Norwegian Patent Office, Oslo

SOVIET UNION/UNION SOVIETIQUE

Mr. S.N. AFANASSIEV, Acting Head of Department of the All Union Institute of State Patent Examination, USSR State Committee for Inventions and Discoveries, Moscow

SWEDEN/SUEDE

Mr. G. BORGGÅRD, Director General, Royal Patent and Registration Office, Stockholm

Mr. E. TERSMEDEN, Legal Adviser, Ministry of Justice, Stockholm

Ms. P. LIND, Legal Adviser, Ministry of Commerce, Stockholm

Ms. B. SANDBERG, Head of International Section, Royal Patent and Registration Office, Stockholm

SWITZERLAND/SUISSE

M. M. LEUTHOLD, Chef de la Division administrative, Office fédéral de la propriété intellectuelle, Berne

UNITED KINGDOM/ROYAUME-UNI

Mr. A. SUGDEN, Principal Examiner, Patent Office, London

Mr. J. SHARROCK, Principal Examiner, Patent Office, London

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Mr. L.O. MAASSEL, Patent Practice Specialist, United States Patent and Trademark Office, Washington, D.C.

Mr. H.D. HOINKES, Legislative and International Patent Specialist, United States Patent and Trademark Office, Washington, D.C.

II. OBSERVER STATES/ETATS OBSERVATEURS

IVORY COAST/COTE D'IVOIRE

M. K. ZOBO, Chargé d'études juridiques, Abidjan

MEXICO/MEXIQUE

Sr. F.J. CRUZ GONZALEZ, Consejero, Misión Permanente, Ginebra

REPUBLIC OF KOREA/REPUBLIQUE DE COREE

Mr. S.H. KIM, Commercial Attaché, Permanent Mission, Geneva

TRINIDAD AND TOBAGO/TRINITE-ET-TOBAGO

Mr. M. LASHLEY, First Secretary, Permanent Mission, Geneva

III. INTERGOVERNMENTAL ORGANIZATION/ORGANISATION
INTERGOUVERNEMENTALE

EUROPEAN PATENT ORGANISATION (EPO)/ORGANISATION EUROPEENNE DES
BREVETS (OEB)

M. U. SCHATZ, Directeur principal, Affaires internationales, Office européen des brevets, Munich

IV. INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS/
ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES

COMMITTEE OF NATIONAL INSTITUTES OF PATENT AGENTS (CNIPA)/COMITE
DES INSTITUTS NATIONAUX D'AGENTS DE BREVETS

Mr. R.P. LLOYD, ICI PLC, Plastics Division, Patent Dept., Welwyn Garden City

INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY (IAPIP)/ ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE
LA PROPRIETE INDUSTRIELLE (AIPPI)

M. G.R. CLARK, Membre d'honneur, Oak Brook

INTERNATIONAL FEDERATION OF INDUSTRIAL PROPERTY
ATTORNEYS/FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE
INDUSTRIELLE (FICPI)

M. H. BARDEHLE, Président, Munich

V. OFFICERS/BUREAU

Chairman/Président : Mr. G. BORGGÅRD (Sweden/Suède)

Secretary/Secrétaire : M. F. CURCHOD (WIPO/OMPI)

VI. INTERNATIONAL BUREAU OF WIPO/BUREAU INTERNATIONAL DE L'OMPI

Dr. A. BOGSCH, Director General

Mr. K. PFANNER, Deputy Director General

M. F. CURCHOD, Directeur, Division du PCT

Mr. B. BARTELS, Head, PCT Legal Section

Mr. M. LAGESSE, Controller, Administrative Division

Mr. N. SCHERRER, Head, PCT Fees, Sales and Statistics Section

[Annex II follows/L'annexe II suit]

ANNEX II

SCHEDULE OF FEES

<u>Fees</u>	<u>Amounts</u>
1. Basic Fee: (Rule 15.2(a))	
if the international application contains not more than 30 sheets	566 Swiss francs
if the international application contains more than 30 sheets	566 Swiss francs plus 12 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	136 Swiss francs
3. Handling Fee: (Rule 57.2(a))	174 Swiss francs
4. Supplement to the Handling Fee: (Rule 57.2(b))	174 Swiss francs
<u>Surcharges</u>	
5. Surcharge for late payment: (Rule 16bis.2(a))	Minimum: 215 Swiss francs Maximum: 540 Swiss francs

[End of Annex II and of document]

WIPO



PCT/A/X/3

ORIGINAL: English/French

DATE: October 17, 1983

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Tenth Session (4th Ordinary) Geneva, September 26 to October 4, 1983

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XIV/1.Rev.): 1, 2, 3, 4, 5, 6, 11, 13, 18, 23 and 24.
2. The report on the said items, with the exception of items 6 and 13, is contained in the General Report (document AB/XIV/13).
3. The report on items 6 and 13 is contained in this document.

ITEM 6 OF THE CONSOLIDATED AGENDA

FIXATION OF FEES UNDER THE PATENT COOPERATION TREATY (PCT)

4. Discussions were based on document PCT/A/X/2.
5. The Delegation of Brazil stated that it continued to strongly believe that it would be desirable to establish preferential treatment in respect of the amount of fees to be paid under the PCT by applicants who are nationals of developing countries in order for the PCT to be more attractive for such applicants.

6. Several Delegations expressed concern that the proposed increases of fees might lead to a decrease in the number of international applications.
7. The Director General said that the number of the international applications filed in recent months showed a tendency that the number of the international applications estimated in the preparation of the draft budget for the 1984-1985 biennium might be too high and, consequently, that biennium may not prove to be self-supporting. In order to decrease that danger, the proposal for the increase of fees was maintained, although it was difficult to estimate whether a higher number of applications because of lower fees or a lower number of applications because of higher fees would produce more revenue for the PCT Union.
8. The Assembly adopted, with effect from January 1, 1984, the Schedule of Fees as proposed in Annex I of the above-mentioned document. It is also reproduced in the Annex to this report.
9. The Assembly noted the amended table of equivalent amounts communicated to the interested Delegations on September 27, 1983.

ITEM 13 OF THE CONSOLIDATED AGENDA

WORKING CAPITAL FUND OF THE PCT UNION

10. Discussions were based on document PCT/A/X/1.
11. A number of delegations expressed themselves in favor of the establishment of a working capital fund for the PCT Union. However, the Delegation of the United States of America said that it did not believe that a working capital fund for the PCT Union was necessary. In any event, that Delegation would have preferred a decision on such establishment to be deferred until the next ordinary session of the Assembly, in 1985.
12. As far as the amount of the working capital fund was concerned, the majority of the delegations pronounced themselves in favor of an amount of 2,000,000 francs and a few delegations recommended a lower amount ranging from 500,000 francs to 1,500,000 francs.
13. In conclusion, the Assembly of the PCT Union made the following decisions:
 - (i) The working capital fund of the PCT Union is hereby established; its amount will be 2,000,000 francs to be covered by instalments of 500,000 francs each year, payable on July 1 of 1984, 1985, 1986, 1987; the amount that each State member of the PCT Union will pay each year will be in the same proportion to 500,000 francs as the number of international applications filed by residents of that State in the preceding year is to the total number of international applications filed in that (that is, the preceding) year.
 - (ii) The possible need for a working capital fund in excess of 2,000,000 francs will be examined during the next (1985) ordinary session of the Assembly of the PCT Union in the light of the report of the Director General and any views expressed by the WIPO Budget Committee on the question.

[Annex follows]

ANNEX

SCHEDULE OF FEES

<u>Fees</u>	<u>Amounts</u>
1. Basic Fee: (Rule 15.2(a))	
if the international application contains not more than 30 sheets	623 Swiss francs
if the international application contains more than 30 sheets	623 Swiss francs plus 13 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	150 Swiss francs
3. Handling Fee: (Rule 57.2(a))	191 Swiss francs
4. Supplement to the Handling Fee: (Rule 57.2(b))	191 Swiss francs
<u>Surcharges</u>	
5. Surcharge for late payment: (Rule 16bis.2(a))	Minimum: 236 Swiss francs Maximum: 594 Swiss francs

[End of Annex and of document]

WIPO



PCT/A/XI/9

ORIGINAL: English

DATE: February 3, 1984

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Eleventh Session (7th Extraordinary)
Geneva, January 30 to February 3, 1984

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly of the International Patent Cooperation Union (PCT Union) (hereinafter referred to as "the Assembly") held its eleventh session (7th extraordinary) in Geneva from January 30 to February 3, 1984.
2. The following 19 Contracting States were represented at the session: Australia, Austria, Belgium, Brazil, Denmark, Finland, France, Germany (Federal Republic of), Hungary, Japan, Luxembourg, Netherlands, Norway, Romania, Soviet Union, Sweden, Switzerland, United Kingdom and United States of America.
3. The following two States, members of the International Union for the Protection of Industrial Property (Paris Union), participated in the session as observers: Republic of Korea and Spain.
4. The European Patent Organisation (EPO), having the status of special observer, was represented. The following nine international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), Committee of National Institutes of Patent Agents (CNIPA), European Federation of Agents of Industry in Industrial Property (FEMIP), Institute of Professional Representatives Before the European Patent Office (EPI), International Association for the Protection of Industrial

Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International Federation of Inventors' Associations (IFIA), Union of European Practitioners in Industrial Property (UEPIP) and Union of Industries of the European Community (UNICE).

5. The list of participants is contained in Annex I to this report.

OPENING OF THE SESSION

6. The Chairman, Mr. I. Marinescu (Romania), opened the session.

7. Mr. F. Curchod (WIPO) acted as Secretary of the session.

ADOPTION OF THE AGENDA

8. The Assembly adopted the agenda of its session as contained in document PCT/A/XI/1 Rev., after the reference, in item 4 thereof, to document PCT/A/XI/7 had been replaced by a reference to document PCT/A/XI/7 Rev.

AMENDMENT OF THE RULES OF PROCEDURE OF THE ASSEMBLY, OF THE PCT COMMITTEE FOR TECHNICAL COOPERATION, OF THE PCT COMMITTEE FOR ADMINISTRATIVE AND LEGAL MATTERS AND OF THE PCT COMMITTEE FOR TECHNICAL ASSISTANCE

9. Discussions were based on document PCT/A/XI/2.

10. The Assembly adopted the amendments to the said Rules of Procedure which had been proposed in document PCT/A/XI/2, after having slightly modified the proposed amendments. The texts of the said Rules of Procedure as amended by the Assembly are contained in Annexes II, III, IV and V to this report.

AMENDMENT OF THE AGREEMENTS CONCLUDED BETWEEN CERTAIN INTERNATIONAL SEARCHING AUTHORITIES AND THE INTERNATIONAL BUREAU

11. Discussions were based on document PCT/A/XI/7 Rev.

12. In the course of the session, the Secretariat, referring to the second footnote appearing on page 2 of that document, announced that the Australian Government had approved the amendment to the Agreement between the Australian Patent Office and the International Bureau.

13. The Assembly approved amendments to the following provisions of the Agreements indicated below:

- (i) Article 7(2) of the Agreement between the Australian Patent Office and the International Bureau of WIPO;
- (ii) Article 7(2) of the Agreement between the Federal Ministry for Trade, Commerce and Industry of Austria and the International Bureau of WIPO;
- (iii) Article 8(2) of the Agreement between the Japanese Patent Office and the International Bureau of WIPO;
- (iv) Article 7(2) of the Agreement between the Royal Patent and Registration Office of Sweden and the International Bureau of WIPO;
- (v) Article 7(2) of the Agreement between the USSR State Committee for Inventions and Discoveries and the International Bureau of WIPO;
- (vi) Article 8(2) of the Agreement between the International Bureau of WIPO and the European Patent Organisation.

14. The texts of the amended provisions of the said Agreements are contained in Annex VI to this report.

AMENDMENT OF CERTAIN TIME LIMITS IN THE PCT AND OF THE REGULATIONS UNDER THE PCT

15. Mr. G. Borggård (Sweden), Vice-Chairman of the Assembly, took the chair of the session as from this item of the agenda.

16. Discussions were based on documents PCT/A/XI/3, 4, 5, 6 and 8.

17. Following the discussions of the proposals contained in the documents referred to in the previous paragraph, the Assembly unanimously adopted amendments to the PCT and to the Regulations under the PCT (including, where applicable, the deletion of some Rules or the inclusion of new Rules). Those amendments concern Articles 22(2) and 39(1)(a) of the Treaty and the following Rules of the Regulations: 4.10, 4.17, 6.4, 8.2, 11.15, 12.1, 12.2, 13*bis*.7, 15.4, 16*bis*.1, 16*bis*.2, 16*bis*.3, 17.1, 20.5, 22.1, 22.2, 22.3, 22.4, 22.5, 23.1, 24.1, 26.2, 26.3, 26.3*bis*, 26.4, 26.5, 28.1, 29.2, 32.1, 32*bis*.1, 34.1, 42.1, 46.1, 46.2, 46.3, 46.4, 46.5, 47.1, 48.2, 48.3, 48.6, 49.1, 49.3, 49.4, 49.5, 51.4, 51*bis*.1, 51*bis*.2, 53.1, 54.3, 54.4, 55.1, 55.2, 58.3, 60.3, 61.1, 62.1, 66.2, 66.3, 66.4, 66.5, 66.7, 66.8, 66.9, 69.1, 70.2, 70.11, 70.16, 70.17, 74.1, 74*bis*.1, 75.1, 75.2, 75.3, 76.1, 76.2, 76.3, 76.5, 80.6, 82.1, 82*bis*.1, 82*bis*.2, 82*ter*.1, 88.2, 88.4, 90.3, 91.1, 91.2, 92.2, 92*bis*.1 and 92*bis*.2.

18. The Assembly decided that all amendments would enter into force on January 1, 1985, subject to the following:

- (i) the amendments to Rules 12.1(c) and (d), 34.1 and 48.3(a) and (b) will become applicable at the same time that the PCT will enter into force in respect of the country which, among Spanish-speaking countries, is the first to ratify or accede to the PCT.
- (ii) the deletion of Rule 80.6(b) will enter into force on January 1, 1986.

19. Several delegations stated that their national provisions would have to be modified in order to comply with the amendments adopted by the Assembly. In their view, those modifications would most probably be effective on the date of entry into force of the amendments. The Assembly felt that, in the event that they should become effective only a few weeks or months later, no practical consequences of any importance were to be feared in view of the nature of the amendments concerned.

20. The texts of the decisions of the Assembly concerning Articles 22(2) and 39(1)(a) and of the amendments to the Regulations under the PCT as adopted by the Assembly appear in Annex VII to this report.

Omitting any drawing from the publication of the abstract where the International Searching Authority finds that no drawing is useful for the understanding of the abstract (see Chapter 3 in document PCT/A/XI/4)

21. When adopting the amendment to Rule 8.2, the Assembly agreed that the applicant would, where he considered that none of the figures of the drawings was useful for the understanding of the abstract, have the possibility to indicate in the check list of the request form referred to in Rule 3.3(a) that no figure of the drawings was suggested to accompany the abstract for publication.

Clarifying the due date of payment of certain fees (see Chapter 6 in document PCT/A/XI/5)

22. With respect to the amendments to Rule 15.4, the Assembly noted a statement by the Delegation of the United States of America that the amendments to paragraphs (a) and (b) were in conflict with the existing national law of its country. Legislation which would remove that conflict was pending before the US Congress and was likely to pass before the entry into force of the amendments. However, as long as the national law had not been so changed, the transitory provision of Rule 15.4(d) was needed. It was understood that Rule 16*bis* would apply, *mutatis mutandis*, to cases covered by that transitory provision.

23. When the Assembly adopted the amendment to Rule 15.4(c), it was understood that the amount to be charged to the International Bureau under Rule 16*bis*.1 was the lower amount referred to in Rule 15.4(c)(i) in all cases where the payment of the fee was due within one month from the date of receipt of the international application.

24. In the course of the discussion of the amendments to Rule 15.4, the question was raised whether Rule 14 (Transmittal Fee) could not be amended accordingly. It was agreed by the Assembly that such amendment could not be made since this was a matter of the national law applicable by the receiving Offices.

25. The Assembly also considered whether, as far as the handling fee and the supplement to the handling fee were concerned (Rule 57.3), a provision comparable to the amendment to Rule 15.4(c) was required. The Assembly agreed on the principle that, in the rare cases where the amount of those fees changed between the date of making the demand or the later election and the date of actual payment of those fees, the amount payable was the changed amount, that is, the amount in force on the date of payment. An express provision in Rule 57.3, however, was not felt to be necessary, the more so as the applicant would, in case of

insufficient payment, receive an invitation to pay the missing amount without having to pay any surcharge.

Providing for quicker information of the International Bureau where charges are made under Rule 16bis, and providing for the universal application of that Rule (see Chapter 7 in document PCT/A/XI/4)

26. In the course of the discussion of the proposed deletion of Rule 16bis.3, the Assembly noted that the receiving Office of Japan had withdrawn its notification under Rule 16bis.3 with effect as from February 1, 1984.

Making safer the transmittal of the record copy (see Chapter 9 in document PCT/A/XI/4)

27. When adopting the amendments to Rule 22.1, the Assembly agreed that, as long as measures for the preservation of national security prevented the international application from being treated as such, the procedure under Rules 20.5(c) and 22 would not apply.

28. When adopting the amendment to Rule 22.3, the Assembly agreed that, unless the international application was considered withdrawn, the applicant would, irrespective of whether the time limit prescribed by Rule 22.3 had expired or not, have to enter the national phase before the designated (or elected) Offices within the time limit applicable under Article 22 (or Article 39(1)), failing which he would lose his rights under Article 24(1)(iii) (or Article 39(2)). It was furthermore understood that where the international application was considered withdrawn under Article 12(3) after the applicant had performed the acts referred to in Article 22(1), it was a matter for the designated Office to decide whether the effect of the international application under Article 11(3) should be maintained under Article 24(2) or Article 25 or should cease in the designated State for which the designated Office acts as national Office.

29. When the Assembly adopted the deletion of Rule 22.2 and the amendment to Rule 22.3, it was understood that the receiving Offices and the International Bureau should take appropriate measures in order to ensure early and complete information of the users of the PCT system on the deletion of the alternative procedure for the transmittal of the record copy under Rule 22.2 and on the new time limit under Rule 22.3.

Doing away with the obligation of the International Searching Authority to bring certain defects referred to in Article 14(1)(a) to the attention of the receiving Office (see Chapter 12bis in document PCT/A/XI/4)

30. When adopting the deletion in Rule 28.1(a) of the reference to the International Searching Authority, the Assembly agreed that the deletion of that reference would not prevent the International Searching Authority from bringing a previously overlooked defect to the attention of the receiving Office.

31. When adopting the amendment to Rule 28.1(a), the Assembly agreed that the Guidelines for Receiving Offices for the Processing of International Applications under the PCT should be revised in order to better clarify the formality examination standards, in particular, the physical requirements for reasonably uniform international publication referred to in Rule 26.3, so that the cases of application of Rule 28.1 would decrease in the future.

Allowing the filing of withdrawal of the international application, of designations or of the priority claim in all cases with the receiving Office; specifying other procedural matters in connection with withdrawals (see Chapter 14 in document PCT/A/XI/4)

32. When adopting the amendments to Rule 32.1, the Assembly agreed that it was possible for an applicant to withdraw his international application on the condition that it would not be published under Article 21.

33. In the course of the discussion of the proposed amendment to Rule 32*bis*.1(c), the Assembly noted that the International Bureau would not publish an international application on a date computed on the basis of the original priority date if it received the withdrawal of the priority claim before the completion of the technical preparations for international publication but after the expiration of the period of 15 days referred to in the second sentence of Rule 32*bis*.1(c).

Including certain patent documents published in the Spanish language into the PCT minimum documentation; including the Spanish language among the languages of international publication of international applications (see Chapter 15 in document PCT/A/XI/5)

34. In adopting Rule 12.1(d), the Assembly noted a statement by the Delegation of the United Kingdom which communicated a declaration adopted by the Administrative Council of the EPO in its June 1983 session according to which “the Council has decided to express its support for the amendments to the PCT Regulations proposed by the International Bureau of WIPO to facilitate the participation of Spain and the Spanish-speaking countries of Latin America in the PCT system; the Council has decided that the EPO may act as an International Searching Authority for international applications in Spanish, provided these are accompanied by a translation into one of the EPO’s official languages before reaching the [European Patent] Office; the Member States have agreed to support a proposal from the [European Patent] Office to amend PCT Rule 12 to provide for these procedures.”

35. The representative of the EPO also welcomed the proposals concerning the Spanish language, whereas the Delegation of Spain said that it would have preferred that paragraph (d) of Rule 12.1 be omitted.

36. In consequence it was noted that there subsisted no doubt that the European Patent Office would make the declaration referred to in paragraph (d) as far as the Spanish language is concerned and that the said paragraph was needed for authorities other than the European Patent Office and, in the case of the European Patent Office, possibly for other languages than Spanish. The Delegation of Spain expressed its agreement on that solution which seemed to be acceptable from a practical point of view, in particular with a view to finding a quick solution in order to allow for the filing of international applications in Spanish.

37. The representative of the EPO pointed out that the declaration adopted by the Administrative Council of the EPO was concerned only with the role of the European Patent Office as an International Searching Authority. He added that there were some practical problems yet to be solved, hopefully without a need to change the PCT Regulations or the Agreement between the EPO and the International Bureau, concerning the language of the international search report, the final establishment of the title and of the abstract, correspondence with applicants and the rectification of errors.

38. The Director General said that the International Bureau would be at the disposal of both the Spanish-speaking countries and the EPO in order to contribute to finding solutions to those problems and added that, in view of the practical nature of the problems, he was convinced that they could be solved without further changes to the Regulations or to the above-mentioned Agreement.

39. The Assembly also adopted the proposed amendments to Rules 34.1 and 48.3 permitting patent documents published in the Spanish language to be included into the PCT minimum documentation under certain conditions and recognizing the Spanish language as one of the languages of international publication of international applications.

40. With respect to the amendment of Rule 34.1(c)(vi) and (e), the Delegation of the United Kingdom said that its Office, in its capacity as International Preliminary Examining Authority, would need to receive the sorted collections of Spanish-language patent documents with English abstracts referred to in the said provisions in the same manner as for International Searching Authorities.

Specifying the time limit for international search in the PCT Regulations (see Chapter 16 in document PCT/A/XI/3).

41. When the Assembly adopted the amendment to Rule 42.1, it was understood that where, due to the late payment of the search fee, the remaining time of the three-month period for the establishment of the international search report did not allow the timely establishment of that report, its transmittal could be effected exceptionally after the expiration of the three-month period, but not later than one month after that expiration.

Giving more time to the applicant for filing, during the international phase, amendments to the claims in certain cases (see Chapter 17 in document PCT/A/XI/3)

42. When adopting the amendment to Rule 46.1, the Assembly agreed that the Guidelines for Receiving Offices for the Processing of International Applications under the PCT and the Guidelines for International Search to be Carried Out under the PCT should state that, in those cases where amendments under Article 19 would be submitted by the applicant to the receiving Office or to the International Searching Authority, instead of being directly filed with the International Bureau, that Office or Authority should transmit them promptly to the International Bureau.

Simplifying the communication under Article 20 of the international application; changing the date which is relevant for an indication in the pamphlet if certain events have not occurred before that date (see Chapter 20 in document PCT/A/XI/3)

43. In the course of the discussion of the proposal to amend Rule 47, the Assembly, notwithstanding an earlier proposal for amendment by the International Bureau which would have allowed to use the pamphlet for the purposes of communication under Article 20 in all cases, decided not to amend the present text of Rule 47.2(c). However, it was understood that the International Bureau could ask at any time for a reconsideration of that provision if the exceptions to the general rule that copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20 were to increase to such an extent that they would put a substantial additional burden on the International Bureau.

Making it possible for the applicant to present additional arguments to the International Preliminary Examining Authority even where he submits no amendments; making longer the time limit for establishing the international preliminary examination report (see Chapter 25 in document PCT/A/XI/5)

44. When adopting the amendment to Rule 69.1, the Assembly agreed that during the transitory period when the time limit of 30 months from the priority date under the amended Article 39(1)(a) was not applicable to all Offices elected by an applicant, the International Preliminary Examining Authority should, if the applicant so desired, establish the international preliminary examination report, whenever feasible, before the expiration of 25 months from the priority date.

Simplifying the procedure where the International Preliminary Examining Authority needs the priority document but the International Bureau has not received it under Rule 17.1 (see Chapter 26 in document PCT/A/XI/4)

45. When adopting the amendment to Rule 66.7(a), the Assembly agreed that where, through no fault of the applicant, the International Preliminary Examining Authority had not received a copy of the priority document prior to the establishment of the international preliminary examination report, it was left to the International Preliminary Examining Authority to decide whether or not, when establishing the said report, the priority claim would be disregarded.

Making uniform for all receiving Offices the manner of computing time limits (see Chapter 27 in document PCT/A/XI/4)

46. In the course of the discussion of the proposed deletion of Rule 80.6(b), the Assembly noted that the receiving Office of Japan had withdrawn its notification under Rule 80.6(b) with effect as from February 1, 1984. The Assembly was informed by the Delegation of Sweden that the necessary adaptation of the national law of its country had been completed and that the receiving Office of Sweden would, in the near future, withdraw its notification under Rule 80.6(b). The Delegations of Denmark, Finland and Norway informed the Assembly that the preparations for an amendment to the national laws of their countries had started but that it was unlikely that the process of amending those laws would be completed by the end of this year. They added that, therefore, the entry into force of the deletion of Rule 80.6(b) should be delayed.

Making more liberal the rules concerning the rectification of obvious errors in the international application and other documents of the applicant (see Chapter 30 in document PCT/A/XI/5)

47. When adopting the amendment to Rule 91.1(f), the Assembly agreed that the publication by the International Bureau of a request for rectification where the rectification had been refused during the international phase would not relieve the applicant from the need to request, during the national phase, the designated Offices to authorize the rectification. It was also agreed that the PCT Applicant's Guide should contain information to that effect and that it would also indicate how the International Bureau would obtain the request the publication of which was requested.

Fixing a time limit for the possibility of asking for the recording of certain changes in the request or the demand (see Chapter 31 in document PCT/A/XI/4)

48. When the Assembly adopted the proposed amendments to Rule 92*bis*, it was understood that, where the International Bureau would not record a requested change because the applicable time limit under Rule 92*bis*.1(b) had expired when it received the request for recording the change, the International Bureau, if a preliminary examination was under way by that time, would inform the International Preliminary Examining Authority of the requested change and notify the applicant that he had to request the change before each elected Office.

Making uniform, and in some cases longer, the time limits for entering the national phase in designated or elected States (see Chapter 32 & 33 in document PCT/A/XI/5)

49. In the course of the discussion on the extension of the time limits under Article 22(2) and Article 39(1)(a), the Assembly was informed by the Delegation of Sweden that an amendment to the national law of its country had entered into force on October 1, 1983, which would make it compatible with the extension of the time limit under Article 22(2); the extension of the time limit under Article 39(1)(a), however, would still require a further amendment to the national law but it was hoped that such change would become effective before January 1, 1985. The Delegation of Austria said that the national law of its country was presently also in conflict with the extended time limit under Article 39(1)(a) but that it was being amended; the Delegation added that it was convinced that the necessary amendments would enter into force during 1984. The Delegation of Japan stated that the national law of its country was presently in conflict with the extended time limit under Article 39(1)(a) but that it would be amended as required; the Delegation stated that the Japanese Government would be in a position to apply the 30-month period latest in the course of 1985. The Delegation of Brazil stated that, while maintaining the reservations reflected in paragraph 81 of the report on the second session of the PCT Committee for Administrative and Legal Matters (document PCT/CAL/II/9), it would not object to a consensus on the amendment proposed to Article 39(1)(a).

50. As far as the extension of the time limit under Article 39(1)(a) was concerned, all those participating in the discussion recognized that the said extension constituted a very important improvement for applicants and for the PCT system in general.

51. The Delegations of the United Kingdom and of the Netherlands informed the Assembly that certain interested circles in their countries had expressed concern that a longer time limit for entry into the national phase under Article 39(1)(a) might, under certain circumstances, increase the uncertainty as to the fate of pending international applications. The Assembly felt that the uncertainties which existed under any patent procedure were not significantly affected by the said prolongation.

52. Some delegations and some of the representatives of non-governmental organizations, while underlining the distinct advantages of the extension of the time limit under Article 39(1)(a), expressed, nevertheless, some hesitations as to its consequences since the greater attractiveness of the use of Chapter II of the PCT resulting therefrom might, in the case of the European Patent Office, in its capacity as International Preliminary Examining Authority, lead to an additional burden which, in turn, might affect the processing of other applications. In this context, particular reference was made to the possibility that the United States Patent and Trademark Office, once Chapter II became applicable for the United States

of America, might, for a transitory period at least, specify the European Patent Office as competent International Preliminary Examining Authority for international applications filed with it.

53. The representative of the EPO replied that his Organisation welcomed the proposed extension of the time limit under Article 39(1)(a) since it would alleviate the time pressure under which the European Patent Office had to carry out international preliminary examination under the present 25-month time limit. It would be extremely difficult, without an extension of the time limit, to absorb any increase of such examination work. Therefore, the proposed amendment would help the European Patent Office. The question whether the European Patent Office would be specified as competent International Preliminary Examining Authority for international applications filed in the United States of America was not the concern of the Assembly but of the Administrative Council of the EPO. If any negative effect on the normal functioning of the European Patent Office would occur, the necessary measures would be taken in order to ensure an appropriate processing of applications not filed under the PCT.

54. The Delegation of the United States of America said that, although its country was not bound by Chapter II of the PCT, it would welcome the proposed amendment. If its country was to accept Chapter II, which was under consideration, this would be of benefit for all users of the PCT system and not only for applicants from the United States of America. Because of internal commitments, however, it was impossible to envisage that the United States Patent and Trademark Office could assume the task of an International Preliminary Examining Authority before 1986 or 1987. It was therefore desirable to reach an interim solution with the EPO. If no mutually acceptable solution could be found, the Government of the United States of America would have to reconsider the timetable for the withdrawal of its reservation excluding the application of Chapter II of the PCT.

55. The Chairman concluded the discussion with the statement that the question of possible effects of cooperation under Chapter II between the United States Patent and Trademark Office and the EPO which might be envisaged at a later stage was not a matter for consideration by the Assembly. Moreover, it appeared from what had been stated by the Delegation of the United States of America as well as by other delegations and the representative of the EPO that there should be no risk of any negative effect on the European patent system arising from any such future cooperation under the PCT between the two Offices since it would have to be on terms satisfactory to both parties.

56. When the Assembly adopted the amendment to the time limit under Article 22(2), it agreed that the extended time limit would apply as from its entry into force to all pending international applications to which Article 22(2) was applicable. Where the International Searching Authority had made a declaration, under Article 17(2)(a), that no international search report would be established, and where the present two-month time limit was applicable on the date of the notification of the said declaration but had not expired on the date of entry into force of the modification of the time limit under Article 22(2), the two-month time limit would automatically be extended to 20 months from the priority date.

57. When the Assembly adopted the amendment to the time limit under Article 39(1)(a), it agreed that the extended time limit would apply as from its entry into force to all pending international applications to which Article 39(1)(a) was applicable. Where, on the date of entry into force of the extended time limit of 30 months from the priority date, the present

time limit of 25 months from the priority date had not expired with respect to such applications, the new time limit of 30 months would apply. In respect of the amended time limit under Rule 69.1 for the establishment of the international preliminary examination report, it was understood that the new time limit of 28 months from the priority date would apply in all cases where, on the date of its entry into force, the international preliminary examination report had not yet been established.

Making it unnecessary for the applicant to transmit copies of his international application to the designated Offices (see Chapter 34 in document PCT/A/XI/5)

58. In the course of the discussion of the new Rule 49.1(a-bis) and (a-ter), it was pointed out that not all designated Offices relied entirely on the communication of the international application under Article 20 since the national laws applied by some designated Offices provided that a copy of the international application had to be provided within the Article 22 time limit. If the Article 20 communication had not taken place, such an Office would require a copy of the international application from the applicant.

Specifying the requirements for entering the national phase, in particular, the contents of the translation of the international application (see Chapter 35 in document PCT/A/XI/5)

59. When the Assembly adopted new Rule 49.5(g), it agreed that, where the copy of the drawing, or the drawing executed anew, which was furnished by the applicant did not comply with the physical requirements referred to in Rule 11 (for instance, because the translation of the text matter had been furnished separately whereas it resulted from Rule 11.11 that the text matter of a drawing must be contained in the drawing and could not be furnished separately), the designated Office had the right to request the applicant to correct such defect. On the other hand, since this was merely a defect concerning a physical requirement under Rule 11, it should not consider the international application withdrawn and it should not disregard the drawing. It was to be noted, however, that the international application may be considered withdrawn in case of a failure to furnish the translation of any text matter contained in a drawing.

60. When the Assembly adopted new Rule 49.5(a)(iii), it agreed that the designated Office may require the translation of the international application to be accompanied by a copy of the drawing but it may not require the translation to be accompanied by a drawing executed anew. It was furthermore understood that, if the applicant amended his application during the national phase, it might be necessary to furnish new drawings but that such case was to be distinguished from the cases covered by the new Rule 49.5 which dealt with what the applicant was required to furnish or may not be required to furnish as a condition for entering the national phase.

61. When the Assembly adopted new Rule 49.5(c), it was understood that the designated Office would not be obliged to disregard the statement if not translated; it could take it into account, for instance, if it was drafted in a language which was understood by its examiners. On the other hand, disregarding the statement would be the only possible sanction in case of failure to furnish a translation thereof.

Making it clear that certain requirements to be complied with during the national phase must be complied with by the applicant only after entering the national phase (see Chapter 36 in document PCT/A/XI/5)

62. When the Assembly adopted new Rule 51**bis**.1(a), it agreed that the documents referred to under item (v) of that Rule, namely those which contained proof of the right of the applicant to claim priority where that applicant was different from the applicant having filed the earlier application the priority of which was claimed, included any document relating to the identity of the applicant having filed that earlier application.

63. It was further agreed by the Assembly that item (vi) of new Rule 51**bis**.1(a) would only cover the evidence required in support of a statement concerning non-prejudicial disclosures or exceptions to lack of novelty but not the statement itself. The statement, if not contained in the description, could be required to be furnished in the request. That could be achieved by adding a new optional box to the request form or by adding the case of non-prejudicial disclosures among the cases in which the supplemental box may be used, as would be possible with the new text of Rule 4.17(a). Thus, the evidence would fall under Article 27(2)(ii) as a document constituting proof of a statement made in the international application which, under Article 27(2)(ii), may be required only once the processing of the international application had started in the designated Office.

64. With respect to paragraphs (a)(iii) and (d) of new Rule 51**bis**.1, the Assembly noted a statement by the Delegation of the United States of America that those paragraphs were in conflict with the existing national law of its country. Legislation which would remove that conflict was pending before the US Congress and was likely to pass before the entry into force of the new Rule. However, as long as the national law had not been so changed, a reference to paragraphs (a)(iii) and (d) of Rule 51**bis**.1 was needed in Rule 51**bis**.2(c).

65. When the Assembly adopted new Rule 51**bis**.2, it was understood that there were various possibilities by which the opportunity to comply with national requirements after the entry into the national phase could be granted to the applicant. For instance, the national Office may invite the applicant to comply with the requirement in question within a certain reasonable time limit fixed in the invitation; the national Office may remind the applicant of the said requirement which had to be complied with within a certain time limit or before a certain event (e.g., decision to grant a patent) occurred; the national law may fix a grace period for the compliance or determine a certain event by which the requirement must be complied with after national processing had started; the national Office may, unless the national law expressly provided otherwise, simply accept a later compliance with the requirement or excuse a late compliance, etc.

Improving the wording of Rule 74.1 and simplifying the time limit for the transmittal of the translation of any annexes to the international preliminary examination report (see Chapter 37 in document PCT/A/XI/5)

66. When adopting the amendments to Rule 74.1, the Assembly agreed that the furnishing of a translation of the annexes to the international preliminary examination report was not governed by Article 39(1). That Article applied only to the furnishing of a translation of the international application as filed or, where amended under Article 19(1), as amended. The translation of the annexes to the international preliminary examination report must be furnished pursuant to Article 36(3) (b). The sanction provided for the non-furnishing of a

translation of the international application in Article 39(2) did not apply to the failure to furnish a translation of the annexes to the international preliminary examination report. As a consequence, the sanction for the non-furnishing of a translation of those annexes was left to the national law applied by the elected Office.

Making it clear in which cases Contracting States must excuse delays in meeting time limits or rectify an error made by an international authority (see Chapter 38 in document PCT/A/XI/5)

67. When the Assembly adopted the new Rule 82*bis*.1, it was understood that the excusing of the delay in meeting a time limit may take place, under Article 48(2), only during the national phase, independent of whether the delay to be excused concerned a time limit pertaining to the international phase or a time limit pertaining to the national phase. It was further understood that, for the purposes of Article 48(2), the provisions referred to in Rule 81*bis*. 2 may be applied only under the conditions set forth by the national law. For example, if the applicant failed to pay a fee or to correct a defect within a certain time limit and if such failure could be excused under the national law of a Contracting State, it must be excused for international applications. The Delegation of the United Kingdom said that it did not consider that Article 48(2)(a) could override the provisions of Article 24(1) of the Treaty. Under those provisions, if the international application was correctly considered withdrawn during the international phase, the effect of the international application ceased in the designated States, unless any such State voluntarily chose otherwise. The Delegations of the Netherlands and of the United Kingdom said that they were not convinced that Article 48(2)(a) could be understood in such a way that an applicant, having chosen to follow the PCT route, could make use of both the advantages offered by the procedure under the PCT and the advantages that would have been obtained if the applicant had chosen to follow the national route straight away. Other delegations said that PCT applicants should enjoy the unrestricted advantages offered under the national systems.

Final observation

68. The Delegation of the Soviet Union, at the close of the substantive discussions on the modification of time limits in the Treaty and amendments to the Regulations, stressed the need, after the completion of the rather far-reaching round of revisions of the system, to reduce future changes in the Treaty and the Regulations, both in quantity and frequency. Numerous changes at short intervals could be discouraging for the users. It was of course not possible to stop further revision of the system completely. The system, after the overhaul now completed, should be allowed to rest for a while in order to allow those working with it to gain practical experience. Any future revision should be reduced to the extent to which a real need for it could be established.

69. The Assembly agreed with the views expressed by the Delegation of the Soviet Union and, in concluding its discussion of time limits and Regulations, asked for its appreciation of the work done by the International Bureau to be recorded. The mandate given to the International Bureau by the Assembly in 1981 had been most successfully accomplished.

QUESTIONS OF SPECIAL INTEREST TO DEVELOPING COUNTRIES

70. The Assembly considered this question on the basis of paragraphs 10 to 14 of document PCT/A/XI/3 and the Draft Resolution of the Assembly contained in the Annex to that document.

71. The Assembly expressed itself in favor of measures allowing developing countries to derive full benefit from participating in the PCT system as provided for in the Draft Resolution under discussion.

72. The Delegation of Romania stressed the importance of appropriate action on the basis of the proposed Resolution, not only for the developing countries members of the PCT Union, but also for developing countries still remaining outside that Union. Practical implementation of the principles of the Draft Resolution would undoubtedly enhance use of the PCT system by developing countries and, by attracting further developing countries to adhere, broaden the geographical application of the system.

73. The representative of AIPPI suggested to speak in items (1) and (2) of the Draft Resolution of “applicants from” rather than “nationals of” developing countries in order to align the text with that of item (3).

74. The Delegation of the United States of America reiterated its position taken in earlier discussions concerning the question of preferential treatment as to fees payable by applicants from developing countries and stated that, in its view, adoption of this Resolution should await the outcome of the ongoing revision of the Paris Convention for the Protection of Industrial Property and that, in the meantime, any fee reductions for applicants should be considered and granted on the basis of individual need rather than as an automatic consequence of their nationality. Consequently, the Delegation had some reservations with respect to the principles expressed in items (1) and (2) of the Draft Resolution. If that part of the Draft Resolution were retained nevertheless, it should at least be amended as suggested by the representative of AIPPI.

75. The Assembly agreed with the suggestion of the representative of AIPPI.

76. The representative of the EPO drew attention to a decision taken by the Administrative Council of the EPO on December 9, 1983, concerning the reduction, in favor of nationals of developing countries, of the fees for international search and preliminary examination carried out by the European Patent Office as International Searching and Preliminary Examining Authority. This decision, which was unanimously approved by the Administrative Council of the EPO, provided for a reduction by 50% of the search fee and the fee for international preliminary examination where the international application was filed by a national of a developing country with the receiving Office of a developing country or with the receiving Office acting on behalf of that country. Consequently, the EPO had already taken the necessary measures to implement the principles stated in item (2) of the Draft Resolution.

77. Following statements made by the Delegation of Brazil and the International Bureau, welcoming that decision, expressing their gratitude for that significant step towards facilitating the use of the PCT system by nationals of developing countries and expressing the hope that other countries and PCT Authorities would follow that example, the Assembly noted the information provided by the representative of the EPO with appreciation.

78. The Assembly adopted thereafter unanimously the Resolution as amended during the discussion. The text of the Resolution is contained in Annex VIII to this report.

79. The Delegation of Brazil, stressing the need for a reduction of fees in favor of developing countries, and recalling that its original proposal to consider lower fees in favor of nationals of developing countries went further than the Resolution now adopted, underlined that its proposal included also a study with a view to reducing the level of international fees under the PCT for nationals of developing countries. The Resolution now adopted was a step in the right direction but not enough to enhance the universal character of the PCT by the inclusion of more developing countries and the promotion of an increased use of the PCT by developing countries. The Delegation said furthermore that the proposals with respect to the use of the Spanish language in the framework of the PCT, adopted by the Assembly at its present session, constituted a positive step towards more universal acceptance of the PCT and were therefore very welcome.

CONSULTATIONS WITH THE NATIONAL OFFICES AND THE INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES RELATING TO THE ADMINISTRATIVE INSTRUCTIONS

80. The Assembly noted that, on the occasion of the present session, consultations were held between the International Bureau and the national Offices as well as the International Searching and Preliminary Examining Authorities relating to the Administrative Instructions, as provided in PCT Rule 89.2.

81. The consultations were based on the proposed modifications to the Administrative Instructions as contained in documents PCT/A/XI/3, 4 and 5. During the consultations, the International Bureau expressed its intention to study the need for further modifications resulting, in particular, from the amendments to the Regulations which had been adopted by the Assembly. It was necessary in any case to review the existing forms contained in Annex F to the Administrative Instructions. Further consultations would therefore be held, preferably by correspondence. Should, however, the volume and character of the further modifications so require, the Director General would convene a further consultation meeting to advise him before promulgating the modified Administrative Instructions and forms.

82. The Assembly unanimously adopted this report on February 3, 1984.

[Annex I follows]

ANNEX I/ANNEXE I

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS

I. MEMBER STATES/ETATS MEMBRES

AUSTRALIA/AUSTRALIE

Mr. P.M. THOMAS, Senior Assistant Commissioner, Patent, Trade Marks and Designs Office, Canberra

AUSTRIA/AUTRICHE

Mr. N. MARTERER, Vice-President, Austrian Patent Office, Vienna

BELGIUM/BELGIQUE

M. P. CEUNINCK, Secrétaire d'administration, Service de la propriété industrielle, Ministère des affaires économiques, Bruxelles

BRAZIL/BRESIL

Mr. E. CORDEIRO, First Secretary, Permanent Mission, Geneva

DENMARK/DANEMARK

Mr. J. DAM, Head of Section, Patent and Trademark Office, Copenhagen

FINLAND/FINLANDE

Mrs. S.L. LAHTINEN, Acting Deputy Director General, National Board of Patents and Registration, Helsinki

Mrs. E. HÄKLI, Head of Section, National Board of Patents and Registration, Helsinki

FRANCE

M. P. GUERIN, Conseiller juridique, Institut national de la propriété industrielle, Paris

Mlle G. RAJOT, Juriste, Institut national de la propriété industrielle, Paris

GERMANY (FEDERAL REPUBLIC OF)/ALLEMAGNE (REPUBLIQUE FEDERALE D')

Mr. F. GOEBEL, Head of Legal Division, German Patent Office, Munich

Mr. J. SCHADE, Head of Section, German Patent Office, Munich

HUNGARY/HONGRIE

Mr. I. IVANYI, Vice-President, National Office of Inventions, Budapest

Mrs. E. PARRAGH, Head, International Section, National Office of Inventions, Budapest

JAPAN/JAPON

Mr. Y. HASHIMOTO, Director General, Industrial Property Training Institute, Patent Office, Tokyo

Mr. E. SIRAKASI, Director, Examination Standard Office, Patent Office, Tokyo

Mr. S. ONO, First Secretary, Permanent Mission, Geneva

LUXEMBOURG

M. F. SCHLESSER, Inspecteur principal, Service de la propriété intellectuelle, Ministère de l'économie et des classes moyennes, Luxembourg

NETHERLANDS/PAYS-BAS

Mr. J.J. BOS, President, Netherlands Patent Office, Rijswijk

Mr. S. de VRIES, Member of the Patents Council, Netherlands Patent Office, Rijswijk

NORWAY/NORVEGE

Mr. P.T. LOSSIUS, Deputy Director General, Norwegian Patent Office, Oslo

Mr I. LILLEVIK, Head of Section, Patent Department, Norwegian Patent Office, Oslo

Mr. K.H. REINSKOU, Executive Officer, Ministry of Justice, Oslo

ROMANIA/ROUMANIE

M. I. MARINESCU, Directeur, Office d'Etat pour les inventions et les marques, Bucarest

M. P. GAVRILESCU, Troisième Secrétaire, Ministère des affaires étrangères, Bucarest

SOVIET UNION/UNION SOVIETIQUE

Mr. L. KOMAROV, First Deputy Chairman, USSR State Committee for Inventions and Discoveries, Moscow

Mr. V. TROUSSOV, Deputy Director, Patent Examination Department, USSR State Committee for Inventions and Discoveries, Moscow

SWEDEN/SUEDE

Mr. G. BORGGÅRD, Director General, Royal Patent and Registration Office, Stockholm

Ms. B. SANDBERG, Head, International Section, Royal Patent and Registration Office, Stockholm

Mr. E. TERSMEDEN, Legal Adviser, Ministry of Justice, Stockholm

SWITZERLAND/SUISSE

M. M. LEUTHOLD, Chef de la Division administrative, Office fédéral de la propriété intellectuelle, Berne

M. K. GRÜNIG, Fonctionnaire spécialiste, Office fédéral de la propriété intellectuelle, Berne

M. J.-M. SOUCHE, Juriste, Office fédéral de la propriété intellectuelle, Berne

UNITED KINGDOM/ROYAUME-UNI

Mr. A. SUGDEN, Principal Examiner, Patent Office, London

Mr. J. SHARROCK, Principal Examiner, Patent Office, London

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Mr. H.D. HOINKES, Legislative and International Patent Specialist, United States Patent and Trademark Office, Washington, D.C.

Mr. L.O. MAASSEL, Patent Practice and Procedure Specialist, United States Patent and Trademark Office, Washington, D.C.

II. OBSERVER STATES/ETATS OBSERVATEURS

REPUBLIC OF KOREA/REPUBLIQUE DE COREE

Mr. J.U. CHAE, Commercial Attaché, Permanent Mission, Geneva

SPAIN/ESPAGNE

Sr. J. DELICADO MONTERO-RIOS, Director General del Registro de la Propiedad Industrial, Madrid

Sra. S. JESSEL, Directora, Departamento Estudios y Relaciones Internacionales, Registro de la Propiedad Industrial, Madrid

Sr. A. CASADO CERVINO, Jefe del Servicio de Relaciones Internacionales, Registro de la Propiedad Industrial, Madrid

III. INTERGOVERNMENTAL ORGANIZATION/ORGANISATION
INTERGOUVERNEMENTALE

EUROPEAN PATENT ORGANISATION (EPO)/ORGANISATION EUROPEENNE DES
BREVETS (OEB)

M. U. SCHATZ, Directeur principal, Affaires internationales, Office européen des brevets,
Munich

Mme L. GRUSZOW, Administrateur, Affaires internationales, Office européen des brevets,
Munich

M. M.S. PÅRUP, Juriste, Affaires juridiques, Office européen des brevets, Munich

IV. INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS/
ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES

ASIAN PATENT ATTORNEYS ASSOCIATION (APAA)/ASSOCIATION ASIATIQUE
D'EXPERTS JURIDIQUES EN BREVETS

Mr. T. YAMAGUCHI, Chairman, PCT Committee, Japanese Group, Tokyo

COMMITTEE OF NATIONAL INSTITUTES OF PATENT AGENTS (CNIPA)/COMITE
DES INSTITUTS NATIONAUX D'AGENTS DE BREVETS

Mr. C.J.W. EVERITT, Patent Agent, London

EUROPEAN FEDERATION OF AGENTS OF INDUSTRY IN INDUSTRIAL
PROPERTY/FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN
PROPRIETE INDUSTRIELLE (FEMIP)

M. F.A. JENNY, Vice-président, Bâle, Suisse

INSTITUTE OF PROFESSIONAL REPRESENTATIVES BEFORE THE EUROPEAN
PATENT OFFICE (EPI)/INSTITUT DES MANDATAIRES AGREES PRES L'OFFICE
EUROPEEN DES BREVETS

M. F.A. JENNY, Président, Commission pour la pratique du brevet européen,
Bâle, Suisse

INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY/ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE LA
PROPRIETE INDUSTRIELLE (AIPPI)

M. G.R. CLARK, Membre d'honneur, Downers Grove, Etats-Unis d'Amérique

INTERNATIONAL FEDERATION OF INDUSTRIAL PROPERTY
ATTORNEYS/FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE
INDUSTRIELLE (FICPI)

Mr. H. BARDEHLE, President, Munich

Mr. K. RAFFNSOE, Vice-President, Study and Works Commission, Copenhagen

INTERNATIONAL FEDERATION OF INVENTORS' ASSOCIATIONS
(IFIA)/FEDERATION INTERNATIONALE DES ASSOCIATIONS DES INVENTEURS

Mr. C.P. FELDMANN, Glattbrugg, Switzerland

UNION OF EUROPEAN PRACTITIONERS IN INDUSTRIAL PROPERTY
(UEPIP)/UNION DES PRATICIENS EUROPEENS EN PROPRIETE INDUSTRIELLE
(UPEPI)

M. G.E. KIRKER, Ingénieur-conseil en propriété industrielle, Genève

UNION OF INDUSTRIES OF THE EUROPEAN COMMUNITY/UNION DES
INDUSTRIES DE LA COMMUNAUTE EUROPEENNE (UNICE)

Mr. R. KOCKLÄUNER, Hoechst AG, Frankfurt

V. OFFICERS/BUREAU

Chairman/Président	: M. I. MARINESCU (Romania/Roumanie)
Vice-Chairmen/Vice-présidents	: Mr. G. BORGGÅRD (Sweden/Suède) (Togo)
Secretary/Secrétaire	: M. F. CURCHOD (WIPO/OMPI)

VI. INTERNATIONAL BUREAU OF WIPO/BUREAU INTERNATIONAL DE L'OMPI

Dr. A. BOGSCH, Director General

Mr. K. PFANNER, Deputy Director General

M. F. CURCHOD, Directeur, Division du PCT

Mr. J. FRANKLIN, Deputy Head, PCT Division

Mr. B. BARTELS, Head, PCT Legal Section

Mr. N. SCHERRER, Head, PCT Publications, Fees and Statistics Section

Mr. Y. PLOTNIKOV, Senior Counsellor, PCT Legal Section

Mr. T. HIRAI, Examination Procedures Officer, PCT Examination Section

[Annex II follows/L'annexe II suit]

ANNEX II

RULES OF PROCEDURE OF THE
ASSEMBLY OF THE PCT UNION
as amended on February 3, 1984

Rule 1: Application of the General Rules of Procedure

The Rules of Procedure of the Assembly of the International Patent Cooperation (PCT) Union shall consist of the General Rules of Procedure of WIPO, supplemented and amended by the provisions set forth hereinafter.

Rule 2: Special Observers

Intergovernmental authorities having the power to grant patents effective in one or more States members of the PCT Union shall be invited as “special observers” to all sessions of the Assembly. They shall have the same rights in the sessions of the Assembly as States members of the Assembly, except the right to vote.

Rule 3: Draft Agenda

The draft agenda of each session shall be drawn up by the Director General. In the case of ordinary sessions, such draft shall follow the instructions of the Executive Committee once the Executive Committee is established (see PCT Articles 53(9) and 54(6)(a)). In the case of extraordinary sessions, the said draft shall include the item or items mentioned in the request referred to in Article 53(11)(c) of the Patent Cooperation Treaty.

Rule 4: Publication of the Report

The report on the work of each session, or a summary drawn up by the International Bureau, shall be published in the Gazette of the PCT Union and in the reviews of the World Intellectual Property Organization La Propriété industrielle and Industrial Property.

[Annex III follows]

RULES OF PROCEDURE OF THE PCT COMMITTEE
FOR TECHNICAL COOPERATION (PCT/CTC)
as amended on February 3, 1984

Rule 1: Application of the General Rules of Procedure

The PCT Committee for Technical Cooperation (PCT/CTC, hereinafter referred to as “the Committee”), being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, supplemented and amended by the provisions set forth hereinafter.

Rule 2: Special Observers

Intergovernmental authorities not members of the Committee which have the status of special observer in the PCT Assembly shall be invited as “special observers” to all sessions of the Committee. They shall have the same rights in the sessions of the Committee as members of the Committee, except the right to vote.

Rule 3: Joint Meetings with the WIPO Permanent Committee on Patent Information

The meetings of the Committee shall be joint with those of the WIPO Permanent Committee on Patent Information, it being understood that the activities of the two Committees shall be coordinated and that, where decisions are made by the Committee, only the members of the Committee shall vote.

[Annex IV follows]

RULES OF PROCEDURE OF THE PCT COMMITTEE FOR
ADMINISTRATIVE AND LEGAL MATTERS (PCT/CAL)
as amended on February 3, 1984

Rule 1: Composition

The PCT Committee for Administrative and Legal Matters (PCT/CAL, hereinafter referred to as “the Committee”) shall have as members the States members of the PCT Union and the International Searching and Preliminary Examining Authorities, it being understood that, where any such Authority is the national Office of a State member of the PCT Union, that State shall not be additionally represented on the Committee.

Rule 2: Terms of Reference

The Committee shall deal with matters concerning

(i) the relationship between the International Bureau on the one hand and the applicants, the receiving Offices, the designated Offices, the elected Offices, the International Searching Authorities and the International Preliminary Examining Authorities on the other hand,

(ii) the relationship between the applicants on the one hand and the receiving Offices, the designated Offices, the elected Offices, the International Searching Authorities and the International Preliminary Examining Authorities on the other hand,

(iii) the relationship between the receiving Offices, the designated Offices and the elected Offices on the one hand and the International Searching Authorities and the International Preliminary Examining Authorities on the other hand,

(iv) fees, forms, procedures and publications under the PCT,

(v) other administrative and legal questions concerning the application of the PCT.

Rule 3: Application of the General Rules of Procedure

The Committee, being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, supplemented and amended by the provisions set forth hereinafter.

Rule 4: Special Observers

Intergovernmental authorities not members of the Committee which have the status of special observer in the PCT Assembly shall be invited as “special observers” to all sessions of the Committee. They shall have the same rights in the sessions of the Committee as members of the Committee, except the right to vote.

Rule 5: Observers

The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested organizations to attend the sessions of the Committee in an observer capacity.

Rule 6: Working Groups

The Committee may, with the approval of the Assembly, set up working groups for the purposes of dealing with specific questions. It shall decide their composition, terms of reference, duration and rules of procedure.

[Annex V follows]

RULES OF PROCEDURE OF THE PCT COMMITTEE
FOR TECHNICAL ASSISTANCE (PCT/CTA)
as amended on February 3, 1984

Rule 1: Application of the General Rules of Procedure

The PCT Committee for Technical Assistance (PCT/CTA, hereinafter referred to as “the Committee”), being, within the meaning of Rule 12 of the General Rules of Procedure of WIPO, a subsidiary body of the PCT Assembly, the provisions of the said General Rules of Procedure shall be the Rules of Procedure of the Committee, supplemented and amended by the provisions set forth hereinafter.

Rule 2: Special Observers

Intergovernmental authorities which have the status of special observer in the PCT Assembly shall be invited as “special observers” to all sessions of the Committee. They shall have the same rights in the sessions of the Committee as States members of the Committee, except the right to vote.

Rule 3: Observers

The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested international non-governmental organizations to attend the sessions of the Committee in an observer capacity.

Rule 4: Joint Meetings with the WIPO Permanent Committee for Development Cooperation
Related to Industrial Property

The meetings of the Committee shall be joint with those of the WIPO Permanent Committee for Development Cooperation Related to Industrial Property, it being understood that the activities of the two Committees shall be coordinated and that, where decisions are made by the Committee, only the members of the Committee shall vote.

[Annex VI follows]

ANNEX VI

TEXTS OF THE AMENDED PROVISIONS OF THE
AGREEMENTS CONCLUDED BETWEEN CERTAIN
INTERNATIONAL SEARCHING AUTHORITIES AND
THE INTERNATIONAL BUREAU OF WIPO

Agreement between the Australian Patent Office
and the International Bureau of WIPO

Article 7

Fees and Charges

(1) [No change]

(2) The Authority shall, to the extent and under the conditions set out in Annex C of this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1).

Agreement between the Federal Ministry for Trade, Commerce and Industry of Austria and
the International Bureau of WIPO

Article 7

Fees and Charges

(1) [No change]

(2) The Authority shall, to the extent and under the conditions set out in Annex C of this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1).

Agreement between the Japanese Patent Office
and the International Bureau of WIPO

Article 8

Fees and Charges

(1) [No change]

(2) The Authority shall, to the extent and under the conditions set out in Annex D of this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1).

Agreement between the Royal Patent and
Registration Office of Sweden and the International
Bureau of WIPO

Article 7

Fees and Charges

(1) [No change]

(2) The Authority shall, to the extent and under the conditions set out in Annex C of this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1).

Agreement between the USSR State Committee for
Inventions and Discoveries and the
International Bureau of WIPO

Article 7

Fees and Charges

(1) [No change]

(2) The Authority shall, to the extent and under the conditions set out in Annex C of this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1).

Agreement between the International Bureau of WIPO
and the European Patent Organisation

Article 8

Fees and Other Charges

(1) [No change]

(2) The Authority shall, to the extent and under the conditions set out in Annex B of this Agreement, refund the whole or part of the international search fee paid where an international search report can be wholly or partially based on the results of an earlier search made by the Authority.

[Annex VII follows]

DECISIONS OF THE ASSEMBLY CONCERNING
ARTICLES 22(2) AND 39(1)(a) OF THE PATENT COOPERATION TREATY (PCT) AND
AMENDMENTS TO THE REGULATIONS UNDER THE PCT
AS ADOPTED BY THE ASSEMBLY

DECISIONS CONCERNING ARTICLES 22(2) AND 39(1)(a)

Decision concerning Article 22(2)

The Assembly, in order to make the same time limit applicable under paragraphs (1) and (2) of Article 22, decides as follows:

(1) Article 22(2) is modified as follows:

“*Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).”

(2) The modification enters into force on January 1, 1985. However, as long as that time limit is incompatible with the national law applied by the designated Office, a time limit of two months from the date of the notification sent to the applicant of the said declaration shall, during that transitory period, apply with respect to that designated Office, provided that such Office has made a notification to that effect to the International Bureau.

(3) The notification referred to in paragraph (2) shall be addressed to the International Bureau before October 1, 1984. It shall be promptly published by the International Bureau in the Gazette, and it shall become effective on January 1, 1985.

(4) Any notification effected under paragraph (3) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette, and it shall be effective 2 months after its publication in the Gazette or at any later date as indicated in the notice of withdrawal.

Decision Concerning Article 39(1)(a)

The Assembly, in order to extend the time limit under Article 39(1)(a) from 25 to 30 months from the priority date, decides as follows:

(1) Article 39(1)(a) is modified as follows:

“If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as

* The modification consists of replacing the words “two months from the date of the notification sent to the applicant of the said declaration” by the words underlined; it also consists of deleting, before the word “Where,” the words “Notwithstanding the provisions of paragraph (1),”

prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30* months from the priority date.”

(2) The modification enters into force on January 1, 1985. However, as long as the said time limit of 30 months is incompatible in all cases with the national law applied by the elected Office, a time limit of 25 months from the priority date shall, during that transitory period, apply with respect to that elected Office, provided that such Office has made a notification to that effect to the International Bureau.

(3) The notification referred to in paragraph (2) shall be addressed to the International Bureau before October 1, 1984. It shall be promptly published by the International Bureau in the Gazette, and it shall become effective on January 1, 1985.

(4) Any notification effected under paragraph (3) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette, and it shall be effective 2 months after its publication in the Gazette or at any later date as indicated in the notice of withdrawal.

* The modification consists of changing “25” to “30.”

AMENDMENTS TO THE REGULATIONS*

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 Priority Claim

(a) [No change]

(b) If the request does not indicate both

(i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, at least one country for which it was filed, and

(ii) the date on which it was filed,

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made except where, resulting from an obvious error^{**}, the indication of the said country or the said date is missing or is erroneous; whenever the identity or correct identity of the said country, or the said date or the correct date, may be established on the basis of the copy of the earlier application which reaches the receiving Office before it transmits the record copy to the International Bureau, the error shall be considered as an obvious error.

(c) If the application number of the earlier application is not indicated in the request but is furnished by the applicant to the International Bureau or to the receiving Office prior to the expiration of the 16th month from the priority date, it shall be considered by all designated States to have been furnished in time.^{***}

(d) If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated. If the applicant fails to act accordingly within 1 month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled ex officio.^{****}

(e) [No change]

* Where the amendment consists of one or more new words, it or they are underlined (the word or words which is or are replaced are not indicated). Where the amendment consists of deleting one or more words, without replacing it or them, this fact is indicated in footnotes.

** The amendment consists of deleting, after the word "error," the words "of transcription".

*** The amendment also consists of deleting the last two sentences of this paragraph.

**** The amendment consists of deleting the last two sentences of the present text of this paragraph.

4.11 to 4.16 [No change]

4.17 Additional* Matter

(a) The request shall contain no matter other than that specified in Rules 4.1 to 4.16, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that specified in Rules 4.1 to 4.16 or permitted under paragraph (a) of the Administrative Instructions, the receiving Office shall ex officio delete the additional matter.

* The amendment consists of deleting the word “No” before the word “Additional”.

Rule 6

The Claims

6.1 to 6.3 [No change]

6.4 Dependent Claims

(a) Any claim which includes all the features of one or more other claims (claim in dependent form, hereinafter referred to as “dependent claim”) shall do so by a reference, if possible at the beginning, to the other claim or claims and shall then state the additional features claimed. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such claims in the alternative only. Multiple dependent claims shall not serve as a basis for any other multiple dependent claim. Where the national law of the national Office acting as International Searching Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the preceding two sentences, failure to use that manner of claiming may result in an indication under Article 17(2)(b) in the international search report. Failure to use the said manner of claiming shall have no effect in a designated State if the manner of claiming actually used satisfies the national law of that State.

(b) and (c) [No change]

6.5 [No change]

Rule 8

The Abstract

8.1 [No change]

8.2 Figure

(a) If the applicant fails to make the indication referred to in Rule 3.3(a)(iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall, subject to paragraph (b), indicate the figure or figures which should accompany the abstract when the latter is published by the International Bureau. In such case, the abstract shall be accompanied by the figure or figures so indicated by the International Searching Authority. Otherwise, the abstract shall, subject to paragraph (b), be accompanied by the figure or figures suggested by the applicant.

(b) If the International Searching Authority finds that none of the figures of the drawings is useful for the understanding of the abstract, it shall notify the International Bureau accordingly. In such case, the abstract, when published by the International Bureau, shall not be accompanied by any figure of the drawings even where the applicant has made a suggestion under Rule 3.3(a)(iii).

8.3 [No change]

Rule 11

Physical Requirements of the International Application

11.1 to 11.14 [No change]

11.15 Translations

[Deleted]

Rule 12

Language of the International Application

12.1 Admitted Languages

(a) Any international application shall be filed in the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Searching Authority competent for the international searching of that application, provided that, if the agreement specifies several languages, the receiving Office may prescribe among the specified languages that language in which or those languages in one of *which* the international application must be filed.

(b) If the international application is filed in a language other than the language in which it is to be published, the request may, notwithstanding paragraph (a), be filed in the language of publication.

(c) Subject to paragraph (d), where the official language of the receiving Office is one of the languages referred to in Rule 48.3(a) but is a language not specified in the agreement referred to in paragraph (a), the international application may be filed in the said official language. If the international application is filed in the said official language, the search copy transmitted to the International Searching Authority under Rule 23.1 shall be accompanied by a translation into the language, or one of the languages, specified in the agreement referred to in paragraph (a); such translation shall be prepared under the responsibility of the receiving Office.

(d) 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).

12.2 Language of Changes in the International Application

Any changes in the international application, such as amendments and corrections, shall, subject to Rules 46.3 and 66.9, be in the same language as the said application.^{*}

*

The amendment also consists of deleting, after the word “application,” the expression “(cf. Rule 66.5).”

Rule 13bis

Microbiological Inventions

13bis.1 to 13bis.6 [No change]

13bis.7 National Requirements: Notification and Publication

(a) [No change]

(b) Each national Office shall notify the International Bureau^{*} of the depository institutions with which the national law permits deposits of microorganisms to be made for the purposes of patent procedure before that Office or, if the national law does not provide for or permit such deposits, of that fact.

(c) [No change]

*

The amendment consists of deleting, after the word “Bureau,” the following words: “a first time before entry into force of this Rule and then each time a change occurs.”

Rule 15

The International Fee

15.1 to 15.3 [No change]

15.4 Time of Payment

(a) The basic fee shall be paid within one month from the date of receipt of the international application.

(b) The designation fee shall be paid:

(i) where the international application does not contain a priority claim under Article 8, within one year from the date of receipt of the international application,

(ii) where the international application contains a priority claim under Article 8, within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date.

(c) Where the basic fee or the designation fee is paid later than the date on which the international application was received and where the amount of that fee is, in the currency in which it is payable, higher on the date of payment (“the higher amount”) than it was on the date on which the international application was received (“the lower amount”),

(i) the lower amount shall be due if the fee is paid within one month from the date of receipt of the international application,

(ii) the higher amount shall be due if the fee is paid later than one month from the date of receipt of the international application.

(d) If, on February 3, 1984, paragraphs (a) and (b) are not compatible with the national law applied by the receiving Office and as long as they continue to be not compatible with that law, the basic fee shall be paid on the date of receipt of the international application and the designation fee shall be paid within one year from the priority date.

15.5 [No change: remains deleted]

15.6 [No change]

Rule 16bis

Advancing Fees by the International Bureau

16bis.1 Guarantee by the International Bureau

(a) Where, by the time they are due under Rule 14.1(b), Rule 15.4(a)* and Rule 16.1(f), the receiving Office finds that in respect of an international application no fees were paid to it by the applicant, or that the amount paid to it by the applicant is less than what is necessary to cover the transmittal fee, the basic fee and the search fee, the receiving Office shall charge the amount required to cover those fees, or the missing part thereof, to the International Bureau and shall consider the said amount as if it had been paid by the applicant at the due time.

(b) Where, by the time* they are due under Rule 15.4(b)** , the receiving Office finds that in respect of an international application the payment made by the applicant is insufficient to cover the designation fees necessary to cover all the designations, the receiving Office shall charge the amount required to cover those fees to the International Bureau and shall consider that amount as if it had been paid by the applicant at the due time.

(c) [No change]

(d) [Deleted]

16bis.2 Obligations of the Applicant, Etc.

(a) to (c) [No change]

(d) to (g) [Deleted]

16bis.3 Notifications

[Deleted]

* The amendment consists of deleting, after the word “time,” the words “it or. ”

** The amendment consists of deleting the reference to paragraph (c).

Rule 17

The Priority Document

17.1 Obligation to Submit Copy of Earlier National Application

(a) Where the priority of an earlier national application is claimed under Article 8 in the international application, a copy of the said national application, certified by the authority with which it was filed (“the priority document”), shall, unless already filed with the receiving Office together with the international application, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date or, in the case referred to in Article 23(2), not later than at the time the processing or examination is requested.*

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to transmit the priority document to the International Bureau. Such request shall be made not later than the expiration of the applicable time limit referred to under paragraph (a) and may be subjected by the receiving Office to the payment of a fee.**

(c) [No change]

(d) (Deleted)

17.2 [No change]

*

The amendment consists of deleting the last two sentences of this paragraph.

**

The amendment consists of deleting the last sentence of this paragraph.

Rule 20

Receipt of the International Application

20.1 to 20.4 [No change]

20.5 Positive Determination

(a) [No change]

(b) [No change]

(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).

20.6 to 20.9 [No change]

Rule 22

Transmittal of the Record Copy

22.1 Procedure

(a) [No change]

(b) If the International Bureau has received a copy of the notification under Rule 20.5(c) 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 20.5(c) 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.

(d) After the expiration of 14 months from the priority date, the applicant may request the receiving Office to certify a copy of his international application as being identical with the international application as filed and may transmit such certified copy to the International Bureau.

(e) Any certification under paragraph (d) shall be free of charge and may be refused only on any of the following grounds:

(i) the copy which the receiving Office has been requested to certify is not identical with the international application as filed;

(ii) prescriptions concerning national security prevent the international application from being treated as such:

(iii) the receiving Office has already transmitted the record copy to the International Bureau and that Bureau has informed the receiving Office that it has received the record copy.

(f) Unless the International Bureau has received the record copy, or until it receives the record copy, the copy certified under paragraph (e) and received by the International Bureau shall be considered to be the record copy.

(g) If, by the expiration of the time limit applicable under Article 22, the applicant has performed the acts referred to in that Article but the designated Office has not been informed by the International Bureau of the receipt of the record copy, the designated Office shall inform the International Bureau. If the International Bureau is not in possession of the record copy, it shall promptly notify the applicant and the receiving Office unless it has already notified them under paragraph (c).

22.2 Alternative Procedure

[Deleted]

22.3 Time Limit under Article 12(3)

The time limit referred to in Article 12(3) shall be 3 months from the date of the notification sent by the International Bureau to the applicant under Rule 22.1(c) or (g).

22.4 Statistics Concerning Non-Compliance with Rules 22.1 and 22.2

[Deleted]

22.5 Documents Filed with the International Application

[Deleted]

Rule 23

Transmittal of the Search Copy

23.1 Procedure

(a) 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.*

(b) If the International Bureau has not received, within 10 days from the receipt of the record copy, information from the International Searching Authority that that Authority is in possession of the search copy, the International Bureau shall promptly transmit a copy of the international application to the International Searching Authority.**

(c) [Deleted]

* The amendment consists of deleting, at the end of the present text of this paragraph, the words “or, under Rule 22.2(d), to the applicant.”

** The amendment consists of deleting the second sentence of this paragraph.

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 Recording of Date of Receipt of the Record Copy

[Deleted]

24.2 [No change]

Rule 26

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

26.1 [No change]

26.2 Time Limit for Correction

The time limit referred to in Article 14(1)(b) shall be reasonable under the circumstances* and shall be fixed in each case by the receiving Office. It shall not be less than 1 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.

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

The physical requirements referred to in Rule 11 shall be checked only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

26.3bis Invitation to Correct Defects under Article 14(1)(b)

The receiving Office shall not be required to issue the invitation to correct a defect under Article 14(1)(a)(v) where the physical requirements referred to in Rule 11 are complied with to the extent necessary for the purpose of reasonably uniform international publication.

26.4 Procedure

(a) [No change]

(b) to (d) [Deleted]

26.5 Decision of the Receiving Office

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

(b) [Deleted]

26.6 [No change]

*

The amendment consists of deleting, after the word “circumstances,” the words “of the particular case.”

**

The amendment consists of deleting, after the word “month,” the words “and normally not more than 2 months.”

Rule 28

Defects Noted by the International Bureau^{*}

28.1 Note on Certain Defects

(a) If, in the opinion of the International Bureau^{**}, the international application contains any of the defects referred to in Article 14(1)(a)(i), (ii) or (v), the International Bureau^{***} shall bring such defects to the attention of the receiving Office.

(b) [No change]

^{*} The amendment consists of deleting, after the word “Bureau,” the words “or the International Searching Authority.”

^{**} The amendment consists of deleting, after the word “Bureau,” the words “or of the International Searching Authority.”

^{***} The amendment consists of deleting, after the word “Bureau,” the words “or the International Searching Authority, respectively.”

Rule 29

International Applications or Designations Considered
Withdrawn under Article 14(1), (3) or (4)

29.1 [No change]

29.2 Finding by Designated Office

[Deleted]

29.3 and 29.4 [No change]

Rule 32

Withdrawal of the International Application
or of Designations

32.1 Withdrawals

(a) and (b) [No change]

(c) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau or* to the receiving Office. In the case of Rule 4.8(b), the notice shall require the signature of all the applicants.

(d) [~~Deleted~~]

(e) There shall be no international publication of the international application or of the designation, as the case may be, if the notice effecting withdrawal reaches the International Bureau before the technical preparations for publication have been completed.

*

The amendment consists of deleting, after the word “or,” the following words: “, if the record copy has not yet been sent to the International Bureau.”

Rule 32**bis**

Withdrawal of the Priority Claim

32**bis**.1 Withdrawals

(a) and (b) [No change]

(c) Where the withdrawal of the priority claim, or, in the case of more than one such claim, the withdrawal of any of them, causes a change in the priority date of the international application, any time limit which is computed from the original priority date and which has not already expired shall be computed from the priority date resulting from that change. In the case of the time limit of 18 months referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice effecting withdrawal reaches the International Bureau during the period of 15 days preceding the expiration of that time limit.

(d) For any withdrawal under paragraph (a), the provisions of Rule 32.1(c)* shall apply mutatis mutandis.

* The amendment also consists of deleting, after the words “Rule 32.1(c),” the words “and (d) and Rule 74**bis**.1.”

Rule 34

Minimum Documentation

34.1 Definition

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) to (v) [No change]

(vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority.

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages is not Japanese, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan and the Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than 6 months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

Rule 42

Time Limit for International Search

42.1 Time Limit for International Search

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be 3 months from the receipt of the search copy by the International Searching Authority, or 9 months from the priority date, whichever time limit expires later.*

*

The amendment also consists of deleting the last sentence of Rule 42.1.

Rule 46

Amendment of Claims Before the International Bureau

46.1 Time Limit

The time limit referred to in Article 19 shall be 2 months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later, provided that any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

46.2 Dating of Amendments

[Deleted]

46.3 Language of Amendments

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 of publication.

46.4 Statement

(a) The statement referred to in Article 19(1) shall be in the language in which the international application is published and shall not exceed 500 words if in the English language or if translated into that language. 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.

(b) The statement shall contain no disparaging comments on the international search report or the relevance of ^{***} citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

46.5 Form of Amendments

(a) [No change]

(b) and (c) [Deleted]

^{*} The amendment also consists of deleting, after the word “published,” the words “by the International Bureau”.

^{**} The amendment also consists of deleting, after the word “be,” the word “both.”

^{***} The amendment also consists of deleting, after the word “of” the word “the.”

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) [No change]

(b) Such communication shall be effected promptly after the international publication of the international application and, in any event, by the end of the 19th month after the priority date. Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.*

(c) to (e) [No change]

47.2 and 47.3 [No change]

*

The amendment also consists of deleting the last sentence of Rule 47.1(b).

Rule 48

International Publication

48.1 [No change]

48.2 Contents

(a) The pamphlet shall contain:

(i) to (v) [No change]

(vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4,

(vii) any request for rectification referred to in the third sentence of Rule 91.1(f).

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

(i) [No change]

(ii) a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies,

(iii) [No change]

(c) to (f) [No change]

(g) If, at the time of the completion of the technical preparations for international publication, the international search report is not yet available, (for example, because of publication on the request of the applicant as provided in Articles 21(2)(b) and 64(3)(c)(i)), the pamphlet shall contain, in place of the international search report, an indication to the effect that that report was not available and that either the pamphlet (then also including the international search report) will be republished or the international search report (when it becomes available) will be separately published.

(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 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]

48.3 Languages

(a) If the international application is filed in English, French, German, Japanese, Russian or Spanish, that application shall be published in the language in which it was filed.

(b) If the international application is filed in a language other than English, French, German, Japanese, Russian or Spanish, that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the essence of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

(c) If the international application is published 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 shall be prepared under the responsibility of the International Bureau.

48.4 and 48.5 [No change]

48.6 Announcing of Certain Facts

(a) [No change]

(b) [Deleted]

(c) If the international application or the designation of any designated State is withdrawn under Rule 32.1, or if the priority claim is withdrawn under Rule 32bis.1, after the technical preparations for international publication have been completed, this fact shall be published in the Gazette.

Rule 49

Copy, Translation and Fee under Article 22

49.1 Notification

(a) [No change]

(a-bis) Any Contracting State not requiring the furnishing, under Article 22, by the applicant of a copy of the international application (even though the communication of the copy of the international application by the International Bureau under Rule 47 has not taken place by the expiration of the time limit applicable under Article 22) shall notify the International Bureau accordingly.

(a-ter) Any Contracting State which, pursuant to Article 24(2), maintains, if it is a designated State, the effect provided for in Article 11(3) even though a copy of the international application is not furnished by the applicant by the expiration of the time limit applicable under Article 22 shall notify the International Bureau accordingly.

(b) Any notification received by the International Bureau under paragraphs (a), (a-bis) or (a-ter) shall be promptly published by the International Bureau in the Gazette.

(c) [No change]

49.2 [No change]

49.3 Statements under Article 19; Indications under Rule 13bis.4

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13bis.4 shall, subject to Rule 49.5(c) and (h), be considered part of the international application.

49.4 Use of National Form

No applicant shall be required to use a national form when performing the acts referred to in Article 22.

49.5 Contents of and Physical Requirements for the Translation

(a) For the purposes of Article 22, the translation of the international application shall contain the description, the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b) and (e),

(i) contain the request,

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended, and

(iii) be accompanied by a copy of the drawings.

(b) Any designated Office requiring the furnishing of a translation of the request shall furnish copies of the request form in the language of the translation free of charge to the

applicants. The form and contents of the request form in the language of the translation shall not be different from those of the request under Rules 3 and 4; in particular, the request form in the language of the translation shall not ask for any information that is not in the request as filed. The use of the request form in the language of the translation shall be optional.

(c) Where the applicant did not furnish a translation of any statement made under Article 19(1), the designated Office may disregard such statement.

(d) If any drawing contains text matter, the translation of that text matter shall be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew.

(e) Any designated Office requiring under paragraph (a) the furnishing of a copy of the drawings shall, where the applicant failed to furnish such copy within the time limit applicable under Article 22,

(i) invite the applicant to furnish such copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation or,

(ii) disregard the said drawing if such invitation, on February 3, 1984, is not compatible with the national law applied by that Office and as long as it continues to be not compatible with that law.

(f) The expression “Fig.” does not require translation into any language.

(g) Where any copy of the drawings or any drawing executed anew which has been furnished under paragraph (d) or (e) does not comply with the physical requirements referred to in Rule 11, the designated Office may invite the applicant to correct the defect within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(h) Where the applicant did not furnish a translation of any indication furnished under Rule 13bis.4, the designated Office shall invite the applicant to furnish such translation, if it deems it to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(i) Information on any requirement and practice of designated Offices under the second sentence of paragraph (a) shall be published by the International Bureau in the Gazette.

(j) No designated Office shall require that the translation of the international application comply with physical requirements other than those prescribed for the international application as filed.

Rule 51

Review by Designated Offices

51.1 to 51.3 [No change]

51.4 Notification to the International Bureau

[Deleted]

Rule 51bis

Certain National Requirements Allowed
under Article 27(1), (2), (6) and (7)

51bis.1 Certain National Requirements Allowed

(a) The documents referred to in Article 27(2)(ii), or the evidence referred to in Article 27(6), which the applicant may be required to furnish under the national law applicable by the designated Office include, in particular:

(i) any document relating to the identity of the inventor,

(ii) any document relating to any transfer or assignment of the right to the application,

(iii) any document containing an oath or declaration by the inventor alleging his inventorship,

(iv) any document containing a declaration by the applicant designating the inventor or alleging the right to the application,

(v) any document containing any proof of the right of the applicant to claim priority where he is different from the applicant having filed the earlier application the priority of which is claimed,

(vi) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

(b) The national law applicable by the designated Office may, in accordance with Article 27(7), require that

(i) the applicant be represented by an agent having the right to represent applicants before that Office and/or have an address in the designated State for the purpose of receiving notifications,

(ii) the agent, if any, representing the applicant be duly appointed by the applicant.

(c) The national law applicable by the designated Office may, in accordance with Article 27(1), require that the international application, the translation thereof or any document relating thereto be furnished in more than one copy.

(d) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the translation of the international application furnished by the applicant under Article 22 be verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful.

51bis.2 Opportunity to Comply with National Requirements

(a) Where any of the requirements referred to in Rule 51bis.1, or any other requirement of the national law applicable by the designated Office which that Office may apply under Article 27(1), (2), (6) or (7), is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.

(b) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the applicant, upon invitation by the designated Office, furnish a certification of the translation of the international application by a public authority or a sworn translator, if the designated Office deems such certification to be necessary under the circumstances, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(c) If, on February 3, 1984, paragraph (a) is, with respect to the requirements referred to in Rule 51bis.1(a)(iii) and (vi), (b)(i) and (d), not compatible with the national law applied by the designated Office and as long as it continues to be not compatible with that law, the applicant shall have no opportunity to comply with any of the requirements after the expiration of the time limit applicable under Article 22. Information on such national laws shall be published by the International Bureau in the Gazette.

Rule 53

The Demand

53.1 Form

(a) to (c) [No change]

(d) [Deleted]

53.2 to 53.8 [No change]

Rule 54

The Applicant Entitled to Make a Demand

54.1 and 54.2 [No change]

54.3 Several Applicants: Different for Different Elected States

(a) [No change]

(b) [Deleted]

54.4 Applicant Not Entitled to Make a Demand or an Election

(a) If the applicant does not have the right or, in the case of several applicants, if none of them has the right to make a demand under Article 31(2), the demand shall be considered not to have been submitted.

(b) If the requirement under Rule 54.3(a) is not fulfilled in respect of any elected State, the election of that State shall be considered not to have been made.

Rule 55

Languages (International Preliminary Examination)

55.1 The Demand

The demand shall be in the language 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.

55.2 The International Application

[Deleted]

Rule 58

The Preliminary Examination Fee

58.1 and 58.2 [No change]

58.3 Refund

The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted^{*}, and the International Bureau shall promptly publish such information.

^{*} The amendment consists of deleting, after the word “submitted,” the words “under Rule 57.4(c), Rule 58.2(c) or Rule 60.1(c).”

Rule 60

Certain Defects in the Demand or Elections

60.1 and 60.2 [No change]

60.3 Attempted Elections

[Deleted]

Rule 61

Notification of the Demand and Elections

61.1 Notifications to the International Bureau, the Applicant, and the International Preliminary Examining Authority

(a) The International Preliminary Examining Authority shall indicate on* the demand the date of receipt or, where applicable, the date referred to in Rule 60.1(b). The International Preliminary Examining Authority shall promptly send the demand to the International Bureau, and shall prepare and keep a copy in its files.

(b) The International Preliminary Examining Authority shall promptly inform the applicant in writing of the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 57.4(c), 58.2(c) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 54.4(b) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) [No change]

61.2 and 61.3 [No change]

*

The amendment consists of deleting, after the word “on,” the words “both copies of.”

Rule 62

Copy for the International Preliminary Examining Authority

62.1 The International Application

[Deleted]

62.2 [No change]

Rule 66

Procedure Before the International Preliminary
Examining Authority

66.1 [No change]

66.2 First Written Opinion of the International Preliminary Examining Authority

(a) If the International Preliminary Examining Authority

(i) considers that the international application has any of the defects described in Article 34(4),

(ii) considers that the international preliminary examination report should be negative in respect of any of the claims because the invention claimed therein does not appear to be novel, does not appear to involve an inventive step (does not appear to be non-obvious), or does not appear to be industrially applicable,

(iii) notices that there is some defect in the form or contents of the international application under the Treaty or these Regulations,

(iv) considers that any amendment goes beyond the disclosure in the international application as filed, or

(v) wishes to accompany the international preliminary examination report by observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description, the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

(b) [No change]

(c) The notification shall invite the applicant to submit a written reply together, where appropriate, with amendments*.

(d) [No change]

66.3 Formal Response to the International Preliminary Examining Authority

(a) The applicant may respond to the invitation referred to in Rule 66.2(c) of the International Preliminary Examining Authority by making amendments* or--if he disagrees with the opinion of that Authority--by submitting arguments, as the case may be, or do both.

(b) [No change]

* The amendment consists of deleting, after the word “amendments,” the words “or corrections.”

66.4 Additional Opportunity for Submitting Amendments or Arguments

(a) [No change]

(b) On the request of the applicant, the International Preliminary Examining Authority may give him one or more additional opportunities to submit amendments or arguments.

66.5 Amendment

Any change, other than the rectification of obvious errors^{*}, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

66.6 [No change]

66.7 Priority Document

(a) If the International Preliminary Examining Authority needs a copy of the application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1, the international preliminary examination report may be established as if the priority had not been claimed.

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may invite the applicant to furnish a translation in the said language or one of the said languages within 2 months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

(c) [Deleted]

66.8 Form of^{**} Amendments

(a) The applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of^{***} an amendment, differs from the sheet originally filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.

(b) [Deleted]

66.9 Language of Amendments

* The amendment consists of deleting, after the word “errors,” the words “of transcription.”

** The amendment consists of deleting, after the word “of,” the words “Corrections and.”

*** The amendment consists of replacing, after the word “of,” the words “a correction or” by the word “an.”

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(a), shall be submitted in the language of publication.

Rule 69

Time Limit for International Preliminary Examination

69.1 Time Limit for International Preliminary Examination

(a) The time limit for establishing the international preliminary examination report shall be:

(i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date;

(ii) 9 months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.

(b) and (c) [No change]

Rule 70

The International Preliminary Examination Report

70.1 [No change]

70.2 Basis of the Report

(a) [No change]

(b) If, pursuant to Rule 66.7(a) or (b), the report is established as if the priority had not been claimed, the report shall so indicate.

(c) [No change]

70.3 to 70.10 [No change]

70.11 Mention of Amendments^{*}

If, before the International Preliminary Examining Authority, amendments^{*} have been made, this fact shall be indicated in the report. Where any amendment has resulted in the cancellation of an entire sheet, this fact shall also be specified in the report.

70.12 to 70.15 [No change]

70.16 Annexes of the Report

If the claims, the description, or the drawings, were amended^{**} before the International Preliminary Examining Authority, each replacement sheet under Rule 66.8(a) shall be annexed to the report.^{***} Replacement sheets superseded by later replacement sheets and letters under Rule 66.8(a) shall not be annexed.^{****}

70.17 Languages of the Report and the Annexes

(a) The report and any annex shall be in the language in which the international application to which they relate is published.

(b) [Deleted]

* The amendment consists of deleting, in the title, after the word “Amendments,” the words “or Correction of Certain Defects” and, in the Rule itself, after the word “amendments,” the words “or corrections.”

** The amendment also consists of deleting, after the word “amended”, the words “or any part of the international application was corrected.”

*** The amendment also consists of deleting, after the word “report,” the words “as an annex thereto.”

**** The amendment also consists of deleting the last sentence of Rule 70.16.

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

Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), transmit a translation of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report. The same time limit shall apply where the furnishing of a translation of the international application to the elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22.

Rule 74bis

Notification of Withdrawal under Rule 32

74bis.1 Notification of the International Preliminary Examining Authority

[Deleted]

Rule 75

Withdrawal of the Demand, or of Elections

75.1 Withdrawals

(a) Withdrawal of the demand or all the elections may be effected prior to the expiration of 30 months from the priority date except as to any elected State in which national processing or examination has already started. Withdrawal of the election of any elected State may be effected prior to the date on which examination and processing may start in that State.

(b) [No change]

75.2 Notification of Elected Offices

[Deleted]

75.3 Notification of the International Preliminary Examining Authority

[Deleted]

75.4 [No change]

Rule 76

Copy, Translation and Fee under Article 39(1);
Translation of Priority Document

76.1 Notification

[Deleted]

76.2 Languages

[Deleted]

76.3 Statements under Article 19; Indications under Rule 13bis.4

[Deleted]

76.4 [No change]

76.5 Application of Rules 22.1(g), 49 and 51bis

Rules 22.1(g), 49 and 51bis shall apply, provided that:

(i) any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) any reference in the said Rules to Article 22 shall be construed as a reference to Article 39(1);

(iii) the words “international applications filed” in Rule 49.1(c) shall be replaced by the words “a demand submitted.”

Rule 80

Computation of Time Limits

80.1 to 80.5 [No change]

80.6 Date of Documents

(a) [No change]

(b) [Deleted]

80.7 [No change]

Rule 82

Irregularities in the Mail Service

82.1 Delay or Loss in Mail

(a) and (b) [No change]

(c) In the cases provided for in paragraph (b), evidence of mailing within the prescribed time limit, and, where the document or letter was lost, the substitute document or letter as well as the evidence concerning its identity with the document or letter lost shall be submitted within 1 month after the date on which the interested party noticed--or with due diligence should have noticed--the delay or the loss, and in no case later than 6 months after the expiration of the time limit applicable in the given case.

82.2 [No change]

Rule 82bis

Excuse by the Designated or Elected State of Delays
in Meeting Certain Time Limits

82bis.1 Meaning of “Time Limit” in Article 48(2)

The reference to “any time limit” in Article 48(2) shall be construed as comprising a reference:

(i) to any time limit fixed in the Treaty or these Regulations;

(ii) to any time limit fixed by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau or applicable by the receiving Office under its national law;

(iii) to any time limit fixed by, or in the national law applicable by, the designated or elected Office, for the performance of any act by the applicant before that Office.

82bis.2 Reinstatement of Rights and Other Provisions to which Article 48(2) Applies

The provisions of the national law which is referred to in Article 48(2) concerning the excusing, by the designated or elected State, of any delay in meeting any time limit are those provisions which provide for reinstatement of rights, restoration, restitutio in integrum or further processing in spite of non-compliance with a time limit, and any other provision providing for the extension of time limits or for excusing delays in meeting time limits.

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

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 declaration made under Article 8(1) has been erroneously cancelled or corrected by the receiving Office or the International Bureau, 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 declaration under Article 8(1) had not been cancelled or corrected, as the case may be.

Rule 88

Amendment of the Regulations

88.1 [No change]

88.2 Requirement of Unanimity During a Transitional Period

[Deleted]

88.3 [No change]

88.4 Procedure

Any proposal for amending a provision referred to in Rules 88.1^{*} or 88.3 shall, if the proposal is to be decided upon in the Assembly, be communicated to all Contracting States at least 2 months prior to the opening of that session of the Assembly which is called upon to make a decision on the proposal.

*

The amendment consists of deleting, after the expression “Rule 88.1,” the expression “88.2.”

Rule 90

Representation

90.1 and 90.2 [No change]

90.3 Appointment

(a) and (b) [No change]

(c) If the separate power of attorney is not signed^{*}, or if the required separate power of attorney is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered non-existent unless the defect is corrected.

(d) [No change]

90.4 [No change]

^{*} The amendment consists of deleting, after the word “signed,” the words “as provided in paragraph (a).”

Rule 91

Obvious Errors in Documents

91.1 Rectification

(a) Subject to paragraphs (b) to (g-quater), obvious errors* in the international application or other papers submitted by the applicant may be rectified.

(b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors*. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.

(c) [No change]

(d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be an obvious error** may invite the applicant to present a request for rectification as provided in paragraphs (e) to (g-quater). Rule 26.4(a) shall apply mutatis mutandis to the manner in which rectifications shall be requested.

(e) [No change]

(f) Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor. The authority which authorizes a rectification shall promptly notify the International Bureau accordingly. Where the authorization of the rectification was refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (q-bis), (q-ter) or (q-quater) and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification together with the international application. A copy of the request for rectification shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

(g) The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (q-bis), (g-ter) and (g-quater), be effective:

(i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;

(ii) where it is given by the International Preliminary Examining Authority, if it is given before the establishment of the international preliminary examination report;

(iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.

* The amendment consists of deleting, after the word “errors,” the words “of transcription.”

** The amendment consists of deleting, after the word “error,” the words “of transcription.”

(g-bis) If the notification made under paragraph (q)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.

(g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.

(g-quater) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.

(h) [Deleted]

91.2 Manner of Carrying Out Rectifications

[Deleted]

Rule 92

Correspondence

92.1 [No change]

92.2 Languages

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates.

(b) [No change]

(c) [Deleted]

(d) and (e) [No change]

92.3 and 92.4 [No change]

Rule 92bis

Recording of Changes in Certain Indications in the Request
or the Demand

92bis.1 Recording of Changes by the International Bureau

(a) The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request or demand:

- (i) person, name, residence, nationality or address of the applicant,
- (ii) person, name or address of the agent, the common representative or the inventor.

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration:

(i) of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;

(ii) of the time limit referred to in Article 39(1)(a), where Article 39(1) is applicable with respect to at least one Contracting State.

92bis.2 Notifications

[Deleted]

[Annex VIII follows]

Resolution

The Assembly of the International Patent Cooperation Union (PCT Union)

Noting that the number of developing countries which are members of the PCT Union is relatively small,

Noting further that the number of international applications emanating from those developing countries which are members of the PCT Union is extremely small,

Assuming that one of the reasons for such unsatisfactory situation may be the high cost of international search and international preliminary examination for applicants from developing countries,

Resolves to:

(1) Recommend to all States members of the PCT Union to seek ways and means for financing at least part of the fees payable by applicants from developing countries for international search and international preliminary examination;

(2) Recommend to all International Searching and Preliminary Examining Authorities to study the possibility of reducing the amount of the fees payable by applicants from developing countries for international search and international preliminary examination;

(3) Recommend to all States members of the PCT Union to study whether national or regional funds could be put at the disposal of the International Bureau or of the International Searching and Preliminary Examining Authorities, in order to be used to assist such applicants from developing countries in paying such fees.

[Adopted on February 3, 1984]

[End of Annex VIII and of document]

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PCT/A/XII/4

ORIGINAL: English/French

DATE: October 2, 1984

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Twelfth Session (8th Extraordinary) Geneva, September 24 to 28, 1984

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XV/1.Rev.Rev.): 1, 2, 8, 9, 10, 12 and 13.
2. The report on the said items, with the exception of items 8, 9 and 10, is contained in the General Report (document AB/XV/8).
3. The report on items 8, 9 and 10 is contained in this document.
4. The session, as far as items 8, 9 and 10 are concerned, was chaired by Mr. G. Borggård (Sweden), Vice-Chairman of the Assembly. The meeting adopting the present report was chaired by Mr. C. Fernandez Ballesteros (Uruguay) as ad hoc Chairman in his capacity as Chairman of the WIPO Coordination Committee.

ITEM 8 OF THE CONSOLIDATED AGENDA FIXATION OF FEES UNDER THE PATENT COOPERATION TREATY (PCT)

5. Discussions were based on document PCT/A/XII/1.

6. The Assembly amended, with effect as of January 1, 1985, the Schedule of Fees annexed to the PCT Regulations by increasing the fees specified therein by 5%, as set out in the Annex to document PCT/A/XII/1, with the modification suggested in paragraph 13 of that document. The amended Schedule of Fees is set out in Annex I to this report.

7. The Assembly noted the table of equivalent amounts in currencies other than Swiss francs which was distributed to the interested delegations on September 24, 1984.

8. In the course of the discussion on the fee increase, the need for the PCT system to become self-supporting as soon as possible was stressed. A number of delegations, while not objecting to the 5% increase, said that they would have preferred an increase by 10% which would allow that objective to be reached sooner since they did not believe that the level of the fee increase would have a significant impact on the use of the PCT system. Other delegations, however, expressed their preference for an increase of only 5% since they were convinced that a higher increase might have an adverse effect on the number of international applications and of designations and would therefore be counterproductive to the manifold efforts to make the PCT system self-supporting in the near future.

9. A number of delegations agreed with the view expressed by the International Bureau that a more intensive use of the PCT and consequently an improvement of the financial situation of the PCT Union were expected to result from the important amendments to the PCT system adopted by the Assembly during its eleventh session in February 1984 as well as from the withdrawal, under preparation or consideration in several countries, of reservations excluding Chapter II of the PCT. Furthermore, it was stressed that the territorial extension of the PCT Union was an important factor for making the PCT more attractive. In this context, it was emphasized that early participation of Italy and Canada in the PCT system was of particular importance, and the hope was expressed that the ongoing preparations for ratification by those two countries would soon lead to a positive result. Moreover, an appeal was made to all States not yet party to the Treaty to adhere to the PCT as soon as possible.

10. The Delegations of Brazil and Romania reiterated proposals, made to the Assembly at earlier sessions, aiming at providing in future preferential treatment in favor of nationals of developing countries by lowering the fees specified in the Schedule of Fees in their favor.

11. In connection with the modification of the structure of the designation fee, referred to in paragraph 13 of document PCT/A/XII/1, several delegations doubted that such a measure would lead to an improvement of the financial situation of the PCT Union, but it was agreed to adopt that measure on a trial basis and to review it, in the light of experience, on the occasion of the next reconsideration of the level of the fees.

12. In the course of the discussion on savings, the Assembly noted with appreciation the efforts made by the International Bureau in making savings and in identifying possibilities for additional savings.

13. As to the possibility, referred to in paragraph 7 of document PCT/A/XII/1, to publish in future only one, largely bilingual version of the PCT Gazette which would, however, not contain a French version of the abstracts and of the text matter pertaining to the drawings, the Assembly decided not to implement that solution in view of the arguments of a political and of a technical nature invoked against it by the Delegations of France, the Ivory Coast and Congo and the representative of the African Intellectual Property Organization (OAPI).

However, the International Bureau was requested to study the question whether it would not be possible to produce a completely bilingual edition of the Gazette in a way which would yield savings of sufficient importance.

14. As to the possibility, referred to in paragraph 8 of document PCT/A/XII/1, to change the format of PCT pamphlets, including the suggestion not to mark every sheet with the international publication number, the Assembly decided to refer the matter to the PCT Committee for Technical Cooperation for consideration and to take a final decision on the basis of the advice of that Committee. In this context, several delegations saw serious problems of a technical nature with such a change of format.

15. In reply to a suggestion made by the Delegation of the United Kingdom that the sales price of the PCT pamphlets should be increased by an amount not exceeding two Swiss francs in order to compensate for the additional deficit resulting from the increase of the PCT fees by only 5%, it was agreed that the International Bureau would study the usefulness and feasibility of such solution, including its possible implications on the number of pamphlets sold.

ITEM 9 OF THE CONSOLIDATED AGENDA
AMENDMENT OF THE AGREEMENT UNDER THE PATENT COOPERATION
TREATY (PCT) BETWEEN THE INTERNATIONAL BUREAU OF WIPO AND THE
EUROPEAN PATENT ORGANISATION (EPO)

16. The Assembly approved the amendment to Article 3 of the Agreement concluded between the International Bureau and the European Patent Organisation as shown in paragraph 5 of document PCT/A/XII/2. The text of the amended Article 3 is contained in Annex II to this report.

ITEM 10 OF THE CONSOLIDATED AGENDA
FILING BY TELECOPIER OF INTERNATIONAL APPLICATIONS UNDER THE
PATENT COOPERATION TREATY (PCT)

17. Discussions were based on document PCT/A/XII/3.

18. In conclusion, the Assembly agreed that an international application which is received by telecopier by the receiving Office is to be accorded an international filing date if all the requirements listed in items (i) to (iii) of Article 11(1) are complied with and that any formal defect, such as the lack of signature or of fitness for reproduction, may be corrected upon an invitation issued by the receiving Office under Article 14(1). It was understood, however, that no receiving Office would be obliged to make telecopier facilities available to applicants. The Delegation of Brazil, while accepting the conclusion of the Assembly, said that it needed more time to study the legal implications resulting from the requirement of signature of the international application. The Delegation of Senegal expressed doubts on the question whether an international application could be considered to be filed before the day of receipt of the original signature and was of the opinion that the matter should be considered on the basis of the evolution of legal systems and the level of technological development of each country. In that context, it was, however, pointed out that, according to the conclusion referred to above, an international application which was not signed was to be accorded an

international filing date and that the lack of signature was a correctable defect under Article 14(1) of the Treaty.

19. The Assembly unanimously adopted this report on September 28, 1984.

[Annexes follow]

ANNEX I

SCHEDULE OF FEES

<u>Fees</u>	<u>Amounts</u>
1. Basic Fee: (Rule 15.2(a))	
if the international application contains not more than 30 sheets	654 Swiss francs
if the international application contains more than 30 sheets	654 Swiss francs plus 13 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	158 Swiss francs per designation for which the fee is due, with a maximum of 1,580 Swiss francs, any such designation in excess of 10 being free of charge
3. Handling Fee: (Rule 57.2(a))	200 Swiss francs
4. Supplement to the Handling Fee: (Rule 57.2(b))	200 Swiss francs
<u>Surcharges</u>	
5. Surcharge for late payment: (Rule 16bis.2(a))	Minimum: 248 Swiss francs Maximum: 624 Swiss francs

ANNEX II

TEXT OF THE AMENDED PROVISIONS OF THE AGREEMENT
UNDER THE PATENT COOPERATION TREATY (PCT)
BETWEEN THE INTERNATIONAL BUREAU OF WIPO AND
THE EUROPEAN PATENT ORGANISATION

Article 3

Competence of Authority

(1) [No change]

(2) Subject to paragraph (3), the Authority undertakes to act as an International Preliminary Examining Authority, provided that the receiving Office specifies the Authority for that purpose, for all international applications which are filed with the receiving Offices of, or acting for, all Contracting States and with respect to which the Authority, the Royal Patent and Registration Office of Sweden or the Austrian Patent Office acts or has acted as an International Searching Authority.

(3) [No change]

[End of the Annexes and of the document]

WIPO



PCT/A/XIII/3

ORIGINAL: English

DATE: October 11, 1985

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Thirteenth Session (5th Ordinary) Geneva, September 23 to October 1, 1985

REPORT

Adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XVI/1.Rev.): 1, 2, 3, 5, 6, 14, 15, 16, 22, 24, 25, 28 and 29.
2. The report on the said items, with the exception of item 16, is contained in the General Report (document AB/XVI/23).
3. The report on item 16 is contained in this document.
4. Mr. Patrick A. Smith (Australia) was elected Chairman of the Assembly.

ITEM 16 OF THE CONSOLIDATED AGENDA:

CERTAIN MATTERS CONCERNING THE PCT UNION
(FEES; GAZETTE; PAMPHLETS; COMMITTEES)

5. Discussions were based on documents PCT/A/XIII/1 and 2.
6. A number of delegations stated that, although they reluctantly agreed that an increase of the fees specified in the Schedule of Fees was necessary, they were not in favor of the proposal of the International Bureau to increase the fees by 5% for 1986 and a further 5% for 1987. In their view, too frequent changes should be avoided since they were confusing for applicants and difficult to implement by the national offices, which were both already faced with changes due to fluctuations in exchange rates. A single increase for the biennium 1986-87, with effect from January 1, 1986, would be preferable and would also advance the time when the break-even point in the finances of the PCT Union would be reached. The level of that single increase should be higher than 5%--for example 7% or 8%--and should be such that the overall revenue expected to be derived from the proposal of the International Bureau would not be affected.
7. The Delegation of Romania stated that it agreed with the proposal of the International Bureau and that the possibility for applicants from developing countries to pay lower fees should be further explored.
8. The Director General drew the Assembly's attention to the fact that an increase of 8% in the currency in which the fees are set--that is, in Swiss francs--would immediately cause a percentage increase of between 12% and 20% in important other currencies because of the present exchange rate between them and the Swiss franc and that it is in currencies other than Swiss francs that all applicants, except the Swiss, have to pay the fees. For this reason, he would have preferred an initial increase of 5% only. He added that even if the increase in Swiss francs was set for two years, rather than one year (as proposed by him), applicants and patent offices in several countries would have to get accustomed, during those two years, probably to several changes caused by the future fluctuation of the exchange rate between the Swiss franc and the other currencies. He also said that one additional change, namely the one that would be caused by introducing a change in Swiss francs in the middle of the two year period, would not appreciably aggravate the problem of variations in fees.
9. The Delegation of Japan stated that it was in principle in favor of a single increase of the fees for the biennium 1986-87 on the condition that such an increase should be low in view of the fact that Japanese applicants were sensitive to high increases of fees. Should the increase result in a level higher than 10% in Japanese yen, the delegation would prefer that the fees be increased twice during the biennium but by less than 10% in Japanese yen each time. In other words, the Delegation of Japan stated its preference for the original proposal of the International Bureau; however, in a spirit of cooperation, it also stated that it did not want to prevent a consensus.
10. It was understood that the question of the ceiling of the designation fee would be reviewed on the occasion of the next ordinary session of the Assembly, in September 1987.
11. The Assembly:

(i) amended, with effect from January 1, 1986, the Schedule of Fees by increasing the fees specified therein by 8% and agreed that no further increase in the fees in Swiss francs should be made for 1987 (the amended Schedule of Fees is set out in the Annex to this report);

(ii) decided that the PCT Gazette would continue to be published in an English-language edition and a French-language edition, the two editions being separate;

(iii) noted that the sales price of the PCT pamphlets would be 11 Swiss francs per copy for 1986 and 1987;

(iv) decided that the present format of the PCT pamphlets should not be changed, at least as regards the printing of drawings and the number of pages of the international application which should appear on each page of the pamphlet;

(v) agreed to postpone any decision concerning the establishment of the Executive Committee until any State member of the PCT Union or the Director General proposed that the matter be reconsidered;

(vi) decided that all PCT Contracting States--in addition, in the case of the Committee for Technical Cooperation, to the ex officio members according to Article 56(2)(b) of the PCT--would continue to be members of the Committee for Technical Cooperation and the Committee for Technical Assistance until any State member of the PCT Union or the Director General proposed that the matter be reconsidered.

[The Annex follows]

ANNEX

SCHEDULE OF FEES

<u>Fees</u>	<u>Amounts</u>
1. Basic Fee: (Rule 15.2(a))	
if the international application contains not more than 30 sheets	706 Swiss francs
if the international application contains more than 30 sheets	706 Swiss francs plus 14 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	171 Swiss francs per designation for which the fee is due, with a maximum of 1,710 Swiss francs, any such designation in excess of 10 being free of charge
3. Handling Fee: (Rule 57.2(a))	216 Swiss francs
4. Supplement to the Handling Fee: (Rule 57.2(b))	216 Swiss francs
<u>Surcharges</u>	
5. Surcharge for late payment: (Rule 16bis.2(a))	Minimum: 268 Swiss francs Maximum: 674 Swiss francs

[End of Annex and of document]

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PCT/A/XIV/3

ORIGINAL: English

DATE: September 23, 1986

E

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Fourteenth Session (9th Extraordinary) Geneva, September 8 to 12, 1986

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (documents AB/XVII/1.Rev. and 1.Rev.Add.): 1, 2, 4, 9, 10, 10bis, 14 and 15.
2. The report on the said items, with the exception of items 10 and 10bis, is contained in the General Report (document AB/XVII/11).
3. The report on items 10 and 10bis is contained in this document.

ITEM 10 OF THE CONSOLIDATED AGENDA:

ACCESSION OF GREECE AND SPAIN TO THE PATENT COOPERATION TREATY

4. Discussions were based on document PCT/A/XIV/1.

5. The Delegation of Spain stated that, for the PCT to become more attractive to the Spanish-speaking countries, it was necessary that the Spanish language be fully recognized in the framework of that Treaty, which implied that three objectives had to be reached: the admittance of Spanish as a language of filing and of publication of international applications, the incorporation of Spanish language patent documents into the PCT minimum documentation, and the possibility for a Spanish-speaking patent office to become an International Searching Authority. The revision of Rules 12, 34 and 48 of the Regulations under the PCT made it possible to reach the first two objectives. As to the acquisition of the status of an International Searching Authority, the Patent Office of Spain was undertaking a number of internal reforms which would make it possible for it to become, in due course, an International Searching Authority. The Delegation informed the Assembly that the internal procedure for accession to the PCT had already been initiated and added that such accession would be facilitated by a declaration of the Assembly expressing its willingness to appoint, in due course, the Patent Office of Spain as an International Searching Authority.

6. The Delegation of Greece thanked the member States of the PCT Union for their interest in inviting Greece to accede to the PCT and said that it would inform the government authorities of its country of the decision of the Assembly.

7. The Representative of the European Patent Office (EPO) stated that the EPO as a regional Office was naturally interested in PCT matters. He expressed his appreciation and admiration for the skillful and sustained efforts of WIPO in successfully promoting this important Treaty. For the PCT user, the interaction between the European Patent Convention (EPC) and the PCT was an essential feature. It was therefore highly desirable that any new member of the EPO ratify or accede to the PCT as soon as possible in order to maintain for the applicant the possibility of designating all EPC countries in the international application. The EPO had taken measures to permit consolidation of a European application designating any EPC country not yet a party to the PCT and an international application designating all other EPC countries in a so-called Euro/PCT designation. However, the full advantages of the PCT would be available only if PCT membership covered all EPC States. The EPO was therefore ready to give full assistance to the countries becoming new members of the EPC in overcoming any obstacle in adhering to the PCT. The intention of Spain to act as an International Searching Authority under the PCT was to be warmly welcomed. The Patent Office of Spain would fulfill an important function in searching and processing PCT applications.

8. The Delegations of France, Switzerland, Norway, Romania, the Soviet Union, the United States of America and Germany (Federal Republic of) supported the proposals contained in paragraph 5 of document PCT/A/XIV/1.

9. The Assembly unanimously declared that it would very much welcome the early accession to the PCT of Greece and Spain as well as of all the other countries not yet party to the PCT and invited those countries to join them in the PCT Union. Furthermore, the Assembly unanimously declared its willingness to appoint the Patent Office of Spain as an International Searching Authority under the PCT once all the conditions prescribed by the PCT and the Regulations thereunder were fulfilled, in particular, those which must be fulfilled by any Office acting as International Searching Authority.

10. The Delegation of Brazil stated that the National Institute of Industrial Property (INPI) of its country was contemplating to become an International Searching Authority under the PCT.

11. The Director General noted with interest the desire of the Brazilian INPI to become an International Searching Authority and said that the International Bureau was at the disposal of that Office to discuss the necessary procedures.

ITEM 10*bis* OF THE CONSOLIDATED AGENDA:

APPOINTMENT OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
AS AN INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY
UNDER THE PATENT COOPERATION TREATY

12. Discussions were based on document PCT/A/XIV/2.

13. The Delegation of the United States of America welcomed the proposals contained in paragraph 3 of document PCT/A/XIV/2. It was anticipated that, in October 1986, the authority to withdraw the reservation under Article 64(1) of the PCT would be given and the necessary implementing legislation would be adopted by the United States Congress, so that the withdrawal of the reservation could be effected before the next ordinary session of the Assembly. Discussion of the agreement between the United States Patent and Trademark Office (USPTO) and the International Bureau had begun. It was expected that the amended agreement would be similar in substance to the agreements already concluded by the International Bureau with the other industrial property offices acting both as International Searching Authorities and as International Preliminary Examining Authorities.

14. The Assembly decided that it was not necessary, before making the proposed appointment, to seek the advice of the PCT Committee for Technical Cooperation.

15. The Assembly decided to provisionally appoint the USPTO as an International Preliminary Examining Authority, and to approve in advance the required amendments to the existing agreement between the USPTO and the International Bureau provided that the amended agreement would, in substance, be similar to the agreements already concluded by the International Bureau with the other industrial property offices acting both as International Searching Authorities and International Preliminary Examining Authorities. It was understood that the appointment would become effective only once the United States of America was bound by the provisions of Chapter II of the PCT, that the agreement, once amended, would be promptly communicated by the International Bureau to all Contracting States of the PCT and that the Assembly at its first session following the amendment of the existing agreement (probably in September 1987) would be invited to confirm the appointment of the USPTO as an International Preliminary Examining Authority.

16. As regards the existing agreements with the International Searching and Preliminary Examining Authorities, the International Bureau recalled that, except for the agreement with the United Kingdom Patent Office, which would expire in 1993 and was not renewable, the existing agreements would expire in 1988 or in early 1989 (and, in the case of the agreement with the Australian Patent Office, in early 1990). That meant that the Assembly would have

to approve the renewal of the agreements in its 1987 ordinary session. Since the agreements could not be simply renewed because they contained obsolete provisions or provisions which required adaptation to the changes made in the Regulations under the PCT in 1984, it was intended to amend them so that new texts would be submitted to the Assembly in 1987. At the same time, that procedure would allow further harmonization of the substance and wording of the agreements. There were presently some differences which, in the opinion of the International Bureau based on the experience gained since 1978, could and should be eliminated. Naturally, some differences would have to be maintained here and there, particularly in the annexes to the agreements, which dealt with particular questions such as languages and fees, but the objective would be to have texts as identical as possible. The procedure would be the following. The International Bureau would approach each International Searching and Preliminary Examining Authority with a uniform new text which, it was hoped, would be acceptable to each of them. Once the new agreements were agreed upon with each Authority, the International Bureau would prepare a document for the 1987 ordinary session of the Assembly containing the texts of the new agreements, which would all enter into force on January 1, 1988, and be valid for 10 years, namely, until December 31, 1997.

17. The Assembly noted the statement reflected in the previous paragraph.

[End of document]

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PCT/A/XV/2

ORIGINAL: English

DATE: October 1, 1987

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Fifteenth Session (6th Ordinary) Geneva, September 21 to 30, 1987

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XVIII/1 Rev.): 1, 2, 3, 4, 10, 11, 13, 17, 20 and 21.
2. The report on the said items, with the exception of item 11, is contained in the General Report (document AB/XVIII/14).
3. The report on item 11 is contained in this document.
4. Mr. Donald H. Quigg (United States of America) was elected Chairman of the Assembly.

ITEM 11 OF THE CONSOLIDATED AGENDA:

CERTAIN MATTERS CONCERNING THE PCT UNION (APPOINTMENT OF AN INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY; EXTENSION OF APPOINTMENTS OF INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES: CEILING OF DESIGNATION FEE)

5. Discussions were based on documents PCT/A/XV/1 and 1 Corr.

6. The Assembly:

(i) confirmed the appointment of the United States Patent and Trademark Office as an International Preliminary Examining Authority;

(ii) after noting that it was not necessary, before extending the appointment of the International Searching and Preliminary Examining Authorities, to seek the advice of the PCT Committee for Technical Cooperation, extended, until December 31, 1997, the appointments of

the Patent Office of Australia,
the Austrian Patent Office,
the Japanese Patent Office,
the USSR State Committee for Inventions and Discoveries,
the Royal Patent and Registration Office of Sweden,
the United States Patent and Trademark Office, and
the European Patent Office

as International Searching and Preliminary Examining Authorities,

(iii) approved the new texts of the Agreements between WIPO and the Authorities referred to in item (ii), above, as appearing in documents PCT/A/XV/1 (Annex) and 1 Corr.;

(iv) decided that the ceiling of the designation fee would continue to apply.

[End of document]

WIPO



PCT/A/XVI/3

ORIGINAL: English

DATE: October 4, 1989

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Sixteenth Session (7th Ordinary) Geneva, September 25 to October 4, 1989

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XX/1 Rev.): 1, 2, 3, 4, 8, 11, 13, 17, 19, 23 and 24.
2. The report on the said items, with the exception of item 8, is contained in the General Report (document AB/XX/20).
3. The report on item 8 is contained in this document.
4. Mr. Max A.J. Engels (Netherlands) was elected Chairman of the Assembly.

ITEM 8 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

5. Discussions were based on documents PCT/A/XVI/1 and 2.
6. Several delegations expressed their satisfaction with the growth in use of the PCT, which indicated the manifest attractiveness of the PCT system for users. Several of them also expressed their appreciation for the work done by the Director General and the International Bureau in promoting the use of the PCT and in administering its operations, and noted that further resources and personnel were clearly needed to cope with the increased workload of the PCT.
7. The Delegations of Switzerland, France, Denmark and Belgium suggested that an interim report could be prepared for consideration by the 1990 session of the Assembly to provide the basis for approval of the posts for 1991, which approval they were willing to give in principle.
8. The Delegation of the United Kingdom agreed that the Director General needed a degree of flexibility in staffing posts to deal with the increased workload.
9. The Director General recalled that flexibility in staffing posts was foreseen in paragraph 11 of document PCT/A/XVI/1 as well as in the draft budget for the 1990-91 biennium. The suggestion to review in 1990 the number of posts was undesirable because such a procedure would change the biennial nature of the budget.
10. A number of delegations supported the development of computerization to improve PCT operations and welcomed the proposed development of an optical disc system. The Delegations of Switzerland, France, Denmark and Belgium requested that, since a new technology was involved, a detailed progress report should be submitted in 1990 on the status and further development of the optical disc system.
11. The Director General said that he would present such a report to the 1990 session of the Assembly.
12. The Delegation of Switzerland said that it was satisfied with the conclusions reached in the comparative study regarding whether to print PCT pamphlets in-house or outside.
13. As concerns the proposal to begin reimbursement of PCT deficit-covering contributions, the Delegations of Switzerland, Sweden, Australia and Japan said that they agreed with the proposal. The Delegations of Denmark and Belgium added that they would like the reimbursements to be as fast as possible. The Delegations of France, the United Kingdom, the United States of America, the Federal Republic of Germany and the Netherlands said that they also agreed with the proposal but considered that, in the light of the favorable financial situation of the PCT Union, such reimbursement should be at the level of 2,000,000 francs per year even if the fees were not increased. The Delegation of the United States of America added that it would prefer transfer instead of crediting to contributions.

14. The Delegations of Switzerland, France, the United Kingdom, the United States of America, Australia, Belgium, Japan, the Federal Republic of Germany and the Netherlands opposed any increase in fees for one or several of the following reasons: the reasons given for the increase did not demonstrate the need for increase; the self-supporting requirement of the fee system was more than assured without any change in the fees; an increase of fees may deter some prospective applicants from the use of the PCT.

15. The Delegations of Sweden, the Soviet Union and Austria agreed to a fee increase, but said that it should be lower than the 10% proposed.

16. The Delegation of Denmark agreed to the proposed fee increase and added that it could also accept a fee increase which would be lower than 10%.

17. The representative of FICPI asked that a possible extension of the present 30-month period under Chapter II of the PCT be studied in due course. Speaking on behalf of users of the PCT, he supported an increase in PCT fees provided it was more modest than the 10% proposed by the Director General.

18. The Assembly

(i) noted the information contained in documents PCT/A/XVI/1 and 2,

(ii) approved the proposal concerning the reimbursement of deficit-covering contributions contained in paragraph 43 of document PCT/A/XVI/1 and fixed the yearly amount for 1990 and 1991 at 2,000,000 francs^{*}, and

(iii) decided not to amend the Schedule of Fees annexed to the PCT Regulations.

[Annex follows]

*

The share of each interested country in the said amount is shown in the Annex.

ANNEX

SHARE OF COUNTRIES IN THE YEARLY AMOUNT OF TWO MILLION FRANCS
FOR 1990 AND 1991 WHICH IS REFERRED TO IN PARAGRAPH 18(ii)

<u>Country</u>	<u>Amount</u>
Australia	55,724
Austria	33,740
Belgium	11,988
Brazil	32,570
Canada	46,560
Cuba	568
Denmark	32,672
Egypt	976
Finland	21,086
France	143,070
Germany (Fed. Rep. of)	231,172
Hungary	14,866
Ireland	4,666
Israel	4,232
Japan	285,730
Liechtenstein	1,044
Luxembourg	3,864
Monaco	54
Netherlands	58,270
Norway	22,672
Philippines	644
Romania	3,928
Soviet Union	166,548
Spain	14,110
Sweden	90,732
Switzerland	80,182
United Kingdom	170,142
United States of America	466,630
Yugoslavia	1,560
	2,000,000

[End of document]

WIPO



PCT/A/XVII/2

ORIGINAL: English

DATE: October 1, 1990

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Seventeenth Session (10th Extraordinary)
Geneva, September 24 to October 2, 1990

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XXI/1 Rev.): 1, 2, 6, 11, 15 and 16.
2. The report on the said items, with the exception of item 11, is contained in the General Report (document AB/XXI/7).
3. The report on item 11 is contained in this document.

ITEM 11 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

4. Discussions were based on document PCT/A/XVII/1.
5. The Delegation of Australia expressed its satisfaction with the progress report on the status and further development of an optical disc system for the processing of international applications under the PCT. The Australian Patent Office was keen in assisting the International Bureau in its efforts to developing an optical disc system and had taken care of selecting, for the purpose of participating as expert-adviser in the tendering procedure, one of its staff members who was familiar with both the PCT and with the optical disc technology.
6. The Delegations of Australia, Austria, Brazil, Canada, the Democratic People's Republic of Korea, France, Germany (Federal Republic of), Hungary, Luxembourg, the Netherlands, Switzerland, the United Kingdom and the United States of America supported the proposal of the International Bureau that each of the International Searching or Preliminary Examining Authorities and each of the other national Offices that chose to receive the ESPACE-WORLD CD-ROMs in substitution for paper or microfilm copies would be able to request the International Bureau to provide it, free of charge, with one work station for reading and printing the said CD-ROMs. They expressed the view that the CD-ROM technology was becoming a major tool for the dissemination of patent documents and that efforts to facilitate the use of that technology were welcomed.
7. The Delegation of Australia called for a certain flexibility in the application of the said proposal.
8. The Delegation of Canada called for a certain flexibility in the application of the said proposal and would see what negotiations were possible for receiving the documentation in CD-ROM format.
9. The Director General said that he would exercise a certain degree of flexibility in implementing the proposal, should the said proposal be accepted.
10. The Delegations of Germany (Federal Republic of), Japan and the United States of America expressed their concern about the present lack of any international standard concerning the production of CD-ROMs for the purpose of making available patent documents as facsimile images. They expressed the hope that the International Bureau would, as soon as an international standard was established, conform to such a standard.
11. The Director General recalled that a draft recommended standard concerning the making available of patent documents as facsimile images on CD-ROMs was under consideration within the framework of the Permanent Committee on Industrial Property Information (PCIPI) and said that the International Bureau would continue to promote the adoption of such a standard and apply it. The Director General stressed, however, that such a standard would have to be followed by all the patent offices producing CD-ROMs. Otherwise, real problems would arise, also with respect to the CD-ROMs of the International Bureau or the European Patent Office.

12. The Delegation of Japan said that it was ready to accept the proposal of the International Bureau if the latter promoted the swift adoption of an international standard and followed that standard once adopted.

13. The Delegations of Austria and the United Kingdom, although they shared the concern of other Delegations concerning the present lack of an international standard on CD-ROMs containing patent documents as facsimile images, expressed the opinion that, pending the establishment of such a standard, the decision to start producing such CD-ROMs before the adoption of the standard was appropriate, it being understood that the standard, when adopted, would be adhered to, as stated by the Director General.

14. The Delegations of the Netherlands and Switzerland said that the move from paper copies of patent documents to CD-ROMs did raise some technical problems which had not yet been fully solved, such as the printing of paper copies from CD-ROMs: the printing speed of the proposed work stations was insufficient for printing large volumes of patent documents and would not allow printing on both sides of paper sheets. Both Delegations expressed the hope that such problems could be solved in a not too distant future. The Delegation of Switzerland added that the exercise of a certain flexibility in providing the offices with work stations could be a partial solution to such problems.

15. The Delegation of Luxembourg expressed the hope that the same work stations could be used for reading and printing both the CD-ROMs relating to international trademarks and those relating to PCT pamphlets.

16. The Delegation of Austria underlined the importance of CD-ROMs containing patent documents as a dissemination media for developing countries, which could access the patent information in a much easier and cheaper way by using such a media.

17. The Representative of the European Patent Organisation stated that the European Patent Office (EPO) was in total agreement with the proposal of the International Bureau. The proposal was fully in line with the policy of the EPO which was aiming at replacing paper copies of patent documents by CD-ROMs.

18. The Representative of Algeria stated that the Authorities of his country were considering the possibility of acceding the PCT. He stressed the importance of CD-ROMs as a media for the dissemination of patent information and asked whether it would be possible for developing countries not party to the PCT to receive also free of charge CD-ROM reading and printing work stations.

19. The Director General said that CD-ROMs containing patent documents were a much cheaper and easier tool for the dissemination of patent information throughout the world and, as such, were of great importance to developing countries. He also said that all possible means would be used within the framework of development cooperation programs to provide developing countries with CD-ROM reading and printing equipment.

20. The Assembly

(i) noted with satisfaction the progress report contained in paragraphs 2 to 8 of document PCT/A/XVII/1,

(ii) approved the proposal contained in paragraph 16 of the said document.

[End of document]

WIPO



PCT/A/XVIII/9

ORIGINAL: English

DATE: July 12, 1991

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Eighteenth Session (11th Extraordinary) Geneva, July 8 to 12, 1991

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly of the International Patent Cooperation Union (PCT Union) (hereinafter referred to as "the Assembly") held its eighteenth session (11th extraordinary) in Geneva from July 8 to 12, 1991.
2. The following 25 Contracting States were represented at the session: Australia, Austria, Cameroon, Canada, Czechoslovakia, Democratic People's Republic of Korea, Denmark, Finland, France, Germany, Hungary, Italy, Japan, Mongolia, Netherlands, Norway, Poland, Republic of Korea, Romania, Soviet Union, Spain, Sweden, Switzerland, United Kingdom and United States of America.
3. The following three States, members of the International Union for the Protection of Industrial Property (Paris Union), participated in the session as observers: Bangladesh, Indonesia and Mexico.
4. The European Patent Organisation (EPO), having the status of special observer, was represented.

5. The following six non-governmental organizations were represented by observers: Committee of National Institutes of Patent Agents (CNIPA), European Federation of Agents of Industry in Industrial Property (FEMIPI), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI) and Union of Industrial and Employers' Confederations of Europe (UNICE).

6. The list of participants is contained in Annex I to this report.

OPENING OF THE SESSION

7. The session was opened by the Director General.

ELECTION OF AN ACTING CHAIRMAN

8. In the absence of its Chairman and of the two Vice-Chairmen, the Assembly unanimously elected Mr. Peter Messerli (Switzerland) as Acting Chairman. Mr. Messerli was obliged for unexpected and unavoidable reasons to be absent after the first day of the session. The Assembly therefore elected another Acting Chairman, Mr. Leslie Lewis (United Kingdom).

ADOPTION OF THE AGENDA

9. The Assembly adopted, for its session, the agenda contained in Annex II to this report (document PCT/A/XVIII/1 Rev.).

AMENDMENTS TO THE REGULATIONS UNDER THE PCT

10. The Assembly considered proposed amendments as appearing in documents PCT/A/XVIII/2 to 8 as well as several proposals presented during the meeting.

11. Following the discussion of the proposals referred to in the previous paragraph, the Assembly unanimously adopted amendments to the Regulations under the PCT as appearing in Annex III to this report.

12. The Assembly decided that the amendments would enter into force on July 1, 1992

13. All amendments to Rules which are not referred to in the subsequent paragraphs of this report were adopted without any discussion or without any request for the inclusion of statements in this report.

14. Rule 3.3(a)(iii)^{*}. In adopting the amendments to this Rule, the Assembly noted that the Delegation of France would have preferred that the words "on the front page of the pamphlet and in the Gazette" be kept in the said Rule.

* References in this report to "Articles" are to those of the Patent Cooperation Treaty (PCT) and to "Rules" to those of the Regulations under the PCT ("the Regulations").

15. The Representative of the EPO suggested that the check list under Rule 3.3 allow for the inclusion of an indication that a sequence listing in machine readable form for the purposes of Rule 13~~ter~~ is submitted with the international application.

16. Rules 4.1(b)(iv) and 4.9(a). In adopting the amendments to these Rules, the Assembly noted the view expressed by the Delegation of the Netherlands and the Representative of the EPO that the names of all States designated for a regional patent should be indicated in the request.

17. Rule 4.5(d). In response to a question raised by the Representative of the EPO, the Assembly agreed that this Rule enabled different applicants to be indicated for different States designated for a European patent.

18. Rule 4.9(b) and (c). In response to a question by the Representative of the EPO whether the receiving Office was required to make a declaration under Article 14(3)(b) if designation and confirmation fees were not paid within the time limit under Rule 4.9(b)(ii), the Assembly noted that, because of the wording of the applicant's statement under Rule 4.9(b)(ii), the designation concerned would be withdrawn by the applicant in such a case, rather than be "considered withdrawn" in the terms of Article 14(3)(b), so that no declaration under that Article would be required. Also, the confirmation fee under Rule 15.5 was not a fee prescribed under Article 14(3)(a) and (b) (see Rule 27.1).

19. Rule 4.10(d-bis). The Assembly decided not to adopt Rule 4.10(d-bis), as set out in document PCT/A/XVIII/4, since it could not be fully discussed in the present session of the Assembly due to lack of time, and noted that most delegations preferred to retain the present practice followed under Rule 4.10(d). The International Bureau informed the Assembly that the question of a priority claim based on an earlier application filed on the same day as the international application might be taken up at another time.

20. Rules 4.15, 53.8, 56.1 and 90bis.5. The Assembly noted, in response to a concern expressed by the Representative of the EPO, that the amended Rules simply provided a procedural mechanism for handling international applications in certain cases where an applicant-inventor was unwilling or unavailable to sign the documents referred to, but agreed that the situation in which the applicant was unwilling to sign should not apply to the provisions of Rule 90bis.5. The questions of entitlement to apply for a patent and ownership of the invention would not be affected by these amended Rules and would continue to be matters for national law.

21. Rules 12.1, 20.4 and 26.3~~ter~~. In adopting these Rules, the Assembly noted the view of the Delegation of Japan that Article 11(1)(ii) required the whole international application to be in a single prescribed language only, but the Assembly took a different view of the scope of that Article as reflected in Rule 20.4(c). When discussing the amendments, reference was made to the Draft Patent Law Treaty which would allow that any text matter contained in any drawings, if originally furnished in a foreign language, be subsequently furnished in the official language without the filing date being affected.

22. In connection with Rule 26.3~~ter~~(a), the Assembly noted the view of the Delegation of the Netherlands that the Rule would be inconsistent with Articles 11 and 14, which made no provision for correction of the language used in elements of the international application without changing the international filing date of that application, but the Assembly took the

view that elements other than those referred to in Article 11(1)(iii)(d) and (e) were capable of correction by way of filing a translation into an admitted language.

23. The Assembly agreed that, when filing a translation to effect a correction under Rule 26.3*ter*(a), it was not permitted to change the substance of the international application. If the filing of such a translation were to result in a broadening of the scope of the international application, sanctions under national law would apply.

24. Rule 13. In adopting the amendments to this Rule, the Assembly agreed that the contents of the current Rules 13.2 and 13.3 relating to unity of invention would continue to apply. It decided to delete the current Rules 13.2 and 13.3 from the Regulations and to include their contents, along with similar details relating to unity of invention in “Markush” type claims and in “intermediate and final product” claims as set out in document PCT/CAL/IV/5, in the Administrative Instructions and, with other examples, in the International Search Guidelines and the International Preliminary Examination Guidelines. It was also agreed that the PCT Applicant’s Guide should explain the requirement of unity of invention for the users of the PCT.

25. It was agreed by the Assembly that the unity of invention provisions of Rule 13 governed the practice to be followed in processing international applications during both the international phase before the international authorities and the national phase before the designated and elected Offices.

26. Rule 13*ter*. In adopting Rules 13*ter*.1 and 13*ter*.2, the Assembly agreed, with the concurrence of the International Bureau, the International Searching Authorities and the International Preliminary Examining Authorities, that no Administrative Instructions would be promulgated which included a standard for nucleotide and/or amino acid sequence listings in machine readable form without the prior agreement of all International Searching and Preliminary Examining Authorities. Pending the establishment of such a standard in the Administrative Instructions, each International Searching Authority, International Preliminary Examining Authority and designated Office could require sequence listings to be furnished in a machine readable form acceptable to it. The Assembly recommended that a WIPO standard for a machine readable format for sequence listings be developed, and the International Bureau was requested to put the matter to the WIPO Permanent Committee on Industrial Property Information (PCIP) for development of such a standard as soon as possible.

27. Rule 15.5(b). In adopting Rule 15.5(b), the Assembly agreed that any specification by the applicant for the allocation of moneys under that Rule to certain designations under Rule 4.9(b) could be taken into account only if it had been received by the receiving Office within the time limit under Rule 4.9(b)(ii), and that the Administrative Instructions should make this clear.

28. Rules 15.6 and 57.6. In adopting the amendments to these Rules, the Assembly agreed that refunds of the international fee and the handling fee could also be made by the International Bureau, on a case-by-case basis, where justified in special circumstances, but that no specific enabling provision in the Regulations was needed to this effect. The Delegations of Australia, the Netherlands and the United Kingdom noted that they would have preferred express provisions for refund by the International Bureau to be included in the Regulations.

29. Rule 16.2. In adopting the amendment to this Rule, the Assembly agreed that the receiving Office would be entitled to apply the Rule by first inviting the applicant to make a

request for a refund and then refunding the fee only after receipt of such a request from the applicant.

30. Rule 16bis.2. In adopting the amendment to this Rule, the Assembly agreed that, if separate invitations were made under both paragraphs (a) and (b) of Rule 16bis.1 (for example, where the international application was filed early in the priority year or without claiming priority), a late payment fee could be payable twice.

31. Rule 27.1. The Assembly noted the view of the Delegation of Japan that the late payment fee under Rule 16bis.1(a) and (b) should not fall under the “fees prescribed under Article 3(4)(iv)” as provided in Rule 27.1(a).

32. Rules 32bis and 90bis.3. In adopting Rule 90bis.3 and agreeing to the deletion of Rule 32bis, the Assembly noted the view expressed by the Delegations of France, Italy, Japan and the United Kingdom that withdrawal of a priority claim should not be permitted after international publication.

33. Rule 36. A proposal to amend Rule 36 was submitted by Sweden and the EPO in document PCT/A/XVIII/8 along with the proposal of the International Bureau on that Rule in document PCT/A/XVIII/2. The International Bureau withdrew its proposal in favor of the proposal by Sweden and the EPO which was adopted in a modified form to include documentation not only on paper but also in microform or on electronic media, such as, for example, CD-ROM, optical disks, magneto-optic disks, magnetic tapes and magnetic disks.

34. Rule 42. The Assembly agreed not to amend Rule 42. However, the Assembly recognized that there may be special circumstances, such as where time is needed to resolve matters arising under Rule 13ter (nucleotide and/or amino acid sequence listings) or Rule 40 (lack of unity of invention), in which it may not be possible to establish the international search report within the time limit under Rule 42. In such a case, the international search report must be established as soon as possible after the expiration of that time limit. The report should be established prior to international publication.

35. Several delegations would have preferred to include appropriate provisions in Rule 42.

36. The Delegation of Sweden and the Representative of the EPO pointed out that, in some cases, the International Searching Authority would not be able to establish the international search report prior to international publication, for example, where the applicant paid the search fee under Rule 16bis delaying significantly the start of the international search. In such circumstances, the time limit under Rule 42 could well expire after the technical preparations for international publication had been completed.

37. Rule 43.8. In response to a question raised by the Delegation of Japan as to the difference in meaning between “an authorized officer” in present Rule 43.8 and “the officer ... responsible” in that Rule as amended, the Assembly agreed that “the officer ... responsible” meant the person who actually performed the search work and prepared the search report.

38. Rule 43.9. The Representative of the EPO proposed that the Administrative Instructions should include provision for an indication in the international search report that a sequence listing has been furnished under Rule 13ter.1(a).

39. Rules 47.1(a-bis) and 47.4. The International Bureau indicated, in response to a question raised by the Delegation of the United Kingdom during the discussion of Rule 47.4,

that any early communication to a designated Office under Article 20, resulting from a request under Article 23(2), would include the notice of designation under Rule 47.1(a-bis).

40. Rule 49.5(c-bis). In adopting the amendment to Rule 49.5(c-bis), the Assembly noted the view, expressed by the Delegations of Japan and the Netherlands, that Rule 49.5(c-bis), in governing the procedure for the provision of translations to designated Offices under Article 22, dealt with matters which should be left to national law.

41. The Assembly agreed that Rule 49.5(c-bis), in permitting the designated Office to “consider the international application withdrawn,” was referring only to the loss of effect of the international application in the designated State referred to in Article 24.

42. Rule 49.5(h). In adopting the amendment to Rule 49.5(h), the Assembly noted the view expressed by the Delegation of Japan that the procedure for the provision of translations of abstracts and of indications under Rule 13bis.4 to designated Offices should be left to national law. The Delegation of the Netherlands expressed a similar view but only as regards the translation of the abstract.

43. The Assembly also noted the view of the Representative of the EPO that some sanction for non-compliance should be included in Rule 49.5(h), but the Assembly decided that it was preferable to leave the sanction to national law.

44. Rule 53.9. The Representative of the EPO expressed the view that amendments under Article 19 could be disregarded for the purposes of the international preliminary examination without the need to consider them as reversed by an amendment under Article 34; that amendments under Article 34 merely served the purposes of the procedure for international preliminary examination; and that amendments under Article 34 thus did not affect the scope of the applicant’s rights under the national law applicable in elected States. However, in adopting Rule 53.9, the Assembly took the view that the making of amendments under Articles 19 and 34 resulted in the amendment of the international application itself; that amendments under Article 19 made prior to the filing of the demand continued to be applicable in the international preliminary examination procedure unless superseded, or considered as reversed, by amendments under Article 34; and that what constituted the international application for the purposes of the national phase before the elected Offices was, unless further amended under Article 41, the application as amended by any amendments annexed to the international preliminary examination report (see Rule 76.5(iv)).

45. In response to a question from the Delegation of the Netherlands, the International Bureau explained that each designated or elected Office was entitled to require a translation of both the international application as filed and the international application as amended. In view of this entitlement, a designated or elected Office would have the right to require less than both translations; for example, it could require a translation only of the international application as filed.

46. The Assembly agreed that amendments under Article 34 were made for the purposes of the international preliminary examination in the sense that they did not affect the international application for the purposes of designated Offices which were not elected, and that amendments under Article 19 which were subsequently superseded, or considered as reversed, by amendments under Article 34 continued to be applicable for the purposes of designated Offices not elected.

47. As regards the concept that amendments under Article 19 were considered as reversed by an amendment under Article 34 (see Rule 53.9(a)(ii)), the Assembly agreed that what was meant was that the claims were thereby amended under Article 34 so as to revert to the claims as originally filed, with effect from the time when the demand was filed.

48. Rules 54.2 and 54.3. In adopting the amendments to Rule 54.2 and the deletion of Rule 54.3, the Assembly agreed that Rule 54.2 as adopted would not permit a sole applicant who was not a national or resident of a Contracting State bound by Chapter II to file a demand.

49. The Assembly also noted the views of the Delegations of Japan and the Netherlands that an applicant who was not a national or resident of a Contracting State bound by Chapter II should not be entitled to make an election as the sole applicant for an elected State, even if the demand had been filed by two or more applicants of whom at least one was entitled to file the demand under Rule 54.2. The Assembly agreed that the deletion of Rule 54.3 was consistent with amendments adopted to Rule 18 whereby two or more applicants could jointly file an international application and decide upon the distribution among them of the designations, provided that at least one of them was a national or resident of a Contracting State, with no restriction that there be such an applicant for each designated State. The Assembly agreed that the adopted minimum requirements for filing a demand were consistent with Article 31.

50. Rule 56.1. In adopting the amendments to this Rule, the Assembly noted the concerns of the Delegations of Japan and the Netherlands as to the qualifications needed to file a later election, similar to those outlined above in relation to Rules 54.2 and 54.3. However, the Assembly decided that the provisions for filing a later election should place any applicant making a later election in no worse a position than he would have been if he had been indicated in the demand and had made the election in that demand.

51. Rule 56.1(f). In response to a question from the Delegation of the United States of America as to why the last sentence of this Rule contained the expression “considered to have been submitted to the International Bureau” rather than an expression such as “considered to have been received by the International Bureau”, the International Bureau drew attention to Article 31(6)(b) in which the expression “shall be submitted to the International Bureau” is used relative to later elections.

52. Rule 60.1(g). The Delegation of the United States of America indicated that the invitation procedure provided for in the Rule would unduly delay the start of the international preliminary examination. The Assembly noted that any delay resulting from that invitation procedure would be caused by the applicant and could not be attributed to the International Preliminary Examining Authority.

53. Rule 61.3. In adopting the amendment to this Rule, the Assembly agreed that the Administrative Instructions should include appropriate provisions for notifying the applicant promptly when a demand was filed after the expiration of the time limit under Article 39(1)(a).

54. Rule 61.4. In response to a concern expressed by the Delegation of Japan, the Assembly agreed that the requirement of confidentiality imposed by Article 38 in relation to the file of the international preliminary examination did not extend to the mere fact that a demand had been made or that certain States had been elected. This view was consistent with the provisions of Article 31(7) which, in requiring that each elected Office be notified of its

election, did not impose an obligation on that Office to keep the fact of its election confidential.

55. Rule 62.1. In adopting Rule 62.1, the Assembly agreed that the Administrative Instructions should include appropriate provisions for the International Preliminary Examining Authority to be informed if no amendments under Article 19 had been made by the time when the copy of the demand was received by the International Bureau.

56. Rules 66.1(d) and 66.4bis. The Assembly agreed that the effect of these Rules was that any amendments which were received by the International Preliminary Examining Authority before it had begun to draw up a written opinion or the international preliminary examination report would always be taken into account for the purposes of that opinion or report. The Assembly also agreed that the International Preliminary Examination Guidelines should include guidance for the International Preliminary Examining Authorities as to circumstances in which amendments were permitted not to be taken into account.

57. In adopting Rule 66.4bis, the Assembly noted the view of the Delegation of Japan that such a provision should not be included in the Regulations since the Treaty required all amendments under Article 19 to be taken into account for the purposes of the international preliminary examination, without any exception, and that the international preliminary examination should not start until amendments under Article 19 had been received or until the time limit for making amendments under Article 19 had expired.

58. Rule 66.1(e). In adopting Rule 66.1(e), the Assembly agreed that the International Preliminary Examination Guidelines should clarify that, where a claim had been only partly searched by the International Searching Authority, that claim should be subjected to international preliminary examination to the extent possible.

59. Rule 76.5(iv). In adopting this Rule, the Assembly noted the view of the Delegations of Japan, the Netherlands and the United States of America that the question of provision of translations for the purposes of Article 39(1) should be a matter for national law.

60. The Assembly noted that Rule 76.5(iv) related only to the requiring of translations for the purposes of entry into the national phase under Article 39(1). The Assembly agreed, noting the provisions of Article 29, that the Rule did not preclude national law from requiring, for the purposes of provisional protection, a translation of amendments made under Article 19 even where the amendments were not annexed to the international preliminary examination report.

61. Rule 82.1(d) and (e). The Delegation of Spain, noting that these provisions were contrary to the Spanish legislation, considered them to be contrary to Article 48 and expressed the view that they should not be included in the Regulations. This view was shared by the Delegations of Japan and the United States of America. However, the Assembly took the view that the word “mail” in Article 48 was not limited to the service of postal authorities.

62. Rule 90. In adopting Rule 90, the Assembly noted a suggestion by the Delegation of Germany, which was supported by the Representative of AIPPI, to add to Rule 90.2(b) a provision pursuant to which the first named agent would be considered as the common agent of all the applicants in all cases where only some, but not all, applicants have appointed an agent, instead of considering the first named applicant as common representative also in such cases.

63. Rule 90bis.6. In response to a request by the Representative of the EPO, the International Bureau stated that it would take appropriate measures to assess any possible abuse resulting from withdrawal of demands prior to the establishment of the international preliminary examination report but after entry into the national phase. The Delegation of the United States of America and the Representative of the EPO expressed concerns relative to Rule 90bis.6 but welcomed the statement by the International Bureau.

64. Rule 91.1. The United Kingdom proposed an amendment to Rule 91.1(b) in document PCT/A/XVIII/6 Rev. which was considered with the proposed amendment to Rule 91 in document PCT/A/XVIII/2. Both of these proposed amendments were very much welcomed by all representatives of the non-governmental organizations and met with favor from several delegations, because they would make the PCT safer for applicants. Other delegations expressed great hesitation about adopting such amendments, in particular, because they would allow introduction into the international application of information not contained therein at the time of filing. In view of such hesitations, the proposed amendments were not adopted.

65. Rule 92.4. In adopting the amendment to this Rule, the Assembly noted that the Rule as amended would enable a national Office or intergovernmental organization, if it wished, to require the furnishing of the originals of signed documents. This could be done by way of a general requirement under Rule 92.4(d) (e.g., by providing that the original of any filed document signed by the applicant was required to be furnished) or by taking action, in specific cases, under Rule 92.4(f).

66. The Assembly unanimously adopted this report on July 12, 1991

[Annex I follows]

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

I. ÉTATS MEMBRES/MEMBER STATES

(dans l'ordre alphabétique français des noms des États)
(in the French alphabetical order of the names of the States)

ALLEMAGNE/GERMANY

Frank Peter GOEBEL, Director, Legal Division, German Patent Office, Munich

AUSTRALIE/AUSTRALIA

Bruce Ian MURRAY, Deputy Commissioner, Australian Patent, Trade Marks and Designs Offices, Canberra

AUTRICHE/AUSTRIA

Dietmar TRATTNER, Examiner, Presidential Department II, Austrian Patent Office, Vienna

CAMEROUN/CAMEROON

Gaspard TOWO-ATANGANA, Consul général, Genève

CANADA

Pierre TREPANIER, Directeur, Direction PCT, Ministère de la consommation et des corporations, Hull, Québec

DANEMARK/DENMARK

Lise Dybdahl ØSTERBORG (Mrs.), Head of Division, Industrial Property Department, Danish Patent Office, Copenhagen

ESPAGNE/SPAIN

Alberto CASADO CERVIÑO, Director, Departamento de Estudios y Relaciones Internacionales, Registro de la Propiedad Industrial, Madrid

Juan F. IBÁÑEZ BALLANO, Jefe de la Sección de Patente Europea y del PCT, Registro de la Propiedad Industrial, Madrid

ETATS-UNIS D'AMERIQUE/UNITED STATES OF AMERICA

Vincent TURNER, Administrator, International Division, Patent and Trademark Office, Department of Commerce, Washington, D.C.

Richard LAZARUS, Lead Legal Examiner, International Division, Patent and Trademark Office, Department of Commerce, Washington, D.C.

Anne KELLY (Mrs.), Director, Office of National and International Application Review, Patent and Trademark Office, Department of Commerce, Washington, D.C.

FINLANDE/FINLAND

Maarit Helena LOYTOMAKI (Mrs.), Head of Division, National Board of Patents and Registration, Helsinki

FRANCE

Jacques VERONE, Responsable de la Section administrative du PCT et des demandes européennes, Institut national de la propriété industrielle, Paris

Jean-Baptiste MOZZICONACCI, Attaché a la Direction générale, Institut national de la propriété industrielle, Paris

HONGRIE/HUNGARY

Gusztáv VEKAS, Vice-President, National Office of Inventions, Budapest

Margit SUMEGHY (Mrs.), Head, Legal Section, National Office of Inventions, Budapest

ITALIE/ITALY

Marco G. FORTINI, Ambassadeur, Délégué aux accords de propriété intellectuelle, Ministère des affaires étrangères, Rome

Pasquale IANNANTUONO, Conseiller juridique, Bureau des accords de propriété intellectuelle, Ministère des affaires étrangères, Rome

Bruno GRADI, Chef de la Division PCT et brevet européen, Office central des brevets, Ministère de l'industrie, du commerce et de l'artisanat, Rome

Giovanni de SANCTIS, Examinateur, Office central des brevets, Ministère de l'industrie, du commerce et de l'artisanat, Rome

JAPON/JAPAN

Kunishige SATO, Director of PCT Affairs Office, Japanese Patent Office, Tokyo

Tetsuo SHIBA, Deputy Director of the Patent Examination Standard Office, Japanese Patent Office, Tokyo

Shigeo TAKAKURA, First Secretary, Permanent Mission, Geneva

MONGOLIE/MONGOLIA

Gonchiguin GONGOR, Premier secrétaire, Mission permanente, Genève

NORVÈGE/NORWAY

Ingolf LILLEVIK, Head of Division, Patent Department, Norwegian Patent Office, Oslo

PAYS-BAS/NETHERLANDS

Siep de VRIES, Member of the Patents Council, Netherlands Patent Office, Rijswijk

POLOGNE/POLAND

Bogdan ROKICKI, Directeur, Département des demandes, Office des brevets de la République de Pologne, Varsovie

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

Joon Kyu KIM, Attaché (Intellectual Property), Permanent Mission, Geneva

RÉPUBLIQUE POPULAIRE DÉMOCRATIQUE DE CORÉE/DEMOCRATIC PEOPLE'S
REPUBLIC OF KOREA

Chang Rim PAK, Counsellor, Permanent Mission, Geneva

ROUMANIE/ROMANIA

Ion CONSTANTIN, Examineur principal, Chef de la Section PCT, Office d'État pour les inventions et les marques, Bucarest

ROYAUME-UNI/UNITED KINGDOM

Cedric G.M. HOPTROFF, Principal Examiner, Industrial Property and Copyright Department, The Patent Office, London

Leslie LEWIS, Principal Examiner, Legal Division, The Patent Office, Newport

Hugh J. EDWARDS, Senior Examiner, Legal Division, The Patent Office, Newport

SUEDE/SWEDEN

Jan-Eric BODIN, Deputy Head, Patents, Royal Patent and Registration Office, Stockholm

Marie ERIKSSON (Miss), Head of Division, Royal Patent and Registration Office, Stockholm

SUISSE/SWITZERLAND

Peter MESSERLI, Chef du service juridique I, Office fédéral de la propriété intellectuelle, Berne

Karl GRUNIG, Chef de la section administrative des brevets, Office fédéral de la propriété intellectuelle, Berne

TCHECOSLOVAQUIE/CZECHOSLOVAKIA

Michal GUTTMANN, Vice-President, Federal Office for Inventions, Prague

Marta HOSKOVA (Mrs.), Head of Department, Federal Office for Inventions, Prague

UNION SOVIÉTIQUE/SOVIET UNION

Alexander Vladimirovich SENCHIKHIN, Head, Department of International Patent Cooperation, All-Union Scientific Research Institute of State Patent Examination (VNIIGPE), USSR Patent Office, Moscow

II. ÉTATS OBSERVATEURS/OBSERVER STATES

BANGLADESH

Mohammed Ishaq TALUKDAR, Minister (Economic Affairs), Permanent Mission, Geneva

INDONÉSIE/INDONESIA

Etti HUSIN (Miss), Third Secretary, Permanent Mission, Geneva

MEXIQUE/MEXICO

Ismael NAVEJA, Deuxième secrétaire, Mission permanente, Genève

III. ORGANISATION INTERGOUVERNEMENTALE/
INTERGOVERNMENTAL ORGANIZATION

ORGANISATION EUROPÉENNE DES BREVETS/EUROPEAN PATENT
ORGANISATION

Larissa GRUSZOW (Mme), Administrateur principal, Affaires juridiques internationales,
Office européen des brevets, Munich

Brigitte GUNZEL (Mme), Juriste, Direction "Droit des brevets", Office européen des brevets,
Munich

Jacques VAN AUBEL, Chef de Groupe, Section de dépôt, Office européen des brevets,
Rijswijk

Bertil HJELM, Examineur, Direction générale 2, Office européen des brevets, Munich

Erich WAECKERLIN, Directeur, Direction générale 2, Office européen des brevets, Munich

IV. ORGANISATIONS NON GOUVERNEMENTALES/
NON-GOVERNMENTAL ORGANIZATIONS

Association internationale pour la protection de la propriété industrielle (AIPPI)/International
Association for the Protection of Industrial Property (AIPPI): Heinz BARDEHLE (Chairman
of PCT Committee; Patent Attorney, Munich); Michael N. MELLER (Patent Attorney, New
York)

Chambre de commerce internationale (CCI)/International Chamber of Commerce (ICC):
John H. KRAUS (Representative to the United Nations and other International Organizations
at Geneva)

Comité des instituts nationaux d'agents de brevets (CNIPA /Committee of National Institutes
of Patent Agents (CNIPA): Eugen POPP (Patent Attorney, Munich)

Fédération européenne des mandataires de l'industrie en propriété industrielle
(FEMIPPI)/European Federation of Agents of Industry in Industrial Property (FEMIPPI):
Reinhard KOCKLAUNER (Patentassessor, Hofheim)

Fédération internationale des conseils en propriété industrielle (FICPI)/International
Federation of Industrial Property Attorneys (FICPI): Knud RAFFNSØE (President of Study
and Works Commission; Patent Agent, Copenhagen)

Union des confédérations de l'industrie et des employeurs d'Europe (UNICE)/Union of
Industrial and Employers' Confederations of Europe (UNICE): Reinhard KOCKLAUNER
(Patentassessor, Hofheim)

V. BUREAU/OFFICERS

Président par interim/Acting Chairman: – le premier jour de la session/
on the first day of the session
Peter MESSERLI (Suisse/Switzerland)
– les autres jours de la session/
on the other days of the session
Leslie LEWIS (Royaume-Uni/United Kingdom)

Secrétaire/Secretary: Busso BARTELS (OMPI/WIPO)

VI. BUREAU INTERNATIONAL DE L'ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Arpad BOGSCH, Directeur général/Director General

François CURCHOD, Directeur du Cabinet du Directeur général/Director of the Office of the
Director General

Division de l'administration du PCT/PCT Administration Division: Daniel BOUCHEZ
(Directeur/Director); Teruhisa SHIMOMICHI

Division juridique du PCT/PCT Legal Division: Busso BARTELS (Directeur/Director);
Louis O. MAASSEL; Vitaly TROUSSOV; Philip THOMAS; Isabelle BOUTILLON (Mlle)

[L'annexe II suit/Annex II follows]

ANNEX II

AGENDA

adopted by the Assembly

1. Opening of the session by the Director General
2. Election of an Acting Chairman
3. Adoption of the agenda (this document)
4. Amendment of the Regulations under the PCT (documents PCT/A/XVIII/2 to 8)
5. Adoption of the report of the session
6. Closing of the session by the Acting Chairman

[Annex III follows]

ANNEX III

TEXT OF THE ADOPTED AMENDMENTS

Regulations under the Patent Cooperation Treaty

PART A

Introductory Rules

Rule 1
Abbreviated Expressions

[No change]

Rule 2
Interpretation of Certain Words

2.1 [Amendment to the French text only]

2.2 “Agent”

Whenever the word “agent” is used, it shall be construed as meaning an agent appointed under Rule 90.1, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used.*

2. 2bis “Common Representative”

Whenever the expression “common representative” is used, it shall be construed as meaning an applicant appointed as, or considered to be, the common representative under Rule 90.2.

2.3 [No change]

PART B

Rules Concerning Chapter I of the Treaty

Rule 3
The Request (Form)

3.1 Form of Request**

The request shall be made on a printed form or be presented as a computer print-out.

3.2 [No change]

* The amendment consists in deleting, at the end of the sentence, the words “, also the common representative referred to in Rule 4.8”.

** The title has been amended to read “Form of Request” instead of “Printed Form”.

3.3 Check List

(a) The request shall contain a list indicating:

(i) [No change]

(ii) [No change]

(iii) the number of that figure of the drawings which the applicant suggests should accompany the abstract when the abstract is published;* in exceptional cases, the applicant may suggest more than one figure.

(b) The list shall be completed by the applicant, failing which the receiving Office shall** make the necessary indications, except that the number referred to in paragraph (a)(iii) shall not be indicated by the receiving Office.

3.4 Particulars

Subject to Rule 3.3, particulars of the printed request form and of a request presented as a computer print-out shall be prescribed by the Administrative Instructions.

Rule 4 **The Request (Contents)**

4.1 Mandatory and Optional Contents; Signature

(a) [No change]

(b) The request shall, where applicable, contain:

(i) [No change]

(ii) [Amendment to the French text only]

(iii) [No change]

(iv) an indication that the applicant wishes to obtain a regional patent,**

(v) [No change]

(c) [No change]

(d) [No change]

* The amendment consists in deleting, after the word “published”, the words “on the front page of the pamphlet and in the Gazette”.

** The amendment consists in deleting, after the word “shall”, the words “fill it in and”.

*** The amendment consists in deleting, after the word “patent”, the words “and the names of the designated States for which he wishes to obtain such a patent”.

4.2 [No change]

4.3 [No change]

4.4 Names and Addresses

(a) [No change]

(b) [No change]

(c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. In order to allow rapid communication with the applicant, it is recommended to indicate any^{*} teleprinter address, telephone and facsimile machine numbers, or corresponding data for other like means of communication, of the applicant or, where applicable, the agent or the common representative.

(d) [No change]

4.5 The Applicant

(a) [No change]

(b) [No change]

(c) [No change]

(d) The request may, for different designated States, indicate different applicants. In such a case, the request shall indicate the applicant or applicants for each designated State or group of designated States.

4.6 [No change]

4.7 [No change]

4.8 Common Representative^{**}

If a common representative is designated, the request shall so indicate.

4.9 Designation of States

(a) Contracting States shall be designated in the request:

* The amendment consists in deleting, after the words “indicate any”, the words “telegraphic and”.

** The title has been amended to read “Common Representative” instead of “Representation of Several Applicants Not Having a Common Agent”.

(i) in the case of designations for the purpose of obtaining national patents, by an indication of each State concerned;

(ii) in the case of designations for the purpose of obtaining a regional patent, by an indication that a regional patent is desired either for all Contracting States which are party to the regional patent treaty concerned or only for such Contracting States as are specified.

(b) The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:

(i) at least one Contracting State is designated under paragraph (a), and

(ii) the request also contains a statement that any designation made under this paragraph is subject to confirmation as provided in paragraph (c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.

(c) The confirmation of any designation made under paragraph (b) shall be effected by

(i) filing with the receiving Office a written notice containing an indication as referred to in paragraph (a)(i) or (ii), and

(ii) paying to the receiving Office the designation fee and the confirmation fee referred to in Rule 15.5

within the time limit under paragraph (b)(ii)

4.10 Priority Claim

(a) [No change]

(b) If the request does not indicate both

(i) when the earlier application is not a regional or an international application, the country in which such earlier application⁺ was filed; when the earlier application is a regional or an international application, at least one country for which such earlier application⁺ was filed, and⁺

(ii) the date on which the earlier application was filed,

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made. However, where, resulting from an obvious error, the indication of the said country or the said date is missing or is erroneous, the receiving Office may, at the request of the applicant, make the necessary correction. The error shall be considered as an obvious error whenever the correction is obvious from a comparison with the earlier application. Where the error consists of the omission of the indication of the said date, the correction can only be made before the transmittal of the record copy to the International

⁺ Amendment to the English text only.

Bureau. In the case of any other error relating to the indication of the said date or in the case of any error relating to the indication of the said country, the correction can only be made before the expiration of the time limit under Rule 17.1(a) computed on the basis of the correct priority date.

(c) [No change]

(d) [No change]

(e) [No change]

4.11 [Amendment to the French text only]

4.12 [No change]

4.13 [Amendment to the French text only]

4.14 [Amendment to the French text only]

4.15 Signature

(a) Subject to paragraph (b), the request shall be signed by the applicant or, if there is more than one applicant, by all of them.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.

4.16 [No change]

4.17 [Amendment to the French text only]

Rule 5

The Description

5.1 Manner of the Description

(a) The description shall first state the title of the invention as appearing in the request and shall:

(i) [No change]

(ii) [Amendment to the French text only]

(iii) [No change]

(iv) [No change]

(v) [No change]

(vi) [No change]

(b) [No change]

(c) [No change]

5.2 Nucleotide and/or Amino Acid Sequence Disclosure

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 the Administrative Instructions.

Rule 6 The Claims

6.1 [No change]

6.2 [No change]

6.3 [No change]

6.4 Dependent Claims

(a) [Amendment to the French text only]

(b) [No change]

(c) [No change]

6.5 [No change]

Rule 7 The Drawings

[No change]

Rule 8 The Abstract

[No change]

Rule 9 Expressions, Etc., Not to Be Used

[No change]

Rule 10
Terminology and Signs

[No change]

Rule 11
Physical Requirements of the International Application

11.1 [No change]

11.2 [No change]

11.3 [No change]

11.4 [No change]

11.5 [No change]

11.6 Margins

(a) The minimum margins of the sheets containing^{*} the description, the claims, and the abstract, shall be as follows:

- top: 2 cm
- left side: 2.5 cm
- right side: 2 cm
- bottom: 2 cm

(b) [No change]

(c) [No change]

(d) [No change]

(e) Subject to paragraph (f) and to Rule 11.8(b), the margins of the international application, when submitted, must be completely blank.

(f) The top margin may contain in the left-hand corner an indication of the applicant's file reference, provided that the reference appears within 1.5 cm from the top of the sheet. The number of characters in the applicant's file reference shall not exceed the maximum fixed by the Administrative Instructions.

11.7 Numbering of Sheets

(a) [No change]

(b) The numbers shall be centered at the top or bottom of the sheet,^{**} but shall not be placed in the margin.

^{*} The amendment consists in deleting, after the word “containing”, the words “the request,”.

^{**} The amendment consists in deleting, after the word “sheet”, the words “in the middle,”.

11.8 Numbering of Lines

- (a) [No change]
- (b) The numbers should appear in the right half of the left margin.

11.9 [No change]

11.10 Drawings, Formulae, and Tables, in Text Matter

- (a) [No change]
- (b) [No change]
- (c) [No change]
- (d) [Amendment to the French text only]

11.11 [No change]

11.12 [No change]

11.13 [No change]

11.14 [No change]

Rule 12
Language of the International Application

12.1 Admitted Languages

- (a) [No change]
- (b) Notwithstanding paragraph (a), the request, any text matter of the drawings, and the abstract need not be in the same language as other elements of the international application, provided that:
 - (i) the request is in a language admitted under paragraph (a) or in the language in which the international application is to be published;
 - (ii) the text matter of the drawings is in the language in which the international application is to be published;
 - (iii) the abstract is in the language in which the international application is to be published.
- (c) [No change]
- (d) [No change]

12.2 [No change]

Rule 13 **Unity of Invention**

13.1 [No change]

13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled*

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

13.3 Determination of Unity of Invention Not Affected by Manner of Claiming**

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

13.4 [No change]

13.5 [No change]

Rule 13bis **Microbiological Inventions**

[No change]

Rule 13ter **Nucleotide and/or Amino Acid Sequence Listings**

13ter.1 Sequence Listing for International Authorities

(a) If the International Searching Authority finds that a nucleotide and/or amino acid sequence listing does not comply with the standard prescribed in the Administrative Instructions under Rule 5.2, and/or is not in a machine readable form provided for in those Instructions, it may invite the applicant, within a time limit fixed in the invitation, as the case may be:

* The title has been amended to read “Circumstances in Which the Requirement of Unity of Invention Is to be Considered Fulfilled” instead of “Claims of Different Categories”.

** The title has been amended to read “Determination of Unity of Invention Not Affected by Manner of Claiming” instead of “Claims of One and the Same Category”.

(i) to furnish to it a listing of the sequence complying with the prescribed standard, and/or

(ii) to furnish to it a listing of the sequence in a machine readable form provided for in the Administrative Instructions or, if that Authority is prepared to transcribe the sequence listing into such a form, to pay for the cost of such transcription.

(b) any sequence listing 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.

(c) If the applicant does not comply with the invitation within the time limit fixed in the invitation, the International Searching Authority shall not be required to search the international application to the extent that such non-compliance has the result that a meaningful search cannot be carried out.

(d) If the International Searching Authority chooses, under paragraph (a)(ii), to transcribe the sequence listing into a machine readable form, it shall send a copy of such transcription in machine readable form to the applicant.

(e) The International Searching Authority shall, upon request, make available to the International Preliminary Examining Authority a copy of any sequence listing furnished to it, or as transcribed by it, under paragraph (a).

(f) A sequence listing furnished to the International Searching Authority, or as transcribed by it, under paragraph (a) shall not form part of the international application.

13ter.2 Sequence Listing for Designated Office

(a) Once the processing of the international application has started before a designated Office, that Office may require the applicant to furnish to it a copy of any sequence listing furnished to the International Searching Authority, or as transcribed by that Authority, under Rule 13ter.1(a).

(b) If a designated Office finds that a nucleotide and/or amino acid sequence listing does not comply with the standard prescribed in the Administrative Instructions under Rule 5.2, and/or is not in a machine readable form provided for in those Instructions, and/or no listing of the sequence was furnished to the International Searching Authority, or transcribed by that Authority, under Rule 13ter.1(a), that Office may require the applicant:

(i) to furnish to it a listing of the sequence complying with the prescribed standard, and/or

(ii) to furnish to it a listing of the sequence in a machine readable form provided for in the Administrative Instructions or, if that Office is prepared to transcribe the sequence listing into such a form, to pay for the cost of such transcription.

Rule 14 The Transmittal Fee

[No change]

Rule 15
The International Fee

15.1 Basic Fee and Designation Fee

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau (“international fee”) to be collected by the receiving Office and consisting of,

(i) a “basic fee,” and

(ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a) by the applicant in the international application, except that, where Article 44 applies in respect of a designation, only one designation fee shall be due for that designation.

15.2 [No change]

15.3 [No change]

15.4 Time of Payment

(a) [No change]

(b) [No change]

(c) [No change]

(d) [Deleted]

15.5 Fees under Rule 4.9(c)

(a) Notwithstanding Rule 15.4(b), the confirmation under Rule 4.9(c) of any designations made under Rule 4.9(b) shall be subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office), as set out in the Schedule of Fees.

(b) Where moneys paid by the applicant within the time limit under Rule 4.9(b)(ii) are not sufficient to cover the fees due under paragraph (a), the receiving Office shall allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.

15.6 Refund

The receiving Office shall refund the international fee to the applicant:

(i) if the determination under Article 11(1) is negative, or

(ii) if, before the transmittal of the record copy to the International Bureau, the international application is withdrawn or considered withdrawn.

Rule 16
The Search Fee

16.1 [No change]

16.2 Refund

The receiving Office shall refund the search fee to the applicant:

- (i) if the determination under Article 11(1) is negative, or
- (ii) if, before the transmittal of the search copy to the International Searching Authority, the international application is withdrawn or considered withdrawn.

16.3 [No change]

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 Rule 14.1(b), Rule 15.4(a) and Rule 16.1(f), the receiving Office finds that in respect of an international application no fees were paid to it by the applicant, or that the amount paid to it by the applicant is less than what is necessary to cover the transmittal fee, the basic fee and the search fee, the receiving Office shall 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 one month from the date of the invitation.

(b) Where, by the time they are due under Rule 15.4(b), the receiving Office finds that in respect of an international application the payment made by the applicant is insufficient to cover the designation fees necessary to cover all the designations under Rule 4.9(a), the receiving Office shall 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 one month from the date of the invitation.

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) or (b) and the applicant has not, within one month from the date of the invitation, paid in full the amount due, including, where applicable, the late payment fee under Rule 16bis.2, the receiving Office shall:

- (i) allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions,

* The title has been amended to read “Extension of Time Limits for Payment of Fees” instead of “Advancing Fees by the International Bureau”.

** The title has been amended to read “Invitation by the Receiving Office” instead of “Guarantee by the International Bureau”.

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

(iii) proceed as provided in Rule 29.

16bis.2 Late Payment Fee***

(a) The payment of fees in response to an invitation under Rule 16bis.1(a) or (b) may be subjected by the receiving Office to the payment to it of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation,
or,

(ii) if the amount calculated under item (i) is less than the transmittal fee,
an amount equal to the transmittal fee.

(b) The amount of the late payment fee shall not, however, exceed the amount of the basic fee.

(c) [Deleted]

Rule 17
The Priority Document

17.1 [No change]

17.2 Availability of Copies

(a) [No change]

(b) [No change]

(c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

(i) the international application was withdrawn,

(ii) the relevant priority claim was withdrawn or was considered, under Rule 4.10(b), not to have been made, or

(iii) the relevant declaration under Article 8(1) was cancelled under Rule 4.10(d).

(d) Paragraphs (a) to (c) shall apply also to any earlier international application whose priority is claimed in the subsequent international application.

*** The title has been amended to read “Late Payment Fee” instead of “Obligations of the Applicant, Etc.”.

Rule 18

The Applicant

18.1 [No change]

18.2 [No change]

18.3 Two or More Applicants^{*}

If there are two or more applicants, the right to file an international application shall exist if at least one of them is entitled to file an international application according to Article 9.

18.4 Information on Requirements Under National Law as to Applicants^{**}

(a) [Deleted]

(b) [Deleted]

(c) [No change]

Rule 19

The Competent Receiving Office

19.1 Where to File

(a) [No change]

(b) [Amendment to the French text only]

(c) [No change]

19.2 Two or More Applicants⁺

If there are two or more applicants⁺⁺, the requirements of Rule 19.1 shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national.

19.3 [No change]

* The title has been amended to read “Two or More Applicants” instead of “Several Applicants: Same for All Designated States”.

** The title has been amended to read “Information on Requirements Under National Law as to Applicants” instead of “Several Applicants: Different for Different Designated States” .

+ The title has been amended, in English only, to read “Two or More Applicants” instead of “Several Applicants”.

++ Amendment to the English text only. Another amendment is made to the French text only; see the French version of this document.

Rule 20
Receipt of the International Application

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) [No change]

20.2 Receipt on Different Days

(a) [Amendment to the French text only]

(b) [No change]

20.3 [No change]

20.3bis [Deleted]

20.4 Determination under Article 11(1)

(a) [Amendment to the French text only]

(b) [No change]

(c) For the purposes of Article 11(1)(ii), it shall be sufficient that the elements referred to in Article 11(1)(iii)(d) and (e) be in a language admitted under Rule 12.1(a) or (c).

(d) If, on July 12, 1991, 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, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

20.5 Positive Determination

(a) If the determination under Article 11(1) is positive, the receiving Office shall stamp on the request the name of the receiving Office and the words “PCT International Application,” or “Demande internationale PCT.” If the official language of the receiving Office is neither English nor French, the words “International Application” or “Demande internationale” may be accompanied by a translation of these words in the official language of the receiving Office.

(b) The copy whose request⁺ has been so stamped shall be the record copy of the international application.⁺

* The amendment consists in deleting after the word “request” the word “form”.

(c) [No change]

20.6 [No change]

20.7 [No change]

20.8 [No change]

20.9 [No change]

Rule 21
Preparation of Copies

[No change]

Rule 22
Transmittal of the Record Copy

[No change]

Rule 23
Transmittal of the Search Copy

23.1 Procedure

(a) 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) [Deleted]

Rule 24
Receipt of the Record Copy by the International Bureau

24.1 [Remains deleted]

24.2 Notification of Receipt of the Record Copy

(a) The International Bureau shall promptly notify:

(i) the applicant,

[Footnote continued from previous page]

⁺ Amendment to the English text only

(ii) the receiving Office, and

(iii) the International Searching Authority (unless it has informed the International Bureau that it wishes not to be so notified),

of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant*, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the States designated under Rule 4.9(a) and, where applicable, of those States whose designations have been confirmed under Rule 4.9(c).

(b) Each designated Office which has informed the International Bureau that it wishes to receive the notification under paragraph (a) prior to the communication under Rule 47.1 shall be so notified by the International Bureau:

(i) if the designation concerned was made under Rule 4.9(a), promptly after the receipt of the record copy;

(ii) if the designation concerned was made under Rule 4.9(b), promptly after the International Bureau has been informed by the receiving Office of the confirmation of that designation.

(c) If the record copy is received after the expiration of the time limit fixed in Rule 22.3, the International Bureau shall promptly notify the applicant, the receiving Office, and the International Searching Authority, accordingly.

Rule 25

Receipt of the Search Copy by the International Searching Authority

[No change]

Rule 26

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

26.1 [No change]

26.2 [No change]

26.3 [No change]

26.3bis [No change]

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

* The amendment consists in deleting, after the word “applicant”, the words “, and the name of the receiving Office”.

(a) Where any element of the international application, other than those referred to in Article 11(1)(iii)(d) and (e), does not comply with Rule 12.1, the receiving Office shall invite the applicant to file the required correction. Rules 26.1 a, 26.2, 26.5 and 29.1 shall apply *mutatis mutandis*.

(b) If, on July 12, 1991, paragraph (a) is not compatible with the national law applied by the receiving Office, paragraph (a) 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, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

26.4 [No change]

26.5 [No change]

26.6 [No change]

Rule 27

Lack of Payment of Fees

27.1 Fees

(a) For the purposes of Article 14(3)(a), “fees prescribed under Article 3(4)(iv)” means: the transmittal fee (Rule 14), the basic fee part of the international fee (Rule 15.1(i)),* the search fee (Rule 16), and, where required, the late payment fee (Rule 16bis.2).

(b) For the purposes of Article 14(3)(a) and (b), “the fee prescribed under Article 4(2)” means the designation fee part of the international fee (Rule 15.1(ii)) and, where required, the late payment fee (Rule 16bis.2).

Rule 28

Defects Noted by the International Bureau

[No change]

Rule 29

International Applications or Designations Considered Withdrawn under Article 14(1), (3) or (4)

29.1 Finding by Receiving Office

(a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), that the international application is considered withdrawn:

* The amendment consists in deleting the word “and” after the comma.

(i) [No change]

(ii) the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration, and the International Bureau shall in turn notify each designated Office which has already been notified of its designation;

(iii) [No change]

(iv) [No change]

(b) If the receiving Office declares under Article 14(3)(b) (failure to pay the prescribed designation fee under Rule 27.1(b)) that the designation of any given State is considered withdrawn, the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration. The International Bureau shall in turn notify each designated Office which has already been notified of its designation.

29.2 [Remains deleted]

29.3 [No change]

29.4 [No change]

Rule 30
Time Limit under Article 14(4)

[No change]

Rule 31
Copies Required under Article 13

[No change]

Rule 32
[Deleted]

Rule 32bis
[Deleted]

Rule 33
Relevant Prior Art for the International Search

33.1 Relevant Prior Art for the International Search

(a) [No change]

(b) When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

(c) Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report.

33.2 [No change]

33.3 [No change]

Rule 34 **Minimum Documentation**

[No change]

Rule 35 **The Competent International Searching Authority**

[No change]

Rule 36 **Minimum Requirements for International Searching Authorities**

36.1 Definition of Minimum Requirements

The minimum requirements referred to in Article 16(3)(c) shall be the following:

(i) [No change]

(ii) that Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media;

(iii) [No change]

Rule 37 **Missing or Defective Title**

[No change]

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 (in the language in which the international application is published).*

(b) The applicant may, within one month from the date of mailing of the international search report, submit comments on the abstract established by the International Searching Authority. Where that Authority amends the abstract established by it, it shall notify the amendment to the International Bureau.

Rule 39
Subject Matter under Article 17(2)(a)(i)

[No change]

Rule 40
Lack of Unity of Invention (International Search)

40.1 [No change]

40.2 Additional Fees

(a) [No change]

(b) [No change]

(c) [No change]

(d) [No change]

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the three-member board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified.

⁺ The title has been amended, in English only, to read “Missing or Defective Abstract” instead of “Missing Abstract”.

^{*} The amendment consists in deleting the second sentence.

40.3 [No change]

Rule 41
Earlier Search Other Than International Search
[No change]

Rule 42
Time Limit for International Search

[No change]

Rule 43
The International Search Report

43.1 Identifications

The international search report shall identify the International Searching Authority which established it by indicating the name of such Authority, and the international application by indicating the international application number, the name of the applicant,^{*} and the international filing date.

43.2 Dates

The international search report shall be dated and shall indicate the date on which the international search was actually completed. It shall also indicate the filing date of any earlier application whose priority is claimed or, if the priority of more than one earlier application is claimed, the filing date of the earliest among them.

43.3 [No change]

43.4 [No change]

43.5 Citations

(a) [No change]

(b) [Amendment to the French text only]

(c) [No change]

(d) [No change]

(e) If only certain passages of the cited document are relevant or particularly relevant, they shall be identified, for example, by indicating the page, the column, or the lines, where

^{*} The amendment consists in deleting, after the word “applicant”, the words “the name of the receiving Office, ”.

the passage appears. If the entire document is relevant but some passages are of particular relevance, such passages shall be identified unless such identification is not practicable.

43.6 Fields Searched

(a) [Amendment to the French text only]

(b) [Amendment to the French text only]

(c) If the international search was based on, or was extended to, any electronic data base, the international search report may indicate the name of the data base and, where considered useful to others and practicable, the search terms used.

43.7 Remarks Concerning Unity of Invention

If the applicant paid additional fees for the international search, the international search report shall so indicate. Furthermore, where the international search was made on the main invention only or on less than all the inventions (Article 17(3)(a)), the international search report shall indicate what parts of the international application were and what parts were not searched.

43.8 Authorized Officer^{*}

The international search report shall indicate the name of the officer of the International Searching Authority responsible for that report.

43.9 Additional Matter^{**}

The international search report shall contain no matter other than that specified in Rules 33.1(b) and (c), 43.1 to 43.3, 43.5 to 43.8, and 44.2(a),^{***} and the indication referred to in Article 17(2)(b), provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. The international search report shall not contain, and the Administrative Instructions shall not permit the inclusion of, any expressions of opinion, reasoning, arguments, or explanations.

43.10 [No change]

Rule 44 **Transmittal of the International Search Report, Etc.**

44.1 [No change]

44.2 Title or Abstract

* The title has been amended to read “Authorized Officer” instead of “Signature”.

** The title has been amended to read “Additional Matter” instead of “No Other Matter”.

*** The amendment consists in deleting the words “and (b)” after “44.2(a)”.

(a) The international search report shall either state that the International Searching Authority approves the title and the abstract as submitted by the applicant or be accompanied by the text of the title and/or abstract as established by the International Searching Authority under Rules 37 and 38.

(b) [Deleted]

(c) [Deleted]

44.3 Copies of Cited Documents.

(a) [No change]

(b) [No change]

(c) [Deleted]

(d) Any International Searching Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

Rule 45 **Translation of the International Search Report**

[No change]

Rule 46 **Amendment of Claims before the International Bureau**

46.1 [No change]

46.2 Where to File

Amendments made under Article 19 shall be filed directly with the International Bureau.

46.3 [No change]

46.4 [No change]

46.5 [No change]

Rule 47 **Communication to Designated Offices**

47.1 Procedure

(a) [No change]

(a-bis) The International Bureau shall notify each designated Office, at the time of the communication provided for in Article 20, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document. Such notification shall also be sent to any designated Office which has waived the communication provided for in Article 20, unless such Office has also waived the notification of its designation.

(b) [No change]

(c) [Amendment to the French text only]

(d) [No change]

(e) [Amendment to the French text only]

47.2 [No change]

47.3 [No change]

47.4 Express Request under Article 23(2)

Where the applicant makes an express request to a designated Office under Article 23(2) before the communication provided for in Article 20 has taken place, the International Bureau shall, upon request of the applicant or the designated Office, promptly effect that communication to that Office.

Rule 48

International Publication

48.1 [No change]

48.2 Contents

(a) The pamphlet shall contain:

(i) [No change]

(ii) [No change]

(iii) [No change]

(iv) [No change]

(v) [No change]

(vi) [No change]

(vii) [No change, except the period is replaced by a comma]

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

(b) [No change]

(c) [No change]

(d) [No change]

(e) [No change]

(f) [No change]

(g) [No change]

(h) [No change]

(i) [No change]

48.3 [No change]

48.4 [No change]

48.5 [No change]

48.6 Announcing of Certain Facts

(a) [No change]

(b) [Remains deleted]

(c) If the international application, the designation of any designated State or the priority claim is withdrawn under Rule 90bis after the technical preparations for international publication have been completed, notice of the withdrawal shall be published in the Gazette.

Rule 49 **Copy, Translation and Fee under Article 22**

49.1 [No change]

49.2 [No change]

49.3 [No change]

49.4 [No change]

49.5 Contents of and Physical Requirements for the Translation

(a) For the purposes of Article 22, the translation of the international application shall contain the description, the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b), (c-bis) and (e),

(i) [No change]

(ii) [No change]

(iii) [No change]

(b) [No change]

(c) [No change]

(c-bis) Where the applicant furnishes, to a designated Office which requires under paragraph (a)(ii) a translation of both the claims as filed and the claims as amended, only one of the required two translations, the designated Office may disregard the claims of which a translation has not been furnished or invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the designated Office chooses to invite the applicant to furnish the missing translation and the latter is not furnished within the time limit fixed in the invitation, the designated Office may disregard those claims of which a translation has not been furnished or consider the international application withdrawn.

(d) [No change]

(e) Any designated Office requiring under paragraph (a) the furnishing of a copy of the drawings shall, where the applicant failed to furnish such copy within the time limit applicable under Article 22,^{*} invite the applicant to furnish such copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.^{**}

(f) [No change]

(g) [No change]

(h) Where the applicant did not furnish a translation of the abstract or of any indication furnished under Rule 13bis.4, the designated Office shall invite the applicant to furnish such translation, if it deems it to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

(i) [No change]

(j) [No change]

(k) Where a title has been established by the International Searching Authority pursuant to Rule 37.2, the translation shall contain the title as established by that Authority.

(l) If, on July 12, 1991, paragraph (c-bis) or paragraph (k) is not compatible with the national law applied by the designated Office, the paragraph concerned shall not apply to that designated 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, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

* The amendment consists in deleting, after the words "Article 22," "(i)".

** The amendment consists in deleting, after the word "invitation", " , or" and the entire item (ii).

Rule 50
Faculty under Article 22(3)

[No change]

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 Rules 20.7(i), 24.2(c), 29.1(a)(ii), or 29.1(b).

51.2 [No change]

51.3 [No change]

Rule 51bis
Certain National Requirements Allowed under Article 27(1), (2), (6) and (7)

51bis.1 Certain National Requirements Allowed

- (a) [No change]
- (b) [Amendment to the French text only]
- (c) [No change]
- (d) [Amendment to the French text only]

51bis.2 Opportunity to Comply with National Requirements

- (a) [No change]
- (b) [No change]
- (c) [Deleted]

Rule 52
Amendment of the Claims, the Description, and the Drawings, before Designated Offices

[No change]

PART C
Rules Concerning Chapter II of the Treaty

Rule 53
The Demand

53.1 Form

(a) The demand shall be made on a printed form or be presented as a computer print-out. The particulars of the printed form and of a demand presented as a computer print-out shall be prescribed by the Administrative Instructions.

(b) Copies of printed demand forms shall be furnished free of charge by the receiving Office or by the International Preliminary Examining Authority.

(c) [Deleted]

53.2 Contents

(a) The demand shall contain:

(i) [No change]

(ii) [No change]

(iii) [No change]

(iv) [No change, except the period is replaced by a comma]

(v) where applicable, a statement concerning amendments.

(b) [No change]

53.3 [No change]

53.4 The Applicant

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply *mutatis mutandis*. Only applicants for the elected States are required to be indicated in the demand.

53.5 Agent or Common Representative*

If an agent or common representative is designated, the demand shall so indicate. Rules 4.4** and 4.16 shall apply, and Rule 4.7 shall apply *mutatis mutandis*.

* The title has been amended to read “Agent or Common Representative” instead of “The Agent”.
** The amendment consists in deleting “, 4.7,” after “Rules 4.4”.

53.6 Identification of the International Application

The international application shall be identified by* the name and address of the applicant, the title of the invention,** the international filing date (if known to the applicant) and the international application number or, where such number is not known to the applicant, the name of the receiving Office with which the international application was filed.

53.7 Election of States

(a) 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.

(b) Election of Contracting States in the demand shall be made:

(i) by an indication that all eligible States are elected, or,

(ii) in the case of States which have been designated for the purpose of obtaining national patents, by an indication of those eligible States that are elected, and, in the case of States which have been designated for the purpose of obtaining a regional patent, by an indication of the regional patent concerned together with either an indication that all eligible States party to the regional patent treaty concerned are elected or an indication of those among the said States that are elected.

53.8 Signature

(a) Subject to paragraph (b), the demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.

(b) Where two or more applicants file a demand which elects a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the demand or could not be found or reached after diligent effort, the demand need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and

(i) a statement is furnished explaining, to the satisfaction of the International Preliminary Examining Authority, the lack of signature of the applicant concerned, or

(ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with.

53.9 Statement Concerning Amendments

(a) If amendments under Article 19 have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments

* The amendment consists in deleting, after the word “by”, the words “the name of the receiving Office with which the international application was filed.”.

** The amendment consists in deleting, after the word “invention”, the words “and, where”.

(i) to be taken into account, in which case a copy of the amendments shall preferably be submitted with the demand, or

(ii) to be considered as reversed by an amendment under Article 34.

(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 the applicant wishes the start of the international preliminary examination to be postponed in accordance with Rule 69.1(d).

(c) If any amendments under Article 34 are submitted with the demand, the statement shall so indicate.

Rule 54 **The Applicant Entitled to Make a Demand**

54.1 [No change]

54.2 Two or More Applicants^{*}

If there are two or more applicants, the right to make a demand under Article 31(2) shall exist if at least one of the applicants making the demand 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) [Amendment to the French text only]

54.3 [Deleted]

54.4 Applicant Not Entitled to Make a Demand^{**}

(a) If the applicant does not have the right to make a demand or, in the case of two or more applicants, if none of them has the right to make a demand under Rule 54.2, the demand shall be considered not to have been submitted.

(b) [Deleted]

Rule 55 **Languages (International Preliminary Examination)**

[No change]

* The title has been amended to read “Two or More Applicants” instead of “Several Applicants: Same for All Elected States”.

** The amendment to the title consists in deleting, at the end, the words “or an Election”.

Rule 56

Later Elections

56.1 Elections Submitted Later Than the Demand

(a) The election of States subsequent to the submission of the demand (“later election”) shall be effected by a notice* submitted to the International Bureau. The notice shall identify the international application and the demand, and shall include an indication as referred to in Rule 53.7(b)(ii).

(b) Subject to paragraph (c), the notice referred to in paragraph (a) shall be signed by the applicant for the elected States concerned or, if there is more than one applicant for those States, by all of them.

(c) Where two or more applicants file a notice effecting a later election of a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the notice or could not be found or reached after diligent effort, the notice need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and

(i) a statement is furnished explaining, to the satisfaction of the International Bureau, the lack of signature of the applicant concerned, or

(ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or did not sign the demand but the requirements of Rule 53.8(b) were complied with.

(d) An applicant for a State elected by a later election need not have been indicated as an applicant in the demand.

(e) If a notice effecting a later election is submitted after the expiration of 19 months from the priority date, the International Bureau shall notify the applicant that the election does not have the effect provided for under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in respect of the elected Office concerned within the time limit applicable under Article 22.

(f) If, notwithstanding paragraph (a), a notice effecting a later election is submitted by the applicant to the International Preliminary Examining Authority rather than the International Bureau, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

56.2 [Amendment to the French text only]

56.3 [Amendment to the French text only]

56.4 Form of Later Elections

* The amendment consists in deleting, after the word “notice”, the words “signed and”.

The notice effecting the later election shall* preferably be worded as follows: "In relation to the international application filed with ...on ... under No. ...by ...(applicant) (and the demand for international preliminary examination submitted on ...to ...), the undersigned elects the following additional State(s) under Article 31 of the Patent Cooperation Treaty: ..."

56.5 [No change]

Rule 57 **The Handling Fee**

57.1 Requirement to Pay

- (a) [No change]
- (b) [~~Deleted~~]

57.2 Amount**

- (a) The amount of the handling fee is as set out in the Schedule of Fees.***
- (b) [~~Deleted~~]
- (c) [No change]
- (d) [No change]
- (e) [No change]

57.3 Time and Mode of Payment

- (a) [Amendment to the French text only]
- (b) [~~Deleted~~]
- (c) [Amendment to the French text only]
- (d) [~~Deleted~~]

57.4 Failure to Pay****

- (a) [No change]

*

The amendment consists in deleting, after the words "election shall", the words "preferably be made on a printed form furnished free of charge to applicants. If it is not made on such a form, it shall".

**

The title has been amended to read "Amount" instead of "Amounts of the Handling Fee and the Supplement to the Handling Fee".

The amendment consists in deleting the second sentence.

The amendment consists in deleting, at the end of the title, the words " (Handling Fee)".

(b) [No change]

(c) [No change]

57.5 [Deleted]

57.6 Refund

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

(i) if the demand is withdrawn before the demand has been sent by that Authority to the International Bureau, or

(ii) if the demand is considered, under Rule 54.4(a), not to have been submitted.

Rule 58

The Preliminary Examination Fee

[No change]

Rule 59

The Competent International Preliminary Examining Authority

59.1 Demands under Article 31(2)(a)

For demands made under Article 31(2)(a), each receiving Office of or acting for a Contracting State bound by the provisions of Chapter II shall, in accordance with the terms of the applicable agreement referred to in Article 32(2) and (3), inform the International Bureau which International Preliminary Examining Authority is or which International Preliminary Examining Authorities are competent for the international preliminary examination of international applications filed with it. The International Bureau shall promptly publish such information. Where several International Preliminary Examining Authorities are competent, the provisions of Rule 35.2 shall apply *mutatis mutandis*.

59.2 [No change]

Rule 60

Certain Defects in the Demand or Elections

60.1 Defects in the Demand

(a) If the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to 53.8 and 55, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted contained at least one election and permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

(c) Subject to paragraph (d), if the applicant does not comply with the Invitation within the time limit under paragraph (a), the demand shall be considered as if it had not been submitted.

(d) Where, after the expiration of the time limit under paragraph (a), a signature required under Rule 53.8 or a prescribed indication is lacking in respect of an applicant for a certain elected State, the election of that State shall be considered as if it had not been made.

(e) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in paragraphs (a) to (d).

(f) If the demand does not contain a statement concerning amendments, the International Preliminary Examining Authority shall proceed as provided for in Rules 66.1 and 69.1(a) or (b).

(g) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall invite the applicant to submit the amendments within a time limit fixed in the invitation and shall proceed as provided for in Rule 69.1(e).

60. 2 Defects in Later Elections

(a) If the notice effecting a later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Bureau at any time before a decision is taken.

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had been received on the actual filing date, provided that the notice as submitted contained at least one election and permitted the international application to be identified; otherwise, the notice shall be considered as if it had been received on the date on which the International Bureau receives the correction.

(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had not been submitted.

(d) Where, in respect of an applicant for a certain elected State, the signature required under Rule 56.1(b) and (c) or the name or address is lacking after the expiration of the time limit under paragraph (a), the later election of that State shall be considered as if it had not been made.

Rule 61
Notification of the Demand and Elections

61.1 Notification to the International Bureau and the Applicant*

(a) [No change]

(b) The International Preliminary Examining Authority shall promptly inform the applicant in writing of the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 57.4(c), 58.2(c) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 60.1(d) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) The International Bureau shall promptly notify** the applicant of the receipt, and the date of receipt, of any notice effecting a later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b). Where the notice has been considered under Rule*** 60.2(c) as if it had not been submitted or where a later election has been considered under Rule 60.2(d) as if it had not been made, the International Bureau shall notify the applicant accordingly.

61.2 Notification to the Elected Offices****

(a) [No change]

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant,***** the filing date of the application whose priority is claimed (where priority is claimed), the date of receipt by the International Preliminary Examining Authority of the demand, and--in the case of a later election--the date of receipt***** of the notice effecting the later election. The latter date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b).

(c) The notification shall be sent to the elected Office together with the communication provided for in Article 20. Elections effected after such communication shall be notified promptly after they have been made.

* The title has been amended to read "Notification to the International Bureau and the Applicant" instead of "Notifications to the International Bureau, the Applicant, and the International Preliminary Examining Authority".

** The amendment consists in deleting, after the word "notify", the words "the International Preliminary Examining Authority and".

*** The amendment consists in deleting the words "Rules 57.5(c) or".

**** The title has been amended to read "Notification to the Elected Offices" instead of "Notifications to the Elected Offices".

***** The amendment consists in deleting, after the word "applicant", the words "the name of the receiving Office,".

***** The amendment consists in deleting, after the word "receipt", the words "by the International Bureau".

(d) Where the applicant makes an express request to an elected Office under Article 40(2) before the communication provided for in Article 20 has taken place, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect that communication to that Office.

61.3 Information for the Applicant

The International Bureau shall inform the applicant in writing of the notification referred to in Rule 61.2 and of the elected Offices notified under Article 31(7).

61.4 Publication in the Gazette

Where a demand has been filed prior to the expiration of the 19th month from the priority date, the International Bureau shall publish a notice of that fact in the Gazette promptly after the filing of the demand, but not before the international publication of the international application. The notice shall indicate all designated States bound by Chapter II which have not been elected.

Rule 62 **Copy of Amendments Under Article 19 for the** **International Preliminary Examining Authority***

62.1 Amendments Made before the Demand is Filed

Upon receipt of a demand from the International Preliminary Examining Authority, the International Bureau shall promptly transmit a copy of any amendments under Article 19 to that Authority, unless that Authority has indicated that it has already received such a copy.

62.2 Amendments Made after the Demand is Filed**

(a) If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority. In an case, the International Bureau shall promptly transmit a copy of such amendments to that Authority.

(b) [Deleted]

Rule 63 **Minimum Requirements for International Preliminary Examining Authorities**

[No change]

* The title has been amended to read “Copy of Amendments Under Article 19 for the International Preliminary Examining Authority” instead of “Copy for the International Preliminary Examining Authority”.

** The title has been amended to read “Amendments Made after the Demand is Filed” instead of “Amendments”.

Rule 64
Prior Art for International Preliminary Examination

64.1 [No change]

64.2 Non-Written Disclosures

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

64.3 Certain Published Documents

In cases where any application or any patent which would constitute prior art for the purposes of Article 33(2) and (3) had it been published prior to the relevant date referred to in Rule 64.1 was published on a date which is the same as, or later than, the relevant date but was filed earlier than the relevant date or claimed the priority of an earlier application which had been filed prior to the relevant date, such published application or patent shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such application or patent in the manner provided for in Rule 70.10.

Rule 65
Inventive Step or Non-Obviousness

[No change)

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 Basis of the International Preliminary Examination

(a) Subject to paragraphs (b) to (d), the international preliminary examination shall be based on the international application as filed.

(b) The applicant may submit amendments under Article 34 at the time of filing the demand or, subject to Rule 66.4bis, until the international preliminary examination report is established.

(c) Any amendments under Article 19 made before the demand was filed shall be taken into account for the purposes of the international preliminary examination unless superseded, or considered as reversed, by an amendment under Article 34.

(d) Any amendments under Article 19 made after the demand was filed and any amendments under Article 34 submitted to the International Preliminary Examining Authority shall, subject to Rule 66.4bis, be taken into account for the purposes of the international preliminary examination.

(e) Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

66.2 First Written Opinion of the International Preliminary Examining Authority

(a) If the International Preliminary Examining Authority

(i) considers that any of the situations referred to in Article 34(4) exists,

(ii) [No change]

(iii) [No change]

(iv) considers that any amendment goes beyond the disclosure in the international application as filed,^{*}

(v) [No change]

(vi) considers that a claim relates to an invention in respect of which no international search report has been established and has decided not to carry out the international preliminary examination in respect of that claim, or

(vii) considers that a nucleotide and or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

(b) [No change]

(c) [No change]

(d) The notification shall fix a time limit for the reply. The time limit shall be reasonable under the circumstances. It shall normally be two months after the date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. It shall not be more than three months after the said date but may be extended if the applicant so requests before its expiration.

66.3 [No change]

* The amendment consists in deleting the word “or”.

66.4 Additional Opportunity for Submitting Amendments or Arguments

- (a) [Amendment to the French text only]
- (b) [No change]

66.4bis Consideration of Amendments and Arguments

Amendments or arguments need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received after that Authority has begun to draw up that opinion or report.

66.5 [No change]

66.6 [No change]

66.7 [No change]

66.8 Form of Amendments

(a) The applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. Where the amendment consists in the deletion of passages or in minor alterations or additions, it may be made on a copy of the relevant sheet of the international application, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.

- (b) [Remains deleted]

66.9 [No change]

Rule 67
Subject Matter under Article 34(4)(a)(i)

[No change]

Rule 68
Lack of Unity of Invention (International Preliminary Examination)

68.1 No Invitation to Restrict or Pay

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses not to invite the applicant to restrict the claims or to pay additional fees, it shall proceed with the international preliminary

examination^{*}, subject to Article 34(4)(b) and Rule 66.1(e), in respect of the entire international application, but shall indicate, in any written opinion and in the international preliminary examination report, that it considers that the requirement of unity of invention is not fulfilled and it shall specify the reasons therefor.

68.2 [Amendment to the French text only]

68.3 Additional Fees

(a) [No change]

(b) [No change]

(c) [No change]

(d) [No change]

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the three-member board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified.

68.4 [No change]

68.5 [No change]

Rule 69
Start of and Time Limit for International Preliminary Examination^{**}

69.1 Start of International Preliminary Examination^{***}

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession both of the demand and of either the international search report or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established.

(b) If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the International

^{*} The amendment consists in deleting, after the word “examination”, the word “report”.

^{**} The title has been amended to read “Start of and Time Limit for International Preliminary Examination” instead of “Time Limit for International Preliminary Examination”.

^{***} The title has been amended to read “Start of International Preliminary Examination” instead of “Time Limit for International Preliminary Examination”.

Preliminary Examining Authority so wishes and subject to paragraph (d), start at the same time as the international search.*

(c) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned.

(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

(i) it has received a copy of any amendments made under Article 19,

(ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19, or

(iii) the expiration of 20 months from the priority date,

whichever occurs first.

(e) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.

69.2 Time Limit for International Preliminary Examination**

The time limit for establishing the international preliminary examination report shall be:

(i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date;

(ii) nine months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.

Rule 70 **The International Preliminary Examination Report**

70.1 [No change]

70.2 Basis of the Report

(a) [No change]

* The amendment consists in deleting the second sentence.

** This Rule was renumbered (former Rule 69.1(a)).

(b) [No change]

(c) [No change]

(d) Where claims relate to inventions in respect of which no international search report has been established and have therefore not been the subject of international preliminary examination, the international preliminary examination report shall so indicate.

70.3 Identifications

The report shall identify the International Preliminary Examining Authority which established it by indicating the name of such Authority, and the international application *by indicating the international application number, the name of the applicant,** and the international filing date.

70.4 No change]

70.5 [No change]

70.6 [No change]

70.7 [No change]

70.8 [No change]

70.9 [No change]

70.10 [No change]

70.11 [No change]

70.12 Mention of Certain Defects and Other Matters***

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

(i) [No change]

(ii) [No change, except the period is replaced by a semi-colon]

(iii) any of the situations referred to in Article 34(4) exists, it shall state this opinion and the reasons therefor in the report;

* The amendment consists in deleting the comma after the word “application”.

** The amendment consists in deleting, after the word “applicant”, the words “the name of the receiving Office, ”.

*** The title has been amended to read “Mention of Certain Defects and Other Matters” instead of “Mention of Certain Defects”.

(iv) a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, it shall so state in the report.

70.13 Remarks Concerning Unity of Invention

If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under Article 34(3), the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (Article 34(3)(a)), or on the main invention only (Article 34(3)(c)), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination. The report shall contain the indications provided for in Rule 68.1, where the International Preliminary Examining Authority chose not to invite the applicant to restrict the claims or to pay additional fees.

70.14 Authorized Officer*

The report shall indicate the name of the officer of the International Preliminary Examining Authority responsible for that report.

70.15 [No change]

70.16 Annexes of the Report

Each replacement sheet under Rule 66.8(a) and each replacement sheet containing amendments under Article 19 shall, unless superseded by later replacement sheets, be annexed to the report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8(a) shall not be annexed.

70.17 [No change]

Rule 71
Transmittal of the International Preliminary Examination Report

71.1 [No change]

71.2 Copies of Cited Documents

(a) [No change]

(b) [No change]

(c) [Deleted]

(d) Any International Preliminary Examining Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

* The title has been amended to read “Authorized Officer” instead of “Signature”.

Rule 72
Translation of the International Preliminary Examination Report

72.1 Languages

(a) Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, of its national Office, be translated into English.*

(b) [No change]

72.2 Copy of Translation for the Applicant

The International Bureau shall transmit a copy of the translation referred to in Rule 72.1(a) of the international preliminary examination report to the applicant at the same time as it communicates such translation to the interested elected Office or Offices.

72.3 [No change]

Rule 73
Communication of the International Preliminary Examination Report

73.1 [No change]

73.2 Time Limit for Communication

The communication provided for in Article 36(3)(a) shall be effected as promptly as possible but not earlier than the communication under Article 20.

Rule 74
**Translations of Annexes of the International
Preliminary Examination Report and Transmittal Thereof**

[No change]

Rule 75

[Deleted]

Rule 76
Copy, Translation and Fee under Article 39(1); Translation of Priority Document

76.1 [Remains deleted]

* The amendment consists in deleting, after the word “English”, the words “, French, German, Japanese, Russian, or Spanish”.

76.2 [Remains deleted]

76.3 [Remains deleted]

76.4 [No change]

76.5 Application of Rules 22.1(g), 49 and 51bis

Rules 22.1(g), 49 and 51bis shall apply, provided that:

(i) [Amendment to the French text only]

(ii) any reference in the said Rules to Article 22 or Article 24(2) shall be construed as a reference to Article 39(1) or Article 39(3), respectively;

(iii) [No change, except the period is replaced by a semi-colon]

(iv) for the purposes of Article 39(1), where an international preliminary examination report has been established, a translation of any amendment under Article 19 shall only be required if that amendment is annexed to that report.

76.6 Transitional Provision

If, on July 12, 1991, Rule 76.5(iv) is not compatible with the national law applied by the elected Office in respect of claims amended under Article 19, Rule 76.5(iv) shall not apply in that respect to that elected 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, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 77 **Faculty under Article 39(1)(b)**

[No change]

Rule 78 **Amendment of the Claims, the Description, and the Drawings, before Elected Offices**

78.1 Time Limit Where Election Is Effected prior to Expiration of 19 Months from Priority Date

(a) Where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, the applicant shall, if he so wishes, exercise the right under Article 41 to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfilment of the requirements under Article 39(1)(a), provided that, if the transmittal of the international preliminary examination report under Article 36(1) has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than four months after such expiration

date. In either case, the applicant may exercise the said right at any other time if so permitted by the national law of the said State.

(b) In any elected State in which the national law provides that examination starts only on special request, the national law may provide that the time limit within or the time at which the applicant may exercise the right under Article 41 shall, where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under paragraph (a).

78.2 [No change]

78.3 [No change]

PART D
Rules Concerning Chapter III of the Treaty

Rule 79
Calendar

[No change]

Rule 80
Computation of Time Limits

80.1 [No change]

80.2 [No change]

80.3 [No change]

80.4 [No change]

80.5 [No change]

80.6 [No change]

80.7 End of Working Day

(a) [No change]

(b) [No change]

(c) [Deleted]

Rule 81
Modification of Time Limits Fixed in the Treaty

[No change]

Rule 82
Irregularities in the Mail Service⁺

82.1 Delay or Loss in Mail

(a) [Amendment to the French text only]

(b) If the mailing, in accordance with paragraph (a), of a document or letter is proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, or, if the document or letter is lost in the mail, substitution for it of a new copy shall be permitted, provided that the interested party proves

⁺ Amendment to the title in the French text only.

to the satisfaction of the said Office or organization that the document or letter offered in substitution is identical with the document-or letter lost.

(c) [Amendment to the French text only]

(d) Any national Office or intergovernmental organization which has notified the International Bureau that it will do so shall, where a delivery service other than the postal authorities is used to mail a document or letter, apply the provisions of paragraphs (a) to (c) as if the delivery service was a postal authority. In such a case, the last sentence of paragraph (a) shall not apply but evidence may be offered only if details of the mailing were recorded by the delivery service at the time of mailing. The notification may contain an indication that it applies only to mailings using specified delivery services or delivery services which satisfy specified criteria. The International Bureau shall publish the information so notified in the Gazette.

(e) Any national Office or intergovernmental organization may proceed under paragraph (d):

(i) even if, where applicable, the deliver service used was not one of those specified, or did not satisfy the criteria specified, in the relevant notification under paragraph (d), or

(ii) even if that Office or organization has not sent to the International Bureau a notification under paragraph (d).

82.2 Interruption in the Mail Service

(a) [No change]

(b) [Amendment to the French text only]

Rule 82bis

Excuse by the Designated or Elected State of Delays in Meeting Certain Time Limits

[No change]

Rule 82ter

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

[No change]

Rule 83

Right to Practice before International Authorities

[No change]

PART E
Rules Concerning Chapter V of the Treaty

Rule 84
Expenses of Delegations

[No change]

Rule 85
Absence of Quorum in the Assembly

[No change]

Rule 86
The Gazette

86.1 [No change]

86.2 [No change]

86.3 Frequency

The frequency of publication of the Gazette shall be determined by the Director General.

86.4 Sale

The subscription and other sale prices of the Gazette shall be determined by the Director General.

86.5 Title

The title of the Gazette shall be determined by the Director General.

86.6 [No change]

Rule 87
Copies of Publications

87.1 [No change]

87.2 National Offices

(a) [No change]

(b) The publications referred to in paragraph (a) shall be sent on special request.* If any publication is available in more than one language, the request shall specify the language or languages in which it is desired.

Rule 88

Amendment of the Regulations

88.1 Requirement of Unanimity

Amendment of the following provisions of these Regulations shall require that no State having the right to vote in the Assembly vote against the proposed amendment:

- (i) [No change]
- (ii) [Deleted]
- (iii) [No change]
- (iv) [No change]
- (v) [No change]
- (vi) [No change]
- (vii) [No change]

88.2 [Remains deleted]

88.3 [No change]

88.4 [No change]

Rule 89

Administrative Instructions

89.1 [No change]

89.2 Source

- (a) [No change]
- (b) [Amendment to the French text only]
- (c) [No change]

89.3 [No change]

* The amendment consists in deleting, after the words “special request”, the words “, which shall be made, in respect of each year, by November 30 of the preceding year”.

PART F
Rules Concerning Several Chapters of the Treaty

Rule 90*
Agents and Common Representatives**

90.1 Appointment as Agent

(a) A person having the right to practice before the national Office with which the international application is filed may be appointed by the applicant as his agent to represent him before that Office acting as the receiving Office and before the International Bureau, the International Searching Authority and the International Preliminary Examining Authority.

(b) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(c) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Preliminary Examining Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed;

(ii) specifically before the International Searching Authority or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority or International Preliminary Examining Authority, as the case may be.

90.2 Common Representative

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a "common agent") under Rule 90.1(a), one of the applicants

* Rule 90 has been substantially amended, with renumbering of those provisions which are retained, and modification of titles. The text is therefore presented as a new Rule (i.e., the whole text being underlined). For the purposes of comparison with the text of present Rule 90, however, it should be noted that the substance of Rules 90.3, 90.4 and 90.6 is derived from present Rules 90.2, 90.3 and 90.4, respectively, and that deletions are not separately indicated.

** The title has been amended to read "Agents and Common Representatives" instead of "Representation".

who is entitled to file an international application according to Article 9 may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office shall be considered to be the common representative of all the applicants.

90.3 Effects of Acts by or in Relation to Agents and Common Representatives

(a) Any act by or in relation to an agent shall have the effect of an act by or in relation to the applicant or applicants concerned.

(b) If there are two or more agents representing the same applicant or applicants, any act by or in relation to any of those agents shall have the effect of an act by or in relation to the said applicant or applicants

(c) Subject to Rule 90bis.5(a), second sentence, any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

90.4 Manner of Appointment of Agent or Common Representative

(a) The appointment of an agent shall be effected by the applicant signing the request, the demand or a separate power of attorney. Where there are two or more applicants, the appointment of a common agent or common representative shall be effected by each applicant signing, at his choice, the request, the demand or a separate power of attorney.

(b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be submitted to the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

(c) If the separate power of attorney is not signed, or if the required separate power of attorney is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered non-existent unless the defect is corrected.

90.5 General Power of Attorney

(a) Appointment of an agent in relation to a particular international application may be effected by referring in the request, the demand or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a “general power of attorney”), provided that:

(i) the general power of attorney has been deposited in accordance with paragraph (b), and

(ii) a copy of it is attached to the request, the demand or the separate notice, as the case may be; that copy need not be signed.

(b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be deposited with the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

90.6 Revocation and Renunciation

(a) Any appointment of an agent or common representative may be revoked by the persons who made the appointment or by their successors in title, in which case any appointment of a sub-agent under Rule 90.1(d) by that agent shall also be considered as revoked. Any appointment of a sub-agent under Rule 90.1(d) may also be revoked by the applicant concerned.

(b) The appointment of an agent under Rule 90.1(a) shall, unless otherwise indicated, have the effect of revoking any earlier appointment of an agent made under that Rule.

(c) The appointment of a common representative shall, unless otherwise indicated, have the effect of revoking any earlier appointment of a common representative.

(d) An agent or a common representative may renounce his appointment by a notification signed by him.

(e) Rule 90.4(b) and (c) shall apply, *mutatis mutandis*, to a document containing a revocation or renunciation under this Rule.

Rule 90bis Withdrawals

90bis.1 Withdrawal of the International Application

(a) The applicant may withdraw the international application at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(c) No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

90bis.2 Withdrawal of Designations

(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies in respect of that State, prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90bis.4.

(b) Where a State has been designated for the purpose of obtaining both a national patent and a regional patent, withdrawal of the designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.

(c) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90bis.1.

(d) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(e) No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

90bis.3 Withdrawal of Priority Claims

(a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, 30 months from the priority date.

(b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one or more or all of the priority claims.

(c) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change.

(e) In the case of the time limit referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for international publication.

90bis.4 Withdrawal of the Demand, or of Elections

(a) The applicant may withdraw the demand or any or all elections at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective upon receipt of a notice addressed by the applicant to the International Bureau.

(c) If the notice of withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

90bis.5 Signature

(a) Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, subject to paragraph (b), be signed by the applicant. Where one of the applicants is considered to be the common representative under Rule 90.2 (b), such notice shall, subject to paragraph (b), require the signature of all the applicants.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant ("the applicant concerned") if it is signed by at least one applicant and

(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or

(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d) or 90bis.3(c), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or

(iii) in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with, or did not sign the later election concerned but the requirements of Rule 56.1(c) were complied with.

90bis.6 Effect of Withdrawal

(a) Withdrawal under Rule 90bis of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2).

(b) Where the international application is withdrawn under Rule 90bis.1, the international processing of the international application shall be discontinued.

(c) Where the demand or all elections are withdrawn under Rule 90bis.4, the processing of the international application by the International Preliminary Examining Authority shall be discontinued.

90bis.7 Faculty under Article 37(4)(b)

(a) Any Contracting State whose national law provides for what is described in the second part of Article 37(4)(b) shall notify the International Bureau in writing.

(b) The notification referred to in paragraph (a) shall be promptly published by the International Bureau in the Gazette, and shall have effect in respect of international applications filed more than one month after the date of such publication.

Rule 91 **Obvious Errors in Documents**

91.1 Rectification

- (a) [No change]
- (b) [No change]
- (c) [Amendment to the French text only]
- (d) [No change]
- (e) No rectification shall be made except with the express authorization:
 - (i) [No change]
 - (ii) [No change]
 - (iii) [Amendment to the French text only]
 - (iv) [No change]
- (f) [No change]
- (g) [No change]
- (g-bis) [No change]
- (g-ter) [No change]
- (g-quater) [No change]

Rule 92 **Correspondence**

92.1 Need for Letter and for Signature

- (a) [Amendment to the French text only]
- (b) [No change]
- (c) [No change]

92.2 Languages

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. Where the international application has been translated under Rule 12.1(c), the language of such translation shall be used.

(b) [No change]

(c) [Remains deleted]

(d) [No change]

(e) [No change]

92.3 Mailings by National Offices and Intergovernmental Organizations

Any document or letter emanating from or transmitted by a national Office or an intergovernmental organization and constituting an event from the date of which any time limit under the Treaty or these Regulations commences to run shall be sent by ^{*} air mail, provided that surface mail may be used instead of air mail in cases where surface mail normally arrives at its destination within two days from mailing or where air mail service is not available.

92.4 Use of Telegraph, Teleprinter, Facsimile Machine, Etc.^{**}

(a) A document making up the international application, and any later document or correspondence relating thereto, may, notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraph (h), be transmitted, to the extent feasible, by telegraph, teleprinter, facsimile machine^{***} or other like means of communication producing a printed or written document.

(b) A signature appearing on a document transmitted by facsimile machine shall be recognized for the purposes of the Treaty and these Regulations as a proper signature.

(c) Where the applicant has attempted to transmit a document by any of the means referred to in paragraph (a) but part or all of the received document is illegible or part of the document is not received, the document shall be treated as not having been received to the extent that the received document is illegible or that the attempted transmission failed. The national Office or intergovernmental organization shall promptly notify the applicant accordingly.

(d) Any national Office or intergovernmental organization may require that the original of any document transmitted by any of the means referred to in paragraph (a) and an

* The amendment consists in deleting, before the words “air mail” (first instance), the word “registered”.

** The title has been amended to read “Use of Telegraph, Teleprinter, Facsimile Machine, Etc. ” instead of “Use of Telegraph, Teleprinter, Etc.”.

*** The amendment consists in deleting the second sentence.

accompanying letter identifying that earlier transmission be furnished within 14 days from the date of the transmission, provided that such requirement has been notified to the International Bureau and the International Bureau has published information thereon in the Gazette. The notification shall specify whether such requirement concerns all or only certain kinds of documents.

(e) Where the applicant fails to furnish the original of a document as required under paragraph (d), the national Office or intergovernmental organization concerned may, depending on the kind of document transmitted and having regard to Rules 11 and 26.3,

(i) waive the requirement under paragraph (d), or

(ii) invite the applicant to furnish, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation, the original of the document transmitted,

provided that, where the document transmitted contains defects, or shows that the original contains defects, in respect of which the national Office or intergovernmental organization may issue an invitation to correct, that Office or organization may issue such an invitation in addition to, or instead of, proceeding under item (i) or (ii).

(f) Where the furnishing of the original of a document is not required under paragraph (d) but the national Office or intergovernmental organization considers it necessary to receive the original of the said document, it may issue an invitation as provided for under paragraph (e)(ii)

(g) if the applicant fails to comply with an invitation under paragraph (e)(ii) or (f):

(i) where the document concerned is the international application, the latter shall be considered withdrawn and the receiving Office shall so declare;

(ii) where the document concerned is a document subsequent to the international application, the document shall be considered as not having been submitted.

(h) No national Office or intergovernmental organization shall be obliged to receive any document submitted by a means referred to in paragraph (a) unless it has notified the International Bureau that it is prepared to receive such a document by that means and the International Bureau has published information thereon in the Gazette.

Rule 92bis

Recording of Changes in Certain Indications in the Request or the Demand

[No change]

Rule 93

Keeping of Records and Files

[No change]

Rule 94

**Furnishing of Copies by the International Bureau and
the International Preliminary Examining Authority**

[No change]

Rule 95

Availability of Translations

[No change]

Rule 96
The Schedule of Fees

[No change]

SCHEDULE OF FEES

Fees		Amounts	
1.	Basic Fee: Rule 15.2(a))		
	(a) if the international application contains not more than 30 sheets	706	Swiss francs
	(b) if the international application contains more than 30 sheets	706	Swiss francs plus 14 Swiss francs for each sheet in excess of 30 sheets
2.	Designation Fee: (Rule 15.2(a))		
	(a) <u>for designations made under Rule 4.9(a)</u>	171	Swiss francs per designation, <u>provided that any designation made under Rule 4.9(a) in excess of 10 shall not require the payment of a designation fee</u>
	(b) <u>for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)</u>	171	<u>Swiss francs per designation</u>
3.	<u>Confirmation Fee:</u> (Rule 15.5(a))	50%	<u>of the sum of the designation fees payable under item 2(b)</u>
4.	Handling Fee: (Rule 57.2(a))	216	Swiss francs
	*[Heading deleted]		
5.	[Deleted]		

* The amendment consists in deleting the heading "Surcharges".

[End of document]

WIPO



PCT/A/XIX/3

ORIGINAL: English

DATE: October 2, 1991

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Nineteenth Session (8th Ordinary) Geneva, September 23 to October 2, 1991

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XXII/l Rev.): 1, 2, 3, 5, 8, 12, 14, 15, 22, 27 and 28.
2. The report on the said items, with the exception of item 8, is contained in the General Report (document AB/XXII/22).
3. The report on item 8 is contained in this document.
4. Mr. Alfons Schäfers (Germany) was elected Chairman of the Assembly.

ITEM 8 OF THE CONSOLIDATED AGENDA:**MATTERS CONCERNING THE PCT UNION**General

5. The Delegations of France and Germany observed that there had been extraordinary growth in the use of the PCT system in recent years. They were pleased that the growth was continuing in spite of the present economic situation in various countries.

6. The Delegations of Poland and Czechoslovakia, noting that their countries had recently joined the PCT, expressed their appreciation to the International Bureau for the assistance rendered in this connection.

Finances of the PCT Union

7. Discussions were based on document PCT/A/XIX/1.

8. The discussions focused on the following five matters:

(i) the proposed participation of the PCT Union in the financing of certain activities in which it had not previously participated (see paragraph 4 of document PCT/A/XIX/1);

(ii) the proposed "Alternative Financing Arrangement" (see paragraph 8 of document PCT/A/XIX/1);

(iii) the proposed allocation of the surplus of the PCT Union for the 1992-93 biennium to the special reserve fund for additional premises and computerization (see paragraph 25 of document PCT/A/XIX/1);

(iv) the determination of the amount of the reimbursement of the PCT deficit-covering contributions during the 1992-93 biennium (see paragraph 27 of document PCT/A/XIX/1);

(v) the proposed increase of the PCT fees by 10% effective January 1, 1992 (see paragraph 37 of document PCT/A/XIX/1).

9. Proposed participation of the PCT Union in the financing of certain activities in which it had not previously participated. The Delegations of France, Switzerland, Germany, the United States of America, the United Kingdom, Belgium, Australia and Denmark stated that they supported this new orientation of the PCT Union, involving support for development cooperation activities, on the understanding that the activities concerned would be relevant to the development of the PCT system.

10. The Director General said that he agreed with that understanding which already resulted from paragraph 5 of document PCT/A/XIX/1, giving the main examples of such activities in the field of development cooperation, and Annex 3 of document AB/XXII/2, which indicated the amounts of the said participation of the PCT Union in the activities concerned.

11. The Delegations of Poland, Sri Lanka and Brazil expressed support for the proposal, as it would result in an increase of the level of development cooperation activities. In their view, the participation of the PCT Union in development cooperation was important not only for developing countries but also for the PCT system.

12. The Delegations of Canada, Romania, the Soviet Union, Sudan, Côte d'Ivoire, the Netherlands, Finland, Spain, Mongolia, the Democratic People's Republic of Korea and Luxembourg said that they supported the proposal.

13. Support for the proposal was also expressed by three delegations of States not members of the PCT Union, namely, the Delegations of the United Republic of Tanzania, India and Portugal.

14. On a vote by show of hands, the Assembly unanimously accepted the proposed participation of the PCT Union in the financing of certain activities in which it had not previously participated, on the understanding that the activities concerned would be relevant to the development of the PCT system, as indicated in the documents mentioned above.

15. Proposed "Alternative Financing Arrangement". The Delegations of France, Switzerland, Germany, the United States of America, the United Kingdom, Canada, Belgium, Denmark and Australia stated that they did not agree with the proposal. The Delegations of Switzerland, Germany, the United States of America and the United Kingdom said that they considered that surplus funds should be kept for purely PCT needs. In this context, the Delegations of Switzerland and the United States of America noted, in particular, the requirement for investments for additional premises. The latter two Delegations added that they considered that users of the PCT system would object to a fee increase if at the same time PCT reserves were to be allocated as proposed under the Alternative Financing Arrangement.

16. The Delegation of Japan expressed some concern over implementing at the present time the proposed Alternative Financing Arrangement since, in its view, that could only be done once it was clear that there would be sufficient surpluses in the Fee-financed Unions also in the future so that such financing would be possible on a continuing basis.

17. The Delegation of the Soviet Union said that it maintained the position it had expressed in the Budget Committee (see document AB/XXII/3, paragraph 21) namely, that it would be premature to support the Alternative Financing Arrangement.

18. The Delegation of Portugal, as the representative of a country which intended to accede to the PCT in the near future, said that it did not support the Alternative Financing Arrangement.

19. The Delegations of Sri Lanka, Brazil, Romania, Sudan, Côte d'Ivoire, the Netherlands, Mongolia, the Democratic People's Republic of Korea and Luxembourg said that they supported the proposed Alternative Financing Arrangement. The Delegation of Sri Lanka noted that the resulting reduction of the burden of contributions would be of benefit to all countries. The Delegation of the Netherlands added that it considered the proposal to be totally justified.

20. The Delegation of the United Republic of Tanzania also supported the proposed Alternative Financing Arrangement.

21. The Delegation of Bulgaria said that it abstained as concerns the proposed Alternative Financing Arrangement.

22. On a vote by show of hands, the Assembly decided not to approve the proposed Alternative Financing Arrangement, by a majority of 16 votes against, with 8 votes for and one abstention.

23. Proposed allocation of the surplus of the PCT Union for the 1992-93 biennium to the special reserve fund for additional premises and computerization. The Delegations of France, Sri Lanka, Switzerland, the United States of America, Belgium, Brazil, Romania, the Soviet Union, Sudan, Côte d'Ivoire, the Netherlands, Mongolia, the Democratic People's Republic of Korea and Luxembourg said that they supported the proposal.

24. The Delegations of Germany, the United Kingdom and Australia said that they agreed that funds would be needed for computerization projects but urged caution as regards the provision of reserves for building premises for future needs. The Delegation of Canada said it was not convinced that reserves needed to be increased for additional premises.

25. On a vote by show of hands, the Assembly decided unanimously, with the abstention of the Delegation of Germany, that the surplus of the PCT Union for the 1992-93 biennium go to the special reserve fund for additional premises and computerization.

26. Amount of the reimbursement of PCT deficit-covering contributions during the 1992-93 biennium. The delegations of several countries supported--and no delegation objected to--the recommendation of the WIPO Budget Committee that the reimbursement of the PCT deficit-covering contributions be at the amount of 6,580,819 francs during the 1992-93 biennium, in order to complete that reimbursement.

27. The Assembly decided that the reimbursement of the PCT deficit-covering contributions be at the amount of 6,580,819 francs during the 1992-93 biennium, in order to complete that reimbursement.

28. Proposed 10% increase of the PCT fees. The Delegation of France said that, after long consultations with the interested circles, it agreed with the proposed fee increase. The Delegations of Poland, Sri Lanka, Italy, Switzerland, Brazil, Romania, the Soviet Union, Sweden, Sudan, Côte d'Ivoire, the Netherlands, Finland, Austria, Bulgaria, Mongolia, the Republic of Korea, the Democratic People's Republic of Korea and Hungary stated that they supported or could accept the proposed fee increase. The Delegations of Sri Lanka, Switzerland and Brazil said that the proposed fee increase was very modest and much less than the rate of inflation over the period since the last fee increase. The Delegation of Austria noted the experience of certain Offices where excessive deferring of fee increases had, in the end, led to very large eventual increases, which had had very adverse effects for applicants.

29. The observer Delegation of Portugal expressed itself in favor of the proposed fee increase.

30. The Delegations of Germany, Japan, Belgium, Denmark, Australia and Spain said that they were not convinced that the fees should be increased. The Delegations of Japan, Belgium and Spain added that a fee increase might discourage applicants.
31. The Delegation of Luxembourg said that it would prefer a fee increase of less than 10%.
32. The Delegations of the United States of America, the United Kingdom and Canada said that fees should not be increased without a clear need, and noted that a surplus was expected to result for the PCT Union even without a fee increase; they therefore opposed the proposed fee increase. The Delegations of the United States of America and Canada said that a fee increase might have an adverse effect on the number of filings. The Delegation of Canada added that PCT users in Canada strongly opposed a fee increase in light of the large reserves available to the PCT Union.
33. The Director General pointed out that, for a number of countries, the proposed 10% fee increase amounted to considerably less (for example, about 6% in Canada) when expressed in their national currencies, due to exchange rate changes.
34. The Delegation of Norway suggested that perhaps a 5% fee increase could be an acceptable compromise.
35. In order to promote a consensus, the Chairman proposed that the fee increase be 8% instead of 10%.
36. The Delegations of Japan, Finland, Norway, Luxembourg, Spain and Belgium said that, in order to achieve a consensus, they were willing to support the Chairman's proposal.
37. The Delegations of Germany, Australia and Denmark stated that, while they saw no justification for a fee increase, they would not oppose an 8% increase, in order to demonstrate their willingness to achieve a consensus.
38. The Delegations of the United States of America, Canada and the United Kingdom said that they saw no need for a fee increase and expressed themselves against any increase.
39. The Assembly, noting the opposition of the three Delegations mentioned in the preceding paragraph, decided to increase the PCT fees by 8%, effective January 1, 1992.
40. The amended Schedule of Fees for the PCT system, resulting from the said 8% increase, is reproduced in the Annex.
41. Other matters. In reply to a suggestion by the Delegation of France that consideration might be given to distribute part of the surplus of the PCT Union to the PCT Contracting States, as was the case for the Madrid Union, the Director General said that the situation was quite different in those two Unions. In the Madrid Union, the national and regional Trademark Offices received no national or regional fees from the owners of the international registrations but received fees only from the International Bureau and since the amount of the fees received from the International Bureau may be lower than their costs, there was a justification for Member States to share in the surplus. On the other hand, in the PCT Union, the national and regional Patent Offices received their national or regional fees in the same amount as what

they received outside the PCT procedure; consequently, there was no justification for any share in the surplus.

42. The Delegations of Switzerland, Germany and the United Kingdom stated that they agreed that there should not be any distribution of part of the surplus of the PCT Union to the PCT Contracting States.

43. The Delegation of Germany observed that the Madrid Union bore the costs of one delegate per Member State of the Madrid Union attending meetings of the Madrid Union. In light of the financial situation of the PCT Union, the Delegation proposed that Rule 84 of the PCT Regulations be changed to allow the PCT Union to bear the expenses of one or two delegates from each Member State of the PCT Union to participate in PCT meetings.

44. The Delegations of the United States of America, the United Kingdom, Japan and Belgium said that the proposal of the Delegation of Germany would require further study.

45. The Delegation of Denmark said that it supported the proposal of the Delegation of Germany.

46. The Director General said that paying from PCT funds for one delegate per PCT Contracting State would be particularly useful for developing countries, in allowing them to participate regularly in PCT meetings. There would, however, be important budgetary consequences if one had to pay for several delegates from each PCT Contracting State for each PCT meeting.

47. The Chairman proposed that the International Bureau and the PCT Contracting States consider the matter of a possible change to Rule 84 of the PCT Regulations with a view to possibly presenting a concrete proposal to one of the next sessions of the Assembly.

48. The proposal of the Chairman contained in the preceding paragraph was adopted by the Assembly.

Progress Report on the DICAPS Project

49. Discussions were based on document PCT/A/XIX/2.

50. The Delegation of France noted that the cost estimates indicated in the document for the DICAPS system amounted to approximately twice the cost estimates submitted to the Assembly of the PCT Union in 1989, but expressed its understanding for such a cost increase, taking into account the considerable development of the PCT.

51. The Delegation of the United Kingdom asked to what extent the cost estimates indicated in the document under consideration could differ from the final costing of the DICAPS system, and invited the International Bureau to indicate what savings could be expected in its operations from the implementation of the DICAPS system.

52. The International Bureau replied that, as far as the cost of the DICAPS system was concerned, the final costing of the system was not expected to differ from the present cost estimate by more than 10%. With respect to the savings expected from the implementation of the DICAPS system, the International Bureau stated that the further rationalization of its

operations under the PCT would undoubtedly bring significant savings, in particular in human resources and mailing costs.

53. The Delegation of Japan expressed its satisfaction with the progress achieved so far. At the same time, the said Delegation expressed its concern, already expressed at the seventeenth session of the Assembly of the PCT Union, about the lack of any international standard concerning the production of CD-ROMs for the purpose of making available patent documents as facsimile images. The Delegation expressed the hope that the Permanent Committee for Industrial Property Information (PCIPI) would be able to produce standards covering the production of such CD-ROMs as soon as possible.

54. The Assembly noted with satisfaction the progress report contained in document PCT/A/XIX/2.

[Annex follows]

ANNEX

SCHEDULE OF PCT FEES APPLICABLE FROM JANUARY 1, 1992

<u>Fees</u>	<u>Amounts</u>
1. Basic Fee (Rule 15.2(a))	
(i) if the international application contains not more than 30 sheets	762 Swiss francs
(ii) if the international application contains more than 30 sheets	762 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee (Rule 15.2(a))	185 Swiss francs per designation for which the fee is due, with a maximum of 1,850 Swiss francs, any such designation in excess of 10 being free of charge
3. Handling Fee (Rule 57.2(a))	233 Swiss francs
4. Supplement to the Handling Fee (Rule 57.2(b))	233 Swiss francs
<u>Surcharges</u>	
5. Surcharge for late payment (Rule 16bis.2(a))	Minimum: 289 Swiss francs Maximum: 728 Swiss francs

[End of Annex and of document]

WIPO



PCT/A/XX/5

ORIGINAL: English

DATE: September 29, 1992

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Twentieth Session (12th Extraordinary) Geneva, September 21 to 29, 1992

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (documents AB/XXIII/1 Rev.2 and AB/XXIII/6, paragraphs 16 and 17): 1, 2, 9, 9bis, 13 and 14.
2. The report on the said items, with the exception of item 9, is contained in the General Report (document AB/XXIII/6).
3. The report on item 9 is contained in this document.

ITEM 9 OF THE CONSOLIDATED AGENDA:**MATTERS CONCERNING THE PCT UNION**Accession of China to the PCT

4. The Chairman noted that discussion would be based on the proposals by the International Bureau contained in document PCT/A/XX/1, taking into account the recommendation to the Assembly, contained in paragraph 13 of document PCT/CTC/XIII/3, which the PCT Committee for Technical Cooperation had made pursuant to Articles 16(3)(e) and 32(3) of the PCT.

5. In response to an invitation by the Chairman and in accordance with Articles 16(3)(e) and 32(3) of the PCT, the Delegation of China made a statement to the Assembly. It first expressed its gratitude for the consideration being given to questions associated with China's accession to the PCT and for the welcome, support and assistance it had received from other countries and from organizations. It emphasized the importance of the PCT generally and in particular to China, which had decided to accede to the PCT as soon as possible on the understanding that Chinese would be made a filing and publication language under the PCT and that the Chinese Patent Office would be appointed as an International Searching and Preliminary Examining Authority. The Delegation then enumerated the facts that qualified the Chinese Patent Office for becoming an International Searching and Preliminary Examining Authority.

6. The Delegation recalled some of the achievements made since the establishment of the Chinese Patent Office (CPO) in 1980, including in particular:

(a) The CPO, located in a new, modern and large building, has a computerized management system and nearly 1,400 staff.

(b) The Chinese Patent Law and Regulations of April 1, 1985, have been revised with effect on January 1, 1993; the revised law provides patent protection for pharmaceutical products and chemical substances, extends the patent term from 15 years to 20 years from the filing date, and makes other important improvements.

(c) A nation-wide system of bodies dealing with patent matters has been established. They include 54 Local Administrative Authorities for Patent Affairs, 474 Patent Agencies with 5,000 registered patent agents, the All China's Inventors' Association, several Intellectual Property Societies, the Patent Documentation Service Network and several Intellectual Property Institutes.

(d) During the period from April 1, 1985, to August 31, 1992, a total of 258,848 patent applications (including 74,295 for inventions, 45.5% of which were from 69 foreign countries and regions) were filed with the CPO which granted, during the said period, a total of 105,784 patent rights (including 14,283 for inventions, 61.6% of which were from foreign countries and regions).

(e) China is a party to the WIPO Convention and to the Paris Convention.

7. In relation to patent examination, the Chinese Patent Office had established a strong examining force with five examination departments and one re-examination board. The first examination department was in charge of various administrative functions and would, in the future, undertake the function of a PCT receiving Office. The other examination departments were in charge of substantive examination of patent applications in the mechanical, electrical, chemical and physical fields, respectively. Substantive examination included a search of the prior art and examination for novelty, inventiveness and industrial applicability. The re-examination board was in charge of re-examination and invalidation cases.

8. The Chinese Patent Office had nearly 350 examiners, all of whom had a university degree and a good knowledge of at least one foreign language. Of the examiners, one third were senior examiners, half had received training abroad, and two-thirds had more than five years experience as examiners. Examiners were trained intensively in various patent law and examination subjects by Chinese and foreign experts, and underwent probation of one to two years under a senior examiner's supervision.

9. Between April 1, 1985, and June 30, 1992, the Chinese Patent Office had searched, examined and issued first official actions in relation to 31,908 applications (accounting for 76.8% of the total number of requests for examination), and 28,987 applications had been finally disposed of by way of grant, rejection or withdrawal (61.9% of the total number of requests for examination). A special quality control would ensure the quality of search and examination.

10. In relation to patent documentation, the Chinese Patent Office had established a collection including more than 30 million patent documents from more than 20 countries, dating back to 1890. The collection also included a complete set of the periodicals contained in the non-patent literature provided for in the PCT minimum documentation. The search files were arranged according to the International Patent Classification (IPC). Means of access by examiners included search files, microfiche, CD-ROM and computer, details of which were outlined by the Delegation.

11. The Delegation pointed out that, of the PCT minimum documentation, only those documents listed in Annex III to document PCT/A/XX/I were not presently held by the Chinese Patent Office. However, arrangements had already been made for the documents covered by items 2, 3, 5 and 6 of that list to be obtained. The Delegation expressed its gratitude, in particular, to the Patent Offices of Austria, France, Germany, Switzerland and the United Kingdom, to the EPO and to WIPO and the Director General, for their generous assistance in this regard. The Delegation expected that the remaining documents covered by the list would be obtained by the Chinese Patent Office before its planned accession to the PCT in 1993.

12. The Delegation concluded its statement by pointing out that the Chinese Patent Office had, through a program of development over a number of years, built up a strong examining force, supported by a rich collection of documentation. The Office thus had the capability of carrying out the functions of an International Searching and Preliminary Examining Authority. The Delegation expressed its confidence that the Chinese Patent Office would be able to fulfil the duties of an International Searching and Preliminary Examining Authority under the PCT, and expressed its hope that the Assembly would approve the Office's appointment as such an Authority with a view to China's accession to the PCT as soon as possible.

13. The Delegations of Germany, France, Bulgaria, Austria, the Republic of Korea, Japan, Australia, Hungary, the Russian Federation, Sweden, Switzerland, the United States of America, Belgium, Poland, Czechoslovakia, Canada, the United Kingdom, Denmark, Spain, Finland, Mongolia, Norway and Portugal and the Representative of the European Patent Organisation, as well as the Delegations of Egypt and Kenya and the Representative of FICPI expressed their strong support for the appointment of the Chinese Patent Office as International Searching and Preliminary Examining Authority, noting that China had succeeded in a remarkably short time in establishing a viable and efficient patent system on the basis of a modern patent law of international standard. Many delegations congratulated the Chinese Patent Office for its impressive accomplishments and noted that the accession of China to the PCT would represent a major step towards improving relations between China and the present PCT member States.

14. As recommended by the Committee for Technical Cooperation of the PCT Union and set out in paragraph 13 of document PCT/CTC/XIII/3, the Assembly unanimously:

(i) adopted the amendments to PCT Rules 10.1(f), 11.9(b) and (e) and 48.3(a) and (b), as set out in Annex II to this report, with effect on the date on which China becomes bound by the PCT;

(ii) approved the text of the Agreement between the Chinese Patent Office and WIPO, as set out in Annex I to this report;

(iii) appointed the Chinese Patent Office as International Searching and Preliminary Examining Authority with effect on the date on which China becomes bound by the PCT.

Cut-Off Date of Minimum Documentation

15. The Delegation of Australia raised the question of whether the 1920 cut-off date for minimum documentation provided in PCT Rule 34 was, at the present time, still a reasonable date. It believed that one should examine whether it was necessary to include, in the PCT minimum documentation, documents older than 50 years. The Delegation of Australia proposed that the competent bodies under the PCT should study the matter.

16. The Delegations of Sweden, Belgium, the United Kingdom and Germany, and the Representative of the European Patent Organisation, supported the proposal made by the Delegation of Australia.

17. The Representative of FICPI, while agreeing that the matter should be studied with an open mind, was concerned about the possible effects a change might have on the reliability of the international search report, and stated that his Federation would also be studying the question.

18. The Assembly decided that the desirability of revising PCT Rule 34 would be studied and that such a study should start with the consideration of the question in the December 1992 session of the PCT Committee for Technical Cooperation.

International Search and International Preliminary Examination of International Applications filed in Spanish

19. Discussions were based on document PCT/A/XX/2 Rev.

20. The Delegation of Spain expressed concern of a general nature with the proposed amendments as they stood, and stated that the time available for studying the proposed amendments had been insufficient. It noted that earlier changes to PCT Rule 12.1, which provided for international search on the basis of translations of international applications filed in Spanish, had been introduced as an interim measure to enable Spain's accession to the PCT. However, those changes did not, in the Delegation's view, justify the making of amendments to similar effect in relation to international preliminary examination. The amendments proposed would worsen the situation for Spanish-speaking applicants by widening the range of circumstances in which they would be required to prepare costly translations of international applications during the international phase.

21. The Delegation noted that the Assembly had, when Spain's impending accession to the PCT was discussed in 1986, unanimously declared its willingness to appoint the Spanish Patent Office as an International Searching Authority once all the conditions prescribed by the PCT and the Regulations thereunder were fulfilled (document PCT/A/XIV/3, paragraph 9). The Spanish Patent Office had, since its accession to the PCT in 1989, made great efforts towards preparing itself to be an International Searching Authority. These efforts had included the assembling, with the valued assistance of the industrial property offices of France, Germany, Switzerland, the United States of America and other countries, of the minimum documentation under the PCT in its documents. In addition, the Spanish Office had promoted the creation of a patent documentation center in the Spanish language, whose objective was to collect all patent documents in that language. That Center had received much support from other Spanish-speaking countries. The Spanish Patent Office had commenced the preparation of state-of-the-art searches in 1991, and hoped to actively pursue appointment as an International Searching Authority in 1993.

22. The Delegation also indicated that the Spanish Patent Office would, in the event that Spain were to withdraw its reservation on Chapter II of the PCT, also hope to seek appointment as an International Preliminary Examining Authority.

23. The Delegation noted that Spain's membership of the European Patent Organisation did not preclude the appointment of the Spanish Patent Office as an International Searching Authority and as an International Preliminary Examining Authority. The Administrative Council of the European Patent Organisation had agreed that the criteria of Section III, paragraph 1, of the Protocol on Centralisation of the European Patent System were fulfilled, with the effect that the Spanish Patent Office should in due course be authorized by the Administrative Council to act as an International Searching Authority and as an International Preliminary Examining Authority under the PCT in respect of international applications filed in Spanish (see Official Journal EPO, No. 2/1986, page 49).

24. The Delegation of Spain noted with gratitude, in connection with the provisions of PCT Rule 12.1(c) and (d), that the European Patent Office had, in practice, for a limited number of international applications filed in Spanish with the Spanish Patent Office as receiving Office, waived the requirement that applicants must provide the translation required under that Rule. The Delegation observed that the European Patent Office employed more than 100 examiners with a capacity in the Spanish language, and believed that there would be benefit in exploring the possibility that the European Patent Office might afford a similar exemption to nationals and residents of other Spanish-speaking countries which might accede to the PCT.

25. The Delegation of Spain believed, in view of these various possibilities for future action which had not yet been pursued, that it would be premature to accept the proposed amendments at present.

26. The Director General emphasized that there was not yet any International Searching Authority or International Preliminary Examining Authority which had declared itself prepared to carry out international searches or international preliminary examination in respect of international applications filed in Spanish without the need for a translation. The European Patent Office had not so declared itself, and the Spanish Patent Office had not yet sought appointment as an International Searching Authority or International Preliminary Examining Authority. While the Regulations presently provided the possibility for international searches on international applications in Spanish on the basis of a translation, not even that possibility existed for international preliminary examination of international applications in Spanish. Several Latin American countries were interested in the PCT. Participation of Spain in Chapter II of the PCT was highly desirable. For all these reasons, a solution to the Spanish language question was urgent. Naturally, as soon as there will be an International Searching Authority and an International Preliminary Examining Authority which can work in Spanish, the need for translation would disappear.

27. The Delegation of Chile, speaking as an observer, indicated that Chile had, as a Spanish-speaking country, cooperated with the Spanish Patent Office in its efforts to develop the Documentation Center with Spanish language documents. As far as international search and preliminary examination were concerned, the Delegation noted that the International Bureau had proposed a solution to a problem with which Spanish-speaking countries were faced. The Delegation looked forward to the time when Spanish would be fully used as a working language under the PCT.

28. The Representative of the European Patent Organisation confirmed that, having regard to the Protocol on the Centralisation of the European Patent System, the Spanish Patent Office would be entitled to act as an International Searching and Preliminary Examining Authority for applicants from Spain and from other Spanish-speaking countries. Currently, the European Patent Office, in practice, conducted international searches on international applications filed in Spanish with the Spanish Patent Office as receiving Office without requiring a translation as provided by PCT Rule 12.1(c). That was made on the basis of an informal arrangement with Spain, in view of the fact that Spain was a Contracting State of the European Patent Convention. The Representative was not, at that stage, in a position to offer an extension of that arrangement to international applications filed in Spanish in States other than Spain.

29. The Director General noted that the informal arrangement between the European Patent Organisation and Spain was not applicable to Latin-American Spanish-speaking countries and

in any case did not deal with international preliminary examination. He once again pointed out that the amendments proposed by the International Bureau were intended to apply to international applications filed in Spanish only until such time as they were able to be subjected to international search and international preliminary examination by an International Searching and Preliminary Examining Authority without the need for a translation, and suggested that this circumstance should be expressed by the Assembly in adopting the proposed Rules.

30. The Delegation of Spain indicated that its concerns would be largely met by the Director General's suggestion and that, if that suggestion was adopted, it could agree to the proposed amendments.

31. The Delegate of France, noting that he was also Chairman of the Administrative Council of the European Patent Organisation, indicated that the carrying out of international searches by the European Patent Office on international applications filed in Spanish could be considered further, but he would not wish any assumption to be made as to such a possible decision.

32. The Delegation of Germany pointed out that, although the discussion had so far been restricted to international applications filed in the Spanish language, the proposed amendments were not limited to such applications. The Chairman observed that the document under consideration made this clear, although its title mentioned only international applications filed in Spanish.

33. The Delegation of Portugal stated that the Rules concerned should apply in all cases where an international application was filed in a language for which there was no competent International Preliminary Examining Authority prepared to undertake the international preliminary examination without the need for a translation.

34. The Assembly agreed with a suggestion by the Delegation of the United Kingdom that the word "However," be inserted at the beginning of the second sentence of PCT Rule 92.2(a) as proposed to be amended.

35. The Assembly noted the position of the Delegation of Spain and unanimously adopted the amendments to the Regulations under the PCT as set out in Annex II to this report, and decided that those amendments would enter into force on January 1, 1993. The Assembly agreed that the adopted amendments would cease to be applicable with respect to international applications filed in Spanish as soon as a competent International Searching and Preliminary Examining Authority was available to carry out, without the need for a translation, international searches and international preliminary examinations in respect of international applications filed in Spanish.

Amendment to Rule 91.1 of the Regulations under the PCT (obvious errors in documents)

36. Discussions were based on document PCT/A/XX/3, a proposal by the United Kingdom.

37. The Delegation of the United Kingdom introduced its proposal, noting that earlier proposals to amend Rule 91.1 had been considered by the PCT Committee for Administrative and Legal Matters and by the Assembly at its eighteenth session. The Delegation emphasized

that the problems dealt with by its proposal were amongst the most serious of those encountered by applicants using PCT procedures and were urgently in need of resolution.

38. The Delegation of France seconded, and the International Bureau indicated its full agreement with, the United Kingdom's proposal.

39. The Delegation of the United States of America expressed its sympathy with the objectives of the proposal, noting that it was designed to make the PCT more user-friendly and to afford more flexibility in enabling applicants to rectify errors which might adversely affect their rights. However, the Delegation raised the question of compatibility of the proposal with Article 11 of the PCT, and pointed out that it would be undesirable if an international application rectified under the Rule was liable to challenge because of lack of such compatibility. This was important in the interests of both applicants and third parties. The Delegation therefore proposed that consideration of the proposal be deferred, and that the International Bureau be invited to prepare a document studying the relationship between Article 11 and the proposal and to convene a meeting of the PCT Committee for Administrative and Legal Matters to consider the legal implications in greater detail.

40. The Delegation of Japan also expressed sympathy for the objectives of the proposal, but was not in a position to support the proposal as presented. It believed that the proposal could allow rectifications which broaden the disclosure in an international application so as to include new matter not present in the international application as originally filed. In its view, the contents of the priority document were not relevant for the purposes of determining the scope of the original disclosure in the international application itself. The Delegation expressed particular concern that the interests of third parties might be adversely affected.

41. Moreover, the Delegation of Japan noted that the question of correction of applications was due for discussion in July 1993 in the context of the proposed Patent Law Treaty, and was of the opinion that it would therefore be premature for the Assembly to make a decision on the United Kingdom's proposal at this stage. However, the Delegation indicated that it would not oppose further consideration of the question by the PCT Committee for Administrative and Legal Matters.

42. The Delegation of Sweden, with which the Delegations of Finland, Canada, Norway, Australia, Austria and Germany agreed, stated that it was in favor of the proposal but would not object to further study of the question by the PCT Committee for Administrative and Legal Matters.

43. The Delegation of the United Kingdom expressed its appreciation for this support and indicated its agreement to such further study. It suggested that the Committee be convened at an early opportunity to enable work to proceed rapidly, with a view to resolving the concerns expressed and to putting the matter to the Assembly for decision at its next meeting.

44. The Representative of the European Patent Organisation welcomed the proposal as a step in the right direction. The interests of both applicants and third parties should be taken into account. The Representative supported the suggestion that the question be further considered by the PCT Committee for Administrative and Legal Matters. The Representative also noted that Rule 88 of the Implementing Regulations to the European Patent Convention bore a strong similarity to PCT Rule 91.1, and felt it advisable that the two Rules and the relevant practice in relation to them be as uniform as possible. The European Patent Office

was awaiting a pending decision of the Enlarged Board of Appeal which was expected to deal with various aspects of rectification of errors. The Representative believed that the decision would be helpful for further consideration of the United Kingdom's proposal, and indicated that he would, after making enquiries, advise the International Bureau of when the decision could be expected.

45. The Director General stated that the fact that the proposed Patent Law Treaty contained provisions on amendments and corrections of patent applications should not prevent the early consideration of the United Kingdom's proposal.

46. The Delegations of Sweden and France supported the Director General's statement.

47. The Assembly decided not to consider the United Kingdom's proposal further at its present session and invited the International Bureau to convene an early meeting of the PCT Committee for Administrative and Legal Matters for a detailed study of the proposal.

Amendments to the Regulations Under the PCT in Connection With Certain Newly Independent States

48. Discussions were based on document PCT/A/XX/4.

49. In introducing its proposal, the International Bureau noted that the system contained in the proposal had been specially created in response to a situation not envisaged in the PCT itself.

50. The Delegation of the Russian Federation expressed agreement with the proposal, noting that it appeared to meet fully the previously unforeseen situation which had arisen with the cessation of the existence of the Soviet Union.

51. The Delegation of Ukraine, in supporting the proposal, observed that a time gap between the cessation of the existence of the Soviet Union and the deposit of a declaration of continuation was inevitable. The Delegation stated that Ukraine was ready to fulfil its obligations under the proposed new Rules.

52. The Delegation of France, while agreeing that provisions were needed to deal with the situation which had arisen, expressed its concern as to the legal basis for the proposal. First, the Delegation was not of the opinion that it would be by a declaration of continuation that successor States would become member States, since, in the Delegation's view, the fact that a State was a successor State made that State a Contracting State. Second, the Delegation was of the opinion that the Soviet Union had not ceased to exist; it continued to exist as the Russian Federation. The Delegation proposed certain modifications of the wording of the proposed Rules designed to overcome these legal problems.

53. The Delegation of Japan stated that it agreed with the intention behind the proposal of the International Bureau. However, the Delegation expressed concern as to the general legal basis of the proposed system. It was not clear whether Article 58(1) of the PCT enabled the Assembly to make Regulations governing declarations of continuation; rather, the Assembly should deal with such cases by way of making decisions. The Delegation observed that a declaration could be deposited by a successor State which in fact was not diplomatically

recognized by one or more of the existing Contracting States. A declaration deposited under proposed PCT Rule 32.1 could, in the Delegation's view, only be effective if the existing PCT Contracting States recognized the successor State.

54. The Director General pointed out that the making of Regulations is, in itself, a decision of the Assembly. In any event, Article 58(1)(ii) and (iii) of the PCT provided, in itself, a sufficient legal basis for the proposed new Rules. The application of the PCT or of any of the international treaties administered by WIPO to a State could not be denied by another State on the ground there were no diplomatic relations between the two States since the mutual obligations provided for in a multilateral treaty flowed from that treaty, and that treaty alone; consequently the lack of diplomatic recognition was irrelevant. The Director General also noted that direct benefits under the proposed new Rules would be enjoyed, in particular, by applicants from Contracting States other than the successor State because such applicants could, under the proposed new Rules, extend their rights to the successor State having deposited a declaration of continuation.

55. The Delegation of Germany pointed out that benefits would also accrue to the successor States concerned, particularly in relation to the importation of technology associated with the granting of patents to nationals and residents of other Contracting States. As to the legal basis of the proposed new Rules, the Delegation's view was that the Assembly was clearly competent to act; the mode by which a decision was expressed (by making Regulations or otherwise) was not relevant.

56. Noting the concerns expressed by the Delegation of France, the International Bureau modified its proposal in relation to proposed new PCT Rule 32.1(d) by omitting the words "as a successor State."

57. In response to a query by the Delegation of Germany, the International Bureau advised that the extension fee required under proposed PCT Rule 32.1(c)(ii) would be payable in every case, even if the maximum fee for ten designations had already been paid. Although the extension fee was of the same amount as the designation fee, it was a different fee which was not subject to the maximum amount payable for designation fees. The extension fee was intended to cover the costs incurred by the International Bureau in its operations under the proposed Rules.

58. The Delegations of Switzerland, the United Kingdom, Australia, the Netherlands, the Democratic People's Republic of Korea, Austria and Belgium joined those who had already expressed their support for the International Bureau's proposal. Satisfaction and congratulations were expressed for the rapid and creative approach taken by the International Bureau in addressing the unusual situation posed by the ceasing of the existence of the Soviet Union.

59. The Assembly adopted PCT Rules 32.1 and 32.2 as set out in Annex II to this report and decided that the said Rules would enter into force on October 1, 1992.

60. The Delegations of France and Japan stated that, had a vote been taken on the question, they would have voted against the adoption of the said Rules.

[Annexes follow]

ANNEX I

AGREEMENT
between

the CHINESE PATENT OFFICE

and the WORLD INTELLECTUAL PROPERTY ORGANIZATION
in relation to the functioning of
the CHINESE PATENT OFFICE as
an International Searching and International Preliminary
Examining Authority under the Patent-Cooperation Treaty

The Chinese Patent Office and the World Intellectual Property Organization
hereby agree as follows:

Article 1

Terms and Expressions Used in the Agreement

(1) For the purposes of this Agreement:

- (a) “Treaty” means the Patent Cooperation Treaty;
- (b) “Regulations” means the Regulations under the Treaty;
- (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
- (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
- (e) “Rule” means a Rule of the Regulations;
- (f) “Contracting State” means a State party to the Treaty;
- (g) “Authority” means the Chinese Patent Office.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2

Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching and International Preliminary Examining Authority as are provided under the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall be guided

by the Guidelines for International Search and for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty. The Authority shall apply and observe all the common rules of international search and of international preliminary examination.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent possible, mutual assistance in the performance of their functions thereunder.

Article 3 **Competence of Authority**

(1) The Authority shall act as an international Searching Authority for all international applications filed with the receiving Office of, or acting for, any Contracting State indicated in Annex A of this Agreement, provided that the receiving Office specifies the Authority for that purpose and that such applications are in one of the languages specified in Annex A of this Agreement.

(2) The Authority shall act as an International Preliminary Examining Authority for all international applications filed with the receiving Office of, or acting for, any Contracting State indicated in Annex A of this Agreement, provided that the receiving Office specifies the Authority for that purpose and that such applications are in one of the languages specified in Annex A of this Agreement.

Article 4 **Subject Matter Not Required to be Searched or Examined**

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or shall not be obliged to examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that the international application relates to subject matter set forth in Rule 39.1 or Rule 67.1, as the case may be, with the exception of the subject matter specified in Annex B of this Agreement.

Article 5 **Fees and Charges**

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its function as an International Searching and International Preliminary Examining Authority, is set out in Annex C of this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C of this Agreement, refund the whole or part of the search fee paid where an international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1) or where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C of this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6 **Classification**

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7 **Languages of Correspondence Used by the Authority**

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language, specified in Annex A of this Agreement, which is the language of the international application.

Article 8 **International-Type Search**

The Authority shall carry out international-type searches to the extent decided by it.

Article 9 **Entry Into Force of the Agreement**

This Agreement shall enter into force on the day on which China becomes bound by the PCT.

Article 10 **Duration and Renewability of the Agreement**

This Agreement shall remain in force for five years. At the latest four years after its entry into force, the parties to this Agreement shall start negotiations for its renewal.

Article 11 **Amendment**

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes of this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by notice in writing given to the Director General of the World Intellectual Property Organization:

(i) add to the States and languages listed in Annex A of this Agreement;

(ii) amend the schedule of fees and other charges contained in Annex C of this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified by the Authority, provided that for any increase of fees or other charges contained in Annex C that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12 **Termination of the Agreement**

(1) This Agreement shall terminate before the expiration of the five-year period referred to in Article 10 of this Agreement:

(i) if the Authority gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

(ii) if the Director General of the World Intellectual Property Organization gives the Authority written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

DONE at Geneva, this th day of September 1992, in two originals in the Chinese and English languages, each text being equally authentic.

For the Authority by:

.....

For the World Intellectual Property Organization by:

.....

ANNEX A
STATES AND LANGUAGES

Under Article 3 of the Agreement, the Authority

(i) shall act for the following States:

China,

any developing country that the Authority will specify;

(ii) specifies the following languages:

Chinese,

English.

ANNEX B
SUBJECT MATTER NOT EXCLUDED
FROM SEARCH OR EXAMINATION

The subject matter set forth in Rule 39.1 or Rule 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

Subject matter which is searched or examined in Chinese national applications.

ANNEX C

**FEES AND CHARGES FOR INTERNATIONAL SEARCH
AND PRELIMINARY EXAMINATION**

Part I: Schedule of Fees and Charges

Kind of fee or charge

	Amount (RMB Yuan)
Search fee (Rule 16.1(a))	800
Additional fee (Rule 40.2(a))	800
Preliminary examination fee (Rule 58.1(b))	800
Additional fee (Rule 68.3(a))	800
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1)	2 per page

**Part II: Conditions and Extent of Refunds of the Search Fee and of the
Preliminary Examination Fee**

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or is considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search to the full extent or to a substantially prevailing portion, 75% of the search fee paid shall be refunded.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) If the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

[Annex II follows]

ANNEX II

AMENDMENTS TO PCT REGULATIONS

Rule 10
Terminology and Signs

10.1 Terminology and Signs

(a) to (e) [No change]

(f) When the international application or its translation is in Chinese, English or Japanese, the beginning of any decimal fraction shall be marked by a period, whereas, when the international application or its translation is in a language other than Chinese, English or Japanese, it shall be marked by a comma.

10.2 [No change]

Rule 11
Physical Requirements of the International Application

11.1 to 11.8 [No change]

11.9 Writing of Text Matter

(a) [No change]

(b) Only graphic symbols and characters, chemical or mathematical formulae, and certain characters in the Chinese or Japanese language may, when necessary, be written by hand or drawn.

(c) and (d) [No change]

(e) As far as the spacing of the typing and the size of the characters are concerned, paragraphs (c) and (d) shall not apply to texts in the Chinese or Japanese language.

11.10 to 11.14 [No change]

Rule 32 [New]
Extension of Effects of International Application to Certain Successor States

32.1 Request for Extension of International Application to Successor State

(a) The effects of any international application whose international filing date falls in the period defined in paragraph (b) may, subject to the performance by the applicant of the acts specified in paragraph (c), be extended to a State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting State which subsequently ceased to exist (“the predecessor State”), provided that the successor State has become a Contracting State through the deposit, with the Director General, of a declaration of continuation the effect of which is that the Treaty is applied by the successor State.

(b) The period referred to in paragraph (a) starts on the day following the last day of the existence of the predecessor State and ends two months after the date on which the declaration referred to in paragraph (a) was notified by the Director General to the Governments of the States party to the Paris Convention for the Protection of Industrial Property. However, where the date of independence of the successor State is earlier than the date of the day following the last day of the existence of their predecessor State, the successor State may declare that the said period starts on the date of its independence; such a declaration shall be made together with the declaration referred to in paragraph (a) and shall specify the date of independence.

(c) In respect of any international application whose filing date falls within the applicable period under paragraph (b), the International Bureau shall send the applicant a notification informing him that he may make a request for extension by performing, within three months from the date of that notification, the following acts:

(i) filing with the International Bureau the request for extension;

(ii) paying to the International Bureau an extension fee in Swiss francs, the amount of which shall be the same as the amount of the designation fee referred to in Rule 15.2(a).

(d) This Rule shall not apply to the Russian Federation.

32.2 Effects of Extension to Successor State

(a) Where a request for extension is made in accordance with Rule 32.1,

(i) the successor State shall be considered as having been designated in the international application, and

(ii) the applicable time limit under Article 22 or 39(1) in relation to that State shall be extended until the expiration of at least three months from the date of the request for extension.

(b) Where, in the case of a successor State which is bound by Chapter II of the Treaty, the request for extension was made after, but the demand was made before, the expiration of

the 19th month from the priority date, and a later election is made of the successor State within three months from the date of the request for extension, the applicable time limit under paragraph (a)(ii) shall be at least 30 months from the priority date.

(c) The successor State may fix time limits which expire later than those provided in paragraphs (a)(ii) and (b). The International Bureau shall publish information on such time limits in the Gazette.

Rule 37
Missing or Defective Title

37.1 [Amendment to the French text only]

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 published or, if a translation was transmitted under Rule 12.1(c) and the international Searching Authority so wishes, in the language of that translation.

Rule 38
Missing or Defective Abstract

38.1 [Amendment to the French text only]

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 published or, if a translation was transmitted under Rule 12.1(c) and the International Searching Authority so wishes, in the language of that translation.

(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 published or, if a translation was transmitted under Rule 12.1(c) and the International Searching Authority so wishes, in the language of that translation.

43.5 to 43.10 [No change]

Rule 48
International Publication

48.1 and 48.2 [No change]

48.3 Languages

(a) If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish, that application shall be published in the language in which it was filed.

(b) If the international application is filed in a language other than Chinese, English, French, German, Japanese, Russian or Spanish, that application shall be published in English translation. the translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the essence of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

(c) [No change]

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 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.

55.2 Translation of International Application

(a) Where the international application is neither filed nor published in the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Preliminary Examining Authority competent for the international preliminary examination of that application, that Authority may require that, subject to paragraph (b), the applicant furnish with the demand a translation of the international application into the language, or one of the languages, specified in the said agreement.

(b) Where a translation of the international application into a language referred to in paragraph (a) was transmitted to the International Searching Authority under Rule 12.1(c) and the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority, the applicant need not furnish a translation under paragraph (a). In such a case, unless the applicant furnishes a translation under paragraph (a), the international preliminary examination shall be carried out on the basis of the translation transmitted under Rule 12.1(c).

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

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

(e) Paragraphs (a) to (d) shall apply only where the International Preliminary Examining Authority has declared, in a notification addressed to the International Bureau, that it accepts to carry out international preliminary examination on the basis of the translation referred to in those paragraphs.

* The title has been amended to read “Language of Demand” instead of “The Demand”.

55.3 Translation of Amendments

(a) Where a translation of the international application is required under Rule 55.2, any amendments which are referred to in the statement concerning amendments under Rule 53.9 and which the applicant wishes to be taken into account for the purposes of the international preliminary examination, and any amendments under Article 19 which are to be taken into account under Rule 66.1(c), shall be in the language of that translation. Where such amendments have been or are filed in another language, a translation shall also be furnished.

(b) Where the required translation of an amendment referred to in paragraph (a) is not furnished, the International Preliminary Examining Authority shall invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(c) If the applicant fails to comply with the invitation within the time limit under paragraph (b), the amendment shall not be taken into account for the purposes of the international preliminary examination.

Rule 60
Certain Defects in the Demand or Elections

60.1 Defects in the Demand

(a) If the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(b) to (g) [No change]

60.2 [No change]

Rule 61
Notification of the Demand and Elections

61.1 Notification to the International Bureau and the Applicant

(a) [No change]

(b) The International Preliminary Examining Authority shall promptly inform the applicant in writing of the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 55.2(d), 57.4(c), 58.2(c) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 60.1(d) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) [No change]

61.2 to 61.4 [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(a), shall be submitted in the language of publication.

(b) If the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, any amendment, as well as any letter referred to in paragraph (a), shall be submitted in the language of that translation.

(c) Subject to Rule 55.3, if an amendment or letter is not submitted in a language as required under paragraph (a) or (b), the International Preliminary Examining Authority shall, if practicable having regard to the time limit for establishing the international preliminary examination report, invite the applicant to furnish the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances.

(d) If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

Rule 70
The International Preliminary Examination Report

70.1 to 70.16 [No change]

70.17 Languages of the Report and the Annexes

(a) The report and any annex shall be in the language in which the international application to which they relate is published, 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.

(b) [Remains deleted]

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) Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), transmit a translation of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report, unless such sheet is in the language of the required translation of the international application. The same time limit shall apply where the furnishing of a translation of the international application to the elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22.

(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 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.

Rule 92

Correspondence

92.1 [No change]

92.2 Languages

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 12.1(c) or furnished under Rule 55.2(a) or (c), the language of such translation shall be used.

(b) to (e) [No change]

92.3 and 92.4 [No change]

[End of Annex II and of document]

WIPO



PCT/A/XXI/5

ORIGINAL: English

DATE: September 29, 1993

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY Twenty-First Session (9th Ordinary) Geneva, September 20 to 29, 1993

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XXIV/1 Rev.): 1, 2, 3, 4, 11, 14, 16, 17, 19, 24 and 25.
2. The report on the said items, with the exception of item 11, is contained in the General Report (document AB/XXIV/18).
3. The report on item 11 is contained in the present document.
4. Mr. Alec Sugden (United Kingdom) was elected Chairman of the Assembly.

**ITEM 11 OF THE CONSOLIDATED AGENDA:
MATTERS CONCERNING THE PCT UNION**

Finances of the PCT Union

5. Discussions were based on document PCT/A/XXI/1.
6. The Delegations of the United States of America, Japan, the United Kingdom, Italy, Denmark, Portugal, Belgium and Canada stated that they welcomed the continuing success of the PCT and the growth in its use. The Delegations of the United States of America, the United Kingdom, Italy, Portugal and Canada said that they accepted that more funds of the PCT Union would be devoted to development cooperation.
7. The Assembly approved the increased level of participation of the PCT Union in the financing of program activities of the Organization, as proposed in paragraphs 4 to 12 of document PCT/A/XXI/1.
8. The discussions then focussed on the proposed increase of the PCT fees by 10% effective January 1, 1994.
9. In introducing that proposal, the Director General emphasized the need to build up the special reserve for additional premises and computerization investments. The target at the present time would be between 100 and 150 million francs.
10. The Delegations of the United States of America, Japan, the United Kingdom, Italy, Australia, Germany, Denmark, the Russian Federation, the Netherlands, Belgium and Canada stated that they could not support the proposed fee increase, on one or more of the following grounds: the need for additional premises and computerization investments required further demonstration; there was no need for a fee increase since the expected surplus of the PCT Union, even without a fee increase, would be 11 million francs; in the circumstances it would be difficult to justify increased fees to applicants; in the light of the difficult economic climate, various national Offices had frozen their fees for the next year and the same should be done for the PCT; increased fees could make the PCT system less attractive and used less than without a fee increase; the last PCT fee increase was only two years ago. The Delegations of the United States of America and the United Kingdom suggested that consideration be given to a reduction of the fees.
11. The Delegations of Portugal, Sweden and Brazil said that they supported the proposed fee increase, on one or several of the following grounds: there was a need for significant reserve funds for investments for additional premises and computerization; it was prudent to aliment the reserve while this was possible; the actual amounts of the fees, even if increased, were very small, so that it was unlikely that this would reduce the use of the PCT system; it was better to increase fees more frequently and modestly than infrequently but substantially. The Delegations of Sweden and Brazil added that they could also accept a fee increase of less than 10%.
12. The Delegation of Finland, recognizing the need of the Organization for funds in the future, proposed as a compromise that the fee increase be 5% effective January 1, 1994. That proposal was supported by the Delegations of Spain, Norway, Cote d'Ivoire, Austria,

Romania, Switzerland, the Czech Republic, Ireland, France, Hungary and the Democratic People's Republic of Korea.

13. The Delegations of the United States of America, Germany, Australia and the United Kingdom said that they could not go along with such a 5% fee increase.

14. The Delegation of the United Kingdom suggested, as a further compromise, that a 5% fee increase might be implemented a year later, that is, effective January 1, 1995. That suggestion was supported by the Delegations of Italy and Belgium.

15. On the proposal of the Delegation of Sweden, supported by the Delegation of Australia, it was agreed to put to the vote the questions of (i) whether there should be a fee increase or not and, if an increase was supported, (ii) whether the fee increase should be 5%. Voting was undertaken by show of hands.

16. The result of the vote on the first question was 29 votes in favor of a fee increase, and 13 votes against a fee increase.

17. The result of the vote as to the amount of the fee increase was 26 votes in favor of a 5% fee increase effective January 1, 1994, and 13 votes against. Since the required three-quarters majority was not obtained, the proposal failed.

18. The Director General proposed that it should be understood that the PCT Assembly could examine the possibility of a fee increase in an extraordinary session in 1994.

19. The Assembly agreed with this understanding, and also decided to approve the proposal contained in paragraph 30 of document PCT/A/XXI/1.

The International Bureau as alternative receiving Office: proposed amendments to the Regulations under the PCT*

20. Discussions of the proposal to amend the Regulations were based on documents PCT/A/XXI/2 (paragraphs 1 to 36 and Annex, containing proposals approved by the PCT Committee for Administrative and Legal Matters at its fifth session) and PCT/A/XXI/4 (containing a proposal by the Delegation of the United Kingdom relating to Rule 35.3).

21. The Delegation of the United Kingdom explained that its proposal would ensure that each PCT Contracting State would be able to specify the competent International Searching Authority(ies) and International Preliminary Examining Authority(ies) for international applications filed by its nationals and residents, whether those international applications were filed with the national Office of or acting for that State or with the International Bureau as receiving Office under Rule 19.1(a)(iii). The Delegation believed that its proposal aimed at maintaining the status quo, which was desirable, at least for the time being. However, the United Kingdom would be ready to study the wider political issue of whether or not the International Bureau, when acting as receiving Office, should be empowered to pass the

* References in this report to “Articles” and “Rules” are, respectively, to those of the Patent Cooperation Treaty (PCT) and of the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case requires.

international application to any International Searching Authority chosen by the applicant with which the International Bureau had an agreement. The Delegation's proposal was supported by the Delegations of Denmark, Romania, Portugal, Sweden, Ireland, the Russian Federation, Japan, Italy, Belgium, Finland, Canada, Bulgaria, Hungary and Austria. The International Bureau also expressed its support for the proposal of the Delegation of the United Kingdom.

22. The Delegation of France repeated the view which it had expressed during the fifth session of the PCT Committee for Administrative and Legal Matters that the role of receiving Office should be reserved to national Offices, but said that, in a spirit of compromise, it would join the consensus. The Delegation stated that it preferred the proposal of the Delegation of the United Kingdom in relation to Rule 35.3 to that contained in document PCT/A/XXI/2.

23. The Delegation of Australia expressed its preference for proposed Rule 35.3 as contained in document PCT/A/XXI/2. The Delegation believed that that proposal would give applicants filing with the International Bureau as receiving Office under Rule 19.1(a)(iii) a wider choice of competent International Searching and Preliminary Examining Authorities, the choice depending only on the readiness of the various Authorities to act for nationals and residents of particular PCT Contracting States. However, the Delegation said that it could accept the proposal of the Delegation of the United Kingdom.

24. While supporting the proposal of the Delegation of the United Kingdom, a number of delegations felt that the broader proposal relating to Rule 35.3 contained in document PCT/A/XXI/2 would be worth further study. The Chairman noted that further consideration might be given to the matter by the PCT Committee for Administrative and Legal Matters.

25. In response to a question by the Delegation of the Netherlands in connection with the operation of proposed Rule 19.4 in relation to Article 11(2), the International Bureau stated that proposed Rule 19.4 was intended to be so interpreted that a national Office would not transmit an international application to the International Bureau as receiving Office under Rule 19.1(a)(iii) if the national Office had made a finding that no applicant was a resident or national of any PCT Contracting State. In such a case, Article 11(2) would apply. However, if it appeared that any applicant was a resident or national of a PCT Contracting State, but the national Office was not competent to act as receiving Office, then the international application would be transmitted under Rule 19.4 to the International Bureau as receiving Office.

26. The Assembly agreed that an applicant should not be obliged to make a special request that the Office transmit the international application under Rule 19.4 to the International Bureau as receiving Office, and the text contained in square brackets in proposed Rules 4.1(c)(iii) and 19.4(b) should therefore be omitted. However, the PCT Receiving Office Guidelines should be revised to include details of a procedure whereby the Office concerned would contact the applicant to inform him that it intended to transmit the international application to the International Bureau as receiving Office.

27. The Assembly adopted the amendments to the Regulations under the PCT as set out in Annex I to this report, and decided that those amendments would enter into force on January 1, 1994.

Rule 91.1 of the Regulations under the PCT (obvious errors in documents)

28. Discussions were based on document PCT/A/XXI/2, paragraphs 37 to 42.

29. The Assembly noted the conclusions of the PCT Committee for Administrative and Legal Matters at its fifth session concerning obvious errors in documents and, in particular, the intention of the Committee to consider further improvements in specific remedies, particularly in relation to Rule 4.10(b).

30. It was noted that the amendments to the Regulations set out in Annex I to this report included a minor amendment to the English text of Rule 91.1.

Rule 34.1 of the Regulations under the PCT (cut-off date of PCT minimum documentation)

31. Discussions were based on document PCT/A/XXI/2, paragraphs 43 and 44.

32. The Assembly noted the conclusion of the PCT Committee for Technical Cooperation at its twentieth session, namely, that the cut-off date of the PCT minimum documentation as set out in Rule 34.1 should not be changed.

Rule 84.1 of the Regulations under the PCT (expenses of delegations)

33. Discussions were based on document PCT/A/XXI/2, paragraphs 45 to 51.

34. In response to a question by a delegation, the International Bureau confirmed that the proposal was compatible with the financial situation of the PCT Union, whether or not the PCT fees were increased.

35. The Assembly agreed to suspend the application of Rule 84.1 in relation to its own sessions and the sessions of the PCT Committee for Administrative and Legal Matters, to the extent that the travel and subsistence expenses of one delegate of each PCT Contracting State for the sessions of those bodies be paid from the budget of the PCT Union. The Assembly also agreed that, if such suspension could not be continued at any time beyond 1995 because of lack of sufficient funds, the Director General would make proposals to end the suspension.

Appointment of the Spanish Patent and Trademark Office as International Searching Authority

36. Discussions were based on the proposals by the International Bureau contained in document PCT/A/XXI/3, and the advice to the Assembly contained in document PCT/CTC/XVI/3, paragraph 13, which the PCT Committee for Technical Cooperation had made pursuant to Article 16(3)(e). The Chairman noted that the Committee had unanimously recommended that the Assembly approve the draft agreement between the Spanish Patent and Trademark Office and WIPO as set out in the Annex to document PCT/A/XXI/3 and appoint the Spanish Patent and Trademark Office as International Searching Authority with effect from the entry into force of the said agreement.

37. In response to an invitation by the Chairman and in accordance with Article 16(3)(e), the Delegation of Spain made a statement to the Assembly. It first expressed its gratitude for the

interest, support and assistance it had received from other countries and organizations. It emphasized the importance of the appointment of the Spanish Patent and Trademark Office as International Searching Authority not only to Spanish applicants but potentially to all those countries which had Spanish as an official language. The Delegation observed that this appointment would be an important step towards greater acceptance of the PCT in Spanish speaking countries and towards the ultimate accomplishment of the PCT's stated goals. The Delegation additionally expressed its hope that the number of PCT applications filed by Spanish applicants would increase significantly.

38. The Delegation explained the capability of the Spanish Patent and Trademark Office to undertake the work of an International Searching Authority. Since 1986, the Office had undertaken a great effort in acquiring necessary documentation and in recruiting and training technically qualified personnel for the search and examination of patent applications. As a result of this effort, the Office now possessed the minimum documentation referred to in Rule 36.1(ii), and additionally an extensive collection of patent documents from countries of Latin America. The Office employed 80 technically and linguistically qualified full-time examiners, many of whom had received additional training at the European Patent Office and the Austrian Patent Office. The Delegation expected that between 1994 and 1995 the Spanish Patent and Trademark Office would reach the level of 100 examiners qualified to undertake international searches.

39. The Director General expressed his hope that, with the Spanish Patent and Trademark Office carrying out international searches of international applications filed in Spanish, Latin American countries would adhere to the PCT in the near future.

40. The Assembly:

(i) approved the text of the agreement between the Spanish Patent and Trademark Office and WIPO as set out in Annex II to this report, and

(ii) appointed the Spanish Patent and Trademark Office as International Searching Authority with effect from the entry into force of the said agreement.

Designation of Chinese as a language in which an official text of the PCT shall be established

41. Discussions were based on an oral proposal made by the International Bureau in view of China's becoming bound by the PCT on January 1, 1994.

42. The Assembly designated Chinese as a language in which an official text of the PCT shall be established pursuant to Article 67(1)(b).

[Annexes follow]

ANNEX I

**AMENDED RULES OF THE REGULATIONS UNDER THE PATENT
COOPERATION TREATY APPLICABLE FROM JANUARY 1, 1994**

Rule 4
The Request (Contents)

4.1 Mandatory and Optional Contents; Signature

(a) [No change]

(b) The request shall, where applicable, contain:

(i) to (iv) [No change]

(v) a reference to a parent application or parent patent,

(vi) an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) [No change]

4.2 to 4.14 [No change]

4.14bis Choice of International Searching Authority

If two or more International Searching Authorities are competent for the searching of the international application, the applicant shall indicate his choice of International Searching Authority in the request.

4.15 to 4.17 [No change]

ANNEX I

Rule 18
The Applicant

18.1 Residence and Nationality

(a) Subject to the provisions of paragraphs (b) and (c), the question whether an applicant is a resident or national of the Contracting State of which he claims to be a resident or national shall depend on the national law of that State and shall be decided by the receiving Office.

(b) In any case,

(i) possession of a real and effective industrial or commercial establishment in a Contracting State shall be considered residence in that State. and

(ii) a legal entity constituted according to the national law of a Contracting State shall be considered a national of that State.

(c) Where the international application is filed with the International Bureau as receiving Office, the International Bureau shall, in the circumstances specified in the Administrative Instructions, request the national Office of, or acting for, the Contracting State concerned to decide the question referred to in paragraph (a). The International Bureau shall inform the applicant of any such request. The applicant shall have an opportunity to submit arguments directly to the national Office. The national Office shall decide the said question promptly.

18.2 [Deleted]

18.3 and 18.4 [No change]

ANNEX I

Rule 19

The Competent Receiving Office

19.1 Where to File

(a) Subject to the provisions of paragraph (b), the international application shall be filed, at the option of the applicant,

(i) with the national Office of or acting for the Contracting State of which the applicant is a resident,

(ii) with the national Office of or acting for the Contracting State of which the applicant is a national, or

(iii) irrespective of the Contracting State of which the applicant is a resident or national, with the International Bureau.

(b) and (c) [No change]

19.2 Two or more Applicants

If there are two or more applicants:

(i) the requirements of Rule 19.1 shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national;

(ii) the international application may be filed with the International Bureau under Rule 19.1(a)(iii) if at least one of the applicants is a resident or national of a Contracting State.

19.3 [No change]

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 that national Office is not competent under Rule 19.1 or 19.2 to receive that international application, that international application shall, subject to paragraph (b), be considered to have been received by that Office on behalf of the International Bureau as receiving Office under Rule 19.1(a)(iii).

(b) Where, pursuant to paragraph (a), an international application is received by a national Office on behalf of the International Bureau as receiving Office under Rule 19.1(a)(iii),

ANNEX I

that national Office shall, unless prescriptions concerning national security prevent the international application from being so transmitted, promptly transmit it to the International Bureau. Such transmittal may be subjected by the national Office to the payment of a fee, for its own benefit, equal to the transmittal fee charged by that Office under Rule 14. The international application so transmitted shall be considered to have been received by the International Bureau as receiving Office under Rule 19.1(a)(iii) on the date of receipt of the international application by that national Office.

ANNEX I

Rule 35

The Competent International Searching Authority

35.1 and 35.2 [No change]

35.3 When the International Bureau Is Receiving Office Under Rule 19.1(a)(iii)

(a) Where the international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), an International Searching Authority shall be competent for the searching of that international application if it would have been competent had that international application been filed with a receiving Office competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

(b) Where two or more International Searching Authorities are competent under paragraph (a), the choice shall be left to the applicant.

(c) Rules 35.1 and 35.2 shall not apply to the International Bureau as receiving Office under Rule 19.1(a)(iii).

ANNEX I

Rule 54

The Applicant Entitled to Make a Demand

54.1 Residence and Nationality

(a) Subject to the provisions of paragraph (b), the residence or nationality of the applicant shall, for the purposes of Article 31(2), be determined according to Rule 18.1(a) and (b).

(b) The International Preliminary Examining Authority shall, in the circumstances specified in the Administrative Instructions, request the receiving Office or, where the international application was filed with the International Bureau as receiving Office, the national Office of, or acting for, the Contracting State concerned to decide the question whether the applicant is a resident or national of the Contracting State of which he claims to be a resident or national. The International Preliminary Examining Authority shall inform the applicant of any such request. The applicant shall have an opportunity to submit arguments directly to the Office concerned. The Office concerned shall decide the said question promptly.

54.2 [No change]

54.3 International Applications Filed with the International Bureau as Receiving Office

Where the international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), the International Bureau shall, for the purposes of Article 31(2)(a), be considered to be acting for the Contracting State of which the applicant is a resident or national.

54.4 [No change]

ANNEX I

Rule 59

The Competent International Preliminary Examining Authority

59.1 Demands Under Article 31(2)(a)

(a) For demands made under Article 31(2)(a), each receiving Office of or acting for a Contracting State bound by the provisions of Chapter II shall, in accordance with the terms of the applicable agreement referred to in Article 32(2) and (3), inform the International Bureau which International Preliminary Examining Authority is or which International Preliminary Examining Authorities are competent for the international preliminary examination of international applications filed with it. The International Bureau shall promptly publish such information. Where several International Preliminary Examining Authorities are competent, the provisions of Rule 35.2 shall apply *mutatis mutandis*.

(b) Where the international application was filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), Rule 35.3(a) and (b) shall apply *mutatis mutandis*. Paragraph (a) of this Rule shall not apply to the International Bureau as receiving Office under Rule 19.1(a)(iii).

59.2 [No change]

ANNEX I

Rule 83

Right to Practice Before International Authorities

83.1 [No change]

83.1*bis* Where the International Bureau Is the Receiving Office

(a) Any person who has the right to practice before the national Office of, or acting for, a Contracting State of which the applicant or, if there are two or more applicants, any of the applicants is a resident or national shall be entitled to practice in respect of the international application before the International Bureau in its capacity as receiving Office under Rule 19.1(a)(iii).

(b) Any person having the right to practice before the International Bureau in its capacity as receiving Office in respect of an international application shall be entitled to practice in respect of that application before the International Bureau in any other capacity and before the competent International Searching Authority and competent International Preliminary Examining Authority.

83.2 [No change]

ANNEX I

Rule 90

Agents and Common Representatives

90.1 Appointment as Agent

(a) A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority.

(b) and (c) [No change]

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office. as the case may be;

(ii) [No change]

90.2 to 90.6 [No change]

ANNEX I

Rule 91
Obvious Errors in Documents

91.1 Rectification

(a) to (d) [No change]

(e) No rectification shall be made except with the express authorization:

(i) and (ii) [No change]

(iii) of the International Preliminary Examining Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority,

(iv) [No change]

(f) to (g-*quater*) [No change]

[Annex II follows]

AGREEMENT
between
the SPANISH PATENT AND TRADEMARK OFFICE
and the WORLD INTELLECTUAL PROPERTY ORGANIZATION
in relation to the functioning of
the SPANISH PATENT AND TRADEMARK OFFICE as
an International Searching Authority
under the Patent Cooperation Treaty

The Spanish Patent and Trademark Office and the World Intellectual Property Organization
hereby agree as follows:

Article 1
Terms and Expressions Used in the Agreement

(1) For the purposes of this Agreement:

- (a) “Treaty” means the Patent Cooperation Treaty;
- (b) “Regulations” means the Regulations under the Treaty;
- (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
- (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
- (e) “Rule” means a Rule of the Regulations;
- (f) “Contracting State” means a State party to the Treaty;
- (g) “Authority” means the Spanish Patent and Trademark Office.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search in accordance with, and perform such other functions of an International Searching Authority as are provided under the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search, the Authority shall be guided by the Guidelines for International Search to Be Carried

Out under the Patent Cooperation Treaty. The Authority shall apply and observe all the common rules of international search.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent possible, mutual assistance in the performance of their functions thereunder.

(3) The Authority undertakes to comply with the conditions laid down in Rule 36.1(i) within three years from the entry into force of this Agreement.

Article 3 Competence of Authority

The Authority shall act as an International Searching Authority for all international applications filed in the Spanish language with the receiving Office of, or acting for, any Contracting State where that Office has specified the Authority for that purpose.

Article 4 Subject Matter Not Required to Be Searched

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), any international application to the extent that it considers that the international application relates to subject matter set forth in Rule 39.1, with the exception of the subject matter specified in Annex A of this Agreement.

Article 5 Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its function as an International Searching Authority, is set out in Annex B of this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex B of this Agreement, refund the whole or part of the search fee paid where an international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1) or where the international application is withdrawn or considered withdrawn before the start of the international search.

Article 6 Classification

For the purposes of Rule 43.3(a), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the Spanish language.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry Into Force of the Agreement

This Agreement shall enter into force upon approval by the Assembly of the International Patent Cooperation Union and subsequent signature.

Article 10
Duration and Renewability of the Agreement

This Agreement shall remain in force until December 31, 1997. Latest in January 1997, the parties to this Agreement shall start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes of this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by notice in writing given to the Director General of the World Intellectual Property Organization, amend the schedule of fees and other charges contained in Annex B of this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified by the Authority, provided that for any increase of fees or other charges contained in Annex B that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination of the Agreement

(1) This Agreement shall terminate before December 31, 1997:

(i) if the Authority gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

(ii) if the Director General of the World Intellectual Property Organization gives the Authority written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

DONE at Geneva, this th day of, 1993, in two originals in the English and Spanish languages, each text being equally authentic.

For the Authority by:

For the World Intellectual Property
Organization by:

.....

.....

ANNEX A
SUBJECT MATTER NOT EXCLUDED
FROM SEARCH

The subject matter set forth in Rule 39.1 which, under Article 4 of the Agreement, is not excluded from search, is the following:

None.

ANNEX B
FEES AND CHARGES FOR INTERNATIONAL SEARCH

Part I: Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> (Peseta)
Search fee (Rule 16.1(a))	50,100 [*]
Additional fee (Rule 40.2(a))	50,100 [*]
Cost of copies (Rule 44.3(b))	
(national documents)	500 ^{**}
(foreign documents)	700 ^{**} per document

Part II: Conditions and Extent of Refund of the Search Fee

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees or charges indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or is considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search, 25%, 50%, 75% or 100% of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

[End of Annexes and of document]

^{*} Amount fixed in accordance with the first schedule of fees "Acquisition and defense of rights," 1.1 Applications, application for state-of-the-art search reports, Law No. 11/86 of March 20 on Patents, as updated by the General Tax Law of 1992.

^{**} Amount fixed in accordance with Item 2 "Documentary holdings" of the Annex to the Order of November 12, 1992, approving the fees for certain activities of the Spanish Patent and Trademark Office.

WIPO



PCT/A/XXII/2

ORIGINAL: English

DATE: October 4, 1994

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Twenty-Second Session (13th Extraordinary)
Geneva, September 26 to October 4, 1994

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XXV/1 Rev.): 1, 2, 8, 14 and 15.
2. The report on the said items, with the exception of item 8, is contained in the General Report (document AB/XXV/6).
3. The report on item 8 is contained in the present document.

**ITEM 8 OF THE CONSOLIDATED AGENDA:
MATTERS CONCERNING THE PCT UNION**

Accession of Mexico to the PCT

4. The Director General announced that Mexico had just deposited its instrument of accession to the PCT. He particularly welcomed this accession as Mexico was the first Spanish-speaking Latin American country to join the PCT. He expressed the ardent hope that this would encourage other Latin American countries to accede to the PCT.

5. The Delegation of Mexico stated that its accession to the PCT was a very important step in the modernization of its intellectual property system and legislation. The present competitiveness of the world economy, with its increased commercial integration, highlighted the importance of technology for industrial development and the need for governments to perfect their industrial property systems. Mexico was in the process of doing this, not only through new legislation to incorporate the "TRIPS" provisions and the intellectual property provisions of the North American Free Trade Agreement, as well as to establish the Mexican Industrial Property Institute, but also through accession to the PCT. The Delegation noted that the majority of countries with which Mexico has trade relations were members of the PCT, and 90% of applications for patents in Mexico came from PCT Contracting States. Mexico's accession to the PCT was in line with its policy of internationalizing the Mexican economy and would make it easier for its nationals to seek patent protection abroad and for foreign applicants to obtain patents in Mexico.

6. The Delegations of the United States of America and Canada expressed pleasure that Mexico had joined the PCT and would thus obtain the many benefits provided by the PCT.

Maximum Number of Designation Fees Payable

7. Discussions were based on paragraphs 23 to 31 of document PCT/A/XXII/1.

8. In reply to a question by the Chairman, the Director General stated that it was extremely difficult to forecast the financial impact of the proposal to increase from 10 to 15 the maximum number of designation fees payable in view of the fact that the reaction of applicants to any such an increase was very difficult to quantify, but that the International Bureau estimated that it might increase PCT fee income by between one and three million francs annually. As compared with an increase of all PCT fees, the proposal seemed to provide a more equitable means of increasing income, especially as concerns small users of the PCT system who, since they generally made less than ten designations, would not have to pay higher fees. The increase was primarily justified by the fact that when the ceiling of 10 designations was decided (in 1984) the maximum number of States which could be designated was 35 whereas today it was 74 and very shortly will exceed 80. Thus, the 50% increase in the ceiling was considerably smaller than the more than 100% increase in the number of contracting States.

9. The Delegations of Sweden, Australia, Italy, Germany, the United States of America, the United Kingdom and Canada expressed their concern that a financial analysis had not been presented to justify the proposal; in the absence of that, they said that they could not support the proposal. The Delegation of Australia asked for further consideration of the expected effect on revenue, and asked that a "revenue-neutral" option be considered. The Delegations

of the United Kingdom and Canada questioned whether a fee increase was needed in the light of the healthy situation of the reserves and the expected surplus for the PCT Union in the present biennium.

10. The Delegation of Sweden, while recognizing that the cost of handling international applications should be covered by the fees, stated that it considered that any proposal for a fee increase should be based on an economic analysis, rather than on a proportionality based on the number of PCT Contracting States or on the number of possible designations.

11. The Delegations of Australia, Germany, the United Kingdom, Japan and Canada expressed concern over the impact that the proposal would have on applicants from their countries. The Delegation of Australia noted that 60% of international applications from Australia designated all countries, so that the proposed increase would increase fees for those applicants, and would cause applicants to be more selective in making their designations, possibly reducing the number of those; it also asked whether the proposal was intended to cause applicants to be more selective in making their designations, and whether that would be advantageous or not. The Delegations of Germany and Japan stated that increasing the ceiling of ten paid designations might lead to less use of the PCT. The Delegation of Germany added that frequent users of the PCT system found that the present ceiling corresponded to their needs. The Delegation of the United Kingdom said that it would be necessary to know what would be the impact of the proposal on the behavior of users of the PCT system.

12. The Delegations of Germany, the Russian Federation, the United States of America, the United Kingdom and Canada said that more information was needed and that they considered that the proposal should be reviewed in more detail by other bodies, notably the PCT Committee for Administrative and Legal Matters and/or the WIPO Budget Committee; they would be willing, in the light of that review, to have the PCT Assembly reconsider the matter next year.

13. The Delegation of Portugal stated that it agreed on the need to have funds in the reserves, especially for an increased level of PCT activities and to promote the PCT. However, since fee increases were generally criticized by users, the Delegation asked whether it would not be possible to increase the revenues without increasing the fees.

14. The Delegation of Spain said that it did not support the proposal.

15. The Delegations of Switzerland, Kenya, Romania, Cote d'Ivoire and Sudan stated that they supported the Director General's proposal. The Delegation of Switzerland added that the proposal was simple and logical; the Delegation considered that such a minor modification in fees would not have any impact on the behavior of applicants, and added that it would be very difficult to make forecasts in this connection.

16. Noting that the proposal would increase PCT income, the Delegations of Kenya and Côte d'Ivoire emphasized the importance of having funds generated for WIPO's activities, particularly development cooperation activities, and for reducing member State contributions below their current levels.

17. The Delegation of Brazil affirmed that the issue involved more than just budgetary questions. The Delegation noted that it would have been helpful to have had more precise

information and estimates provided in the document, but said that it would be willing to accept the Director General's proposal.

18. The representatives of the International Federation of Industrial Property Attorneys (FICPI) and of the International Association for the Protection of Industrial Property (AIPPI) stated that the users of the PCT system were happy with that system. They noted that the typical PCT applicant planned to make six to eight designations, but often increased the number of paid designations to ten in order to be able to keep his options open by covering a large number of countries; the low incremental cost constituted a major attraction of the PCT system. If the maximum number of designation fees were to be increased, that would result in a large increase in cost for such applicants, and could influence their behavior to keep to the original number of designations planned, which could even result in an overall loss of PCT revenue. Those representatives therefore recommended that the proposal be reconsidered. They also suggested that consideration be given to means of rationalizing operations to reduce the number of communications from the International Bureau to designated States.

19. The Director General noted the need for additional revenue in order to have reserves in case of unfavorable economic conditions, for investments in additional premises needed mainly because of the expansion of the PCT, for investment in the continuous modernization and computerization required because of the rapid growth in numbers of international applications, and in order to provide assistance to the Offices of new PCT member States, which in future would nearly all be developing countries.

20. The International Bureau also noted that the additional income expected from the proposal to increase to 15 the maximum number of designations payable would correspond to a general fee increase of about 2 to 4%. Noting that the PCT Assembly had a year ago supported a 5% fee increase, but not with the necessary three-quarters majority, it could be asked whether a general fee increase would be preferable to the said proposal as a means of generating additional revenues.

21. The Chairman observed that the budget approved a year ago had forecast a surplus of about 11 million francs for the PCT Union, but that a higher surplus might be expected as the number of international applications was now higher than had been budgeted.

22. The Delegations of Portugal, Ireland and Denmark, while sympathetic to the need for further revenues, noted that no financial study had been provided to give a basis for a general fee increase at this time. The Delegation of Denmark considered that the question of having a fee increase or increasing the number of designation fees payable should be examined in the context of consideration of the budget.

23. The Assembly concluded that further work was needed on the proposal to increase the maximum number of designation fees payable, including both its budgetary implications (in the context of the needs of the Organization) and an assessment of its possible impact on applicants; the said proposal or an alternative proposal for a general fee increase could be considered by the Assembly in 1995 following consideration by the PCT Committee for Administrative and Legal Matters and/or the WIPO Budget Committee, as appropriate.

Cost of Producing the “PCT Gazette” and “Gazette du PCT”

24. Discussions were based on paragraphs 1 to 22 of document PCT/A/XXII/1.

25. The Delegation of Germany said that if the PCT operations were run by a private enterprise, as a first step for making economies, the French “Gazette du PCT” would be dropped because the production cost was considerably out of proportion to its use; even the production cost of the English “PCT Gazette” was out of proportion. Therefore, it would be appropriate, as a second step, to simplify the paper version of the Gazette, possibly along the lines used by the European Patent Office by eliminating the abstracts and the drawings (since those were available on CD-ROMs). A final step would be to transfer from paper completely to CD-ROMs--as the medium of the future--the publication of information on international applications.

26. The Delegations of Switzerland, Canada, France and Cameroon stated that they would not agree to any possible future proposal to eliminate the French version of the Gazette. The Delegations of Canada and Cameroon added that there should be equality of the substantive content of the English and French versions of the Gazette. The Delegation of the Organisation africaine de la propriété intellectuelle (OAPI) noted the importance to it of having the Gazette available in OAPI’s two working languages.

27. As to the possibility of eliminating the abstracts and the drawings from the Gazette, and publishing in that Gazette only the bibliographic data as in the European Patent Bulletin, the Delegations of Switzerland and France said that this should be studied thoroughly, including consultations with the interested circles. The Delegation of France suggested that the abstracts could be made available on CD-ROMs, separately from the Gazette. The representative of FICPI, speaking also on behalf of AIPPI, expressed support for any proposal to make PCT operations more cost-effective; while some practitioners would attach importance to having the abstract and drawings included in the Gazette, it recommended that the possibility of eliminating those should be seriously considered; the format of the Gazette could be like that of the European Patent Bulletin, with a single edition in both English and French containing only the titles and the necessary bibliographic information.

28. As to the possibility of replacing the (paper) Gazette by publication of CD-ROMs, the Delegations of Switzerland and Canada noted that, although this was not urgent, it should be considered in due course as technology was evolving in the direction of replacing information on paper by CD-ROMs. The Delegation of France noted the need to consult with interested circles before eliminating the paper version. The Delegation of the United Kingdom said that a move from publication in paper form in the short term would cause problems; it asked that its patent libraries be involved in any consultations on the matter. The Delegations of Cameroon and OAPI recognized the value of the electronic format, but emphasized the need to continue having the (paper) Gazette, which was important to developing countries which did not have advanced technological equipment widely available. The representative of FICPI, speaking also on behalf of AIPPI, considered that it might be premature to replace the (paper) Gazette by CD-ROMs, but would be supportive if that would contribute to substantial cost savings.

29. The International Bureau observed that much praise had been received for the contents of its Gazette, which contained more information than the gazettes or bulletins of other Offices. However, in light of the rapid and cheap availability of information in CD-ROM format,

consideration could be given to the two possibilities mentioned in paragraphs 27 and 28, above, both by the International Bureau and by the users of the Gazette.

30. The Delegations of the United Kingdom, Canada and France said that they agreed that the index of international publication numbers according to designated States be eliminated.

31. The Assembly noted the contents of paragraphs 1 to 21 of document PCT/A/XXII/1, and it agreed that publication of the index of international publication numbers according to designated States be discontinued.

[End of document]

WIPO



PCT/A/XXIII/2

ORIGINAL: English

DATE: October 3, 1995

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Twenty-Third Session (10th Ordinary)
Geneva, September 25 to October 3, 1995

REPORT

Adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document AB/XXVI/1 Rev.): 1, 2, 3, 5, 9, 12, 13, 15, 19 and 20.
2. The report on the said items, with the exception of item 9, is contained in the General Report (document AB/XXVI/19).
3. The report on item 9 is contained in the present document. The revised Schedule of Fees under the Patent Cooperation Treaty adopted by the Assembly, with effect from January 1, 1996, under item 13 of the Consolidated Agenda, is shown in the Annex to this report.
4. Mr. Daniel Hangard (France), Chairman of the Assembly, presided over the meeting of the Assembly.

**ITEM 9 OF THE CONSOLIDATED AGENDA:
MATTERS CONCERNING THE PCT UNION**

5. Discussions were based on document PCT/A/XXIII/1.
6. While a number of delegations supported the proposal by the International Bureau for amendment of PCT Rule 93.4 as set out in the said document, several delegations raised questions as to the wording of Rule 93.4 as proposed to be amended and expressed the view that the matter should be further considered by a WIPO expert body with a view to submission of a revised text to the Assembly at a later date.
7. The Assembly agreed that such further consideration should take place, that the revised proposal should take into account the fact that new kinds of data carrier had become and would continue to become available as technology developed and that the revised proposal should not be limited to the use of any particular kind of data carrier. The revised proposal should also take into account that any data carrier used for keeping files needed to be suitable for long-term storage consistent with the requirements of Rule 93 as to the duration of storage and needed to permit the preparation of faithful reproductions of the material stored, which reproductions, as one delegation suggested, would also have to be durable.
8. Furthermore, the Assembly agreed that the International Bureau could keep files and documents in facsimile form on optical disks (under the International Bureau's Document Imaging and Computer-Assisted Publishing System (DICAPS)) and, provided that optical disk storage met the long-term storage requirements of Rule 93, could destroy the original files and documents in paper form subsequent to the storage of copies thereof on optical disks.

[Annex follows]

ANNEX

SCHEDULE OF FEES APPLICABLE FROM JANUARY 1,1996

Fees	<u>Amounts</u>
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	762 Swiss francs
(b) if the international application contains more than 30 sheets	762 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	185 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 11 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	185 Swiss francs per designation
3. Confirmation Fee: (Rule 15.5(a))	50% of the sum of the designation fees payable under item 2(b)
4. Handling Fee: (Rule 57.2(a))	233 Swiss francs

All fees are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[End of Annex and of document]

WIPO



PCT/A/XXIV/10

ORIGINAL: English

DATE: October 1, 1997

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Twenty-Fourth Session (11th Ordinary)
Geneva, September 16 to October 1, 1997**

REPORT

adopted by the Assembly

1. The Assembly, which opened its session on September 16, 1997, was concerned with the following items of the Consolidated Agenda of the thirty-first series of meetings (September-October 1997) of the Governing Bodies of WIPO (document AB/XXXI/1 Prov.2): 2, 5, 6, 10, 21, 28, 29 and 30.
2. The report on the said items, with the exception of item 10, is contained in the General Report (document AB/XXXI/12). The list of participants in the Assembly for the period from September 16 to 19, 1997, appears in document PCT/A/XXIV/INF/1.
3. The report on item 10 is contained in the present document.

ITEM 10 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

OPENING OF THE SESSION

4. The session was opened by Mr. François Curchod, Deputy Director General.

ELECTION OF A CHAIRMAN AND TWO VICE-CHAIRMEN

5. Mr. Bruce Murray (Australia) was elected Chairman of the Assembly; Mr. Jorge Amigo Castañeda (Mexico) and Mr. Jan-Eric Bodin (Sweden) were elected Vice-Chairmen. When the Assembly met to adopt the present report, the Chairman and both Vice-Chairmen being absent, Mr. Roland Grossenbacher (Switzerland) was elected Acting Chairman.

ADOPTION OF THE AGENDA

6. The Assembly adopted, in connection with matters falling under item 10 of the Consolidated Agenda, the agenda appearing in Annex I to this report.
7. Other matters considered by the Assembly are contained in the Consolidated Agenda (see paragraph 1, above).

INTERNATIONAL SEARCHING AUTHORITIES AND INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITIES: EXTENSION OF APPOINTMENTS;
RENEWAL OF THE AGREEMENTS WITH THE INTERNATIONAL BUREAU

8. Discussions were based on documents PCT/A/XXIV/3 and 3 Corr. (French only), relating to the proposed extension, under Articles¹ 16 and 32, of the appointments of the Australian Patent Office, the Austrian Patent Office, the Chinese Patent Office, the European Patent Office, the Japanese Patent Office, the Russian Agency for Patents and Trademarks, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office as International Searching Authorities and International Preliminary Examining Authorities, and of the Spanish Patent and Trademark Office as an International Searching Authority.

9. The Assembly:

(i) approved the texts of the Agreements with the International Bureau appearing in Appendices I to IX to document PCT/A/XXIV/3, subject to the

¹ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be.

modifications to the French texts thereof appearing in document PCT/A/XXIV/3 Corr., relating to the functions of the Authorities mentioned in the previous paragraph;

- (ii) extended the appointments of those Authorities until December 31, 2007.

APPOINTMENT OF THE KOREAN INDUSTRIAL PROPERTY OFFICE AS AN
INTERNATIONAL SEARCHING AUTHORITY AND
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

10. Discussions were based on documents PCT/A/XXIV/4 and 4 Corr. (French only).

11. In response to an invitation by the Chairman and pursuant to Article 16(3)(e), the Delegation of the Republic of Korea made a statement to the Assembly, the text of which appears in Annex II to this report.

12. The Assembly noted the recommendation made by the PCT Committee for Technical Cooperation at its nineteenth session held in Geneva from May 26 to 30, 1997 (see document PCT/CTC/XIX/5, paragraphs 6 to 11), that the Assembly appoint the Korean Industrial Property Office as an International Searching Authority and International Preliminary Examining Authority, provided that the appointment should take effect upon entry into force of the Agreement between the Office and the International Bureau in relation to the functioning of the Office as an International Searching Authority and International Preliminary Examining Authority, and that such entry into force should be one month after the date on which the Office notified the Director General of WIPO that it had in its possession the PCT minimum documentation referred to in Rule 34, properly arranged for search purposes, including both

- (a) the complete collection of patent documents referred to in Rule 34.1(b)(i) and (ii), including the missing documents indicated in document PCT/CTC/XIX/3, and
- (b) the non-patent literature as published in the PCT List of Periodicals to Be Used for Search and Examination according to Rule 34.1(b)(iii), including all missing items,

and noted, in this connection, that the draft Agreement appearing in Appendix II to document PCT/A/XXIV/4 made provision accordingly.

13. The Assembly:

- (i) approved the text of the Agreement between the Korean Industrial Property Office and the International Bureau appearing in Appendix II to document PCT/A/XXIV/4, subject to the modification of the French text thereof appearing in document PCT/A/XXIV/4 Corr.;

- (ii) appointed the Korean Industrial Property Office as an International Searching Authority and International Preliminary Examining Authority, with effect from the entry into force of that Agreement, until December 31, 2007.

14. The Delegations of Japan, the United States of America and France, and the Representative of the European Patent Organisation, congratulated the Korean Industrial Property Office on its appointment and assured the Korean Industrial Property Office of their continued support. The Chairman congratulated the Korean Industrial Property Office on behalf of the Assembly.

AMENDMENT OF THE REGULATIONS; DIRECTIVES OF THE ASSEMBLY
RELATING TO THE ESTABLISHMENT OF NEW EQUIVALENT AMOUNTS OF
CERTAIN FEES

15. The Assembly considered proposed amendments of the Regulations contained in documents PCT/A/XXIV/2, 6 and 7 (prepared by the International Bureau), PCT/A/XXIV/8 (proposal by the United States of America) and PCT/A/XXIV/9 (proposal by France), as well as a number of proposals presented during its session. The proposed amendments related to the following topics:

- (i) *PCT minimum documentation* (see document PCT/A/XXIV/2);
- (ii) *language of the international application* (see documents PCT/A/XXIV/6, paragraphs 8 to 17 and Annex I, and PCT/A/XXIV/8, pages 2 and 3);
- (iii) *electronic filing of international applications* (see documents PCT/A/XXIV/6, paragraphs 18 to 30 and Annex II, and PCT/A/XXIV/8, pages 4 and 5);
- (iv) *priority claims and priority documents* (see documents PCT/A/XXIV/6, paragraphs 31 to 44 and Annex III, and PCT/A/XXIV/8, page 6);
- (v) *deposits of biological materials* (see documents PCT/A/XXIV/6, paragraph 45 and Annex IV, and PCT/A/XXIV/8, page 7);
- (vi) *Rules and directives relating to fees* (see documents PCT/A/XXIV/2 and PCT/A/XXIV/6, paragraphs 46 to 56 and Annexes V and VI; as to the new amounts of certain PCT fees appearing in the Schedule of Fees, see paragraphs 43 and 44, below);
- (vii) *nucleotide and amino acid sequence listings* (see documents PCT/A/XXIV/7, paragraphs 8 to 11 and Annex I, and PCT/A/XXIV/8, pages 8 and 9);
- (viii) *PCT Gazette* (see documents PCT/A/XXIV/7, paragraphs 12 to 19 and Annex II, PCT/A/XXIV/8, page 10, and PCT/A/XXIV/9);
- (ix) *international preliminary examination* (see documents PCT/A/XXIV/7, paragraphs 20 to 27 and Annex III, and PCT/A/XXIV/8, page 11).

16. The Assembly unanimously adopted amendments of the Regulations as appearing in Annex III to this report (as to the new amounts of certain PCT fees appearing in the Schedule of Fees, see paragraphs 43 and 44, below), and decided:

- (i) that the amendments of the Regulations, with the exception of those referred to in items (ii) and (iii), below, would enter into force on July 1, 1998 (as to the new

amounts of certain PCT fees appearing in the Schedule of Fees, see paragraphs 43 and 44, below);

(ii) that the amendments of Rule 86 would enter into force on January 1, 1998, on the understanding noted in paragraph 37, below;

(iii) that new Rules 89*bis* and 89*ter* would enter into force at the same time as the modifications of the Administrative Instructions implementing those new Rules, the effective date to be included in the promulgation of those modifications by the Director General;

(iv) that Rule 94 as amended would apply only in respect of international applications filed on or after July 1, 1998, and that present Rule 94 would continue to apply after July 1, 1998, in respect of international applications filed before that date.

17. The Assembly unanimously adopted, with effect from July 1, 1998, modified directives relating to the establishment of new equivalent amounts of certain fees as appearing in Annex IV to this report, replacing those adopted at its third session held from April 25 to May 1, 1979 (see document PCT/A/III/11, paragraph 20).

18. Certain matters noted by the Assembly, by various delegations and by the International Bureau in connection with the amendments of the Regulations or in connection with particular Rules are set out in the following paragraphs.

Language of the international application

19. *Rules 12.3 and 55.2.* In connection with the adoption of Rule 12.3 and the amendment of Rule 55.2, the Assembly noted that there was no requirement for any Office or Authority to check the accuracy or completeness of any translation of the international application furnished under those Rules. The Assembly recognized the importance of the accuracy and completeness of any such translation, the ensuring of which was the responsibility of the applicant. However, the Assembly decided not to introduce a requirement for verification by the applicant for the purposes of the international phase, nor to permit the national law of any designated State to require verification, upon entry into the national phase, of any translation furnished under Rule 12.3 or 55.2.

20. *Rule 19.4.* The Assembly noted that the adoption of amendments of Rule 19.4(a) did not involve the making of any decision by the Assembly under Article 9(2).

21. *Rule 47.3.* In connection with the adoption of Rule 47.3(b), the International Bureau emphasized that it would be desirable to avoid having to send to every designated Office a copy of the international application in the language in which it was filed, whether or not the international application concerned had in fact entered the national phase. The International Bureau stated that it would seek to make arrangements with affected designated Offices so as to meet their particular needs in this regard, noting that the use of modern computer technology for the communication of documents between the International Bureau and designated Offices would facilitate solution of this problem in the future.

22. *Rule 48.3.* The Assembly noted that the International Bureau intended to have discussions with the International Searching Authorities and receiving Offices affected by the procedure under present Rule 48.3(b) with a view to its possible amendment, in the future, to make the procedure for preparation of translations under that Rule more similar to that to be followed under Rule 12.3.

Electronic filing of international applications

23. *Rule 89bis.* The Assembly noted, in relation to the question of what would be the legally determinative version of an international application filed in electronic form or by electronic means, that the Administrative Instructions would need to deal both with situations in which the electronic form of the international application was filed as the sole authentic version and also with those in which the paper version of the application may need to be referred to (for example, when evidence led to the questioning of the integrity of a document in electronic form and in cases where corruption of a document in electronic form had occurred).

24. The Assembly noted that the words “filed and processed” in Rule 89bis.1(a) were intended to cover all aspects of the filing and subsequent processing of international applications, including communications between Offices and authorities, and between applicants and Offices and authorities.

25. The Delegation of Japan, noting that the Japanese Patent Office had been the first to introduce a fully electronic filing procedure, stated, in relation to the provision of Rule 89bis.1(a) requiring any receiving Office to permit the filing of international applications on paper, that, although the Delegation did not oppose the inclusion of that requirement, the provision might need to be reviewed in the future.

26. The Assembly noted, in relation to the list contained in Rule 89bis.1(c) of subject matter areas which would need to be addressed in Sections of, or Annexes to, the Administrative Instructions in connection with the electronic filing of international applications, that the list was not intended to be exhaustive or comprehensive. It was clearly understood that all matters necessary for electronic filing and processing of applications may be governed by the Administrative Instructions even if not mentioned in the list of examples under Rule 89bis.1(c). The Assembly noted that it would be appropriate, in the future, to incorporate into the Regulations certain matters which would, in the first stages of implementation of electronic filing procedures, need to be dealt with in the Administrative Instructions.

27. The Assembly noted that Rule 89bis.3 would permit the scanning of, for example, a record copy or a demand, and transmittal to the International Bureau of the document so scanned in facsimile format, provided that the integrity and quality of reproduction from such documents in facsimile format were assured.

28. In response to comments by the Delegations of China and Kenya, the International Bureau emphasized that the needs of developing countries were being kept in mind in the context of the development of procedures for the filing and processing of international applications in electronic form and by electronic means, as well as in the context of developments discussed by the WIPO Working Group on Information Technologies for Intellectual Property, and that it was definitely the intention of the International Bureau to

assist developing countries so that they would benefit from the advantages associated with electronic filing and processing of patent applications, including international applications under the PCT.

29. *Rule 93.4.* The Assembly noted that Rule 93.4 as amended would enable the storage of records and files on computer-readable media, such as optical or magnetic disks or in microform.

Priority claims and priority documents

30. *Rules 17.2 and 76.4.* The Assembly noted that, while the deletion from Rules 17.2(a) and 76.4 of references to certified translations of priority documents would have the effect that designated and elected Offices could no longer require the furnishing of *certified* translations of priority documents, those Offices could continue to require the furnishing of *verified* translations of priority documents (see Rule 51*bis*.1(d) as to the meaning of “verified”).

Deposits of biological materials

31. *Rules 13bis and 48.2.* In adopting the proposed amendments of Rules 13*bis* and 48.2(a)(viii), the Assembly noted the statement made by the Delegation of Sweden in connection with the replacement of the word “microorganism” by the words “biological material” in those Rules. The Delegation indicated that, even though it was, in principle, in favor of the amendment, it could not take a position on it since the amendments to those Rules would necessitate an amendment of the Swedish national law. The Swedish Government had stated that any related amendments of the Swedish law would be deferred until a European Union Council Directive on Legal Protection of Biotechnological Inventions had been approved.

Fees

32. *Rule 58bis.2.* The Assembly noted the possible need for a review, at some later date, of the amount of the late payment fee fixed in Rule 58*bis*.2, if experience showed that payment of the preliminary examination and handling fees was being deferred in a significant number of cases.

Nucleotide and amino acid sequence listings

33. *Rule 5.2.* In adopting Rule 5.2(a), the Assembly noted that the envisaged common standard for the presentation of sequence listings in international applications would specifically exclude from its scope certain sequences, so that Rule 5.2(a) would not apply to them (for example, branched sequences or sequences with fewer than four specifically defined nucleotides or amino acids, among others).

PCT Gazette

34. *Rule 86.* In introducing its proposal (see document PCT/A/XXIV/7, paragraphs 12 to 19 and Annex II), the International Bureau drew attention to the decreasing number of subscriptions to the PCT Gazette (subscriptions had decreased by approximately 30% over the last 15 years), which was in contrast to the rapid growth in the number of international

applications filed (an approximately 10-fold increase over the same period). The main reason seemed to be that information about international applications was increasingly available from other sources and in formats other than the Gazette in paper form currently published by the International Bureau. The proposal of the International Bureau was aimed at improving the availability of information about international applications, in particular in easily searchable electronic formats, such as CD-ROMs and on-line, while at the same time reducing the resources required for producing the printed paper version of the Gazette by merging publication of the bibliographic data, currently published in separate English and French versions of the Gazette, into a single bilingual Gazette without abstracts and drawings. Abstracts and drawings would, together with the bibliographic data, be published in future in electronic form in parallel with the paper form.

35. In introducing its proposal (see document PCT/A/XXIV/9), the Delegation of France indicated that information about international applications had to be available to everyone in both languages and in easily searchable form. Those requirements would be fulfilled by its proposal, which provided for two forms of the Gazette, one in paper form and the other in electronic form. Easy, low cost access to bibliographic information relating to published international applications would be provided through the paper version of the Gazette, while access to bibliographic information, abstracts and drawings in a modern, easily searchable format would be possible through the electronic version of the Gazette. The proposal would, moreover, ensure the equal treatment of languages.

36. The Assembly noted that reference in Rule 86.2(c) to the Gazette being “made accessible, in English and French at the same time,” did not mean that publication of the information concerned had to occur on the same carrier in both languages.

37. The Assembly, in deciding that the amendments of Rule 86 would enter into force on January 1, 1998 (see paragraph 16(ii), above), did so on the understanding that, for practical reasons, it may not be possible for the new formats of the Gazette to be implemented from that date, in which case the International Bureau would continue to publish the Gazette in the present format for a short period after January 1, 1998, and the new formats would be introduced as soon as possible after that date.

International preliminary examination

38. *Rule 53.7.* The Delegation of the United States of America expressed its concern that the International Bureau’s proposal for amendment of Rule 53.7 (see document PCT/A/XXIV/7, paragraph 23 and Annex III, pages 1 and 2), by which any demand for international preliminary examination would be considered as containing the election of all eligible States, would conflict with Article 31(4)(a). The Delegation suggested an alternative proposal (see document PCT/A/XXIV/8, page 11) whereby the International Preliminary Examining Authority would have discretion to decide in particular cases whether a demand could reasonably be construed as containing the election of all eligible States.

39. The International Bureau explained its view that, while Article 31(4)(a) required that the election of States be indicated in the demand, it did not specify how this had to be done, and that the Regulations could make suitable implementing provisions such as those proposed by the International Bureau, which would be particularly appropriate since most applicants, in practice, elect all eligible States. However, noting that its proposal did not find unanimous

acceptance, the International Bureau withdrew it together with certain proposed consequential amendments of Rules 56.1(a), 60.1(a) and (b) and 60.2(b).

40. *Rule 59.3.* In connection with the adoption of Rule 59.3, the Delegation of the United States of America expressed its concern that the Rule, which provided for a demand for international preliminary examination to be accorded, as the date of filing, the date of its receipt by the “non-competent” Office or authority rather than the date of its actual receipt by the competent International Preliminary Examining Authority, may be inconsistent with Article 31(6)(a). The Assembly noted that, while Article 31(6)(a) required that the demand “shall be submitted to the competent International Preliminary Examining Authority,” it did not specify by what route, and that Rule 59.3 followed, so far as the demand was concerned, a similar approach to that taken by present Rule 19.4 in relation to the international application itself and present Rule 56.1(f) in relation to a notice effecting a later election.

41. *Rule 69.2.* The Assembly noted that the calculation of time under Rule 69.2(ii) would commence only from the date on which *both* the demand had been received by the (competent) International Preliminary Examining Authority *and* the handling and preliminary examination fees had been paid.

42. *Rule 94.* The Assembly noted that access by third parties to the file of the international preliminary examination could, under Rule 94, be obtained only via the elected Offices for the application concerned. The question whether particular documents held in the file of a given elected Office would be treated as confidential would depend on the applicable national law and practice. As to the application of the amendments of Rule 94, see paragraph 16(iv), above.

ADOPTION OF NEW AMOUNTS OF CERTAIN PCT FEES

43. Discussions were based on document PCT/A/XXIV/5.

44. The Assembly fixed new, lower, amounts of the basic and designation fees, applicable from January 1, 1998, as appearing in the Schedule of Fees to the Regulations contained in Annex III to this report, and decided that the new amounts would apply only to international applications filed on or after January 1, 1998.

[Annexes follow]

ANNEX I

AGENDA

adopted by the Assembly

1. Opening of the session
2. Election of a Chairman and two Vice-Chairmen
3. Adoption of the agenda
4. International Searching Authorities and International Preliminary Examining Authorities: extension of appointments; renewal of the Agreements with the International Bureau (documents PCT/A/XXIV/3 and 3 Corr. (in French only))
5. Appointment of the Korean Industrial Property Office as an International Searching Authority and International Preliminary Examining Authority (documents PCT/A/XXIV/4 and 4 Corr. (in French only))
6. Amendment of the PCT Regulations (documents PCT/A/XXIV/2, 6, 7, 8 and 9)
7. Amendment of certain PCT fees (document PCT/A/XXIV/5)
8. Adoption of the report of the session
9. Closing of the session

[Annex II follows]

ANNEX II

STATEMENT BY THE DELEGATION OF THE REPUBLIC OF KOREA

Mr. Chairman, distinguished delegates, ladies and gentlemen:

First of all, on behalf of the Korean Industrial Property Office (KIPO) and the Delegation of the Republic of Korea, we would like to express our sincere gratitude to Dr. Arpad Bogisch, Director General of the World Intellectual Property Organization (WIPO), and his colleagues for their kindness in putting forward KIPO's request for appointment as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT) at this PCT Assembly. We would also like to take this opportunity to extend our appreciation to the member States of the PCT Committee for Technical Cooperation including Japan, the Netherlands, Canada, Sweden and Ireland, for their support shown to us at its nineteenth session held in Geneva from May 26 to 30, 1997. And the same thanks go to all other countries and organizations for their support and assistance extended to KIPO with reference to its appointment as a PCT/ISA and an IPEA.

We believe the recent rapid increase in both the number of PCT member States and the number of international applications via PCT procedures in member States including the Republic of Korea is the very proof that the PCT has been recognized worldwide as an easier and more convenient channel for filing patent applications abroad.

Along with a substantial increase in industrial property right applications during the past decade, the awareness of the importance of industrial property rights (IPRs) has been growing remarkably in the Republic of Korea. For instance, the number of patent applications including utility models has increased more than four times from 35,160 in 1986 to 157,480 in 1996. And even the total IPR applications has trebled from 81,922 in 1986 to 274,069 in 1996, thus placing the Republic of Korea fourth in the world in terms of IPR applications. Moreover, international applications under the PCT also have been increasing, following the same trend as national patent applications.

To cope with such a promising trend, upgrading the quality of patent search and examination has become one of the principal priorities for the Korean IPR policies. And KIPO is presently facing an increasing challenge from private companies for KIPO to take measures for a more user-friendly environment for filing PCT applications utilizing PCT procedures. We believe it is high time for KIPO to further strengthen its international role and responsibility corresponding to its status in the field of industrial property rights to bridge the advanced and the developing countries. In this respect, KIPO's becoming a PCT/ISA as well as a PCT/IPEA would be timely and could serve to meet the above demands.

Availing ourselves of this opportunity, we would like to make a brief presentation on KIPO's capability for undertaking the prospective task as a PCT/ISA and as an IPEA, focusing on the minimum requirements prescribed in Article 16(3)(c) of the PCT.

First, with regard to the requirement for patent examination personnel, KIPO has continuously and substantially increased the number of patent examiners in order to effectively cope with the remarkable increase in patent applications, despite the trend of strict control over the increase in the number of staff of the public sector under the "small

government” policy. KIPO has presently about 400 full-time patent examiners with sufficient academic and professional qualifications to carry out international-type searches and examinations.

Almost all examiners have a good command of at least one foreign language. In particular, 120 examiners holding a doctorate degree were recently recruited to undertake examinations with respect to the newly emerging areas of technology including biotechnology and computer-related technology.

Moreover, in order to cope effectively with the ever increasing number of IPR applications, consultations were held with the authorities concerned in the Government of the Republic of Korea with a view to a further increase of more than 200 persons next year, and we are planning to increase the total number of patent examiners to over 800 by the year 2000.

In addition to the increase in the number of patent examiners, KIPO has also made every effort to further enhance the quality of examination through a series of intensive training programs. Before becoming a patent examiner, the prospective examiner must complete a series of intensive training courses to acquire all the necessary professional knowledge and skills including IPR-related laws, patent classification, and the guidelines for patent search and examination. Even after becoming an examiner, he or she is required to take supplementary training courses in the third and the fifth years in order to keep informed of new information and knowledge in the related field of intellectual property as well as the technology concerned.

KIPO has also established and implemented the so-called “Examiner Evaluation System” to ensure high quality of examination by providing incentives to the prominent examiners who obtain high points in the evaluation.

While strengthening the examination staff, KIPO has also made every effort to accelerate and upgrade computerization of patent search and examination with the aim of reducing pendency time and improving efficiency substantially in IPR processing.

Since the launch of the first comprehensive computerization plan in 1989 with the assistance of WIPO, KIPO’s computerization project has successfully progressed. In spite of many difficulties arising from the lack of experienced experts and sufficient funding as well as necessary facilities, concerted efforts have been made to implement the computerization as planned. As a result, a number of computerized subsystems were developed and successfully employed in the area of administrative processing, and patent search and examination.

KIPO will continue to make efforts to further improve computerization, including the continuous upgrading of computer-aided search and examination, so as to ensure efficiency and quality in patent search and examination.

And, now pertaining to the requirement for the minimum documentation, KIPO has continued a series of restructuring and has strengthened the function of documentation and information. For instance, the Documentation Division has been operating since 1977 collecting patent documents and non-patent literature, classifying them for easier access by patent examiners and providing an information service to the public. In 1991, KIPO created the Information and Documentation Bureau with the aim of further facilitating the task of

systematic collecting, processing and utilizing patent information and documentation, under the envisaged computerization of patent administration.

As a result of systematic and continuous efforts, KIPO has now collected a wide range of information resources from 35 countries and three international organizations. As of September 1997, KIPO is in possession of more than 48 million patent documents in the form of paper, microfilm or other electronic format like CD-ROM.

The collected paper patent documents have been processed and classified complying with the International Patent Classification (IPC) from the early 1980's, replacing the previous Korean Patent Classification into the examiner search files.

The documents in the search files contain the full text of patent specifications of more than 36 million cases of 16 countries including Australia, France, Germany, Japan, Russia, Switzerland, the United Kingdom and the United States of America as well as of four organizations, namely, ARIPO, the EPO, OAPI and WIPO, together with the patent abstracts of 18 countries.

In addition to the paper documents, KIPO has extensive collections of electronic documents, loaded on microfilms as well as on CD-ROMs. KIPO possesses microfilm documents for more than six million cases of nine countries like Australia, France, Germany, Japan, Switzerland, the United Kingdom and the United States of America, as well as of two organizations, that is, the EPO and WIPO. There are also over five million cases on CD-ROMs of 12 leading countries and three organizations, like the EPO and WIPO.

Furthermore, KIPO operates 56 CD-ROM workstations, together with about 400 personal computers equipped with a CD-ROM drive. KIPO also plans to provide a PC equipped with a CD-ROM drive to each examiner by the end of this year, so that the examiners can conduct searches or other work related to examination utilizing CD-ROMs or other electronic formats.

KIPO has also established a database system for the World Patent Index (WPI) and the First Page Data Base (FPDB), and a retrieval system for the patent examiners to utilize the data published by Derwent Information Ltd. and the EPO. The WPI database contains more than six million cases of 35 countries and two organizations going back to 1963, the contents of which are bibliographic data, drawings and abstracts in English, while FPDB encompasses patent documents of the EPO, Japan and the United States of America.

As for non-patent literature, KIPO has so far collected 68 periodicals among the list of 135 established under PCT Rule 34.1(b)(iii). Accordingly, to supplement the gap, KIPO has made arrangements for the patent examiners to have access to the non-patent literature via the retrieval system provided by the Korean Institute of Industry and Technology Information (KINITI). However, as KIPO is scheduled to move in 1998 to Taejon, which is located about 150 kilometers away to the south of Seoul, KIPO is planning to subscribe to 68 additional periodicals next year which are not currently available in order to meet the requirement for the non-patent literature.

We are pleased to inform you that KIPO's plan for obtaining the missing documents listed in Appendix I of document PCT/A/XXIV/4, has been progressing as scheduled, thanks to the kind cooperation of the foreign patent Offices concerned.

With respect to item 1, documents issued by Australia, we will purchase them from the Australian Industrial Property Organisation (AIPO).

And as regards item 2 through item 6, documents issued by Austria, France, Germany, the United Kingdom and the United States of America, the European Patent Office has agreed to provide us with those documents at a reasonable price, which are loaded on the Bacon Numerical System (BNS). We have already contacted the Offices concerned for their formal approval of the delivery of their documents on BNS via the EPO.

Once again, we would like to express our sincere appreciation to the Australian Industrial Property Organisation and the European Patent Office as well as the patent Offices of Austria, France, Germany, the United Kingdom and the United States of America for their kind cooperation extended to us for obtaining the supplementary documents.

While hoping these Offices will continue to grant assistance by donating or selling to KIPO the missing parts of the minimum documentation they published, we anticipate that we will be able to complete the collection of those documents by the first half of next year.

In conclusion, we would like to assure all of you that KIPO has already established a sufficient qualified examining force and extensive documentation system for meeting almost all of the minimum requirements to be a qualified PCT/ISA and IPEA. The remainder of the documents for the minimum documentation will be secured in the shortest period of time. Encouraged by the recommendation of PCT/CTC for KIPO to be a prospective PCT/ISA and IPEA, as well as the successful progress in our preparations thus far, we sincerely request your full support for KIPO's appointment as a PCT/ISA and an IPEA.

Once again, we would like to express our appreciation to Dr. Bogsch, Director General of WIPO, and the members of the International Bureau for their excellent arrangements and cooperation for this meeting.

[Annex III follows]

ANNEX III

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
TEXT OF THE AMENDED RULES¹

Rule 3
The Request (Form)

3.1 and 3.2 [No change]

3.3 *Check List*

(a) The request shall contain a list indicating:

(i) the total number of sheets constituting the international application and the number of the sheets of each element of the international application: request, description (separately indicating the number of sheets of any sequence listing part of the description), claims, drawings, abstract;

(ii) where applicable, that the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a sequence listing in computer readable form, a document relating to the payment of fees, or any other document (to be specified in the check list);

(iii) [No change]

(b) [No change]

3.4 [No change]

Rule 4
The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

(a) 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:

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

1. The amendments will enter into force on July 1, 1998, except where otherwise indicated.

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property in which it was filed;

(iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

(b) In addition to any indication required under paragraph (a)(iv) or (v):

(i) where the earlier application is a regional application or an international application, the priority claim may indicate one or more countries party to the Paris Convention for the Protection of Industrial Property for which that earlier application was filed;

(ii) where the earlier application is a regional application and the countries party to the regional patent treaty are not all party to the Paris Convention for the Protection of Industrial Property, the priority claim shall indicate at least one country party to that Convention for which that earlier application was filed.

(c) For the purposes of paragraphs (a) and (b), Article 2(vi) shall not apply.

(d) [Deleted]

(e) [Deleted]

4.11 to 4.17 [No change]

Rule 5

The Description

5.1 [No change]

5.2 Nucleotide and/or Amino Acid Sequence Disclosure

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain a sequence listing complying with the standard provided for in the Administrative Instructions and presented as a separate part of the description in accordance with that standard.

(b) Where the sequence listing part of the description contains any free text as defined in the standard provided for in the Administrative Instructions, that free text shall also appear in the main part of the description in the language thereof.

Rule 11
Physical Requirements of the International Application

11.1 to 11.13 [No change]

11.14 *Later Documents*

Rules 10, and 11.1 to 11.13, also apply to any document—for example, corrected pages, amended claims, translations—submitted after the filing of the international application.

Rule 12
**Language of the International Application
and Translation for the Purposes of International Search**

12.1 *Languages Accepted for the Filing of International Applications*

(a) An international application shall be filed in any language which the receiving Office accepts for that purpose.

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

(i) a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office, and

(ii) a language of publication.

(iii) [Deleted]

(c) Notwithstanding paragraph (a), the request shall be filed in a language which is both a language accepted by the receiving Office under that paragraph and a language of publication.

(d) Notwithstanding paragraph (a), any text matter contained in the sequence listing part of the description referred to in Rule 5.2(a) shall be presented in accordance with the standard provided for in the Administrative Instructions.

12.2 *Language of Changes in the International Application*

(a) 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) where a translation of the international application is required under Rule 12.3(a), 48.3(b) or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language of the application and the language of that translation;

(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.

(c) Any correction under Rule 26 of a defect in the international application shall be in the language in which the international application is filed. Any correction under Rule 26 of a defect in a translation of the international application furnished under Rule 12.3 or 55.2(a), or in a translation of the request furnished under Rule 26.3ter(c), shall be in the language of the translation.

12.3 Translation for the Purposes of International Search

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

(i) a language accepted by that Authority, and

(ii) a language of publication, and

(iii) a language accepted by the receiving Office under Rule 12.1(a), unless the international application is filed in a language of publication.

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

(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 two months from the date of receipt of the international application by the receiving Office, whichever expires later.

(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 international application 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 and before the expiration of 15 months

from the priority date shall be considered to have been received before the expiration of that time limit.

(e) The furnishing of a translation 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 a late furnishing fee equal to 50% of the basic fee.

Rule 13bis **Inventions Relating to Biological Material**

13bis.1 Definition

For the purposes of this Rule, “reference to deposited biological material” means particulars given in an international application with respect to the deposit of biological material with a depositary institution or to the biological material so deposited.

13bis.2 References (General)

Any reference to deposited biological material shall be made in accordance with this Rule and, if so made, shall be considered as satisfying the requirements of the national law of each designated State.

13bis.3 References: Contents; Failure to Include Reference or Indication

(a) A reference to deposited biological material shall indicate:

- (i) [No change]
- (ii) the date of deposit of the biological material with that institution;
- (iii) and (iv) [No change]

(b) Failure to include a reference to deposited biological material or failure to include, in a reference to deposited biological material, an indication in accordance with paragraph (a), shall have no consequence in any designated State whose national law does not require such reference or such indication in a national application.

13bis.4 References: Time Limit for Furnishing Indications

(a) Subject to paragraphs (b) and (c), if any of the indications referred to in Rule 13bis.3(a) is not included in a reference to deposited biological material in the international application as filed but is furnished to the International Bureau:

(i) within 16 months from the priority date, the indication shall be considered by any designated Office to have been furnished in time;

(ii) after the expiration of 16 months from the priority date, the indication shall be considered by any designated Office to have been furnished on the last day of that time limit

if it reaches the International Bureau before the technical preparations for international publication have been completed.

(b) If the national law applicable by a designated Office so requires in respect of national applications, that Office may require that any of the indications referred to in Rule 13bis.3(a) be furnished earlier than 16 months from the priority date, provided that the International Bureau has been notified of such requirement pursuant to Rule 13bis.7(a)(ii) and has published such requirement in the Gazette in accordance with Rule 13bis.7(c) at least two months before the filing of the international application.

(c) Where the applicant makes a request for early publication under Article 21(2)(b), any designated Office may consider any indication not furnished before the technical preparations for international publication have been completed as not having been furnished in time.

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

(i) if the indication was received before the technical preparations for international publication have been completed, indicate that date, and include the relevant data from the indication, in the pamphlet published under Rule 48;

(ii) if the indication was received after the technical preparations for international publication have been completed, notify that date and the relevant data from the indication to the designated Offices.

*13bis.5 References and Indications for the Purposes of One or More Designated States;
Different Deposits for Different Designated States; Deposits with Depositary
Institutions Other than Those Notified*

(a) A reference to deposited biological material shall be considered to be made for the purposes of all designated States, unless it is expressly made for the purposes of certain of the designated States only; the same applies to the indications included in the reference.

(b) References to different deposits of the biological material may be made for different designated States.

(c) Any designated Office may disregard a deposit made with a depositary institution other than one notified by it under Rule 13bis.7(b).

13bis.6 Furnishing of Samples

(a) [Deleted]

Pursuant to Articles 23 and 40, no furnishing of samples of the deposited biological material to which a reference is made in an international application shall, except with the authorization of the applicant, take place before the expiration of the applicable time limits after which national processing may start under the said Articles. However, where the applicant performs the acts referred to in Articles 22 or 39 after international publication but before the expiration of the said time limits, the furnishing of samples of the deposited

biological material may take place, once the said acts have been performed. Notwithstanding the previous provision, the furnishing of samples of the deposited biological material may take place under the national law applicable by any designated Office as soon as, under that law, the international publication has the effects of the compulsory national publication of an unexamined national application.

13bis.7 National Requirements: Notification and Publication

(a) Any national Office may notify the International Bureau of any requirement of the national law:

(i) that any matter specified in the notification, in addition to those referred to in Rule 13bis.3(a)(i), (ii) and (iii), is required to be included in a reference to deposited biological material in a national application;

(ii) that one or more of the indications referred to in Rule 13bis.3(a) are required to be included in a national application as filed or are required to be furnished at a time specified in the notification which is earlier than 16 months from the priority date.

(b) Each national Office shall notify the International Bureau of the depositary institutions with which the national law permits deposits of biological materials to be made for the purposes of patent procedure before that Office or, if the national law does not provide for or permit such deposits, of that fact.

(c) [No change]

Rule 13ter
Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Sequence Listing for International Authorities

(a) Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:

(i) the international application does not contain a sequence listing complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing complying with that standard;

(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.

(b) [Deleted]

(c) If the applicant does not comply with an invitation under paragraph (a) within the time limit fixed in the invitation, the International Searching Authority shall not be required

to search the international application to the extent that such non-compliance has the result that a meaningful search cannot be carried out.

(d) Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to file the required correction. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

(e) Paragraphs (a) and (c) shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

(f) Any sequence listing not contained in the international application as filed shall not, subject to Article 34, form part of the international application.

13ter.2 Sequence Listing for Designated Office

Once the processing of the international application has started before a designated Office, Rule 13ter.1(a) shall apply *mutatis mutandis* to the procedure before that Office. No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

(b) [Deleted]

Rule 14 The Transmittal Fee

14.1 The Transmittal Fee

(a) [No change]

(b) The amount of the transmittal fee, if any, shall be fixed by the receiving Office.

(c) The transmittal fee shall be paid within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

Rule 15 The International Fee

15.1 Basic Fee and Designation Fee

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau ("international fee") to be collected by the receiving Office and consisting of,

(i) [No change]

(ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a), except that, where Article 44 applies in respect of a designation, only one designation fee shall be due for that designation, and that the Schedule of Fees may indicate a maximum number of designation fees payable.

15.2 *Amounts*

(a) [No change]

(b) The basic fee and the designation fee shall be payable in the currency or one of the currencies prescribed by the receiving Office (“prescribed currency”), it being understood that, when transferred by the receiving Office to the International Bureau, they shall be freely convertible into Swiss currency. The amounts of the basic fee and of the designation fee shall be established, for each receiving Office which prescribes the payment of those fees in any currency other than Swiss currency, by the Director General after consultation with the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as the prescribed currency. The amounts so established shall be the equivalents, in round figures, of the amounts in Swiss currency set out in the Schedule of Fees. They shall be notified by the International Bureau to each receiving Office prescribing payment in that prescribed currency and shall be published in the Gazette.

(c) [No change]

(d) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish new amounts in the prescribed currency according to directives given by the Assembly. The newly established amounts shall become applicable two months after the date of their publication in the Gazette, provided that the receiving Office referred to in the second sentence of paragraph (b) and the Director General may agree on a date falling during the said two-month period, in which case the said amounts shall become applicable from that date.

15.3 [Deleted]

15.4 *Time Limit for Payment; Amount Payable*

(a) The basic fee shall be paid within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

(b) The designation fee shall be paid within a time limit of:

(i) one year from the priority date, or

(ii) one month from the date of receipt of the international application if that one-month period expires later than one year from the priority date.

(c) Where the designation fee is paid before the expiration of one month from the date of receipt of the international application, the amount payable shall be the amount applicable on that date of receipt. Where the time limit under paragraph (b)(i) applies and the designation fee is paid before the expiration of that time limit but later than one month from

the date of receipt of the international application, the amount payable shall be the amount applicable on the date of payment.

(i) and (ii) [Deleted]

15.5 *Fees Under Rule 4.9(c)*

(a) Notwithstanding Rule 15.4(b), the confirmation under Rule 4.9(c) of any designations made under Rule 4.9(b) shall be subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office) equal to 50% of the sum of the designation fees payable under this paragraph. Such fees shall be payable in respect of each designation so confirmed, even if the maximum number of designation fees referred to in item 2(a) of the Schedule of Fees is already payable or if a designation fee is already payable in respect of the designation under Rule 4.9(a) of the same State for a different purpose.

(b) [No change]

15.6 *Refund*

The receiving Office shall refund the international fee to the applicant:

- (i) if the determination under Article 11(1) is negative,
- (ii) if, before the transmittal of the record copy to the International Bureau, 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.

Rule 16 **The Search Fee**

16.1 *Right to Ask for a Fee*

(a) [No change]

(b) The search fee shall be collected by the receiving Office. The said fee shall be payable in the currency or one of the currencies prescribed by that Office (“receiving Office currency”), it being understood that, if any receiving Office currency is not that, or one of those, in which the International Searching Authority has fixed the said fee (“fixed currency”), it shall, when transferred by the receiving Office to the International Searching Authority, be freely convertible into the currency of the State in which the International Searching Authority has its headquarters (“headquarters currency”). The amount of the search fee in any receiving Office currency, other than the fixed currency, shall be established by the Director General after consultation with the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as the receiving Office currency. The amounts so established shall be the equivalents, in round figures, of the

amount established by the International Searching Authority in the headquarters currency. They shall be notified by the International Bureau to each receiving Office prescribing payment in that receiving Office currency and shall be published in the Gazette.

(c) [No change]

(d) Where the exchange rate between the headquarters currency and any receiving Office currency, other than the fixed currency or currencies, becomes different from the exchange rate last applied, the Director General shall establish the new amount in the said receiving Office currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that any receiving Office referred to in the third sentence of paragraph (b) and the Director General may agree on a date falling during the said two-month period, in which case the said amount shall become applicable for that Office from that date.

(e) [No change]

(f) As to the time limit for payment of the search fee and the amount payable, the provisions of Rule 15.4(a) relating to the basic fee shall apply *mutatis mutandis*.

16.2 *Refund*

The receiving Office shall refund the search fee to the applicant:

- (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.

16.3 [No change]

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(a) 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 basic fee and the search fee, the receiving Office shall 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.

(b) Where, by the time they are due under Rule 15.4(b), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the designation fees necessary to cover all the designations under Rule 4.9(a), the receiving Office shall 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. The amount payable in respect of any designation fee shall be the amount applicable on the last day of the one-year period from the priority date if the time limit under Rule 15.4(b)(i) applies or the amount applicable on the date of receipt of the international application if the time limit under Rule 15.4(b)(ii) applies.

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) or (b) 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 (d):

(i) to (iii) [No change]

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

(e) 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) or (b).

16bis.2 Late Payment Fee

(a) The payment of fees in response to an invitation under Rule 16bis.1(a) or (b) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) and (ii) [No change]

(b) The amount of the late payment fee shall not, however, exceed the amount of the basic fee referred to in item 1(a) of the Schedule of Fees.

Rule 17 **The Priority Document**

17.1 Obligation to Submit Copy of Earlier National or International Application

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed (“the priority document”), shall, unless already filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraph (b), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office to the payment of a fee.

(c) If the requirements of neither of the two preceding paragraphs are complied with, any designated State may disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a) or (b), the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(b) [No change]

(c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

(i) [No change]

(ii) the relevant priority claim was withdrawn or considered, under Rule 26bis.2(b), not to have been made.

(iii) [Deleted]

(d) [Deleted]

Rule 19 **The Competent Receiving Office**

19.1 to 19.3 [No change]

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 but

- (i) that national Office is not competent under Rule 19.1 or 19.2 to receive that international application, or
- (ii) that international application is not in a language accepted under Rule 12.1(a) by that national Office but is in a language accepted under that Rule by the International Bureau as receiving Office, or
- (iii) that national Office and the International Bureau agree, for any reason other than those specified under items (i) and (ii), and with the authorization of the applicant, that the procedure under this Rule should apply,

that international application shall, subject to paragraph (b), be considered to have been received by that Office on behalf of the International Bureau as receiving Office under Rule 19.1(a)(iii).

(b) [No change]

(c) For the purposes of Rules 14.1(c), 15.4(a) to (c) and 16.1(f), where the international application was transmitted to the International Bureau under paragraph (b), the date of receipt of the international application shall be considered to be the date on which the international application was actually received by the International Bureau. For the purposes of this paragraph, the last sentence of paragraph (b) shall not apply.

Rule 20

Receipt of the International Application

20.1 to 20.3 [No change]

20.4 *Determination Under Article 11(1)*

(a) and (b) [No change]

(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.

20.5 to 20.9 [No change]

Rule 22
Transmittal of the Record Copy and Translation

22.1 *Procedure*

(a) to (g) [No change]

(h) Where the international application is to be published in the language of a translation furnished under Rule 12.3, that translation shall be transmitted by the receiving Office to the International Bureau together with the record copy under paragraph (a) or, if the receiving Office has already transmitted the record copy to the International Bureau under that paragraph, promptly after receipt of the translation.

22.2 [Remains deleted]

22.3 [No change]

Rule 23
Transmittal of the Search Copy, Translation and Sequence Listing

23.1 *Procedure*

(a) Where no translation of the international application is required under Rule 12.3(a), 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, a copy of the said translation and of the request shall be transmitted promptly after payment of the search fee.

(c) Any sequence listing in computer readable form which is furnished to the receiving Office shall be transmitted by that Office to the International Searching Authority.

Rule 26
**Checking by, and Correcting Before, the Receiving Office
of Certain Elements of the International Application**

26.1 and 26.2 [No change]

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

(a) Where the international application is filed in a language of publication, the receiving Office shall check:

(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;

(ii) any translation furnished under Rule 12.3 for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.

(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:

(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction;

(ii) any translation furnished under Rule 12.3 and the drawings for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

26.3bis Invitation under Article 14(1)(b) to Correct Defects Under Rule 11

The receiving Office shall not be required to issue the invitation under Article 14(1)(b) to correct a defect under Rule 11 where the physical requirements referred to in that Rule are complied with to the extent required under Rule 26.3.

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) a translation of the international application is required under Rule 12.3(a), or

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

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

(b) If, on October 1, 1997, paragraph (a) is not compatible with the national law applied by the receiving Office, paragraph (a) 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.

(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*.

(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.

26.4 [No change, except for the deletion of the redundant numbering of paragraph “(a)”]

26.5 [No change, except for the deletion of the redundant numbering of paragraph “(a)”]

26.6 [No change]

Rule 26bis **Correction or Addition of Priority Claim**

26bis.1 Correction or Addition of Priority Claim

(a) The applicant may correct or add a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

(b) Any notice referred to in paragraph (a) received by the receiving Office or the International Bureau after the applicant has made a request for early publication under Article 21(2)(b) shall be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed.

(c) Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

26bis.2 Invitation to Correct Defects in Priority Claims

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds that a priority claim does not comply with the requirements of Rule 4.10 or that any indication in a priority claim is not the same as the corresponding indication appearing in the priority document, the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim.

(b) If, in response to an invitation under paragraph (a), the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim so as to comply with the requirements of Rule 4.10, that priority claim shall, 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, provided that a priority claim shall not be considered not to

have been made only because the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing or because an indication in the priority claim is not the same as the corresponding indication appearing in the priority document.

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

Rule 29

International Applications or Designations Considered Withdrawn

29.1 Finding by Receiving Office

(a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) to (iv) [No change]

(b) [No change]

29.2 [Remains deleted]

29.3 and 29.4 [No change]

Rule 34

Minimum Documentation

34.1 Definition

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) the patents issued in and after 1920 by France, the former *Reichspatentamt* of Germany, Japan, the former Soviet Union, Switzerland (in the French and German languages only), the United Kingdom, and the United States of America,

(ii) the patents issued by the Federal Republic of Germany and the Russian Federation,

(iii) [No change]

(iv) the inventors' certificates issued by the former Soviet Union,

(v) and (vi) [No change]

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [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 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.

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 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.

(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 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.

43.5 to 43.8 [No change]

43.9 *Additional Matter*

The international search report shall contain no matter other than that specified in Rules 33.1(b) and (c), 43.1 to 43.3, 43.5 to 43.8, and 44.2, and the indication referred to in Article 17(2)(b), provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. The international search report shall not contain, and the Administrative Instructions shall not permit the inclusion of, any expressions of opinion, reasoning, arguments, or explanations.

43.10 [No change]

Rule 44 **Transmittal of the International Search Report, Etc.**

44.1 [No change]

44.2 [No change, except for the deletion of the redundant numbering of paragraph “(a)”]

44.3 [No change]

Rule 46
Amendment of Claims Before the International Bureau

46.1 to 46.4 [No change]

46.5 [No change, except for the deletion of the redundant numbering of paragraph “(a)”]

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.

(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, a copy of that application in the language in which it was filed.

47.4 [No change]

Rule 48
International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (vii) [No change]

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

(ix) any information concerning a priority claim considered not to have been made under Rule 26*bis*.2(b), the publication of which is requested under Rule 26*bis*.2(c).

(b) to (i) [No change]

48.3 *Languages of Publication*

(a) 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.

(a-bis) 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, that application shall be published in the language of that translation.

(b) If the international application is filed in a language which is not a language of publication and no translation into a language of publication is required under Rule 12.3(a), that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the relevant portions of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

(c) [No change]

48.4 to 48.6 [No change]

Rule 49

Copy, Translation and Fee Under Article 22

49.1 to 49.4 [No change]

49.5 *Contents of and Physical Requirements for the Translation*

(a) For the purposes of Article 22, the translation of the international application shall contain the description (subject to paragraph (a-bis)), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b), (c-bis) and (e),

(i) to (iii) [No change]

(a-bis) No designated Office shall require the applicant to furnish to it a translation of any text matter contained in the sequence listing part of the description if such sequence listing part complies with Rule 12.1(d) and if the description complies with Rule 5.2(b).

(b) to (l) [No change]

Rule 54
The Applicant Entitled to Make a Demand

54.1 [No change]

54.2 *Right to Make a Demand*

The right to make a demand under Article 31(2) shall exist if the applicant making the demand or, if there are two or more applicants, at least one of them is 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.

(i) and (ii) [Deleted]

54.3 [No change]

54.4 [No change, except for the deletion of the redundant numbering of paragraph “(a)”]

Rule 55
Languages (International Preliminary Examination)

55.1 [No change]

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 is accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant shall, subject to paragraph (b), furnish with the demand a translation of the international application into a language which is both:

(i) a language accepted by that Authority, and

(ii) a language of publication.

(b) Where a translation of the international application into a language referred to in paragraph (a) was transmitted to the International Searching Authority under Rule 23.1(b) and the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority, the applicant need not furnish a translation under paragraph (a). In such a case, unless the applicant furnishes a translation under paragraph (a), the international preliminary examination shall be carried out on the basis of the translation transmitted under Rule 23.1(b).

(c) [No change]

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

(e) [Deleted]

55.3 [No change]

Rule 57 **The Handling Fee**

57.1 [No change, except for the deletion of the redundant numbering of paragraph “(a)”]

57.2 *Amount*

(a) [No change]

(b) [Remains deleted]

(c) The handling fee shall be payable in the currency or one of the currencies prescribed by the International Preliminary Examining Authority (“prescribed currency”), it being understood that, when transferred by that Authority to the International Bureau, it shall be freely convertible into Swiss currency. The amount of the handling fee shall be established, in each prescribed currency, for each International Preliminary Examining Authority which prescribes the payment of the handling fee in any currency other than Swiss currency, by the Director General after consultation with the Office with which consultation takes place under Rule 15.2(b) in relation to that currency, or, if there is no such Office, with the Authority which prescribes payment in that currency. The amount so established shall be the equivalent, in round figures, of the amount in Swiss currency set out in the Schedule of Fees. It shall be notified by the International Bureau to each International Preliminary Examining Authority prescribing payment in that prescribed currency and shall be published in the Gazette.

(d) and (e) [No change]

57.3 *Time Limit for Payment; Amount Payable*

The handling fee shall be paid within one month from the date on which the demand was submitted, provided that, where the demand was transmitted to the International Preliminary Examining Authority under Rule 59.3, the handling fee shall be paid within one month from the date of receipt by that Authority. The amount payable shall be the amount applicable on that date of submittal or date of receipt, as the case may be. For the purposes of the preceding two sentences, Rule 59.3(e) shall not apply.

(b) [Remains deleted]

(c) [Deleted]

57.4 [Deleted]

57.5 [Remains deleted]

57.6 *Refund*

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

- (i) [No change]
- (ii) if the demand is considered, under Rule 54.4, not to have been submitted.

Rule 58 **The Preliminary Examination Fee**

58.1 *Right to Ask for a Fee*

- (a) [No change]
- (b) The amount of the preliminary examination fee, if any, shall be fixed by the International Preliminary Examining Authority. As to the time limit for payment of the preliminary examination fee and the amount payable, the provisions of Rule 57.3 relating to the handling fee shall apply *mutatis mutandis*.
- (c) [No change]

58.2 [Deleted]

58.3 [No change]

Rule 58bis **Extension of Time Limits for Payment of Fees**

58bis.1 *Invitation by the International Preliminary Examining Authority*

- (a) Where, by the time they are due under Rules 57.3 and 58.1(b), the International Preliminary Examining Authority finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the handling fee and the preliminary examination fee, the Authority shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 58bis.2, within a time limit of one month from the date of the invitation.
- (b) Where the International Preliminary Examining Authority has sent 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 58bis.2, the demand shall, subject to paragraph (c), be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

(c) Any payment received by the International Preliminary Examining Authority before that Authority sends the invitation under paragraph (a) shall be considered to have been received before the expiration of the time limit under Rule 57.3 or 58.1(b), as the case may be.

(d) Any payment received by the International Preliminary Examining Authority before that Authority proceeds under paragraph (b) shall be considered to have been received before the expiration of the time limit under paragraph (a).

58bis.2 Late Payment Fee

(a) The payment of fees in response to an invitation under Rule 58bis.1(a) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

- (i) 50% of the amount of unpaid fees which is specified in the invitation, or,
- (ii) if the amount calculated under item (i) is less than the handling fee, an amount equal to the handling fee.

(b) The amount of the late payment fee shall not, however, exceed double the amount of the handling fee.

Rule 59

The Competent International Preliminary Examining Authority

59.1 and 59.2 [No change]

59.3 Transmittal of Demand to the Competent International Preliminary Examining Authority

(a) If the demand is submitted to a receiving Office, an International Searching Authority, or an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, that Office or Authority shall mark the date of receipt on the demand and, unless it decides to proceed under paragraph (f), transmit the demand promptly to the International Bureau.

(b) If the demand is submitted to the International Bureau, the International Bureau shall mark the date of receipt on the demand.

(c) Where the demand is transmitted to the International Bureau under paragraph (a) or submitted to it under paragraph (b), the International Bureau shall promptly:

- (i) if there is only one competent International Preliminary Examining Authority, transmit the demand to that Authority and inform the applicant accordingly, or
- (ii) if two or more International Preliminary Examining Authorities are competent, invite the applicant to indicate, within 15 days from the date of the invitation or 19 months

from the priority date, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

(d) Where an indication is furnished as required under paragraph (c)(ii), the International Bureau shall promptly transmit the demand to the competent International Preliminary Examining Authority indicated by the applicant. Where no indication is so furnished, the demand shall be considered not to have been submitted and the International Bureau shall so declare.

(e) Where the demand is transmitted to a competent International Preliminary Examining Authority under paragraph (c), it shall be considered to have been received on behalf of that Authority on the date marked on it under paragraph (a) or (b), as applicable, and the demand so transmitted shall be considered to have been received by that Authority on that date.

(f) Where an Office or Authority to which the demand is submitted under paragraph (a) decides to transmit that demand directly to the competent International Preliminary Examining Authority, paragraphs (c) to (e) shall apply *mutatis mutandis*.

Rule 60

Certain Defects in the Demand or Elections

60.1 Defects in the Demand

(a) and (b) [No change]

(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

(d) to (g) [No change]

60.2 Defects in Later Elections

(a) and (b) [No change]

(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had not been submitted and the International Bureau shall so declare.

(d) [No change]

Rule 61
Notification of the Demand and Elections

61.1 Notification to the International Bureau and the Applicant

(a) The International Preliminary Examining Authority shall indicate on the demand the date of receipt or, where applicable, the date referred to in Rule 60.1(b). The International Preliminary Examining Authority shall promptly either send the demand to the International Bureau and keep a copy in its files or send a copy to the International Bureau and keep the demand in its files.

(b) The International Preliminary Examining Authority shall promptly notify the applicant of the date of receipt of the demand. Where the demand has been considered under Rules 54.4, 55.2(d), 58*bis*.1(b) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 60.1(d) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) [No change]

61.2 and 61.3 [No change]

61.4 Publication in the Gazette

Where a demand has been filed before the expiration of 19 months from the priority date, the International Bureau shall, promptly after the filing of the demand but not before the international publication of the international application, publish in the Gazette information on the demand and the elected States concerned, as provided in the Administrative Instructions.

Rule 62
Copy of Amendments Under Article 19
for the International Preliminary Examining Authority

62.1 Amendments Made Before the Demand is Filed

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit a copy of any amendments under Article 19, and any statement referred to in that Article, to that Authority, unless that Authority has indicated that it has already received such a copy.

62.2 Amendments Made After the Demand is Filed

If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments and any statement referred to in that Article. In any case, the International Bureau shall promptly transmit a copy of such amendments and statement to that Authority.

Rule 66
Procedure Before the International Preliminary Examining Authority

66.1 to 66.7 [No change]

66.8 Form of Amendments

(a) Subject to paragraph (b), the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) Where the amendment consists in the deletion of passages or in minor alterations or additions, the replacement sheet referred to in paragraph (a) may be a copy of the relevant sheet of the international application containing the alterations or additions, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter which shall preferably also explain the reasons for the amendment.

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 of publication.

(b) to (d) [No change]

Rule 69
Start of and Time Limit for International Preliminary Examination

69.1 [No change]

69.2 Time Limit for International Preliminary Examination

The time limit for establishing the international preliminary examination report shall be:

- (i) 28 months from the priority date, or
- (ii) eight months from the date of payment of the fees referred to in Rules 57.1 and 58.1(a), or
- (iii) eight months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2,

whichever expires last.

Rule 70
The International Preliminary Examination Report

70.1 to 70.6 [No change]

70.7 *Citations Under Article 35(2)*

(a) The report shall cite the documents considered to be relevant for supporting the statements made under Article 35(2), whether or not such documents are cited in the international search report. Documents cited in the international search report need only be cited in the report when they are considered by the International Preliminary Examining Authority to be relevant.

(b) [No change]

70.8 to 70.15 [No change]

70.16 *Annexes to the Report*

Each replacement sheet under Rule 66.8(a) or (b), each replacement sheet containing amendments under Article 19 and each replacement sheet containing rectifications of obvious errors authorized under Rule 91.1(e)(iii) shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

70.17 [No change, except for the deletion of the redundant numbering of paragraph “(a)”]

Rule 76
Copy, Translation and Fee Under Article 39(1);
Translation of Priority Document

76.1 to 76.3 [Remain deleted]

76.4 *Time Limit for Translation of Priority Document*

The applicant shall not be required to furnish to any elected Office a translation of the priority document before the expiration of the applicable time limit under Article 39.

76.5 and 76.6 [No change]

Rule 80
Computation of Time Limits

80.1 to 80.5 [No change]

80.6 [No change, except for the deletion of the redundant numbering of paragraph “(a)”]

80.7 [No change]

Rule 82^{ter}
Rectification of Errors Made by
the Receiving Office or by the International Bureau

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

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered 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.

Rule 86²
The Gazette

86.1 Contents and Form

(a) The Gazette referred to in Article 55(4) shall contain:

(i) for each published international application, the data specified by the Administrative Instructions taken from the front page of the pamphlet published under Rule 48, the drawing (if any) appearing on the said front page, and the abstract,

(ii) to (v) [No change]

2. The amendments of Rule 86 will enter into force on January 1, 1998, on the understanding that, for practical reasons, it may not be possible for the new formats of the Gazette to be implemented from that date, in which case the International Bureau will continue to publish the Gazette in the present format for a short period after January 1, 1998, and the new formats will be introduced as soon as possible after that date.

(b) The information referred to in paragraph (a) shall be made available in two forms:

(i) as a Gazette in paper form, which shall contain the data specified by the Administrative Instructions taken from the front page of the pamphlet published under Rule 48 (“bibliographic data”) and the matters referred to in paragraph (a)(ii) to (v);

(ii) as a Gazette in electronic form, which shall contain the bibliographic data, the drawing (if any) appearing on the said front page, and the abstract.

86.2 *Languages; Access to the Gazette*

(a) The Gazette in paper form shall be published in a bilingual (English and French) edition. It shall also be published in editions in any other language, provided the cost of publication is assured through sales or subventions.

(b) [No change]

(c) The Gazette in electronic form referred to in Rule 86.1(b)(ii) shall be made accessible, in English and French at the same time, by any electronic ways and means specified in the Administrative Instructions. The translations shall be ensured by the International Bureau in English and French. The International Bureau shall ensure that the making accessible of the Gazette in electronic form shall be effected on, or as soon as possible after, the date of publication of the pamphlet containing the international application.

86.3 to 86.6 [No change]

Rule 89bis³

Filing, Processing and Transmission of International Applications and Other Documents in Electronic Form or by Electronic Means

89bis.1 International Applications

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

(b) These Regulations shall apply *mutatis mutandis* to international applications filed in electronic form or by electronic means, subject to any special provisions of the Administrative Instructions.

3. Rules 89bis and 89ter, to be inserted in Part F (Rules Concerning Several Chapters of the Treaty) before Rule 90, will enter into force at the same time as the modifications of the Administrative Instructions implementing those Rules, the effective date to be included in the promulgation of those modifications by the Director General.

(c) The Administrative Instructions shall set out the provisions and requirements in relation to the filing and processing of international applications filed, in whole or in part, in electronic form or by electronic means, including but not limited to, provisions and requirements in relation to acknowledgment of receipt, procedures relating to the according of an international filing date, physical requirements and the consequences of non-compliance with those requirements, signature of documents, means of authentication of documents and of the identity of parties communicating with Offices and authorities, and the operation of Article 12 in relation to the home copy, the record copy and the search copy, and may contain different provisions and requirements in relation to international applications filed in different languages.

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

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

89bis.2 Other Documents

Rule 89bis.1 shall apply *mutatis mutandis* to other documents and correspondence relating to international applications.

89bis.3 Transmittal Between Offices

Where the Treaty, these Regulations or the Administrative Instructions provide for documents, notifications, communications or correspondence to be transmitted by one national Office or intergovernmental organization to another, such transmittal may, where so agreed by both the sender and the receiver, be effected in electronic form or by electronic means.

Rule 89^{ter}⁴

Copies in Electronic Form of Documents Filed on Paper

89^{ter}.1 Copies in Electronic Form of Documents Filed on Paper

Any national Office or intergovernmental organization may provide that, where an international application or other document relating to an international application is filed on paper, a copy thereof in electronic form, in accordance with the Administrative Instructions, may be furnished by the applicant.

Rule 91

Obvious Errors in Documents

91.1 Rectification

(a) to (c) [No change]

(d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be an obvious error may invite the applicant to present a request for rectification as provided in paragraphs (e) to (g-*quater*). Rule 26.4 shall apply *mutatis mutandis* to the manner in which rectifications shall be requested.

(e) to (g-*quater*) [No change]

Rule 92

Correspondence

92.1 [No change]

92.2 Languages

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

(b) [No change]

4. Rules 89^{bis} and 89^{ter}, to be inserted in Part F (Rules Concerning Several Chapters of the Treaty) before Rule 90, will enter into force at the same time as the modifications of the Administrative Instructions implementing those Rules, the effective date to be included in the promulgation of those modifications by the Director General.

(c) [Remains deleted]

(d) and (e) [No change]

92.3 [No change]

92.4 *Use of Telegraph, Teleprinter, Facsimile Machine, Etc.*

(a) A document making up the international application, and any later document or correspondence relating thereto, may, notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraph (h), be transmitted, to the extent feasible, by telegraph, teleprinter, facsimile machine or other like means of communication resulting in the filing of a printed or written document.

(b) to (h) [No change]

Rule 93 **Keeping of Records and Files**

93.1 to 93.3 [No change]

93.4 *Reproductions*

For the purposes of this Rule, records, copies and files may be kept as photographic, electronic or other reproductions, provided that the reproductions are such that the obligations to keep records, copies and files under Rules 93.1 to 93.3 are met.

Rule 94⁵ **Access to Files**

94.1 *Access to the File Held by the International Bureau*

(a) At the request of the applicant or any person authorized by the applicant, the International Bureau shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

5. Rule 94 as amended will apply only in respect of international applications filed on or after July 1, 1998; present Rule 94 will continue to apply after July 1, 1998, in respect of international applications filed before that date.

94.2 Access to the File Held by the International Preliminary Examining Authority

At the request of the applicant or any person authorized by the applicant, or, once the international preliminary examination report has been established, of any elected Office, the International Preliminary Examining Authority shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

94.3 Access to the File Held by the Elected Office

If the national law applicable by any elected Office allows access by third parties to the file of a national application, that Office may allow access to any documents relating to the international application, including any document relating to the international preliminary examination, contained in its file, to the same extent as provided by the national law for access to the file of a national application, but not before the international publication of the international application. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

SCHEDULE OF FEES

as in force from January 1 to June 30, 1998⁶

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 ⁷ Swiss francs
(b) if the international application contains more than 30 sheets	650 ⁷ Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	150 ⁷ Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 11 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	150 ⁷ Swiss francs per designation
3. ⁶ Confirmation Fee: (Rule 15.5(a))	50% of the sum of the designation fees payable under item 2(b)
4. ⁶ Handling Fee: (Rule 57.2(a))	233 Swiss francs

All fees are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

6. The Schedule of Fees appearing on this page will enter into force on January 1, 1998; it will be further amended with effect from July 1, 1998, by deleting item 3 and renumbering item 4 as item 3 (see the following page).

7. The new amounts of the basic fee and the designation fee will apply only to international applications filed on or after January 1, 1998.

SCHEDULE OF FEES

as in force from July 1, 1998⁸

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 ⁹ Swiss francs
(b) if the international application contains more than 30 sheets	650 ⁹ Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	150 ⁹ Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 11 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c) ¹⁰	150 ⁹ Swiss francs per designation
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

All fees are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[Annex IV follows]

8. The Schedule of Fees appearing on this page will enter into force on July 1, 1998.

9. The new amounts of the basic fee and the designation fee will apply only to international applications filed on or after January 1, 1998.

10. See also Rule 15.5(a) for the confirmation fee, which is also payable.

ANNEX IV

MODIFIED DIRECTIVES OF THE PCT ASSEMBLY
RELATING TO THE ESTABLISHMENT OF
NEW EQUIVALENT AMOUNTS OF CERTAIN FEES

The Assembly established in the following terms the directives referred to in Rules 15.2(d), 16.1(d) and 57.2(e), it being understood that, in the light of experience, the Assembly may at any time modify these directives:

(1) At the time of each ordinary session of the Assembly, the Director General shall undertake consultations along the lines of the consultations referred to in Rules 15.2(b) and 57.2(c) and shall establish new equivalent amounts of the basic fee, designation fee and handling fee in currencies other than Swiss francs according to the exchange rates applicable on the first day of that session, so that their amounts correspond to the amounts of the fees expressed in Swiss currency. Where such adjustment would only slightly affect the income of the International Bureau, the Director General may decide not to proceed with it. Unless otherwise decided by the Assembly, any adjustment under this paragraph shall enter into force on the first day of the calendar year subsequent to the ordinary session referred to above.

(2) Where for more than 30 consecutive days, the exchange rate between Swiss currency and any other currency is by at least 5% higher, or by at least 5% lower, than the last exchange rate applied,

- (i) so far as Rule 15.2(d) is concerned, any receiving Office referred to in the second sentence of Rule 15.2(b) or
- (ii) so far as Rule 57.2(e) is concerned, any receiving Office or International Preliminary Examining Authority referred to in the second sentence of Rule 57.2(c)

may ask the Director General to newly establish the amount of the basic fee, designation fee and/or handling fee in that currency according to the exchange rate prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly, as provided in Rules 15.2(d) and 57.2(e).

(3) Where for more than 30 consecutive days, the exchange rate between Swiss currency and any other currency is by at least 10% higher, or by at least 10% lower, than the last exchange rate applied, the Director General shall,

- (i) so far as Rule 15.2(d) is concerned, after consultation with the receiving Office referred to in the second sentence of Rule 15.2(b) or
- (ii) so far as Rule 57.2(e) is concerned, after consultation with the receiving Office or International Preliminary Examining Authority referred to in the second sentence of Rule 57.2(c)

and as provided in Rules 15.2(d) and 57.2(e), as the case may be, newly establish the amount of the basic fee, designation fee and/or handling fee in that currency according to the

exchange rate prevailing on the day preceding the day on which the consultation is initiated by the Director General. Where such adjustment would only slightly affect the income of the International Bureau, the Director General may decide not to proceed with it.

(4) As far as the search fee of any International Searching Authority in any currency other than the currency or currencies fixed by that Authority is concerned, paragraphs (1) to (3) shall, to the extent applicable, apply *mutatis mutandis*, except in the case where the equivalent amount of that fee in Swiss francs is equal to or more than 1,000 Swiss francs, in which case the Director General may decide to apply paragraph (3) as if the percentage referred to in that paragraph was 5%.

[End of Annex and of document]

WIPO



PCT/A/26/2

ORIGINAL: English

DATE: September 15, 1998

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Twenty-Sixth (15th Extraordinary) Session
Geneva, September 7 to 15, 1998**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/33/1 Prov.2): 1, 2, 4, 6, 7, 9, 14, 15, 20 and 21.
2. The report on the said items, with the exception of item 15, is contained in the General Report (document A/33/8).
3. The report on item 15 is contained in the present document.
4. In the absence of its Chair and two Vice-Chairs, the Assembly unanimously elected Mrs. América Néstar Santos Riveras (Cuba) as Acting Chair.

ITEM 15 OF THE CONSOLIDATED AGENDA:

AMENDMENT OF THE SCHEDULE OF FEES UNDER THE PCT

5. Discussions were based on document PCT/A/26/1.
6. The Secretariat introduced the proposals set out in document PCT/A/26/1 and proposed a minor amendment to item 4 of the proposed amended Schedule of Fees set out in Annex 1 to document PCT/A/26/1, whereby the words “in accordance with and to the extent provided for in the Administrative Instructions” would be placed before, rather than after, the word “filed.” This would make it clear that both the international application on paper and the copy thereof in electronic form would have to be filed in accordance with and to the extent provided for in the Administrative Instructions in order to qualify for the proposed fee reduction.
7. The Secretariat also proposed a further minor drafting change to the French text of item 4 of the proposed amended Schedule of Fees, namely, to replace the words “en même temps qu’” by the word “avec.”
8. With regard to the proposed modifications of the Administrative Instructions implementing Rule 89~~ter~~ to the extent provided for in those modifications, as set out in Annex 2 to document PCT/A/26/1, which had been issued for the purposes of consultation under Rule 89.2(b), the International Bureau asked that any comments by delegations be communicated to the International Bureau during the session of the Assembly. Further guidance with regard to the application of the proposed fee reductions, including information on the equivalent amounts of the 200 Swiss franc fee reduction in currencies other than Swiss francs, would be provided by the International Bureau to receiving Offices when promulgating the modifications of the Administrative Instructions.
9. The Delegation of the Netherlands, speaking on behalf of Group B, expressed its support for the proposed amendments of the Schedule of Fees and noted the intentions of the Director General as regards the proposed modifications of the Administrative Instructions.
10. The Delegation of Mexico expressed its support for the measures proposed in paragraph 16(a) and (b) of document PCT/A/26/1, which would promote greater use of the PCT system. With respect to the reduction of PCT fees, the delegation requested that the Secretariat carry out a study of whether the 75% fee reduction presently applicable to natural persons who were nationals and residents of certain States (now appearing as item 5 of the proposed amended Schedule of Fees) could be extended to certain entities such as universities and research institutions. Such an extension would encourage countries such as Mexico to strengthen the use of the PCT.
11. The Delegation of Cuba expressed its support for the proposed fee reductions, agreeing with the Delegation of the Netherlands, and for the study requested by the Delegation of Mexico.
12. The Director General stated that, if it was the wish of the Assembly, the Secretariat was prepared to carry out such a study.

13. The Assembly:

- (i) unanimously adopted the proposed amendments to the Schedule of Fees as set out in the Annex to this report and decided that they would enter into force on January 1, 1999;
- (ii) noted that the Director General intended to promulgate modifications of the Administrative Instructions implementing Rule 89^{ter} of the PCT Regulations to the extent provided for in those modifications as set out in Annex 2 to document PCT/A/26/1 and revised taking into account the results of consultations with interested Offices pursuant to Rule 89.2(b) of the PCT Regulations during the Assembly's session, with effect from January 1, 1999.

14. The Delegation of the Netherlands, speaking on behalf of Group B, made the following statement:

“Group B notes with satisfaction the adoption of the proposal. However, having said so, we would like to point out that there should, in principle, be no surplus and that, if there will be any, it should be kept to a minimum in the fee-financed Unions, such as the PCT Union. The International Bureau must continue to strive to reduce excess revenues and to maintain fiscal stringency in the expenditure budget. Taking into consideration the size of the possible surplus at the end of this biennium, which will be accumulated into the reserve fund which has already a considerable size, Group B considers the revised PCT fees to be still too high; further substantial reduction could be possible. Therefore, with a view to ensuring transparency and accountability, we would like to request the International Bureau to submit documentation to the members of the PCT Union, including future projections such as the increase of applications, with respect to the Schedule of Fees, which enables members of the Union to evaluate whether the revised fees are appropriate. Finally, Madam Chair, we would like to underline that fee reduction as such does not mean automatically the decrease of total income of this Union since the increase in applications will be able to compensate for the reduction. Rather, in the long term, we may expect the increase of total income by the appropriate fee reduction. Thank you, Madam Chair.”

15. The Director General stated that the Secretariat had noted the statement made by the Delegation of the Netherlands on behalf of Group B and that, if it was the wish of the Assembly, the requested projections would be prepared by the Secretariat and provided to Contracting States.

16. Speaking later in the General Assembly, the Delegation of Mexico made, on behalf of the Group of Latin American and Caribbean countries, the following statement:

“I would like to begin by thanking the Secretariat for preparing and distributing the statement made on Friday by the Delegation of the Netherlands speaking on behalf of Group B. On behalf of the Latin American and Caribbean Group, I should like to say that we were very surprised by this statement because, as proposed by Group B itself, we had agreed to discuss the budget surplus at the next regular session of the Budget Committee. We are not prejudging, of course, the right of any Group or any individual delegation to make a statement, but there was a political agreement under items 5 and 6 of the agenda to take this up in the Budget Committee next March. We see that

Group B has requested or suggested that a study on this subject be carried out within the context of the PCT. The Group of Latin American and Caribbean countries feels that this study, or indeed any study that affects the use of the income of the PCT in the context of the overall work of WIPO, should be carried out only after we have had this discussion in the Budget Committee.”

[Annex follows]

ANNEX

SCHEDULE OF FEES
(as in force from January 1, 1999)

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 Swiss francs
(b) if the international application contains more than 30 sheets	650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	150 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 10 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	150 Swiss francs per designation
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

4. The total amount of the fees payable under items 1 and 2(a) is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.
5. All fees payable (where applicable, as reduced under item 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$ 3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[End of Annex and of document]

WIPO



PCT/A/27/4

ORIGINAL: English

DATE: September 29, 1999

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Twenty-Seventh (12th Ordinary) Session
Geneva, September 20 to 29, 1999**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/34/1 Prov.3): 1, 2, 3, 4, 5, 6, 8, 14, 23, 26, 28 and 29.
2. The report on the said items, with the exception of item 14, is contained in the General Report (document A/34/16).
3. The report on item 14 is contained in the present document.
4. Mr. Jorge Amigo Castañeda (Mexico) was elected Chair of the Assembly; Mrs. Maureen Dougan (Canada) and Mr. Sarkis Khantardjian (Armenia) were elected Vice-Chairs.

ITEM 14 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Proposed Amendments of the Schedule of Fees Annexed to the Regulations Under the PCT

5. Discussions were based on document PCT/A/27/1.
6. The Delegation of Cuba supported the proposed amendments of the Schedule of Fees, noting, however, that it was concerned with the impact such reductions could have on funds for development activities and expressing its hope that such funds would not decrease as a result.
7. The Assembly unanimously adopted the amendments of the Schedule of Fees as set out in the Annex to this report and decided that they would enter into force on January 1, 2000.

PCT Automation

8. Discussions were based on document PCT/A/27/2.
9. Introducing the document, the Secretariat announced the distribution of a paper containing a report drawn up by the experts from six Offices who helped the International Bureau in evaluating the five short-listed bids submitted for the purpose of selecting an enterprise or consortium of enterprises that would develop the automated system.
10. The Delegation of the United States of America, applauding WIPO's efforts to bring the PCT system into the electronic age, stated that any electronic filing solution developed in the context of the PCT should, at least, be compatible with electronic filing solutions developed for national filings. The Delegation emphasized that now that WIPO had begun deployment of information technology resources that were approved in the 1998-1999 Program and Budget and would consider further deployments in future budgets, it was critical that these resources be utilized to the maximum advantage of the users of WIPO services. The Delegation further noted that it supported WIPO's business process reengineering efforts and the coordination of WIPO's numerous information technology initiatives through the development of the Strategic Information Technology Plan and expressed its belief that the effective use of information technology would enable WIPO to continue to meet the growing demands placed on it by the private sector, while reducing the need for staff growth, increasing efficiency and lowering costs in the future. The Delegation further stated that it lauded WIPO's dedication to the principles of transparency and accountability and that it looked forward to working with the International Bureau in implementing the important automation initiatives in WIPO.
11. The Assembly took note of the progress report on the PCT Automation ("IMPACT") Project contained in paragraphs 1 to 8 of document PCT/A/27/2, took note of the information concerning the modifications to be made to the PCT Administrative Instructions to provide for electronic filing contained in paragraph 9 of document PCT/A/27/2, and approved the proposal concerning the provision of workstations contained in paragraph 10 of document PCT/A/27/2.

Claiming Priority Under the PCT: Proposed Amendments of the Regulations

12. Discussions were based on document PCT/A/27/3.

13. The Secretariat introduced the proposed amendments to PCT Rule 4.10 set out in document PCT/A/27/3 as well as proposed new paragraph (d) of Rule 4.10, presented during the discussion in connection with the matter raised by the Delegation of Japan (see next paragraph). It also drew attention to paragraph 6 of document PCT/A/27/3, which indicated that a PCT Contracting State that was not a WTO Member would not be obliged to recognize the effects of a claim to priority based on an earlier filing in a WTO Member which was not party to the Paris Convention. Information as to any effect given by such PCT Contracting States to such claims would be collected and published by the International Bureau. Moreover, any such Contracting State, and any Contracting State to which new paragraph (d) of Rule 4.10 applied, having any special requirements in relation to claims to priority based on earlier filings in countries not party to the Paris Convention would be invited to inform the International Bureau of those requirements so that the latter could publish them.

14. The Delegation of Japan indicated that, even though it agreed with the proposal in principle, the proposal was not compatible with the Japanese national law and a transitional provision was needed, as far as Japan was concerned, until that law was amended; the proposed new paragraph (d) of Rule 4.10 was acceptable to the Delegation.

15. The Delegation of Cuba expressed its agreement on the substance of the proposal, noting, however, that it would have been preferable to deal with this matter by a revision of Article 8 of the Treaty itself. However, in view of the difficulties involved in a revision procedure, it could accept the proposed amendments of Rule 4.10.

16. The Delegation of the Netherlands stated that it shared the position of the Delegation of Cuba. It added that not only Article 8, but the Treaty as a whole might need revision so as to bring it up to modern standards.

17. The Assembly unanimously adopted the amendments of Rule 4.10 as set out in the Annex to this report and decided that they would enter into force on January 1, 2000.

[Annex follows]

ANNEX

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
TEXT OF THE AMENDED RULE AND SCHEDULE OF FEES
(as in force from January 1, 2000)

4.10 *Priority Claim*

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

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

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;

(iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

(b) In addition to any indication required under paragraph (a)(iv) or (v):

(i) where the earlier application is a regional application or an international application, the priority claim may indicate one or more countries party to the Paris Convention for the Protection of Industrial Property for which that earlier application was filed;

(ii) where the earlier application is a regional application and at least one of the countries party to the regional patent treaty is neither party to the Paris Convention for the Protection of Industrial Property nor a Member of the World Trade Organization, the priority claim shall indicate at least one country party to that Convention or one Member of that Organization for which that earlier application was filed.

(c) For the purposes of paragraphs (a) and (b), Article 2(vi) shall not apply.

(d) If, on September 29, 1999, paragraphs (a) and (b) as amended with effect from January 1, 2000, are not compatible with the national law applied by a designated Office, those paragraphs as in force until December 31, 1999, shall continue to apply after that date in respect of that designated Office for as long as the said paragraphs as amended continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by October 31, 1999. The information received shall be promptly published by the International Bureau in the Gazette.

SCHEDULE OF FEES
(as in force from January 1, 2000)

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 Swiss francs
(b) if the international application contains more than 30 sheets	650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	140 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 8 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	140 Swiss francs per designation
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

4. The total amount of the fees payable under items 1 and 2(a) is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.
5. All fees payable (where applicable, as reduced under item 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[End of Annex and of document]

WIPO



PCT/A/28/5

ORIGINAL: English

DATE: March 17, 2000

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Twenty-Eighth (16th Extraordinary) Session
Geneva, March 13 to 17, 2000**

REPORT

adopted by the Assembly

INTRODUCTION

1. The twenty-eighth (16th extraordinary) session of the PCT Union Assembly was held in Geneva from March 13 to 17, 2000¹.

2. The following 90 States, members of the PCT Union, were represented at the session: Algeria, Armenia, Australia, Austria, Azerbaijan, Belarus, Belgium, Benin, Bosnia and Herzegovina, Brazil, Bulgaria, Burkina Faso, Cameroon, Canada, Central African Republic, Chad, China, Congo, Costa Rica, Côte d'Ivoire, Croatia, Cuba, Czech Republic, Democratic People's Republic of Korea, Denmark, Estonia, Finland, France, Gabon, Gambia, Georgia,

¹ This and other documents for the Assembly's session are available on WIPO's Internet site at http://www.wipo.int/eng/document/govbody/wo_pct/index_28.htm.

Germany, Ghana, Guinea, Hungary, India, Indonesia, Ireland, Israel, Italy, Japan, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lesotho, Liberia, Lithuania, Madagascar, Malawi, Mali, Mauritania, Mexico, Mongolia, Morocco, Mozambique, Netherlands, New Zealand, Niger, Norway, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Sierra Leone, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sudan, Swaziland, Sweden, Switzerland, Tajikistan, The Former Yugoslav Republic of Macedonia, Togo, Trinidad and Tobago, Turkey, Turkmenistan, Uganda, Ukraine, United Kingdom, United Republic of Tanzania, United States of America, Uzbekistan, Viet Nam, Zimbabwe.

3. The following seven States, members of the International Union for the Protection of Industrial Property (Paris Union), participated in the session as observers: Argentina, Guatemala, Haiti, Jamaica, Mauritius, Panama, Philippines.

4. The following four intergovernmental organizations were represented by observers: Eurasian Patent Organization (EAPO), European Patent Organisation (EPO), African Regional Industrial Property Organization (ARIPO), Organization of African Unity (OAU).

5. The following three international non-governmental organizations were represented by observers: International Association for the Protection of Industrial Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), Institute of Professional Representatives before the European Patent Office (EPI).

6. The list of participants is contained in Annex I to this report.

OPENING OF THE SESSION

7. The session was opened by Mr. Jorge Amigo Castañeda (Mexico), Chair of the Assembly. Mr. François Curchod, Deputy Director General of WIPO, conveyed the welcome of the Director General.

ADOPTION OF THE AGENDA

8. The Assembly adopted the agenda appearing in document PCT/A/28/1 Rev.

ELECTION OF AN ACTING CHAIR

9. The Chair informed the Assembly that he could not attend the whole session. The Assembly unanimously elected Mr. Alan Michael Troicuk (Canada) as Acting Chair for the remainder of the session.

AMENDMENTS OF THE PCT REGULATIONS RELATING TO THE DRAFT PATENT LAW TREATY

10. The Assembly considered proposed amendments of the Regulations under the PCT² relating to the draft Patent Law Treaty (PLT)³ contained in documents PCT/A/28/2 (prepared by the International Bureau), PCT/A/28/2 Add.1 (proposal by the Netherlands) and PCT/A/28/2 Add.2 (proposal by Germany).

11. The Delegation of the United States of America suggested the deletion of proposed Rule 51*bis*.1(a)(vi) as contained in document PCT/A/28/2, in light of having undertaken a review of the controlling statutory provision. That review revealed that the controlling statutory provision only imposed an obligation on a contractor-applicant to include in the application a statement as referred to in proposed item (vi); it did not provide any authority for the United States Patent and Trademark Office to require such statement.

12. The Assembly unanimously adopted the amendments of the Regulations set out in Annex II to this report and decided that the amendments would enter into force on March 1, 2001.

13. The Assembly noted the following consequences in connection with the applicability of the amendments:

(i) the Rules as amended will apply, as explained in and subject to the following items, to international applications irrespective of when they are filed (that is, whether they are filed before, on or after March 1, 2001);

(ii) the provisions providing for certain declarations under new Rule 4.17, and the related provisions of new or amended Rules 4.1(c)(iii), 4.5(e), 4.6(a), 4.7(b), 4.18, 26*ter*, 47.1(a-*ter*), 48.2(a)(x) and (b)(iv), and 51*bis*.2, will not apply, subject to items (iii) and (iv), to international applications filed before March 1, 2001;

(iii) new Rule 26*ter* will apply to international applications filed before March 1, 2001, to the extent that it will permit the applicant to add a declaration to the request, and new Rule 4.17 and the related provisions mentioned in item (ii) will apply in respect of such an added declaration;

(iv) amended Rule 51*bis*.2 will apply to international applications filed before March 1, 2001, which enter the national phase on or after March 1, 2001, in respect of which indications concerning the inventor are included in the request or a declaration is added to the request under Rule 26*ter* or submitted directly to the designated Office.

² References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as amended or added, as the case may be. Any reference to “national” law, “national” applications, “national” Offices, etc., is to be construed as also including a reference to regional law, regional applications, regional Offices, etc.

³ References to “draft PLT Articles” and “draft PLT Rules” are, respectively, to those of the draft Patent Law Treaty (PLT) contained in the basic proposal for submission to the PLT Diplomatic Conference (document PT/DC/3) and of the draft Regulations under the Patent Law Treaty (“draft PLT Regulations”) contained in the basic proposal (document PT/DC/4).

PROPOSED MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS RELATING TO THE DRAFT PLT

14. The session of the Assembly provided an opportunity for consultation with Offices pursuant to Rule 89.2(b) regarding proposed modifications of the Administrative Instructions in connection with the amendments of the Regulations (see document PCT/A/28/2, Annex II), in particular, relating to declarations containing standardized wording which may be contained in the request pursuant to amended Rule 4.17.

15. Comments made by Offices and user representatives were noted by the International Bureau and would be taken into account in preparing revised Administrative Instructions with a view to possible further consultation at a later date.

DEVELOPMENTS REGARDING THE DRAFT PLT; INTERFACE BETWEEN THE DRAFT PLT AND THE PCT

16. The International Bureau noted that the documents for the Diplomatic Conference for the Adoption of the Patent Law Treaty were mailed in November 1999. While the International Bureau had received informal comments from several delegations, no formal proposals for the Diplomatic Conference had yet been submitted.

17. With regard to the interface between the draft PLT and the PCT, the International Bureau indicated that the following issues needed to be discussed at the Diplomatic Conference:

(i) whether existing and future transitional reservations made under the PCT Regulations should have effect under the PLT;

(ii) the harmonization of the use of certain terms in the draft PLT and in the PCT, in particular, the terms “form or contents,” “form,” “Form,” “format” and “means”;

(iii) the international law implications of the automatic incorporation into the PLT of future modifications of the PCT, the Regulations and the Administrative Instructions, in particular in respect of non-PCT Contracting States.

18. The International Bureau indicated that it intended to submit to the Diplomatic Conference a document reporting the results of the PCT Assembly and possibly reflecting on the above-mentioned issues.

OFFICE OF THE PCT: ACTIVITIES IN 1999

19. The International Bureau presented a summary of the wide range of PCT-related activities in 1999. The presentation highlighted the growth in the number of filings of international applications, which reached 74,023 in 1999, and the increasing use of the PCT-EASY software, introduced in January 1999, which enabled simplified preparation of the PCT request form, including a substantial number of validation checks. The presentation included an overview of the functions of the Office of the PCT, including operations,

administration, training, legal development, development cooperation and information dissemination.

PCT AUTOMATION

20. The International Bureau, reporting on the progress of the PCT automation (IMPACT) project, outlined the main objectives of the IMPACT Project, the work undertaken so far, the present state of the project, and future steps to be taken (see document PCT/A/28/4).

21. The International Bureau explained that the WIPONET Project would provide Offices with the appropriate mechanisms enabling the secure exchange of data between Offices and the International Bureau.

22. The Assembly:

(i) noted the International Bureau's progress report on the IMPACT Project contained in document PCT/A/28/4; and

(ii) noted that the IMPACT Project plan was being further elaborated by the IMPACT Project team, as indicated in document PCT/A/28/4, paragraph 9; that plan would be available in approximately one month and would be included in the progress report on the IMPACT Project to be submitted to the September 2000 session of the PCT Assembly; the component of that plan relating to PCT electronic filing would thus supersede the present SCIT Action Plan for PCT On-Line Filing⁴ (see paragraph 24, below).

IMPLEMENTATION OF ELECTRONIC FILING AND PROCESSING OF INTERNATIONAL APPLICATIONS

General discussion

23. Discussions were based on document PCT/A/28/3, taking into account the documents reproduced in document PCT/A/28/3 Add.1 relating to the development by the WIPO Standing Committee on Information Technologies (SCIT) of the necessary technical standard⁴ to enable implementation of electronic filing and processing of international applications, and the comments of delegations and user representatives reproduced in documents PCT/A/28/3 Add.2 to Add.5.

24. The Assembly agreed that the proposed new Part 7 of the Administrative Instructions (referred to in this document as "Part 7"; see document PCT/A/28/3, Annex II), and draft

⁴ The current version of the draft standard, submitted to the SCIT Task Force by the Trilateral Offices (the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office), appears as "Annex F (version 3.1)" (referred to in this document as "draft Annex F") in a SCIT Program Project File, document SCIT/P 8/99 Rev.1, Annex 5, and is reproduced as an attachment in document PCT/A/28/3 Add.1. The Action Plan for PCT On-Line Filing adopted by the SCIT Plenary appears in document SCIT/P 8/99 Rev.1, Annex 6, and is also reproduced as an attachment to document PCT/A/28/3 Add.1.

Annex F needed extensive redrafting, that consultations on the redrafted versions were necessary, and that the target dates included in the present SCIT Action Plan needed to be reviewed accordingly. In particular, promulgation of Administrative Instructions in April 2000 in accordance with the present SCIT Action Plan was not possible.

25. Several delegations emphasized that the legal framework for electronic filing should have a clear relationship to the provisions of the Treaty, in particular, Articles 10, 11, 14 and 27, and should also clearly implement the main internationally accepted legal requirements of global electronic commerce, that is, authenticity, integrity, confidentiality and non-repudiation.

26. Several delegations noted that the proposed three-level structure of an electronic filing system, as outlined in paragraph 9 of document PCT/A/28/3, was not currently reflected in draft Part 7 or draft Annex F. The Assembly agreed that, for the purposes of the applicable national law, all designated Offices should accept an international application filed in compliance with a single "recommended basic level" without imposing further requirements as to the form or contents of the application.

27. The Assembly agreed that provision needed to be made in the legal and procedural framework for the needs of those designated Offices which accepted documents on paper only (including, but not limited to, Offices of developing countries), and in particular for the furnishing to such Offices of paper copies of documents which existed only in electronic form during the international phase.

28. The Assembly agreed that legal principles should appear as part of the provisions establishing the necessary legal framework in Part 7 rather than in the technical standard contained in Annex F. In particular, the principles of authenticity, integrity, confidentiality and non-repudiation should be primarily addressed in the legal framework rather than in the technical standard.

29. The Delegation of the United States of America, with which several other delegations agreed, expressed the view that some parts of the Administrative Instructions relating to electronic filing should be transferred to the Regulations. In particular, the Delegation of the United States of America proposed that the subject matter of draft Section 713 should be addressed in the Regulations. In response, the International Bureau said that this was indeed the intention but that such a transfer should be made after some experience had been gained in the implementation of the electronic filing system.

30. In connection with draft Section 713, the Delegations of France, Morocco and the United Kingdom, and the representative of the EPO, questioned whether the PCT was the appropriate context to attempt to establish the admissibility of electronic records as evidence in national court proceedings.

31. The Assembly noted that draft PLT Rule 8(2) would have the effect that any Office which accepted electronic filing of international applications under the PCT would also have to accept electronic filing of national applications, applying the same requirements. The International Bureau further noted that the provisions in the draft PLT concerning electronic filing contained the maximum which Offices could require, but that they would be free to accept communications desired by applicants and requiring a different level of technical capability.

32. The Assembly noted that one of the objectives of the IMPACT project was the creation of PCT software for use in electronic filing of international applications. The Assembly agreed that such software would need to be widely accessible as an open standard to PCT applicants in all PCT Contracting States, that it would need both to meet the legal requirements of the PCT (including Part 7 and Annex F) and to be consistent with global standards of electronic commerce, and that applicants using such software could not be asked to comply with additional requirements (relating to the fact that the international application was filed electronically) in the national phase.

Further work

33. The International Bureau indicated that the task of defining the requirements for and ultimately producing the PCT electronic filing software would be undertaken in consultation with the PCT Contracting States, the Trilateral Offices, the SCIT Task Force and user representatives. The requirements of potential users of such software (both Offices and applicants) would be identified and documented at the outset in order to ensure that they were addressed by adopting appropriate technical solutions.

34. The Assembly agreed that the redraft of Part 7 and Annex F should take into account the following principles:

(a) the need to proceed with electronic filing of international applications for those receiving Offices which are already in a position to accept such filing, while encouraging other receiving Offices and, where necessary, potential applicants, by providing clear and workable Administrative Instructions and technical standards including appropriate safeguards;

(b) accessibility to all applicants having the necessary equipment and access to a receiving Office that is in a position to accept electronically filed international applications;

(c) acceptability to all designated Offices without the need for applicants to meet further requirements in the national phase arising out of the electronic nature of international applications;

(d) consistency with the general legal principles both of the PCT, particularly as set out in Articles 11, 14 and 27, and of global electronic commerce, including authenticity, integrity, confidentiality and non-repudiation;

(e) use of public key infrastructure (PKI), it being understood that implementation of any future technology achieving the same (or better) results than PKI could be introduced into Annex F when available and feasible;

(f) consistency, to the maximum extent possible, with other WIPO standards;

(g) loss of the international filing date should, to the extent possible, be the last resort penalty in case of a problem arising out of the electronic nature of an international application;

(h) clarification of the relationship and links between Part 7 (the legal framework) and Annex F (the technical solutions).

35. It was agreed that the International Bureau would include in its redraft the relevant modifications of Part 7 and of Annex F necessary to implement filing systems other than on-line filing, for example, filing with other media such as CD-ROM, DVD and diskette.

36. The International Bureau stated that it envisaged the following procedural steps could be taken following the present consultation:

(a) the IMPACT project team would coordinate and provide leadership in the redrafting of Annex F in consultation with interested Offices, in particular, drawing on the expertise of the Trilateral Offices, as they had delivered the first draft of Annex F. The redrafting exercise would take into account comments made by the SCIT Task Force, and the IMPACT project team would continue to coordinate its work with the Office of the PCT; at the same time, the Office of the PCT would redraft Part 7, coordinating its work with the redrafting of Annex F;

(b) once redrafted, Annex F would be the subject of consultation with all PCT Contracting States and Authorities, with the members of the SCIT Task Force and with user representatives; redrafted Part 7 would also be the subject of consultation with all PCT Contracting States and Authorities and with user representatives;

(c) when there was agreement on both Part 7 and Annex F, they would both be promulgated; Annex F would then become the PCT standard and would be referred to SCIT for adaptation and adoption as a WIPO Standard; the promulgation of Part 7 would mean that Rule 89*bis* would enter into force, thus legally enabling the electronic filing of international applications under the PCT with those receiving Offices which had notified their acceptance of such filings.

37. The Assembly agreed that a redraft of Part 7 and Annex F should be made available by the International Bureau by May 10, 2000, on the PCT electronic forum and the SCIT area of WIPO's website and would be discussed at a broadly-constituted informal consultation meeting to be convened during the same week as the next SCIT meeting, scheduled to take place in Geneva from July 10 to 14, 2000. Participants would include PCT Contracting States and Authorities, observer States, other observers and user representatives. Delegations at that meeting should comprise, where possible, both legal and information technology specialists, including the members of the SCIT Task Force. The results of the consultation meeting would be reported to the September 2000 session of the PCT Assembly.

PROPOSED MODIFICATIONS OF THE ADMINISTRATIVE INSTRUCTIONS RELATING TO PCT ELECTRONIC FILING

38. The session of the Assembly provided an opportunity for consultation pursuant to Rule 89.2(b) regarding proposed new Part 7 (see document PCT/A/28/3, Annex II and the comments of Offices and user representatives set out in documents PCT/A/28/3 Add.2 to Add.5). Those comments and other comments made on all draft Sections during the consultation will be taken into account by the International Bureau in preparing revised Administrative Instructions.

39. Certain conclusions reached during the consultation and certain comments of delegations relating to general matters are noted in the following paragraphs.

Draft Section 701

40. It was noted, in relation to Section 701(a), that the words “original” and “authentic” should be avoided and that descriptive words should be used, along the lines of the proposal by the Delegation of Japan or the proposal by the Delegation of the United States of America (see document PCT/A/28/3 Add.2, Annexes III (JP) and VI (US), respectively).

41. The International Bureau indicated its intention that the next draft of Part 7 would include a Section containing definitions of relevant terms. The representative of the EPO pointed to the need for definitions of “record copy” and “true copy” in the context of electronic filing.

Draft Section 702

42. The Delegation of Australia underlined the importance for applicants of being accorded an international filing date for electronically filed international applications, even in cases where the application was filed in a format which was not accepted by the receiving Office but where the Office could read the text of the application.

43. It was noted that electronically filed international applications which complied with the requirements of the Administrative Instructions would have to be accepted by receiving Offices accepting electronic filing and that the legal effect of such applications would have to be recognized by all designated Offices.

44. The Delegation of the United States of America suggested that draft Section 702(b)(ii) should include a reference to methods of on-line payment which would be acceptable to the receiving Office.

45. The Delegation of Japan proposed that Section 702(b) cover the type of electronic signature acceptable to the receiving Office and that the format described in Section 702(a) should include not only the document format but also the electronic envelope format (see document PCT/28/3 Add.1, Annex 5, pages 31 to 34). The Delegation proposed that, in relation to Section 702(a), where the international application was not in a format acceptable to the receiving Office, the receiving Office should not be obliged to receive or process the application. In relation to Section 702(f), the Delegation requested that the scope of the phrase “in a particular case” be made clear.

Draft Section 703

46. It was agreed that the Section should not imply that the document whose receipt was acknowledged was being treated as an international application or that it had received an international filing date.

Draft Section 704

47. The Delegation of Australia expressed concern over the possible loss of an international filing date in a case where an electronically filed international application was considered as not “fully and successfully received” by the receiving Office.

48. In response to the question raised by several delegations as to how Offices were to deal with the question of multiple time zones, it was concluded that further study of the question was necessary.

Draft Section 705

49. Although it was agreed that loss of an international filing date should only be a measure of last resort and that the circumstances in which this provision would apply would need to be clearly defined in the Administrative Instructions, it was understood that, in principle, applications which were found to be illegible should not be accorded an international filing date and that it was important to strike an appropriate balance between the rights of applicants to obtain and retain their international filing date with the burden on Offices to cope with infected files.

50. The Delegation of Kenya raised a question as to the fate of international applications filed in electronic form on diskette which were infected by a virus where the virus infection was only detected at a later stage, noting particularly that receiving Offices of developing countries may not be in a position to detect all viruses. The Delegation stressed the need for a safeguard such as the filing of the application on paper in parallel. In response, the International Bureau stated that modifications to draft Part 7 would be made to attempt to deal with this difficulty. The International Bureau also confirmed that, via the WIPONET project, it would centrally distribute virus checking software to all Offices receiving the WIPONET hardware and software package and a central virus scanning system would be put in place to ensure all filings were virus free prior to processing. Manuals containing security guidelines would be distributed to all Offices which were users of the WIPONET system.

51. The Delegation of China raised the question whether all international applications in electronic form could not be filed with a single receiving Office, namely the International Bureau as receiving Office, and in this way avoid many of the problems under discussion.

52. The Delegation of Australia, supported by the Delegation of the Netherlands, suggested that Section 705(b) should be redrafted in such a way that the international filing date would be accorded, but that the Office would have the possibility to require an uninfected copy of the file (or a paper copy).

Draft Section 706

53. The Delegation of the United States of America stated that use of the ticket mechanism in the context of PCT electronic filing would be reviewed at the next meeting of the Trilateral Electronic Filing Working Group.

54. The Delegations of Australia, the United Kingdom, the Netherlands, France and Germany expressed doubts concerning whether the ticket mechanism, as explained in document PCT/A/28/3 Add.1, satisfied the requirements of Article 11 or their respective national or regional laws for according a filing date. In this regard, the Delegation of the Netherlands expressed the view that the date of receipt of the ticket could not be the date on which the Office was in a position to determine whether the relevant legal requirements for according an international filing date were satisfied, and that the ticket should more correctly be seen as a declaration of intent to file.

55. While noting the considerable attractiveness of the ticket mechanism, the Delegation of Australia expressed additional concern about implementing an electronic filing system which relied on proprietary technology, such as the ticket mechanism, for the submission of international applications and related documents. The International Bureau noted that to be consistent with the general principles of software development it was advisable to avoid the use of proprietary technology.

56. In response to a question from the Delegation of France as to the advantages of the ticket mechanism, the Delegation of Japan explained that the ticket mechanism would provide protection to an applicant where a transmission was interrupted or where, because of the length of the international application, it took several hours to transmit the full application electronically and, as a result, the date changed between the transmission of the digest and the receipt of the full application. The Delegation of Japan indicated that the ticket mechanism could indeed be used for the transmission of larger files over the Internet, and that, if the ticket mechanism was not implemented, an alternative mechanism to accomplish the same objectives should be offered for the purpose of safeguarding international filing dates.

57. The representative of the EPO suggested a compromise position in which the ticket mechanism would be technically implemented but without having legal effect so far as the according of an international filing date was concerned. Several delegations expressed support for the practical benefits which could be achieved through the use of the ticket mechanism, and indicated that such a mechanism could be implemented so as to enable applicants to seek relief in cases where time limits (subsequent to the international filing date of the international application) had not been complied with, similarly to the operations of existing Rule 82.

58. It was agreed that the legal and technical aspects of the possible implementation of the ticket mechanism would be further reviewed.

Draft Section 709

59. Several delegations stated that a mere reference to the technical standard as contained in Annex F was not sufficient to clarify the legal consequences of the use of certain types of electronic signatures by applicants or whether and to what extent applicants would have a choice between the various types of electronic signatures referred to in draft Annex F. The representative of the EPO suggested that the draft Section should list the types of electronic signatures deemed acceptable and that the wording in draft Section 701(b) referring to Rule 51*bis* should be moved into this provision, since that wording was originally intended to resolve signature-related problems. The Delegation of France stated that the Administrative Instructions should indicate which type of signature might be needed for particular situations.

60. In response to a question from the Delegation of the United Kingdom, the Delegation of the United States of America stated that there was a need to provide for the possibility of using signature standards other than those contained in the PKI system, in order to make electronic filing accessible to as many users as possible. The Delegation further indicated that, if the possibility of simple electronic signatures was offered to applicants, designated Offices should have the right to request further proof concerning the authenticity of international applications. On the same point, the Delegation of the Netherlands suggested that the question of the right to ask for further proof should be dealt with in the context of Rule 51*bis* rather than in the Administrative Instructions.

61. The International Bureau expressed the hope that Contracting States would agree on a basic level of electronic signature requirements which would be acceptable to Offices at all stages in the life of the international application.

Draft Section 711

62. The Delegation of the United States of America stated that the current draft did not provide a sound basis for the presumption of integrity, and that further elaboration was needed. In response, the Delegation of Australia indicated a preference for using more liberal wording, along the lines of the United Nations Commission on International Trade Law (UNCITRAL) Model Law on Electronic Commerce, so that applicant's rights were not prejudiced if an Office failed to comply with the detailed record keeping requirements contained in draft Annex F.

Draft Section 713

63. The representative of the EPO suggested that the Section should be redrafted to emphasize the requirement that designated Offices must give legal effect in the national phase to electronic records, and to papers produced on the basis of electronic records.

Public Key Infrastructure (PKI)

64. Several delegations stated that use of PKI was seen as necessary for PCT electronic filing so far as their respective Offices were concerned as receiving Offices and designated Offices, and that a coordinated PKI policy within the context of the PCT needed to be established.

65. Several delegations stated that, in relation to the level of authentication of identity to be required for a PKI certificate, they were not concerned with the actual identity of the applicant, but rather wanted to ensure that in subsequent processing (for example, in the case of withdrawals), the person taking the subsequent action was the same person who filed the application. As a result, those delegations proposed that a PKI should incorporate a standard of "relative identity" rather than "absolute identity." There was a general expression of interest in the use of PKI based on a minimum level of authentication of identity (for example, use of low-level digital certificates), although this needed to be balanced against the need for levels of authentication to be meaningful and useful to designated Offices.

66. The Delegation of France questioned whether a PCT electronic filing system based on the use of PKI was the only system which could fully address the four main information security requirements (integrity, confidentiality, authentication, non-repudiation) and whether the PCT electronic filing system should be framed in a technology-neutral manner so as to allow for the development of further technologies. The Delegation also wondered whether it would not be desirable for Certification Authorities to be third parties so as to comply with the main internationally accepted legal requirements of electronic commerce and, in particular, with the requirements relating to authenticity and integrity.

67. The Delegation of the United States of America strongly urged the International Bureau to become a Certification Authority for PCT applicants. In response, the International Bureau stated that its participation in PKI, for example, as a Certification Authority, was currently under consideration and that it was hoped that a proposal would be developed before the Assembly's next session in September 2000.

68. It was agreed that the International Bureau should begin work on a uniform PKI policy. The International Bureau explained that it would begin this process by looking first at the requirements of PCT users and Contracting States.

Electronic records management (ERM)

69. The Delegation of the United States of America proposed a new Rule 93.5 (see document PCT/A/28/3 Add. 2, Annex VI (US), page 2), providing that national Offices which accepted or maintained electronic records would certify that those records were maintained in accordance with the requirements of Annex F, and would provide copies of such certification for the purposes of evidentiary proceedings. The Delegations of the United Kingdom and France reserved their position on that proposal; several delegations indicated their preference for third party certification or audits of compliance with the applicable ERM requirements.

70. Several delegations proposed that guidelines on ERM be developed rather than requiring compliance with the content of Annex F.

71. The Delegation of Australia proposed returning to the wording of the UNCITRAL Model Law in relation to the effects of the keeping of electronic records, and that any certification issued for the purposes of evidentiary proceedings in relation to those records should correspondingly be only to the effect that the electronic records had been kept in accordance with the principles set out in the UNCITRAL Model Law and not with the requirements in Annex F. However, the Delegation did support a separate document on electronic records management as guidelines for Offices on how to best meet the UNCITRAL principles.

National security

72. It was noted, in relation to a comment by the Delegation of France, that Article 27(8) already provided a basis for any Contracting State to apply measures deemed necessary for the preservation of its national security. It was agreed that clarification should be made, where necessary, of matters regarding the preservation of national security.

73. The Assembly unanimously adopted this report on March 17, 2000.

[Annex I follows]

ANNEXE I/ANNEX I

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

I. ÉTATS MEMBRES/MEMBER STATES

(dans l'ordre alphabétique des noms français des États/
in the alphabetical order of the names in French of the States)

AFRIQUE DU SUD/SOUTH AFRICA

Cecilia 'Maelia PETLANE (Mrs.), Assistant Director, South African Patents and Trademarks Office, Pretoria

ALGÉRIE/ALGERIA

Amor BOUHNİK, directeur général de l'Institut algérien de la propriété industrielle, Alger

ALLEMAGNE/GERMANY

Carolin HÜBENETT (Mrs.), Head, Section of International Industrial Property Law, German Patent and Trade Mark Office, Munich

ARMÉNIE/ARMENIA

Sarkis KHANTARDJIAN, President, Armenian Patent Office, Yerevan

AUSTRALIE/AUSTRALIA

David HERALD, Deputy Commissioner, IP Australia, Canberra

AUTRICHE/AUSTRIA

Peter HOFBAUER, Technical Department 16, Presidential Department II, Austrian Patent Office, Vienna

AZERBAÏDJAN/AZERBAIJAN

Habib SULEYMANOV, Main Expert, State Register Department, State Committee for Science and Engineering, Baku

BÉLARUS/BELARUS

Alexander CHENADO, Chief Specialist, Preliminary Examination Division, The Belarus Patent Office, Minsk

BELGIQUE/BELGIUM

Stefan DRISQUE, ingénieur, chef de la Section production et comptabilité à l'Office de la propriété industrielle, Ministère des affaires économiques, Bruxelles

BÉNIN/BENIN

Lola Juliette AYITE DOUMATEY (Mme), directrice du Centre national de la propriété industrielle (CENAPI), Ministère de l'industrie et des PME, Cotonou

BOSNIE-HERZÉGOVINE/BOSNIA AND HERZEGOVINA

Ismet GALIJAŠEVIĆ, Director, Institute for Standardization, Metrology and Patents, Sarajevo

Irma ISAK-GUDELJ (Mrs.), Patent Examiner, PCT Division, Institute for Standardization, Metrology and Patents, Sarajevo

BRÉSIL/BRAZIL

Carlos Pazos RODRIGUEZ, Counsellor, Patent Directorate, National Institute of Industrial Property (INPI), Rio de Janeiro

Francisco CANNABRAVA, Second Secretary, Permanent Mission, Geneva

BULGARIE/BULGARIA

Margarita Ivanova NEDIALKOVA-METCHEVA (Mrs.), Vice-President, Bulgarian Patent Office, Sofia

BURKINA FASO

Adama TRAORE, directeur général du développement industriel, Ministère du commerce, de l'industrie et de l'artisanat, Ouagadougou

CAMEROUN/CAMEROON

AGBOR-AMBANG ANTEM AKO, chef du Service des brevets et des marques, Ministère du développement industriel et commercial, Yaoundé

Martin Lacdagné ZOUA, deuxième conseiller, Mission permanente, Genève

CANADA

Alan Michael TROICUK, Counsel to the Canadian Intellectual Property Office, Department of Justice, Hull, Québec

J. Scott VASUDEV, Project Officer, Patent Branch, Canadian Intellectual Property Office (CIPO), Department of Industry, Hull, Québec

CHINE/CHINA

YIN Xintian, Director General, Legal Affairs Department, State Intellectual Property Office (SIPO), Beijing

CONGO

Justin BIABAROH-IBORO, Ministre-Conseiller, Mission permanente, Genève

COSTA RICA

Luis POLINARIS, Viceministro de Justicia y Gracia, Ministerio de Justicia y Gracia, San José

Estaban PENROD, Ministro Consejero, Misión Permanente, Ginebra

CÔTE D'IVOIRE

Nagolo SORO, directeur de l'Office ivoirien de la propriété industrielle (OIPI), Ministère du développement industriel et des PME, Abidjan

Bosson-Désiré ASSAMOI, Conseiller, Mission permanente, Genève

CROATIE/CROATIA

Tatjana SUČIĆ (Mrs.), Head, PCT Department, State Intellectual Property Office, Zagreb

Gordana VUKOVIĆ (Mrs.), Head, Patent Formal Examination Department, State Intellectual Property Office, Zagreb

CUBA

Rolando Miguel HERNÁNDEZ VIGAUD, Director General Adjunto, Oficina Cubana de la Propiedad Industrial (OCPI), La Habana

DANEMARK/DENMARK

Anne Rejnhold JØRGENSEN (Mrs.), Director, Industrial Property Law Division, Danish Patent and Trademark Office, Taastrup

Catharina L.D. WINTERBERG (Miss), Legal Adviser, Danish Patent and Trademark Office, Taastrup

ESPAGNE/SPAIN

Miguel HIDALGO LLAMAS, Jefe, Area Jurídico Administrativa, Departamento de Patentes e Información Tecnológica, Oficina Española de Patentes y Marcas, Madrid

ESTONIE/ESTONIA

Toomas LUMI, Deputy Director General, The Estonian Patent Office, Tallinn

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

Lois E. BOLAND (Mrs.), Attorney Advisor, Office of Legislative and International Affairs, Patent and Trademark Office, Department of Commerce, Washington, D.C.

Stephen G. KUNIN, Deputy Assistant Commissioner, Patent and Trademark Office, Department of Commerce, Washington, D.C.

Charles PEARSON, Patent Legal Administrator, Patent and Trademark Office, Department of Commerce, Washington, D.C.

David R. NICHOLSON, Representative, Office of U.S. Trade Representative, Geneva

EX-RÉPUBLIQUE YOUGOSLAVE DE MACÉDOINE/THE FORMER YUGOSLAV
REPUBLIC OF MACEDONIA

Liljana VARGA (Mrs.), Assistant Director, Industrial Property Protection Office, Skopje

FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

Guennadi NEGOULIAEV, Director, Department of International Relations, Russian Agency for Patents and Trademarks (ROSPATENT), Moscow

Valery JERMAKYAN, First Deputy Director on Examination, Federal Institute of Industrial Property, Russian Agency for Patents and Trademarks (ROSPATENT), Moscow

FINLANDE/FINLAND

Maarit LÖYTÖMÄKI (Mrs.), Deputy Director, National Board of Patents and Registration, Helsinki

Marjo AALTO-SETÄLÄ (Ms.), Coordinator of International Affairs, National Board of Patents and Registration, Helsinki

FRANCE

Jacques VERONE, chef du Bureau OEB/PCT au Département des brevets de l'Institut national de la propriété industrielle (INPI), Paris

Jean-François LESPRIT, chargé de mission à la Direction générale de l'Institut national de la propriété industrielle (INPI), Paris

Camille-Rémy BOGLIOLO, chargé de mission au Service du droit international et communautaire de l'Institut national de la propriété industrielle (INPI), Paris

Michèle WEIL-GUTHMANN (Mme), conseiller (Affaires juridiques), Mission permanente, Genève

GABON

Malem TIDZANI, directeur général du développement industriel, Ministère du commerce, du tourisme, du développement industriel et de l'artisanat, Libreville

Patrick Florentin MALEKOU, conseiller, Mission permanente, Genève

GAMBIE/GAMBIA

Hagar Fola ALLEN (Mrs.), Registrar General, Department of State for Justice and Attorney General's Chambers, Banjul

GÉORGIE/GEORGIA

David DZAMUKASHVILI, Deputy Director General, National Intellectual Property Center, Tbilisi

Noshrevan MEKVABISHVILI, Deputy Director General, National Intellectual Property Center, Tbilisi

GHANA

Jemima Mamaa OWARE (Mrs.), Principal State Attorney, Registrar-General's Department, Ministry of Justice, Accra

GUINÉE/GUINEA

Mamadou Billo BAH, chef de bureau au Service national de la propriété industrielle, Ministère du commerce, de l'industrie et des P.M.E., Conakry

Aminata KOUROUMA (Mlle), premier secrétaire (Affaires économiques et commerciales), Mission permanente, Genève

HONGRIE/HUNGARY

László BRETZ, Deputy Head of Department, Hungarian Patent Office, Budapest

Margit SÜMEGHY (Mrs.), Senior Intellectual Property Adviser, Hungarian Patent Office, Budapest

INDE/INDIA

Homai SAHA (Mrs.), Minister (Economic), Permanent Mission, Geneva

INDONÉSIE/INDONESIA

Emawati JUNUS (Mrs.), Director of Patents, Directorate General of Intellectual Property Rights, Jakarta

Iwan WIRANATA-ATMADJA, Counsellor, Permanent Mission, Geneva

Dewi M. KUSUMAASTUTI (Miss), First Secretary, Permanent Mission, Geneva

Umar HADI, Third Secretary, Permanent Mission, Geneva

IRLANDE/IRELAND

Donal McCARTHY, Policy Advisor, Intellectual Property Unit, Department of Enterprise, Trade and Employment, Dublin

ISRAËL/ISRAEL

Michael BART, Head, PCT Division, The Patent Office, Ministry of Justice, Jerusalem

ITALIE/ITALY

Angelo CAPONE, chef de la Division “Brevet européen-PCT” à l’Office italien des brevets et des marques, Ministère de l’industrie, du commerce et de l’artisanat, Rome

JAPON/JAPAN

Takashi SAKURAI, Director, Automation Planning Office, Electronic Data Processing Administration Division, General Administration Department, Japanese Patent Office, Tokyo

Sachiyo YOSHINO (Mrs.), Assistant Director, International Affairs Division, General Administration Department, Japanese Patent Office, Tokyo

Susumu IWASAKI, Deputy Director, International Affairs Division, General Administration Department, Japanese Patent Office, Tokyo

Satoshi MORIYASU, First Secretary, Permanent Mission, Geneva

KAZAKHSTAN

Tatiana VYPRITSKAYA (Mrs.), Head, Department of Inventions and Utility Models Examination, National Patent Office, Almaty

Erik ZHUSSUPOV, Second Secretary, Permanent Mission, Geneva

KENYA

Rose Njeri NDEGWA (Miss), Patent Examination Officer, Kenya Industrial Property Office, Nairobi

Juliet M. GICHERU, First Secretary, Permanent Mission, Geneva

KIRGHIZISTAN/KYRGYZSTAN

Roman O. OMOROV, Director, State Agency of Intellectual Property, Bishkek

LESOTHO

‘Nyalleng M. PII (Mrs.), Registrar-General, Attorney-General’s Chambers, Ministry of Law and Constitutional Affairs, Maseru

LETONIE/LATVIA

Guntis RAMANS, Head, Department of Examination of Inventions, Patent Office of the Republic of Latvia, Rīga

Mara ROZENBLATE (Mrs.), Senior PCT Examiner, Patent Office of the Republic of Latvia, Rīga

LIBÉRIA/LIBERIA

James W. MAYSON, Director of Archives, Patents, Trademarks and Copyright, Ministry of Foreign Affairs, Monrovia

LITUANIE/LITHUANIA

Rimvydas NAUJOKAS, Director, State Patent Bureau of the Republic of Lithuania, Vilnius

MADAGASCAR

Tianamalala Mamy RASAMIMANANA, secrétaire général du Ministère de l’industrialisation et de l’artisanat, président du Conseil d’administration de l’Office malgache de la propriété industrielle, Antananarivo

Rinah RAKOTOMANGA (Mme), conseiller auprès du Premier-Ministre – Ministre des finances, Antananarivo

Olgatte ABDOU (Mme), premier secrétaire, Mission permanente, Genève

MALAWI

Tony Stener CHAPAMBALI, Assistant Deputy Registrar General, Department of the Registrar General, Ministry of Justice, Blantyre

MALI

Mamadou TRAORE, chef de la Division de la propriété industrielle à la Direction nationale des industries, Ministère de l’industrie, du commerce et des transports, Bamako

MAROC/MOROCCO

Ilham BENNANI (Mme), ingénieur, responsable du dossier de la recherche à l'Office marocain de la propriété industrielle, Ministère du commerce et de l'industrie, Casablanca

Fatima EL MAHBOUL (Mme), conseiller, Mission permanente, Genève

MAURITANIE/MAURITANIA

Sidi Mohamed MOUSTAPHA, cadre à la Direction de l'industrie, Ministère des mines et de l'industrie, Nouakchott

MEXIQUE/MEXICO

Jorge AMIGO CASTAÑEDA, Director General, Instituto Mexicano de la Propiedad Industrial (IMPI), México

J. Germán CAVAZOS-TREVIÑO, Director General Adjunto, Instituto Mexicano de la Propiedad Industrial (IMPI), México

MONGOLIE/MONGOLIA

Dashpuntsag GANBOLD, ministre de la justice, Ministère de la justice, Ulaanbaatar

Bazar SANJMYATAV, premier secrétaire, Mission permanente, Genève

MOZAMBIQUE

José Maria do Rosário GUILHERME, Senior Officer, Industrial Property Department, Ministry of Industry, Commerce and Tourism, Maputo

NIGER

Boukar ARY TANIMOUNE, directeur des affaires juridiques et consulaires a.i., Ministère des affaires étrangères, de la coopération et de l'intégration africaine, Niamey

NORVÈGE/NORWAY

Randi Merete WAHL (Mrs.), Head, Legal Section, Norwegian Patent Office, Oslo

Inger NÆSQAARD (Mrs.), Chief Engineer, Norwegian Patent Office, Oslo

NOUVELLE-ZÉLANDE/NEW ZEALAND

Mary Heather BONSELL (Mrs.), Project Manager, Intellectual Property Office, Ministry of Commerce, Wellington

OUGANDA/UGANDA

Ketrah A. TUKURATIIRE (Mrs.), Acting Registrar General, Registrar General's Department, Ministry of Justice and Constitutional Affairs, Kampala

OUZBÉKISTAN/UZBEKISTAN

Poulat K. KHABIBULLAEV, Chairman, State Committee for Science and Technology, Tashkent

Akil A. AZIMOV, Director, State Patent Office, Tashkent

PAYS-BAS/NETHERLANDS

Siep de VRIES, Head, Chemical Division, Netherlands Industrial Property Office, Rijswijk

POLOGNE/POLAND

Irena CZERNICKA-NALEWAJKO (Mrs.), Coordinator, PCT Section, Patent Office, Warsaw

PORTUGAL

Isabel AFONSO (Mme), directeur de la Direction des brevets à l'Institut national de la propriété industrielle, Lisbonne

Eduardo FRAGA, examinateur en brevets à l'Institut national de la propriété industrielle, Lisbonne

José Sérgio de CALHEIROS DA GAMA, conseiller juridique, Mission permanente, Genève

RÉPUBLIQUE CENTRAFRICAINE/CENTRAL AFRICAN REPUBLIC

Augustin GALAWANA, Directeur de la promotion du développement industriel et artisanal par intérim, Ministère du commerce, de l'industrie et de la promotion du secteur privé, Bangui

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

Young-Min GOO, Deputy Director, International Cooperation Division, Korean Industrial Property Office (KIPO), Taejon City

Chaho JUNG, Deputy Director, Examination Coordination Division, Korean Industrial Property Office (KIPO), Taejon City

Seung-Jong LEE, Deputy Director, Application Division, Korean Industrial Property Office (KIPO), Taejon City

Won-Joon KIM, Counsellor, Permanent Mission, Geneva

RÉPUBLIQUE DE MOLDOVA/REPUBLIC OF MOLDOVA

Eugen STASHKOV, Director General, State Agency on Industrial Property Protection, Kishinev

RÉPUBLIQUE POPULAIRE DÉMOCRATIQUE DE CORÉE/
DEMOCRATIC PEOPLE'S REPUBLIC OF KOREA

JONG Jin Song, Director, Patent Information Department, Invention Office of the Democratic People's Republic of Korea, Pyongyang

JANG Chun Sik, Counsellor, Permanent Mission, Geneva

RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

Marta HOŠKOVÁ (Mrs.), Deputy Director, Head of PCT Department, Industrial Property Office, Prague

RÉPUBLIQUE-UNIE DE TANZANIE/UNITED REPUBLIC OF TANZANIA

Esteriano Emmanuel MAHINGILA, Registrar of Patents and Trade Marks, Business Registrations & Licensing Agency, Ministry of Industry and Commerce, Dar-es-Salaam

ROUMANIE/ROMANIA

Viorel PORDEA, Head, Preliminary Examination Department, State Office of Patents and Trademarks, Bucharest

ROYAUME-UNI/UNITED KINGDOM

Richard C. KENNEL, Senior Legal Adviser, The Patent Office, Newport

Duncan J. WEARMOUTH, Policy Advisor, The Patent Office, Newport

Geoffrey BENNETT, Head, IT Services, The Patent Office, Newport

SIERRA LEONE

Salimatu KOROMA (Mrs.), Administrator and Registrar-General, Administrator and Registrar-General's Department, Freetown

SLOVAQUIE/SLOVAKIA

Vladimír BANSKÝ, Director, International Department and PCT, Industrial Property Office, Banská Bystrica

SLOVÉNIE/SLOVENIA

Erik VRENKO, Director, Slovenian Intellectual Property Office, Ljubljana

Andrej PIANO, Deputy Director, Slovenian Intellectual Property Office, Ljubljana

Mojca PEČAR (Mrs.), Legal Counsellor, Slovenian Intellectual Property Office, Ljubljana

SOUDAN/SUDAN

Farida Abdalla RAIHAN (Mrs.), Senior Legal Adviser, Head of Patent Department, The Commercial Registrar General, Ministry of Justice, Khartoum

SRI LANKA

Gamage D.D.K. PERERA, Assistant Director, Intellectual Property, National Intellectual Property Office of Sri Lanka, Colombo

Gothami INDIKADAHENA (Mrs.), First Secretary (Economic and Commercial), Permanent Mission, Geneva

SUEDE/SWEDEN

Jan-Eric BODIN, Deputy-Head, Patents, Swedish Patent and Registration Office, Stockholm

Linda BERGIUS (Miss), Legal Officer, Swedish Patent and Registration Office, Stockholm

SUISSE/SWITZERLAND

Lukas BÜHLER, juriste au Service juridique des brevets et designs de l'Institut fédéral de la propriété intellectuelle, Berne

Rolf HOFSTETTER, chef du Service de l'administration des brevets à la Division des brevets de l'Institut fédéral de la propriété intellectuelle, Berne

Matthias GÜNTER, chef du Service publication et communication électronique à la Division finances et informatique de l'Institut fédéral de la propriété intellectuelle, Berne

SWAZILAND

Beatrice S. SHONGWE (Mrs.), Acting Registrar-General, Registrar-General's Office, Ministry of Justice, Mbabane

TADJIKISTAN/TAJIKISTAN

Lubat SHARIPOVA (Ms.), Head, Department of State Examination of Invention and Industrial Designs, Dushanbe

TCHAD/CHAD

MAHAMAT ADOUDOU ALLAZAM, directeur de l'industrie, d'appui au mouvement associatif et coopératif et aux PME/PMI, Ministère de l'industrie, du commerce et de l'artisanat, N'Djamena

TOGO

Komlan Abalo AHENOU, chef de la Division de la propriété industrielle à la Structure nationale de la propriété industrielle (SNPIT), Ministère de l'industrie, Lomé

TRINITÉ-ET-TOBAGO/TRINIDAD AND TOBAGO

John Malcolm SPENCE, Chief Technical Examiner, Intellectual Property Office, Ministry of the Attorney General and Legal Affairs, Port of Spain

TURKMÉNISTAN/TURKMENISTAN

Reshit AGABAEV, Chairman, Patent Office of Turkmenistan, Ashgabat

TURQUIE/TURKEY

M. Serkan KAVLAK, Assistant Patent Examiner, Turkish Patent Institute, Ankara

UKRAINE

Peter BOROVIK, Deputy Director, Industrial Property Institute, State Committee of Ukraine for Science and Intellectual Property, Kyiv

VIET NAM

PHAN Phi Anh, Director, Invention and Utility Solution Division, National Office of Industrial Property (NOIP), Hanoi

ZIMBABWE

Fidelis MAREDZA, Deputy Controller, National Patent Office, Ministry of Justice, Harare

Cleopas ZVIRAWA, Counsellor, Permanent Mission, Geneva

II. ÉTATS OBSERVATEURS/OBSERVER STATES

ARGENTINE/ARGENTINA

Marta GABRIELONI (Sra.), Consejero, Misión Permanente, Ginebra

GUATEMALA

Rosemarie LUNA (Sra.), Misión Permanente ante la OMC, Ginebra

HAÏTI/HAITI

Moetsi DUCHATELLIER (Mlle), premier secrétaire, Mission permanente, Genève

Fritzner GASPARD, conseiller, Mission permanente, Genève

JAMAÏQUE/JAMAICA

Symone BETTON (Ms.), First Secretary, Permanent Mission, Geneva

MAURICE/MAURITIUS

Ravindranath SAWMY, Second Secretary, Permanent Mission, Geneva

PANAMA

Alfredo SUESCUM, Ambassador, Misión Permanente ante la OMC, Ginebra

PHILIPPINES

Ma. Angelina STA. CATALINA (Mrs.), First Secretary, Permanent Mission, Geneva

III. ORGANISATIONS INTERGOUVERNEMENTALES/
INTERGOVERNMENTAL ORGANIZATIONS

ORGANISATION EURASIENNE DES BREVETS (OEAB)/EURASIAN PATENT
ORGANIZATION (EAPO)

Alexandre GRIGORIEV, Vice-President, Moscow

ORGANISATION EUROPÉENNE DES BREVETS (OEB)/EUROPEAN PATENT
ORGANISATION (EPO)

York BUSSE, Principal Administrator, Directorate International Legal Affairs, European Patent Office, Munich

Eleni KOSSONAKOU (Mrs.), Lawyer, Directorate Patent Law, European Patent Office, Munich

John BAMBRIDGE, Director, EPOLINE, European Patent Office, The Hague

ORGANISATION RÉGIONALE AFRICAINE DE LA PROPRIÉTÉ INDUSTRIELLE
(ARIPO)/AFRICAN REGIONAL INDUSTRIAL PROPERTY ORGANIZATION (ARIPO)

Mzondi Haviland CHIRAMBO, Director General, Harare

ORGANISATION DE L'UNITÉ AFRICAINE (OUA)/ORGANIZATION OF AFRICAN
UNITY (OAU)

Venant WEGE-NZOMWITA, observateur permanent a.i., Délégation permanente, Genève

IV. ORGANISATIONS INTERNATIONALES
NON GOUVERNEMENTALES/
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association internationale pour la protection de la propriété industrielle (AIPPI)/International Association for the Protection of Industrial Property (AIPPI) : Heinz BARDEHLE (Chairman, PCT Commission, c/o Bardehle, Pagenberg & Kollegen, Munich)

Fédération internationale des conseils en propriété industrielle (FICPI)/International Federation of Industrial Property Attorneys (FICPI) : Jan MODIN (Group Reporter of Group 3 Study and Work Commission, c/o Axel Ehrens Patentbyrå AB, Stockholm); Christopher J.W. EVERITT (President, Study and Work Commission (CET), London); Claus-Mickel MAYR (President of Documentation Commission, Munich); Alexander ESSLINGER (Chairman, CET Group, Munich)

Institut des mandataires agréés près l'Office européen des brevets (EPI)/Institute of Professional Representatives before the European Patent Office (EPI) : Paul Georg MAUÉ (EPPC member, Basel)

V. BUREAU/OFFICERS

Président/Chair : Jorge AMIGO CASTAÑEDA (Mexique/Mexico)

Président par intérim/Acting Chair : Alan Michael TROICUK (Canada)

Secrétaire/Secretary : Philip THOMAS (OMPI/WIPO)

VI. BUREAU INTERNATIONAL DE L'ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

François CURCHOD, vice-directeur général/Deputy Director General

Bureau du PCT/Office of the PCT : Gary SMITH (directeur/Director); Jean-Luc PERRIN (directeur du Département de l'administration du PCT/Director, PCT Administration Department); WANG Zhengfa (directeur de la Division des pays en développement (PCT)/Director, Developing Countries (PCT) Division)

Division juridique du PCT/PCT Legal Division : Philip THOMAS (directeur/Director); Isabelle BOUTILLON (Mlle) (directrice adjointe/Deputy Director); Matthew BRYAN (conseiller principal/Senior Counsellor); Marie ERIKSSON (Ms.) (juriste principale/Senior Legal Officer); Takao KATO (juriste principal/Senior Legal Officer); Mamue KAMM (Mrs.) (administratrice de programme/Program Officer); Kevin KRAMER (juriste/Legal Officer); Matthias REISCHLE (juriste/Legal Officer)

Division du droit de la propriété industrielle/Industrial Property Law Division : Albert TRAMPOSCH (directeur/Director); Philippe BAECHTOLD (chef de la Section du droit des brevets/Head, Patent Law Section); Tomoko MIYAMOTO (Ms.) (juriste principale/Senior Legal Officer)

Projet PCT IMPACT/PCT IMPACT Project : Allan ROACH (chef/Head)

Helen FRARY (Ms.) (administratrice principale, Gestion des techniques de l'information/Information Technology Business Manager)

Services d'information interoffices/Inter-Office Information Services : Klaus-Peter WITTIG (directeur adjoint/Deputy Director); William GUY (chef de la Section des projets spéciaux/Head, Special Projects Section)

Brad HUTHER (Consultant)

[L'annexe II suit/Annex II follows]

ANNEX II

AMENDMENTS OF THE PCT REGULATIONS:

TEXT OF THE AMENDED RULES

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) [No change]

(ii) a request to the receiving Office to prepare and transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office,

(iii) declarations as provided in Rule 4.17.

(d) [No change]

4.2 to 4.4 [No change]

4.5 *The Applicant*

(a) to (d) [No change]

(e) Where the applicant is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the applicant is so registered.

4.6 *The Inventor*

(a) Where Rule 4.1(a)(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.

(b) and (c) [No change]

4.7 *The Agent*

(a) If an agent is appointed, the request shall so indicate, and shall state the agent's name and address.

(b) Where the agent is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the agent is so registered.

4.8 *Common Representative*

If a common representative is appointed, the request shall so indicate.

4.9 to 4.16 [No change]

4.17 *Declarations Relating to National Requirements Referred to in Rule 51bis.1(a)(i) to (v)*

The request may, for the purposes of the national law applicable in one or more designated States, contain one or more of the following declarations, worded as prescribed by the Administrative Instructions:

(i) a declaration as to the identity of the inventor, as referred to in Rule 51bis.1(a)(i);

(ii) a declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent, as referred to in Rule 51bis.1(a)(ii);

(iii) a declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application, as referred to in Rule 51bis.1(a)(iii);

(iv) a declaration of inventorship, as referred to in Rule 51bis.1(a)(iv), which shall be signed as prescribed by the Administrative Instructions;

(v) a declaration as to non-prejudicial disclosures or exceptions to lack of novelty, as referred to in Rule 51bis.1(a)(v).

4.18 *Additional Matter*

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

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

Rule 26ter

Correction or Addition of Declarations Under Rule 4.17

26ter.1 Correction or Addition of Declarations

The applicant may correct or add to the request any declaration referred to in Rule 4.17 by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

26ter.2 Processing of Declarations

(a) Where the receiving Office or the International Bureau finds that any declaration referred to in Rule 4.17 is not worded as required or, in the case of the declaration of inventorship referred to in Rule 4.17(iv), is not signed as required, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within a time limit of 16 months from the priority date.

(b) Where the International Bureau receives any declaration or correction under Rule 26ter.1 after the expiration of the time limit under Rule 26ter.1, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions.

Rule 47

Communication to Designated Offices

47.1 Procedure

(a) and (a-bis) [No change]

(a-ter) The notification under paragraph (a-bis) shall include any declaration referred to in Rule 4.17(i) to (iv), and any correction thereof under Rule 26ter.1, which was received by the International Bureau before the expiration of the time limit under Rule 26ter.1, provided that the designated Office has informed the International Bureau that the applicable national law requires the furnishing of documents or evidence relating to the matter to which the declaration relates.

(b) to (e) [No change]

47.2 to 47.4 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (viii) [No change]

(ix) any information concerning a priority claim considered not to have been made under Rule 26*bis*.2(b), the publication of which is requested under Rule 26*bis*.2(c),

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

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

(i) and (ii) [No change]

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first,

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

(c) to (i) [No change]

48.3 to 48.6 [No change]

Rule 51bis

Certain National Requirements Allowed Under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

- (i) any document relating to the identity of the inventor,
- (ii) any document relating to the applicant's entitlement to apply for or be granted a patent,
- (iii) any document containing any proof of the applicant's entitlement to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed,
- (iv) where the international application designates a State whose national law requires that national applications be filed by the inventor, any document containing an oath or declaration of inventorship,
- (v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

(b) and (c) [No change]

(d) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the translation of the international application furnished by the applicant under Article 22 be:

- (i) verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful;
- (ii) certified by a public authority or sworn translator, but only where the designated Office may reasonably doubt the accuracy of the translation.

(e) The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

(f) If, on March 17, 2000, the proviso in paragraph (e) is not compatible with the national law applied by the designated Office, that proviso shall not apply in respect of that Office for as long as that proviso continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

51bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required

(a) Where the applicable national law does not require that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is contained in the request or is submitted directly to the designated Office;

(ii) relating to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rule 51bis.1(a)(ii)), if a declaration as to that matter, in accordance with Rule 4.17(ii), is contained in the request or is submitted directly to the designated Office;

(iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office.

(b) Where the applicable national law requires that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv))), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request;

(ii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;

(iii) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.

(c) If, on March 17, 2000, paragraph (a) is not compatible, in relation to any item of that paragraph, with the national law applied by the designated Office, paragraph (a) shall not apply in respect of that Office in relation to that item for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

51bis.3 Opportunity to Comply with National Requirements

(a) Where any of the requirements referred to in Rule 51bis.1(a)(i) to (iv) and (c) to (e), or any other requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27(1) or (2), is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for complying with national requirements in response to the invitation.

(b) Where any requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27(6) or (7) is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.

(c) If, on March 17, 2000, paragraph (a) is not compatible with the national law applied by the designated Office in relation to the time limit referred to in that paragraph, the said paragraph shall not apply in respect of that Office in relation to that time limit for as long as the said paragraph continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 53

The Demand

53.1 to 53.4 [No change]

53.5 Agent or Common Representative

If an agent or common representative is appointed, the demand shall so indicate. Rules 4.4 and 4.16 shall apply, and Rule 4.7 shall apply *mutatis mutandis*.

53.6 to 53.9 [No change]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 to 66.6 [No change]

66.7 Priority Document

(a) [No change]

(b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

66.8 and 66.9 [No change]

[End of Annex and of document]

WIPO



PCT/A/29/4

ORIGINAL: English

DATE: October 3, 2000

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Twenty-Ninth (17th Extraordinary) Session
Geneva, September 25 to October 3, 2000

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/35/1 Prov.4): 1, 2, 4, 5, 7, 9, 11, 22, 27 and 28.
2. The report on the said items, with the exception of item 9, is contained in the General Report (document A/35/15).
3. The report on item 9 is contained in the present document.
4. Mr. Jorge Amigo Castañeda (Mexico), presided over the meeting of the Assembly.

ITEM 9 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Proposed Amendment of the Schedule of Fees Annexed to the Regulations Under the PCT;
Proposed Rectification of the French Text of PCT Rule 26bis.2(c)

5. Discussions were based on document PCT/A/29/1.
6. In introducing the document, the International Bureau reiterated the statement it had made before the Program and Budget Committee (at its second session held from September 20 to 22, 2000) to the effect that reductions in PCT fees invariably make the PCT system more attractive to users and that the International Bureau therefore expected the proposed reduction to result in an increase in PCT filings. Although such an increase was difficult to quantify in advance, the increased filings could be expected to roughly compensate, in terms of overall fee income for the International Bureau, for the decreased amount of fees payable per application. Consequently, there should be no fear that the fee reduction might negatively affect the resources available for cooperation for development activities.
7. The Delegations of Algeria, Cuba, Bulgaria (speaking on behalf of the Central European and Baltic States), Canada, the Republic of Korea and the Czech Republic expressed support for the proposal, several of them noting that such a fee reduction would further stimulate PCT filings.
8. The Delegation of Egypt expressed its gratitude for the assistance provided to its country by the International Bureau on intellectual property matters in general and on the PCT in particular. The Delegation informed the Assembly that steps for accession by Egypt to the PCT were being taken and that the deposit of the instrument of accession could be expected after the next parliamentary elections.
9. The International Bureau took the opportunity to inform the Assembly that the Director General had decided to lower the present amount of the transmittal fee charged by the International Bureau acting as receiving Office from 300 Swiss francs to 100 Swiss francs, as from January 1, 2001. Furthermore, the Director General had decided that, in respect of international applications filed with the International Bureau acting as receiving Office, applicants who presently qualified for a 75% reduction of the international fee under item 5 of the Schedule of Fees (see the Annex to this report) would not, as from January 1, 2001, have to pay any transmittal fee.
10. The Assembly unanimously adopted the amendment of the Schedule of Fees as set out in the Annex to this report and decided that it would enter into force on January 1, 2001, and approved the rectification of the French text of Rule 26bis.2(c) as set out in paragraph 8 of document PCT/A/29/1.

Progress Report on the PCT Automation (“IMPACT”) Project

11. Discussions were based on documents PCT/A/29/2 and PCT/A/29/2 Add.
12. In introducing the documents, the International Bureau emphasized the approach, based on the best practices of the Project Management Institute, which was being used in the management of the IMPACT project. The International Bureau noted that a detailed plan had been prepared for the development and implementation of the first stage of the project (the IMPACT Communication System (COR) stage), that a plan for the project as a whole was being further refined, and that a high-level plan for the PCT Electronic Filing (E-filing) stage had been prepared.
13. The International Bureau noted that recent informal consultations with the combined membership of the PCT and the Standing Committee on Information Technologies (SCIT) had led to significant progress towards the establishment of the legal framework and technical standards necessary to implement PCT electronic filing and that agreement was close to being reached on a set of common requirements.
14. The International Bureau drew attention to steps taken in relation to the high priority task of identifying user requirements in connection with the IMPACT project. A questionnaire relating to the first stage of the project had been circulated to PCT Offices and Authorities in June 2000, to which some replies had been received by the International Bureau and more would be welcomed. To complement the questionnaire, the IMPACT Project Team had undertaken eight fact-finding missions to Offices of PCT Contracting States in various regions of the world to study in detail their working methods in their different capacities under the PCT. The International Bureau intended to continue such missions as the IMPACT project progressed to ensure that the requirements of Contracting States would be fully taken into account during the development and deployment of the project.
15. The Delegation of Algeria noted its satisfaction with the documents. It referred to the assistance that had to be provided to developing countries, under the agreement reached at the Diplomatic Conference on the Patent Law Treaty (see document PT/DC/47, page 56, paragraph 4).
16. The Delegations of the Czech Republic and of Cuba commended the efforts of the International Bureau in respect of PCT automation.
17. The Assembly took note of documents PCT/A/29/2 and PCT/A/29/2 Add.

Reform of the Patent Cooperation Treaty

18. Discussions were based on document PCT/A/29/3, the Annex to which contained a proposal by the United States of America.
19. The Delegation of the United States of America stated that it was intensely interested in reform of the PCT in order to simplify both the Treaty and the Regulations, and to streamline filing and processing procedures for users, patent Offices (both large and small), and the International Bureau. The Delegation explained that its proposal had been made after formal and informal discussions with its “Trilateral partners” (the European Patent Office and the Japanese Patent Office), other patent Offices, WIPO officials and PCT users in the United

States of America. The Delegation noted that the Assembly was not being asked to act on the particulars of the proposal but rather on the proposal of the Director General set out in paragraphs 2 and 3 of the document. The Delegation urged strong support for the Director General's proposal, adding that the issues raised in its proposal could serve as a basis for the work of the proposed special body for PCT reform.

20. The Delegation of Algeria noted that, although its country's accession to the PCT was recent (March 2000), it expected some difficulties with respect to national phase processing. The Delegation therefore welcomed the proposal to simplify the PCT as well as the proposal to establish a special body entrusted with the consideration of the issue.

21. The Delegation of Canada, noting the recent adoption of the Patent Law Treaty, expressed the view that enhancing the PCT was key to the development of an effective international patent system. The Delegation further stated that Canada wished to participate in the proposed special body.

22. The Delegation of France, speaking on behalf of the Member States of the European Union, recalled the opening statement by the Director General of WIPO at the commencement of the Assemblies' meetings in which he emphasized that the PCT was a major success for the International Bureau. The Delegation observed, however, that after 22 years of operation, the PCT had come to the point where it needed to be reformed, rationalized and modernized. The Delegation noted the Director General's proposal that a special body be set up to consider the proposal made by the United States of America. The Member States of the European Union supported the idea of embarking on a process aimed at achieving reform of the PCT and, in particular, simplifying its operations and reducing costs. They supported the establishment of a special body for this purpose but wanted more specificity as to its mandate and composition. Regarding the mandate for the special body, the Member States of the European Union were of the opinion that it should concentrate on the issues presented under the heading "First Stage of Reform" in the Annex to document PCT/A/29/3. Furthermore, they believed that the special body should not limit itself to the proposals by the United States of America but that proposals, pursuing the same objectives as those presented under the heading "First Stage of Reform," from other PCT Member States and intergovernmental organizations responsible for international search and preliminary examination should also be considered. Such other proposals should be presented within a reasonable period of time, for example, during the first few months of 2001, taking into account the numerous ongoing exercises in the field of patents. As to the membership of the special body, the Member States of the European Union would like to be closely associated with its work. The Delegation also expressed the view that the European Commission should be able to participate. In addition, it would be important to fully involve the European Patent Office in the discussions.

23. The Delegation of Japan expressed its appreciation to the United States of America for its proposal. The Delegation expressed support for the Director General's proposal contained in document PCT/A/29/3. The Delegation noted that the PCT system was working well, judging from the increase in the number of applications filed, but stated that it was also a fact that PCT users often complained about the complexity of PCT procedures and, in particular, about the duplication of work in search and examination procedures among International Searching Authorities, International Preliminary Examining Authorities and designated Offices. Japan shared the view of the United States of America that the PCT system should be simplified and that duplication of work should be reduced in order to facilitate the process of obtaining patent protection worldwide. The Delegation added that the PCT, if further

improved, would form one of the pillars for a global patent system along with the envisaged substantive patent law harmonization. In this context, it supported embarking on a comprehensive review of the Treaty as well as the Regulations. The Delegation was also of the view that PCT reform should take into account such considerations as consistency with the Patent Law Treaty, simplification of procedures, reduction of duplication of work in search and examination throughout the international and the national phases, accommodation of different users' needs, and equitable treatment among applicants. The Delegation further stated that the proposal of the United States of America identified many issues needing to be tackled in order to improve the PCT system. The issues to be examined in detail should also include a review of PCT Article 64(4) relating to reservations as to prior art effect.

24. The Delegation of Switzerland observed that, even though the PCT system was one of the major successes of WIPO and had achieved a degree of integration of patent systems throughout the world, it was still too complex and too expensive compared with what might be expected. The Delegation therefore was in favor of efforts to reform the PCT, in particular those aimed at the granting of patents effective worldwide, while recognizing that that might be a long term matter. It noted that the proposal annexed to document PCT/A/29/3 emphasized the importance of harmonization of substantive patent law as a condition for further integration of patent granting procedures. The Delegation referred to the recent conclusion of the Patent Law Treaty and remarked that some ambitious goals had had to be set aside in the process of negotiating that Treaty since certain countries had not been prepared to review particularities of their national patent systems. In the view of the Delegation, the far-reaching proposal by the United States of America was laudable but might be rather difficult to achieve. The Delegation, referring to the intervention made by the Delegation of France on behalf of the Member States of the European Union, supported the ambitious proposals with respect to the future development of the PCT, but hoped that reform of the PCT would take place in connection with a more in-depth harmonization of substantive patent law. The Delegation stated that the issues to be examined by the special body should be expanded so as to also cover substantive patent law aspects, which it considered to be essential.

25. The Delegation of Spain expressed its support for the statement made by the Delegation of France on behalf of the Member States of the European Union. The Delegation emphasized the following three points: first, only the first stage of the proposal by the United States of America should be included in the terms of reference of the special body; second, the work of that special body should not necessarily be limited to that proposal; and third, the Member States of the European Union should be involved in the work of the special body. Spain would be extremely interested in participating in the work of the special body if and when established.

26. The Delegation of Brazil felt that the Assembly was being asked to engage in a full-fledged reform of the PCT system without being clear as to what the parameters of the exercise would be. It commented that the proposal by the United States of America dealt with two different aspects: a procedural aspect which the Delegation could readily agree to, since it would make the PCT system easier to use, and a substantive aspect, which was more delicate. The Delegation stressed that it would not be in a position to accept the creation of the special body unless its mandate was clear. Since the PCT was a cornerstone of WIPO activities, the Assembly should deal with these issues very carefully.

27. The Delegation of Australia welcomed the proposal to establish a special process to consider reform of the PCT. It also thanked the United States of America for presenting a

thought-provoking paper on some of the issues that might be considered. The Delegation expressed the view that significant areas of reform in the PCT system could be addressed, but it shared the views of some other delegations, such as the Delegation of Switzerland, that there were implications for patent law harmonization. The Assembly would need to consider how those two processes would be linked. The Delegation was of the view that some aspects of PCT reform needed to be addressed and acted upon in a shorter time frame than that contemplated in the proposal contained in the Annex to document PCT/A/29/3. The year 2005 seemed a long way away, taking into consideration the rapidly increasing workload of patent Offices worldwide; aspects of reform which would assist in dealing with that workload should be undertaken as quickly as possible. Referring to the intervention by the Delegation of Brazil, the Delegation of Australia suggested that the Assembly could request the special body to report to the Assembly on the scope of the reform agenda at an early stage.

28. The Delegation of Cuba stated that a reform of the PCT system would require prior consultation with all Member States. The reform should address those features of the PCT which prevented it from becoming more universal, while maintaining the features that had made it work successfully. The Delegation associated itself with the comments made by the Delegation of Brazil, expressed its confidence in the Director General and indicated full support for his proposal.

29. The Delegation of the Czech Republic expressed its support for reform of the PCT, which would need to take due account of the Patent Law Treaty as well as other new developments, and supported the Director General's proposal.

30. The Director General stated that the approach to reform should be inclusive in that it should also take into account proposals other than those contained in the Annex to document PCT/A/29/3. He indicated that the special body should report to the Assembly and not to the Director General. As to the composition of the special body, and referring mainly to the statement by the Delegation of France speaking on behalf of the Member States of the European Union, the Director General indicated that the European Patent Office would necessarily be included under the International Bureau's proposal since it was one of the International Searching and Preliminary Examining Authorities mentioned in paragraph 2 of document PCT/A/29/3. He indicated that the European Commission could also be invited, if the Assembly so wished.

31. The Delegation of Brazil stated that, since the PCT was a cornerstone of WIPO activities, membership of the special body should be open to all Member States, noting that the Director General could select additional members. The Delegation, noting that the mandate of the special body had not yet been defined, agreed with the view expressed by other delegations that the special body should also consider proposals other than that contained in the Annex to document PCT/A/29/3.

32. On the question of the composition of the special body, the Director General stated his intention to consult with the coordinators of the various groups, in particular on the question whether the membership should be open to all States wishing to participate. He would favor a composition which would lead to the most effective, efficient and speedy process. The Director General further indicated that he had no objection to clarifying that the special body would be asked to consider both the proposal contained in the Annex to document PCT/A/29/3 and subsequent proposals.

33. The Delegation of Brazil stated that the Assembly should, in the creation of a special body, balance the needs for both efficiency and inclusiveness. It indicated that it would certainly wish to put forward ideas about reform of the PCT, as would other delegations, and that there should be no limitation in this respect; it further stated that all Member States should be looking forward to working on such a matter in an open context.

34. The Delegation of France thanked the Director General for his explanations. The Delegation wished to clarify the spirit in which it had made its statement on behalf of the Member States of the European Union. The special body should focus on the first stage of reform as set out in the Annex to document PCT/A/29/3, that is, on changes of a more modest nature, aimed at simplifying the PCT. Other proposals by Member States of the European Union, other Member States of the PCT and the European Patent Office should be examined at the same time as, and on an equal footing with, the proposals by the United States of America. The Delegation stated that, taking due account of other discussions concerning patent law currently being undertaken both at the international level and within the European Union, such proposals should be able to be submitted during the first months of the year 2001. The Delegation stressed that it did not wish the special body which was to be established to transform itself into another PCT Assembly. The Delegation thanked the Director General for having confirmed that the European Commission, which now had competence in certain patent matters, could be invited to participate in the special body.

35. The representative of the European Patent Organisation underlined the dedication of the European Patent Office (EPO) to the PCT, noting that the EPO carried out more than 60% of the international searches and international preliminary examinations under the PCT. It was obvious that the EPO would be affected to a great extent by any change to the PCT, and it would have a great interest in sharing its own experience and knowledge so as to improve the system wherever possible. The representative wished, as had already been emphasized by the Delegation of Japan, that the question of increasing workload for Offices be taken into consideration when examining the first stage of reform as proposed by the United States of America. The mandate of the special body should not be limited to issues relating to simplification, but should also include issues relating to workload. The representative noted that the EPO had launched some ideas concerning the time limit for entry into the national phase under PCT Article 22, and that related ideas were in fact mentioned in the proposal by the United States of America. The representative was grateful for the clarification given by the Director General as to the mandate and composition of the special body. He would, however, appreciate receiving further clarification with respect to the working methods of the special body, and in particular, whether it would report to the Assembly or to the Director General. The representative stressed, as had been done by the Delegations of Japan and of Switzerland, that substantive patent law harmonization was an issue. The representative further stated that the EPO would agree to concentrate on the first stage of reform and related proposals. The representative finally recalled the question of the existing reservations under PCT Article 64 and stated that it should be considered, if not within the first stage of reform, then in the second stage.

36. The Director General confirmed his view that the special body should report directly to the PCT Assembly.

37. The representative of IFIA congratulated the Delegation of the United States of America for having initiated a process for reform of the PCT and stated that the Director General's proposal contained in document PCT/A/29/3, with the subsequent clarifications provided during the discussion, was the wisest solution. The representative indicated that the views of

users and potential users of the PCT should be taken into account, and stressed that the important users were in fact inventors and patent applicants, noting that all inventions were the creation of either independent inventors, inventor entrepreneurs, or employee inventors, the latter being employed by either enterprises or research institutes. When the choice of non-governmental organizations to participate in the special body was made, this should be borne in mind. The representative also recognized the need to invite organizations representing patent attorneys and other experts. The representative emphasized that IFIA was in favor of the development of a world patent system, and also spoke of his desire to see the creation of a world patent court. The representative concluded by saying that the market economy would drive the system in the direction of world patents.

38. The Delegation of Mexico indicated that it had carefully analyzed the proposal by the United States of America and had found it most useful, but that the discussion would be enhanced by contributions from other countries so as to ensure that different viewpoints were taken into account. The proposal by the Director General to set up a special body seemed to be the appropriate way of handling such a discussion. The Delegation indicated that, in order for the work of the special body to be successful, its composition should be limited in numbers, but that its members should be representative of all regions. The Delegation expressed the hope that there would be financial assistance to enable participation of those developing countries which were invited.

39. The Delegation of India stated that a large body of opinion appeared to favor consideration of the proposal by the United States of America, but only as a basis for further discussion. The Delegation therefore believed that the Director General should formally invite all members of the PCT Assembly to contribute proposals for PCT reform within three months, which would all be considered on an equal footing. With regard to the composition of the special body, the Delegation indicated that the possibility of inviting participation by all interested Member States was worthy of serious consideration.

40. The International Bureau read the following suggestion for a draft decision by the Assembly:

“The Assembly decided that a special body would be set up to consider the proposals contained in the Annex to document PCT/A/29/3 under the title “First Stage of Reform” and any other proposal pursuing the same objectives that would be submitted to the International Bureau until the end of January 2001, that the special body would consist of Member States, International Searching and Preliminary Examining Authorities and interested intergovernmental and non-governmental organizations, that the Director General would designate the members of the special body in consultation with Member States, and that the special body would report to the September 2001 session of the Assembly.”

41. The Delegation of Australia stated that it did not appear to be necessary at this time to include in the draft text the limitation which had been proposed by the Delegation of France, which spoke on behalf of the Member States of the European Union, to the effect that only stage one in the proposal by the United States of America should be considered. The Delegation was of the view that the special body should itself consider the entire proposal and then propose any limitations to the scope of its work.

42. The Delegation of France referred to the recent conclusion of the Patent Law Treaty and expressed its agreement with the view of the Delegation of Switzerland to the effect that

questions of substantive patent law needed to be kept in mind. The first stage of reform, which aimed at simplifying the PCT system, would be helpful not only to users but also to International Searching and Preliminary Examining Authorities. On the other hand, considering more substantive changes at a time when discussions on patent-related issues were taking place in other fora would be premature. The Delegation stated that the Assembly was competent, as provided for in the PCT, to decide upon the mandate of the special body.

43. The Delegation of the United States of America stated that its proposal did indeed divide issues into two categories but that some of those in the first category could in fact prove to be more difficult to tackle than some in the second category, and vice versa. Therefore, it was of the view that the special body should have a chance to review all proposals and decide which ones were ready to move forward and which ones should be deferred. The Delegation thus supported the proposal made by the Delegation of Australia as to how the special body should proceed.

44. The Director General confirmed that the Assembly, not the International Bureau, would decide on the scope of the mandate of the special body. The International Bureau would provide the services required depending on the Assembly's decision, whether it meant considering all proposals together, or taking them step by step.

45. The representative of the European Patent Organisation, while expressing support for the statement made by the Delegation of France, stated that the Assembly should consider what was envisaged in the second stage of reform before deciding on what should be included in the first round of proposals to be examined by the special body. The representative referred to several points mentioned under "Second Stage of Reform," in the Annex to document PCT/A/29/3, namely "Regionalization of current search/examination authorities," "Elimination of distinction between national and international applications," "Positive examination results in certain PCT authorities bind Contracting States," and "Provide further flexibilities in terms of relaxed timing requirements for national stage processing." The representative indicated that the last point, but only that last point, could, in his view, be included in the first stage of reform. The other three points, among others, concerned issues of substantive harmonization. The representative urged the Assembly to consider the problems relating to those steps and reiterated a comment made earlier to the effect that the European Patent Office as an International Authority (and the same would be true for other International Authorities) had major problems with workload and was now looking for solutions which could be implemented in the short term, not the long term. The representative further stated that the special body should concentrate on those points which would help Offices and Authorities and on those which aimed at modernizing the PCT, without embarking on a complete revision at this point.

46. The Delegation of Japan stated that the special body should consider the entire proposal as made by the Delegation of the United States of America, noting that the issues raised under the second stage of reform were indeed rather difficult but that discussion of those issues should be initiated. The Delegation stated that it would be very interested in discussing the third point of the second stage of reform.

47. The Delegation of the United States of America noted the comments made by the representative of the European Patent Organisation to the effect that the fourth point listed under the second stage of reform could be discussed in the first stage. The Delegation stated that the Assembly should leave it to the special body to determine how to move forward on

the issues in both proposed stages of reform and that the special body should also be able to consider proposals other than those made by the United States of America.

48. The Chairman made the following proposal to the Assembly: one of the first objectives of the special body should be to decide on the issues which should be analyzed on the basis of both stages of the proposal by the United States of America; it would also decide on other issues which might have been raised by other countries interested in the subject. The Chairman recognized that there might be some logic in tackling certain issues first and others later having regard to their complexity. The Chairman, noting that no delegation had spoken against the need to reform the PCT, thought it was clear at this point that the Assembly would have to embark upon a process of reforming the PCT for all the reasons which had been put forward by various delegations.

49. The Delegation of France stated that it would be useful to hold consultations among delegations on the basis of a written text that would reflect the discussions so far in the Assembly's session.

50. The Delegation of Brazil expressed its concern on the third point of the proposed second phase of PCT reform, as contained in the Annex to document PCT/A/29/3, which envisaged the transformation of the non-binding patentability opinions into binding opinions, since that would imply a major departure from a basic characteristic of the PCT. The Delegation suggested that further discussions take place on the basis of a written text which would reflect a compromise enabling the Assembly to take a decision.

51. The session was suspended to allow for consultations. When the session resumed its work, the Chairman read the following draft decision (in English):

“The Assembly of the PCT Union decided:

- “(i) that a special body would be set up to consider, as a first step, proposals for reform of the PCT that would pursue the same objectives as those defined under the title “The First Stage of Reform” of the Annex to document PCT/A/29/3. These proposals may be those contained in the Annex and/or in any other submission made to the International Bureau, if possible, before the end of January 2001;
- “(ii) that the special body would consist of Member States, the International Searching and Preliminary Examining Authorities and observers, in particular, intergovernmental and non-governmental organizations, including the European Commission;
- “(iii) that the Director General would designate the members of the special body in consultation with Member States, taking due consideration of the need for geographical balance;
- “(iv) that the special body would report to the September 2001 session of the Assembly of the PCT Union, which would also include its recommendations to that Assembly for proposals to be considered as part of the first step;
- “(v) that the special body would proceed with diligence in completing the first step and in addressing other key issues, subject to the same procedure as that agreed for the first step.”

52. The Delegation of France, as coordinator of Group B, asked the Chairman to give the floor to the Delegation of Canada for a statement to be made, on behalf of Group B, on the draft decision which had just been read.

53. The Delegation of Canada made the following statement:

“Thank you for providing my Delegation with the opportunity of clarifying the compromise proposal now submitted by a number of groups regarding PCT reform. We would appreciate it if this declaration could be included in its entirety in the Assembly’s report. For many delegations, the aim of PCT reform is to simplify operations under the PCT and reduce its costs for users and Offices, particularly in the context of electronic commerce. This initiative is all the more important since PCT services contribute to some three-quarters of the Organization’s revenues—several among us agree on the urgency of moving forward.

“The proposal before the Assembly, based on the unofficial document distributed last night to this Assembly, is one of compromise. Bearing the stamp of caution, it recognizes the common thread underlying a large number of interventions made yesterday and focusing on the mandate of the new body, which can be represented by two main themes: the objective of the first phase of the work program, and an open mandate enabling the inclusion of items originating from any Member State. The present proposal is also a response to concerns expressed by delegations and voiced today by their coordinators, particularly regarding the status of non-governmental organizations and the geographical distribution of the new body’s participants. It does not modify the Director General’s proposal as to how members will be designated.

“Regarding the objective of the work program, as generally agreed, the first phase should focus on issues relating to the simplification of operations, modest in scope and achievable within a five-year period, dealing in particular with elements contained in the recently adopted Patent Law Treaty.

“Regarding the origin of issues to be addressed by the new body, we have also taken into account concerns expressed by numerous delegations on the importance of an open agenda, not limited to issues already identified in the proposal by the United States of America, the quality of which is recognized by several of us. The text therefore emphasizes that the new body will be able to consider issues raised in any other submission.

“Item (iv) of the compromise proposal recognizes the role of the Assembly, which will approve the issues that the group of experts recommends, in particular in September 2001, for inclusion in the list of issues to be addressed in the first phase. In other words, the issues to be submitted by the new body to the Assembly will be, from the start, exclusively within the objective of the first stage.

“Item (v) emphasizes the urgency of starting the process—we will further comment on that point—and underlines the importance of the initiative. The wording of this item ensures that proposals for issues to be addressed in subsequent stages will be subject to the same procedures as those followed during the first stage. It will be up to the Assembly to decide which questions will be discussed in these subsequent stages.

“Finally, this project, while urgent, will require time—only one meeting is planned before September 2001, and the total program for the first phase is not expected to be completed before 2005. In addition, we believe that the timetable will have to be developed by the new body in time for its report next year. This initiative must be imbued with urgency, otherwise these important reforms will take many years. As Boileau said, one must hasten slowly.”

54. The Delegation of South Africa stated that it would be pleased for the establishment of the special body to be left to the Director General, and expressed its hope that South Africa would serve as a member of that body.

55. The Director General thanked the Delegation of South Africa for expressing its confidence in the International Bureau to establish the special body, and stated that the International Bureau would do so in consultation with the coordinators of the groups promptly after the Assemblies’ meetings.

56. The Delegation of Brazil supported the statement made by the Delegation of Canada.

57. The Delegation of Mexico welcomed the agreement reached and in particular the draft decision as contained in paragraph 51, above. It stressed that Mexico was very interested in being part of the special body and added that it was important for developing countries to be guaranteed financial assistance so that they could fully participate in the work of that body.

58. The Assembly of the PCT Union adopted the draft decision as contained in paragraph 51, above.

[Annex follows]

ANNEX

SCHEDULE OF FEES
(as in force from January 1, 2001)

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 Swiss francs
(b) if the international application contains more than 30 sheets	650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	140 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 6 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	140 Swiss francs per designation
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

4. The total amount of the fees payable under items 1 and 2(a) is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.
5. All fees payable (where applicable, as reduced under item 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[End of Annex and of document]

WIPO



PCT/A/30/7

ORIGINAL: English

DATE: October 3, 2001

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Thirtieth (13th Ordinary) Session
Geneva, September 24 to October 3, 2001**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/36/1): 1, 2, 4, 5, 6, 7, 8, 12, 17, 24, 27 and 28.
2. The report on the said items, with the exception of item 17, is contained in the General Report (document A/36/15).
3. The report on item 17 is contained in the present document.
4. Mr. Jørgen Smith (Norway) was elected Chair of the Assembly; Mr. Wang Jingchuan (China) and Mr. Miklós Bendzsel (Hungary) were elected Vice-Chairs.
5. Mr. Jørgen Smith (Norway), presided over the meeting of the Assembly.

ITEM 17 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Proposed Amendment of the Schedule of Fees Annexed to the Regulations Under the PCT

6. Discussions were based on document PCT/A/30/1.
7. The Delegation of Algeria expressed its support for the proposal and stressed that it would be desirable in the future to move towards a single fee to be paid, irrespective of the number of designations made.
8. The Delegation of the Republic of Korea supported the proposal which, in its view, would contribute to the progressive development of the PCT system and foster broader access to patent protection.
9. The Delegation of Colombia supported the proposal which, in its opinion, would entail substantial benefits for PCT users.
10. The Delegation of Israel supported the proposal, noting that it represented an important step towards PCT reform.
11. The Delegation of France supported the proposal, agreeing with the view expressed by the Delegation of Algeria in favor of a future single fee irrespective of the number of designations, and noting that this would be in line with PCT reform objectives.
12. The Delegation of the Netherlands, while it was not against the proposal, questioned whether it would be wise to reduce PCT fee income when the special reserve fund was becoming depleted. In response, the International Bureau confirmed that the impact of the proposal on the finances of the Organization had been taken into account in the Program and Budget for 2002-2003.
13. The representative of IFIA while supporting the proposal, noted that official fees were not a major expense for applicants compared with patent attorneys' charges. He also favored speedy action towards reducing the designation fee to zero and eliminating the concept of designations.
14. The Assembly unanimously adopted the amendment of the Schedule of Fees as set out in Annex I to this report and decided that it would enter into force on January 1, 2002.

Reform of the Patent Cooperation Treaty

15. Discussions were based on document PCT/A/30/2.
16. The Delegation of Austria recalled that the PCT had a membership of 112 countries as of July this year and noted the importance of reform for customers and Offices. The report of the Committee on Reform of the PCT correctly focused, in the short term, on simplifying and streamlining PCT procedures by way of amendment of the PCT Regulations. The Delegation

stated its strong support for the establishment of a working group that addressed the most obvious and urgent matters required to attain the common goals identified by the Committee.

17. The Delegation of Algeria expressed its satisfaction with what had been accomplished in only one year of the PCT reform process. The Delegation noted that the high number of proposals which had been submitted for consideration by the Committee was an indication of how important the PCT was for both developed and developing countries. There was an enormous need to change the current system and the setting up of a working group was a good initiative. The Delegation stressed that for the system to be more user-friendly, it should ensure a better distribution of tasks among the PCT Authorities and a streamlining of procedures.

18. The Delegation of Ukraine expressed its satisfaction with the work which had already been achieved by the Committee. The Delegation supported the establishment of a working group and agreed with the matters to be referred to it. It emphasized the need to focus on reduction of costs.

19. The Delegation of Colombia supported the procedure proposed by the Committee but did not necessarily agree with all the matters to be considered during the reform process. Enhanced international harmonization under the PCT should be restricted to formal requirements and not cover the grant of substantive rights. The Delegation stressed that reform of the PCT should not digress from its legal framework, that is, relating to the filing of international applications and the establishment of international search and preliminary examination reports, as well as the dissemination of technical information.

20. The Delegation of France agreed that the PCT should be reformed so as to make the system more user-friendly by streamlining procedures. The Delegation noted that the first stage of the reform process should not go beyond the agreed mandate. The Delegation recalled that the Assembly, at its session in September 2000, had agreed that the second stage of the reform process would begin only upon harmonization of the substantive law of patents.

21. The Delegation of Slovakia stated that it fully supported the process of PCT reform and the Committee's recommendations concerning the establishment of a working group as well as the matters to be referred to it. The Delegation stressed the need to conform PCT requirements to those in the Patent Law Treaty, in particular with regard to filing date requirements.

22. The representative of FICPI recognized that the backlog which International Authorities were currently facing needed to be addressed, but believed that the current timeframe for the establishment and publication of international search reports should not be revised. There were other means to address the current situation, such as appointing more International Searching and Preliminary Examining Authorities as well as sub-contracting international search and preliminary examination work to Offices of other PCT Contracting States, which did not act in such capacities, but that did, or could have, the necessary resources to perform these tasks.

23. The Assembly

(i) took note of the report of the first session of the Committee on Reform of the PCT contained in document PCT/R/1/26, and

(ii) unanimously approved the Committee's recommendations concerning the establishment of a working group, the matters to be referred to the working group, and the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly, as set out, respectively, in paragraphs 67 and 68, 69 to 75, and 205 of the Committee's report.

IMPACT Project and PCT Electronic Filing Project Status Reports

24. Discussions were based on document PCT/A/30/3.

25. The Delegation of Mexico stated that it was very pleased to see the progress on both projects, noting especially the importance of the electronic filing project to the Mexican Institute of Industrial Property. The Delegation also noted that the electronic filing project represented the first step of what the International Bureau had promised to developing countries during the negotiation of the Patent Law Treaty so as to allow them to be ready to handle electronic filings by 2005.

26. The Delegation of Cuba thanked the International Bureau for the progress on these projects, and noted, in particular, that access to information was very important for developing countries. It hoped that such progress would continue in the future.

27. The Delegation of Israel noted that the Israel Patent Office attached great importance to its membership in the IMPACT External User Focus Group. The Delegation congratulated the International Bureau and the IMPACT Project Team for the excellent work they had carried out in the development of the new system for the electronic communication of PCT-related documents, and noted that this new system met all of its needs and expectations.

28. The Delegation of the Republic of Korea expressed its hope that implementation of the IMPACT Project would take place as planned.

29. The Assembly took note of the progress reports on the IMPACT Project and the PCT Electronic Filing Project contained in document PCT/A/30/3.

Proposed Modifications of Time Limits Fixed in Article 22(1) of the PCT

30. Discussions were based on documents PCT/A/30/4 and PCT/A/30/4 Add.

31. The Delegation of Brazil, while stating that it was not opposed to the proposal, emphasized that the quality of PCT search and examination results needed to be improved. One had to consider the implications of the proposal on developing countries like Brazil which were making considerable efforts to reduce their backlog in examination of patent applications and to provide improved services to users. The Delegation was concerned that, while the proposal would resolve, in the short term, the problem faced by International Preliminary Examining Authorities, it might cause other problems for countries like Brazil which relied heavily on international preliminary examination reports. Further consideration would be needed if the current growth rate in PCT filings were to continue. The Delegation was also concerned about the effect of the delayed issuance of those reports. In particular, the proposal would have the effect of extending the period of legal uncertainty in respect of third parties and could prevent investors from making decisions until they received the results of substantive national examination. Even though many PCT applicants made use of

international preliminary examination only in order to “buy time,” many others used international preliminary examination reports as a basis for deciding whether and where to enter the national phase. One result of the proposed amendment might be an increase in the number of applications which entered the national phase without international preliminary examination reports, which would result in national Offices having to bear the full burden of examination as to patentability.

32. The Delegation of Mexico expressed its support for the proposal since it was necessary to maintain and even improve the quality of international preliminary examination reports which were an essential element of the Mexican patent system. The Delegation stated that the proposal represented a first step towards definitive reform of the PCT system.

33. The Delegation of Algeria supported the proposal, stating that it would benefit small and medium-sized enterprises, especially those in developing countries, since it would give them more time to decide whether or not to enter the national phase.

34. The Delegation of India, speaking on behalf of the Asian Group, expressed support for the proposal, but noted that the implications for developing countries and small Offices had to be understood and that such Offices would in all likelihood need appropriate supplemental assistance under WIPO's program and budget.

35. The Delegation of Bulgaria, speaking on behalf of the Central European and Baltic States, expressed full support for the proposal, not only because it contained advantages for all users but also in the light of the proposed transitional measures.

36. The Delegation of Venezuela, speaking on behalf of the PCT Contracting States which are members of the Group of Latin American and Caribbean Countries, expressed its gratitude for the willingness of the International Bureau to provide additional information concerning the possible impact of the proposal on the countries in the region. The Group, while supporting the proposal, wished to emphasize the following points: first, this type of change should not constitute a precedent; second, the decision to adopt the proposal should not prejudice the ongoing PCT reform process; and third, possible repercussions of the proposal on small Offices should be carefully considered, bearing in mind that it was difficult to assess the long term effects.

37. The Delegation of Azerbaijan, speaking on behalf of the Central Asian, Caucasus and Eastern European Countries, supported the proposal.

38. The Delegation of Switzerland stated that, in view of the current situation, any measure aimed at reducing the workload of International Authorities should be welcomed. The Delegation strongly supported the proposal and considered it an urgent measure intended to improve the operation of the PCT. While recognizing the necessity to have a wide-ranging discussion on improvements in the PCT system, the Delegation noted that a short-term solution was by all means necessary. The Delegation noted that the envisaged reform could lead to a decrease in the number of international preliminary examination reports by about 30%, but that should not be a drawback for national Offices. Finally, the Delegation added that the proposal would not reduce transparency and legal certainty for third parties, noting that the time limit for the publication of international search reports had not been modified.

39. The Delegation of France agreed with the views of the Delegation of Switzerland and added that the current exercise was in fact bringing the law into conformity with users'

practice. The proposal would not affect the right of applicants to enter the national phase before the end of the 30-month period. This measure was probably not sufficient to alleviate the current situation, but other solutions could be examined by the working group on reform of the PCT. In any case, new technologies should be increasingly used in the establishment of international preliminary examination reports and their communication to applicants.

40. Speaking on behalf of Group B, the Delegation of France recalled that Group B had already pledged its support for the proposal to modify the time limits fixed in Article 22(1) of the PCT in a statement made earlier under another agenda item.

41. The Delegation of Saint Lucia, speaking also on behalf of the Delegation of Antigua and Barbuda, expressed its sympathy for the views of the Delegation of Brazil and stated that it could support the proposal under the conditions expressed by the Delegation of Venezuela on behalf of the Group of Latin American and Caribbean Countries. The Delegation stressed the need to take into account the particular situation of countries, such as Saint Lucia and Antigua and Barbuda, which did not have the technical means to assess the implications of such a modification of time limits, noting also that recently adopted patent legislation provided for reliance on international preliminary examination reports.

42. The Delegation of Slovakia supported the proposal, noting that the fact that most Slovak applicants chose the Chapter II procedure was a sign that the time limit of 30 months had proven to be more user-friendly than the time limit of 20 months.

43. The representative of the EAPO welcomed the proposal, which would benefit both applicants and International Authorities.

44. The representative of the EPO expressed the EPO's gratitude to the delegations which had expressed support for the proposal. He noted that the applicable time limit for entry into the regional phase before the EPO had already been amended to 31 months from the priority date in all cases (Rule 107 of the Regulations under the European Patent Convention). He emphasized that the true benefit of that amendment could only be achieved through a concerted approach by all Contracting States. In view of the increasing number of filings under the PCT and the rising backlog in Offices, it had become essential that resources of Offices be used optimally. Those applicants who were only interested in "buying time" should not have to comply with the formal requirement of requesting international preliminary examination, and international preliminary examination reports should be established only for those applicants who were truly interested in obtaining them. International search reports, which were at the very heart of the PCT procedure, were of interest to all applicants and therefore had to retain their present quality. With respect to some of the concerns voiced by delegations, the representative of the EPO emphasized three main points. First, many applications did not enter the national phase under PCT Chapter II or, if they did, no amendments were made to the applications in light of the comments contained in the international preliminary examination reports, so that the work done by International Preliminary Examining Authorities was of no benefit in terms of further prosecution of those applications. Second, in respect of those applications which did enter the national phase, not all elected Offices were in a position to readily distinguish between those cases in which the applicant had shown a genuine interest and those where the applicant had merely wanted to "buy time." The result of the proposal, in this connection, would be that elected Offices could be confident that, where international preliminary examination reports were made available, they would be "quality products." Third, the representative recalled that, within the context of PCT reform, there were a number of interesting suggestions which could bring about

significant improvements in the processing of international applications, such as an enhanced international search report which would include an opinion on patentability.

45. The representative of IFIA expressed support for the proposal, which would benefit applicants, especially independent inventors and small and medium-sized enterprises, by providing a *de facto* 30-month priority period. He praised the expeditious manner in which the proposal had been tabled and considered, and asked that similar expeditious treatment be given in the future to reductions of PCT fees for independent inventors and small and medium-sized enterprises.

46. The representative of FICPI queried whether the proposal was in the best interest of the public. The representative noted, however, that some Offices had already unilaterally extended the time limit under Article 22(3), with the effect that users would have to deal with different time limits for different Offices, thereby adding greater complexity and confusion with the risk of errors being made by applicants. The representative observed that it was important that the applicable time limit under Article 22 be harmonized amongst all national and regional Offices.

47. The representative of AIPPI expressed full support for the proposal.

48. The Director General confirmed that all concerns expressed during the discussion were noted and fully understood, and that they would be taken into account in the context of PCT reform as well as in the framework of WIPO's Cooperation for Development Program.

49. The Assembly

(i) unanimously adopted the modifications of the time limits fixed in Article 22(1) of the PCT as set out in Annex II to this report and the amendments of Rule 90*bis* as set out in Annex III to this report, and

(ii) unanimously adopted the decisions, as set out in Annex IV to this report, relating to entry into force and transitional arrangements in respect of those provisions.

Appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority; Amendment of the Agreement Between the Spanish Patent and Trademark Office and the International Bureau of WIPO

50. Discussions were based on document PCT/A/30/5.

51. The Delegations of Algeria, Brazil, Equatorial Guinea, Colombia, Sudan, Romania, Costa Rica, China and Sweden supported the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority.

52. The Delegation of Croatia supported the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority. It also noted that the national law of Croatia had recently been modified to allow for the granting of patents by their Office based on the decisions of other Offices; to this end, the Office had concluded agreements with several other Offices, namely, those of Austria, Australia, Japan, China, the Russian Federation, Germany and Sweden, and would conclude further agreements with other Offices in the near future.

53. The Delegation of Ukraine expressed its support for the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority and praised the Office for the excellent work it had performed over the last years as an International Searching Authority.

54. The Delegation of the Netherlands, referring to PCT Articles 16(3)(c) and (e) and 32(3), queried whether the advice of the PCT Committee for Technical Cooperation had been sought prior to the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority. The International Bureau replied that, in 1986, when the United States Patent and Trademark Office, already an International Searching Authority, was appointed as an International Preliminary Examining Authority, the same questions had arisen, and the Assembly had concluded that it was not necessary, before making the proposed appointment, to seek the advice of the PCT Committee for Technical Cooperation (see document PCT/A/XIV/3). This was because such advice had been sought in connection with the appointment of the United States Patent and Trademark Office as an International Searching Authority. The International Bureau believed that the same procedure should be followed in the present instance since the situation was the same.

55. The Delegation of Azerbaijan supported the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority. In reply to a question raised by that Delegation on the differences in the amounts of certain fees charged by International Preliminary Examining Authorities, the International Bureau pointed out that, under the PCT, the amounts of the fees contained in Annexes C of the Agreements were fixed unilaterally by the Authorities concerned.

56. The Delegation of the Republic of Korea supported the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority, stressing the importance of this appointment for Spanish-speaking applicants and expressing its hope that it would also significantly reduce the workload of the European Patent Office as International Preliminary Examining Authority.

57. The Delegation of Ecuador welcomed the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority and referred to its close linguistic and cultural ties to Spain.

58. The Delegation of Cuba expressed full support for the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority and emphasized the importance of this decision for Spanish-speaking countries.

59. The Delegation of Mexico expressed full support for the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority, praising the Office for its excellent work and noting the importance of this decision for the whole PCT system. The Delegation referred to the tight links in the field of technical cooperation between the Mexican Institute of Industrial Property and the Spanish Patent and Trademark Office and stressed the relevance of the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority for Latin American countries.

60. The Delegation of Morocco expressed full support for the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority, noting the close ties between the Moroccan and Spanish Offices based on a cooperation agreement.

61. The Director General informed the Assembly that the Spanish Patent and Trademark Office had been implementing a project on technical cooperation with Latin American countries, focusing on patent procedures, especially those concerning the PCT. This initiative was presented in the framework of the 9th Iberoamerican Summit of Heads of States and Presidents of Governments, held in 1999 in Havana. The Director General noted the Spanish Patent and Trademark Office's initiative which funded on-the-job training programs for patent examiners from Spanish-speaking Latin American countries, with an overall objective of promoting and improving use of the PCT system. The project encompassed training programs covering receiving Office functions, international search and the roles of designated and elected Offices under the PCT. It was expected that the project would include training on procedures relating to international preliminary examination once the Spanish Patent and Trademark Office became an International Preliminary Examining Authority. The Director General cited this initiative as an example of fruitful cooperation, stating that it contributed positively to better use of the PCT, industrial property in general and development of human resources.

62. The Delegation of Spain thanked the Assembly for its support. The Delegation noted that the Spanish Patent and Trademark Office had acted as an International Searching Authority since 1993, which benefited not only the Iberoamerican States party to the PCT but also the PCT system in general. The Delegation referred to the cooperation agreement on international search between the European Patent Office, the Swedish Patent Office and the Spanish Patent and Trademark Office. The Delegation stated that the experience acquired by the Spanish Patent and Trademark Office, both as an International Searching Authority and, since the introduction of national examination, in the national granting procedure, qualified the Office to obtain the status of an International Preliminary Examining Authority.

63. The Assembly

(i) unanimously appointed the Spanish Patent and Trademark Office as International Preliminary Examining Authority, with effect as indicated in paragraph 4 of document PCT/A/30/5, and

(ii) unanimously approved the text of the amended Agreement between the Spanish Patent and Trademark Office and the International Bureau, as set out in Annex V to this report.

Amendment of the Agreement Between the European Patent Organisation and the International Bureau of WIPO Relating to the Functioning of the European Patent Office as an International Searching and Preliminary Examining Authority under the PCT

64. Discussions were based on document PCT/A/30/6.

65. The representative of the EPO referred to the fact that the universal competence of the EPO as an International Searching and Preliminary Examining Authority had significantly contributed to the great success of the PCT, with however the consequence that the EPO was now performing an increasingly disproportionate share of international searches and preliminary examinations (61% and 58%, respectively, in 2000). Taking into account the minimum of 10% annual growth rate in filings experienced over several years, and even 23% in 2000, the expected continued strain on the EPO could easily be understood, as well as the

effect such growth rates had on the ability of the EPO to cope with its obligation of ensuring timely processing of patent applications under the European Patent Convention and granting of European patents. On the latter point, the EPO faced growing criticism from applicants in respect of Euro-direct applications, more than 50% of which originated from outside Europe, noting the strict time limits provided under the PCT for performing search and preliminary examination work. The EPO was therefore proposing a modest change to the Agreement which would allow it to restrict its competence as an International Searching and Preliminary Examining Authority for a limited period: (i) to applicants from Contracting States of the European Patent Convention and to applicants from States whose national Offices did not act as an International Searching and Preliminary Examining Authority, or (ii) in respect of certain technical fields, or (iii) in respect of the number of international applications concerned. The representative of the EPO confirmed that the proposed amendment to the Agreement would not affect the current situation with regard to those applicants whose national Offices did not act as International Searching and Preliminary Examining Authorities; indeed, the EPO would continue to act for those applicants.

66. The Delegation of Algeria supported the proposed amendment and expressed its understanding for the EPO's concerns, noting that applicants were suffering from the workload situation and the consequential delays in issuance of reports. Furthermore, with delayed reports, applicants were also at a disadvantage in the context of registration systems, such as in Algeria. Other solutions could be found in the framework of PCT reform. The Delegation expressed the hope that the EPO would in the future be in a position to return to its universal competence.

67. The Assembly unanimously approved the text of the amended Agreement between the European Patent Organisation and the International Bureau, as set out in Annex VI to this report.

[Annexes follow]

ANNEX I

AMENDMENT OF
THE REGULATIONS UNDER THE PCTSCHEDULE OF FEES
(with effect from January 1, 2002)

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 Swiss francs
(b) if the international application contains more than 30 sheets	650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	140 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 5 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	140 Swiss francs per designation
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

4. The total amount of the fees payable under items 1 and 2(a) is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.
5. All fees payable (where applicable, as reduced under item 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[Annex II follows]

ANNEX II

MODIFICATIONS OF ARTICLE 22
OF THE PCT

Article 22

Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 30 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 30 months from the priority date.

(2) Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).

(3) Any national law may, for performing the acts referred to in paragraphs (1) or (2), fix time limits which expire later than the time limit provided for in those paragraphs.

[Annex III follows]

ANNEX III

AMENDMENTS OF RULE 90*bis*
OF THE REGULATIONS UNDER THE PCT

Rule 90*bis*
Withdrawals

90bis.1 Withdrawal of the International Application

(a) The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date.

(b) and (c) [No change]

90bis.2 Withdrawal of Designations

(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90*bis*.4.

(b) to (e) [No change]

90bis.3 Withdrawal of Priority Claims

(a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 30 months from the priority date.

(b) to (e) [No change]

90bis.4 to 90bis.7 [No change]

[Annex IV follows]

ANNEX IV

DECISIONS RELATING TO ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

(1) The modifications of the time limits fixed in Article 22(1) set out in Annex II shall, subject to paragraphs (2) and (3), enter into force on April 1, 2002. The modifications shall apply, so far as any designated Office is concerned, to any international application in respect of which the period of 20 months from the priority date expires on or after the date on which the modifications enter into force in respect of that Office and in respect of which the acts referred to in Article 22(1) have not yet been performed by the applicant.

(2) If, on October 3, 2001, any such modification is not compatible with the national law applied by a designated Office, it shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office notifies the International Bureau accordingly by January 31, 2002. The notification shall be promptly published by the International Bureau in the Gazette.

(3) Any notification sent to the International Bureau under paragraph (2) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette and the modifications shall enter into force two months after the date of such publication or on such earlier or later date as may be indicated in the notice of withdrawal.

(4) It is recommended that any Contracting State whose national law is not compatible with the modifications take urgent action to amend its law to make it compatible so that a notification does not have to be given under paragraph (2) or, if such a notification must be given, so that it can be withdrawn under paragraph (3) as soon as possible thereafter.

(5) The amendments of Rule 90*bis* set out in Annex III shall enter into force on April 1, 2002.

[Annex V follows]

ANNEX V

AMENDED AGREEMENT
BETWEEN THE SPANISH PATENT AND TRADEMARK OFFICE
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to the functioning of the Spanish Patent and Trademark Office
as an International Searching Authority and
International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Spanish Patent and Trademark Office and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of October 1, 1997, under Article 16(3)(b) of the Patent Cooperation Treaty in relation to the functioning of the Spanish Patent and Trademark Office as an International Searching Authority under the Patent Cooperation Treaty entered into force on January 1, 1998, and will remain in force until December 31, 2007,

Considering Article 32(3) of the Patent Cooperation Treaty in relation to the functioning of national Offices and intergovernmental organizations as International Preliminary Examining Authorities under the Patent Cooperation Treaty,

Desirous to continue the functioning of the Spanish Patent and Trademark Office as an International Searching Authority and to start its functioning as an International Preliminary Examining Authority, under the Patent Cooperation Treaty,

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
- (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Spanish Patent and Trademark Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2

Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3

Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement, that, where applicable, the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4

Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5

Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its function as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6 **Classification**

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7 **Languages of Correspondence Used by the Authority**

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8 **International-Type Search**

The Authority shall carry out international-type searches to the extent decided by it.

Article 9 **Entry into Force**

This Agreement, as amended, shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is ready to start functioning as an International Preliminary Examining Authority.

Article 10 **Duration and Renewability**

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the Authority gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the Authority written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at Geneva, this third day of October 2001, in two originals in the English and Spanish languages, each text being equally authentic.

For the Spanish Patent and
Trademark Office by:

For the International Bureau by:

José López Calvo
Director General
Spanish Patent and Trademark Office

Kamil Idris
Director General
World Intellectual Property Organization

Annex A
Languages

Under Article 3 of the Agreement, the Authority specifies the following language:

Spanish.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination is the following:

all subject matter searched or examined in Spanish national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Spanish pesetas)	Amount (Euros)
Search fee (Rule 16.1(a))	157,235 ¹	945 ¹
Additional fee (Rule 40.2(a))	157,235 ¹	945 ¹
Preliminary examination fee (Rule 58.1(b))	78,860	473.96
Additional fee (Rule 68.3(a))	78,860	473.96
Cost of copies (Rules 44.3(b) and 71.2(b))		
– national documents, per document	610	3.67
– foreign documents, per document	859	5.16
Cost of copies (Rule 94.2) per document	37	0.22

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search, 25%, 50%, 75% or 100% of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

¹ This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person and is a national of and resides in a State not party to the European Patent Convention, which fulfils the requirements for the corresponding reduction of certain PCT fees as specified in the Schedule of Fees annexed to the PCT Regulations (see also corresponding footnote to the Annex C(IB) and *PCT Gazette* No. 50/1995, pages 19233 and 19234), and in accordance with the decision of the EPO's Administrative Council of October 11, 2000 (OJ EPO 2000, 446).

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following language:

Spanish.

[Annex VI follows]

ANNEX VI

AMENDED AGREEMENT
BETWEEN THE EUROPEAN PATENT ORGANISATION
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to the functioning of the European Patent Office
as an International Searching Authority and
International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The European Patent Organisation and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of October 1, 1997, under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty, as well as Articles 154 and 155 of the European Patent Convention, in relation to the functioning of the European Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty was concluded for a period of 10 years from January 1, 1998, to December 31, 2007,

Desirous to continue the functioning of the European Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty,

Hereby agree as follows:

Article 1
Terms and Expressions

(1) For the purposes of this Agreement:

- (a) “Treaty” means the Patent Cooperation Treaty;
- (b) “Regulations” means the Regulations under the Treaty;
- (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
- (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
- (e) “Rule” means a Rule of the Regulations;
- (f) “Contracting State” means a State party to the Treaty;
- (g) “the Authority” means the European Patent Office;
- (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization;
- (i) “Convention” means the Convention on the Grant of European Patents (European Patent Convention).

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3

Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that, for such application, the international search is or has been performed by the Authority or the industrial property Office of a State party to the Convention and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

(4)(a) Notwithstanding paragraphs (1) and (2), if the work load of the Authority reaches such a level that, because of its then existing facilities, it cannot perform the tasks assumed by it under this Agreement without risks for its proper functioning under the Convention, the Authority may

(i) entrust any industrial property Office of a State party to the Convention with work in respect of international search or international preliminary examination to be carried out under the responsibility of the Authority;

(ii) notify the International Bureau either that it will not carry out international search or international preliminary examination or both in respect of international applications filed with any receiving Office of or acting for a State whose nationals or residents may choose that Office acting as an International Searching and/or International Preliminary Examining Authority or that it will carry out international search or international preliminary examination or both in respect of such international applications but only for a given number of applications each year or only in respect of certain fields of technology.

(b) Any limitation under subparagraph (a)(ii) shall take effect on the date agreed upon between the receiving Office and the Authority and specified in the notification, provided that that date is at least one month later than the date on which the notification is received by the International Bureau. If such a date is not agreed upon by the receiving Office and the Authority, the limitation shall take effect three months from the date of receipt of the notification by the Authority to the International Bureau. The International Bureau shall promptly publish in the Gazette any notification under this subparagraph.

(c) The initial duration of any limitation under subparagraph (a)(ii) shall not exceed a period of three years and may be extended one or more times for a period not exceeding two years provided that notice of three months is given prior to the expiration of the preceding period.

Article 4

Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates

to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5

Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6

Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7

Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8

International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9

Entry into Force

This Agreement, as amended, shall enter into force on November 1, 2001.

Article 10

Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the President of the European Patent Office; they shall take effect on the date agreed upon by them.

(3) The President of the European Patent Office may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the European Patent Organisation gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the European Patent Organisation written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at Geneva, this _____, in two originals in the English, French and German languages, each text being equally authentic.

For the European Patent Organisation by:

For the International Bureau by:

Ingo Kober
President
European Patent Office

Kamil Idris
Director General
World Intellectual Property Organization

Annex A
Languages

Under Article 3 of the Agreement, the Authority specifies the following languages:

English, French, German, and, where the receiving Office is the industrial property Office of Belgium or the Netherlands, Dutch.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under the European patent grant procedure in application of the equivalent provisions of the Convention.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Euro)
Search fee (Rule 16.1(a))	945 ¹
Additional fee (Rule 40.2(a))	945 ¹
Preliminary examination fee (Rule 58.1(b))	1,533 ¹
Additional fee (Rule 68.3(a))	1,533 ¹
Protest fee (Rules 40.2(e) and 68.3(e))	1,022
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1), per page	0.60

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall, upon request, be fully refunded.

(3) Where the Authority benefits from an earlier search (including a privately commissioned “standard” search) already made by the Authority on an application whose priority is claimed for the international application, the following refund of the search fee shall be made:

(i) no supplementary search performed: refund of 100%;

¹ This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person and is a national of and resides in a State not party to the European Patent Convention, which fulfils the requirements for the corresponding reduction of certain PCT fees as specified in the Schedule of Fees annexed to the PCT Regulations (see also corresponding footnote to the Annex C(IB) and *PCT Gazette* No. 50/1995, pages 19233 and 19234), and in accordance with the decision of the EPO’s Administrative Council of October 11, 2000 (OJ EPO 2000, 446).

- (ii) supplementary search performed in the documentation relating to one or more subdivisions consulted in the earlier search or extended to one or more subdivisions not yet consulted: refund of 75%;
 - (iii) supplementary search performed in the documentation relating to one or more subdivisions already consulted and extended to one or more subdivisions not yet consulted: refund of 50%;
 - (iv) supplementary search performed in the documentation relating to subdivisions concerning a new aspect of the invention claimed (for instance, cases where the international application is based on several earlier applications only one of which was the subject of an earlier search report): refund of 25%.
- (4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.
- (5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, 75% of the preliminary examination fee paid shall be refunded.

Annex D

Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

English, French or German, depending on the language in which the international application is filed or translated.

[End of Annex and of document]

WIPO



WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PCT/A/31/10
ORIGINAL: English
DATE: October 1, 2002

E

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Thirty-First (18th Extraordinary) Session
Geneva, September 23 to October 1, 2002**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/37/1 Prov.3): 1, 2, 5, 7, 8, 9, 12, 18, 23 and 24.
2. The report on the said items, with the exception of item 18, is contained in the General Report (A/37/14).
3. The report on item 18 is contained in the present document.
4. Mr. Jørgen Smith (Norway), the current Chair of the Assembly, presided over the session.

ITEM 18 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Appointment of the Canadian Commissioner of Patents as an International Searching and Preliminary Examining Authority Under the PCT; Approval of the Corresponding Agreement

5. Discussions were based on documents PCT/A/31/1 and 1 Add.1, and PCT/CTC/20/5.
6. The Chair noted that the PCT Committee for Technical Cooperation (PCT/CTC) had, at its twentieth session held from September 23 to October 1, 2002 (see document PCT/CTC/20/5, paragraph 25), unanimously recommended to the Assembly that the Canadian Commissioner of Patents be appointed as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA).
7. In response to an invitation by the Chair, the Delegation of Canada referred to the statement it had made before the PCT/CTC (see document PCT/CTC/20/5, paragraphs 12 to 15 and 24).
8. In response to a question from the Delegation of Sudan, which was in favor of the proposed Agreement, the International Bureau clarified that the Agreement would be terminated before December 2007 only in extraordinary situations, and that the body which would settle possible disputes between the parties would be the Assembly.
9. The Assembly:
 - (i) approved the text of the Agreement between the Canadian Commissioner of Patents and the International Bureau as set out in Annex I to this report; and
 - (ii) appointed the Canadian Commissioner of Patents as ISA and IPEA with effect from the entry into force of said Agreement.
10. The Delegation of Canada, on behalf of the Government of Canada, expressed its gratitude to the Assembly for granting the Commissioner of Patents the status of an ISA and IPEA. It pointed out that the Canadian Intellectual Property Office had a highly qualified, competent and growing number of patent examiners. It also had a modern and efficient automated patent processing system as well as a vast collection of patent documents and on-line resources; it also had an organizational commitment to the pursuit of excellence in client service delivery. Canada was looking forward to working with WIPO and all of its Member States in the pursuit of improved services in industrial property Offices around the world. The anticipated commencement of the new services would be in the summer of 2004.

Appointment of the National Board of Patents and Registration of Finland as an International Searching and Preliminary Examining Authority Under the PCT

11. Discussions were based on documents PCT/A/31/2 and PCT/CTC/20/5.

12. The Chair noted that the PCT/CTC had, at its twentieth session held from September 23 to October 1, 2002 (see document PCT/CTC/20/5, paragraph 52), recommended to the Assembly that further consideration of the request by the National Board of Patents and Registration of Finland ("the Finnish Office") for appointment as an ISA and IPEA be deferred until 2003. He stated that no delegation had questioned the right of the Finnish Office to seek appointment as an ISA and IPEA and that compliance by that Office with technical requirements was not at issue; indeed, many delegations had expressed their confidence in the competence and technical capacity of the Finnish Office.

13. In response to an invitation by the Chair, the Delegation of Finland made a short statement on behalf of its government. It welcomed the International Bureau's positive consideration of the Finnish application to be appointed as a PCT International Authority. It recalled that all speakers who participated on this item had stated, during the session of the PCT/CTC, that the Finnish Office had the right to be appointed as International Authority, and had also stated that the Finnish Office had the capacity and ability to be a PCT International Authority. Such statements had been noted by the Finnish Office with great satisfaction. Therefore, the Finnish government was going to continue to pursue this application and expected that it would be decided during the upcoming session of the Assembly.

14. The Assembly deferred further consideration of the request by the Finnish Office for appointment as an ISA and IPEA until 2003.

Amendment of the Agreement Between the Japan Patent Office and the International Bureau of WIPO in Relation to the Functioning of the Japan Patent Office as an International Searching Authority and Preliminary Examining Authority Under the PCT

15. Discussions were based on document PCT/A/31/3.

16. The Assembly unanimously approved the text of the amended Agreement between the Japan Patent Office and the International Bureau, as set out in Annex II to this report.

Report of the Committee on Reform of the PCT: Proposed Amendments of the Regulations Under the PCT

17. Discussions were based on documents PCT/A/31/5, 6, 6 Add.1, 6 Add.2, 6 Add.3 and 9.

18. The representative of the EPO stated that the Assembly had before it a series of proposals which represented the most significant amendments of the PCT since its entry into force. On behalf of the European Patent Organisation, he congratulated the International Bureau on this important step in the PCT reform process.

19. The representative of the EPO noted that the first stage of reform of the PCT hailed the beginning of a process which may well, in due course, go on to consider even more far-reaching changes to the Treaty. He further noted that, over the last 30 years, the Treaty had proved itself to be an outstanding example of international cooperation in the field of industrial property, and had changed the face of patent prosecution at the global level. Many factors had combined to make the PCT the route of choice for the majority of applicants

seeking international patent protection. Its efficiency, legal certainty and attractiveness were the products of step-by-step reforms introduced under the stewardship of WIPO but with the active involvement of the national Offices and, in particular, the leading International Authorities, stemming back to the 1980's, continuing with undiminished energy right up to the present day.

20. Recalling that the proposals for amendment of the PCT Regulations had been thoroughly discussed in the Committee and the Working Group on Reform of the PCT, and also within the European Patent Organisation's Administrative Council and its Committee on Patent Law, the representative of the EPO stated that the proposed amendments would contribute to the originally stated objective of simplifying and improving the PCT system. In particular, the expanded international search system would bring concrete benefits in terms of improved quality for applicants and national Offices, in particular, smaller national Offices, and for developing countries. The expected alleviation of the workload problems would help to free up resources which might be better deployed elsewhere in the system. The EPO was confident that it would be in a position to implement the proposals by the target date, that is, for international applications filed as from January 1, 2004.

21. The representative of the EPO noted that the first stage of PCT reform had certainly led to a number of practical suggestions, and that much more rapid progress had been achieved than might have been thought possible two years ago when the exercise started. The question would now arise as to where to go from here. He expressed the view that much remained to be done, and emphasized that the European Patent Organisation was keen to play its part in shaping a vision for the long-term future.

22. The representative of the EPO stated that ensuring high quality work during the international phase of processing was essential to facilitate national and regional processing, but it also had a direct bearing on the quality of patents ultimately granted by national or regional Offices concerned. He believed that there could be no question of removing decisions from the exclusive competence of each Contracting State; this had never been the aim of the PCT. Sovereign decisions of the Contracting States should have a firm basis in the groundwork done in international processing, which would not only foster improved quality but would also help to ensure equality, since the high standard of work attributed to search and examination should not be the preserve of only a few selected Offices; rather, it should be freely accessible to applicants in all PCT Contracting States. The new expanded international search system would certainly represent a significant improvement in that regard.

23. The representative of the EPO stated that the European Patent Organisation would welcome discussion on quality management mechanisms such as continuing review of the PCT guidelines for international search and international preliminary examination. The representative further stated that, as a consequence, any progress achieved within the Standing Committee on the Law of Patents on harmonization of substantive patent law could only have a positive influence on quality. In fact, the "PCT Partnership" between the EPO and the Spanish and Swedish Offices could serve as a useful model for quality control, since the Partnership had considerable experience in establishing common standards and in joint training and monitoring. The Meeting of International Authorities under the PCT (PCT/MIA) had an important role to play in shaping quality standards. There were, of course, many other possibilities for ensuring greater uniformity and higher quality across the board, some of which were currently given effect within the PCT Partnership, including examiner exchanges

and common working tools and procedures, such as common classifications and common databases.

24. The representative of the EPO further stated that it would be difficult to say whether quality management in this context could be promoted by a more regulatory framework. At the moment, applicants and national Offices had the opportunity to decide where their expectations of quality could best be met. The EPO had certainly enjoyed considerable success in attracting applicants from all over the world. Freedom of choice established a *de facto* benchmark. The European Patent Organisation very much encouraged other Authorities to adopt a similar open and user conscious approach.

25. In summarizing, the representative of the EPO stressed that the European Patent Organisation considered that it had a duty to participate fully in ensuring the proper development of the PCT system. Further development of the PCT would be desirable and, with this in mind, it was of the utmost importance that quality, which was the cornerstone of the system, be maintained and, where possible, improved. The current proposals represented a significant milestone in the reform process; they would simplify and improve the system. The European Patent Organisation fully supported the proposals and underlined its commitment to future reform work.

26. Noting that it was proposed, in paragraph 61 of document PCT/A/31/6, not to change the level of PCT fees in 2003, the Delegation of the United States of America expressed the view that there was no reason to postpone a possible further reduction of PCT fees to a later date. The Delegation repeated the proposal, which it had made during the discussions on the revised program and budget of WIPO for 2002-2003, to reduce the maximum number of designation fees payable to 4 as of January 1, 2003, as had been envisaged by the Assembly at its session last year. The Delegation further requested more detailed information on the proposed amount of the late furnishing fee under Rule 12.3(e) as proposed to be amended and proposed new Rule 12.4(e), and of the late payment fee under Rule 16*bis*.2(b) as proposed to be amended.

27. Responding to the intervention made by the Delegation of the United States of America, the International Bureau confirmed that the Assembly, at its thirtieth (13th ordinary) session held from September 24 to October 3, 2001, had envisaged that a further reduction of the maximum number of designation fees payable from 5 to 4 could take place with effect from January 1, 2003, in line with the business plan and objectives at the time. However, at the time, it had been impossible to predict that PCT reform would proceed as fast as it had and that, as one of the results of the discussions on PCT reform, the designation system and, as a consequence, the system of designation fees would in practice be abolished. Against this background, it was felt that a review of the fee structure and possible reductions of fees should best be undertaken, in the context of the necessary determination of the amount of the new international filing fee, in the course of preparing the program and budget of WIPO for 2004-2005.

28. With regard to the proposed amount of the late furnishing fee under Rule 12.3(e) as proposed to be amended and proposed new Rule 12.4(e), and of the late payment fee under Rule 16*bis*.2(b) as proposed to be amended, the International Bureau explained that, upon reflection, the percentage originally agreed upon in the Committee on Reform of the PCT, namely, 50% of the international filing fee, would have resulted in those fees being much higher than at present, namely, 50% of the basic fee. It was thus proposed to fix the amount at 25% of the international filing fee.

29. The Delegation of Japan expressed its support for the proposed new fee structure and the new international filing fee, but emphasized that, in the context of the necessary review of the fee structure that would take place in the course of preparing the program and budget of WIPO for 2004-2005, care and caution should be exercised in deciding whether to incorporate the handling fee (applicable under Chapter II of the PCT) into the new international filing fee (applicable under Chapter I) (see paragraph 62 of document PCT/A/31/6). The Delegation emphasized the need to ensure that applicants who, under the present system and fee structure, only used the Chapter I procedure would not be disadvantaged by having to pay considerably higher fees than was presently the case under Chapter I.

30. In response to the intervention made by the Delegation of Japan, the International Bureau stated that extensive consultations with all parties involved would take place in the process of preparing a proposal for the new fee structure.

31. Following the explanations given by the International Bureau, the Delegation of the United States of America, speaking on behalf of Group B, stated that Group B had noted the statements of the International Bureau proposing to delay the envisaged reduction of the maximum number of designation fees payable from 5 to 4, which was to bring about a reduction in PCT fees of approximately 8%, and that the International Bureau placed this proposal in the context of various other fee changes and a complete review of the fee structure. The Delegation further stated that Group B stressed its interest in continuing the reduction of PCT fees. Group B accepted the rationale of the International Bureau for the delay, but expected that, once the new fee structure had been elaborated in the course of preparing the program and budget of WIPO for 2004-2005, the new fees should be significantly lower, by a percentage which would represent not only the expected 8 per cent reduction but also a further percentage, in effect to compensate users for the one-year delay.

32. The Delegation of Barbados thanked WIPO for the PCT reform work, noting that the PCT had served Barbados extremely well over the years. While generally in agreement with all of the proposed reforms, and in particular with the proposal to introduce a procedure for establishing an examiner's opinion under Chapter I, the Delegation wished to express some concern about the quality of some of the international preliminary examination reports which Barbados had been receiving recently under Chapter II.

33. The Delegation of Barbados further stated that as a small Office with no substantive examination capacity, the Barbados Intellectual Property Office had always given great weight to the examiner's opinion on patentability contained in international preliminary examination reports. Over the years, those reports had provided to the Office important technical opinions on the basis of which a patent could be granted. However, the Office recently had noted a marked deterioration in the quality of some of the reports that it had received. For example, whereas the Office had grown accustomed to receiving detailed and well-reasoned reports that clearly identified the individual claims in respect of which a patent may or may not be issued, some of the reports received recently had simply indicated, in a mere one or two pages, that patentability criteria had not been met for some or all of the claims, or had only been met in part, without giving much additional information. Obviously, such reports left a small Office like the Barbados Intellectual Property Office with little technical basis or rationale on which to proceed.

34. The Delegation of Barbados expressed its hope that the examiner's opinion on patentability to be established under the new Chapter I proceedings would bear those quality

concerns in mind, and further, that the quality of the international preliminary examination reports under Chapter II would be improved.

35. The Delegation of Barbados noted further that, during the course of the session of the Committee on Reform of the PCT held in July this year, it had been understood that, unlike the current procedure under Chapter II in which the International Preliminary Examining Authority entered into a dialogue with the applicant, the International Searching Authority would not be entertaining a dialogue with the applicant during the course of the establishment of the written opinion on patentability under the proposed new Chapter I proceedings. Noting that some delegations at the Committee meeting had expressed the view that such a dialogue on the written opinion should instead take place during the national phase, the Delegation expressed its concern about the absence of a dialogue during the international phase on the proposed written opinion by the International Searching Authority under Chapter I and noted that the Barbados Intellectual Property Office, having no capacity in technical matters, would be unable to enter into a technical discussion on patentability with the applicant during the national phase. For obvious reasons, this could adversely affect the Office's ability to process international applications in the national phase.

36. The International Bureau confirmed that it was an important part of the proposed amendments that the International Searching Authority would prepare, in respect of all international applications, a written opinion at the same time as the international search report. For applicants, and also for small Offices for whom the opinion contained in the international preliminary examination report was essential, the proposed new Chapter I procedure would provide such opinion in all cases, instead of only about 80 per cent of cases as at present. In respect of quality, the International Bureau noted that certain International Preliminary Examining Authorities were under substantial work pressure and had adopted a truncated system of international preliminary examination as an interim measure; this was not intended to represent a system for the future. The future system aimed at full and high quality opinions.

37. With regard to the dialogue between the applicant and the examiner, the International Bureau stated that, while it would not be practical for such a dialogue to be introduced into the proposed new Chapter I procedure, it would remain one of the essential features of the Chapter II procedure. However, if more Offices, like the Barbados Intellectual Property Office, used international preliminary examination reports effectively, there would be a greater incentive for applicants to use Chapter II, thus reducing duplication of work around the world and increasing the benefits of the PCT system, especially to smaller Offices. In further developments of this aspect of the system, it would be essential that the needs of small Offices be borne particularly in mind.

38. The Delegation of South Africa requested clarification on when the single international filing fee was to be introduced and on the new role of the International Searching Authorities, the effect of which should be monitored by the International Bureau and by the Assembly.

39. The International Bureau, in response to the above request, explained that the single international filing fee was a consequence of the amendments proposed in Annex II of document PCT/A/31/6, which would come into effect on January 1, 2004. The new fee structure, including the amount of the new international filing fee and possible fee reductions, would be considered in the course of preparing the program and budget of WIPO for 2004-2005. The enhanced international search and preliminary examination procedure had been discussed in great detail by the Committee and Working Group on Reform of the PCT. The

changes were radical but represented an enhancement of the system, both for applicants and for Offices.

40. The Delegation of China noted that there were differences between the new system and existing Chinese law in respect of the possibilities for late entry into the national phase and concerning priority documents and that, consequently, China would need to take advantage of the transitional reservation provisions. The Delegation welcomed the development of digital libraries and hoped that WIPO would be able to accelerate the process of their creation. Furthermore, the Delegation expressed the wish for a clear medium- and long-term plan for future work on reform of the PCT so as to enable Offices to consult with users of the system on particular proposals.

41. The International Bureau proposed the following minor corrections to the text appearing in Annex II of document PCT/A/31/6, in addition to the amendments appearing in document PCT/A/31/6 Add.3:

(i) in Rule 16*bis*.1(c), since item (i) was deleted, items (ii) and (iii) should be renumbered as (i) and (ii), respectively (see document PCT/A/31/6, Annex II, page 14);

(ii) in Rule 47.2, since items (b) and (c) were deleted, leaving only (a), the letter “(a)” at the beginning of the paragraph should be deleted (see document PCT/A/31/6, Annex II, page 31);

(iii) in the title of Rule 60, since the part of the Rule relating to later elections had been deleted, the words “or Elections” should be deleted from the title (see document PCT/A/31/6, Annex II, page 44);

(iv) Rule 78.3, which was not mentioned in document PCT/A/31/6, should be indicated as remaining unchanged (see document PCT/A/31/6, Annex II, page 57);

(v) in item 1 of the Schedule of Fees set out on page 64 of Annex II to document PCT/A/31/6, the current amount of the basic fee (650 Swiss francs) should be indicated (rather than a blank space (“[...]”)) as the amount of the international filing fee, and a footnote should be added, stating that the fee structure and the amounts of the fees were subject to further consideration, and including a reference to paragraph 50 of this report.

42. With regard to the proposed amendment of the Schedule of Fees annexed to the Regulations under the PCT, set out in Annex I to document PCT/A/31/9 (fee reduction for international applications filed in electronic form), the Delegation of Japan stated that it strongly supported the proposal. Noting the advantages of electronic filing for applicants and the benefits for Offices resulting from a streamlined handling of international applications filed in fully electronic form, the Delegation stressed the importance of promoting electronic filing and of giving applicants an incentive to file international applications in electronic form in the form of a fee reduction.

43. The Delegation of France stated that it also supported the proposal set out in Annex I to document PCT/A/31/9, agreeing with the views expressed by the Delegation of Japan, and noting that Offices would greatly benefit from the exchange of information in fully electronic form, including priority documents.

44. The Assembly:

(i) took note of the report of the second session of the Committee on Reform of the PCT contained in document PCT/R/2/9 and reproduced in Annex II to document PCT/A/31/5;

(ii) unanimously approved the Committee's recommendations concerning the language-related filing date requirements of the Patent Law Treaty and the proposed amendments of certain Rules relating to the right of priority and priority claims, as set out, respectively, in paragraphs 92 and 125 of the Committee's report;

(iii) unanimously approved the Committee's recommendations concerning the work program in connection with reform of the PCT to be undertaken between the September 2002 and September 2003 sessions of the Assembly, including the matters to be considered, the convening of sessions of the Working Group and possibly the Committee, and financial assistance to enable attendance of certain delegations, as set out, respectively, in paragraphs 135 and 136, 140(i) and 140(ii) of the Committee's report.

45. The Assembly unanimously adopted:

(i) the amendments of the Regulations under the PCT contained in Annexes III, IV and V;

(ii) the decisions contained in Annex VI relating to entry into force and transitional arrangements in respect of those amendments.

46. In connection with amended Rules 36.1 and 63.1, the Assembly noted that those provisions as amended would require that any future appointment by the Assembly of an Office or organization as an International Searching Authority and an International Preliminary Examining Authority would need to be simultaneous.

47. The Assembly agreed that no special provision should be included in the Regulations to enable the applicant to comment on the written opinion of the International Searching Authority. Any formal response to the written opinion of the International Searching Authority would need to be submitted to the International Preliminary Examining Authority under Article 34 as part of the Chapter II procedure, that is, by requesting international preliminary examination. Under the Chapter I procedure, the applicant could, however, submit comments on an informal basis to the International Bureau. Such informal comments would be sent by the International Bureau to all designated Offices and made publicly available, as would be, under proposed new Rule 44*ter*, the report resulting from the written opinion of the International Searching Authority. Designated Offices would be free to require a translation of such comments. The main purpose of allowing for informal comments to be submitted would be to give the applicant an opportunity to rebut the written opinion of the International Searching Authority in the event that international preliminary examination was not requested.

48. In connection with new Rule 44*bis* and amended Rule 70, the Assembly agreed that the titles "international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)" and "international preliminary report on patentability (Chapter II

of the Patent Cooperation Treaty)” were not in conflict with Article 35(2), since such reports would not, as provided by that Article, “contain any statement on the question whether the claimed invention was or seemed to be patentable or unpatentable according to any national law.” Rather, the report would be limited to a statement, in relation to each claim, as to whether the claim appeared to satisfy the criteria of novelty, inventive step and industrial applicability as defined for the purposes of the international phase under the PCT (see Article 33 and Rules 64 and 65).

49. In connection with amended Rules 17.1(b-*bis*) and (d), 66.7(a) and 93*bis*.1(b), the Assembly noted that details of the system for making documents available via digital libraries would be governed by the Administrative Instructions, the necessary modifications of which would, under Rule 89.2(b), be the subject of consultation with interested Offices and Authorities, and agreed that it would be necessary to ensure that those Offices and Authorities found the proposed system acceptable before the modifications were promulgated.

50. In connection with amended Rule 15 and the Schedule of Fees, the Assembly agreed that, as a consequence of the change in the fee structure, the amount of the new international filing fee would be determined in the course of preparing the program and budget of WIPO for 2004-2005, taking into consideration the proposed level of budgetary resources, including reserve requirements, as outlined in document PCT/A/31/6, paragraphs 59 to 61.

51. The Assembly agreed that consideration should be given to incorporating the handling fee (see Rule 57 and the Schedule of Fees) into the new international filing fee, and that proposed amendments of the Regulations should be prepared by the International Bureau accordingly and submitted to the Assembly in 2003 for consideration in conjunction with the fixing of the amount of the international filing fee.

Common Quality Framework

52. Discussions were based on document PCT/A/31/8.

53. In introducing document PCT/A/31/8, the Delegation of the United Kingdom stated that the successful Roundtable held earlier this week had considered the growth in the number of patent applications and the burden this was placing on Offices around the world. The importance of issuing high quality patents had been emphasized. Increased demand and scarce resources made the achievement of that objective increasingly difficult.

54. The Delegation of the United Kingdom pointed to the progress made in agreeing on reforms of the PCT procedure which should enable better use of the international phase and a reduction in the duplication of effort involved in the way Offices work. The Delegation pointed out that there was a need for further substantive harmonization before States could reap the full rewards of an approach of “one search - one examination - many grants.” But something else needed to be done, which would not only give confidence but also help identify where further harmonization was needed and also where it was not needed: that “something else” was the construction of a quality management system providing a quality framework which was both transparent and objective. There were a number of ways in which this could be achieved, some of which were identified in the document; the European Patent Organisation, in its earlier statement, which was supported by the Delegation of the United

Kingdom, had identified others. The essential matter was recognizing the importance of quality levels. The Delegation referred to the earlier intervention of the Delegation of Barbados, which identified the importance of high quality reports for smaller Offices.

55. The Delegation of the United Kingdom emphasized that the transparency required of the system was such that quality must be publicly validated. Patent Offices might have the technical skills and systems to be confident of their own quality, but users and other stakeholders needed that confidence too. The Delegation stated that this could be provided by including monitoring and feedback in the system. The United Kingdom's Patent Office had chosen to use the International Organization for Standardization (ISO) quality standard, and such principles could well be applicable to the PCT system. However, the Delegation was not calling for a detailed and final decision on how to deal with the matter; rather, the question of a quality framework should be discussed by the Committee or the Working Group on Reform of the PCT as part of the program for future reform. The Delegation of the United Kingdom stated its intention to play a full and constructive role in this effort.

56. The Delegation of Denmark fully endorsed the proposal submitted by the United Kingdom. In the context of European discussions, Denmark had for many years argued that qualified resources in national patent Offices should be used, for instance, in dealing with backlogs, but only if a quality management system were created in such a way that users could feel sure that the work performed by such Offices was of the required quality. In this connection, Denmark had commissioned reports from an international consulting company which described how a quality system could be established. The Delegation had given a copy of those reports to the International Bureau in the hope that they would provide some inspiration in the future work related to quality.

57. The Delegation of Australia strongly endorsed the proposal submitted by the United Kingdom. There were significant improvements to be made and a quality framework would play an important part. Offices around the world were struggling to keep up with an ever-increasing workload, and various suggestions had been put forward as to how this problem could be addressed. Given that many applicants filed applications for the same invention in a number of countries, and that those applications were then assessed against virtually the same criteria in each national Office, there should be ways of avoiding the duplication of effort currently occurring in Offices. The PCT system went some way towards addressing that situation by allowing for the filing of a single application which was then subjected to a single international search and possibly a single preliminary examination. However, it seemed that there was still considerable duplication of effort between Offices, even in the processing of PCT applications.

58. The Delegation of Australia stated that it believed that there should be only a single search and examination for applications around the world for the same invention. National Offices would do only the additional work necessary to ensure that applications met the requirements of national law. This could not be achieved unless Offices had confidence in the work performed by other Offices. One way of gaining that confidence would be to conduct "benchmarking" exercises among Offices, focusing on particular aspects of the patent process. IP Australia and the United Kingdom Patent Office had conducted formal benchmarking exercises involving the comparison of searches carried out on a number of applications across a range of technologies. As a result of those exercises, both Offices had been able to build confidence in the searches performed by one another, as well as to gain a greater understanding of their internal processes. The Delegation believed that similar exercises could provide greater understanding of common areas of practice, so that Offices

could assess the extent to which work done by other Offices was equivalent to work done domestically. An Office could then determine what, if any, other work was required to meet domestic requirements.

59. The Delegation of Australia pointed out that such benchmarking exercises could be time-consuming and costly. However, it was not necessary for Offices to conduct separate exercises if a common quality framework for the conduct of search and examination could be established. That framework would need to be based on recognized quality standards that were clear and transparent for both Offices and users of the system, together with procedures to assess and maintain quality. A possible starting point might be to adopt an internationally recognized standard for quality, such as the ISO 9000:2000 standard. Any Office that could demonstrate that it met the quality standard would be able to participate. As a result, all Offices, irrespective of whether or not they participated, could have confidence in the work done by the participating Offices.

60. The Delegation of Australia felt that an important issue in adopting any quality standard was to determine the level of quality required. It was possible to set the level so high that many Offices would be unable to achieve it without significant expenditure of resources, and consequent additional costs to users of the system. On the other hand, if the level were too low, some Offices would not have confidence in the work performed by other Offices, which would also damage user confidence. Benchmarking exercises could be used as one way of determining the standard. A possible starting point could be to include quality standards for search and examination in the PCT guidelines for international search and international preliminary examination.

61. The Delegation of the United States of America stated that, while it fully supported the proposal submitted by the United Kingdom to add a quality framework to the PCT system, it had a concern about the proposed role for WIPO in taking “an overview” (as outlined in document PCT/A/31/8, paragraph 9). The Delegation believed that the matter should be discussed in the context of the revision of the PCT guidelines on international search and international preliminary examination, and that the discussion should preferably be undertaken by PCT/MIA.

62. The Delegation of Japan expressed its satisfaction with the progress and the results achieved so far in reforming the PCT system. Noting the great importance of high quality international search and international preliminary examination reports, the Delegation stated that it fully supported the proposal by the United Kingdom, which should be further discussed within the context of PCT reform by either the Committee or the Working Group on Reform of the PCT.

63. The Delegation of the Netherlands wholeheartedly endorsed the proposal of the United Kingdom to develop a program for sustained quality and efficiency. The Delegation agreed with the proposal that quality standards for search and examination should be set out for Offices that wished to be appointed as International Searching and Preliminary Examining Authorities. The Delegation noted that a quality system based on the notion that “the higher the standard, the lower the number of applications for patent protection that will be granted protection” would effectively reduce the workload of Offices in an economic way. The Delegation expressed the view that, from a third party perspective, exclusive rights for a period of 20 years should not be earned too easily.

64. The Delegation believed that the International Bureau might be the most appropriate body to be responsible for the management of a quality control system, setting detailed criteria (to be agreed upon by the Assembly) and forming a group of experts of senior examiners from International Authorities to act as a “watch-dog” in terms of quality control.

65. The Assembly decided to refer the proposal for development of a common quality framework for further discussion by the Working Group on Reform of the PCT.

PCT-SAFE Project Status Report

66. Discussions were based on document PCT/A/31/4 Rev.

67. In introducing the document, the International Bureau provided the Assembly with a brief update on the status of the project.

68. The Delegation of the United States of America stated that it was encouraged with the progress on the PCT-SAFE project and supported continued efforts. The Delegation also expressed its desire for the International Bureau to bring into line Part 7 (relating to electronic filing and processing of international applications) and Part 8 (relating to international applications containing large nucleotide and/or amino acid sequence listings) of the Administrative Instructions under the PCT.

69. The Delegation of Cuba thanked the International Bureau for the progress made on this project, and noted the positive experience, since 2000, of applicants filing international applications with the Cuban Office, using the PCT-EASY software. The Delegation also noted that access to technology was very important for developing countries and that the different levels of technological development among developing countries had to be taken into account. The Delegation expressed the wish that the International Bureau would make Public Key Infrastructure (PKI) technology available to developing countries via the WIPONET services, considering the high cost of that technology.

70. The Assembly took note of the status report on the PCT-SAFE Project contained in document PCT/A/31/4 Rev.

IMPACT Project Status Report

71. Discussions were based on document PCT/A/31/7.

72. In introducing the document, the International Bureau provided the Assembly with a brief update on the status of the project.

73. The Assembly took note of the status report on the IMPACT Project contained in document PCT/A/31/7.

PCT minimum documentation

74. Discussions were based on documents PCT/CTC/20/4 and 5.

75. The Assembly took note of the contents of document PCT/CTC/20/4 and of the unanimous recommendation of the PCT/CTC, made at its twentieth session held from September 23 to October 1, 2002 (see document PCT/CTC/20/5, paragraph 10), and requested the Meeting of International Authorities under the PCT (PCT/MIA) to undertake the study proposed in that document and to make recommendations to the PCT/CTC on proposed modifications of Rule 34 and proposed mechanisms for reviewing and maintaining the non-patent literature part of the PCT minimum documentation.
76. The Delegation of Malaysia noted that the PCT had indeed eased the filing of patent applications throughout the world and that member countries were beginning to reap the benefits of the PCT system. The PCT reduced the cost of filing and thus encouraged patent owners to seek protection in more countries. In realizing the importance of providing wider protection for national industries in a globalized world, the Delegation wished to inform the Assembly that Malaysia was making final preparations for accession to the PCT and hoped to become a member of the PCT Union at the earliest possible time. It, however, emphasized that it was seeking WIPO's assistance towards making the accession of Malaysia to the PCT a success.
77. The Delegation of the Republic of Moldova thanked the International Bureau for the detailed analysis of the current state of patent-related matters, contained in the document provided, and also for devising a new overview based on principles for the future of the international patent system. The Republic of Moldova supported the initiatives proposed by WIPO, which would be implemented at the same time as substantive patent law was harmonized and together with the reform of the PCT. In order for work in this field to be more effective, the Delegation was of the view that it was essential to take steps, as a matter of priority, to implement the program. The Delegation further stated that the Republic of Moldova would support and participate in all the events held by WIPO for this purpose. In addition, the Delegation drew attention to the ongoing need for retraining of the staff of national offices, since, without good technical staff, the project to enhance the international patent system could not be carried out. This matter could be addressed within the framework of the WIPO Worldwide Academy, the European Patent Office (EPO), the Eurasian Patent Office (EAPO) and other regional patent offices.
78. Following the announcement by the Director General that Mr. Gary Smith, Senior Director of the Office of the PCT, would be leaving WIPO in October, the Assembly and the Chair expressed their thanks and best wishes to Mr. Smith.

[Annex I follows]

ANNEX I

AGREEMENT
BETWEEN THE CANADIAN COMMISSIONER OF PATENTS
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to
the functioning of the Canadian Commissioner of Patents
as an International Searching Authority
and International Preliminary Examining Authority
Under the Patent Cooperation Treaty

Preamble

The Canadian Commissioner of Patents and the International Bureau of the World Intellectual Property Organization,

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Canadian Commissioner of Patents;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided

under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement, and, where applicable, that the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4 *Subject Matter Not Required to Be Searched or Examined*

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5 *Fees and Charges*

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its function as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6 *Classification*

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7 *Languages of Correspondence Used by the Authority*

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8 *International-Type Search*

The Authority shall carry out international-type searches to the extent decided by it.

Article 9 *Entry into Force*

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is prepared to start functioning as an International Searching Authority and as an International Preliminary Examining Authority.

Article 10 *Duration and Renewability*

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the Canadian Commissioner of Patents gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the Canadian Commissioner of Patents written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at Geneva, this [...] day of [...], in two originals in the English and French languages, each text being equally authentic.

For the Canadian Commissioner of Patents:
by:

For the International Bureau:
by:

(signature)
David Tobin
Canadian Commissioner of Patents

(signature)
Kamil Idris
Director General
World Intellectual Property Organization

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

(i) the following States:

Canada, and the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations;

(ii) the following languages:

English, French.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter which is searched or examined under the Canadian patent grant procedure.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Canadian dollars)</i>
Search fee (Rule 16.1(a))	[...]
Additional fee (Rule 40.2(a))	[...]
Preliminary examination fee (Rule 58.1(b))	[...]
Additional fee (Rule 68.3(a))	[...]
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1)	[...]

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search, [*percentages under consideration*] of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

English, French.

[Annex II follows]

ANNEX II

AMENDED AGREEMENT
BETWEEN THE JAPAN PATENT OFFICE
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to
the functioning of the Japan Patent Office
as an International Searching Authority and
International Preliminary Examining Authority
Under the Patent Cooperation Treaty

Preamble

The Japan Patent Office and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of October 1, 1997, under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty in relation to the functioning of the Japan Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty was concluded for a period of 10 years from January 1, 1998, to December 31, 2007,

Desirous to continue the functioning of the Japan Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty,

Hereby agree as follows:

Article 1
Terms and Expressions

(1) For the purposes of this Agreement:

- (a) “Treaty” means the Patent Cooperation Treaty;
- (b) “Regulations” means the Regulations under the Treaty;
- (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
- (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
- (e) “Rule” means a Rule of the Regulations;
- (f) “Contracting State” means a State party to the Treaty;
- (g) “the Authority” means the Japan Patent Office;
- (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it

considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement, as amended, shall enter into force upon approval by the Assembly of the International Patent Cooperation Union and subsequent signature.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the Authority gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the Authority written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at Geneva, this _____, in two originals in the English and Japanese languages, each text being equally authentic.

For the Japan Patent Office by:

For the International Bureau by:

(signature)
(name)
(function)
Japan Patent Office

(signature)
Kamil Idris
Director General
World Intellectual Property Organization

*Annex A
States and Languages*

Under Article 3 of the Agreement, the Authority specifies:

(i) the following States, so far as Article 3(1) is concerned:

Japan and any State that the Authority will specify;

(ii) the following States, so far as Article 3(2) is concerned:

where the Authority has prepared the international search report, Japan and any State the Authority will specify;

(iii) the following languages:

Japanese, English.

*Annex B
Subject Matter Not Excluded from Search or Examination*

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined in Japanese national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Japanese yen)</i>
Search fee (Rule 16.1(a))	72,000
Additional fee (Rule 40.2(a))	63,000
Preliminary examination fee (Rule 58.1(b))	28,000
Additional fee (Rule 68.3(a))	18,000
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1), per document	1,400

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the Authority benefits from an earlier search to a considerable extent, the amount of 29,000 Japanese yen shall be refunded, upon request.

(3) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(4) As long as the refund of the search fee (in the case where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search) and the refund of the preliminary examination fee (in the case where the international application or the demand is withdrawn before the start of the international preliminary examination) continue not to be compatible with the national law applicable to the Authority, the Authority may abstain from refunding those fees.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Japanese, English.

[Annex III follows]

ANNEX III

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
TO ENTER INTO FORCE ON OCTOBER 17, 2002¹*(fee reduction where international application filed in electronic form)*SCHEDULE OF FEES²

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 Swiss francs
(b) if the international application contains more than 30 sheets	650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	140 Swiss francs per designation provided that any designation made under Rule 4.9(a) in excess of 5 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	140 Swiss francs per designation
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

4. The total amount of the fees payable under items 1 and 2(a) is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed:

- (a) on paper together with a copy thereof in electronic form; or
- (b) in electronic form.

5. All fees payable (where applicable, as reduced under item 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[Annex IV follows]

¹ See Annex VI for details concerning entry into force and transitional arrangements.

² See Annex V for further amendments entering into force on January 1, 2004.

ANNEX IV

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
TO ENTER INTO FORCE ON JANUARY 1, 2003¹

*(language of the international application;
missed time limit for entering the national phase)*

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¹ See Annex VI for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the Regulations.

Rule 12³

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

12.1 Languages Accepted for the Filing of International Applications

(a) and (b) [No change]

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

(d) [No change]

12.2 Language of Changes in the International Application

(a) [No change]

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

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

(ii) [No change]

(c) [No change]

12.3 Translation for the Purposes of International Search

(a) to (d) [No change]

(e) The furnishing of a translation 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 a late furnishing fee equal to 50% of the basic fee referred to in item 1(a) of the Schedule of Fees.

12.4 Translation for the Purposes of International Publication

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

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

(c) Where the applicant has not, within the time limit referred to in paragraph (a), furnished a translation required under that paragraph, the receiving Office shall invite the

³ See Annex V for further amendments entering into force on January 1, 2004.

applicant to furnish the required translation, and to pay, where applicable, the late furnishing fee required under paragraph (e), within 16 months from the priority date. Any translation received by the receiving Office before that Office sends the invitation under the previous sentence shall be considered to have been received before the expiration of the time limit under paragraph (a).

(d) Where the applicant has not, within the time limit under paragraph (c), furnished the required translation and paid any required late furnishing fee, the international application 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 and before the expiration of 17 months from the priority date shall be considered to have been received before the expiration of that time limit.

(e) The furnishing of a translation 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 a late furnishing fee equal to 50% of the basic fee referred to in item 1(a) of the Schedule of Fees.

Rule 22

Transmittal of the Record Copy and Translation

22.1 Procedure

(a) to (g) [No change]

(h) Where the international application is to be published in the language of a translation furnished under Rule 12.3 or 12.4, that translation shall be transmitted by the receiving Office to the International Bureau together with the record copy under paragraph (a) or, if the receiving Office has already transmitted the record copy to the International Bureau under that paragraph, promptly after receipt of the translation.

22.2 [Remains deleted]

22.3 [No change]

Rule 26⁴

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

26.1 and 26.2 [No change]

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

(a) [No change]

(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:

(i) [No change]

⁴ See Annex V for further amendments entering into force on January 1, 2004.

(ii) any translation furnished under Rule 12.3 or 12.4 and the drawings for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

26.3bis to 26.6 [No change]

Rule 29⁵
International Applications or Designations Considered Withdrawn

29.1 *Finding by Receiving Office*

(a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) or 12.4(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) to (iv) [No change]

(b) [No change]

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

Rule 48⁶
International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) [No change]

(b) 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.⁷

(c) [No change]

48.4 to 48.6 [No change]

⁵ See Annex V for further amendments entering into force on January 1, 2004.

⁶ See Annex V for further amendments entering into force on January 1, 2004.

⁷ Paragraph (b) is deleted and paragraph (a-bis) is renumbered as paragraph (b).

Rule 49
Copy, Translation and Fee Under Article 22

49.1 to 49.5 [No change]

49.6 Reinstatement of Rights After Failure to Perform the Acts Referred to in Article 22

(a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, and subject to paragraphs (b) to (e) of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit occurred in spite of due care required by the circumstances having been taken.

(b) The request under paragraph (a) shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within whichever of the following periods expires first:

- (i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or
- (ii) 12 months from the date of the expiration of the applicable time limit under Article 22;

provided that the applicant may submit the request at any later time if so permitted by the national law applicable by the designated Office.

(c) The request under paragraph (a) shall state the reasons for the failure to comply with the applicable time limit under Article 22.

(d) The national law applicable by the designated Office may require:

- (i) that a fee be paid in respect of a request under paragraph (a);
- (ii) that a declaration or other evidence in support of the reasons referred to in paragraph (c) be filed.

(e) The designated Office shall not refuse a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

(f) If, on October 1, 2002, paragraphs (a) to (e) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that designated 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 January 1, 2003. The information received shall be promptly published by the International Bureau in the Gazette.

[Annex V follows]

ANNEX V

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
TO ENTER INTO FORCE ON JANUARY 1, 2004^{1, 2}

*(enhanced international search and preliminary examination system;
concept and operation of the designation system;
availability of priority documents from digital library)*

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¹ The amended provisions appearing in this Annex incorporate the amendments set out in Annex III (Schedule of Fees) and Annex IV (see Rules 12, 26, 29 and 48).

² See Annex VI for details concerning entry into force and transitional arrangements.

³ The Table of Contents is included for convenience; it does not form part of the Regulations.

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Rule 4
The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) The request shall contain:

(i) to (iii) [No change]

(iv) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

(b) The request shall, where applicable, contain:

(i) and (ii) [No change]

(iii) a reference to a parent application or parent patent,

(iv) an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) [No change]

4.2 to 4.4 [No change]

4.5 *The Applicant*

(a) The request shall indicate:

(i) the name,

(ii) the address, and

(iii) the nationality and residence

of the applicant or, if there are several applicants, of each of them.

(b) to (e) [No change]

4.6 to 4.8 [No change]

4.9 *Designation of States; Kinds of Protection; National and Regional Patents*

(a) The filing of a request shall constitute:

(i) the designation of all Contracting States that are bound by the Treaty on the international filing date;

(ii) an indication that the international application is, in respect of each designated State to which Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State;

(iii) an indication that the international application is, in respect of each designated State to which Article 45(1) applies, for the grant of a regional patent and also, unless Article 45(2) applies, a national patent.

(b) Notwithstanding paragraph (a)(i), if, on October 1, 2002, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request may, for as long as that national law continues to so provide, contain an indication that the designation of that State is not made, provided that the designated Office informs the International Bureau by January 1, 2003, that this paragraph shall apply in respect of designations of that State. The information received shall be promptly published by the International Bureau in the Gazette.

(c) *[Deleted]*

4.10 *[No change]*

4.11 *Reference to Earlier Search, Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

- (i) an international or international-type search has been requested on an application under Article 15(5);
- (ii) the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application;
- (iii) the applicant intends to make an indication under Rule 49*bis*.1(a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or
- (iv) the applicant intends to make an indication under Rule 49*bis*.1(c) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or indicate the relevant parent application or parent patent or other parent grant.

(b) The inclusion in the request of an indication under paragraph (a)(iii) or (iv) shall have no effect on the operation of Rule 4.9.

4.12 *[Deleted]*

4.13 *[Deleted]*

4.14 *[Deleted]*

4.14bis to 4.18 [No change]

Rule 12

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

12.1 and 12.2 [No change]

12.3 *Translation for the Purposes of International Search*

(a) to (d) [No change]

(e) The furnishing of a translation 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 a 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.

12.4 *Translation for the Purposes of International Publication*

(a) to (d) [No change]

(e) The furnishing of a translation 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 a 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.

Rule 15

The International Filing Fee

15.1 *The International Filing Fee*

Each international application shall be subject to the payment of a fee for the benefit of the International Bureau (“international filing fee”) to be collected by the receiving Office.

15.2 *Amount*

(a) The amount of the international filing fee is as set out in the Schedule of Fees.

(b) The international filing fee shall be payable in the currency or one of the currencies prescribed by the receiving Office (“prescribed currency”), it being understood that, when transferred by the receiving Office to the International Bureau, it shall be freely convertible into Swiss currency. The amount of the international filing fee shall be established, for each receiving Office which prescribes the payment of that fee in any currency other than Swiss currency, by the Director General after consultation with the receiving Office of, or acting under Rule 19.1(b) for, the State whose official currency is the same as the prescribed currency. The amount so established shall be the equivalent, in round figures, of the amount in Swiss currency set out in the Schedule of Fees. It shall be notified by the International

Bureau to each receiving Office prescribing payment in that prescribed currency and shall be published in the Gazette.

(c) Where the amount of the international filing fee set out in the Schedule of Fees is changed, the corresponding amount in the prescribed currencies shall be applied from the same date as the amount set out in the amended Schedule of Fees.

(d) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new amount in the prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after the date of its publication in the Gazette, provided that the receiving Office referred to in the second sentence of paragraph (b) and the Director General may agree on a date falling during the said two-month period, in which case the said amount shall become applicable from that date.

15.3 *[Remains deleted]*

15.4 *Time Limit for Payment; Amount Payable*

The international filing fee shall be paid within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

15.5 *[Deleted]*

15.6 *Refund*

The receiving Office shall refund the international filing fee to the applicant:

(i) to (iii) *[No change]*

Rule 16 **The Search Fee**

16.1 *Right to Ask for a Fee*

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

(f) As to the time limit for payment of the search fee and the amount payable, the provisions of Rule 15.4 relating to the international filing fee shall apply *mutatis mutandis*.

16.2 and 16.3 *[No change]*

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 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.

(b) *[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 (d):

(i) make the applicable declaration under Article 14(3), and⁴

(ii) proceed as provided in Rule 29.⁴

(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), as the case may be.

(e) 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 Late Payment Fee

(a) The payment of fees in response to an invitation under Rule 16bis.1(a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

(b) The amount of the late payment fee shall not, however, exceed the amount of 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.

Rule 17 **The Priority Document**

17.1 Obligation to Submit Copy of Earlier National or International Application

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed ("the priority document"), shall, unless that priority document has already been filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraphs (b) and (b-bis), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that

⁴ Item (i) is deleted and items (ii) and (iii) are renumbered as items (i) and (ii).

Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) [No change]

(b-bis) Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library, the applicant may, as the case may be, instead of submitting the priority document:

- (i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or
- (ii) request the International Bureau to obtain the priority document from such digital library.

Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

(c) If the requirements of none of the three preceding paragraphs are complied with, any designated Office may, subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with it in its capacity as national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

17.2 [No change]

Rule 19

The Competent Receiving Office

19.1 to 19.3 [No change]

19.4 *Transmittal to the International Bureau as Receiving Office*

(a) and (b) [No change]

(c) For the purposes of Rules 14.1(c), 15.4 and 16.1(f), where the international application was transmitted to the International Bureau under paragraph (b), the date of receipt of the international application shall be considered to be the date on which the international application was actually received by the International Bureau. For the purposes of this paragraph, the last sentence of paragraph (b) shall not apply.

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 *[Remains deleted]*

24.2 *Notification of Receipt of the Record Copy*

(a) The International Bureau shall promptly notify:

(i) to (iii) [No change]

of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the designated Offices and, in the case of a designated Office which is responsible for granting regional patents, of the Contracting States designated for such regional patent.

(b) *[Deleted]*

(c) [No change]

Rule 26 **Checking by, and Correcting Before, the Receiving Office of** **Certain Elements of the International Application**

26.1 and 26.2 [No change]

26.2bis *Checking of Requirements Under Article 14(1)(a)(i) and (ii)*

(a) For the purposes of Article 14(1)(a)(i), if there is more than one applicant, it shall be sufficient that the request be signed by one of them.

(b) For the purposes of Article 14(1)(a)(ii), if there is more than one applicant, it shall be sufficient that the indications required under Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who is entitled according to Rule 19.1 to file the international application with the receiving Office.

26.3 to 26.6 [No change]

Rule 27 **Lack of Payment of Fees**

27.1 *Fees*

(a) For the purposes of Article 14(3)(a), “fees prescribed under Article 3(4)(iv)” means: the transmittal fee (Rule 14), the international filing fee (Rule 15.1), the search fee (Rule 16), and, where required, the late payment fee (Rule 16bis.2).

(b) For the purposes of Article 14(3)(a) and (b), “the fee prescribed under Article 4(2)” means the international filing fee (Rule 15.1) and, where required, the late payment fee (Rule 16bis.2).

Rule 29
International Applications Considered Withdrawn

29.1 *Finding by Receiving Office*

If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) or 12.4(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) to (iv) [No change]

(b) [*Deleted*]

29.2 [*Remains deleted*]

29.3 and 29.4 [No change]

Rule 32
**Extension of Effects of International Application to
Certain Successor States**

32.1 *Request for Extension of International Application to Successor State*

(a) The effects of any international application whose international filing date falls in the period defined in paragraph (b) are extended to a State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting State designated in the international application which subsequently ceased to exist (“the predecessor State”), provided that the successor State has become a Contracting State through the deposit, with the Director General, of a declaration of continuation the effect of which is that the Treaty is applied by the successor State.

(b) [No change]

(c) Information on any international application whose filing date falls within the applicable period under paragraph (b) and whose effect is extended to the successor State shall be published by the International Bureau in the Gazette.

(d) [*Deleted*]

32.2 *Effects of Extension to Successor State*

(a) Where the effects of the international application are extended to the successor State in accordance with Rule 32.1,

(i) [No change]

(ii) the applicable time limit under Article 22 or 39(1) in relation to that State shall be extended until the expiration of at least six months from the date of the publication of the information under Rule 32.1(c).

(b) The successor State may fix a time limit which expires later than that provided in paragraph (a)(ii). The International Bureau shall publish information on such time limits in the Gazette.⁵

Rule 36 **Minimum Requirements for International Searching Authorities**

36.1 Definition of Minimum Requirements

The minimum requirements referred to in Article 16(3)(c) shall be the following:

- (i) and (ii) [No change]
- (iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;
- (iv) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

Rule 43bis **Written Opinion of the International Searching Authority**

43bis.1 Written Opinion

(a) Subject to Rule 69.1(b-bis), the International Searching Authority shall, at the same time as it establishes the international search report, establish a written opinion as to:

- (i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;
- (ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority.

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.2(a), (b) and (e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

(c) The written opinion shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion shall, under Rule 66.1bis(a) but subject to Rule 66.1bis(b), be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a), in which case the applicant is invited to submit to that Authority, before the expiration of the time limit under Rule 54bis.1(a), a written reply together, where appropriate, with amendments.

⁵ Paragraph (b) is deleted and paragraph (c) is renumbered as paragraph (b).

Rule 44
Transmittal of the International Search Report, Written Opinion, Etc.

44.1 Copies of Report or Declaration and Written Opinion

The International Searching Authority shall, on the same day, transmit one copy 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), to the International Bureau and one copy to the applicant.

44.2 and 44.3 [No change]

Rule 44bis
**International Preliminary Report on Patentability by
the International Searching Authority**

44bis.1 Issuance of Report

(a) Unless an international preliminary examination report has been or is to be established, the International Bureau shall issue a report on behalf of the International Searching Authority (in this Rule referred to as “the report”) as to the matters referred to in Rule 43bis.1(a). The report shall have the same contents as the written opinion established under Rule 43bis.1.

(b) The report shall bear the title “international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)” together with an indication that it is issued under this Rule by the International Bureau on behalf of the International Searching Authority.

44bis.2 Communication to Designated Offices

(a) Where a report has been issued under Rule 44bis.1, the International Bureau shall communicate it to each designated Office in accordance with Rule 93bis.1 but not before the expiration of 30 months from the priority date.

(b) Where the applicant makes an express request to a designated Office under Article 23(2), the International Bureau shall communicate a copy of the written opinion established by the International Searching Authority under Rule 43bis.1 to that Office promptly upon the request of that Office or of the applicant.

44bis.3 Translation for Designated Offices

(a) Any designated State may, where a report has been issued under Rule 44bis.1 in a language other than the official language, or one of the official languages, of its national Office, require a translation of the report into English. Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

(b) If a translation is required under paragraph (a), it shall be prepared by or under the responsibility of the International Bureau.

(c) The International Bureau shall transmit a copy of the translation to any interested designated Office and to the applicant at the same time as it communicates the report to that Office.

(d) In the case referred to in Rule 44bis.2(b), the written opinion established under Rule 43bis.1 shall, upon request of the designated Office concerned, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to the designated Office concerned within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

44bis.4 Observations on the Translation

The applicant may make written observations as to the correctness of the translation referred to in Rule 44bis.3(b) or (d) and shall send a copy of the observations to each of the interested designated Offices and to the International Bureau.

Rule 44ter **Confidential Nature of Written Opinion, Report, Translation and Observations**

44ter.1 Confidential Nature

(a) The International Bureau and the International Searching Authority shall not, unless requested or authorized by the applicant, allow access by any person or authority before the expiration of 30 months from the priority date:

(i) to the written opinion established under Rule 43bis.1, to any translation thereof prepared under Rule 44bis.3(d) or to any written observations on such translation sent by the applicant under Rule 44bis.4;

(ii) if a report is issued under Rule 44bis.1, to that report, to any translation of it prepared under Rule 44bis.3(b) or to any written observations on that translation sent by the applicant under Rule 44bis.4.

(b) For the purposes of paragraph (a), the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication.

Rule 47 **Communication to Designated Offices**

47.1 Procedure

(a) The communication provided for in Article 20 shall be effected by the International Bureau to each designated Office in accordance with Rule 93bis.1 but, subject to Rule 47.4, not prior to the international publication of the international application.

(a-bis) The International Bureau shall notify each designated Office, in accordance with Rule 93bis.1, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document.

(a-ter) [No change]

(b) Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication provided for in Article 20 shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

(c) The International Bureau shall, promptly after the expiration of 28 months from the priority date, send a notice to the applicant indicating:

(i) the designated Offices which have requested that the communication provided for in Article 20 be effected under Rule 93*bis*.1 and the date of such communication to those Offices; and

(ii) the designated Offices which have not requested that the communication provided for in Article 20 be effected under Rule 93*bis*.1.

(c-*bis*) The notice referred to in paragraph (c) shall be accepted by designated Offices:

(i) in the case of a designated Office referred to in paragraph (c)(i), as conclusive evidence that the communication provided for in Article 20 was effected on the date specified in the notice;

(ii) in the case of a designated Office referred to in paragraph (c)(ii), as conclusive evidence that the Contracting State for which that Office acts as designated Office does not require the furnishing, under Article 22, by the applicant of a copy of the international application.

(d) [No change]

(e) Where any designated Office has not, before the expiration of 28 months from the priority date, requested the International Bureau to effect the communication provided for in Article 20 in accordance with Rule 93*bis*.1, the Contracting State for which that Office acts as designated Office shall be considered to have notified the International Bureau, under Rule 49.1(a-*bis*), that it does not require the furnishing, under Article 22, by the applicant of a copy of the international application.

47.2 Copies

The copies required for communication shall be prepared by the International Bureau. Further details concerning the copies required for communication may be provided for in the Administrative Instructions.

(b) [*Deleted*]

(c) [*Deleted*]

47.3 [No change]

47.4 *Express Request Under Article 23(2) Prior to International Publication*

Where the applicant makes an express request to a designated Office under Article 23(2) prior to the international publication of the international application, the

International Bureau shall, upon request of the applicant or the designated Office, promptly effect the communication provided for in Article 20 to that Office.

Rule 48
International Publication

48.1 to 48.5 [No change]

48.6 *Announcing of Certain Facts*

(a) If any notification under Rule 29.1(ii) reaches the International Bureau at a time later than that at which it was able to prevent the international publication of the international application, the International Bureau shall promptly publish a notice in the Gazette reproducing the essence of such notification.

(b) *[Remains deleted]*

(c) [No change]

Rule 49bis
Indications as to Protection Sought for Purposes of National Processing

49bis.1 *Choice of Certain Kinds of Protection*

(a) If the applicant wishes the international application to be treated, in a designated State in respect of which Article 43 applies, as an application not for the grant of a patent but for the grant of another kind of protection referred to in that Article, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office.

(b) If the applicant wishes the international application to be treated, in a designated State in respect of which Article 44 applies, as an application for the grant of more than one kind of protection referred to in Article 43, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office and shall indicate, if applicable, which kind of protection is sought primarily and which kind is sought subsidiarily.

(c) In the cases referred to in paragraphs (a) and (b), if the applicant wishes the international application to be treated, in a designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition, the applicant, when performing the acts referred to in Article 22, shall indicate the relevant parent application, parent patent or other parent grant.

(d) If the applicant wishes the international application to be treated, in a designated State, as an application for a continuation or a continuation-in-part of an earlier application, the applicant, when performing the acts referred to in Article 22, shall so indicate to the designated Office and shall indicate the relevant parent application.

(e) Where no express indication under paragraph (a) is made by the applicant when performing the acts referred to in Article 22 but the national fee referred to in Article 22 paid by the applicant corresponds to the national fee for a particular kind of protection, the payment of that fee shall be considered to be an indication of the wish of the applicant that the international application is to be treated as an application for that kind of protection and the designated Office shall inform the applicant accordingly.

49bis.2 Time of Furnishing Indications

(a) No designated Office shall require the applicant to furnish, before performing the acts referred to in Article 22, any indication referred to in Rule 49bis.1 or, where applicable, any indication as to whether the applicant seeks the grant of a national patent or a regional patent.

(b) The applicant may, if so permitted by the national law applicable by the designated Office concerned, furnish such indication or, if applicable, convert from one kind of protection to another, at any later time.

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 20.7(i), 24.2(c) or 29.1(ii).

51.2 and 51.3 [No change]

Rule 51bis
Certain National Requirements Allowed Under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iv) [No change]

(v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time;

(vi) the confirmation of the international application by the signature of any applicant for the designated State who has not signed the request;

(vii) any missing indication required under Rule 4.5(a)(ii) and (iii) in respect of any applicant for the designated State.

(b) to (f) [No change]

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

Rule 52
**Amendment of the Claims, the Description, and the Drawings,
Before Designated Offices**

52.1 Time Limit

(a) In any designated State in which processing or examination starts without special request, the applicant shall, if he so wishes, exercise the right under Article 28 within one

month from the fulfillment of the requirements under Article 22, provided that, if the communication under Rule 47.1 has not been effected by the expiration of the time limit applicable under Article 22, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any later time if so permitted by the national law of the said State.

(b) [No change]

Rule 53 **The Demand**

53.1 to 53.3 [No change]

53.4 *The Applicant*

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply *mutatis mutandis*.

53.5 and 53.6 [No change]

53.7 *Election of States*

The filing of a demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty.

53.8 and 53.9 [No change]

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:

(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) 22 months from the priority date.

(b) Any demand made after the expiration of the time limit applicable under paragraph (a) shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

Rule 56 **[Deleted]**

Rule 57 **The Handling Fee**

57.1 and 57.2 [No change]

57.3 Time Limit for Payment; Amount Payable

(a) Subject to paragraphs (b) and (c), the handling fee shall be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later.

(b) Subject to paragraph (c), where the demand was transmitted to the International Preliminary Examining Authority under Rule 59.3, the handling fee shall be paid within one month from the date of receipt by that Authority or 22 months from the priority date, whichever expires later.

(c) Where, in accordance with Rule 69.1(b), the International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search, that Authority shall invite the applicant to pay the handling fee within one month from the date of the invitation.

(d) The amount of the handling fee payable shall be the amount applicable on the date of payment.

57.4 and 57.5 [Remain deleted]

57.6 Refund

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

(i) [No change]

(ii) if the demand is considered, under Rule 54.4 or 54bis.1(b), not to have been submitted.

Rule 58bis
Extension of Time Limits for Payment of Fees

58bis.1 Invitation by the International Preliminary Examining Authority

(a) Where the International Preliminary Examining Authority finds:

(i) that the amount paid to it is insufficient to cover the handling fee and the preliminary examination fee; or

(ii) by the time they are due under Rules 57.3 and 58.1(b), that no fees were paid to it;

the Authority shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 58bis.2, within a time limit of one month from the date of the invitation.

(b) to (d) [No change]

58bis.2 [No change]

Rule 59
The Competent International Preliminary Examining Authority

59.1 and 59.2 [No change]

59.3 *Transmittal of the Demand to the Competent International Preliminary Examining Authority*

(a) and (b) [No change]

(c) Where the demand is transmitted to the International Bureau under paragraph (a) or submitted to it under paragraph (b), the International Bureau shall promptly:

(i) [No change]

(ii) if two or more International Preliminary Examining Authorities are competent, invite the applicant to indicate, within the time limit applicable under Rule 54bis.1(a) or 15 days from the date of the invitation, whichever is later, the competent International Preliminary Examining Authority to which the demand should be transmitted.

(d) to (f) [No change]

Rule 60
Certain Defects in the Demand

60.1 *Defects in the Demand*

(a) Subject to paragraphs (a-bis) and (a-ter), if the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(a-bis) For the purposes of Rule 53.4, if there are two or more applicants, it shall be sufficient that the indications referred to in Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who has the right according to Rule 54.2 to make a demand.

(a-ter) For the purposes of Rule 53.8, if there are two or more applicants, it shall be sufficient that the demand be signed by one of them.

(b) to (g) [No change]

60.2 *[Deleted]*

Rule 61
Notification of the Demand and Elections

61.1 *Notification to the International Bureau and the Applicant*

(a) and (b) [No change]

(c) *[Deleted]*

61.2 *Notification to the Elected Offices*

(a) [No change]

(b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the filing date of the application whose priority is claimed (where priority is claimed) and the date of receipt by the International Preliminary Examining Authority of the demand.

(c) [No change]

(d) Where the applicant makes an express request to an elected Office under Article 40(2) prior to the international publication of the international application, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect the communication provided for in Article 20 to that Office.

61.3 [No change]

61.4 *Publication in the Gazette*

The International Bureau shall, promptly after the filing of the demand but not before the international publication of the international application, publish in the Gazette information on the demand and the elected States concerned, as provided in the Administrative Instructions.

Rule 62

Copy of the Written Opinion by the International Searching Authority and of Amendments Under Article 19 for the International Preliminary Examining Authority

62.1 *Copy of Written Opinion by International Searching Authority and of Amendments Made Before the Demand Is Filed*

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

(i) a copy of the written opinion established under Rule 43bis.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and

(ii) a copy of any amendment under Article 19, and any statement referred to in that Article, unless that Authority has indicated that it has already received such a copy.

62.2 [No change]

Rule 62bis

Translation for the International Preliminary Examining Authority of the Written Opinion of the International Searching Authority

62bis.1 *Translation and Observations*

(a) Upon request of the International Preliminary Examining Authority, the written opinion established under Rule 43bis.1 shall, when not in English or in a language accepted

by that Authority, be translated into English by or under the responsibility of the International Bureau.

(b) The International Bureau shall transmit a copy of the translation to the International Preliminary Examining Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

(c) The applicant may make written observations as to the correctness of the translation and shall send a copy of the observations to the International Preliminary Examining Authority and to the International Bureau.

Rule 63

Minimum Requirements for International Preliminary Examining Authorities

63.1 Definition of Minimum Requirements

The minimum requirements referred to in Article 32(3) shall be the following:

(i) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iv) that Office or organization must hold an appointment as an International Searching Authority.

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 [No change]

66.1bis Written Opinion of the International Searching Authority

(a) Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43*bis*.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) shall not apply to the procedure before it in respect of written opinions established under Rule 43*bis*.1 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.

(c) Where the written opinion established by the International Searching Authority under Rule 43*bis*.1 is not, by virtue of a notification under paragraph (b), considered to be a written opinion of the International Preliminary Examining Authority for the purposes of

Rule 66.2(a), the International Preliminary Examining Authority shall notify the applicant accordingly in writing.

(d) A written opinion established by the International Searching Authority under Rule 43bis.1 which is not, by virtue of a notification under paragraph (b), considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a) shall nevertheless be taken into account by the International Preliminary Examining Authority in proceeding under Rule 66.2(a).

66.2 Written Opinion of the International Preliminary Examining Authority

(a) to (c) [No change]

(d) The notification shall fix a time limit for the reply. The time limit shall be reasonable under the circumstances. It shall normally be two months after the date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. It shall, subject to paragraph (e), not be more than three months after the said date.

(e) The time limit for replying to the notification may be extended if the applicant so requests before its expiration.

66.3 to 66.6 [No change]

66.7 Copy and Translation of Earlier Application Whose Priority is Claimed

(a) If the International Preliminary Examining Authority needs a copy of the earlier application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1, and if that earlier application was not filed with that Authority in its capacity as a national Office or the priority document is not available to that Authority from a digital library in accordance with the Administrative Instructions, the international preliminary examination report may be established as if the priority had not been claimed.

(b) [No change]

66.8 and 66.9 [No change]

Rule 69
Start of and Time Limit for International Preliminary Examination

69.1 Start of International Preliminary Examination

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of all of the following:

(i) the demand;

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

provided that the International Preliminary Examining Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54bis.1(a) unless the applicant expressly requests an earlier start.

(b) If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes and subject to paragraphs (d) and (e), start at the same time as the international search.

(b-bis) Where, in accordance with paragraph (b), the national Office or intergovernmental organization that acts as both International Searching Authority and International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search and considers that all of the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organization need not, in its capacity as International Searching Authority, establish a written opinion under Rule 43bis.1.

(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) it has received a copy of any amendments made under Article 19;
- (ii) 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 54bis.1(a).

(e) [No change]

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

- (i) 28 months from the priority date; or
- (ii) six months from the time provided under Rule 69.1 for the start of the international preliminary examination; or

(iii) six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2.

Rule 70
International Preliminary Report on Patentability by
the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 to 70.14 [No change]

70.15 *Form; Title*

(a) The physical requirements as to the form of the report shall be prescribed by the Administrative Instructions.

(b) The report shall bear the title “international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty)” together with an indication that it is the international preliminary examination report established by the International Preliminary Examining Authority.

70.16 and 70.17 [No change]

Rule 72
Translation of the International Preliminary Examination Report and of the Written
Opinion of the International Searching Authority

72.1 and 72.2 [No change]

72.2bis *Translation of the Written Opinion of the International Searching Authority*
Established Under Rule 43bis.1

In the case referred to in Rule 73.2(b)(ii), the written opinion established by the International Searching Authority under Rule 43bis.1 shall, upon request of the elected Office concerned, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to the elected Office concerned within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

72.3 *Observations on the Translation*

The applicant may make written observations as to the correctness of the translation of the international preliminary examination report or of the written opinion established by the International Searching Authority under Rule 43bis.1 and shall send a copy of the observations to each of the interested elected Offices and to the International Bureau.

Rule 73
Communication of the International Preliminary Examination Report
or the Written Opinion of the International Searching Authority

73.1 [No change]

73.2 *Communication to Elected Offices*

(a) The International Bureau shall effect the communication provided for in Article 36(3)(a) to each elected Office in accordance with Rule 93*bis*.1 but not before the expiration of 30 months from the priority date.

(b) Where the applicant makes an express request to an elected Office under Article 40(2), the International Bureau shall, upon the request of that Office or of the applicant,

(i) if the international preliminary examination report has already been transmitted to the International Bureau under Rule 71.1, promptly effect the communication provided for in Article 36(3)(a) to that Office;

(ii) if the international preliminary examination report has not been transmitted to the International Bureau under Rule 71.1, promptly communicate a copy of the written opinion established by the International Searching Authority under Rule 43*bis*.1 to that Office.

(c) Where the applicant has withdrawn the demand or any or all elections, the communication provided for in paragraph (a) shall nevertheless be effected, if the International Bureau has received the international preliminary examination report, to the elected Office or Offices affected by the withdrawal.

Rule 76 **Copy, Translation and Fee Under Article 39(1);** **Translation of Priority Document**

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 *[No change]*

76.5 *Application of Rules 22.1(g), 47.1, 49, 49bis and 51bis*

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

(i) to (iii) *[No change]*

(iv) for the purposes of Article 39(1), where an international preliminary examination report has been established, a translation of any amendment under Article 19 shall only be required if that amendment is annexed to that report;

(v) the reference in Rule 47.1(a) to Rule 47.4 shall be construed as a reference to Rule 61.2(d).

76.6 *[Deleted]*

Rule 78
**Amendment of the Claims, the Description, and the Drawings,
Before Elected Offices**

78.1 *Time Limit*

(a) The applicant shall, if he so wishes, exercise the right under Article 41 to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfillment of the requirements under Article 39(1)(a), provided that, if the transmittal of the international preliminary examination report under Article 36(1) has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any later time if so permitted by the national law of the said State.

(b) In any elected State in which the national law provides that examination starts only on special request, the national law may provide that the time limit within or the time at which the applicant may exercise the right under Article 41 shall be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under paragraph (a).

78.2 *[Deleted]*

78.3 *[No change]*

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

89bis.1 and 89bis.2 *[No change]*

89bis.3 *Communication Between Offices*

Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, notification, communication, correspondence or other document by one national Office or intergovernmental organization to another, such communication may, where so agreed by both the sender and the receiver, be effected in electronic form or by electronic means.

Rule 90
Agents and Common Representatives

90.1 *[No change]*

90.2 *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a “common agent”) under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 and in respect of whom all indications required under Rule 4.5(a) have been provided may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office and in respect of whom all indications required under Rule 4.5(a) have been provided shall be considered to be the common representative of all the applicants.

90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) to (c) [No change]

(d) Subject to paragraph (e), any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement under paragraph (b) that a separate power of attorney be submitted to it, in which case paragraph (c) shall not apply.

(e) Where the agent or the common representative submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4, the requirement under paragraph (b) for a separate power of attorney shall not be waived under paragraph (d).

90.5 and 90.6 [No change]

Rule 90bis Withdrawals

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

(a) Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, subject to paragraph (b), be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, subject to paragraph (b), not be entitled to sign such a notice on behalf of the other applicants.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and

(i) and (ii) [No change]

(iii) in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with.

90bis.6 and 90bis.7 [No change]

Rule 92bis
Recording of Changes in Certain Indications
in the Request or the Demand

92bis.1 Recording of Changes by the International Bureau

(a) [No change]

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date.

Rule 93bis
Manner of Communication of Documents

93bis.1 Communication on Request; Communication via Digital Library

(a) Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, notification, communication, correspondence or other document (“document”) by the International Bureau to any designated or elected Office, such communication shall be effected only upon request by the Office concerned and at the time specified by that Office. Such request may be made in relation to individually specified documents or a specified class or classes of documents.

(b) A communication under paragraph (a) shall, where so agreed by the International Bureau and the designated or elected Office concerned, be considered to be effected at the time when the International Bureau makes the document available to that Office in electronic form in a digital library, in accordance with the Administrative Instructions, from which that Office is entitled to retrieve that document.

Rule 94
Access to Files

94.1 Access to the File Held by the International Bureau

(a) [No change]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 and Rule 44ter.1, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

(c) The International Bureau shall, if so requested by an elected Office, furnish copies of the international preliminary examination report under paragraph (b) on behalf of that Office. The International Bureau shall promptly publish details of any such request in the Gazette.

94.2 and 94.3 [No change]

SCHEDULE OF FEES⁶

Fees	Amounts
1. International Filing Fee: (Rule 15.2)	650 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling Fee: (Rule 57.2)	233 Swiss francs

Reductions

3. The international filing fee is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed:

- (a) on paper together with a copy thereof in electronic form; or
- (b) in electronic form.

4. All fees payable (where applicable, as reduced under item 3) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[Annex VI follows]

⁶ The fee structure and the amounts of the fees are subject to further consideration; see paragraph 50 of this report.

ANNEX VI

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
DECISIONS RELATING TO ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

1. The amendments set out in Annex III shall enter into force on October 17, 2002, and shall apply to any international application whose date of receipt is on or after October 17, 2002.

2. The amendments set out in Annex IV:

(a) shall enter into force on January 1, 2003, and shall apply to any international application whose international filing date is on or after January 1, 2003;

(b) shall not apply to any international application whose international filing date is before January 1, 2003, provided that:

(i) new Rule 49.6(a) to (e) shall, subject to item (iii), apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 22 expires on or after January 1, 2003;

(ii) to the extent that new Rule 49.6(a) to (e) is applicable by virtue of Rule 76.5, the latter Rule shall, subject to item (iii), apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 39(1) expires on or after January 1, 2003;

(iii) where a designated Office informs the International Bureau under paragraph (f) of Rule 49.6 that paragraphs (a) to (e) of that Rule are not compatible with the national law applied by that Office, items (i) and (ii) of this paragraph shall apply in respect of that Office except that each reference in those items to the date January 1, 2003, shall be read as a reference to the date of entry into force of Rule 49.6(a) to (e) in respect of that Office.

3. The amendments set out in Annex V:

(a) shall enter into force on January 1, 2004, and shall apply to any international application whose international filing date is on or after January 1, 2004, provided that:

(i) Rule 15.4 and the Schedule of Fees as worded before their amendment shall continue to apply to any international application which is received by the receiving Office before January 1, 2004, and is accorded an international filing date that is on or after January 1, 2004;

(ii) Rule 47.1(c) and (e) as amended shall apply to any international application whose international filing date is on or after January 1, 2004, in respect of a designated Office which has made a notification under paragraph (2) of the decisions of the Assembly set out in Annex IV of document PCT/A/30/7, and which has not withdrawn that notification under paragraph (3) of those decisions, as though the reference in each of Rule 47.1(c) and (e) to “28 months” was a reference to “19 months,” with the consequence that two notifications under Rule 47.1(c) shall, if applicable, be sent in respect of such an application;

(b) shall not apply to any international application whose international filing date is before January 1, 2004, provided that:

(i) Rules 53.4, 53.7, 60.1, 61.2 and 90*bis*.5(b) as amended, the Rules as amended that are referred to in those Rules and the deletion of Rules 56, 60.2 and 61.1(c) shall apply to any international application in respect of which a demand for international preliminary examination is filed on or after January 1, 2004, whether the international filing date of the international application is before, on or after January 1, 2004;

(ii) new Rule 94.1(c) shall apply to the furnishing on or after January 1, 2004, of copies of the international preliminary examination report in respect of any international application, whether the international filing date of the application is before, on or after January 1, 2004.

[End of Annex VI and of document]

WIPO



PCT/A/32/8

ORIGINAL: English

DATE: October 1, 2003

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Thirty-Second (14th Ordinary) Session
Geneva, September 22 to October 1, 2003**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/39/1): 1, 2, 3, 4, 5, 6, 7, 9, 11, 18, 23, 25 and 26.
2. The report on the said items, with the exception of item 6, is contained in the General Report (document A/39/15).
3. The report on item 6 is contained in the present document.
4. Mr. Ian Heath (Australia) was elected Chair of the Assembly; Mr. Bisereko Kyomuhendo (Uganda) and Mr. Rimvydas Naujokas (Lithuania) were elected Vice-Chairs.
5. Mr. Heath presided over the meeting of the Assembly.

ITEM 6 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Schedule of Fees Annexed to the Regulations Under the PCT; Directives for Establishing New Equivalent Amounts of Certain Fees

6. Discussions were based on documents PCT/A/32/1 and 6.

7. The Director General stated that he had closely followed the important discussion on PCT reform, PCT fees and its impact on the budget process for the coming biennium. He assured the Assembly that WIPO was committed to providing cost-effective and user-friendly services of the PCT. The system was currently in the process of transition. The PCT reform would bring about a number of important changes and services as of early next year. In addition, it was necessary to fix the financial framework of this new phase of operation. He suggested, as a matter of principle, to start this process without a change in the fees charged for the typical PCT application. It seemed that to implement this approach at this stage was difficult, as it was not yet known how the PCT users would adapt their filing strategy to the new arrangement. He therefore recommended a two-step approach to respond to this issue in a flexible manner. First, he suggested the approval of a new PCT fee structure closely linked to the proposals set out in document PCT/A/32/1 with one modification, namely, an international filing fee of 1,400 Swiss francs. Second, he intended to consult with Member States and review the actual usage of the new PCT arrangement. On the basis of this work, he would propose a readjustment of the PCT fee, if necessary, next year.

8. The International Bureau referred to the proposal in the Schedule of Fees according to which the reduction currently applied to natural persons from certain countries, including least developed countries (LDCs), would be extended to legal persons, such as companies, from LDCs. A number of delegations had expressed concern to the International Bureau that this might open up the possibility of exploitation on the part of less scrupulous companies from States which were not LDCs. Having looked closely at this matter, noting Rule 18 of the PCT Regulations which dealt with the concepts of residence and nationality, the International Bureau suggested that the Assembly should proceed, as proposed in document PCT/A/32/1, to extend the reduction to corporations and other legal persons in LDCs. The International Bureau did not think that abuse would be likely to arise, but undertook to monitor the matter carefully over the course of the following 12 months. It would then make further proposals to the Assembly if necessary.

9. The Assembly unanimously adopted the amendments of the Schedule of Fees annexed to the Regulations under the PCT appearing in Annex I to this report and decided that those amendments:

(a) shall enter into force on January 1, 2004, and shall apply to any international application whose international filing date is on or after January 1, 2004, provided that the Schedule of Fees as worded before its amendment (by either the present amendments or by those set out in document PCT/A/31/10, Annex V) shall continue to apply to any international application which is received by the receiving Office before January 1, 2004, and is accorded an international filing date that is on or after January 1, 2004;

(b) shall not apply to any international application whose international filing date is before January 1, 2004, provided that the following provisions shall apply to any international application in respect of which a demand for international preliminary examination is filed on or after January 1, 2004, whether the international filing date of the international application is before, on or after January 1, 2004:

(i) item 2 of the Schedule of Fees as amended; and

(ii) item 4 of the Schedule of Fees as amended, insofar as it relates to the handling fee.

10. The Assembly unanimously adopted the modifications of the directives relating to the establishment of new equivalent amounts of certain fees appearing in Annex II to this report and decided that those modifications shall enter into force on January 1, 2004.

11. The Delegation of the Republic of Korea thanked the International Bureau for the development of the electronic filing system designed to cope with the increasing number of PCT applications in an efficient manner. The Delegation considered that the character coded (XML) format for patent applications would provide the greatest benefits, bringing efficiency in data entry, storage, handling and searching possibilities. Furthermore, it noted that PCT-EASY, the forerunner of this system, offered fewer benefits and less efficiency, requiring the handling and storage of paper, the diskette and the electronic contents of the diskette. Consequently, the Delegation supported the incentive scheme, encouraging applicants to file applications in electronic form, and especially in XML format, by providing differential fee reductions. However, the Delegation noted that the XML-based system was new to most users and that the first application in this format filed with the receiving Office of the International Bureau had been filed only one month ago. The PCT-EASY software remained, among Contracting States, including the Republic of Korea, the most popular electronic means for filing international applications. Consequently, the Delegation was concerned about the change from 200 to 100 Swiss francs in the fee reduction in respect of international applications filed using the PCT-EASY software being applicable from January 1, 2004, just three months from now. The PCT receiving Office of the Republic of Korea would not be ready to accept applications in XML format by that time, and the Delegation would have preferred a transitional period of at least six months in applying the changes in the reduction scheme for PCT applications filed using the PCT-EASY software.

12. The International Bureau noted the particular circumstances described by the Delegation of the Republic of Korea, while emphasizing that introducing an appropriate scale of incentives for electronic filing in the new fee structure had been a complex exercise.

13. The Delegation of Mexico highlighted WIPO's importance for developing countries in the context of a globalized economy. The work done by the Organization could help to speed up economic and social development, as well as development in science, industry, culture and technology. The Delegation recalled that the patent system was established in order to encourage technological and scientific research. The Delegation felt that an appropriate level of PCT fees for the biennium 2004-2005, as proposed by the International Bureau, would, on the one hand, benefit users of the system, who needed quality services, and would make use of the system more attractive; on the other hand, it would financially strengthen the Organization with a positive impact on international cooperation for development. A reduction in PCT fees, together with the decrease in the number of applications filed in 2003

and the possibility of only minor increases in filings in the near future, would create additional pressure on the development cooperation budget. As a result, the Delegation supported the PCT fees proposal consistently with its earlier statements in the Program and Budget Committee and in the Working Group on Reform of the PCT.

14. The Delegation of Italy, on behalf of the European Community and its Member States, as well as the States which were in the process of acceding to the European Community, stated that the Community and those States had carefully examined the proposals concerning the structure and the level of PCT fees and agreed in principle with a policy aimed at reducing them. They were, however, aware that such a policy would have an impact on WIPO's budget and asked the International Bureau to carefully monitor the future development of the revenues of the PCT system, with a view to defining an adequate strategy that would lead to a possible reduction of PCT fees in the medium term.

Reform of the PCT

15. Discussions were based on document PCT/A/32/2.

16. The Delegation of Costa Rica, on behalf of GRULAC, expressed its concern about the envisaged dates for the fifth session of the Working Group on Reform of the PCT, tentatively scheduled to take place in Geneva from November 17 to 21, 2003, noting a scheduling conflict with another meeting in a different forum that was due to take place during that week in Geneva, and noting the difficulties, in particular for smaller delegations, to be adequately represented when several meetings were scheduled to take place at the same time. In this context, the Delegation further noted the importance of financial assistance being made available to enable experts from developing countries to attend the highly technical sessions of the Working Group.

17. The Director General, referring to the concerns expressed by the Delegation of Costa Rica, stated that the International Bureau would consult with the delegations concerned with a view to finding an appropriate solution.

18. The Delegation of China expressed its thanks for WIPO's work on reform of the PCT, noting that the PCT had served China well over the years. The Delegation said that it expected the PCT to play an increasingly important role in China in the years to come, noting that, in the first eight months of 2003, the number of international applications filed with its Office as a PCT receiving Office had increased by about 14%, while the number of international applications entering the national phase in China had increased by about 7%. The Delegation welcomed the remarkable results that reform of the PCT had achieved in a relatively short period of time. It also supported the plan to reduce the international filing fee, which would attract more applicants. Finally, the Delegation emphasized that, at this point, Contracting States needed time to adapt their national legislations and information technology systems, and to train staff, with the assistance of WIPO.

19. The Delegation of Romania, speaking on behalf of the Central European and Baltic States, expressed its support for the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2003 and September 2004 sessions of the Assembly.

20. The Assembly:

(i) took note of the summaries by the Chair of the third and fourth sessions of the Working Group on Reform of the PCT contained in documents PCT/R/WG/3/5 and PCT/R/WG/4/14 and reproduced in Annexes I and II to document PCT/A/32/2;

(ii) unanimously approved the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2003 and September 2004 sessions of the Assembly, including the matters to be considered, the convening of sessions of the Working Group and possibly the Committee, and financial assistance to enable attendance of certain delegations, as set out in paragraph 26 of document PCT/A/32/2.

Proposed Amendments of the Regulations Under the PCT

21. Discussions were based on document PCT/A/32/4 and 4 Add.1.

22. The Assembly unanimously adopted the amendments of the Regulations under the PCT contained in Annex III and decided that those amendments:

(a) shall enter into force on January 1, 2004, and shall apply to any international application whose international filing date is on or after January 1, 2004;

(b) shall not apply to any international application whose international filing date is before January 1, 2004, provided that:

(i) amended Rules 53.2, 60.1 and 61.1 shall apply to any international application in respect of which a demand for international preliminary examination is filed on or after January 1, 2004, whether the international filing date of the international application is before, on or after January 1, 2004;

(ii) amended Rule 70.16 shall apply to any international application in respect of which the international preliminary examination report is established on or after January 1, 2004, whether the international filing date of the international application is before, on or after January 1, 2004.

23. In connection with amended Rule 16*bis*.2(a), the Assembly noted that the 75% reduction provided for by the Schedule of Fees in the case of certain applicants from qualifying countries (including most developing countries) would, in effect, carry over to any late payment fee payable under Rule 16*bis*.2 by virtue of Rule 16*bis*.2(a)(i) (see document PCT/A/32/4, Annex II, paragraph 4).

24. The Assembly noted that Rule 73.2 as adopted on October 1, 2002, with effect from January 1, 2004, had to be read in light of Article 38(1) and present Rule 94.2 and would not prevent an elected Office from gaining access to the file of the international preliminary examination once the international preliminary examination report had been established (see document PCT/A/32/4, Annex II, paragraph 12).

Appointment of the National Board of Patents and Registration of Finland as an International Searching and Preliminary Examining Authority Under the PCT; Approval of the Corresponding Draft Agreement

25. Discussions were based on document PCT/A/32/5.

26. The Delegation of Finland stated that the PCT Committee for Technical Cooperation had recognized, last year, that Finland had the right to seek appointment of the National Board of Patents and Registration of Finland (the "Board") as an International Searching and Preliminary Examining Authority. The Board had the necessary competence and capacity in this respect, in particular, as far as technical aspects were concerned, as detailed in document PCT/A/32/5. The Delegation explained that the Board wanted to guarantee good service to all its clients, including inventors, small- and medium-sized enterprises and large-scale industry. The Delegation further stated that, over the past five years, the number of international applications originating from Finland had doubled and had been as high as 1,762 in 2002. The Delegation pointed out that Finnish industry had been satisfied with the high standard of search and examination work carried out by the Board, as well as by the modern methods and tools used. Electronic filing of applications had started in the spring of 2001, and the Board aimed at introducing fully electronic processing of applications and electronic file inspection before the end of 2004. The Delegation also emphasized that examiners had access to the whole PCT minimum documentation in electronic form and to an extensive collection of documents in paper form. The Delegation stated that the Board as an International Searching and Preliminary Examining Authority would process applications in Finnish, Swedish and English, originating, at the first stage, from Finland. It was anticipated that the Board would be ready to start operations during the year 2004. On behalf of the Finnish government and on behalf of the Board, the Delegation expressed the wish that its application would receive a positive response.

27. The Delegation of Kyrgyzstan expressed its support for the proposal and stressed that it was sure that Finland met all the required standards, since it was a highly qualified organization with a very good technical basis and a great deal of experience.

28. The Delegation of Australia noted that the Board met all the technical requirements to be appointed as an International Searching and Preliminary Examining Authority and that there was no reason to refuse the appointment. The Delegation expressed its support for the proposal.

29. The Delegation of South Africa stated that it also supported the proposal and was looking forward to future collaboration with the new International Authority.

30. The Delegation of Estonia expressed its strong support for the appointment of the Board.

31. The Delegation of Egypt also supported the proposal.

32. The Assembly:

(i) approved the text of the Agreement between the National Board of Patents and Registration of Finland and the International Bureau as set out in Annex IV to this report; and

(ii) appointed the National Board of Patents and Registration of Finland as International Searching and Preliminary Examining Authority with effect from the entry into force of said Agreement.

33. The Delegation of Finland expressed its gratitude to the Assembly for granting the Board the status of International Searching and Preliminary Examining Authority and especially to the delegations that had supported the proposal, as well as to the Director General and to the International Bureau for its technical support. The Delegation further stated that Finland was looking forward to working with all PCT Contracting States and promised to provide the best possible quality of work.

IMPACT Project Status Report

34. Discussions were based on document PCT/A/32/3.

35. In introducing the report, the International Bureau provided the Assembly with a brief update on the status of the project.

36. The Assembly took note of the status report on the IMPACT Project contained in document PCT/A/32/3.

PCT-SAFE Project Status Report

37. Discussions were based on document PCT/A/32/7.

38. In introducing the report, the International Bureau provided the Assembly with a brief update on the status of the project.

39. The Assembly took note of the status report on the PCT-SAFE Project contained in document PCT/A/32/7.

40. The Delegation of Egypt, referring to its recent accession to the PCT which entered into force on September 6, 2003, expressed the hope that its collaboration with all PCT Contracting States would benefit all and help to promote economic development. The Egyptian Patent Office had been able to enhance its working capacity in the last few years, thanks to the continuous support of WIPO, allowing the Office to look forward to excellent results and performance. The Delegation noted, in particular, the introduction of an electronic processing system and the creation of a PCT receiving unit equipped with advanced technologies for dealing both with international and national phases processing of PCT applications. The Delegation added that the Office, having become a model for other Offices in the Arab region, was currently streamlining its services for search and examination. The Delegation indicated that, as a next step, the Office would consider the question of becoming an International Searching and Preliminary Examining Authority. Furthermore, noting that there were now eight Arab Member States in the PCT Union, the Delegation stressed the importance of envisaging the future introduction of the Arabic language as an official

language under the PCT, in particular for the purposes of international publication, so as to facilitate the use of PCT by applicants from the Arab region and provide wider access to information in that region. The Delegation expressed its appreciation to the Arab Bureau for the continued assistance provided in respect of accession to the PCT, and, in addition to the Office of the PCT and the Developing Countries (PCT) Division.

41. The Delegation of France, reiterating its strong support for a PCT system which is adaptable to various users' needs, indicated that it was pleased with the adoption of the proposed amendments of the Regulations under the PCT. Furthermore, it supported the progress on the automation projects (IMPACT and PCT-SAFE), noting that they had benefitted from a major financial effort. The Delegation was of the view that the effect of the amendments and of the new fee structure would need to be evaluated before any further changes were made to the system. Having noted a gradual slowdown, since last year, in the overall number of applications filed, the Delegation expressed the wish that the PCT Authorities would take advantage of the situation to reduce their backlogs, this being one of the continuing existing difficulties experienced by the system. The slowdown would need to be assessed to see whether it was a one-time situation or whether it represented the beginning of a trend, in which case its impact on WIPO's budget and on the budgets of the various Offices would need to be assessed. The Delegation was pleased to note, as others had already done, the growing number of emerging countries joining the PCT and of the applications originating therefrom, noting that the bilateral and multilateral assistance extended to those countries was beginning to bear fruit. Finally, the Delegation pledged to continue its involvement in work relating to the PCT and to patent law harmonization.

42. The Delegation of Japan stated that it was extremely important to introduce more accountability and transparency in respect of the accounts of the PCT Union. As implied by PCT Article 53(2)(vi), such accounts could be considered, theoretically, as independent, even though they were closely and/or directly related to the accounts of other Unions as well as to the overall accounts of WIPO. In other words, the PCT Union activities could be considered as independent activities, or an independent business, and could be separated from other WIPO activities, especially from the accounting viewpoint. At the same time, the Delegation fully recognized the present budgetary situation of WIPO, noting how much certain WIPO activities depended on the income generated by the PCT. The Delegation was, at this point, asking neither for the immediate introduction of an independent accounting system in respect of the PCT Union nor for a separation of the PCT income from the WIPO general income. However, when trying to secure the future stability of WIPO's budgetary situation, the Delegation believed that it was indispensable to undertake a feasibility study on introducing an independent accounting system for the PCT Union, such as was widely in use in the private sector. When considering the present situation relating to the Madrid Union and the Hague Union, and to some extent that relating to the decrease of international applications, it seemed that thought should be given to the future of the PCT Union. According to document A/39/5, entitled "Medium-term Plan for WIPO Program Activities – Vision and Strategic Direction of WIPO," the modernization of accounting practices would be ensured as a matter of policy, which the Delegation strongly supported, in particular because the PCT Union was the most important Union for WIPO. The Delegation wished to suggest that the International Bureau take into account systems widely used in the private sector when addressing the modernization of WIPO's accounting practices.

43. The Delegation of the United States of America fully supported the statement made by the Delegation of Japan.

44. The International Bureau welcomed the proposal made by the Delegation of Japan, indicating that it would study the question and report back in due course.

[Annex I follows]

ANNEX I

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on January 1, 2004)

SCHEDULE OF FEES

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,400 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling fee: (Rule 57.2)	200 Swiss francs

Reductions

3. The international filing fee is reduced by the following amount if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed:

(a) on paper together with a copy thereof in electronic form:	100 Swiss francs
(b) in electronic form where the text of the description, claims and abstract is not in character coded format:	200 Swiss francs
(c) in electronic form where the text of the description, claims and abstract is in character coded format:	300 Swiss francs

4. The international filing fee (where applicable, as reduced under item 3) and the handling fee are reduced by 75% if the international application is filed by:

- (a) an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); or
- (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations;

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).

[Annex II follows]

ANNEX II

MODIFIED DIRECTIVES OF THE PCT ASSEMBLY RELATING TO THE
ESTABLISHMENT OF NEW EQUIVALENT AMOUNTS OF CERTAIN FEES
(to enter into force on January 1, 2004)

The Assembly establishes in the following terms the directives referred to in Rules 15.2(d), 16.1(d) and 57.2(e), it being understood that, in the light of experience, the Assembly may at any time modify these directives:

(1) At the time of each ordinary session of the Assembly, the Director General shall undertake consultations along the lines of the consultations referred to in Rules 15.2(b) and 57.2(c) and shall establish new equivalent amounts of the international filing fee and handling fee in currencies other than Swiss francs according to the exchange rates applicable on the first day of that session, so that their amounts correspond to the amounts of the fees expressed in Swiss currency. Where such adjustment would only slightly affect the income of the International Bureau, the Director General may decide not to proceed with it. Unless otherwise decided by the Assembly, any adjustment under this paragraph shall enter into force on the first day of the calendar year subsequent to the ordinary session referred to above.

(2) Where for more than 30 consecutive days, the exchange rate between Swiss currency and any other currency is by at least 5% higher, or by at least 5% lower, than the last exchange rate applied,

- (i) so far as Rule 15.2(d) is concerned, any receiving Office referred to in the second sentence of Rule 15.2(b) or
- (ii) so far as Rule 57.2(e) is concerned, any receiving Office or International Preliminary Examining Authority referred to in the second sentence of Rule 57.2(c)

may ask the Director General to newly establish the amount of the international filing fee and/or handling fee in that currency according to the exchange rate prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly, as provided in Rules 15.2(d) and 57.2(e).

(3) Where for more than 30 consecutive days, the exchange rate between Swiss currency and any other currency is by at least 10% higher, or by at least 10% lower, than the last exchange rate applied, the Director General shall,

- (i) so far as Rule 15.2(d) is concerned, after consultation with the receiving Office referred to in the second sentence of Rule 15.2(b) or
- (ii) so far as Rule 57.2(e) is concerned, after consultation with the receiving Office or International Preliminary Examining Authority referred to in the second sentence of Rule 57.2(c)

and as provided in Rules 15.2(d) and 57.2(e), as the case may be, newly establish the amount of the international filing fee and/or handling fee in that currency according to the exchange rate prevailing on the day preceding the day on which the consultation is initiated by the

Director General. Where such adjustment would only slightly affect the income of the International Bureau, the Director General may decide not to proceed with it.

(4) As far as the international filing fee is concerned, the Director General may decide to apply paragraph (3) as if the percentage referred to in that paragraph was 5%.

(5) As far as the search fee of any International Searching Authority in any currency other than the currency or currencies fixed by that Authority is concerned, paragraphs (1) to (3) shall, to the extent applicable, apply *mutatis mutandis*, except in the case where the equivalent amount of that fee in Swiss francs is equal to or more than 1,000 Swiss francs, in which case the Director General may decide to apply paragraph (3) as if the percentage referred to in that paragraph was 5%.

[Annex III follows]

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on January 1, 2004)

Rule 4
The Request (Contents)

4.1 to 4.10 [No change]

4.11 *Reference to Earlier Search, Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

(i) to (iii) [No change]

(iv) the applicant intends to make an indication under Rule 49bis.1(d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or indicate the relevant parent application or parent patent or other parent grant.

(b) [No change]

4.12 to 4.14 [*Remain deleted*]

4.14bis to 4.18 [No change]

Rule 16bis
Extension of Time Limits for Payment of Fees

16bis.1 [No change]

16bis.2 *Late Payment Fee*

(a) [No change]

(b) The amount of the late payment fee shall not, however, exceed the amount of 50% 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.

Rule 17
The Priority Document

17.1 [No change]

17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a), (b) or (b-bis), the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(b) and (c) [No change]

Rule 32
**Extension of Effects of International Application to
Certain Successor States**

32.1 *Extension of International Application to Successor State*

(a) to (c) [No change]

(d) *[Remains deleted]*

32.2 [No change]

Rule 43bis
Written Opinion of the International Searching Authority

43bis.1 *Written Opinion*

(a) [No change]

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 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), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

(c) [No change]

Rule 44bis
International Preliminary Report on Patentability by
the International Searching Authority

44bis.1 Issuance of Report; Transmittal to the Applicant

(a) and (b) [No change]

(c) The International Bureau shall promptly transmit one copy of the report issued under paragraph (a) to the applicant.

44bis.2 to 44bis.4 [No change]

Rule 53
The Demand

53.1 [No change]

53.2 *Contents*

(a) The demand shall contain:

(i) to (iii) [No change]

(iv) where applicable, a statement concerning amendments.

(b) [No change]

53.3 to 53.9 [No change]

Rule 60
Certain Defects in the Demand

60.1 Defects in the Demand

(a) Subject to paragraphs (a-bis) and (a-ter), if the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iii), 53.2(b), 53.3 to 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(a-bis) and (a-ter) [No change]

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had been received on the actual filing

date, provided that the demand as submitted permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

(c) If the applicant does not comply with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare.

(d) [Deleted]

(e) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in paragraphs (a) to (c).

(f) and (g) [No change]

60.2 *[Remains deleted]*

Rule 61

Notification of the Demand and Elections

61.1 *Notification to the International Bureau and the Applicant*

(a) [No change]

(b) The International Preliminary Examining Authority shall promptly notify the applicant of the date of receipt of the demand. Where the demand has been considered under Rules 54.4, 55.2(d), 58bis.1(b) or 60.1(c) as if it had not been submitted, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) *[Remains deleted]*

61.2 to 61.4 [No change]

Rule 70

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

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) Each replacement sheet under Rule 66.8(a) or (b), each replacement sheet containing amendments under Article 19 and each replacement sheet containing rectifications

of obvious errors authorized under Rule 91.1(e)(iii) shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Replacement sheets containing amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

(b) Notwithstanding paragraph (a), each superseded or reversed replacement sheet referred to in that paragraph shall also be annexed to the report where the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c). In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

70.17 [No change]

Rule 80 **Computation of Time Limits**

80.1 to 80.4 [No change]

80.5 *Expiration on a Non-Working Day or Official Holiday*

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day:

- (i) on which such Office or organization is not open to the public for the purposes of the transaction of official business;
- (ii) on which ordinary mail is not delivered in the locality in which such Office or organization is situated;
- (iii) which, where such Office or organization is situated in more than one locality, is an official holiday in at least one of the localities in which such Office or organization is situated, and in circumstances where the national law applicable by that Office or organization provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day; or
- (iv) which, where such Office is the government authority of a Contracting State entrusted with the granting of patents, is an official holiday in part of that Contracting State, and in circumstances where the national law applicable by that Office provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day;

the period shall expire on the next subsequent day on which none of the said four circumstances exists.

80.6 and 80.7 [No change]

Rule 90
Agents and Common Representatives

90.1 [No change]

90.2 *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a “common agent”) under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office shall be considered to be the common representative of all the applicants.

90.3 and 90.4 [No change]

90.5 *General Power of Attorney*

(a) and (b) [No change]

(c) Any receiving Office, any International Searching Authority and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4 to the receiving Office, the International Searching Authority or the International Preliminary Examining Authority, a copy of the general power of attorney shall be submitted to that Office or Authority.

90.6 [No change]

[Annex IV follows]

ANNEX IV

AGREEMENT BETWEEN
THE NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to
the functioning of the National Board of Patents and Registration of Finland
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The National Board of Patents and Registration of Finland and the International Bureau
of the World Intellectual Property Organization,

Hereby agree as follows:

Article 1
Terms and Expressions

(1) For the purposes of this Agreement:

- (a) “Treaty” means the Patent Cooperation Treaty;
- (b) “Regulations” means the Regulations under the Treaty;
- (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
- (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
- (e) “Rule” means a Rule of the Regulations;
- (f) “Contracting State” means a State party to the Treaty;
- (g) “the Authority” means the National Board of Patents and Registration of Finland;
- (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement, that, where applicable, the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its function as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that the Authority satisfies the requirements under Rules 36.1(i) and 63.1(i).

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the National Board of Patents and Registration of Finland gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the National Board of Patents and Registration of Finland written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [Geneva], this _____, in two originals in the English language.

For the National Board of Patents and
Registration of Finland
by:

For the International Bureau
by:

(signature)
Martti Enäjärvi
Director General
National Board of Patents and Registration
of Finland

(signature)
Kamil Idris
Director General
World Intellectual Property Organization

*Annex A
States and Languages*

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States:
 - (a) Finland;
 - (b) any other Contracting State in accordance with the obligations of the Authority within the framework of the European Patent Organisation;
- (ii) the following languages:

Finnish, Swedish, English.

*Annex B
Subject Matter Not Excluded from Search or Examination*

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under the national patent grant procedure under the provisions of the Finnish Patent Law.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Euro)</i>
Search fee (Rule 16.1(a))	[...]
Additional fee (Rule 40.2(a))	[...]
Preliminary examination fee (Rule 58.1(b))	[...]
Additional fee (Rule 68.3(a))	[...]
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	[...]

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from:

- (i) an earlier national search already made by the Authority on an application whose priority is claimed for the international application, [...] % of the search fee paid shall be refunded.
- (ii) an earlier international or international-type search already made by the Authority on an application whose priority is claimed for the international application, [...] % or [...] % of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Finnish, Swedish and English, depending on the language in which the international application is filed or translated.

[End of Annex IV and of document]

WIPO



PCT/A/33/7

ORIGINAL: English

DATE: October 5, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Thirty-Third (19th Extraordinary) Session
Geneva, September 27 to October 5, 2004**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/40/1): 1, 2, 4, 14, 15, 18, 21 and 22.
2. The report on the said items, with the exception of item 15, is contained in the General Report (document A/40/7).
3. The report on item 15 is contained in the present document.
4. The meeting of the Assembly was presided over by Dr. Ian Heath (Australia), Chair of the PCT Assembly, and in the absence of the Chair and the Vice-Chairs, by the Acting Chair, Ambassador Doru Costea (Romania).

ITEM 15 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Reform of the PCT

5. Discussions were based on document PCT/A/33/1.
6. In addition to the discussion reported below, reference should be made to the General Report (document A/40/7), under item 4.
7. The Delegation of Algeria expressed its thanks to the Secretariat for having prepared document PCT/A/33/1 which, in its view, accurately reflected the discussions at the last two sessions of the Working Group on Reform of the PCT. The Delegation recalled that the PCT reform process needed to take into account the interests of all PCT Contracting States and, in this regard, expressed the hope that the collective interest of all parties would prevail in future discussions within the Working Group. The Delegation expressed support for the work plan proposed in the document and recalled that two important items would need to be taken up in the course of the future work of the Working Group. Firstly, consideration would need to be given to requiring a declaration of the source of genetic resources and traditional knowledge in patent applications. The requirement of disclosure of the source of genetic resources and traditional knowledge in patent applications should be mandatory and, in case of non-compliance, should lead to sanctions including revocation of the patent concerned. The Delegation thanked the Delegation of Switzerland for its proposals on this matter that had been submitted to the Working Group, and stated that it would look forward with great interest to a further document to be presented by the Delegation of Switzerland to the next session of the Working Group. Secondly, while the Delegation wished to express its general support for the principle of restoration of the right of priority, it noted that such a principle was envisaged neither by the Paris Convention for the Protection of Industrial Property nor the PCT. The Delegation therefore considered it necessary, in order to allow for the restoration of the right of priority under the PCT, to amend the Treaty itself rather than the Regulations.
8. The Assembly:
 - (a) noted the summaries by the Chair of the fifth and sixth sessions of the Working Group on Reform of the PCT contained in documents PCT/R/WG/5/13 and PCT/R/WG/6/12 and reproduced in Annexes I and II of document PCT/A/33/1; and
 - (b) unanimously approved the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2004 and September 2005 sessions of the Assembly, subject to the availability of sufficient funds, including the matters to be considered, the convening of sessions of the Working Group and possibly the Committee, and financial assistance to enable attendance of certain delegations, as set out in paragraph 37(i) and (ii) of document PCT/A/33/1.

Proposed Amendments of the Regulations Under the PCT

9. Discussions were based on document PCT/A/33/2 and, in French only, document PCT/A/33/2 Rev.

10. The Delegation of Germany, noting that sufficient time was needed for the preparation and publication of an official German text, agreed by several countries concerned, of the Regulations under the PCT as amended, suggested that the date of entry into force of the proposed amendments of the Regulations be April 1, 2005.

11. The Assembly unanimously adopted the amendments of the Regulations under the PCT contained in the Annex to this report and decided that those amendments:

(a) shall enter into force on April 1, 2005, and shall apply to any international application whose international filing date is on or after April 1, 2005;

(b) shall not apply to any international application whose international filing date is before April 1, 2005, provided that amended Rules 13^{ter}.2, 53.9, 68.2, 68.3 and 69.1 shall apply in relation to any international application in respect of which a demand for international preliminary examination is made on or after April 1, 2005, whether the international application is filed before, on or after April 1, 2005.

Status Report on PCT Information Systems

12. Discussions were based on document PCT/A/33/3.

13. In introducing the report, the International Bureau provided the Assembly with a brief update on the activities of the PCT Information Systems Division.

14. The Delegation of the Republic of Korea expressed its appreciation for the International Bureau's efforts in promoting the PCT system, in particular with respect to the launching in January 2004 of the electronic filing system for PCT applications. It informed the Assembly that the International Bureau and the Korean Intellectual Property Office had now begun joint development of a PCT receiving Office administration system called "PCT-ROAD". The PCT-ROAD system would offer PCT receiving Offices core administrative functions such as electronic receipt of PCT applications and management of bibliographic data. The successful development and dissemination of PCT-ROAD would assist receiving Offices in developing countries to modernize their internal administrative processes. The Delegation expressed its desire to continue cooperation with WIPO by offering the experience and expertise of the Office to other Member States to help them modernize their intellectual property administration systems.

15. The Assembly took note of the status report on the PCT Information Systems contained in document PCT/A/33/3.

Status Report on PCT and Patent Statistics Activities

16. Discussions were based on document PCT/A/33/4.

17. In introducing the report, the International Bureau provided the Assembly with a brief update on activities since the document was issued.

18. The Delegation of Japan expressed its appreciation for the work of the International Bureau in the domain of statistics and expressed its support for the proposal of the International Bureau to establish a worldwide database of industrial property statistics.

19. The Delegation of the United Kingdom noted the timeliness of the work of the International Bureau and voiced its active support. The Delegation expressed its concern about delays in the establishment of international search reports, as highlighted in the statistical report annexed to document PCT/A/33/4, and enquired whether statistics were available on this matter.

20. The International Bureau, in reply to the Delegation of the United Kingdom, stated that data had been collected by the International Bureau on the timing of the transmission of international search reports, international search opinions and international preliminary examination reports. Statistics on these matters had been shared with the International Authorities at the Meeting of International Authorities. It further stated that delayed international search reports also had adverse effects on the publication of international applications, and on applicants and third parties. So far this year, over 20,000 re-publications had had to be effected by the International Bureau as a consequence of late international search reports.

21. The Assembly took note of the status report on PCT and Patent Statistics Activities contained in document PCT/A/33/4.

Readjustment of the International Filing Fee

22. Discussions were based on document PCT/A/33/5.

23. In addition to the discussion reported below, reference should be made to the General Report (document A/40/7), under item 4.

24. The Delegation of Canada, speaking on behalf of Group B, indicated that there was serious concern within the Group about WIPO's general financial situation, including with respect to the new construction project. Budgetary restraint was a challenge that WIPO had not had to face in any serious way for some years. The efficient allocation of scarce resources was now a major challenge for WIPO and its Member States and some very difficult decisions had now to be made about WIPO's future priorities. Group B believed there was insufficient information and justification provided to warrant approval of the proposal to increase the PCT filing fee at the 2004 General Assembly. The Delegation stressed that any proposal for a fee increase should be included in the framework of budget discussions.

25. The Delegation of Egypt, speaking on behalf of the African Group, stated that, as was well known, PCT fees constituted the most substantial part of WIPO's income. As the Delegation had indicated in its general statement, the African Group wished to reaffirm how important it was for WIPO to have a solid and stable financial basis, thus enabling it to deliver its services and carry out its activities in accordance with the high level of performance known to all in past years. The Group welcomed and supported, in this regard, the announcement concerning the establishment of a long-term predictability system to monitor future PCT income, made by the Director General in his opening remarks in the framework of the General Assembly. In this context, the African Group wished to recall that, in the period from 1997 to 2003, PCT fees had been reduced by 40% in spite of concerns of developing countries concerning the potential negative impact of such decrease on WIPO's level of activities, particularly in its cooperation for development program. The Delegation noted that, during this period, PCT fees charged by major Patent Offices in the world had increased substantially. However, the reduction of WIPO's PCT fees had been based on a solid understanding that they could be readjusted later if needed. It was in this context that the last

sentence of paragraph 2 of document PCT/A/33/5 referred to the fact that Member States had agreed that, on the basis of consultations, the Director General “would propose a readjustment of PCT fees, if necessary next year”, meaning this year. The shortfall in the Organization’s income over the past year was being felt across the Organization and affected its ability to deliver its services and carry out its activities, taking into consideration the ever-increasing needs of developing countries, particularly African countries and the least developed countries among them, to build their capacities and infrastructure in the field of intellectual property in order to effectively use intellectual property for economic and social development. At the same time, the Organization was faced more than ever with greater challenges and expectations on a global level, necessitating a solid financial basis. As a consequence, the African Group fully supported the readjustment of PCT fees, as proposed. The Group was confident that the International Bureau had proposed such a readjustment after careful study and after having taken all other possible measures to address the financial situation of the Organization, including appropriate cost reduction measures. In respect of the possibility of using the Reserve Funds, which had been mentioned by delegations, the Group was convinced that this was contrary to the rules of financial prudence as it would negatively impact on WIPO’s assets and long term financial basis and would be contravening the Reserve targets agreed to by Member States. The Group wished to make it clear that cooperation for development was an integral part of the mission of the Organization on an equal footing with its other activities, and ultimately contributed to the consolidation of the global intellectual property system. The African Group wished also to highlight the importance it attached to promoting the use of the PCT system by developing countries. In this context, the Group requested the International Bureau to examine the possibility of extending the fee reduction of 75%—presently given to individuals—to firms whose capital was owned by one or more individuals from a country where the national revenue per inhabitant was less than 3,000 US dollars per annum. The African Group wished to seize this opportunity to highlight its full confidence in the management of WIPO and its trust in the high level of professionalism of the International Bureau. The International Bureau was exemplary in its transparency and eagerness to associate the Member States with all decisions concerning financial and administrative matters, as had been effectively witnessed in past years. In conclusion, urging all Member States to heed the call of the Director General, the African Group reiterated that the matter was of great importance for WIPO and could not be deferred, and action should be taken at this session.

26. The Delegation of Mexico stressed that it was particularly important to put the proposal to increase the PCT filing fee into context, from the following two angles. Firstly, the increase proposed was modest compared to the overall cost of patent filings, the major component continuing to be patent agents’ fees. It was patent agents, and not necessarily applicants, who had most benefited from continued PCT fee reductions in the past, which amounted to 40% since 1997. Secondly, the main International Authorities had significantly increased the costs of PCT filings by increasing their own PCT fees this year. It was to be expected that the proposed increase would not affect PCT applicants in developing countries who would find themselves unable to pay even the reduced fees offered by some of these Authorities, which would mean that they would not be able to benefit from the advantages of the PCT system. From these two points of view, the Delegation considered that the proposal was reasonable in order to compensate for the short-fall in WIPO’s income, especially when considering that the fee increases adopted by the main PCT Authorities were, in some cases, higher than 60%, whereas the Secretariat’s proposal was for an increase of less than 5% if one took into account the basic cost of the PCT system (international filing fee and search fee). It was for these reasons that the Delegation supported the proposal. Nonetheless, the Delegation also considered that it would be necessary to adopt additional measures to ensure the financial

health of WIPO and to explore ways of rationalization that would lead to a reduction, in a fairly brief period, in the high operational costs of the Organization. It was not by hiring more people but by making better use of available resources, especially by investment in information technology, that developing countries could obtain more and better benefits from the intellectual property system and also from WIPO's cooperation activities. The Delegation expressed concern at the possibility that the financial situation might have detrimental effects on investment programs in information technologies, particularly in the PCT system. This would affect the consolidation of an interactive electronic environment for users of the system, the strengthening of which was necessary in order to provide dynamic and efficient services to the users. Finally, the Delegation noted that, in the context of electronic filing, some of the present PCT fees would have to be revised in the future, such as, for example, the fee per page charged for sheets in excess of 30. The Delegation was of the view that it was vital to set up a committee, reflecting the multilateral nature of the Organization, which would assess, from different perspectives, any proposed increase or decrease in fees before it was submitted to the Assembly. The purpose of such a committee would be to analyze the impact of the proposed measures on all PCT Member States, to suggest possible solutions with a view to maintaining the "win-win" balance, to the benefit of all involved in the system, including WIPO. The work of the committee would strengthen the PCT system and make it possible to guarantee the financial stability of the Organization in the medium and long terms. In conclusion, the Delegation reiterated its support for the proposal, its call for the adoption of rationalization measures to reduce high operational costs, and its suggestion to establish a committee to assess in advance any increase or decrease of fees which was submitted in the future to the Assembly.

27. The Delegation of Sri Lanka, speaking on behalf of the Asian Group, stated that the countries of the Asian Group had noted with particular interest the discussions on the current financial situation of WIPO, its causes as well as consequences. The Group was aware that the current situation needed redress and therefore welcomed the proposal for a readjustment of the international filing fee. It also welcomed the fact that the proposal sought to ease the burden on developing countries, and indicated that it would consider constructively any further suggestions aimed at ameliorating possible undue hardship resulting from implementation of the proposal. The Group expressed the hope that the additional income guaranteed by the proposed readjustment, combined with other measures taken to reduce expenditure, would contain the deficit in the current biennium to a marginal level while at the same time maintaining the Organization's ability to achieve its objectives.

28. The Delegation of Benin, speaking on behalf of the Least Developed Countries (LDCs) Group, referred to the statement it had made in the framework of the WIPO General Assembly in which LDCs had called for additional assistance to be provided to LDCs in all sectors. In particular, this would involve information technology, the use of technological tools, technical support and modernization of intellectual property systems. In that context, the LDCs Group recalled that, during the period 1997 to 2003, international filing fees were cut by 40% despite the many problems encountered by developing countries over those years, some of which were particularly acute for LDCs. However, understanding was reached on the fact that there would be no impact on cooperation programs, and it was also clearly understood that if the number of filings were to be reduced, then there would be a corresponding adjustment in fees. As stated in the last sentence of paragraph 2 of document PCT/A/33/5, the Member States had agreed that, on the basis of consultations, the Director General would, as required, propose a readjustment in PCT fees the following year, in other words, this year. All Member States, in particular LDCs, were now feeling the impact of the decrease in PCT income and thus on the overall strategic objectives of the Organization,

which would affect not only Member States of WIPO but also society in general. For that reason, the Delegation recalled the plea it had made in the framework of the WIPO General Assembly that intellectual property should be recognized as an instrument to bring about social, economic, educational and cultural development throughout the world, and should also be recognized as a tool to be used in developing international trade and investment and in overcoming poverty at a global level. Once again, the Delegation recalled that it had been agreed that intellectual property should be viewed in a broader context. WIPO should now undertake broader tasks as it sought to attain the Millennium Goal established by the United Nations in various areas, such as health, education and employment. The LDCs Group, composed of the fifty countries which benefited the least from intellectual property rights, was the group in the greatest need of further development, these countries having to try to establish a proper foothold in the international trade arena. Many obstacles and barriers prevented LDCs from doing so. Undoubtedly, WIPO could play an effective role in helping LDCs face those challenges but it needed to have the capacity and the will to get the necessary resources. In view of the situation and in order to ensure, in the medium and long terms, the stability of the resources of the Organization so as to allow it to perform the tasks it was required to do, the LDCs were therefore now proposing a readjustment of 20% in the PCT filing fee, not 12% as proposed by the International Bureau. Further readjustments to the PCT filing fee could be considered in future, depending on how the number of filings evolved and on the amount of income being generated. The Delegation called upon the International Bureau to inform all Member States of this proposal and of the way in which it had been discussed under this agenda item.

29. The Delegation of the Netherlands, speaking on behalf of the European Community and its Member States, was of the view that the proposal was not yet ripe for action at this stage. Having listened to the previous interventions, and after internal deliberations, the European Union (EU) was willing to continue to consider the proposal in a constructive manner in order to find an effective solution as soon as possible for the benefit of WIPO's operations, balancing costs and expenditures. With a view to preparing a draft decision for the Assembly in the coming months, the EU was willing to participate constructively in the competent bodies of the Organization in the elaboration of a soundly based financial outlook for WIPO, based on both income and expenditure, in the short and longer term perspectives. WIPO's Secretariat should make available further information and options for reducing costs in staffing and in the provision of office space. The EU believed that the program for technical assistance for developing countries should continue. On this basis, a reasonable and well-founded decision could be made by the Assembly in the coming months. The Delegation wished to share with other delegations information concerning the question of "risk", should the Assembly not take a decision at the current session to adopt the proposal. The question had been asked of the external auditor of WIPO, whose view was that a modest decrease of the Reserve Funds from the level of 95 million Swiss francs to 75 million Swiss francs would not represent a real risk to the Organization on condition that, in the coming months, the issue of the financial problem was addressed.

30. The Delegation of the United States of America expressed its strong opposition to an increase in PCT fees, in general, and now in particular, for several reasons. The July 2004 PCT statistical report, as annexed to document PCT/A/33/4, noted that "the growth rate of PCT filing of around 4% continues and appears to be sustained in 2004. This is a slight increase over the yearly growth rate of 2002-2003". Just last year, the Assembly had effectively increased the minimum PCT fee when moving from the previous designation system to the new international filing system. At that time, the Assembly agreed to the Director General's suggestion that he would consult with Member States and review the

actual usage of the new PCT arrangement. Those consultations had not taken place, especially on the matter of the actual usage of the new arrangement. The fact that PCT fees had been reduced significantly in recent years was no justification for increasing them now. As had been noted by the Delegation in its statement to the General Assembly, the fees had been set artificially high in the past to generate Reserve Funds for automation and construction projects, reaching some 350 million Swiss francs at the end of 1998. The percentage of WIPO's budget funded by PCT fee income had risen from 58% in 1994 to almost 80% today. That trend was unacceptable and needed to be addressed. There was no indication of a financial crisis supporting the need for fee increases and there had been no demonstrated effort to implement quantifiable cost saving measures in lieu of seeking a fee increase. The Delegation referred to the intervention by the Delegation of the Netherlands, which indicated that there was in fact no risk to the Organization in light of the external auditor's report. In the light of these reasons, the Delegation of the United States of America simply did not see any justification for an increase in the PCT filing fee. The Delegation proposed a thorough review of WIPO prior to the consideration of any fee adjustment. The review should examine the control and use of fees, including an evaluation of the economy, efficiency and effectiveness of WIPO's financial procedures, its accounting system, its internal financial controls, and in general the administration and management of the Organization. The review should also provide detailed information on WIPO's assets and liabilities including staffing levels (permanent posts, fixed-term posts, short-term staff, consultants, etc.), and all financial obligations, rents, contracts, etc. The review should guide WIPO and the Member States in their consideration of the draft Program and Budget for 2006-2007 that would be considered by the Program and Budget Committee in the spring of 2005. While some might see this issue as a choice between fee increases and cuts in the cooperation for development program, the issue in fact concerned the entire Organization. The Delegation stressed that it did not intend to cause, nor did it believe that it would cause, negative effects on the cooperation for development program.

31. The Delegation of the Republic of Korea was of the view that, at first glance, the proposed readjustment of the international filing fee might seem appropriate from the point of view of resolving WIPO's shortfall in PCT income. However, the Delegation was concerned that increasing the filing fee would financially burden applicants and result in a reduction in the use of the PCT. Given that the current budgetary problem was due to a slowdown in the growth rate of PCT filings, increasing the filing fee might backfire and cause the growth rate to slow down even further. The Delegation considered it desirable, therefore, to act prudently before increasing the international filing fee, and was of the view that more discussion was needed on the cause and effect of any fee increase in the framework of the Program and Budget Committee and the Working Group on Reform of the PCT. It suggested that the reasons for the slowdown of the growth rate in PCT filing be first analyzed and that measures aimed at increasing the use of the PCT be considered.

32. The Delegation of the Republic of Moldova, speaking on behalf of the Group of Central Asian, Caucasus and Eastern European States, said that the Group had examined the issue of whether to increase the PCT filing fee from all possible angles, and had listened carefully to the positions and opinions of all the countries and groups that had spoken on the problem. The Group's viewpoint was based on the fact that the interests of all the Organization's Member States would be served through the continuation of its activities according to all the principles laid down in the Program. Based on the general interest of providing the necessary conditions for the sustainable development of WIPO's activities, the Group supported the proposal to increase the PCT filing fee. In addition, it acknowledged that to be a forced

measure and shared the opinion expressed regarding the need to provide more detailed information on the accounts and other measures used to reduce expenditure.

33. The Delegation of Indonesia indicated that, for the last decade, Indonesia had received great assistance from WIPO, such as training programs, seminars and preparation of draft government regulations dealing with intellectual property. For that reason, the Delegation supported the readjustment of the international filing fee and hoped that the additional income would contribute to WIPO's program of assistance to Member States, especially developing countries and least developed countries, in modernizing their intellectual property systems.

34. The Delegation of Morocco stated that, for decades, WIPO had been a source of pride to all of its Member States and also a source of pride to all its staff, the first reason being that WIPO had always been considered as the richest organization within the United Nations system and the second reason being that it had always been considered as a particularly efficient and effective organization. Indeed, WIPO had always been seen as a perfect example in that regard. In recent years, it had run into a few problems, but, looking at the dynamism and professionalism of the staff, there had been no falling off in the cause for pride. The question now posed was how to deal with the drop in income. The budgetary implications of the current situation could be readily seen. All those who had spoken previously had stated that this drop in income was not due to mismanagement, nor to any kind of "mega-budget" that had been decided upon; rather, it was something being caused by conditions that were more or less beyond the control of WIPO, that is, the rate of filing of applications under the PCT system. The dilemma was how to act to save the Organization, to save the efficiency and effectiveness of the Organization, and to maintain its technical cooperation programs at their existing levels. Should the Assembly act now or wait until a number of points could be clarified? The Delegation indicated that it had been pleased to listen to the Delegation of the Netherlands which had indicated that many countries had asked about what was the risk if no decision was taken now. There was a risk in not accepting the proposal for a 12% fee increase. The next question then was whether Member States were willing to accept that risk. The Delegation was of the view, like most countries and particularly developing countries, that the Organization could not afford the luxury of such a risk, that is to say, the risk of seeing its programs collapse, the risk of seeing its financial management compromised by a precarious budget, the risk of no longer enjoying budgetary predictability. Money was needed before actually launching any kind of international program. The Delegation endorsed what had been said by the representative of the African Group and indeed by other regional groups, and strongly supported the adoption of the International Bureau's proposal. If, however, there was a wish to have a more in-depth discussion of the matter, the Delegation was willing to participate in such a discussion, but there had to be some time limit for addressing the issue so as not to allow the Organization to run a more serious risk as time went on. Indeed, the longer it took to reach a positive response on the matter, the greater the problems for WIPO, the more its budget might shrink, and the more difficult the financial management might become. The Delegation appealed for the dialogue to continue within the Program and Budget Committee and within the Working Group on Reform of the PCT. What was important was to give a dynamic impetus to the discussion and not to over-complicate the work that had to be done, which might compromise the very objectives of the exercise. These objectives were ambitious indeed, but nonetheless they were the objectives of the Member States which needed to set up an agenda or plan of action now, taking into account the existing imperatives, in order to resolve the problem as soon as possible.

35. The Delegation of China expressed support in principle for the proposal by the International Bureau to increase the PCT filing fee. The Delegation recalled that, at the Assembly's session in 2003, it had approved a resolution to reduce the PCT fees. But, as had been pointed out in that session by some delegations, the reduction in PCT fees should not affect WIPO's work, including its cooperation with, and support for, developing countries and LDCs. Reviewing WIPO's work and activities in the past year, the Delegation felt that the reduction of the fees as decided at the 2003 session did, to some extent, affect WIPO's work. The Delegation was in principle in favor of taking measures for adjusting the PCT filing fee so that WIPO would have enough resources to carry out its planned work and better help the various countries, including assisting developing and least developed countries to establish and perfect their intellectual property systems. At the same time, the Delegation urged WIPO to ensure effective management of its finances so as to further promote the sound development of the international intellectual property system.

36. The Delegation of the Russian Federation supported the statement made by the coordinator of the Group of Central Asian, Caucasus and Eastern European States. It also supported the proposal to increase the PCT filing fee based upon the financial situation of the Organization and the desire to ensure that WIPO did not run into a budgetary deficit, because that would be very much to the detriment of operational activities of the Organization. The Delegation wished in particular to underscore its concern as to whether the Organization would be able to continue to carry out its activities in all areas of its programs, carefully observing a balance of the interests of all parties. It supported the proposal on the basis that it was a necessary measure, a measure that Member States were forced to take. It wished to stress that the measure could be looked at as a temporary measure which had to be taken because of an urgent need. The Delegation believed that, in increasing the PCT filing fee, consideration should be given to the need for maintaining the Reserve Funds as well as to how to make the Organization operate even more efficiently. This would concern all areas including construction projects and management of overheads. In other words, there should be careful monitoring of indicators on the part of Member States. The Delegation stated that the question of the financial status of the Organization and of possible changes to PCT fees were matters that had been looked at during the previous session of the Assembly after careful consideration within the Program and Budget Committee, and that was an appropriate way in which to continue in future.

37. The Delegation of the Democratic People's Republic of Korea stated that it had considered carefully the proposed readjustment of the international filing fee. As the Delegation of Sri Lanka had mentioned on behalf of the Asian Group, the issue of readjusting the international filing fee was considered to be necessary in the circumstances that the Organization was now facing. Last year, the Organization had proposed amendments to the Schedule of Fees by fixing the new international filing fee and by decreasing the handling fee, which aimed at making the PCT system more economic and profitable. But this year, the income of the Organization generated by the PCT had decreased, which had an impact on several of the Organization's activities including technical assistance to developing and least developed countries. To overcome this financial situation, it was important to adopt a flexible policy in respect of the activities planned and budgeted. But the most important thing was to strengthen international cooperation among Member States and to find the necessary financial resources. Therefore, the Delegation supported the proposal of the Director General on the readjustment of the international filing fee.

38. The Delegation of Barbados expressed its support for the proposed increase in the PCT filing fee. While mindful of the need for efficiency in the Organization, it had to be

recognized that WIPO was not immune to external pressure exerted by worldwide economic trends. The Delegation supported the increase in order to facilitate the funding of cooperation for development activities. While other Member States were well able to fund their own intellectual property development programs, Barbados had slender fiscal resources and could not draw on the benefits of economies of scale. For Barbados, the benefits of the PCT regime lay as much in the funding of development planning as in the promotion of accessible streamlined patent application processes. The Delegation asked those delegations that were skeptical about the need for the increase in the PCT filing fee to bear in mind the needs of the developing countries that relied on WIPO for support deriving from funds generated by the PCT. There was a balance whereby the holders of rights could exploit their intellectual property rights within smaller countries in which cooperation for development programs had aided the establishment of robust intellectual property protection systems and laws working to the benefit of all patent holders.

39. The Delegation of Trinidad and Tobago associated itself with the statement made by the Delegation of Barbados and expressed support for the proposal of the Director General for an increase in the PCT filing fee. Trinidad and Tobago, which joined the PCT in 1994, had since experienced a fair percentage growth in application filings by the local inventive community and an increase in PCT filings with its national office. This growth continued to contribute positively to economic growth and development. While the Delegation felt that WIPO had to explore other avenues to address its present financial shortfall, it also believed that the Member States had an obligation to support the proposal. Trinidad and Tobago relied heavily on the expertise which resided within WIPO and on WIPO's financial support for intellectual property activities, as Trinidad and Tobago continued to develop its intellectual property system. The Delegation believed that the proposed increase in fees would allow WIPO to operate more comfortably with its work in the area of development, particularly for small Offices, like the Office of Trinidad and Tobago, and would also allow the Organization to continue to retain the expertise of its consultants, without whom continued development might be hampered. The Delegation was not willing to take that risk. If Member States were to develop robust intellectual property systems, which were felt to be important for continued growth, but also because such was required as an integral part of every trade agreement which the country had signed so far, and particularly with the developed countries, the approval of the proposal was felt to be critical for the continued development experienced so far, while working with WIPO in previous years. The Delegation concluded by reiterating its support for the fee increase as proposed by the Director General.

40. The Delegation of Antigua and Barbuda strongly supported the proposed readjustment of the international filing fee and emphasized that this readjustment should be implemented by January 1, 2005. The Delegation supported the statements made by other Caribbean delegations and could also identify with the concerns expressed over the current and projected financial status of WIPO. The cooperation for development program was of utmost importance to Antigua and Barbuda and the Caribbean region as a whole. The period from October 2003 to September 2004 saw a reduction in activities rather than the increase that had been envisaged under the Cooperation for Development Agreement signed by the Caribbean countries and WIPO last November. This was mainly due to the fact that the budget for the Economic Development Bureau for Latin American and Caribbean had been severely cut by approximately 67% as a result of WIPO's financial shortfall. The Delegation was convinced that the fee change adopted during the last session of the Assembly had not delivered the desired results, and therefore adequate measures should be devised to reduce, if not eradicate, the deficit. The Delegation felt that a modest increase in fees would certainly not be a deterrent to applicants wanting to file PCT applications. The Delegation reiterated that it

would support any initiatives geared towards the eradication of the financial deficit so long as such initiatives did not further reduce the programs or decrease the number of activities to be implemented in the developing and least developed countries. These countries had received invaluable assistance from WIPO through its cooperation for development program in activities that had resulted in the strengthening of their intellectual property regimes and an increase in awareness of intellectual property issues among stakeholders and interested parties.

41. The Delegation of Dominica supported the statements made by the other Caribbean States. It recognized the demands placed on the Organization in meeting its objectives, including making intellectual property a useful tool for economic growth in all small developing countries. The Delegation therefore endorsed the proposed increase in the PCT filing fee.

42. The Delegation of Cuba indicated that it had taken note of the Director General's proposal and of the measures that had been taken to contain expenditure under the operational budget of the Organization. The Delegation considered that the matter was important, and supported the Director General's proposal to redress the financial situation by increasing the PCT filing fee. The Delegation also recognized that WIPO had to make efforts so as not to adversely affect the budget for the cooperation for development program.

43. The Delegation of Colombia acknowledged the efforts made by the Organization to reduce unnecessary expenditure. The Delegation hoped that these measures would contribute to striking a financial and budgetary balance. It believed that austerity policies aimed at reducing unnecessary expenditure should continue in the Organization in the short and medium terms. To be able to achieve that, it was necessary to implement the budget by defining priorities, using the available resources in a strategic and efficient manner. In this context, the Delegation believed that it was absolutely essential to financially strengthen the Organization to overcome the deficit it was now facing, thus making viable the programs and activities provided for in the Program and Budget for this biennium, thereby strengthening the Program and Budget to be drawn up for the coming biennium. The Delegation attached great importance to activities and programs for development cooperation. It was essential that they be strengthened and extended in 2005, with the expectation that this would have a positive impact in developing and least developed countries. Minimum reserve levels should not be affected but should be maintained according to what was established in the Reserve Funds policy. The Delegation was fully aware that the slowdown in growth in PCT filings for 2004 and the similar trend for the years to come, which was an unforeseen situation, had a negative effect on the Organization's budget, in particular the cooperation for development budget. Therefore, the Delegation considered that an adequate PCT fee level for next year, as suggested in document PCT/A/33/5, would contribute to solving the deficit situation the Organization was currently in. Therefore, the Delegation supported the proposal for the readjustment of the PCT filing fee.

44. The Delegation of Sudan endorsed the statement made by the Delegation of Egypt on behalf of the African Group and supported the increase in the PCT filing fee having regard to WIPO's present situation, with a view to allowing WIPO to continue to provide assistance to countries which needed it. It noted that there were many people, including students and workers in Sudan, who needed such support. The Delegation emphasized that the fee increase proposal had been endorsed by the responsible Minister of its Government.

45. The Delegation of Nicaragua expressed its conviction that intellectual property contributed to the economic, social and cultural development of countries and was an effective tool for economic development and wealth creation. The Delegation stressed that Nicaragua had made great efforts to show that protection and enforcement of intellectual property rights were vital to achievements of the country's objective of improving the standard of living of its citizens. The Delegation stressed that Nicaragua had made major steps in intellectual property issues, thanks to the support of WIPO and other organizations, such as the Secretary for Central American Economic Integration, the European Patent Office (with the LATIPAT project, format 32), the Spanish Patent and Trademark Office, the Mexican Institute of Industrial Property, the Mexican Institute of Copyright, the United States Patent and Trademark Office, and UPOV, among others. The Delegation emphasized that Nicaragua wished to progress further and demystify intellectual property so that entrepreneurs, workers, consumers, researchers and others could enjoy the added value offered by intellectual property. The Delegation emphasized that Nicaragua was fully committed to its new obligations to extend the protection of intellectual property rights. These obligations had been generated through new international commitments which had stemmed from the opening up of trade with Nicaragua's main trading partners. Nicaragua had felt the impact of WIPO's financial health problems, which had had a drastic effect on the country, meaning a drop of practically 60% percent in cooperation programs for Nicaragua, affecting important projects that would have benefited mostly intellectual property right holders, this figure being very high for a country which needed a lot of support. Given this percentage drop plus the need to complete regional projects in the area of intellectual property, Nicaragua supported the readjustment of the PCT filing fee as there was no other solution. However, the increase was needed as a temporary measure in order to allow, amongst other things, the reactivation of development cooperation activities which had been interrupted because of WIPO's financial situation. The Delegation requested that new cooperation activities be undertaken. It also recommended that the Director General implement urgent austerity and rationalization measures that should not affect cooperation for development.

46. The Delegation of India expressed its extreme concern about the precarious financial situation of WIPO. It therefore supported the proposal put to the Assembly by the Director General. It believed that the 12% increase proposed was a modest one, given that WIPO had followed in the past, and Members States had supported, a policy of a balanced budget. There seemed to be no alternative but to increase the fees, just as in surplus years, the Assembly had reduced fees so that the Reserve Funds did not become too large. The Delegation believed that a uniform practice of adjusting fees should be devised so as not to have a situation where there were substantial deficits in one year and substantial surpluses in another. There had been a revision of the fee structure last year. But as it was now understood and was understood then, it was always assumed that there could be a fine tuning if that was indeed what the practical situation demanded and, in the Delegation's view, that was exactly what was being seen today. The projections of PCT income and the expenditure of the Organization led to the inescapable conclusion that, unless the desire was to throttle the Organization, something needed to be done about increasing the fees just as something needed to be done to cut costs wherever possible. The Delegation acknowledged the Director General's intention to meet the deficit, in part, by cutting costs, while noting that an increase in the PCT filing fee was unavoidable. The Delegation stated that the view had been expressed, and the sentiment had been conveyed before and repeated today, that somehow PCT applicants were entitled to a scheme in which there were no charges other than operating costs, that should be levied on the income from PCT fees and that the PCT system should be run essentially as a "no loss no gain" system. It was probably useful to try to understand the

reasons that might underpin such an approach. Was development cooperation an unnecessary and undesirable charge on PCT income? That seemed to be a sentiment that had been articulated before, and there were also references to the disproportionate increase in the development cooperation budget. The Patent Offices in many of these countries also adjusted their fees to meet their expenditure. However, even if they did not do that, even if Member States wished to have a subsidized Patent Office, one where income from other parts of the government subsidized the Patent Office, it might make sense given that, in that particular country, the society might believe that the need to promote innovation was so great and the benefits to society so huge that the subsidy provided to Patent Offices through lower-than-cost application fees to patent applicants would achieve a desirable social objective. However, what was true of a national regime did not necessarily apply internationally. The Delegation pointed to the fact that the profits made by the intellectual property right holders might indeed have a positive impact on society, for example, by increasing job opportunities, investments, etc. These considerations did not apply across borders, and therefore, the idea of a subsidy or a less than fully funded Patent Office did not apply to what was essentially an international regime, for the simple reason that there were no cross-border benefits that accrued under this international system. Indeed, it could quite cogently be argued that the PCT fee system should be revenue maximizing. In other words, one could consider charging the highest PCT fees that would generate the largest revenue to the Organization for the simple reason that lower PCT fees benefited intellectual property right holders, an overwhelmingly large number of whom were in the developed countries, enabling them to secure monopoly rights in developing countries without any reverse flow of resources into developing countries. Not doing that and instead following a different system where the only additional charge expected to be borne by PCT applicants was to support a development cooperation system was, in fact, a very generous policy. WIPO could have instituted a much higher fee structure and, given the relative fee inelasticity of PCT applications, a huge increase in the revenue of WIPO would probably have been seen. The Delegation believed that the first claim on that added revenue would have been by developing countries. That added revenue was truly the income that should have flown to developing countries, given the fact that developing countries provide monopoly protection to the patent applicants of developed countries without getting very much in return. Wherever there was a system of monopolies, it was good policy to extract as much of the profit that monopolists would gain as possible by levying high fees. The Delegation stated that that was what was happening, for example, at the Federal Communications Commission in the United States of America which, in licensing the spectrum, would try to extract the maximum amount of revenue from those who sought to use certain parts of the spectrum, which of course was for the common good. Similarly, it would not have been altogether inappropriate for WIPO to have followed such a policy. But of course, given the fact that the power structure in today's world was very asymmetric, that might be an unrealistic thing to seek. However, at the very least, the development cooperation program of WIPO should be funded with substantial increases from year to year, from surpluses to be generated by the PCT system, given the fact that the PCT system was indeed a cut-price system as far as PCT applicants were concerned. The Delegation wished to dismiss once and for all the impression that development cooperation somehow represented an undeserving charge on PCT income and that every attempt should be made to cut development cooperation so that PCT applicants could get the benefit of lower fees. The Delegation was of the view that, by increasing the PCT fees significantly, the Member States would be able to strengthen the development cooperation sector of the Organization and perhaps reorient it along the lines discussed under Items 4 and 12 of the consolidated agenda of the Assemblies of the Member States of WIPO, so that benefits to developing countries from a fair global intellectual property system were realized. The Delegation recognized the difficult task before the International Bureau. It recognized the

pressures coming from the developed countries. The Delegation urged for recognition that the development cooperation sector was not an unnecessary charge on the system and that the hands should be strengthened of these officers responsible for giving good technical advice and for helping developing countries build a good legislative system and adopt good policies which were in their best interests.

47. The Delegation of Tajikistan expressed support for the statement made by the Delegation of Moldova on behalf of the Group of Central Asian, Caucasus and Eastern European States, as well as that by the Delegation of the Russian Federation. The Delegation noted that WIPO, at the very beginning of its work, had set out on the path of giving assistance to all countries concerned with intellectual property issues, and it had pursued that path until this day. However, in the light of the circumstances and for a number of reasons, there were now changes in the way in which WIPO was having to operate and there had been changes in its financial situation. It was clear from the Director General's report that, in order to enjoy sustainable development in the future, WIPO would be obliged to increase fees as proposed in document PCT/A/33/5. However, looking at the balance between expenditure and income, the rate of PCT filings had to be borne in mind as well as the overall objectives of WIPO. The Delegation felt that, that being so, it could be argued that a 40% fee increase would be required, while what was being proposed was a 12% increase. The Delegation was of the view that the proposed increase was economically justified and it was in the interests not only of WIPO but also of the sustainable development of intellectual property issues in all countries of the world. The Delegation concluded by supporting the proposal.

48. The Delegation of Japan stated that it was against the proposal. First of all, there was no substantial explanation in document PCT/A/33/5 of why the PCT international filing fee had to be revised. The document merely stated that "the international filing fee [...], if not readjusted now, would result in a significant shortfall of the PCT income." Member States did not know from this to what extent PCT income would decrease. The Delegation noted that the International Bureau had provided some data in the context of exchanges between the International Bureau and Group B. Although the Delegation appreciated the efforts made by the International Bureau in compiling that data, it was not satisfied with the way this had been done so far, from the procedural point of view. According to the explanation given in the course of consultations between the International Bureau and Group B, the Delegation had understood that the deficit in year 2005 would be 20 million Swiss francs even after the International Bureau proceeded to some expenditure reduction. It further understood that the International Bureau had proposed the increase in the PCT filing fee, in order to fill the deficit in the year 2005. The Delegation stated that the International Bureau had not done enough so far to persuade the Delegation to approve the proposal. Firstly, the Delegation wondered whether the International Bureau had made efforts to increase the number of PCT applications, such as, for example, by promotion activities, so that the deficit might become smaller. There were many actions that WIPO could take for applicants to use the PCT system. Secondly, although the Delegation noted the International Bureau's efforts to cut expenditure, yet more expenditure should be cut. For example, about half of the expenditure was for staff costs. If the administrative work was more streamlined, the number of staff might decrease. Thirdly, even if those two actions—namely trying to increase the number of PCT applications and trying to further reduce expenditure—were not enough, the Reserve Funds could be used to cover the deficit. The purpose of the Reserve Funds was to cover deficits (see document A/35/6). Although the level of the Reserve Funds would drop below their target if they were used at this stage, the Delegation believed that this should be accepted in this urgent and exceptional situation. The Delegation fully recognized that the income from the PCT system constituted the major part of WIPO's income. In such circumstances, it

was quite natural that the decrease of PCT income following the decrease in the number of PCT applications would hamper the smooth execution of WIPO's programs. However, the present situation in which WIPO's income depended on PCT income meant that the activities of WIPO depended on PCT users. The Delegation believed that, should WIPO think that the increase was inevitable in order for it to carry out its activities smoothly, WIPO should convince the PCT users that the increase of the international filing fee was necessary. However, the Delegation pointed out that there was no convincing explanation in document PCT/A/33/5 directed towards PCT users. The Delegation recalled that major users of the PCT system, represented by the Union of Industrial and Employers' Confederations of Europe (UNICE), the Japan Intellectual Property Association (JIPA), the Intellectual Property Owners Association (IPO) and the American Intellectual Property Association (AIPPI), had expressed their strong opposition to the proposal, by saying in a letter addressed to the Director General that "without a convincing justification, they must oppose the proposal for increasing the international filing fee at this time". This fact showed that WIPO had not succeeded in explaining the situation to PCT users. In the medium and long terms, the Delegation strongly hoped that WIPO would establish means to make accurate forecast of both the number of PCT applications and the level of PCT income. Furthermore, WIPO should streamline PCT administrative work more by computerizing processes. Finally, in the course of discussion on the Program and Budget for the next biennium, the appropriate level of PCT fees should be discussed, taking into consideration the extent of computerizing of processes and the introduction of business accounting methods which the Delegation had asked WIPO to consider.

49. The Delegation of Ghana endorsed the statement made by the Delegation of Egypt, on behalf of the African Group, and strongly supported the proposal for an increase of 12% in the PCT filing fee. Ghana considered the request as an urgent appeal by the Organization for funds to enable it to implement its programs. It was common knowledge that many excellent managers had not been able to implement their programs because of budgetary constraints. Many initiatives had been stifled for lack of resources. It was for this simple reason that the Delegation was proposing that this urgent appeal from the Organization be considered as a short-term measure to secure the resources enabling the Organization to continue with its good work while other solutions were found to put the Organization on a sound financial footing. Other solutions should be considered as medium and long-term measures.

50. The Delegation of Canada expressed support for a sound financial basis for WIPO and the continuation of its services and programs. However, at this stage, the Delegation could not support a fee increase. The difficulty was that the current documentation lacked the financial information that would allow a transparent discussion to take place on the issue. The Delegation supported referring the matter to the Program and Budget process, as had been suggested by other delegations.

51. The Delegation of Kyrgyzstan recalled the discussions on the present point which were held in connection with item 4 of the Consolidated Agenda of the Assemblies of the Member States of WIPO, and wished once again to express support for the Director General and the International Bureau on the issue of increasing the PCT filing fee as described in document PCT/A/33/5. The Delegation also supported the view put forward by the Delegation of Moldova on behalf of the Group of Central Asian, Caucasus and Eastern European States as well as the view that had been taken by the Industry Council of the Commonwealth of Independent States on this particular issue. The Delegation believed that, given the fact that there were fluctuations in the level of PCT fees, a fee increase was required in order to ensure that WIPO was able to undertake all of its work. The Delegation noted that, at present,

because of market circumstances, the number of PCT applications had fallen. But it had to be understood that such fluctuations were not something that would always occur. In terms of the overall strategy for PCT fee setting in future, the Delegation was of the view that this matter should be looked at within the Program and Budget Committee of WIPO in order to determine a long-term strategy for these fees. The Delegation did, however, believe that the proposed adjustment was required and should be introduced as soon as possible in order to ensure that the budgetary deficit was eliminated as soon as possible for the financial health of the Organization.

52. The Delegation of Spain supported the statements made by the Delegation of Canada, on behalf of Group B, and by the Delegation of the Netherlands, on behalf of the European Community and its Member States. The Delegation commented that it would be useful to take some of the drama out of this debate. The discussions were not about highly political issues, but were more prosaic. As in many organizations, the budget approved last year for WIPO needed to be adjusted to reality. It had been approved on the basis of variables, and reality had not played out as predicted. Therefore, there was a deficit which could be faced up to in two ways, either by increasing income or by reducing expenditure. In the Delegation's opinion, it would be necessary to do both things. The Delegation believed that the intention as a whole did recognize that need. However, some delegations considered that the specific proposal was isolated and outside the broader context, and required further justification. The Delegation therefore believed that the most logical solution was that the proposal, together with other proposals dealing with expenditure, be submitted through the normal budgetary procedure. They could then be studied together with other options prepared by the International Bureau in the normal budgetary process which, given the seriousness of the situation, might be brought forward.

53. The Delegation of Zambia, referring to the past reports of the Assembly concerning reductions in PCT fees, had been impressed by the consistency of the trend. Almost all of the reports concerning fee decreases stated that the Assembly had unanimously adopted the reduction of the fees. Nowhere was there any recommendation to take the proposals to the Program and Budget Committee, nor to the next session of the Assembly. Again, nowhere in the past reports concerning reductions did the Assembly subject a proposal to the stringent preconditions now being discussed. Having listened to all the delegations who had spoken, the Delegation noted that there had been many more expressing views in favor of the proposal by the International Bureau than opposing it, and urged all those who had raised reservations to go along with the larger part of the membership which supported the proposal.

54. The Delegation of Switzerland stated that, even though it wished to see the Organization in good financial health, it had found, like many other delegations, that it was not in a position to take a decision on this at this time. The information that would be required to take such a decision was not available and the Delegation wished to continue to engage in this discussion at a later stage.

55. The Delegation of Saint Vincent and the Grenadines expressed concerns on the current financial situation of WIPO and the negative impact that this had had on several areas of WIPO's work, including its cooperation for development activities. The Delegation considered that a positive decision on the proposal was absolutely critical to the development of intellectual property systems in small developing countries such as Saint Vincent and the Grenadines. The Delegation considered that those who welcomed benefits in any sphere should embrace corresponding responsibilities. The PCT filing system provided an opportunity unparalleled in efficacy for innovators to widely protect and commercially exploit

the product of their efforts. Opportunities for the strengthening of the intellectual property systems that served these innovators must be no less pervasive. For this reason the Delegation fully supported the proposed readjustment of the international filing fee.

56. The Delegation of Chile stated that, even though Chile was still not a member of the PCT Union, given the importance of the PCT now in funding the activities of WIPO, it felt entitled to intervene in this debate, especially because Chile was very concerned with the current financial health of the Organization. The PCT fees had become the main source of income of the entire WIPO budget. Therefore, an increase or decrease in PCT fees had a direct impact on the funding of all activities carried out by the Organization. That was why the Delegation supported the proposal made by the Director General, taking into account that it was both a very modest and very serious proposal.

57. The Delegation of the United Kingdom expressed support for the statements made by the Delegation of Canada on behalf of Group B and by the Delegation of the Netherlands on behalf of the European Community and its Member States. However, the Delegation felt that it needed to respond to some of the comments made during the debate. It had been said that a fee increase was inevitable if development work was not going to suffer; it had also been said that it was acceptable to increase PCT fees at will and that this would not affect demand. None of that was correct. Resources had to be used effectively before taxes were levied on industry. The information needed to make the assessment was not available but needed to be made available. The Delegation was confident that development related work could be maintained by using the Reserve Funds without risking the future of the Organization. The Delegation therefore supported what had been said on behalf of Group B and the European Union.

58. The Delegation of Haiti supported the view that had been previously expressed by Caribbean countries. Despite the fact that Haiti was not as yet a member of the PCT Union, the Delegation believed that the International Bureau's proposal for readjustment of the PCT filing fee deserved whole-hearted support. Given the fact that cooperation programs that were of benefit to the least developed countries in particular made intellectual property a real tool for development, the Delegation felt that the Assembly should not allow this particular tool to suffer from a lack of resources.

59. The Delegation of El Salvador recalled that El Salvador was not yet a member of the PCT Union but was making all efforts and taking concrete action so as to become a member in the near future. The Delegation took a very positive view of the proposed fee increase. For El Salvador, it was very important to stress the positive impact that an increase of the PCT filing fee would have on funding for the development cooperation activities of the Organization. The negative impact on such activities caused by the shortfall experienced was already being felt. The Delegation also felt, however, that serious austerity measures and expenditure reduction in areas which were not priority areas for the Organization had to be considered.

60. The Delegation of Monaco expressed support for the statements made on behalf of Group B, and by the Delegation of the Netherlands on behalf of the European Community and its Member States, and by other delegations. It approved the idea of having a sound financial basis for the Organization but, at present, because of a lack of necessary information, it could not approve an increase in fees. For that reason the Delegation believed that this matter should be discussed further.

61. The Delegation of Iran (Islamic Republic of) was also of the opinion that the proposal made by the Secretariat for a PCT fee increase was a positive step and that it should be supported.

62. The Representative of AIPPI recalled that AIPPI represented the community of users from industry, including small and medium-sized industries, and also their representatives. The Representative first stressed that the PCT was a means for patent applications filing that was appreciated by applicants. The Representative stated that AIPPI was happy with the services which were obtained from the staff of the Office of the PCT. A telephone call to the staff was always a great help when problems arose and it was hoped that things would remain that way. It followed that AIPPI was particularly sensitive to any change in the PCT system and in particular to changes in fees. AIPPI members would have to explain to applicants why a fee increase was taking place. While they would show understanding if good reasons were given, for instance, based on increases in staff costs, or the introduction of new technical measures, industry applicants were nowadays looking very strongly at reducing costs. Filing under the PCT cost more than filing under the traditional Paris Convention route. Additional costs were often unavoidable but were sometimes welcome, such as, for example, in connection with the extended 30-month time limit for entry into the national phase. However, the Representative expressed a warning that any significant fee increase might result in a certain reluctance by applicants to use the PCT system. The Representative reported on the results of a questionnaire which had been distributed to the members of AIPPI, the replies to which had been 99% negative; indeed, there was only one country, India, in which a majority of attorneys voting had been in favor of the fee increase. Until more information was available as to why the fee increase was necessary, the Representative was unable to agree to the proposal and asked for discussion on the matter to be deferred.

63. The Representative of AIPLA recalled that AIPLA had more than 15,000 members representing independent and employed inventors in the United States of America and over 30 other countries. AIPLA had long been a strong supporter of WIPO and its development cooperation program, a significant portion of which was supported by the fees paid by applicants from the United States of America who represented 36% of the total number of applicants. AIPLA did not object to the use of PCT fee income to support development activities, but there were limits as to how much PCT applicants should have to support these and other non-PCT related activities of WIPO. The Director General had said that the failure to increase the PCT filing fee would cripple WIPO, yet no analysis or explanation of why this was the case had been presented. The lack of transparency of the WIPO budget made it impossible to determine whether the proposed PCT increase was necessary or justified. In connection with the 2004-2005 biennium, Table 7 of document WO/PBC/7/2 revealed that the total PCT fee income would be 505 million Swiss francs. However, Table 9.3 of that document showed that only 125 million Swiss francs would go directly to funding the costs of operating the PCT. Undoubtedly there were other costs associated with PCT operations not reflected in Table 9.3, but the Representative was unable to determine what those costs were. Similarly, no information was available as to how the remainder of the PCT fee income was being used. The Representative stressed that the fees concerned were fees paid by the clients of AIPLA members and the latter were not able to explain to the former where their fees were going. Until and unless there was an adequate explanation and justification as to where the remaining 375 million Swiss francs were going, AIPLA urged the PCT Assembly to defer the proposed fee increase.

64. The Secretariat noted that the present situation was basically due to a difference between the projections that were made in connection with the Program and Budget for the

biennium 2004-2005 and the reality being faced now. This difference was mainly due to certain projections made in respect of the PCT. Compared to the number of applications which were budgeted for in the Program and Budget approved by Member States last September, according to the latest estimates on PCT, it was expected that in this biennium there would be 30,000 PCT applications fewer than projected. Furthermore, based on data now available, the average fee that applicants would pay in this biennium would be well below the average that was approved in the context of approving the Program and Budget and which was taken as a reference for all the underlying financial assumptions. A further factor was that last year, at the previous session of the Assembly, the international filing fee had been proposed to be fixed at 1,450 Swiss francs but the fee then fixed had been 1,400 Swiss francs, that is, 50 Swiss francs less, which introduced a further shortfall in the budget of about 12 million Swiss francs. The combined shortfall caused by the above three factors was about 70 million Swiss francs. Referring to the intervention by the Delegation of Japan, the Secretariat clarified that, if the Organization were to implement its activities as approved by Member States, it would face a deficit of 70 million Swiss francs, which was not sustainable. If the Organization had to recover this income shortfall only by raising fees, the adjustment needed would not be a 12% increase but about 20%, if it had taken effect on January 1, 2004.

65. The Secretariat observed that, since the authorized level of the budget expenditure could not be sustained in view of the income shortfall, a number of very severe costs saving measures would need to be taken. In reply to some observations which were made in several interventions, the Secretariat confirmed that, due to these cost saving measures, programs all over the Organization were being affected, including development cooperation, and the level of delivery was well below that which had been possible during the past biennium.

66. The Secretariat also recalled that the level of Reserve Funds had been established by the Member States in a decision in 2001. In the view of the Secretariat, if the Reserve Funds were depleted beyond a certain limit, there would be a risk for the Organization, which the Member States needed to appreciate. There were also longer-term avenues which had been and would continue to be explored, but the measure being considered now was a short-term measure necessary in order to maintain a minimum level of operations for the Organization, so as not to disrupt programs and not to take financial risks. The Secretariat underlined that, in spite of these measures, even if the income could be adjusted in 2005 through this proposed adjustment of 12% in the PCT fee, it would still be necessary to continue a severe program of budgetary restraint and further rationalization of the work of the Organization.

67. The Secretariat added that postponement by a few months of a decision on the question would indeed allow more time for the Organization to address the matter and to refine its predictions of income and expenditure. However, a decision on the level of PCT fees was not one for the Program and Budget Committee, as several delegations had pointed out, but for the PCT Assembly. It was noted that convening an extraordinary session of the Assembly would cost approximately 900,000 Swiss francs for delegates' travel expenses, according to the established rules. The Assembly needed to choose between deciding now on an increase of 12% to be effective from January 1, 2005, and deferring a decision to the next scheduled session of the Assembly which would delay implementation by one year. The Secretariat noted that the opinion of the external auditors requested by Group B had indicated that there was no immediate risk. It was of course a matter for the Member States to assess the risks. The Secretariat reiterated that the proposed 12% of the PCT filing fee did not represent an increase in the budget nor an increase in Member States contributions. It would not be a precedent for other international organizations. Rather, the fee increase would be shared

among applicants, who had in fact benefited from some 40% reduction during the past few years.

68. The Secretariat noted that the proposed 12% adjustment should bring in approximately 20 million Swiss francs in income which would apply together with savings of about 30 million Swiss francs in operational expenditures in the current biennium. These proposals could be implemented at the same time as efforts would be continued to refine budgetary predictions.

69. In response to a question from the Delegation of the United States of America, the Secretariat clarified that, at the 2003 session of the Assembly, the amount of the international filing fee had been fixed at 1,400 Swiss francs, which was 50 francs less than what had been proposed by the International Bureau. It was somewhat difficult to compare the level of fees payable before and after that change, because the overall fee structure itself had changed at the same time. However, it could be said that applicants on average would have to pay a slightly higher filing fee in 2004 than in 2003, although some applicants would pay less.

70. The Assembly adopted the following decision:

(a) Consideration of the proposal on the adjustment of PCT fees should be continued beyond the 2004 WIPO Assemblies to reach a conclusion.

(b) The PCT Assembly recommends to the WIPO General Assembly that, as soon as possible, there should be a session of the Program and Budget Committee that should analyze, *inter alia*, any readjustment of PCT fees.

(c) An extraordinary session of the PCT Assembly should be convened, if needed, to consider any proposal on the adjustment of PCT fees. In order to minimize the cost of such an extraordinary session, Rule 84.1 of the Regulations Under the PCT should be applied in this particular instance.

(d) The PCT Assembly takes note of the concerns expressed regarding the possible impact of any delay in decision making on adjustment of PCT fees on the implementation of WIPO's program activities, in particular, on its cooperation for development programs.

(e) The PCT Assembly was informed that in order to maintain its present level of technical and development assistance, WIPO will have to draw on its reserves.

71. The Delegation of Egypt, speaking on behalf of the African Group, stated that the Group would have preferred that the outcome of the discussions be the adoption of the readjustment of fees in order to enable the Organization to maintain the level of its activities, in particular its cooperation for development activities. Nevertheless, the Group accepted the decision of the Assembly and, in doing so, wished to thank in particular all those delegations which had expressed understanding with respect to the importance for the Group that the decision reflect the concerns of the Group.

72. The Delegation of Morocco expressed its support for the statement made by the Delegation of Egypt, on behalf of the African Group in respect of the International Bureau's proposal relating to an increase in PCT fees, and regretted that the Assembly could not adopt the proposal. Adoption of the proposal would have contributed to the enhancement to the

work of the Organization in every program and activity. The Delegation declared itself unsatisfied with the results in view of the fact that other delegations could not accept the proposal. It hoped also that a decision on the proposal would be taken as soon as possible.

73. The Acting Chair emphasized that the decision of the Assembly precisely focused on the concerns expressed by the Delegation of Morocco, in highlighting the Organization's commitment to improve the way in which resources were spent and used. This was also a confirmation of the statements made by the Director General and by other members of the Secretariat in the course of the discussion on this matter. The Acting Chair reiterated that the adopted decision was proof of the common desire to improve the activities of the Organization.

74. The Secretariat stated that, following the decision adopted by the Assembly on the question of the proposed readjustment of PCT fees, and pending the holding of the session of the Program and Budget Committee referred to in that decision, the International Bureau wanted to put on record that, in view of the estimated income shortfall of about 70 million Swiss francs in the 2004-2005 biennium, pending any adjustment of PCT fees, even after postponing the new construction and reducing its operational expenditure of 5%, in order to maintain the present level of delivery of its programs, including its cooperation for development programs, the International Bureau would have to deplete its reserve by an estimated amount of 40 million Swiss francs. In proposing to the Assembly, through document PCT/A/33/5, a 12% adjustment of PCT fees as of January 1, 2005, the International Bureau had actually chosen a different solution, which would have permitted to contain the current budgetary imbalance within, and therefore limit depletion of the reserve by an estimated amount of 20 million Swiss francs. In the current circumstances and in view of the policy on reserve adopted by Member States in the year 2002, the International Bureau believed that such limited depletion of the reserve would have represented more prudent financial management. In this connection, the International Bureau also recalled that the Report on the Auditing of the Accounts of the World Intellectual Property Organization (WIPO), for the 2002-2003 biennium, dated July 15, 2004, and forwarded to Member States in July 2004, contained the following recommendation: "I consider the Reserve Funds to be a matter of sufficient concern for WIPO to be encouraged to monitor their levels with all due care, and also to take all appropriate action with a view to restoring budgetary balance on the one hand and on the other hand the levels of the Reserve Funds in such a way as to allow them, should the need arise, to perform the function for which they were constituted".

75. The Acting Chair thanked the Secretariat for clearly setting out again the budget situation for the period to come, as well as for reminding the Assembly that the Organization would be much more careful in how resources were spent.

76. The Delegation of the United States of America stated that, having heard the International Bureau's analysis of the situation, it wished to note for the record that the Delegation did not agree with that analysis and that it looked forward to examining further the financial situation in the Program and Budget Committee. As the Delegation had noted during informal consultations, the figures quoted by the International Bureau were based on a budget that did not comport with the fee level that had been established, last year by the Assembly. The Delegation concluded by saying that it looked forward to working on this issue constructively.

Report on the Quality Management System for International Authorities Under the PCT

77. Discussions were based on document PCT/A/33/6.

78. The Delegation of the United Kingdom recalled that it had played an instrumental role in the introduction of the quality framework set out in the PCT International Search and Preliminary Examination Guidelines and very much welcomed the “Stage 1” report in the Annex to document PCT/A/33/6. The report showed that there had been good progress on the matter and commitment on the part of the Meeting of International Authorities under the PCT (PCT/MIA). The Delegation requested that, as part of the “Stage 2” reporting process under which the International Authorities would report results annually to PCT/MIA, the PCT/MIA transmit an overview of the Stage 2 reports to the Assembly. The International Bureau indicated that it would request the PCT/MIA to provide such a report.

79. The Assembly noted the contents of the report contained in the Annex to document PCT/A/33/6.

80. The Delegation of Egypt expressed its appreciation to the Director General and the staff of the Organization and, particularly, the Economic Development Bureau for Arab Countries, for their support and assistance to modernize industrial property offices in the Arab world and in particular the Egyptian Patent Office. The Delegation emphasized the need for WIPO to have adequate and sufficient funding to carry out its activities, and thus supported the readjustment of PCT fees suggested by the International Bureau. The Delegation reported that the Egyptian Patent Office had become a PCT receiving Office and that operations had been successful from the outset. In addition to individuals, an increasing number of local companies and firms were filing PCT applications with the Office. In that respect, the Delegation requested that the possibility of extending the 75% reduction of certain PCT fees currently applying to individuals from developing countries to companies of such countries, so as to further encourage PCT filings, be examined. The Delegation underlined the increasing importance granted to intellectual property protection in Egypt at all levels, and in particular among decision-makers. In this context, the Delegation emphasized the priority given by Egypt to the modernization of its intellectual property system and to continue benefiting from WIPO’s assistance in this regard. In this context, the Delegation reported that the Egyptian Patent Office was in the final stages of establishing an electronic network linking it with all relevant national industrial and scientific research institutions, in order to facilitate patent filings. In addition, the Delegation reported that the Egyptian Patent Office operated now with a precise electronic system, which contributed to efficient internal patent processing, and ensured that the processing period within the Office had become comparable to that in the most advanced Patent Offices. The Delegation emphasized the importance it attached to the use of the electronic filing system under the PCT and requested that the Egyptian Patent Office be included in the PCT-ROAD project in order to facilitate filing procedures for companies and research institutions. As the Delegation had stated at the previous session of the Assembly in 2003, Egypt attached great importance to Arabic becoming an international publication language in the PCT, in the context of the preparations of the Egyptian Patent Office to present a request in the future to the Organization to be designated as an International Searching and Preliminary Examining Authority under the PCT for PCT applications filed in the Arabic language, taking into consideration the significant investments in human resources and automation tools already made by the Office in order to perform such a task. The Delegation reiterated the commitment of the Egyptian Patent Office to continue its cooperation with WIPO in relation to the training of personnel in Arab Industrial Property Offices in the Arab world. Finally, the Delegation wished to inform the

meeting that the ninth meeting of Arab Ministers of Higher Education and Scientific Research took place earlier this year in Damascus and recommended the establishment of a single Patent Office in the Arab world, with the Egyptian Patent Office being at the core of such an Office. In this context, the Delegation asked for continued support and assistance from WIPO.

[Annex follows]

ANNEX

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on April 1, 2005¹)

Rule 3
The Request (Form)

3.1 and 3.2 [No change]

3.3 *Check List*

(a) The request shall contain a list indicating:

(i) [No change]

(ii) where applicable, that the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a sequence listing in electronic form, a document relating to the payment of fees, or any other document (to be specified in the check list);

(iii) [No change]

(b) [No change]

3.4 [No change]

Rule 4
The Request (Contents)

4.1 to 4.5 [No change]

4.6 *The Inventor*

(a) Where Rule 4.1(a)(iv) 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.

(b) and (c) [No change]

4.7 to 4.18 [No change]

¹ See paragraph 11 of the main body of this report for details concerning entry into force and transitional arrangements.

Rule 13ter
Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Procedure Before the International Searching Authority

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the International Searching Authority may invite the applicant to furnish to it, for the purposes of the international search, a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, unless such listing in electronic form is already available to it in a form and manner acceptable to it, and to pay to it, where applicable, the late furnishing fee referred to in paragraph (c), within a time limit fixed in the invitation.

(b) Where at least part of the international application is filed on paper and the International Searching Authority finds that the description does not comply with Rule 5.2(a), it may invite the applicant to furnish, for the purposes of the international search, a sequence listing in paper form complying with the standard provided for in the Administrative Instructions, unless such listing in paper form is already available to it in a form and manner acceptable to it, whether or not the furnishing of a sequence listing in electronic form is invited under paragraph (a), and to pay, where applicable, the late furnishing fee referred to in paragraph (c), within a time limit fixed in the invitation.

(c) The furnishing of a sequence listing in response to an invitation under paragraph (a) or (b) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee whose amount shall be determined by the International Searching Authority but shall not exceed 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, provided that a late furnishing fee may be required under either paragraph (a) or (b) but not both.

(d) If the applicant does not, within the time limit fixed in the invitation under paragraph (a) or (b), furnish the required sequence listing and pay any required late furnishing fee, the International Searching Authority shall only be required to search the international application to the extent that a meaningful search can be carried out without the sequence listing.

(e) Any sequence listing not contained in the international application as filed, whether furnished in response to an invitation under paragraph (a) or (b) or otherwise, shall not form part of the international application, but this paragraph shall not prevent the applicant from amending the description in relation to a sequence listing pursuant to Article 34(2)(b).

(f) Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to submit the required correction. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

13ter.2 Procedure Before the International Preliminary Examining Authority

Rule 13ter.1 shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

13ter.3 Sequence Listing for Designated Office

No designated Office shall require the applicant to furnish to it a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

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.

(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):

(i) and (ii) [No change]

(d) and (e) [No change]

16bis.2 [No change]

Rule 23
Transmittal of the Search Copy, Translation and Sequence Listing

23.1 Procedure

(a) and (b) [No change]

(c) Any sequence listing in electronic form which is furnished for the purposes of Rule 13ter but submitted to the receiving Office instead of the International Searching Authority shall be promptly transmitted by that Office to that Authority.

Rule 40
Lack of Unity of Invention
(International Search)

40.1 *Invitation to Pay Additional Fees; Time Limit*

The invitation to pay additional fees provided for in Article 17(3)(a) shall:

(i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention;

(ii) invite the applicant to pay the additional fees within one month from the date of the invitation, and indicate the amount of those fees to be paid; and

(iii) invite the applicant to pay, where applicable, the protest fee referred to in Rule 40.2(e) within one month from the date of the invitation, and indicate the amount to be paid.

40.2 *Additional Fees*

(a) The amount of the additional fees due for searching under Article 17(3)(a) shall be determined by the competent International Searching Authority.

(b) The additional fees due for searching under Article 17(3)(a) shall be payable direct to the International Searching Authority.

(c) Any applicant may pay the additional fees 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 fees is excessive. Such protest shall be examined by a review body constituted in the framework of the International Searching Authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fees. 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.

(d) The membership of the review body referred to in paragraph (c) may include, but shall not be limited to, the person who made the decision which is the subject of the protest.

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee. Where the applicant has not, within the time limit under Rule 40.1(iii), paid any required protest fee, the protest shall be considered not to have been made and the International Searching Authority shall so declare. The protest fee shall be refunded to the applicant where the review body referred to in paragraph (c) finds that the protest was entirely justified.

40.3 [Deleted]

Rule 43bis
Written Opinion of the International Searching Authority

43bis.1 Written Opinion

(a) Subject to Rule 69.1(b-bis), the International Searching Authority shall, at the same time as it establishes the international search report or the declaration referred to in Article 17(2)(a), establish a written opinion as to:

(i) and (ii) [No change]

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

(b) and (c) [No change]

Rule 44
Transmittal of the International Search Report, Written Opinion, Etc.

44.1 Copies of Report or Declaration and Written Opinion

The International Searching Authority shall, on the same day, transmit one copy of the international search report or of the declaration referred to in Article 17(2)(a), and one copy of the written opinion established under Rule 43bis.1 to the International Bureau and one copy to the applicant.

44.2 and 44.3 [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).

(c) [No change]

Rule 68
Lack of Unity of Invention
(International Preliminary Examination)

68.1 [No change]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, the invitation shall:

(i) specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement;

(ii) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention;

(iii) invite the applicant to comply with the invitation within one month from the date of the invitation;

(iv) indicate the amount of the required additional fees to be paid in case the applicant so chooses; and

(v) invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(e) within one month from the date of the invitation, and indicate the amount to be paid.

68.3 *Additional Fees*

(a) The amount of the additional fees due for international preliminary examination under Article 34(3)(a) shall be determined by the competent International Preliminary Examining Authority.

(b) The additional fees due for international preliminary examination under Article 34(3)(a) shall be payable direct to the International Preliminary Examining Authority.

(c) Any applicant may pay the additional fees 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 fees is excessive. Such protest shall be examined by a review body constituted in the framework of the International Preliminary Examining Authority which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fees. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the elected Offices as an annex to the international preliminary examination report.

(d) The membership of the review body referred to in paragraph (c) may include, but shall not be limited to, the person who made the decision which is the subject of the protest.

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a protest fee. Where the applicant has not, within the time limit under Rule 68.2(v), paid any required protest fee, the protest shall be considered not to have been made and the International Preliminary Examining Authority shall so declare. The protest fee shall be refunded to the applicant where the review body referred to in paragraph (c) finds that the protest was entirely justified.

68.4 and 68.5 [No change]

Rule 69

Start of and Time Limit for International Preliminary Examination

69.1 Start of International Preliminary Examination

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of all of the following:

(i) and (ii) [No change]

(iii) either the international search report or the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established, and the written opinion established under Rule 43*bis*.1;

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

(b) and (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) and (ii) [No change]

(iii) the expiration of the applicable time limit under Rule 46.1.

(e) [No change]

69.2 [No change]

Rule 76
Translation of Priority Document;
Application of Certain Rules to Procedures Before Elected Offices

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

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

Rules 13^{ter}.3, 22.1(g), 47.1, 49, 49^{bis} and 51^{bis} shall apply, provided that:

(i) to (v) [No change]

[End of Annex and of document]

WIPO



PCT/A/34/6

ORIGINAL: English

DATE: October 5, 2005

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirty-Fourth (15th Ordinary) Session
Geneva, September 26 to October 5, 2005

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/41/1): 1, 2, 3, 4, 5, 6, 21, 23, 26, 28 and 29.
2. The report on the said items, with the exception of item 21, is contained in the General Report (document A/41/17).
3. The report on item 21 is contained in the present document.
4. Mrs. Nadia Ibrahim Mohamed Abdallah (Egypt) was elected Chair of the Assembly; Mr. Yin Xintian (China) and Mr. Paul E. Salmon (United States of America) were elected Vice-Chairs.
5. Mrs. Nadia Ibrahim Mohamed Abdallah presided over the meeting of the Assembly. Mr. Enrique Manalo (Philippines), Chair of the General Assembly, presided over the adoption of the Report.

ITEM 21 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Reform of the PCT

6. Discussions were based on document PCT/A/34/1.

7. The Delegation of Kenya supported the proposals in the document. Of particular interest to Kenya were matters concerning restoration of the right of priority and central recording of changes by the International Bureau, which would be very beneficial to applicants. The Delegation supported the further work of the Working Group, especially any reforms which served to simplify filing procedures and to safeguard the interests of applicants.

8. The Assembly:

(i) noted the report of the seventh session of the Working Group on Reform of the PCT contained in document PCT/R/WG/7/13 and reproduced in the Annex of document PCT/A/34/1; and

(ii) unanimously approved the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2005 and September 2006 sessions of the Assembly, subject to the availability of sufficient funds, including the matters to be considered, the convening of sessions of the Working Group and possibly the Committee on Reform of the PCT, and financial assistance to enable attendance of certain delegations, as set out in paragraph 22(i) and (ii) of document PCT/A/34/1.

Proposed Amendments of the PCT Regulations

9. Discussions were based on documents PCT/A/34/2 Rev. and 3.

10. The Secretariat informed the Assembly that the producer of the CD-ROM version of the PCT Gazette had given notice of termination of its contract with effect from the end of 2005, but that the International Bureau was investigating alternative ways of providing the information in CD-ROM form. The International Bureau wished to confirm that it would still meet the undertaking, given in Annex V, paragraph 11 of document PCT/A/34/2 Rev., to continue to provide a CD-ROM version of the PCT Gazette to any Office or Authority which preferred to receive it in that form rather than online via WIPO's website.

11. The Delegation of Algeria stated that it had supported the process of PCT reform since it began and therefore welcomed the progress which had been made and hoped that all outstanding points would be dealt with in a manner satisfactory to everybody. The Delegation generally supported the proposals set out in document PCT/A/34/2 Rev. but had a reservation with respect to the proposed amendment of Rule 49^{ter}.2 concerning the restoration of the right of priority subsequent to the period of 12 months provided under the Treaty. The Delegation considered that such an amendment should have been introduced in the Treaty itself. The Delegation stated that it was not opposed to the principle of restoration of the right of priority, but it indicated that the proposed amendments of the Regulations would be incompatible with the national law of Algeria. The Delegation requested that its reservation therefore be noted.

12. In connection with the proposed amendments of Rule 34 set out in Annex III to document PCT/A/34/2 Rev., dealing with the addition of patent documents of the Republic of Korea to the PCT minimum documentation, the Assembly noted the results of the consideration of the matter by the PCT Committee for Technical Cooperation at its 21st session, which was convened during the same period as the Assembly's session (see document PCT/CTC/21/4). The Assembly accepted the recommendation of that Committee that, for reasons of administrative convenience, the proposed amendments of Rule 34 be adopted with the same date of entry into force as the amendments set out in Annex II to document PCT/A/34/2 Rev., and noted the advice of that Committee that, notwithstanding the date of entry into force of the proposed amendments of Rule 34, the International Searching Authorities intended to include the relevant documentation in their databases at the earliest possible date and in any event by January 1, 2007 (see document PCT/CTC/21/4, paragraph 7(iii) and (iv)).

13. The Assembly adopted:

- (i) the amendments of the Regulations under the PCT set out in Annexes I and II;
- (ii) the decisions set out in Annex III relating to entry into force and transitional arrangements in respect of those amendments; and
- (iii) the understandings set out in Annex IV in respect of certain of those amendments.

Report on Quality Management Systems for PCT International Authorities

14. Discussions were based on document PCT/A/34/4.

15. The Assembly noted the report on quality management systems for PCT International Authorities contained in document PCT/A/34/4.

Status Report on PCT Automation

16. Discussions were based on document PCT/A/34/5.

17. The Secretariat recalled that a revised approach to PCT automation was taken in 2003 and emphasized that the progress made in the area of PCT Automation and PCT Information Systems was further confirmation of the success of that approach. The Secretariat also stated that this approach, together with the ongoing cooperation of PCT Contracting States, would enable it to continue to demonstrate similar progress in the future.

18. The Assembly noted the status report on PCT automation contained in document PCT/A/34/5.

[Annexes follow]

ANNEX I

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¹ See Annex III for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 4³
The Request (Contents)

4.1 to 4.8 [No change]

4.9 *Designation of States; Kinds of Protection; National and Regional Patents*

(a) [No change]

(b) Notwithstanding paragraph (a)(i), if, on October 5, 2005, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request in which the priority of an earlier national application filed in that State is claimed may contain an indication that the designation of that State is not made, provided that the designated Office notifies the International Bureau by January 5, 2006, that this paragraph shall apply in respect of designations of that State and that the notification is still in force on the international filing date. The information received shall be promptly published by the International Bureau in the Gazette.

4.10 to 4.18 [No change]

³ See Annex II for further amendments entering into force on April 1, 2007.

Rule 13bis
Inventions Relating to Biological Material

13bis.1 to 13bis.3 [No change]

13bis.4 *References: Time Limit for Furnishing Indications*

(a) to (c) [No change]

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

(i) if the indication was received before the technical preparations for international publication have been completed, publish the indication furnished under paragraph (a), and an indication of the date of receipt, together with the international application;

(ii) [No change]

13bis.5 to 13bis.7 [No change]

Rule 26bis⁴
Correction or Addition of Priority Claim

26bis.1 [No change]

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

(a) and (b) [No change]

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

⁴ See Annex II for further amendments entering into force on April 1, 2007.

Rule 47
Communication to Designated Offices

47.1 *Procedure*

(a) and (a-*bis*) [No change]

(a-*ter*) [Deleted]

(b) to (e) [No change]

47.2 to 47.4 [No change]

Rule 48⁵
International Publication

48.1 *Form and Means*⁶

The form in which and the means by which international applications are published shall be governed by the Administrative Instructions.

48.2 *Contents*⁷

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

- (i) a standardized front page;
- (ii) the description;
- (iii) the claims;
- (iv) the drawings, if any;
- (v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a);
- (vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4;
- (vii) any request for rectification referred to in the third sentence of Rule 91.1(f);
- (viii) the indications in relation to deposited biological material furnished under Rule 13*bis* separately from the description, together with an indication of the date on which the International Bureau received such indications;
- (ix) any information concerning a priority claim considered not to have been made under Rule 26*bis*.2(b), the publication of which is requested under Rule 26*bis*.2(c);
- (x) any declaration referred to in Rule 4.17, and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1.

(b) to (e) [No change]

(f) If the claims have been amended under Article 19, the publication of the international application shall contain the full text of the claims both as filed and as amended. 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.

⁵ See Annex II for further amendments entering into force on April 1, 2007.

⁶ The text of amended Rule 48.1 derives from present Rule 48.1(b); present Rule 48.1(a) is deleted.

⁷ Rule 48.2(a)(i) to (iv), (vi), (vii) and (ix) are amended in the English text only.

[Rule 48.2, continued]

(g) If, at the time of the completion of the technical preparations for international publication, the international search report is not yet available, the front page shall contain an indication to the effect that that report was not available and that the international search report (when it becomes available) will be separately published together with a revised front page.

(h) If, at the time of the completion of the technical preparations for international publication, the time limit for amending the claims under Article 19 has not expired, the front page shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after receipt by the International Bureau of such amendments within the time limit under Rule 46.1, the full text of the claims as amended will be published together with a revised front page. 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) [Deleted]

48.3 Languages of Publication

(a) If the international application is filed in Arabic, 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) and (c) [No change]

48.4 to 48.6 [No change]

Rule 86
The Gazette

86.1 *Contents*⁸

The Gazette referred to in Article 55(4) shall contain:

(i) for each published international application, the data specified by the Administrative Instructions taken from the front page of the publication of the international application, the drawing (if any) appearing on the said front page, and the abstract;

(ii) the schedule of all fees payable to the receiving Offices, the International Bureau, and the International Searching and Preliminary Examining Authorities;

(iii) notices the publication of which is required under the Treaty or these Regulations;

(iv) information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned;

(v) [No change]

86.2 *Languages; Form and Means of Publication; Timing*

(a) The Gazette shall be published in English and French at the same time. The translations shall be ensured by the International Bureau in English and French.

(b) [No change]

(c) The form in which and the means by which the Gazette is published shall be governed by the Administrative Instructions.

(d) The International Bureau shall ensure that, for each published international application, the information referred to in Rule 86.1(i) is published in the Gazette on, or as soon as possible after, the date of publication of the international application.

86.3 to 86.6 [No change]

⁸ The text of amended Rule 86.1 derives from present Rule 86.1(a); present Rule 86.1(b) is deleted. Rule 86.1(ii) to (iv) are amended in the English text only.

Rule 87
Communication of Publications

87.1 *Communication of Publications on Request*

The International Bureau shall communicate, free of charge, every published international application, the Gazette and any other publication of general interest published by the International Bureau in connection with the Treaty or these Regulations, to International Searching Authorities, International Preliminary Examining Authorities and national Offices upon request by the Authority or Office concerned. Further details concerning the form in which and the means by which publications are communicated shall be governed by the Administrative Instructions.

87.2 [Deleted]

Rule 91⁹
Obvious Errors in Documents

91.1 *Rectification*

(a) to (e) [No change]

(f) Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor. The authority which authorizes a rectification shall promptly notify the International Bureau accordingly. Where the authorization of the rectification was refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (g-*bis*), (g-*ter*) or (g-*quater*) and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification together with the international application. A copy of the request for rectification shall be included in the communication under Article 20 where the international application is not published by virtue of Article 64(3).

(g) to (g-*quater*) [No change]

[Annex II follows]

⁹ See Annex II for further amendments entering into force on April 1, 2007.

ANNEX II

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Rule 2
Interpretation of Certain Words

2.1 to 2.3 [No change]

2.4 “*Priority Period*”

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

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

Rule 4³
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,

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

(d) [No change]

4.2 to 4.9 [No change]

4.10 *Priority Claim*

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

(i) the date on which the earlier application was filed;

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.17 [No change]

4.18 *Statement of Incorporation by Reference*

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

³ See Annex I for amendments entering into force earlier, on April 1, 2006.

4.19 *Additional Matter*

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

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

Rule 11
Physical Requirements of the International Application

11.1 to 11.13 [No change]

11.14 *Later Documents*

Rules 10, and 11.1 to 11.13, also apply to any document—for example, replacement sheets, amended claims, translations—submitted after the filing of the international application.

Rule 12
Language of the International Application and Translation
for the Purposes of International Search and International Publication

12.1 [No change]

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

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

12.2 *Language of Changes in the International Application*

(a) [No change]

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

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

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

(c) [No change]

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), the applicant has not furnished a translation required under paragraph (a), the receiving Office shall, preferably together with that notification, invite the applicant:

(i) and (ii) [No change]

(d) and (e) [No change]

12.4 [No change]

Rule 20⁴
International Filing Date

20.1 Determination Under Article 11(1)

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

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

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

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

20.2 Positive Determination Under Article 11(1)

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

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

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

20.3 Defects Under Article 11(1)

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

⁴ The text of Rule 20 is replaced in its entirety by that shown here.

[Rule 20.3(a), continued]

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

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

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

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

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

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

20.4 Negative Determination Under Article 11(1)

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

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

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

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

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

20.5 *Missing Parts*

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

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

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

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

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

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

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

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

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

(i) a sheet or sheets embodying the entire element as contained in the earlier application or embodying the part concerned;

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

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

(iv) in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the earlier application and, where applicable, in any translation referred to in item (iii).

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

(c) Where the receiving Office finds that a requirement under Rule 4.18 or paragraph (a) has not been complied with or that the element or part referred to in paragraph (a) is not completely contained in the earlier application concerned, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b) or 20.5(c), as the case may be.

20.7 *Time Limit*

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

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

(ii) where no such invitation was sent to the applicant, 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.

(b) Where a correction under Article 11(2) or a notice under Rule 20.6(a) confirming the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) is received by the receiving Office after the expiration of the applicable time limit under paragraph (a) but before that Office sends a notification to the applicant under Rule 20.4(i), that correction or notice shall be considered to have been received within that time limit.

20.8 *Incompatibility with National Laws*

(a) If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with that receiving Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(b) If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

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.

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) 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) 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.

(d) to (h) [No change]

22.2 *[Remains deleted]*

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 Correct⁵

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

26.2 Time Limit for Correction

The time limit referred to in Rule 26.1 shall be two months from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

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

(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, 26.2, 26.5 and 29.1 shall apply *mutatis mutandis*.

(d) [No change]

26.4 [No change]

⁵ The text of amended Rule 26.1 derives from present Rule 26.1(a); present Rule 26.1(b) is deleted.

26.5 *Decision of the Receiving Office*

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

26.6 [Deleted]

Rule 26bis⁶
Correction or Addition of Priority Claim

26bis.1 Correction or Addition of Priority Claim

(a) The applicant may correct a priority claim or add a priority claim to the request by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

(b) and (c) [No change]

26bis.2 Defects in Priority Claims

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

- (i) that the international application has an international filing date which is later than the date on which the priority period expired and that a request for restoration of the right of priority under Rule 26bis.3 has not been submitted;
- (ii) that the priority claim does not comply with the requirements of Rule 4.10; or
- (iii) that any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document;

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim. In the case referred to in item (i), where the international filing date is within two months from the date on which the priority period expired, the receiving Office or the International Bureau, as the case may be, shall also notify the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26bis.3, unless the receiving Office has notified the International Bureau under Rule 26bis.3(j) of the incompatibility of Rule 26bis.3(a) to (i) with the national law applied by that Office.

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

⁶ See Annex I for amendments entering into force earlier, on April 1, 2006.

[Rule 26bis.2, continued]

- (c) A priority claim shall not be considered void only because:
- (i) the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing;
 - (ii) an indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document; or
 - (iii) the international application has an international filing date which is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date.
- (d) Where the receiving Office or the International Bureau has made a declaration under paragraph (b) or where the priority claim has not been considered void only because paragraph (c) applies, the International Bureau shall publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Such information shall be included in the communication under Article 20 where the international application is not published by virtue of Article 64(3).
- (e) Where the applicant wishes to correct or add a priority claim but the time limit under Rule 26bis.1 has expired, the applicant may, prior to the expiration of 30 months from the priority date and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, request the International Bureau to publish information concerning the matter, and the International Bureau shall promptly publish such information.

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

- (a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall, on the request of the applicant, and subject to paragraphs (b) to (g) of this Rule, restore the right of priority if the Office finds that a criterion applied by it (“criterion for restoration”) is satisfied, namely, that the failure to file the international application within the priority period:
- (i) occurred in spite of due care required by the circumstances having been taken;
or
 - (ii) was unintentional.

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

[Rule 26bis.3, continued]

- (b) A request under paragraph (a) shall:
- (i) be filed with the receiving Office within the time limit applicable under paragraph (e);
 - (ii) state the reasons for the failure to file the international application within the priority period; and
 - (iii) preferably be accompanied by any declaration or other evidence required under paragraph (f).
- (c) Where a priority claim in respect of the earlier application is not contained in the international application, the applicant shall submit, within the time limit applicable under paragraph (e), a notice under Rule 26bis.1(a) adding the priority claim.
- (d) The submission of a request under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration, payable within the time limit applicable under paragraph (e). The amount of that fee, if any, shall be fixed by the receiving Office.
- (e) The time limit referred to in paragraphs (b)(i), (c) and (d) shall be two months from the date on which the priority period expired, provided that, where the applicant makes a request for early publication under Article 21(2)(b), any request under paragraph (a) or any notice referred to in paragraph (c) submitted, or any fee referred to in paragraph (d) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.
- (f) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b)(iii) be filed with it within a time limit which shall be reasonable under the circumstances. The applicant may furnish to the International Bureau a copy of any such declaration or other evidence filed with the receiving Office, in which case the International Bureau shall include such copy in its files.
- (g) The receiving Office shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal by the receiving Office may be sent to the applicant together with any invitation to file a declaration or other evidence under paragraph (f).
- (h) The receiving Office shall promptly:
- (i) notify the International Bureau of the receipt of a request under paragraph (a);
 - (ii) make a decision upon the request;
 - (iii) notify the applicant and the International Bureau of its decision and the criterion for restoration upon which the decision was based.

[Rule 26bis.3, continued]

(i) Each receiving Office shall inform the International Bureau of which of the criteria for restoration it applies and of any subsequent changes in that respect. The International Bureau shall promptly publish such information in the Gazette.

(j) If, on October 5, 2005, paragraphs (a) to (i) are not compatible with the national law applied by the receiving Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 34
Minimum Documentation

34.1 *Definition*

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) [No change]

(ii) the patents issued by the Federal Republic of Germany, the Republic of Korea and the Russian Federation,

(iii) to (vi) [No change]

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

Rule 38
Missing or Defective Abstract

38.1 [No change]

38.2 *Establishment of Abstract*⁷

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 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.

38.3 *Modification of Abstract*⁷

The applicant may, until the expiration of one month from the date of mailing of the international search report, submit to the International Searching Authority:

- (i) proposed modifications of the abstract; or
- (ii) where the abstract has been established by the Authority, proposed modifications of, or comments on, that abstract, or both modifications and comments;

and the Authority shall decide whether to modify the abstract accordingly. Where the Authority modifies the abstract, it shall notify the modification to the International Bureau.

⁷ The text of amended Rule 38.2 derives from present Rule 38.2(a); the text of new Rule 38.3 derives from present Rule 38.2(b).

Rule 43
The International Search Report

43.1 to 43.6 [No change]

43.6bis Consideration of Rectifications of Obvious Mistakes

(a) A rectification of an obvious mistake that is authorized under Rule 91.1 shall, subject to paragraph (b), be taken into account by the International Searching Authority for the purposes of the international search and the international search report shall so indicate.

(b) A rectification of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search if it is authorized by or notified to that Authority, as applicable, after it has begun to draw up the international search report, in which case the report shall, if possible, so indicate, failing which the International Searching Authority shall notify the International Bureau accordingly and the International Bureau shall proceed as provided for in the Administrative Instructions.

43.7 to 43.10 [No change]

Rule 43bis
Written Opinion of the International Searching Authority

43bis.1 Written Opinion

(a) [No change]

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6) and 35(2) and (3) and Rules 43.4, 43.6bis, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

(c) [No change]

Rule 48⁸
International Publication

48.1 [No change]

48.2 *Contents*⁹

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

(i) to (vi) [No change]

(vii) where the request for publication under Rule 91.3(d) was received by the International Bureau before the completion of the technical preparations for international publication, any request for rectification of an obvious mistake, any reasons and any comments referred to in Rule 91.3(d);

(viii) [No change]

(ix) any information concerning a priority claim referred to in Rule 26*bis*.2(d);

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

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

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

(i) data taken from the request sheet and such other data as are prescribed by the Administrative Instructions;

(ii) a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies;

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first;

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

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

⁸ See Annex I for amendments entering into force earlier, on April 1, 2006.

⁹ Rule 48.2(b)(i) to (iii) are amended in the English text only.

[Rule 48.2(b), continued]

(vi) where applicable, an indication that the published international application contains information under Rule 26*bis*.2(d);

(vii) where applicable, an indication that the published international application contains information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request;

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

(c) to (h) [No change]

(i) If the authorization of a rectification of an obvious mistake in the international application referred to in Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2, as the case may be, and the front page shall be republished.

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

(k) If a request for publication under Rule 91.3(d) was received by the International Bureau after the completion of the technical preparations for international publication, the request for rectification, any reasons and any comments referred to in that Rule shall be promptly published after the receipt of such request for publication, and the front page shall be republished.

48.3 to 48.6 [No change]

Rule 49ter
Effect of Restoration of Right of Priority by Receiving Office;
Restoration of Right of Priority by Designated Office

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

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

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

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

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

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

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

(g) If, on October 5, 2005, paragraphs (a) to (d) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

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

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

- (i) occurred in spite of due care required by the circumstances having been taken;
or
- (ii) was unintentional.

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

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

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

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

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

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

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

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

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

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

[Rule 49ter.2, continued]

(h) If, on October 5, 2005, paragraphs (a) to (g) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

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), 24.2(c) or 29.1(ii).

51.2 Copy of the Notification

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 notification referred to in Rule 20.4(i).

51.3 [No change]

Rule 51bis
Certain National Requirements Allowed Under Article 27

51bis.1 Certain National Requirements Allowed

(a) to (d) [No change]

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

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

(ii) where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii) or 20.5(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, for the purposes of determining under Rule 82~~ter~~.1(b) whether that element or part is completely contained in the priority document concerned, in which case the national law applicable by the designated Office may also require the applicant to furnish, in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the translation of the priority document.

(f) [No change]

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

Rule 55
Languages (International Preliminary Examination)

55.1 [No change]

55.2 *Translation of International Application*

(a) [No change]

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

(b) [No change]

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

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

55.3 [No change]

Rule 64
Prior Art for International Preliminary Examination

64.1 *Prior Art*

(a) [No change]

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

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

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

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

64.2 and 64.3 [No change]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 Basis of the International Preliminary Examination

(a) to (d) [No change]

(d-*bis*) A rectification of an obvious mistake that is authorized under Rule 91.1 shall, subject to Rule 66.4*bis*, be taken into account by the International Preliminary Examining Authority for the purposes of the international preliminary examination.

(e) [No change]

66.1*bis* to 66.4 [No change]

66.4bis Consideration of Amendments, Arguments and Rectifications of Obvious Mistakes

Amendments, arguments and rectifications of obvious mistakes need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received by, authorized by or notified to that Authority, as applicable, after it has begun to draw up that opinion or report.

66.5 Amendment

Any change, other than the rectification of an obvious mistake, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

66.6 to 66.9 [No change]

Rule 70
International Preliminary Report on Patentability
by the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 [No change]

70.2 *Basis of the Report*

(a) to (d) [No change]

(e) If a rectification of an obvious mistake is taken into account under Rule 66.1, the report shall so indicate. If a rectification of an obvious mistake is not taken into account pursuant to Rule 66.4*bis*, the report shall, if possible, so indicate, failing which the International Preliminary Examining Authority shall notify the International Bureau accordingly and the International Bureau shall proceed as provided for in the Administrative Instructions.

70.3 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) Each replacement sheet under Rule 66.8(a) or (b) and each replacement sheet containing amendments under Article 19 shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Replacement sheets containing amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

(b) [No change]

70.17 [No change]

Rule 76
Translation of Priority Document;
Application of Certain Rules to Procedures Before Elected Offices

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

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

Rules 13^{ter}.3, 22.1(g), 47.1, 49, 49^{bis}, 49^{ter} and 51^{bis} shall apply, provided that:

(i) to (v) [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 void by the receiving Office or the International Bureau, 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 void.

(b) Where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii) or 20.5(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part but the designated or elected Office finds that:

- (i) the applicant has not complied with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document;
- (ii) a requirement under Rule 4.18, 20.6(a)(i) or 51*bis*.1(e)(ii) has not been complied with; or
- (iii) the element or part is not completely contained in the priority document concerned;

the designated or elected Office may, subject to paragraph (c), treat the international application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under Rule 20.5(c), as applicable, provided that Rule 17.1(c) shall apply *mutatis mutandis*.

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

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

Rule 91¹⁰
Rectification of Obvious Mistakes
in the International Application and Other Documents

91.1 *Rectification of Obvious Mistakes*

(a) An obvious mistake in the international application or another document submitted by the applicant may be rectified in accordance with this Rule if the applicant so requests.

(b) The rectification of a mistake shall be subject to authorization by the “competent authority”, that is to say:

(i) in the case of a mistake in the request part of the international application or in a correction thereof—by the receiving Office;

(ii) in the case of a mistake in the description, claims or drawings or in a correction thereof, unless the International Preliminary Examining Authority is competent under item (iii)—by the International Searching Authority;

(iii) in the case of a mistake in the description, claims or drawings or in a correction thereof, or in an amendment under Article 19 or 34, where a demand for international preliminary examination has been made and has not been withdrawn and the date on which international preliminary examination shall start in accordance with Rule 69.1 has passed—by the International Preliminary Examining Authority;

(iv) in the case of a mistake in a document not referred to in items (i) to (iii) submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, other than a mistake in the abstract or in an amendment under Article 19—by that Office, Authority or Bureau, as the case may be.

(c) The competent authority shall authorize the rectification under this Rule of a mistake if, and only if, it is obvious to the competent authority that, as at the applicable date under paragraph (f), something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification.

(d) In the case of a mistake in the description, claims or drawings or in a correction or amendment thereof, the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the description, claims and drawings and, where applicable, the correction or amendment concerned.

¹⁰ See Annex I for amendments entering into force earlier, on April 1, 2006. The text of Rule 91 is replaced in its entirety by that shown here with entry into force on April 1, 2007.

[Rule 91.1, continued]

(e) In the case of a mistake in the request part of the international application or a correction thereof, or in a document referred to in paragraph (b)(iv), the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the international application itself and, where applicable, the correction concerned, or the document referred to in paragraph (b)(iv), together with any other document submitted with the request, correction or document, as the case may be, any priority document in respect of the international application that is available to the authority in accordance with the Administrative Instructions, and any other document contained in the authority's international application file at the applicable date under paragraph (f).

(f) The applicable date for the purposes of paragraphs (c) and (e) shall be:

(i) in the case of a mistake in a part of the international application as filed—the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application—the date on which the document was submitted.

(g) A mistake shall not be rectifiable under this Rule if:

- (i) the mistake lies in the omission of one or more entire elements of the international application referred to in Article 3(2) or one or more entire sheets of the international application;
- (ii) the mistake is in the abstract;
- (iii) the mistake is in an amendment under Article 19, unless the International Preliminary Examining Authority is competent to authorize the rectification of such mistake under paragraph (b)(iii); or
- (iv) the mistake is in a priority claim or in a notice correcting or adding a priority claim under Rule 26*bis*.1(a), where the rectification of the mistake would cause a change in the priority date;

provided that this paragraph shall not affect the operation of Rules 20.4, 20.5, 26*bis* and 38.3.

(h) Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers what appears to be a rectifiable obvious mistake in the international application or another document, it may invite the applicant to request rectification under this Rule.

91.2 *Requests for Rectification*

A request for rectification under Rule 91.1 shall be submitted to the competent authority within 26 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation. Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the proposed rectification shall be indicated.

91.3 *Authorization and Effect of Rectifications*

(a) The competent authority shall promptly decide whether to authorize or refuse to authorize a rectification under Rule 91.1 and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. The International Bureau shall proceed as provided for in the Administrative Instructions, including, as required, notifying the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the designated and elected Offices of the authorization or refusal.

(b) Where the rectification of an obvious mistake has been authorized under Rule 91.1, the document concerned shall be rectified in accordance with the Administrative Instructions.

(c) Where the rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application as filed, from the international filing date;

(ii) in the case of a mistake in a document other than the international application as filed, including a mistake in a correction or an amendment of the international application, from the date on which that document was submitted.

(d) Where the competent authority refuses to authorize a rectification under Rule 91.1, the International Bureau shall, upon request submitted to it by the applicant within two months from the date of the refusal, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of the request, reasons and comments (if any) shall if possible be included in the communication under Article 20 where the international application is not published by virtue of Article 64(3).

(e) The rectification of an obvious mistake need not be taken into account by any designated Office in which the processing or examination of the international application has already started prior to the date on which that Office is notified under Rule 91.3(a) of the authorization of the rectification by the competent authority.

(f) A designated Office may disregard a rectification that was authorized under Rule 91.1 if it finds that it would not have authorized the rectification if it had been the competent authority.

[Annex III follows]

ANNEX III

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
DECISIONS RELATING TO ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

1. The amendments set out in Annex I:

(a) shall enter into force on April 1, 2006, and shall apply to international applications whose international filing date is on or after April 1, 2006;

(b) shall not apply to international applications whose international filing date is before April 1, 2006, provided that:

(i) Rules 13*bis*.4, 47.1, 48.1 and 48.2 as amended shall apply to international applications whose international filing date is before April 1, 2006, and which are published under Article 21 on or after April 1, 2006;

(ii) Rules 26*bis*.2 and 91.1 as amended shall apply to international applications whose international filing date is before April 1, 2006, and whose communication under Article 20 is on or after April 1, 2006;

(iii) Rules 86.1 and 86.2 as amended shall apply to issues of the Gazette published on or after April 1, 2006, regardless of the international filing dates of the international applications to which those issues relate;

(iv) Rules 87.1 and 87.2 as amended shall apply to the communication of international applications, the Gazette and other publications on or after April 1, 2006, regardless, where applicable, of the international filing dates of the international applications concerned.

2. The amendments set out in Annex II:

(a) shall enter into force on April 1, 2007, and shall apply to international applications whose international filing date is on or after April 1, 2007, provided that Rules 4.1(c)(iv), 4.18, 4.19, 12.1*bis*, 12.3, 20.1 to 20.9, 21.2, 22.1, 26.1, 26.2, 26.3*ter*, 26.5, 26.6, 48.2(b)(v), 51.1, 51.2, 51*bis*.1, 55.2 and 82*ter*.1 as amended shall not apply to international applications in respect of which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office before April 1, 2007;

(b) shall not apply to international applications whose international filing date is before April 1, 2007, provided that:

(i) Rule 34.1 as amended shall apply to any international search carried out on or after April 1, 2007;

(ii) Rules 43.6*bis*, 43*bis*.1(b), 66.1, 66.4*bis* and 70.2(e) as amended shall apply to international search reports, written opinions and international preliminary examination reports established on or after April 1, 2007, in respect of international applications whose international filing date is before April 1, 2007, as though the references in those Rules to rectifications of obvious mistakes authorized under Rule 91.1 as amended were references to rectifications of obvious errors authorized under existing Rule 91.1;

(iii) Rule 49*ter*.2 as amended shall apply to international applications whose international filing date is before April 1, 2007, and in respect of which the acts referred to in Article 22(1) are performed on or after April 1, 2007;

(iv) Rule 76.5 as amended, to the extent that it has the effect of making Rule 49*ter*.2 applicable, shall apply to international applications whose international filing date is before April 1, 2007, and in respect of which the acts referred to in Article 39(1)(a) are performed on or after April 1, 2007.

3. Furthermore, in relation to the amendments set out in Annex II:

(a) information as to incompatibility given to the International Bureau under existing Rule 20.4(d) shall be considered to remain effective under Rule 20.1(d) as amended;

(b) information as to incompatibility given to the International Bureau under Rule 51*bis*.1(f) in relation to existing Rule 51*bis*.1(e) shall be considered to remain effective under Rule 51*bis*.1(f) in relation to Rule 51*bis*.1(e) as amended.

[Annex IV follows]

ANNEX IV

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
UNDERSTANDINGS RELATING TO CERTAIN PROVISIONS

1. In connection with the adoption of amended Rule 4.9(b) (see Annex I), the Assembly noted that, in order to avoid the need for complicated transitional provisions, notifications of incompatibility under amended Rule 4.9(b) will be required to be given by all affected designated Offices, even if they have already given notifications under the existing Rule.
2. In connection with the adoption of amended Rule 20.8(a) (see Annex II), the Assembly noted that the availability of the procedure under that Rule depends on the existence of an incompatibility with the Rules referred to in that Rule of the national law applicable to a national Office in its capacity as a PCT receiving Office, as distinct from its capacity as a designated Office, and that such incompatibility might arise either from express national law provisions dealing with the subject matter in question or from the more general operation of the national law.
3. In connection with the adoption of amended Rule 26*bis*.3(a) (see Annex II), the Assembly noted that a receiving Office may, if it wishes, apply both criteria for restoration and leave the choice to the applicant as to which criterion is sought to be applied in a specific case, noting that it would be advantageous for the applicant to obtain a positive finding by the receiving Office on the stricter criterion of “due care” since such a finding would in general be effective in all designated States, unlike a finding on the less strict “unintentionality” criterion. Furthermore, a receiving Office will be free to apply, upon request of the applicant, first the “due care” criterion and then, if the receiving Office finds that that criterion is not complied with, the “unintentionality” criterion.
4. In connection with the adoption of amended Rule 26*bis*.3(f) (see Annex II), the Assembly noted that the question of what information or evidence each receiving Office is entitled to require in support of a request for restoration of the right of priority under Rule 26*bis*.3(f) is a matter left to national law and practice.
5. In connection with the adoption of amended Rule 48.2(a)(xi) (see Annex II), the Assembly noted that information as to the criterion for restoration upon which the decision by the Office was based (“due care” criterion, “unintentionality” criterion, or both criteria) will be included in the publication of the international application under new Rule 48.2(a)(xi).
6. In connection with the adoption of amended Rule 49*ter*.1(g) (see Annex II), the Assembly noted that the giving of a notification of incompatibility under Rule 49*ter*.1(g) will have both procedural and substantive effects; for example, there will be consequences both in terms of calculating the time limit for national phase entry before the designated Office concerned and in terms of the assessment of novelty and inventive step during the national search and examination.
7. In connection with the adoption of amended Rule 49*ter*.2(a) (see Annex II), the Assembly noted that a designated Office may, if it wishes, apply both criteria for restoration and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a designated Office will be free to apply, upon request of the applicant, first the “due care” criterion and then, if the designated Office finds that that criterion is not complied with, the “unintentionality” criterion.

8. In connection with the adoption of amended Rule 49*ter*.2(b)(i) (see Annex II), the Assembly noted that, where the effect of the international application provided for in Article 11(3) ceases because the applicant fails to perform the acts referred to in Article 22 or 39(1) within the applicable time limit but the designated Office reinstates the rights of the applicant with respect to that international application in accordance with Rule 49.6 or 76.5(ii), respectively, such reinstatement will extend to all time limits calculated on the basis of the applicable time limit under Article 22 or 39(1), respectively, including the time limit under Rule 49*ter*.2(b)(i).

9. In connection with the adoption of amended Rule 49*ter*.2(h) (see Annex II), the Assembly noted that any designated Office whose national law provides for a criterion more stringent than the “due care” criterion or does not provide for restoration of the right of priority at all may make use of the reservation provision in Rule 49*ter*.2(h). Designated Offices whose applicable national law provides for the restoration of the right of priority based on requirements similar but not identical to the requirements under Rule 49*ter*.2(a) and (b) will not need to make use of the reservation provision if the requirements under the applicable national law are, from the viewpoint of applicants, at least as favorable as the requirements under Rule 49*ter*.2(a) and (b).

10. In connection with the adoption of amended Rule 91.3(f) (see Annex II), the Assembly noted that, where a designated Office has given a notification of incompatibility under Rule 20.8(b) in respect of the application of provisions relating to the incorporation by reference of missing elements or parts, that Office will not be obliged, in determining for the purposes of Rule 91.3(f) whether it would have authorized the rectification, to take into account the contents of any description, claims or drawings incorporated by reference under Rule 20.6.

[End of Annex IV and of document]

WIPO



PCT/A/35/7

ORIGINAL: English

DATE: October 3, 2006

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirty-Fifth (20th Extraordinary) Session
Geneva, September 25 to October 3, 2006

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/42/1): 1, 2, 3, 4, 6, 7, 15, 18, 21, 24 and 25.
2. The report on the said items, with the exception of item 18, is contained in the General Report (document A/42/14).
3. The report on item 18 is contained in the present document.
4. The meeting of the Assembly was presided over by Mrs. Nadia Ibrahim Mohamed Abdallah (Egypt), Chair of the PCT Assembly. Mr. Enrique Manalo (Philippines), Chair of the General Assembly, presided over the adoption of the Report.

ITEM 18 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Reform of the PCT

5. Discussions were based on document PCT/A/35/1.

6. The Assembly:

(i) noted the report of the eighth session of the Working Group on Reform of the PCT contained in document PCT/R/WG/8/9 and reproduced in the Annex of document PCT/A/35/1; and

(ii) unanimously approved the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2006 and September 2007 sessions of the Assembly, subject to the availability of sufficient funds, including the matters to be considered, the convening of sessions of the Working Group and possibly the Committee on Reform of the PCT, and financial assistance to enable attendance of certain delegations, as set out in paragraph 21(i) and (ii) of document PCT/A/35/1.

Proposed Amendments of the PCT Regulations

7. Discussions were based on documents PCT/A/35/2 and 2 Add.

8. The Delegation of Japan expressed its general agreement with pursuing possibilities for fee reductions at all stages of the PCT procedure, for the benefit of users, provided that there were good reasons for granting such reductions. With regard to the proposed fee reduction for international applications filed in a non-character coded electronic document format (see document PCT/A/35/2 Add.), the Delegation stated that, for the sake of efficient processing by Offices, Authorities and the International Bureau, and for the benefit of users, the focus in the future should be on the processing of international applications in character coded format. This would not only allow substantial savings for the International Bureau in terms of data entry of bibliographical data and the abstract, but would also enable users to conduct full text searches of published international applications and to take advantage of machine translation systems. The Delegation expressed its willingness to contribute to the development of systems enabling the International Bureau to process and publish international applications in character coded format so as to make the overall processing more efficient. Against this background, the Delegation questioned the reasoning for the proposed fee reduction, noting that it would not encourage the filing of international applications in character coded format and would result in a workload and cost for the International Bureau similar to that in the case of paper filings.

9. In reply to the Delegation of Japan, the Secretariat noted that, while it shared the view that filing and processing in character coded format was the most efficient and thus preferred way of handling international applications, in practice, at present, many Offices had adopted a different approach and were not yet ready to move to processing in fully character coded format. The Secretariat thanked the Delegation of Japan for its offer to contribute to the further development of systems for the processing and publication of international applications in character coded format and stated that it looked forward to working closely with the Delegation on this matter. As to the rationale for the proposed fee reduction for the

filing of international applications in non-character coded format, the Secretariat explained that the filing of international applications in such format would enable certain savings for the International Bureau since such applications would not have to be converted by way of scanning, as in the case of paper filings, into electronic form.

10. The Assembly:

- (i) adopted the amendments of the Regulations under the PCT set out in Annex I;
- (ii) adopted the amendments of the Schedule of Fees annexed to the Regulations under the PCT set out in Annex II;
- (iii) adopted the decisions set out in Annex III relating to entry into force and transitional arrangements in respect of those amendments;
- (iv) adopted the understandings set out in Annex IV in respect of certain of those amendments; and
- (v) noted the Director General's intention to promulgate certain related modifications of the Administrative Instructions with effect from October 12, 2006.

Quality Management Systems for PCT International Authorities

11. Discussions were based on document PCT/A/35/3.

12. The Assembly noted the contents of document PCT/A/35/3.

Appointment of the Nordic Patent Institute as an International Searching and Preliminary Examining Authority Under the PCT; Approval of the Corresponding Draft Agreement

13. Discussions were based on document PCT/A/35/4.

14. The Chair informed the Assembly that the PCT Committee for Technical Cooperation (PCT/CTC) had, at its 22nd session which was being held concurrently with the Assembly's session, unanimously recommended to the Assembly that the Nordic Patent Institute (NPI) be appointed as an International Searching Authority and International Preliminary Examining Authority under the PCT ("International Authority") (see document PCT/CTC/22/3). The Secretariat noted that delegations had heard the statement of the Delegation of Norway, speaking on behalf of the Delegations of Denmark, Iceland and Norway, in support of the application for appointment of NPI as an International Authority, made during the session of the PCT/CTC (see document PCT/CTC/22/3).

15. The Delegation of Kenya congratulated the Director General of the Danish Patent and Trademark Office, the Director General of the Icelandic Patent Office and the Director General of the Norwegian Patent Office for presenting to the Assembly the request to appoint NPI as an International Authority. The Delegation expressed the view that the request was a positive step towards reducing backlogs and workload before the existing International Authorities. An additional International Authority would assist in enabling the PCT system to meet its objectives of simplification and providing economic protection of inventions internationally. The Delegation stated that it had no doubt about the availability of resources, the competence of the examiners, the quality of processing of patent applications, the training

and the quality control and examination methods and tools in place in the Danish and Norwegian Offices. It expressed its supports for the appointment of NPI as an International Authority.

16. The Delegation of Hungary expressed its strong support for the request of the Delegations of Denmark, Iceland and Norway to seek the appointment of NPI as an International Authority, noting its firm belief that the goals of increased competency, efficiency and improvement of the quality of work carried out, as expressed by the founders of the NPI, were in full conformity with the principle objectives of the PCT. The Delegation stated that it had always expressed the view, in different international fora, that it was the right of the national Office of any Contracting State of the PCT to become an International Authority, provided that it satisfied the requirements prescribed by the PCT. The Delegation believed that forming a new international institution for the purposes of becoming an International Authority, using human and other resources of national Offices, reflected even more the spirit of the PCT and contributed to the enhancement of the effectiveness of existing capacities of national Offices. Therefore, the Delegation supported the text of the draft agreement between the NPI and the International Bureau and the appointment of NPI as an International Authority.

17. The Delegation of Portugal expressed its strong support for the appointment of NPI as an International Authority.

18. The Delegation of Austria reiterated its statement made during the 22nd session of the PCT/CTC (see document PCT/CTC/22/3) and stated that it would look forward to welcoming NPI in the family of International Authorities.

19. The Delegation of China expressed its commendation for the appointment of NPI as an International Authority.

20. The Assembly, having heard the representative of the Nordic Patent Institute and taking into account the advice of the PCT Committee for Technical Cooperation:

(i) approved the text of the draft Agreement between the Nordic Patent Institute and the International Bureau set out in Annex V to this report; and

(ii) appointed the Nordic Patent Institute as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of that Agreement until December 31, 2007.

21. The Delegation of the United States stated that it warmly welcomed the appointment of NPI as an International Authority.

22. The Delegation of Norway, speaking on behalf of the Delegations of Denmark, Iceland and Norway, thanked all delegations who took the floor for their words of encouragement and all delegations for their support.

Quality of International Searches

23. Discussions were based on document PCT/A/35/5.

24. The Assembly noted the contents of document PCT/A/35/5.

PCT Information Systems Report

25. Discussions were based on document PCT/A/35/6.

26. The Delegation of Japan expressed its appreciation for the work of the PCT Information Systems Division, in particular for its efforts to provide more and more information via the PatentScope service. With reference to its earlier statement, made in the context of the discussions on document PCT/A/35/2 Add., concerning the processing of international applications in character coded format, the Delegation expressed its concerns about the envisaged delay in the development of systems which would enable the International Bureau to process and publish international applications in character coded format. Noting that, at present, more than 80% of all international applications filed with the Japan Patent Office as receiving Office were filed in character coded format but, due to the lack of such systems, subsequently converted into, and published in, an image format, the Delegation urged the International Bureau to address the issue as soon as possible, for the benefit not only of the Japan Patent Office but also, in particular, of Japanese applicants who would like to see their applications filed in character coded format processed and published in that format.

27. In reply to the Delegation of Japan, the Secretariat noted that, while it agreed with the Delegation as to the importance of the matter, activities related to the development of systems allowing for the processing and publication of international applications in character coded format had to be deferred due to limited resource availability, as indicated in document PCT/A/35/6. The Secretariat stated that activities related to this matter, as well as all other activities listed in that document as being deferred, would be the subject of a detailed submission for additional resources by the PCT Information Systems Division and the Office of the PCT as part of the preparation of the 2008-2009 Program and Budget of WIPO.

28. The Assembly noted the contents of document PCT/A/35/6.

[Annexes follow]

ANNEX I

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
TO ENTER INTO FORCE ON APRIL 1, 2007¹TABLE OF CONTENTS²

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¹ See Annex III for details concerning entry into force and transitional arrangements. See also Annex IV for details concerning understandings relating to Rules 20.8(c), 76.5 and 82ter.1(b).

² The Table of Contents is included for convenience; it does not form part of the amendments.

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Rule 11
Physical Requirements of the International Application

11.1 to 11.8 [No change]

11.9 *Writing of Text Matter*

(a) to (c) [No change]

(d) All text matter shall be in characters the capital letters of which are not less than 0.28 cm high, and shall be in a dark, indelible color, satisfying the requirements specified in Rule 11.2, provided that any text matter in the request may be in characters the capital letters of which are not less than 0.21 cm high.

(e) [No change]

11.10 to 11.14 [No change]

Rule 12
Language of the International Application
and Translations for the Purposes of International Search
and International Publication

12.1 and 12.1bis [No change]

12.1ter *Language of Indications Furnished under Rule 13bis.4*

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

12.2 *Language of Changes in the International Application*

(a) and (b) [No change]

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

12.3 and 12.4 [No change]

Rule 20
International Filing Date

20.1 to 20.7 [No change]

20.8 *Incompatibility with National Laws*

(a) [No change]

(a-bis) Where a missing element or part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of paragraph (a) of this Rule, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b) or 20.5(c), as the case may be. Where the receiving Office proceeds as provided for in Rule 20.5(c), the applicant may proceed as provided for in Rule 20.5(e).

(b) [No change]

(c) Where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of paragraph (b) of this Rule, the designated Office may treat the application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under Rule 20.5(c), as the case may be, provided that Rule 82*ter*.1(c) and (d) shall apply *mutatis mutandis*.

Rule 26
Checking by, and Correcting before, the Receiving Office
of Certain Elements of the International Application

26.1 to 26.3~~ter~~ [No change]

26.4 *Procedure*

A correction of the request offered to the receiving Office may be stated in a letter addressed to that Office if the correction is of such a nature that it can be transferred from the letter to the request without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred; otherwise, and in the case of a correction of any element of the international application other than the request, the applicant shall be required to submit a replacement sheet embodying the correction and the letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

26.5 and 26.6 [No change]

Rule 36
Minimum Requirements for International Searching Authorities

36.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 16(3)(c) shall be the following:

- (i) to (iii) [No change]
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;
- (v) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

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, provided that:

(i) if a translation of the international application into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, the international search report and any declaration made under Article 17(2)(a) may be in the language of that translation;

(ii) if the international application is to be published in the language of a translation furnished under Rule 12.4 which is not accepted by the International Searching Authority and that Authority so wishes, the international search report and any declaration made under Article 17(2)(a) may be in a language which is both a language accepted by that Authority and a language of publication referred to in Rule 48.3(a).

43.5 to 43.10 [No change]

Rule 48
International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) and (b) [No change]

(c) If the international application is published 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, shall be prepared under the responsibility of the International Bureau.

48.4 to 48.6 [No change]

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:

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

(ii) 22 months from the priority date.

(b) [No change]

Rule 55
Languages (International Preliminary Examination)

55.1 [No change]

55.2 *Translation of International Application*

(a) [No change]

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

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

(b) [No change]

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

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

55.3 [No change]

Rule 63
Minimum Requirements for
International Preliminary Examining Authorities

63.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 32(3) shall be the following:

- (i) to (iii) [No change]
- (iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international preliminary examination;
- (v) that Office or organization must hold an appointment as an International Searching Authority.

Rule 76
Translation of Priority Document;
Application of Certain Rules to Procedures before Elected Offices

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

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

Rules 13^{ter}.3, 20.8(c), 22.1(g), 47.1, 49, 49^{bis}, 49^{ter} and 51^{bis} shall apply, provided that:

(i) to (v) [No change]

Rule 91
Rectification of Obvious Mistakes
in the International Application and Other Documents

91.1 and 91.2 [No change]

91.3 *Authorization and Effect of Rectifications*

(a) to (e) [No change]

(f) A designated Office may disregard a rectification that was authorized under Rule 91.1 only if it finds that it would not have authorized the rectification under Rule 91.1 if it had been the competent authority, provided that no designated Office shall disregard any rectification that was authorized under Rule 91.1 without giving the applicant the opportunity to make observations, within a time limit which shall be reasonable under the circumstances, on the Office's intention to disregard the rectification.

[Annex II follows]

ANNEX II

AMENDMENTS OF THE SCHEDULE OF FEES
ANNEXED TO THE REGULATIONS UNDER THE PCT
TO ENTER INTO FORCE ON OCTOBER 12, 2006¹

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,400 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling fee: (Rule 57.2)	200 Swiss francs

Reductions

3. The international filing fee is reduced by the following amount if the international application is, as provided for in the Administrative Instructions, filed:

(a) on paper together with a copy in electronic form, in character coded format, of the request and the abstract:	100 Swiss francs
(b) in electronic form, the request not being in character coded format:	100 Swiss francs
(c) in electronic form, the request being in character coded format:	200 Swiss francs
(d) in electronic form, the request, description, claims and abstract being in character coded format:	300 Swiss francs

4. The international filing fee (where applicable, as reduced under item 3) and the handling fee are reduced by 75% if the international application is filed by:

- (a) an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); or
- (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations;

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).

[Annex III follows]

ANNEX III

AMENDMENTS OF THE REGULATIONS UNDER THE PCT AND
THE SCHEDULE OF FEES ANNEXED TO THOSE REGULATIONS:
DECISIONS RELATING TO ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

1. The amendments of the Regulations under the PCT set out in Annex I shall enter into force on April 1, 2007, and shall apply to international applications whose international filing date is on or after April 1, 2007, provided that Rules 20.8(a-*bis*) and (c), 55.2(a-*bis*) and 76.5 as amended shall not apply to international applications in respect of which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office before April 1, 2007.

2. The amendments of the Regulations under the PCT set out in Annex I shall not apply to international applications whose international filing date is before April 1, 2007, provided that:

(a) Rule 43.4 as amended shall apply to any international application in respect of which an international search report is established on or after April 1, 2007, whether the international filing date is before, on or after April 1, 2007;

(b) Rule 48.3(c) as amended shall apply to any international application which is published under Article 21 on or after April 1, 2007, whether the international filing date is before, on or after April 1, 2007;

(c) Rules 54*bis*.1 and 55.2(a-*ter*), (c) and (d) as amended shall apply to any international application in respect of which a demand for international preliminary examination is made on or after April 1, 2007, whether the international filing date is before, on or after April 1, 2007.

3. The amendments of the Schedule of Fees annexed to the Regulations under the PCT set out in Annex II shall enter into force on October 12, 2006, and shall apply to international applications whose international filing date is on or after October 12, 2006, provided that the Schedule of Fees as worded before its amendment shall continue to apply to international applications which are received by the receiving Office before October 12, 2006, and are accorded an international filing date that is on or after October 12, 2006.

4. The amendments of the Schedule of Fees annexed to the Regulations under the PCT set out in Annex II shall not apply to international applications whose international filing date is before October 12, 2006.

[Annex IV follows]

ANNEX IV

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
UNDERSTANDINGS RELATING TO CERTAIN PROVISIONS

1. In connection with the adoption of amended Rules 20.8(c) and 76.5, the Assembly noted that:

(a) where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated or elected Office because of the operation of Rule 20.8(b), the time limit for performing the acts referred to in Articles 22 and 39 before such designated or elected Office would be calculated on the basis of the priority date referred to in Article 2(xi) having due regard to the international filing date as accorded by the receiving Office; and

(b) the same should apply where that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated or elected Office because of the operation of Rule 82*ter*.1(b) as adopted by the Assembly in October 2005 with effect from April 1, 2007.

[Annex V follows]

ANNEX V

DRAFT AGREEMENT BETWEEN
THE NORDIC PATENT INSTITUTE AND
THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to the functioning of the Nordic Patent Institute
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Nordic Patent Institute and the International Bureau of the World Intellectual Property Organization,

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Nordic Patent Institute;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.
- (2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement, that, where applicable, the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is prepared to start functioning as an International Searching Authority and as an International Preliminary Examining Authority.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the Nordic Patent Institute gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the Nordic Patent Institute written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [city], this [date], in two originals in the Danish, English, Icelandic and Norwegian languages, each text being equally authentic.

For the Nordic Patent Institute by:

For the International Bureau by:

[...]

[...]

*Annex A
States and Languages*

Under Article 3 of the Agreement, the Authority specifies:

(i) the following States:

(a) Denmark, Iceland, Norway;

(b) any other Contracting State in accordance with the obligations of Denmark and Iceland within the framework of the European Patent Organisation;

(ii) the following languages:

Danish, English, Icelandic, Norwegian and Swedish.

*Annex B
Subject Matter Not Excluded from Search or Examination*

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under the national patent grant procedure under the provisions of the Danish, Icelandic and Norwegian Patent Laws.

*Annex C
Fees and Charges*

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (...)</i>
Search fee (Rule 16.1(a))	[...]
Additional search fee (Rule 40.2(a))	[...]
Preparation of international-type search report	[...]
Preliminary examination fee (Rule 58.1(b))	[...]

Additional fee (Rule 68.3(a)) [...]

Cost of copies (Rule 44.3(b), 71.2(b) and 94.2) [...]

Cost of copies in paper form (Rules 44.3(b)
and 71.2(b)), per document [...]

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier international or international-type search, 50% or 100% of the search fee paid according to Part I shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) Where on an earlier application, the priority of which is claimed, a search report has been issued by the Danish Patent Office, the Icelandic Patent Office or the Norwegian Patent Office, and where the Authority benefits from that search report, the amount of [...] shall be refunded in respect of the search fee paid according to Part I.

(5) In the cases provided for under Rule 58.3, the following amount of the preliminary examination fee shall be refunded:

- (a) refund of the full amount paid where Rule 54.4, 54bis.1(b) or 58bis.1(b) applies;
- (b) refund of the amount paid less the current amount of transmittal fee, where Rule 60.1(c) applies.

(6) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Danish, English, Icelandic, Norwegian and Swedish, depending on the language in which the international application is filed or translated; however, English may be used in all cases.

[End of Annex V and of document]

WIPO



PCT/A/36/13

ORIGINAL: English

DATE: November 12, 2007

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirty-Sixth (16th Ordinary) Session
Geneva, September 24 to October 3, 2007

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/43/1).
2. The report on the said items, with the exception of item 8, is contained in the General Report (document A/43/16).
3. The report on item 8 is contained in the present document.
4. Mrs. Ásta Valdimarsdóttir (Iceland) was elected Chair of the Assembly; Mr. Matti Päts (Estonia) and Mr. Yin Xintian (China) were elected Vice-Chairs. In the absence of the Chair and both Vice-Chairs, Mr. Barney De Schneider (Canada) was elected acting Chair and presided over those parts of the discussions referred to in paragraphs 62 to 105.

ITEM 8 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION INCLUDING
(A) PROPOSAL OF THE UNITED STATES OF AMERICA AND JAPAN;
(B) PROPOSAL OF BRAZIL AND (C) ANY OTHER PROPOSAL

Proposed Amendment of the Schedule of Fees Annexed to the Regulations under the PCT

5. Discussions were based on document PCT/A/36/11, containing a proposal by the United States of America and Japan, and document PCT/A/36/12, containing a proposal by Brazil.

6. The Delegation of the United States of America, in introducing the proposal contained in document PCT/A/36/11, stated that it believed that the reduction in PCT fees was both wanted and reasonable, given the ever growing surplus being generated by the PCT system and the shrinking proportion of PCT fees that were actually dedicated to the PCT system. It further stated that it believed that the proposal could be adopted without prejudice to WIPO's ongoing work in all areas, including its development-related activities.

7. The Delegation of the United States of America noted that, in all but one biennium for the past 20 years, income generated by the PCT system had increased, in most cases quite significantly. As noted by the International Bureau in its comments on the Final Report of the Desk-to-Desk Assessment of the Human and Financial Resources of WIPO (paragraph 9 of document WO/GA/34/12), WIPO's budget had multiplied by a factor of more than 5 in the past 20 years, from 99 million Swiss francs to 531 million Swiss francs. Over the same time, WIPO's staff had more than quadrupled, from 300 staff in 1986 to 1,260 staff today. The PCT system, which now funded the bulk of WIPO's budget, had made possible the expansion of WIPO activities in all areas of its work. Nevertheless, as noted by the United Nations Joint Inspection Unit when it recommended that a desk-to-desk assessment be done, WIPO's budget should not be based solely on its income but should be based on actual needs and good management practices. According to the desk-to-desk results, WIPO may have grown too large without regard to actual needs. The report noted that as many as 200 posts in the Secretariat could be redundant. The Delegation stated that it believed that a PCT fee reduction would both help to curb the unrestrained growth of the Secretariat and encourage greater use of the PCT, especially among small and medium-sized enterprises, by applicants from both developed and developing countries.

8. The Delegation of the United States of America further noted that, during the Program and Budget Committee's session held in February 2007, the Secretariat of WIPO had produced charts that indicated the expected financial impact of a 15% fee reduction. While the Delegation appreciated the Secretariat's efforts in producing those charts, it believed that they were misleading in two respects. First, they ignored future growth in PCT filings, which had been the historical trend, as well as any additional growth that may be induced by reduced fees. Second, they assumed that WIPO would proceed with all of the spending that had been proposed – even that which had been rejected by WIPO Member States such as on security costs. The Delegation noted that the Secretariat, in its proposal on use of WIPO reserve funds, had proposed a substantial reduction of spending on security, mainly because the Building Foundation for the International Organizations (FIPOI) had agreed to fund much of the costs of enhanced security. The Delegation therefore believed that the charts cast the proposed 15% PCT fee reduction in an unwarranted negative light.

9. The Delegation of the United States of America expressed the view that its proposal would have a positive rather than a negative effect on the financial future of the Organization. It also noted that the so-called “Industry Trilateral”, representing PCT users in Japan, Europe and the United States of America, strongly supported the PCT fee reduction proposal made by Japan and the United States of America. The confidence of users of the PCT system would be critical to its continued success. Excessive diversion of PCT fee income could well jeopardize the existing confidence.

10. The Delegation of Japan recalled that the effect of the proposal in document PCT/A/36/11 would be to reduce the PCT international filing fee from 1,400 Swiss francs to 1,190 Swiss francs and the handling fee from 200 Swiss francs to 170 Swiss francs. The Delegation believed that the proposal could be realized in the current robust PCT situation where in 2006 the number of PCT applications grew by 7.9% to a total of 147,500 applications, and noted specifically that double-digit growth had occurred in several countries, including the Republic of Korea and China. Furthermore, a reduction of fees would stimulate more use of the PCT, promoting IP protection across all business sectors and business sizes on a global scale, which was one of the major missions of the Organization. In this context, the Delegation recalled that Trilateral PCT users, that is, applicants from Japan, Europe and the United States of America, had expressed strong support for the 15% fee reduction proposal. The Delegation believed that the Organization should respond to the users’ voice. The Delegation also believed that a PCT fee reduction would lead to an increase in WIPO’s budget, benefiting various important activities of WIPO, including development activities. Given the current situation where more and more new users were entering the PCT world and using PCT services, especially users from developing countries and small and medium-sized enterprises, a fee reduction would assist and benefit those users.

11. The Delegation of Japan pointed out that WIPO was a unique organization in that 90% of its income came from users’ fees, of which 75% came from users of the PCT. From this perspective, the Delegation considered it advisable to use any surplus generated due to unexpected PCT growth for the benefit of users. Reduction of fees could be the most explicit and direct way of returning benefits to the major financial contributors. By so doing, a good relationship and confidence between WIPO and users could be expected to form and grow.

12. The Delegation of Japan set out one possible scenario for achieving a 15% fee reduction as described in Annex II of document PCT/A/36/11, noting that there might also be other possible ways of reaching that goal. It stated that the chart in that Annex showed that a 30.4 million Swiss francs surplus was generated in the PCT Union, after reflecting additional PCT-related expenditure necessary to handle unexpected PCT growth. For the next (2008-2009) biennium, given the Secretariat’s projection of future PCT growth of 5 to 6% per year, and reflecting additional expenditure necessary to handle the expected increase in PCT applications, it could be seen that a surplus of 57.2 million Swiss francs would be generated. Therefore, during this biennium and the next biennium, a total of 87.6 million Swiss francs could be expected to be generated, which could be used as resources for PCT fee reduction. This amounted to 18% of the PCT income, so a 15% reduction could be realized. Additionally, it was considered that the reserve from the previous biennium could be used as resource for a fee reduction. Furthermore, given that a fee reduction would stimulate the filing of PCT applications, PCT income would exceed that projected by the Secretariat, generating a further resource for fee reduction. The Delegation expressed its hope that the Assembly would make an appropriate decision for the right direction of PCT development.

13. The Delegation of Brazil noted that its proposal in document PCT/A/36/12 had been issued on the previous day, but that the same proposal had been discussed during the last session of the Program and Budget Committee, so that members had had an opportunity to consider it several weeks in advance of the PCT Assembly. The Delegation emphasized that its proposal was an alternative to, rather than complementary to, the 15% fee reduction proposed by the United States of America and Japan in document PCT/A/36/11, and it was important to specify why it was an alternative proposal. The 15% reduction of fees as proposed by the US and Japan, which would be applicable to applicants from all PCT Member States, would, as indicated by certain calculations referred to by the Secretariat, impact disproportionately on the income of WIPO in the future. That would create much uncertainty as to whether the Organization would be able to meet all its financial obligations and commitments and whether there would be enough resources for the Organization to fulfill its mission. Such a result would be particularly unfortunate at the present time when Member States were about to commit to the adoption of the 45 agreed recommendations of a WIPO development agenda to be implemented in a cross-cutting fashion and involving the creation of a committee on development of intellectual property which would have quite a lot to deal with in the next couple of years.

14. The Delegation of Brazil also considered that the issue of favoring users which was raised by the proposal for a 15% reduction needed to be carefully scrutinized. The Delegation noted that, based on information provided by the Secretariat during the Program and Budget Committee debate, a 15% reduction as proposed by the United States of America and Japan would, on the one hand, greatly impact the future income of WIPO, transforming a projected surplus over 60 million dollars for the next biennium into a deficit. On the other hand, the benefits to users would be minimal if not insignificant, since the fees charged for international applications under the PCT represented no more than 1% of the total cost incurred by users seeking to obtain patent protection abroad via the PCT or otherwise in contrast to the remaining 99% relating to the cost of engaging agents or lawyers, translation costs, and national fees. The Delegation therefore believed that the proposed 15% fee reduction would be insignificant from the point of view of benefits to users at large, and excessive in terms of its impact on the future income of WIPO and on WIPO's current and new missions.

15. The Delegation of Brazil did not, however, dismiss *a priori* some of the arguments presented by the proponents of the 15% reduction proposal. As a principle, Brazil believed that the Organization should attempt to maintain its expenditures within the Budget adopted by Member States. Certainly, the idea of recurring surpluses could perhaps lead to broad allocation of resources and the permanent expectation of more funds at each new cycle. The Delegation was also sensitive to a certain point to the argument that perhaps the Organization as a whole should not rely disproportionately on PCT revenue. It should also be borne in mind, however, that the PCT system as a whole had been of benefit to its users from its inception in that it offered considerable savings in comparison with the alternative whereby protection relying on the Paris Convention needed to be obtained by applying directly in individual countries. The PCT system was a creation of the membership of the Organization as a whole rather than only of the Member States of the PCT Union, and of course the Organization had other sources of income and did not rely exclusively on the PCT.

16. The Delegation of Brazil also expressed its deep concern as to the imbalance of international applications under the PCT viewed from a north-south perspective. This was something that Brazil would wish to see corrected, or at least encouragement should be provided that could lead to such correction. For 2006, an approximate calculation showed a 9-to-1 gap comparing applications originating from developed countries with those

originating from developing countries. Putting aside applications originating from China and the Republic of Korea for the purposes of the calculation, the gap would be even greater.

17. The Delegation of Brazil noted that this was not a new issue, a first step having been taken in 1997 in an attempt to encourage the filing of more applications by applicants from developing countries. At that time a decision was taken to provide developing countries with a 75% reduction in fees for international applications under the PCT, according to criteria defining who would be the beneficiaries of the reduction. The Delegation's proposal in document PCT/A/36/12 was intended to maintain the 75% reduction that was currently applicable and also to broaden the criteria to apply to all developing country members of the Group of 77 and all those considered as developing countries in the context of the Organisation for Economic Co-operation and Development (OECD). The Delegation's proposal was intended to provide those developing countries which did not currently benefit from the 75% reduction with a 37.5% reduction. In the light of the recent debate in the Program and Budget Committee and of the additional information provided by the Secretariat, although the Delegation adhered to the general thrust of its proposal for a further reduction to the benefit not only of developing countries, it was prepared to reconsider specific details, including the figures contained therein, during either plenary or informal discussions.

18. The Delegation of Algeria, speaking on behalf of the African Group, thanked the United States and Japan, and Brazil, for their respective proposals relating to PCT fee reductions for filing and handling fees. The Group noted that, according to figures from the Secretariat, a 15% reduction for international filing and for handling would give a shortfall of 6 to 8 million Swiss francs in the budget for the biennium 2008-2009. This would mean that the implementation of the Program and Budget for that biennium as presented by the Director General, would generate a deficit of 52.1 million Swiss francs. That, therefore, would reduce the reserves of the Organization to the end of 2007 to 700,000 Swiss francs: a substantial cut in the possible expenditure for that biennium, whereas the percentage recommended for reservations or reserves for this Organization varies between 18 and 27. Such a situation would call into question the allocation of resources for funding a range of projects including the supplementary funding for the development agenda and the creation of a new IT platform for the Madrid system, as well as the projects on security services and the new building. The Group felt that the reduction as proposed by the US and Japan would have strongly negative financial repercussions across all the activities and programs of WIPO. It was pointed out that, according to Secretariat estimates, the reduction proposed on the fees would only account for 1% of the total costs of an application. Such reduction would therefore not have much of an impact on the levels of filing. However, the Brazilian proposal, which the Group did not believe would jeopardize WIPO's budget would provide substantial benefit for developing countries, and was considered worth further examination. The Group agreed with the statement of the Brazilian delegation that a possible adjustment to that proposal might allow a balance to be struck between patent filings from developed and developing countries and try to encourage further filings from developing countries. It was necessary to discuss figures relating to the two proposals to reach a conclusion on proposals which would enable the Organization to fully take on and fulfill the balanced mandate set out in the WIPO Convention.

19. The Delegation of Colombia expressed its thanks for the proposals by the Delegations of the United States of America, Japan and Brazil, which it believed to have a strong foundation and to favor development and innovation in certain countries. The Delegation stated that it should be borne in mind that the PCT procedure contained two phases: the international phase and the national phase. The Delegation referred to the national phase, in

particular, and wished to outline Colombia's experience with that phase of the system. Colombia had acceded to the Treaty in 2001 and since then had observed that, of the number of PCT international applications submitted by natural persons in Colombia, only one had been able to enter the national phase. This was due to the fact that the other applications were filed by applicants who did not have the economic resources to enter national phase. Most of such applicants had great expectations when filing PCT applications because they benefited from a 75% fee reduction. Yet, when those applications entered the national phase in the countries where protection was sought, it was economically impossible for them to continue with the process for three main reasons: the cost of engaging patent attorneys for the purposes of national phase processing; the cost of the national filing fee; and the cost of maintenance fees levied for applications that are undergoing national processing. This meant that the PCT did not in practice live up to the expectations of applicants from developing countries as they were unable to complete the national phase. The Delegation considered that this problem concerned not only Colombia but all developing countries.

20. The Delegation of Colombia therefore proposed examination of the data contained in the report on program outputs for the biennium 2004-2005. In 2005, a total of about 122,000 PCT applications were filed, representing an increase of 14.2% over the biennium 2002-2003. Applications from 23 developing countries increased by 46%. It would be very useful to investigate how many of the 11,000 applications from developing countries filed in 2002-2003 had managed to enter the national phase in at least three countries. The results of such a study would undoubtedly bear out the Delegation's concerns. The Delegation explained that it had not used the figure of about 16,000 applications as in the report since the end of the 30-month period for entering the national phase had not expired for all of the applications referred to.

21. The Delegation of Colombia therefore believed that a reduction in the fees payable in the international phase would not have a great economic impact, although it would make the PCT more accessible to inventors in developing countries. The Delegation rather emphasized the importance of examining the accessibility and benefit of the national phase for applicants from developing countries and countries in transition.

22. The Delegation of Poland, speaking on behalf of the Group of Central European and Baltic States, thanked the proponents of the proposals relating to future levels of PCT fees. The Group would support a slight decrease in the PCT fees for the next budgetary biennium. The main element necessary for long-term programming was not so much the level of fees but the predictability of that level in the longer term. A situation where the Assembly discussed a sharp increase in the fees in one biennium and a sharp decrease two years later was, understandably, not comfortable for the Organization and its policy planners since it made the long-term planning of activities more difficult. For that reason, the Group considered that any changes in the fees should be made by way of small increments over a period of time and should reflect trends in the financial position of the Organization. The Group noted that some burden would be involved in implementing an increased level of development activities related to the outcome of the work of the Provisional Committee on Proposals Related to a WIPO Development Agenda (PCDA), but did not consider that it should be financed entirely from the PCT fees; a necessary budgetary balance should be maintained, and patent applicants should not bear alone the costs of those activities. The Group believed that the long-term trend, parallel to progress in the present activities aiming at increased cost-effectiveness of the Organization, should be a steady decrease in the fees. This would be perceived as a benchmark of success of the Organization in implementing even better cost management policies.

23. The Delegation of Barbados thanked the Delegations of the United States of America, Japan and Brazil for their proposals on the reduction of PCT fees and stated that it supported a reduction in PCT fees, provided that such a reduction would not put in jeopardy the adoption and subsequent implementation of the Program and Budget for the next biennium. The Delegation expressed the view that the criteria presently applied under the PCT Schedule of Fees (per capita national income below 3,000 US dollars according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997) ought not to be the only determinant of eligibility for the 75% fee reduction.

24. The Delegation of Barbados further noted that, in comparison with other countries, Barbados was small with a very small population, and production usually suffered from dis-economies of scale. In order to recover the often considerable expense which a Barbadian inventor would have invested in bringing an invention to the stage where it could be patented, the inventor would have to look outside of Barbados. This made it necessary for the inventor to patent the invention not only in Barbados but also abroad. Similarly, Barbadian inventors may wish to have their inventions manufactured outside of Barbados, either because the necessary expertise to do so was not available in Barbados or because the cost of manufacturing in Barbados would be prohibitive. Again, this would also make it necessary for the inventor to patent the invention outside of Barbados. Given these circumstances, it was important that the PCT System be attractive to potential inventors in small countries like Barbados. A significant reduction in the fee for PCT applications filed by natural persons would facilitate this.

25. The Delegation of Barbados also noted that, at present, notwithstanding these and other factors, no special differential treatment was extended to natural persons in Barbados who wished to use the PCT system. The result was that Barbados was one of the very few members of the Group of 77 whose nationals were required to pay PCT fees in full. The Delegation of Barbados therefore welcomed the proposal of Brazil, in particular, as it would provide for special and differential treatment to be extended to small countries like Barbados. The Delegation believed that natural persons from Barbados who file international applications under the PCT system should be entitled to the same percentage reduction in PCT fees as natural persons from the vast majority of developing countries.

26. The Delegation of China stated that the PCT system had proved to be an efficient, convenient and practical means of filing patent applications internationally. Rational and wide-ranging use of the system would provide better protection for applicants worldwide. The system had now been in operation for almost 30 years and, during that time, the Schedule of Fees had proved to be reasonable. In the view of the Delegation, the accuracy of the projected surplus for the next two year biennium needed to be discussed, including that which was envisaged under the proposal by the Japan and the United States of America. Noting that PCT income was one of the main pillars of WIPO's resources, the Delegation expressed concern about the impact that any change in PCT income may have on the work of the Organization. Referring to the financial difficulties that the Organization had experienced in recent years, forcing it to reduce or even suspend certain activities, in particular, development cooperation activities, the Delegation stated that, in its view, the surplus of the 2006-2007 biennium was in part the result of the reduction or suspension of those activities. The envisaged surplus should not be used to reduce PCT fees but rather to resume those activities that had been affected by the financial difficulties and to fund the work relating to the envisaged establishment of the WIPO Committee on Development that had been approved by the WIPO Assemblies.

27. The Delegation was thus opposed to the proposal for a 15% reduction of PCT fees. The Delegation on the other hand welcomed the proposal by Brazil, noting that it would be beneficial for developing countries since it would facilitate participation by applicants from developing countries in the international patent system.

28. The Delegation of Belize stated that it wished to thank the Delegation of the United States of America for its proposal and noted that it had always treasured the advice and assistance received from the United States Patent and Trademark Office. Referring to the statement by the Delegation of the United States of America that WIPO's budget should be based on needs and not fee income, the Delegation of Belize expressed the view that, in its opinion and from reading document WO/PBC/12/4, the needs of the Organization would be expanding rather than decreasing. Noting that the implementation of several important projects listed in document WO/PBC/12/4, such as funding of activities relating to the Development Agenda or the establishment of new IT platforms for both the Madrid and the Hague Systems, would be jeopardized if the 15% fee reduction were approved, the Delegation expressed its concerns about the proposal by the United States of America and Japan. The Delegation further stated that it supported the remarks by the Delegation of Barbados regarding the extension of the PCT fee reduction to certain developing countries which, at present, because of the criterion applied, did not benefit from any reduction in PCT fees.

29. The Delegation of Nigeria stated that it believed that PCT fees had become a very effective tool as a pillar of resource generation for WIPO. This meant that anything done in connection with the setting of PCT fees would automatically affect the overall resources of WIPO. Consequently, it was necessary to be extremely careful. To that end, the Delegation fully supported the statement by the Delegation of Algeria on behalf of the African Group on this matter. It agreed that any reduction would disproportionately affect WIPO's activities and programs in the next biennium, and in particular progress regarding the development agenda. The argument that efficiency in the Secretariat could be increased by reducing resources might not hold at all. Looking internationally, corporations that were short of money engaged in business that had nothing to do with resources. Attempts to improve the efficiency of the Secretariat should focus on doing just that, and not on reducing the resources allocated to the Secretariat. Consequently, the Delegation would be very reluctant to support a 15% reduction in the PCT fees. It considered that doing so would also hinder the progress of most developing countries, some of which lacked the capacity to make effective use of the PCT system. Some of the resources coming from the PCT should go into helping capacity building in developing countries, as had been pointed out by the Delegation of Barbados. A significant amount could be done with that money.

30. While recognizing that the proposal put forward by the Delegation of Brazil might not be perfect, the Delegation of Nigeria considered that the proposal sought to reach out to a greater percentage of countries in furtherance of the ambitions, expectations and objectives expected of a specialized United Nations agency. It was necessary to consider what the mission of WIPO was. As a specialized agency of the United Nations, WIPO's mission should go beyond the sole purpose of making a profit. This meant that activities of WIPO should help the development of as many countries as possible in terms of economic impact. In the short term, this might not provide the greatest resources coming to WIPO, but it would expand the base of countries from which applications were made, and consequently fees received, through the PCT system, increasing for the future the amount of money that would come to WIPO. Therefore, it was better to invest more in developing countries, which meant investing

in future surpluses for WIPO. With this in mind, the Delegation supported the proposal by Brazil and did not support the 15% reduction in fees proposed by the United States of America and Japan.

31. The Delegation of Cuba stated that it opposed the proposal for a 15% fee reduction, noting the impact that such reduction may have on the financial resources of the Organization, in particular, those allocated to development cooperation and the implementation of the development agenda. The Delegation expressed its support for the proposal by Brazil concerning fee reductions for applicants from developing countries, noting that those applicants were the ones who least used the PCT system.

32. The Delegation of Indonesia could understand the desire to significantly reduce the PCT fees but considered that, taking into consideration that the majority of Contracting States of the PCT were countries with developing economies, the proposal made by the Delegation of Brazil was the most suitable one. It considered that the proposal of Brazil was also in line with the figures provided by the Secretariat.

33. The Delegation of South Africa, noting the resources needed to fund development cooperation related activities, stated that it could not support the proposal for a 15% decrease in PCT fees. In order to allow users from developing countries to gain easier access to the benefits of the PCT system, which at present was mostly used by applicants from developed countries, the Delegation stated that it supported the proposal by Brazil.

34. The Delegation of Trinidad and Tobago thanked the Delegations of Brazil, Japan and the United States of America for their proposals, which both headed in the same direction and which both might have the effect of broadening the user base of the PCT system in developing countries and among small and medium-sized enterprises. The Delegation supported the statements made by the Delegations of Barbados and Belize. It was also mindful of the other very significant overhead costs faced by patent applicants in addition to the PCT fees. The experience of clients of the Intellectual Property Office of Trinidad and Tobago was that external filing and commercialization costs could range from 40,000 to 500,000 United States dollars, on top of approximately 2,000 dollars in PCT fees. In this regard, Trinidad and Tobago supported the proposal made by the Delegation of Brazil for a reduction in PCT fees to a level that would both encourage applicants and also not impact significantly on the income and any dependent development initiatives of WIPO. In the near future, if levels of PCT use increased in accordance with the trend, deeper reductions in PCT fees could be considered, when more data was available on the effects on users and the apportioning of the Program and Budget of WIPO in its development cooperation activities.

35. The Delegation of Benin, speaking on behalf of the least-developed countries (LDCs), considered that the proposal by the United States and Japan would significantly affect the allocation of budgetary resources and the implementation of the recommendations of the PCDA. This would jeopardize the policies that had been started up in WIPO to the benefit of developing countries generally, and more specifically LDCs. Therefore LDCs would not be able to go along with the proposal to reduce the PCT filing and handling fees by 15%. With regard to the Brazilian proposal, LDCs were still waiting for additional information and the Delegation requested the Secretariat to provide further information on the implications of that proposal for the budget.

36. The Delegation of Portugal, on behalf of the European Community and its 27 Member States, stated that this issue merited an in-depth analysis by all PCT Member States and that the European Community was open to engage in a discussion and to look for a consensus on the matter. It was ready to consider the possibility of a limited PCT fee reduction that should not jeopardize the financial equilibrium of the Organization, allowing for a limited increase in the level of reserves of the Organization and the future predictability of revenues, as well as an in-depth examination during one or two years in order to evaluate the consequences of the fee reduction.

37. The Delegation of Kenya aligned itself with the views of the African group as stated by the Delegation of Algeria. It considered that the proposal by Brazil was the more favorable of the two proposals and that it would not affect negatively the work of WIPO. The Delegation was concerned that the proposal by the United States of America and Japan for a 15% decrease in PCT fees would impact negatively on WIPO's reserves. It also believed that a 15% reduction in fees would have negative financial implications for the program of WIPO, including the development agenda. Therefore, the Delegation favored the proposal by Brazil, but noted that further input was required based on actual figures before it could be properly considered.

38. The Delegation of Ecuador thanked the Delegations of the United States of America, Japan and Brazil for their proposals. Ecuador, as had previously been stated in the Program and Budget Committee, was interested in the proposal by Brazil and believed it to be the right path to follow in supporting developing countries such as Ecuador. Through proposals of this sort, it would be possible to address the imbalance which existed in international filing under the PCT, whereby the great majority of Contracting States were developing countries but most of the applications come from the developed States.

39. The Delegation of Chile noted that the Chilean congress was analyzing the accession of Chile to the PCT and, as a future member of the PCT and more particularly because of the implication of the reduction in fees and the impact that that could have on the Program and Budget of WIPO, the Delegation expressed its views on the proposals for a reduction in fees. The Delegation considered that the proposals made by the United States and Japan and by Brazil set out issues that were of extreme importance in WIPO for its member States and for society more broadly. Chile observed that reductions in patenting costs for inventors in developing countries would contribute to ensuring that the PCT system had a positive impact on national promotion of inventiveness in the economies of Contracting States. For this reason, the Delegation considered that the proposal by Brazil was a major contribution. It would allow progress in the international patent system by facilitating access by developing countries' inventors to the system through the PCT. The proposal by Brazil was a positive one, because it would not jeopardize the ordinary budget of the Organization. Issues relating to implementing the development agenda proposals, in particular, needed to be borne in mind. The Delegation considered that a reduction in costs for users from developing countries was something which could be extended in the future to institutions such as research centers, universities and institutes of higher education. These were becoming increasingly important in Chile as promoters of innovation.

40. The Delegation of Switzerland was in principle in favor of a reduction in fees, bearing in mind the financial situation of the Organization, and thanked the Delegations of the United States of America, Japan and Brazil for their proposals. However, the Delegation was not certain that this was the appropriate time to start reducing fees; these doubts extended to both the proposal by the United States of America and Japan and to that by Brazil. The Delegation

considered that the current situation did not permit a proper analysis of the financial situation of the Organization in the medium term. By way of example, it was known that the Organization would be implementing the IPSAS accounting standards, which might cast the financial situation of the Organization in a different light. The proposal by Brazil had real merit, as did that by the United States of America and Japan. However, the Delegation considered that the proposal by Brazil left open a range of questions, particularly of exactly what should be the definition of the applicants who could benefit from the proposed reduction. However, the Delegation did not believe that any reduction in the level of fees should proceed at this time.

41. The Delegation of the United States of America stated that it wished to respond to some of the points that had been raised with regard to the proposal it had made with the Delegation of Japan. It noted that some 94% of WIPO's budget would be supplied by fees provided by its services, with some 80% coming from the PCT system alone. Of that PCT income, some 65% of PCT fees went to activities outside of the PCT system, including development cooperation activities such as those relating to WIPO's development agenda. The Delegation, noting that the vast majority of users of the PCT system came from the United States of America, Japan and Europe, referred to a letter dated September 6, 2007, sent to WIPO's Director General by the so-called "Industry Trilateral", made up of Business Europe, the Intellectual Property Owners Association, the American Intellectual Property Law Association and the Japan Intellectual Property Law Association, voicing strong support for a 15% reduction in PCT fees. The Delegation quoted from that letter as follows: "We are aware that PCT funds subsidize other WIPO programs. While we are interested in any of these programs and activities, we believe the amount of surplus PCT fees that will be generated in the next biennium far exceeds the amount that PCT applicants should reasonably be expected to subsidize other activities of WIPO and that the proposal to reduce PCT fees is justified and fair to all concerned. We urge therefore that the 15% fee reduction be adopted as proposed."

42. The Delegation of the United States of America further stated that Group B countries had shown a great deal of flexibility in adopting the 45 proposals during the discussions in the PCDA and requested that members of the Assembly show similar flexibility in supporting the proposal for a 15% fee reduction. The Delegation noted that serious questions had been raised by the Joint Inspection Unit with regard to budgeting based on income rather than needs and to certain management issues, and expressed the view that any Organization that saw a five-fold increase in its budget and a four-fold increase in its staff in a period of 20 years would face serious management challenges.

43. The Delegation of the United States of America continued to press for what it regarded as a justified fee decrease. It further stated that it believed that the figures presented by the Secretariat were biased against such a fee decrease, noting that the papers that were presented by the Secretariat during the recent session of the Program and Budget Committee with regard to utilization of the reserves contemplated five projects which would completely deplete the reserves in the next biennium, the bulk of which were funded by PCT fees. As noted by other delegations, these were projected reserves and the Secretariat was proposing to spend them without the possibility of a PCT fee decrease. In doing so, the Secretariat was rejecting a proposal by certain countries that represent the majority of PCT users.

44. In concluding, the Delegation of the United States of America stated that, as a major contributor to WIPO through the PCT, it was not in a position to approve a budget that did not reflect a significant decrease in PCT fees in the order of 15%. With regard to the proposal by

Brazil, it stated that it would favor instead an across the board fee reduction and could not at this time support further amending the PCT Schedule of Fees beyond the current reduction granted to natural persons from low income countries. In this context, the Delegation questioned why certain developing countries with a higher income should receive preferential treatment under the PCT, especially since, as had been noted by the Delegation of Brazil, PCT costs represented in many cases only 1% of overall patent costs. It further expressed the hope that the PCT Assembly could support a PCT fee reduction for all users, which could be of an amount between that proposed by United States of America and Japan and that proposed by Brazil.

45. The Secretariat explained that the figures on the impact of the proposed PCT fee reduction which had formed the basis of the discussions in the Program and Budget Committee had been based on an objective model using, upon the request of Member States, two different scenarios, one simulating a 15% reduction of PCT fees and one simulating a 5% reduction, using the same number of applications that it had used as the basis for estimating the income in the proposed Program and Budget for 2008 and 2009. In its view, this did not constitute a biased method but simply a mathematical operation. The simulations had shown that, if a 15% reduction were approved, the next biennium would end with a deficit of 52 million Swiss francs, based on the assumption that the Program and Budget as proposed by the Director General would be approved by the Member States.

46. The Secretariat added that the Program and Budget of the Organization was not driven by income but by demand and the needs of its Member States. If it were income driven, the Secretariat would not propose a Program and Budget with a surplus but rather a balanced budget, using all the income. The fact that the Organization's staff had increased four-fold, and its budget correspondingly, during the last 20 years was mainly due to the success and growth of the PCT system and of the other international registration systems, allowing the resources of the Organization to grow in parallel.

47. The Delegation of El Salvador thanked the Delegations of the United States of America and Japan for their proposal and noted that it would have been beneficial, so as to take the right decisions, if more information on the possible impact of the proposed fee reduction would be available. With regard to the proposal by Brazil, the Delegation stated that it viewed it positively, noting that it would not impact on the Organization's ability to properly finance present and future programs and activities.

48. The Delegation of Congo felt that the proposal for fee reduction would negatively affect a range of programs of great importance to WIPO. It noted that the Secretariat had just stated that the proposed 15% reduction would have a negative impact. Therefore the Delegation expressed its support for the proposal by Switzerland. In addition, it reminded the Assembly that what was at stake involved WIPO administered programs for which there had already been a consensus to implement. As such, it expressed the need to maintain the PCT fees as they were, and carry out a further study on the issue over the next three years. For the sake of the efficiency of the Organization, the Delegation felt that this would be the wiser direction to take at this point in time, considering that it was necessary to save the reserves for the programs foreseen by the Organization for the benefit of Member States. The Delegation also recalled that some other Delegations had said that the reserves themselves should be used to fund certain programs, rather than development-related issues. If so, perhaps certain fees would need to be reduced and if specific fees were to be reduced, it might hinder the successful achievement of the programs and the work that had been set out by WIPO.

49. The Delegation of the United States of America thanked the Secretariat for its explanations but noted that it still disagreed with a number of statements that had been made. It continued to be of the opinion that the charts produced by the Secretariat were biased and misleading because they assumed spending at a level that had been proposed by the Secretariat for the 2008-2009 Program and Budget but which had not been approved by the Program and Budget Committee at its session in September 2007. Furthermore, the charts ignored growth in demand that in the view of the Delegation could very well occur beyond the conservative projection of the Secretariat. The Delegation believed that WIPO's budget was indeed income-driven, noting that, under the proposed program and budget the Secretariat proposed spending all of the reserves beyond the target level.

50. The Delegation of Japan expressed its support for the statements made by the Delegation of the United States of America and questioned the accuracy of the impact assessment carried out by the Secretariat, noting that it was based on a projection of an increase of 5 or 6% in international filings under the PCT over the next biennium and the assumption that expenditures were fixed as proposed by the Secretariat. It expressed the view that it was not healthy for the Organization to increase expenditures every time that income increased.

51. The Delegation of Japan further expressed the view that, in general, a fee reduction would be a positive element which would stimulate PCT filings by applicants seeking patent protection globally, and noted that the issue of reduction of PCT fees should be seen from the perspective of its impact on PCT operations and on the PCT Union. A wish for some kind of fee reduction was shared by a number of delegations, and the Delegation hoped that a reduction might be agreed so as to meet a variety of priorities.

52. The Delegation of Ukraine stated that it had examined the issue of PCT fees several times in the context of the discussions in the Program and Budget Committee. It maintained its position that any possible negative results deriving from the reduction of PCT fees should be avoided. It would be beneficial first to assess several scenarios for possible fee reductions, and the Delegation suggested that a reduction could commence with a 2 or 3% decrease in the 2008-2009 biennium rather than immediately with a 15% reduction. The results of the first year could then be used to analyze and forecast what can be done in the second year of the biennium. In this way, greater use of the PCT would be encouraged, which would be of great benefit to applicants, while the financial situation of WIPO would not be hindered. With regard to the expenses of the PCT sector, the Delegation mentioned that it had asked for relevant financial information. The Delegation considered that such information would be very useful in its assessment of proposals concerning fees.

53. The Delegation of Senegal supported the statement made by the Delegation of Benin on behalf of the least developed countries. With regard to the proposal by the United States of America and Japan, the Delegation expressed the view that the kind of measure proposed would introduce an imbalance between the income and the expenditure of the Organization. This would deprive the Organization of one of the means necessary to carry out the policies and programs that Member States had asked for. The Delegation could thus not endorse the proposal to reduce the PCT fees by 15%. With regard to the proposal by Brazil, the Delegation noted that it was incomplete and that the Delegation could thus not support it without examining it in greater detail. Consequently, the Delegation proposed that consideration of this proposal should be put on the agenda of the 37th session of the PCT Assembly in 2008.

54. The Delegation of Argentina stated that, although Argentina was not a Contracting State of the PCT, it wished to make a statement as a Member State of WIPO. As such, it had taken part in discussions on this item in the WIPO Program and Budget Committee as well as on other occasions. The Delegation expressed its concern about the proposal by the United States of America and Japan to reduce PCT fees, as it might have a negative effect on the budget of the Organization and particularly on the implementation of the development agenda, which would benefit from available funds under the 2008-2009 budget. In this context, the Delegation felt that the proposal by Brazil seemed to cover both the expectations of those delegations that were concerned about broader access to the PCT system and those of developing and least developed countries that wanted to join the system. The Delegation expressed the view that the proposal by Brazil, providing for special treatment for applicants from developing countries, would encourage those applicants, including small and medium sized enterprises, to participate in the PCT system. On the other hand, the proposal by the United States of America and Japan would encourage applicants who already participated in the system to file even more applications. The Delegation further expressed the view that the proposal by Brazil would be an incentive for those States who have not yet joined the PCT to do so.

55. The Chair, in summarizing the discussions to this stage, stated that, while many delegations had supported the proposal by Brazil, other delegations had indicated their preference for an across-the-board fee reduction which would benefit all applicants. In addition, the Delegation of Brazil had itself indicated the need for further informal consultations so as to refine its proposal. With regard to the proposal by the United States of America and Japan, the Chair noted that many delegations had expressed concerns or opposed the proposal, noting its impact on the envisaged program and budget of the Organization, in particular, on development cooperation related activities. The Chair thus stated her intention to hold informal consultations so as to seek a balanced approach with regard to both proposals.

56. The Secretariat stated that it wished to clarify certain aspects with regard to the proposal by Brazil. The Secretariat explained that, under the existing Schedule of Fees under the PCT, a 75% reduction was granted to individuals from developing countries whose per capita income, assessed by reference to the per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996, and 1997, was less than US\$ 3,000. In addition, a 75% reduction was granted to all applicants from least developed countries, whether individuals or legal persons. Under the proposal by Brazil, a different class of countries would benefit from the 75% reduction, since it referred to countries that were members of the Group of 77 or States classed as a developing country by the OECD Development Assistance Committee. A comparison of the list of countries that qualified for a fee reduction under the existing Schedule of Fees with the list of countries that would qualify for such a reduction under the proposal by Brazil showed that the proposal by Brazil would affect only eight countries that were members of the PCT which, at present, did not benefit from any fee reduction, but would benefit from a 37.5% reduction under the proposal by Brazil; those countries were Antigua and Barbuda, Bahrain, Barbados, Libya, Oman, Singapore, Trinidad and Tobago, and the United Arab Emirates.

57. The Secretariat stated further that, under the proposal by Brazil, the threshold to qualify for a fee reduction of 75% would change from the *per capita* national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996, and 1997 to those figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 2005, 2006 and 2007. This

would result in some 39 countries seeing their reduction reduced from the present 75% to 37.5%, with the consequence that, over the next biennium, it was projected that WIPO would have an additional income of about 1.6 million Swiss francs.

58. In addition, the Secretariat stated that it wished to make an observation with regard to the comment made by the Delegation of Colombia, which it had also raised in the Program and Budget Committee, namely, that the PCT was not meeting the expectations of applicants from developing countries with regard to national phase processing of PCT applications, noting the often prohibitively high national fees due upon national phase entry. The Secretariat noted that this was an effect of the cost of patenting at the national level rather than an effect of the PCT system. The effect of the PCT was to delay the payment of national filing fees, from 12 months when filing under the Paris Convention route direct, to 30 months when filing under the PCT. In addition, the basis upon which applicants had to decide whether to proceed with their applications before the national Offices was strengthened, noting the time gained since the filing of the application in which to evaluate the technical and commercial viability of the invention, and the further information gained during the international phase in the form of the international search report and the international preliminary report on patentability. The concerns expressed by the Delegation of Columbia were thus more the result of the costs that have to be incurred at the national level, whether after 12 months or after 30 months, and were not a direct effect of the PCT.

59. The Secretariat also wished to contribute to the discussions on the influence of the PCT fees on the decision to file a patent application. According to calculations by the Organization, using the Global IP Estimator software, PCT fees were less than 1% of the total cost of patenting internationally, a figure which had also been mentioned in the discussions in the Program and Budget Committee. However, from the point of view of the applicant, it would appear that the fact that the PCT costs would only be around 1% of the overall cost of patenting an invention would not necessarily mean that an applicant would not assess the cost of the PCT services by reference to the value of those services to the applicant, as opposed to the total cost that the applicant has to pay to patent his invention. In this context, the Secretariat noted that, in its estimation, PCT applications accounted for only about 48% of international patent applications, international patent applications being defined as patent applications that are filed in more than one country, and that the PCT therefore had to compete with the alternative filing mechanism available under the Paris Convention direct route.

60. The Delegation of Brazil expressed its appreciation for the information and comments provided by the Secretariat. It pointed out, as it had already done in the Program and Budget Committee, that its proposal needed to be refined, and that certain additional data and information that had been provided by the Secretariat should be taken into account. The Delegation stated that, this notwithstanding, the intention of its proposal was clear, namely, to provide an additional benefit in the form of additional fee reductions to applicants from developing countries, and to be as inclusive as possible with regard to all developing countries.

61. The Delegation of Colombia stated that it agreed with the statement by the Secretariat that the costs to be incurred by applicants for national processing of PCT applications were not a direct consequence of the PCT system. However, the Delegation suggested that the Secretariat should carry out a study on the number of applications filed by individuals from developing countries that had been able to enter the national phase. The Delegation stated

that its own statistics in this respect would be a matter of concern and that therefore, in its view, a study to be carried out by the Secretariat would be beneficial to applicants and inventors from developing countries.

62. Following informal consultations, the acting Chair summarized the results of those consultations as follows. There continued to be no consensus on the proposals for PCT fee reductions by, on the one hand, the United States of America and Japan, and, on the other hand, Brazil. One delegation, speaking on behalf of a regional group, had indicated that it would not be prepared to move to discussions on any of the remaining items on the consolidated agenda of the Meetings of the Member States of WIPO until the matter related to item 12 of that agenda had been addressed. Other delegations, speaking on behalf of other regional groups, had indicated their willingness to further discuss the proposals for PCT fee reductions. The acting Chair further noted that, during the informal consultations, there had been agreement among delegations to request the International Bureau to carry out a study on the eligibility criteria for determining the group of developing and least developed countries whose applicants should benefit from a reduction of PCT fees and to present that study to the next session of the PCT Assembly in September-October 2008. In conclusion, the Chair suggested that the session of the Assembly be adjourned and that the Chair of the General Assembly be requested to resume the Meeting of the Member States of WIPO.

63. The Delegation of the United States of America requested clarification from the acting Chair as to whether he proposed to suspend the meeting of the PCT Assembly as opposed to adjourning it, so that delegations would have the possibility of a resumption later in the day.

64. The Delegation of Algeria stated that it, too, requested clarification, noting that the discussions in the PCT Assembly on proposed fee reductions had explicitly been scheduled to take place before the discussions on the WIPO Program and Budget so as to know the outcome of those discussions before starting the discussions on the WIPO Program and Budget.

65. The Delegation of Brazil stated that, in its view, it would not be possible to suspend the meeting of the PCT Assembly before agreement had been reached, be it an agreement on any of the proposals or an agreement not to agree. The matter could not simply be passed on to the Chair of the General Assembly, noting that it was within the competence of the PCT Assembly and not the General Assembly to take a decision on the proposals for PCT fee reduction.

66. The Delegation of Spain stated that it supported the statement by the Delegation of Brazil.

67. The Delegation of the United States of America stated that it, too, shared the sentiment expressed by the Delegations of Brazil and Spain, and expressed the view that the meeting should be suspended as opposed to being adjourned, noting that there was enough time left for attempting to make progress on the matter.

68. The Delegation of Nigeria stated that, in its view, the matter could not be left open indefinitely. If the meeting were to be adjourned, it should be made clear when the meeting would be reconvened to take a decision on the matter. The Delegation, referring to previous statements by other delegations as to the link between the matter at hand with other issues, in particular, item 12 on the agenda of the Meeting of the Member States of WIPO, stated that adjourning the meeting and leaving the matter at hand open would mean that no solution

would be found for an indefinite period, noting that item 12 had already been closed and that it would take a two-thirds majority to reopen discussions on that item.

69. The Delegation of Brazil stated that it wished to clarify that, while its proposal, as modified, was for a 90% fee reduction for applicants from those countries which at present, under the criteria set out in the current Schedule of Fees, benefited from a 75% fee reduction, the proposal was meant to be as inclusive as possible. The Delegation was thus open to an *ad hoc* decision which would allow all developing countries, including those which, under the present Schedule of Fees, did not benefit from any fee reduction, to be included in the group of countries benefiting from the reduction. The Delegation further stated that, during the informal consultations, it had made a proposal for a 2.5% across-the-board fee reduction for all applicants, and that it supported the proposal for a study to be carried out by the Secretariat on the criteria for determining the group of developing and least developed countries whose applicants should benefit from a reduction of PCT fees.

70. The Delegation of Algeria requested the Chair to indicate when it was intended to resume the meeting of the PCT Assembly so as to ensure that the matter at hand was not left open beyond the end of the Meeting of the Member States of WIPO. The Delegation further stated that it would have no objection to suspending the meeting if indeed further informal consultations took place; if, however, there was no readiness to go back to informal consultations to negotiate the proposals at hand, then the meeting should not be suspended but be closed.

71. The Delegation of Congo stated that, in its view, noting the various proposals for PCT fee reductions made by several delegations, the Secretariat should present a balanced proposal that could be negotiated among delegations in a satisfactory manner.

72. Following further informal consultations, the Delegation of Brazil, speaking on behalf of the Group of Latin American and Caribbean countries, stated that the Group wished to support the modified proposal by Brazil for a 90% fee reduction which would benefit applicants from certain developing countries, based on the criteria set out in the current Schedule of Fees. The Delegation stated further that it supported the proposal to request the International Bureau to carry out a study on the eligibility criteria for determining those developing and least developed countries whose applicants should benefit from a reduction of PCT fees and to present that study to the next session of the Assembly in September-October 2008. Finally, it proposed to take an *ad hoc* decision to allow those eight developing countries which at present did not benefit from any fee reduction to be included in the group of developing countries which did benefit, thus bridging the present north-south discrepancy in the use of the PCT without jeopardizing the implementation of WIPO's Program and Budget.

73. The Delegation of the United States of America, speaking on behalf of Group B, stated that it recognized that there was no consensus yet on the two proposals for PCT fee reductions by, on the one hand, the United States of America and Japan, and, on the other hand, Brazil, but that it was aware of active ongoing informal consultations on this matter and several other agenda items. The Delegation stated that it thus could not support closure of the debate on the item of PCT fee reductions.

74. The Delegation of France, referring to the proposal by Brazil, noted that, in its view, during informal consultations, an agreement had emerged that the eligibility criteria for determining who should benefit from a reduction of PCT fees should be based on economic grounds. The Delegation stated that it attached great importance to this point and expressed the view that the study to be carried out by the Secretariat should proceed along those lines.

75. The Delegation of Switzerland stated that it wished to be associated with the statement by the Delegation of the United States of America, speaking on behalf of Group B, and that it therefore was not prepared, at this stage of the debate, in particular, before item 12 of the agenda of the Meeting of Member States of WIPO had been satisfactorily settled, to start discussing any decision on PCT fee reductions.

76. The Delegation of Japan noted that it wished to echo the statement made by the Delegation of the United States of America. Since there was no consensus on the question of a PCT fee reduction, it would not be appropriate to close the debate at this point.

77. The Delegation of Spain stated that it associated itself with the position expressed by the Delegations of the United States of America, Switzerland and Japan.

78. The Delegation of Portugal stated that it wished to endorse the position expressed by the Delegations of the United States of America, Switzerland and Japan.

79. The Delegation of the Netherlands stated that it supported that position as well.

80. The Delegation of Algeria stated that it could not understand the meaning of the statements made by several delegations that the debate could not be closed because of debates that were ongoing on other agenda items. The item under consideration in the PCT Assembly was a separate agenda item, and there was no link in the agenda that would make one agenda item conditional upon another. The Delegation expressed its disappointment that, following the earlier break in proceedings, the time had not been used for further informal consultations and hoped that there would still be informal contacts in good faith before the meeting ended. The Delegation stated further that there may have been some confusion between the closure of the debate and the closure of the meeting and that it wished to formally propose, on behalf of the Group of African states, to close the debate, invite all parties to engage in informal consultations, and to resume the meeting as soon as everybody was read. The Delegation, referring to Rules 18(1) and 19(1) of WIPO's General Rules of Procedure, thus formally requested closure of the debate and suspension of the meeting so that, when it was resumed, only two things could be done: to adopt any decision that may have been reached by consensus and/or to adopt the report.

81. The Delegation of Oman stated that it supported the motion by the Delegation of Algeria.

82. The Delegation of the United States of America, referring to Rule 27(1) of WIPO's General Rules of Procedure, requested that the voting on the motion by the Delegation of Algeria be by roll call.

83. The Delegation of the Spain stated that it supported the request made by the Delegation of United States of America.

84. The Secretariat explained that it was its understanding that the Delegation of Algeria had moved both suspension of the meeting and closure of the debate, and that the Delegation wished to first vote on the motion for suspension of the meeting. The vote on this motion would normally be by show of hands.

85. Following the Secretariat's explanations, the Delegation of Algeria stated that it wished to clarify that it did not want to first vote on the motion for suspension of the meeting; rather, it wished to first vote on the motion for closure of the debate so that informal consultations could take place to try to find a common solution, following which the meeting should be reconvened to adopt any decision and the report.

86. The Secretariat, in response to the intervention by the Delegation of Algeria, stated that Rule 20 of WIPO's General Rules of Procedure specified a particular order of procedural motions as follows: (a) to suspend the meeting; (b) to adjourn the meeting; (c) to adjourn the debate on the question under discussion; and (d) to close the debate on the question under discussion.

87. The Delegation of Algeria stated that it did not agree with the Secretariat's interpretation of Rule 20 of WIPO's General Rules of Procedure, noting that that Rule established an order of priority when there were several procedural motions presented by different countries but not when, as in this case, a delegation presented a single motion with two components, one for the closure of the debate and a second component for the adjournment of the meeting. Should there be a problem with this interpretation, the Delegation stated that it wished to withdraw the second part of the motion in accordance with Rule 22 and move that the debate be closed.

88. The Chair stated that he considered Rule 20 did apply to the two motions put forward by the Delegation of Algeria.

89. Following further clarification by the Delegation of Algeria, the Secretariat stated that, following the withdrawal of the motion to suspend the meeting by the Delegation of Algeria, the vote would be on the motion to close the debate.

90. The Delegation of Brazil, referring to Rule 18(2) of WIPO's General Rules of Procedure, stated that there would be a need for a debate on the motion.

91. The Delegation of South Africa stated that it supported the motion by the Delegation of Algeria.

92. The Delegation of the United States of America urged other delegations to oppose the motion to close the debate. It stated its belief that consultation on the substantive matters could lead to a successful conclusion of the meeting.

93. The Delegation of Brazil expressed the view it would be an unfortunate course of action to resort to the Rules of Procedure without trying to solve the issue at hand. The Delegation stated that the countries belonging to the Group of Latin American and Caribbean countries felt that there should be an attempt to reach consensus on all items and that recourse to voting should be avoided at all costs. The Delegation stated that it expected that many Latin American and Caribbean countries would abstain in the vote.

94. The Delegation of the United Kingdom, noting that the Delegation was not sure whether the last intervention by the Delegation of Brazil constituted the required second argument against the motion, stated that, if it did not, the Delegation wished to speak against the motion.

95. The Delegation of Switzerland requested clarification as to how the vote would take place, whether it would be by roll call or not. Furthermore, the Delegation wished clarification as to which Members of the PCT Union were entitled to vote.

96. The Delegation of Senegal stated that, under WIPO's General Rules of Procedure, once delegations had spoken in favor or against a motion, the motion should immediately be put to the vote without further discussion.

97. The Delegation of Italy stated that it shared the sentiments expressed by the Delegation of Brazil. The Delegation noted its frustration about the lack of dialogue and the inability to reach a compromise.

98. The Secretariat confirmed that voting would be by roll call and further explained the voting procedures set out in Rule 27 of WIPO's General Rules of Procedures.

99. The Delegation of the United States of America stated that it felt it important to address the question put by the Delegation of Switzerland as to which of Members of the PCT Union would be entitled to vote.

100. The Delegation of Algeria stated that it believed that the intervention by the Delegation of the United States of America had been humble because it would represent one of the countries concerned by question as to which delegations had the right to vote or not, noting that the arrears of the United States of America were what they were. The Delegation suggested that the Delegation of the United States of America and delegations of other countries that had arrears should be given the right to vote as they were given the right to vote the last time the Assembly had voted in 1997. If that was not agreed, the Delegation suggested taking a vote on that particular procedural point.

101. The Secretariat explained that Member States that were more than two years in arrears would not have the right to vote in the event of a vote. In reference to the statement made by the Delegation of Algeria about the vote in 1997, the Secretariat noted that, at that time, the Member States of WIPO had agreed a specific agreement had been reached which gave all Member States of WIPO the right to vote, irrespective of whether or not they were in arrears with their contributions. Upon a request for further clarification by the Delegation of the United States of America, the Secretariat clarified that the specific 1997 agreement related specifically to the election of the Director General, as distinct from the provisions of the PCT Treaty which specified which delegations were eligible to vote. In terms of delegations eligible to vote, the Secretariat noted that there were 137 Members of the PCT Union of which 15 were not eligible to vote.

102. The Secretariat further explained that the motion was to close the debate on the question of PCT fee reductions, relating to the proposals by the United States of America and Japan, and of Brazil. Any delegation voting "yes" would be voting to close the debate on that question; any delegation voting "no" would be voting not to close the debate on the question.

103. The result of the vote was as follows:

Comoros: yes; Costa Rica: abstention; Croatia: no; Cuba: yes; Denmark: no; Dominica: absent; Egypt: yes; El Salvador: abstention; United Arab Emirates: absent; Ecuador: abstention; Spain: no; Estonia: no; United States of America: no; The Former Yugoslav Republic of Macedonia: no; Russian Federation: abstention; Finland: no; France: no; Gambia: yes; Georgia: absent; Greece: no; Grenada: absent; Guatemala: absent; Equatorial Guinea: absent; Honduras: abstention; Hungary: no; India: yes; Indonesia: yes; Ireland: no; Iceland: no; Israel: absent; Italy: no; Japan: no; Kazakhstan: abstention; Kenya: yes; Kyrgyzstan: abstention; Lesotho: yes; Latvia: no; Liberia: abstention; Liechtenstein: absent; Lithuania: no; Luxembourg: no; Madagascar: yes; Malaysia: yes; Malawi: abstention; Mali: yes; Malta: absent; Morocco: yes; Mexico: abstention; Moldova: no; Monaco: no; Mongolia: absent; Montenegro: absent; Mozambique: yes; Namibia: yes; Nicaragua: abstention; Norway: no; New Zealand: absent; Oman: yes; Uganda: yes; Uzbekistan: absent; Papua New Guinea: abstention; Netherlands: no; Philippines: yes; Poland: no; Portugal: no; Syrian Arab Republic: yes; Republic of Korea: no; Lao People's Democratic Republic: yes; Democratic People's Republic of Korea: yes; Czech Republic: no; United Republic of Tanzania: yes; Romania: no; United Kingdom: no; Saint Lucia: absent; Saint Kitts and Nevis: abstention; San Marino: absent; Saint Vincent and the Grenadines: absent; Senegal: yes; Serbia: no; Seychelles: yes; Sierra Leone: yes; Singapore: yes; Slovakia: no; Slovenia: no; Sudan: yes; Sri Lanka: yes; Sweden: no; Switzerland: no; Swaziland: yes; Tajikistan: absent; Trinidad and Tobago: abstention; Tunisia: yes; Turkmenistan: absent; Turkey: no; Ukraine: no; Viet Nam: yes; Zambia: yes; Zimbabwe: yes; South Africa: yes; Albania: absent; Algeria: yes; Germany: no; Antigua and Barbuda: abstention; Armenia: absent; Australia: no; Austria: no; Azerbaijan: absent; Bahrain: yes; Barbados: abstention; Belarus: yes; Belgium: no; Belize: abstention; Benin: yes; Bosnia and Herzegovina: no; Botswana: yes; Brazil: abstention; Bulgaria: no; Cameroon: yes; Canada: no; China: yes; Cyprus: no; Colombia: abstention.

104. The Secretariat, in announcing the result of the vote, explained that the motion was to close the debate on the question. In total, there were 82 votes; 55 votes were needed for the motion to succeed. There had been 40 votes in favor of the motion, and 42 votes against the motion. There were 19 abstentions which, under the WIPO General Rules of Procedure, did not count as votes. The motion to close the debate had thus been defeated.

105. In the event, the debate in the PCT Assembly on the question of fee reductions was not resumed.

Flexibility Formula for Administration of the PCT

106. Discussions were based on document PCT/A/36/5.

107. The Delegation of France expressed its concern regarding paragraph 14 of document PCT/A/36/5, relating to the allocation of posts under the flexibility formula to PCT administration and to supporting WIPO activities. It requested information from the Secretariat about the type of "support activities" that were referred to in the document in order to be assured that those activities actually concerned the administration of the PCT. With reference to the ongoing discussions on a proposed revision of the Financial Regulations of the Organization, which also contained a provision concerning flexibility mechanisms, and

noting that those discussions had not reached any conclusion on this point, the Delegation requested that any decision taken on the flexibility formula for PCT administration should not in any way jeopardize the final form of the mechanism to be set out in the Financial Regulations. Furthermore, the Delegation requested that the decision paragraph set out in document PCT/A/36/5 be modified to clarify that the Assembly approved the revision of the flexibility formula only for the 2008-2009 biennium.

108. The Secretariat explained that the reference in document PCT/A/36/5 to “supporting activities” referred to the common services of the Organization, as used by the PCT, such as the legal services, IT systems, and the building and conference services. With regard to the relationship between the flexibility formula for the PCT administration and the flexibility mechanism under consideration in the context of the proposed revision of the Financial Regulations of the Organization, the Secretariat observed that the intention was to further work on that flexibility mechanism, with the aim of making a recommendation to the Assemblies in 2008. Consequently, the discussions were in a transitional period. The idea behind the Financial Regulations proposed by the Secretariat was that there would be a mathematical formula for each biennium that would be approved by the Member States for the Program and Budget. For the next year, it would be necessary to find a solution while awaiting the finalization of the Financial Regulations including the provision on the flexibility mechanism. Consequently, the Secretariat saw no problem should the Assembly now adopt the revision of the flexibility formula for the PCT administration. It noted that there were similar proposals concerning both the Madrid and the Hague systems, and confirmed that any decision at this time would not prejudice what would be decided in the context of revising the Financial Regulations. Consequently, the Secretariat considered that it would be prudent to adopt the proposal enabling the PCT to use the new flexibility formula for the next biennium and to continue working in the Program and Budget Committee to try to find a principle which satisfied all Member States.

109. The Delegation of Japan sought clarification regarding staff costs as described in paragraph 7 of document PCT/A/36/5. It appeared that marginal staff costs had been calculated by multiplying the salary of a G6 staff by the ratio of the current staff numbers and numbers of international applications, but the Delegation wondered whether streamlining effects where cost savings could be made by outsourcing could be reflected in such a categorization. The Delegation believed that these staff costs could be reduced by outsourcing compared to the current cost for the same additional application growth.

110. The Secretariat responded that the increasing use of outsourcing was one reason that it was proposed to move to a new flexibility formula. However, there was also a staff component involved, noting that not all the work was outsourced, and thus a need to calculate that portion of the staff component. This was done at the G6 level as a result of considering what additional posts were required in the International Bureau as a result of growth. Generally, these fell into a number of categories. First, in some cases additional posts were required because of the change in the composition of demand under the PCT. While, for example, there was a growth rate last year of about 8%, that growth was distributed very differently across the world. In the case of China, it was around 60%, so that additional posts were required to acquire skills, in particular language skills, that were necessary to be able to deal with the change in composition of demand. There was also an additional call for some services, for example, legal services, noting the growing number of legal questions from applicants directed at the International Bureau. Increased use of the system also attracted calls to the PCT Infoline, which dealt with thousands of calls from applicants or potential applicants. There were a variety of different functionalities within the PCT that were affected

by growth, and the best way to approach it, in the view of the Secretariat, was to take the level of G6 as an average, which was not considered to be an exaggerated level. This was the level of a Senior Examiner but was far below the level of a Legal Adviser.

111. The Delegation of Brazil queried what policies and procedures applied to the outsourcing of translation services in PCT. In terms of the geographical extension of the service provider, it questioned whether it was possible to outsource not only locally but internationally. If the trend was to increase outsourcing, and the new proposal for the flexibility formula seemed to point in that direction, then the Delegation was particularly interested to know whether all Contracting States could eventually be considered as possible sources of the services required.

112. The Secretariat assured the Delegation of Brazil that outsourcing was undertaken using a rigorous, open, international competition. Requests for tender were always published on the WIPO website and, as a matter of practice, the result was that the International Bureau outsourced widely internationally. This applied not only to PCT translations but also to other areas in the PCT. For example, some proofreading and information technology services had been outsourced and they often ended up with contracts at the other end of the world.

113. The Assembly approved the revision of the flexibility formula for the 2008-2009 biennium so that it is applied on the basis of 341,870 Swiss francs for every variation of 1,000 international applications from the budgeted number of international applications, noting that this decision would not prejudice the envisaged revision of the Financial Regulations of the Organization.

Extension of the Appointments of the International Authorities

114. Discussions were based on document PCT/A/36/4 relating to the proposed extension, under Articles 16 and 32, of the appointments as International Searching Authorities and International Preliminary Examining Authorities (“International Authorities”) of all 13 existing International Authorities, namely: the Austrian Patent Office; the Australian Patent Office; the Canadian Commissioner of Patents; the State Intellectual Property Office of the People’s Republic of China; the European Patent Office; the Spanish Patent and Trademark Office; the National Board of Patents and Registration of Finland; the Japan Patent Office; the Korean Intellectual Property Office; the Russian Federal Service for Intellectual Property, Patents and Trademarks; the Swedish Patent and Registration Office; the United States Patent and Trademark Office; and the Nordic Patent Institute. Draft agreements between the International Bureau and each of those Authorities were set out in the Appendix to document PCT/A/36/4.

115. The Secretariat informed the Assembly that the PCT Committee for Technical Cooperation, at its 23rd session, which was being held concurrently with the Assembly’s session, had recommended to the Assembly that the appointment of all of the International Authorities be extended by a period of 10 years, until December 31, 2017 (see the Committee’s report in document PCT/CTC/23/5, paragraph 7). The Secretariat had informed the Committee of a number of changes to the text of those draft agreements, as set out in document PCT/CTC/23/5, paragraph 5.

116. The Assembly:

(i) approved the texts of the agreements appearing in Annex I to this report relating to the functioning of the International Authorities mentioned in paragraph 114, above;

(ii) extended the appointments of those Authorities until December 31, 2017.

Appointment of the Brazilian National Institute of Industrial Property as an International Authority

117. Discussions were based on document PCT/A/36/6, conveying the wish of the Government of Brazil that the Brazilian National Institute of Industrial Property (INPI) be appointed as an International Searching Authority and International Preliminary Examining Authority under the PCT.

118. The Secretariat informed the Assembly that the PCT Committee for Technical Cooperation, at its 23rd session, which was being held concurrently with the Assembly's session, had recommended to the Assembly that INPI be appointed as an International Authority (see the Committee's report in document PCT/CTC/23/5, paragraphs 8 to 11).

119. The Delegation of Brazil emphasized the importance which it attached to INPI's application to become an International Authority. It was important to the Brazilian Government to have a strong intellectual property Office and it had invested heavily in order to assure that Brazilian citizens could rely on a good environment for the protection of their intellectual property. The Government had made major efforts to enhance the technical capabilities of INPI. A large number of examiners had been hired, with almost 300 already in place, well trained and fully capable of doing a good job, not only for Brazilian citizens but for whoever might need PCT services in Portuguese and also in Spanish and in English. Much work had been done to ensure that INPI would be able to deliver high quality services. In particular, a quality management system was now in place and would be fully operational by the end of 2007. Consequently, INPI expected to be able to operate as an International Authority by early 2008. INPI had expressed its sincere intention to provide a good service to everybody using them. Consequently, the Delegation asked the Assembly to support its application.

120. The Delegations of Algeria (on behalf of the African Group), Canada, El Salvador, Cuba, Kenya, Portugal, Ecuador, China, India, South Africa, Mexico, the Russian Federation, the United States of America, the Dominican Republic, Spain, Finland, Denmark (on behalf of the Nordic Patent Institute), Indonesia, Germany, the Republic of Korea, Austria, Oman, France, Honduras, Japan, Italy, Sudan, Namibia, Egypt and Benin (on behalf of the least-developed countries) expressed their support for the proposal to appoint INPI as an International Authority. (Certain other delegations had expressed support for the proposal earlier, during the session of the PCT Committee for Technical Cooperation; see document PCT/CTC/23/5.)

121. In expressing support for the proposal, the Delegation of Canada recognized the value of the creation of an International Authority in the region, given the service available for users and potential users of the system from International Authorities, and noted the steps which the Brazilian Office had taken to improve quality. The Delegation of El Salvador recognized the great work which had been undertaken by Brazil, and welcomed the application for

appointment of a further Authority able to operate in Spanish and therefore supported the proposal for both technical and linguistic reasons. The Delegation of Cuba noted the importance of having an International Authority operating in the region. The Delegation of Kenya observed that the proposal would allow Portuguese-speaking African countries to make use of the expertise of the Brazilian Office. The Delegations of China and the Dominican Republic noted that such an appointment would promote use of the PCT system in the Latin American region. The Delegation of India expressed its conviction that the Brazilian National Institute of Industrial Property fulfilled all the basic requirements for appointment. The Delegation of Mexico noted that the Mexican Institute of Industrial Property had enjoyed close cooperation with the Brazilian National Institute of Industrial Property for many years, and was sure that INPI would be successful. The Delegation of the United States of America welcomed further involvement in the PCT by the Latin American region and developing countries. The Delegation of Spain welcomed the fact that INPI would accept international applications in Spanish, promoting the use of that language in the region. The Delegation of Finland noted the value of having an International Authority able to work in the Portuguese language. The Delegations of Denmark, speaking on behalf of the Nordic Patent Institute, and Austria looked forward to welcoming INPI to the family of International Authorities. The Delegation of Germany expressed its confidence, noting the long-standing cooperation which existed between the German Patent and Trade Mark Office and INPI, that INPI would meet the high and demanding standards which were required of an International Authority. The Delegation of Benin, speaking on behalf of the least-developed countries, considered that the appointment of INPI as an International Authority would address an important problem and was sure that the Office's activities would be highly successful.

122. The Assembly, having heard the representative of the Brazilian National Institute of Industrial Property and taking into account the advice of the PCT Committee for Technical Cooperation:

(i) approved the text of the draft Agreement between the Brazilian National Institute of Industrial Property and the International Bureau set out in Annex II to this report; and

(ii) appointed the Brazilian National Institute of Industrial Property as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of that Agreement until December 31, 2017.

123. The Delegation of Brazil thanked the Assembly for the support which had been expressed and expressed the conviction that INPI would justify the confidence which had been placed in it.

Appointment of the Indian Patent Office as an International Authority

124. Discussions were based on document PCT/A/36/10, conveying the wish of the Government of India that the Indian Patent Office be appointed as an International Searching Authority and International Preliminary Examining Authority under the PCT.

125. The Secretariat informed the Assembly that the PCT Committee for Technical Cooperation, at its 23rd session, which was being held concurrently with the Assembly's session, had recommended to the Assembly that the Indian Patent Office be appointed as an International Authority (see the Committee's report in document PCT/CTC/23/5, paragraphs 12 to 15).

126. The Delegation of India explained the salient features of India's endeavors to modernize its intellectual property regime. The Indian Government had followed a four-pronged strategy. The first and foremost matter had been to meet India's international obligations with respect to intellectual property. While doing so, India had taken due care to ensure that the creation of a vibrant and strong intellectual property regime was complementary to public interest concerns. India had also undertaken a major effort to modernize its intellectual property administration. Alongside that, it had launched a massive awareness and sensitization program on intellectual property issues. Its objective was to create an intellectual property regime which was efficient, transparent and user friendly. As a first step, India had embarked on a process of rationalization of its IP legislative framework in order to meet both its international and domestic obligations. Thereafter, it launched a well-thought-out modernization program which emphasized the creation of world class infrastructure and extensive use of IT in its activities. This first phase, implemented at a cost of 30 million United States dollars, was now complete, and India was on the verge of launching the second phase of the modernization process. The second phase was far more ambitious, both in financial terms, as well as in the context of capacity building and human resource development. It was intended to increase the strength of the Indian Patent Office's personnel, particularly patent examiners, four-fold. It was hoped to attract highly qualified personnel. A detailed road map had been worked out for training, sensitization and exposure to some of the best practices and systems in the world. The focus would also include the digitization of records, enhancement and strengthening of databases, and the introduction of the most modern search engines. In addition, India had initiated the establishment of a National Institute of Intellectual Property Management, with standards comparable with the best in the world. This Institute would become functional in the near future. It would address, in a holistic manner, major issues relating to training, education and research, and would, above all, function as an IP think-tank. In close collaboration with its private sector, including top-level industry associations, India had launched a nationwide awareness and sensitization program. All these activities would cater to the emerging needs and requirement of IP personnel and other stakeholders, such as policy-makers, industry, the judiciary and patent attorneys, as well as establishing effective linkages with other centers of excellence in the field of education and learning. The Delegation stated that India, which had witnessed an IT revolution in the past few decades, was now on the threshold of an IP revolution. The gains from the first wave of modernization of India's IP regime were self-evident. The number of patent applications had gone up seven-fold in the last six years. More importantly, patent grants had kept pace and had gone up significantly. Moreover, the Indian Patent Office had recently launched a facility for electronic filing of patent applications. The revenues generated by the Indian Patent Office had gone up 16-fold in the same period, touching a record high of 42 million United States dollars last year. Against this backdrop, there was a great expectation of success with the second phase of modernization. A WIPO delegation comprising a number of experts had visited the Indian Patent Office earlier in the year and observed, "The Indian Patent Office has been dramatically transformed in recent years. New buildings, an effective and well-supported new IT system and an enthusiastic and well-qualified staff provide the essential base for a high quality examining Office." The Delegation requested the Assembly to give favorable consideration to the proposal for the appointment of the Indian Patent Office as an International Authority.

127. The Delegations of Algeria (on behalf of the African Group), Canada, Indonesia, Brazil, Sri Lanka, China, Malaysia, the Russian Federation, Austria, Italy, Oman, South Africa, the United States of America, the Republic of Korea (on behalf of the Asian Group), Mexico, Papua New Guinea, Sudan, Egypt, Nepal, Cuba, France, Spain, Namibia, Finland, Denmark (on behalf of the Nordic Patent Institute), Kenya, Germany, Japan, Portugal and Benin (on

behalf of the least-developed countries) expressed their support for the proposal to appoint the Indian Patent Office as an International Authority. (Certain other delegations had expressed support for the proposal earlier, during the session of the PCT Committee for Technical Cooperation; see document PCT/CTC/23/5.)

128. In expressing support for the proposal, the Delegation of Canada recognized the importance that it would have for the region. The Delegation of Brazil restated its intention, which had earlier been expressed in the Committee for Technical Cooperation, that INPI cooperate with the Indian Patent Office as the Offices of two developing countries beginning to act as International Authorities. The Delegation of Sri Lanka observed that the appointment of the Indian Patent Office as an International Authority would be useful to the South Asian region and would support the use of the PCT by nationals from that region. The Delegation of China noted that international applications from the Asian region had increased significantly in number in recent years and considered that the appointment of the Indian Patent Office as an International Authority would be of benefit to developing countries in the region. The Delegations of Austria and Finland, and of Denmark, speaking on behalf of the Nordic Patent Institute, looked forward to welcoming the Indian Patent Office to the family of International Authorities. The Delegation of the United States of America particularly welcomed further involvement in the PCT by the South Asian region and developing countries. The Delegation of Germany welcomed the extension of the geographical involvement in the international patent system and the Indian Patent Office's commitment to meeting the high quality standards required for an International Authority. The Delegation of Benin, speaking on behalf of the least-developed countries, considered that the appointment of the Indian Patent Office as an International Authority would address an important problem and was sure that the Office's activities would be highly successful.

129. The Assembly, having heard the representative of the Indian Patent Office and taking into account the advice of the PCT Committee for Technical Cooperation:

(i) approved the text of the draft Agreement between the Indian Patent Office and the International Bureau set out in Annex III to this report; and

(ii) appointed the Indian Patent Office as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of that Agreement until December 31, 2017.

130. The Delegation of India thanked the Assembly for the breadth of support which had been given to the appointment of the Indian Patent Office as an International Authority.

131. Referring to all of the three, related, previous items on the Assembly's agenda, the Secretariat expressed its gratitude to the 13 existing International Authorities for their support for the PCT system. The Secretariat was delighted by the extension of their appointments and was privileged to have the close cooperation which it enjoyed with the Authorities, which together formed the lynchpin of the system. Equally, the Secretariat wished to express congratulations to Brazil and India on their appointment as International Authorities and looked forward to working with them.

Reform of the PCT

132. Discussions were based on document PCT/A/36/1.

133. The Secretariat proposed that, now that the work of both the Committee on Reform of the PCT and the Working Group on Reform of the PCT had been completed and the mandate of both bodies had come to an end, should the need arise to consider a matter which required submission to the Assembly, a Working Group of the PCT Assembly should be convened to do preparatory work rather than submitting the matter straight to the Assembly. The Secretariat further proposed that, subject to the availability of sufficient funds, the same financial assistance that had been made available to enable attendance of certain delegations at the sessions of the Committee and the Working Group on Reform of the PCT should also be made available to enable attendance of certain delegations at the sessions of the new Working Group. Those financial arrangements were that the Organization had offered financial assistance to two countries per region so as to enable one delegate from each country to attend sessions; in addition, the same financial assistance was offered to China and to three regional Offices, namely, ARIPO, OAPI and the Eurasian Patent Office.

134. The Assembly:

(i) noted the report of the ninth session of the Working Group on Reform of the PCT contained in document PCT/R/WG/9/8 and reproduced in Annex I of document PCT/A/36/1;

(ii) decided that the work of both the Committee on Reform of the PCT and the Working Group had been completed and that the mandate of both bodies, which were established by the Assembly at its 29th session in 2000 and at its 30th session in 2001, respectively, had come to an end; and

(iii) approved the proposal concerning the convening of a new Working Group, and the proposal to offer financial assistance to enable attendance of certain delegations at the sessions of that Working Group, as set out in paragraph 133, above.

Proposed Amendments of the PCT Regulations: Use of Results of Earlier Searches; Restoration of Right of Priority by the Receiving Office; International Applications Considered Withdrawn

135. Discussions were based on document PCT/A/36/2. The Secretariat informed the Assembly that a number of corrections to the French text only of the proposed amendments had been agreed with the Delegation of France and would be included in the text of the amendments as adopted.

136. The Delegation of the Syrian Arab Republic expressed its support especially for the amendments relating to the use of earlier searches, which should encourage use of earlier searches and reduce the amount of search fees.

137. The Assembly:

(i) adopted the amendments of the Regulations under the PCT set out in Annex IV to this report;

(ii) decided that those amendments shall enter into force on July 1, 2008, and shall apply to international applications whose international filing date is on or after July 1, 2008;

(iii) noted, in connection with the addition of new Rule 4.12, that an “earlier search” under that Rule includes an earlier search carried out under the responsibility of an Authority or Office which contracts out searches as well as a search carried out by an Authority or Office itself; and

(iv) noted, in connection with the addition of new Rules 4.12(ii) and 12bis.1(e), that an international application is only considered to be “substantially the same” as the application in respect of which the earlier search was carried out (where applicable, except that the international application is filed in a different language) if both applications are the same in substance, including the inventions described and claimed; any changes may relate only to minor clerical or administrative matters, such as formatting, correction of minor errors, or inclusion or omission of matter not specific to the invention but which is required for applications in some States but not others (for example, details of public funding used in the development of the invention); any International Searching Authority would be free to require the applicant to clarify what the differences were between the international application and the earlier application concerned.

Proposed Amendments of the PCT Regulations: Supplementary International Search

138. Discussions were based on document PCT/A/36/7, containing a proposal by France, and document PCT/A/36/7 Add., containing a proposal by Japan and Spain.

139. The Secretariat, in introducing document PCT/A/36/7, noted that the reference in paragraph 11(i) to “Article 11 of the applicable agreement” should be corrected to read “Article 3 of the applicable agreement”.

140. The Delegation of France commended the International Bureau and Delegations which had taken part in the work on the Reform of the PCT for the excellent results and the benefits which would be enjoyed by users. The proposal under consideration related to the introduction of a supplementary international search system as part of the PCT system. This subject had been debated and reviewed in detail within the Working Group on Reform of the PCT since 2004. At its last session, the Chairman of the Working Group concluded that agreement had been reached on the text of amendments which would need to be made in the PCT Regulations, subject to any reservations and possible drafting changes to be made by the Secretariat. However, because of a lack consensus on the desirability of such a system, the Working Group was only able to present a report with details of this possible set of Rules annexed. However, the Delegation of France believed that the proposal needed to be submitted to the PCT Assembly because it would enhance the PCT procedure and offer flexibility in its use.

141. The Delegation of France emphasized the importance of reaffirming the principle that the international search should permit as much prior art as possible to be discovered. According to Article 15 of the PCT, the international search should allow a clear knowledge of the prior art to be gained during the international phase. It was essential that the applicant and designated Offices should be able to fully use the international search report to determine whether an international application met the criteria of novelty and inventive step. However,

based on the observation that no Office in the world was in a position to carry out in-depth searches in all languages, and in spite of developments in databases, it appeared useful to consider a supplementary search, mainly with the aim of discovering earlier documents in languages in which the Office conducting the supplementary search was competent and which were not official languages of the Authority carrying out the main international search. Furthermore, some Authorities may have particular specializations which would allow them to discover documents in areas not covered by the Authority carrying out the main international search, in order to bridge any gaps in the main search. The proposal for supplementary international search would therefore enhance the PCT system as well the quality of patent applications by allowing applicants to discover the relevant prior art at as early as possible a stage during the international phase and in as exhaustive a fashion as possible. The Delegation therefore considered the proposal to be in the interests of the users, since it would allow them to gain a clearer vision of the prior art during the international phase. It was observed that the proposal was supported in the Working Group by the great majority of user representatives.

142. The Delegation of France noted that the proposed new system would be optional both for applicants and for the International Authorities. It would be up to the PCT users, according to their needs, to have recourse to the supplementary international search system. Each International Authority would also be free to participate or not in the supplementary international search system. The system provided for a certain amount of flexibility in the implementation of supplementary international searches, to avoid problems in internal procedures. In conclusion, the Delegation considered that the proposal offered a practical way of meeting the expectations of users, while ensuring appropriate flexibility for International Authorities. The Delegation had been discussing the proposal with other delegations and hoped that it would achieve a consensus. Noting that this was an innovative procedure, the Delegation agreed that it would be appropriate for the International Bureau to give reports on implementation of the new system to the PCT Assembly, and noted that the Delegations of Japan and Spain had made proposals on that point. Finally, the Delegation of France emphasized that it was essential to maintain all ongoing efforts to enhance the quality of the main international search.

143. The Delegation of Japan stated that it was still opposed to the introduction of a supplementary international search in the PCT system. The Delegation had expressed a variety of reasons for its opposition at the 9th session of the Working Group on Reform of the PCT in April 2007. Details of those arguments were set out in document PCT/A/36/1, Annex I, pages 36 to 44. Some of the main points of opposition were as follows. First, the International Searching Authority was the primary authority with full responsibility to establish the international search report and manage its quality as required by the PCT. Therefore, the Delegation believed that supplementary international search was not an appropriate change having regard to that philosophy of the Treaty. The Delegation particularly doubted the effectiveness of supplementary international search since the Authority conducting it would lack the obligation and motivation to conduct a search of a quality similar to the national search. Second, the Delegation was concerned that introduction of supplementary international search into the PCT system would give rise to further expense and make the PCT system more complicated, putting a burden on the PCT Union. Rather, the opposite goal should be sought, namely, greater cost-effectiveness and streamlining of the PCT system. Third, though the proponents of the proposal had argued that there was a user need for supplementary international searches, the Delegation was not convinced that the user need was sufficiently well identified beyond the mere desire to create another option. On the contrary, the Delegation was concerned that supplementary international search would make

the PCT system unequal in its delivery of service to different applicants, depending on their financial situation. Following the strong expression of opposition by Japan, and while making an alternative proposal, the Delegations of Japan and Spain had opposed the transmission of the proposal to the Assembly and had not joined a consensus in the Working Group.

144. However, the Delegation of Japan had noted the proposal for introduction of supplementary international searches submitted to the Assembly by the Delegation of France. After careful and intensive consideration and in a constructive spirit, Japan had therefore decided to make a compromise proposal, submitted jointly with Spain, whereby if supplementary international search was adopted by the Assembly, the understanding elaborated in document PCT/A/36/7 Add. should also be adopted. The proposed understanding consisted of three elements:

(a) all International Searching Authorities shall continue making efforts to improve the quality of the main international search and that the quality of the international search should be reviewed by the PCT Meeting of International Authorities; and

(b) the International Bureau shall report on the financial and operational situation of the supplementary international search system to the Meeting of International Authorities and to the PCT Assembly for their assessment; and

(c) the Assembly shall review the supplementary international search system three years after the date of entry into force of the system.

145. By this understanding, the Delegation of Japan considered that it would be possible to maintain the motivation to secure and improve use of International Searching Authorities' resources and to assess the complete picture of supplementary international search, including its financial implications, its operation, and practical needs. Finally, it would be possible to review the system after three years, possibly including the issue of whether the system operated well enough to continue with it or not. Consequently, while the Delegation still opposed the introduction of supplementary international search in principle, it would not block a consensus to adopt the proposal made by France, if the understanding proposed by Japan and Spain were also to be adopted by the Assembly.

146. The Delegation of Spain observed that it had always supported the changes that had been made to the PCT system in recent years to the extent that they would enhance the patent system and be a benefit to the users. However, with regard to the proposal to introduce supplementary international searches, the Delegation had already raised concerns. The Delegation had considered that such a system might be contrary to the philosophy of the PCT, which provided for a single high quality international search. In the opinion of the Delegation, introducing this system should require that there be benefit for the overall PCT system. However, the supplementary international search proposal gave an erroneous image of the system, which was in contrast to the increase in applications of the PCT. Moreover, it would derail the PCT system itself because the national phase was the stage intended to add information to the international search with national documents that were not part of the PCT minimum documentation. The Delegation considered that the proposal might be anticipating the national phase and that this would lead to the PCT system becoming much more complicated. The new system might also have adverse effects on the workload for International Authorities as well as introduce a risk of contradictory search results. However, in light of the great support for the proposal shown by various other delegations, the

Delegations of Japan and Spain had cooperated to prepare a consensus approach which had been outlined by the Delegation of Japan and was submitted to the Assembly for its approval so that the amendments to the PCT regulations could also be approved by the Assembly.

147. The Delegation of Germany stated that it shared some of the concerns that had been expressed by the Delegations of Japan and Spain. However, the Delegation could go along with the compromise put forward by those Delegations and would not oppose the proposal of France on that basis.

148. The Delegation of the United States of America stated its support for the proposal of the Delegation of France and also that of the Delegations of Japan and Spain.

149. The Delegation of the Republic of Korea expressed support for the introduction of the supplementary international search system, which would give more options, both to International Searching Authorities and applicants. The Delegation emphasized the importance of quality management for International Searching Authorities and supported the proposal by Japan and Spain.

150. The Delegation of Norway associated itself with the statement by the Delegation of the United States of America.

151. The Delegation of the Syrian Arab Republic expressed its concern about the proposal for supplementary international searches, since it considered that the proposal went against the general principle in the Treaty of there being a single search during the international phase.

152. The Representative of the European Patent Office thanked the Delegations of France, Japan and Spain and expressed support for their proposals.

153. The Assembly:

(i) adopted the amendments of the Regulations under the PCT set out in Annex V to this report;

(ii) decided that those amendments shall enter into force on January 1, 2009, and shall apply to international applications whose international filing date is on or after January 1, 2009, and shall further apply to any international application whose international filing date is before January 1, 2009, and in respect of which the time limit for making a supplementary search request under new Rule 45*bis*.1(a) expires on or after January 1, 2009;

(iii) approved the inclusion in the applicable agreement under PCT Article 16(3), where an International Searching Authority notifies the Director General that it is prepared to carry out supplementary international searches, of the provisions set out in paragraph 11 of document PCT/A/36/7, as modified according to paragraph 139, above, with effect from a date to be agreed upon by the Authority and the Director General;

(iv) noted that supplementary international searches will not be available in practice until such time as at least one International Searching Authority is prepared to offer that service;

(v) urged all International Searching Authorities to continue to make efforts to improve the quality of the main international search, and decided that the quality of the international search shall be reviewed by the Meeting of International Authorities under the PCT;

(vi) decided that the International Bureau shall report to the Meeting of International Authorities under the PCT and to the Assembly on the financial and operational situation of the supplementary international search system; and

(vii) decided that the Assembly shall review the supplementary international search system three years after the date of entry into force of the system.

Proposed Amendments of the PCT Regulations: Addition of Korean and Portuguese as Languages of Publication

154. Discussions were based on documents PCT/A/36/8 and 9.

155. The Delegation of Brazil, in introducing its proposal to include Portuguese in the list of languages referred to in Rule 48.3 in which international applications may be published, stated its expectation that the inclusion of Portuguese, together with the appointment of the Brazilian National Institute of Industrial Property as an International Authority, would result in an increased use of the PCT system by applicants from Brazil and other lusophone countries, and especially by small and medium enterprises, noting that it would become possible for international applications to be filed, searched and published in Portuguese. This would remove the need for the applicant to provide a translation during the international phase. The Delegation therefore considered that this proposal was synergistic with the proposal to appoint the Brazilian National Institute of Industrial Property as an International Authority, which proposal had been approved by the Assembly during the present session. The Delegation believed that it was appropriate to approve Portuguese as a language of publication since there were a huge number of Portuguese speakers in the world, for many of whom this change would facilitate access to the PCT. Portuguese was the official language, or one of the official languages, in nine countries, of which four were already members of the PCT. Those nine countries had a total population of more than 240 million people. The Delegation noted that the cost of adding Portuguese as a language of publication would be very low and requested the Assembly to approve the proposal.

156. The Delegation of the Republic of Korea, in introducing its proposal that Korean be added to the list of publication languages under the PCT system, stated that the Republic of Korea was already fifth in the world in terms of numbers of PCT applications filed and, according to the International Bureau's figures on trends, may rank fourth by the end of 2007. It was therefore time for Korean to become a PCT publication language. There were four reasons in support of the proposal. Firstly, if Korean were to become a language of publication, there would be a substantial increase in PCT applications from the Republic of Korea. Up until now, only 13% of international applications originating from the Republic of Korea were filed through the PCT system. By adding Korean to the list of publication languages, however, the PCT would be made more attractive to Korean users and there would thus be a substantial increase in PCT revenue, which could mean more support for developing countries and least developed countries. Secondly, if there were any concern about increased costs to the system, the Delegation was confident that any cost incurred by publication in the Korean language would be compensated by the increase in PCT applications originating from the Republic of Korea. In fact, PCT applications from the Republic of Korea had increased

by more than 20% over the last three years and would increase further after the addition of Korean as a language of publication, as shown in the analysis submitted by the Delegation. The Delegation stated further that, in the event that the cost would exceed the increase in fee revenues, the Republic of Korea was willing to compensate for the deficit. Finally, the Delegation stated that the Republic of Korea was willing to provide any IP Office with an automatic Korean-to-English machine translation service free of charge, so that there should be no problem with access to Korean patent documents. There also would be an Internet site, providing a search service to the public with high quality translation, with accuracy exceeding 80%. This system had been tested by examiners of the European Patent Office, the United States Patent and Trademark Office and the Japan Patent Office, and all had been satisfied by its quality. Consequently, the Republic of Korea sought the support of the Contracting States for its proposal.

157. The Delegation of Algeria, speaking on behalf of the African Group, stated that, after having studied the relevant documents concerning the proposals to include Portuguese and Korean as languages of publication under the PCT, the reasons presented by the Delegations of Brazil and the Republic of Korea fully justified the addition of the two languages and, thus, it fully supported the proposals.

158. The Delegation of Benin, speaking on behalf of the least developed countries, stated its support for the proposal to add Portuguese and Korean as official languages of publication under in the PCT, and associated itself with the statement by the Delegation of Algeria.

159. The Delegation of Poland, speaking on behalf of the Group of Central European and Baltic States, stated that, in its view, it was justified that the languages most widely understood and used in the world, as well as those languages spoken in the countries that are the biggest users of the PCT system, should be PCT publication languages. Therefore, the Delegation supported the inclusion of Korean and Portuguese as languages of publication under the PCT. However, it would be important that such an inclusion did not hinder the financing of other related PCT services for the benefit of Member States. While it was of the opinion that both proposals were well substantiated, including from a financial point of view, it nevertheless requested the Secretariat's financial assessment of the costs incurred by such addition.

160. The Delegation of Mozambique supported the statements made by the Delegations of Algeria and Benin with regard to the inclusion of Portuguese as a language of publication under the PCT. Noting that Mozambique was a PCT Contracting State, the Delegation expressed the view that the inclusion of Portuguese would be most helpful for the users of the system in general and, in particular, users in Mozambique. The Delegation also supported the proposal for the inclusion of Korean as a language of publication, for the same reasons as those presented by the Delegation of Benin.

161. The Delegation of Singapore, speaking on behalf of the ASEAN countries, expressed its support for the proposal that Korean be included as one of the languages of publication under the PCT. It felt that acceptance of the proposal would encourage even greater use of the PCT system by applicants from the Republic of Korea. Similarly, it supported the proposal that Portuguese be included as one of the languages of publication under the PCT.

162. The Delegation of Portugal, speaking on behalf of the European Community and its 27 Member States, stated that it supported the addition of Portuguese and Korean as languages of publication under the PCT. Speaking on its own behalf, it supported in

particular the addition of Portuguese as a language of publication. The Delegation nevertheless suggested that the PCT Assembly should discuss which criteria and procedures should be applied when deciding to add new PCT publication languages in the future.

163. The Delegation of Australia supported the addition of Korean and Portuguese to the list of languages of publication under the PCT. However, it noted that the PCT system was set up to simplify the filing of international applications and assist industries to navigate the system in an easy way, and that the system as such did not foresee that every language of the world could become a language of publication under the PCT. It thus supported the suggestion made by the Delegation of Portugal to define criteria for the future addition of other publication languages and requested the International Bureau to prepare, for the next meeting of the PCT Assembly in 2008, a proposal as to the criteria to be used to assess any future request for the addition of a language of publication under the PCT.

164. The Delegation of the United States of America supported the statement made by the Delegation of Australia, both in supporting the addition of Korean and Portuguese as languages of publication under the PCT and with regard to criteria for adding new languages of publication under the PCT. It therefore wished to support the request made to the International Bureau to develop such criteria for discussion at the next PCT Assembly.

165. The Delegation of Canada supported the addition of Korean and Portuguese as languages of publication under the PCT and associated itself with the comments made by the Delegation of Portugal, as well as statements made by the Delegations of Australia and the United States of America with respect to establishment of criteria for the addition of new languages of publication.

166. The Delegation of Japan expressed its thanks to the Delegations of Brazil and the Republic of Korea for their explanations of the proposals and stated that it supported the inclusion of Korean and Portuguese as languages of publication. The Delegation highlighted two features that previous speakers had referred to. Firstly, noting that the addition of new languages would require additional financial and human resources of the Organization, it was important to note that these implications should be assessed to ensure that they would not affect the operation of PCT system. Secondly, while it was important that PCT services be used by many countries in all geographical regions, it had to be kept in mind that the addition of languages of publication under the PCT would have not only financial and human resource implications for the Organization but also implications as to the accessibility and readability of published international applications. Therefore, the Delegation of Japan expressed its hope that each Office or Authority would take positive measures to deliver easy accessible and readable English translations of international applications by using machine translation. In this context, the Delegation wished to thank the Republic of Korea for the explanation of its Korean-English machine translation project in document PCT/A/36/8.

167. The Delegation of the Russian Federation supported the addition of Portuguese and Korean as languages of publication under the PCT.

168. The Delegation of Tanzania stated that it fully supported the addition of Portuguese and Korean as languages of publication under the PCT, for the reasons advanced by the Delegations of Algeria and Benin.

169. The Delegation of Indonesia stated that it fully supported the addition of Korean and Portuguese as languages of publication under the PCT.

170. The Delegation of Barbados stated that it, too, supported the addition of Portuguese and Korean as languages of publication under the PCT for the reasons advanced by other delegations.

171. The Delegation of China stated that it, too, supported the addition of Portuguese and Korean as languages of publication under the PCT.

172. The Secretariat, in responding to the question raised by the Delegation of Poland on the financial implications of the addition of Portuguese and Korean as languages of publication under the PCT, noted that it had informally worked with the Delegations of the Republic of Korea and Brazil to assess the financial implications for PCT operations. The Secretariat confirmed that the figures provided by the Delegation of the Republic of Korea in document PCT/A/36/8 were accurate, while noting that the projected growth of international applications from the Republic of Korea was a projection made by the Delegation based on the national evaluation of filing trends. Regarding the addition of Portuguese as a language of publication, the Secretariat affirmed that the financial implications in this respect were modest and less than 100,000 Swiss francs per year on the basis of the existing volume of work, which the International Bureau could easily accommodate.

173. In response to the suggestion made by several delegations to develop criteria for assessing future requests for the addition of languages of publication under the PCT, the Secretariat stated that it was happy to do so and that it would make proposals for possible criteria available for consideration at the next session of the PCT Assembly in 2008.

174. The Assembly:

(i) adopted the amendments of the Regulations under the PCT set out in Annex VI to this report;

(ii) decided that those amendments shall enter into force on January 1, 2009, and shall apply to international applications whose international filing date is on or after January 1, 2009; and

(iii) decided that the Secretariat would develop criteria for assessing future requests for the addition of languages of publication under the PCT, for consideration at the next session of the Assembly in 2008.

175. The Delegation of Brazil thanked the Assembly, on behalf of the Government of Brazil, for having approved the proposal to add Portuguese as a language of publication under the PCT.

176. The Delegation of Portugal, speaking on behalf of the Government of Portugal, expressed its thanks to the Assembly and also to the Delegation of Brazil for having put forward its proposal.

177. The Delegation of the Republic of Korea expressed its thanks for the support for its proposal and stated that it believed that this decision by the Assembly would be of great benefit for the users of the PCT system.

Quality Management Systems for PCT International Authorities

178. Discussions were based on document PCT/A/36/3.

179. The Delegation of Spain noted that quality management was important for both the private and public sectors, at the national and international level, and must be given priority in order to ensure that the needs of users were met. The PCT system required that minimum criteria be met by International Authorities in carrying out their functions and, in particular, Authorities must have in place quality management systems, including internal assessment mechanisms. Chapter 21 of the PCT International Search and Preliminary Guidelines set out substantive requirements in this regard. The Spanish Patent and Trademark Office had been following a strategy of developing a comprehensive quality policy along those lines, and in recent years had made significant improvements. One of the most important steps in this respect was the obtaining last September of ISO 9001 certification in relation to the Office's quality management systems for all aspects of its work under the PCT. That certification showed that the Office met the most advanced nationally and internationally recognized quality management standards. The obtaining of such a certification was one way in which the PCT system, particularly in relation to the carrying out of international searches, could be strengthened in the future.

180. The Assembly noted the contents of document PCT/A/36/3.

[Annexes follow]

ANNEX I

APPROVED DRAFT AGREEMENTS BETWEEN THE INTERNATIONAL BUREAU
AND THE INTERNATIONAL SEARCHING AND
PRELIMINARY EXAMINING AUTHORITIES UNDER THE PCT

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AT: Draft Agreement with the Federal Minister of Transport, Innovation and Technology of the Republic of Austria

Agreement

between the Federal Minister of Transport, Innovation and Technology
of the Republic of Austria
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Austrian Patent Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Federal Minister of Transport, Innovation and Technology of the Republic of Austria and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Austrian Patent Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1

Terms and Expressions

- (1) For the purposes of this Agreement:
- (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Austrian Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the Federal Minister of Transport, Innovation and Technology of the Republic of Austria gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

- (ii) if the Director General of the World Intellectual Property Organization gives the Federal Minister of Transport, Innovation and Technology of the Republic of Austria written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English and German languages, each text being equally authentic.

For the Federal Minister of Transport,
Innovation and Technology of the Republic
of Austria by:

For the International Bureau by:

[...]

[...]

Annex A States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:

the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations, provided that the Republic of Austria, in accordance with its obligations undertaken within the framework of the European Patent Organisation, has concluded with those States an agreement for that purpose;

- (ii) the following languages which it will accept:

English, French, German.

Annex B Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under the national patent grant procedure under the provisions of the Austrian Patent Law.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Euro)</u>
Search fee (Rule 16.1(a))	200
Additional fee (Rule 40.2(a))	200
Preliminary examination fee (Rule 58.1(b))	200
Additional fee (Rule 68.3(a))	200
Protest fee (Rules 40.2(e) and 68.3(e))	220
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	0.95

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search to the full extent or to a substantially prevailing portion, 75% of the search fee shall be refunded.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

English, French and German, noting that the language of correspondence shall be the language in which the international application is filed or translated, as the case may be.

AU: Draft Agreement extending the current agreement with the Government of Australia

Extension of the Agreement

between the Government of Australia
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Australian Patent Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Government of Australia and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of December 7, 1997, under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty in relation to the functioning of the Australian Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty was concluded for a period of 10 years from January 1, 1998 to December 31, 2007,

Considering that the said Agreement has been amended several times in 2001, 2002, 2003 and 2007, all these amendments having been published in PCT Gazette Nos. 04/2001, 33/2002, 49/2003 and 1 February 2007, respectively,

Considering that the Government of Australia and the International Bureau of WIPO have already started negotiations for the renewal of a new Agreement as provided under Article 10 therein,

Aware that the Government of Australia will not be able to complete the necessary domestic procedures to ratify a new Agreement in relation to the functioning of the Australian Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty, as from January 1, 2008,

Hereby agree as follows:

Article 1

Extension of the Agreement

(1) The Agreement between the Government of Australia and the International Bureau of the World Intellectual Property Organization signed on December 4, 1997, including its amendments and Annexes, in relation to the functioning of the Australian Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty, is hereby extended until December 31, 2008 or until the day before the entry into force of a new Agreement on the same subject matter in accordance with PCT Articles 16(3)(b) and 32(3) and with the domestic legal and constitutional procedures of Australia, whichever is sooner.

(2) Consequently, the reference made to “December 31, 2007” under Articles 10 and 12 of the Agreement referred to above is amended, accordingly.

Article 2
Approval and entry into force

(1) According to Article 11 of the Agreement referred to above, this amendment shall be subject to the approval of the Assembly of the International Patent Cooperation Union.

(2) Without prejudice to the above, this amendment shall take effect on December 31, 2007.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English language.

For the Government of Australia by:

For the International Bureau by:

[...]

[...]

AU: Draft Agreement with the Government of Australia

Agreement

between the Government of Australia
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Australian Patent Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Government of Australia and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Australian Patent Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Australian Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on *[date]*.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the Government of Australia gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement;
or

- (ii) if the Director General of the World Intellectual Property Organization gives the Government of Australia written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English language.

For the Government of Australia by:

[...]

For the International Bureau by:

[...]

Annex A States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:

Australia, New Zealand and

by arrangement, the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations;

- (ii) the following language which it will accept:

English.

Annex B Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined under Australian national grant procedure.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Australian dollars)</u>
Search fee (Rule 16.1(a))	1,600
Additional fee (Rule 40.2(a))	1,600
Preliminary examination fee (Rule 58.1(b)):	
– where the international search report was issued by the Authority	550
– in other cases	780
Additional fee (Rule 68.3(a))	550
Cost of copies (Rules 44.3(b) and 71.2(b)), per document	50
Cost of copies (Rule 94), per document	50

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search, 25% or 50% of the search fee shall be refunded, depending on the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following language:

English.

CA: Draft Agreement with the Canadian Commissioner of Patents

Agreement

between the Canadian Commissioner of Patents
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Canadian Commissioner of Patents
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Canadian Commissioner of Patents and the International Bureau of the World
Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for
Technical Cooperation, has appointed the Canadian Commissioner of Patents as an
International Searching and Preliminary Examining Authority under the Patent Cooperation
Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Canadian Commissioner of Patents;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the Canadian Commissioner of Patents gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

- (ii) if the Director General of the World Intellectual Property Organization gives the Canadian Commissioner of Patents written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [city], this [date], in two originals in the English and French languages, each text being equally authentic.

For the Canadian Commissioner of Patents
by:

[...]

For the International Bureau by:

[...]

Annex A States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:

so far as Article 3(1) is concerned: Canada, and the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations;

so far as Article 3(2) is concerned: where the Authority has prepared the international search report, Canada, and the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations;

- (ii) the following languages which it will accept:

English, French.

Annex B Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter which is searched or examined under the Canadian patent grant procedure.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Canadian dollars)</u>
Search fee (Rule 16.1(a))	1,600
Additional fee (Rule 40.2(a))	1,600
Preliminary examination fee (Rule 58.1(b))	800
Additional fee (Rule 68.3(a))	800
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	1

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search, 25% of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

English, French.

CN: Draft Agreement with the State Intellectual Property Office of the People's Republic of China

Agreement

between the State Intellectual Property Office of the People's Republic of China
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the State Intellectual Property Office
of the People's Republic of China
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The State Intellectual Property Office of the People's Republic of China and the
International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for
Technical Cooperation, has appointed the State Intellectual Property Office of the People's
Republic of China as an International Searching and Preliminary Examining Authority under
the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3)
and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
- (a) "Treaty" means the Patent Cooperation Treaty;
 - (b) "Regulations" means the Regulations under the Treaty;
 - (c) "Administrative Instructions" means the Administrative Instructions under the Treaty;
 - (d) "Article" (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) "Rule" means a Rule of the Regulations;
 - (f) "Contracting State" means a State party to the Treaty;
 - (g) "the Authority" means the State Intellectual Property Office of the People's Republic of China;

- (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the State Intellectual Property Office of the People's Republic of China gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the State Intellectual Property Office of the People's Republic of China written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the Chinese and English languages, each text being equally authentic.

For the State Intellectual Property Office of
the People's Republic of China by:

For the International Bureau by:

[...]

[...]

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:

China, Ghana, India, Kenya, Liberia, Turkey, Zimbabwe

and any State that the Authority will specify;
- (ii) the following languages which it will accept:

Chinese, English.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined in Chinese national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Yuan renminbi)</u>
Search fee (Rule 16.1(a))	2,100
Additional fee (Rule 40.2(a))	2,100
Preliminary examination fee (Rule 58.1(b))	1,500
Additional fee (Rule 68.3(a))	1,500
Protest fee (Rules 40.2(e) and 68.3(e))	200
Late furnishing fee (Rule 13 ~~ter~~ .1(c) and 13 ~~ter~~ .2)	200
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	2

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search to the full extent or to a substantially prevailing portion, 75% of the search fee paid shall be refunded.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Chinese and English, noting that the language of correspondence shall be the language in which the international application is filed or translated, as the case may be.

EP: Draft Agreement with the European Patent Organisation

Agreement

between the European Patent Organisation
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the European Patent Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The European Patent Organisation and the International Bureau of the World
Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for
Technical Cooperation, has appointed the European Patent Office as an International
Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and
approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the European Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement, that such application is not an application of a kind specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement, that such application is not an application of a kind specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on December 13, 2007.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the European Patent Organisation gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement;
or
- (ii) if the Director General of the World Intellectual Property Organization gives the European Patent Organisation written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English, French and German languages, each text being equally authentic.

For the European Patent Organisation by:

For the International Bureau by:

[...]

[...]

Annex A
Languages and Kinds of Application

Under Article 3 of the Agreement, the Authority specifies:

(i) the following languages which it will accept:

English, French, German, and, where the receiving Office is the industrial property Office of Belgium or the Netherlands, Dutch;

(ii) the following kinds of application for which it will not act:¹

as an International Preliminary Examining Authority, international applications where the international search is to be, or has been, performed by an International Searching Authority other than the European Patent Office or the industrial property Office of a State party to the European Patent Convention.

¹ Under an existing notification under Article 3(4)(a)(ii) of the present agreement between the European Patent Organization and the International Bureau, the European Patent Office is excluded, until March 1, 2009, from competence as an International Searching Authority and International Preliminary Examining Authority with respect to international applications filed, by a national or a resident of the United States of America, with the United States Patent and Trademark Office or the International Bureau as receiving Office where such applications contain one or more claims relating to business methods. The EPO has informed the International Bureau that this limitation will remain in force until March 2009 as foreseen in its notice dated 27 July 2006 (OJ EPO 10/2006, 555 and *PCT Gazette* No. 38/2006, page 19070); however, it will not be included in Annex A of the new Agreement unless the EPO seeks to issue a fresh limitation in 2009, which will then be introduced in accordance with the procedure under the new Agreement. Details will be included in the *PCT Applicant's Guide* and as a footnote to the new agreement when published in the *PCT Gazette*.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under the European patent grant procedure in application of the equivalent provisions of the European Patent Convention.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Euro)</u>
Search fee (Rule 16.1(a))	1,615 ²
Additional fee (Rule 40.2(a))	1,615 ²
Preliminary examination fee (Rule 58.1(b))	1,595 ²
Additional fee (Rule 68.3(a))	1,595 ²
Protest fee (Rules 40.2(e) and 68.3(e))	1,065
Late furnishing fee (Rule 13 ^{ter} .1(c) and 13 ^{ter} .2)	200
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	0.65

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall, upon request, be fully refunded.

(3) Where the Authority benefits from an earlier search (including a privately commissioned “standard” search) already made by the Authority on an application whose priority is claimed for the international application and depending upon the extent to which the Authority benefits from the earlier search in carrying out the international search and any other task entrusted to it, the search fee paid shall be refunded, to the extent provided for in a communication from the Authority to the International Bureau and published in the Gazette.

² This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person and is a national of and resides in a State not party to the European Patent Convention, which fulfils the requirements for the corresponding reduction of certain PCT fees as specified in the Schedule of Fees annexed to the PCT Regulations (see also corresponding footnote to the Annex C(IB) and *PCT Gazette* No. 50/1995, pages 19233 and 19234), and in accordance with the decision of the EPO’s Administrative Council of October 11, 2000 (OJ EPO 2000, 446).

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, 75% of the preliminary examination fee paid shall be refunded.

(6) The Authority may provide further refunds of the international preliminary examination fee under the conditions and to the extent laid down by it.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

English, French or German, depending on the language in which the international application is filed or translated.

ES: Draft Agreement with the Spanish Patent and Trademark Office

Agreement

between the Spanish Patent and Trademark Office
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Spanish Patent and Trademark Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Spanish Patent and Trademark Office and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Spanish Patent and Trademark Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Spanish Patent and Trademark Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the Spanish Patent and Trademark Office gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

- (ii) if the Director General of the World Intellectual Property Organization gives the Spanish Patent and Trademark Office written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English and Spanish languages, each text being equally authentic.

For the Spanish Patent and Trademark Office For the International Bureau by:
by:

[...]

[...]

*Annex A
Languages*

Under Article 3 of the Agreement, the Authority specifies the following language for which it will act:

Spanish.

*Annex B
Subject Matter Not Excluded from Search or Examination*

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination is the following:

all subject matter searched or examined in Spanish national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Euro)</u>
Search fee (Rule 16.1(a))	1,615 ¹
Additional fee (Rule 40.2(a))	1,615 ¹
Preliminary examination fee (Rule 58.1(b))	533.76
Additional fee (Rule 68.3(a))	533.76
Cost of copies (Rules 44.3(b) and 71.2(b)):	
– national documents, per document	4.69
– foreign documents, per document	4.69
Cost of copies (Rule 94.2), per page	0.23

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search already made by the Authority on an application whose priority is claimed for the international application, 100% or 50% of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

¹ This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person or a legal entity and is a national of and resides in a State not party to the European Patent Convention, which fulfils the requirements for the corresponding reduction of certain PCT fees as specified in the Schedule of Fees annexed to the PCT Regulations (see also corresponding footnote to Annex C(IB) and *PCT Gazette* No. 50/1995, pages 19233 and 19234), and in accordance with the decision of the EPO's Administrative Council of October 11, 2000 (OJ EPO 2000, 446).

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following language:

Spanish.

FI: Draft Agreement with the National Board of Patents and Registration of Finland

Agreement

between the National Board of Patents and Registration of Finland
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the National Board of Patents and Registration of Finland
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The National Board of Patents and Registration of Finland and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the National Board of Patents and Registration of Finland as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1

Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the National Board of Patents and Registration of Finland;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the National Board of Patents and Registration of Finland gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

- (ii) if the Director General of the World Intellectual Property Organization gives the National Board of Patents and Registration of Finland written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English language.

For the National Board of Patents and
Registration of Finland by:

[...]

For the International Bureau by:

[...]

Annex A *States and Languages*

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:
 - (a) Finland;
 - (b) any other Contracting State in accordance with the obligations of the Authority within the framework of the European Patent Organisation;
- (ii) the following languages which it will accept:

Finnish, Swedish, English.

Annex B *Subject Matter Not Excluded from Search or Examination*

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under the national patent grant procedure under the provisions of the Finnish Patent Law.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Euro)</u>
Search fee (Rule 16.1(a))	1,615
Additional fee (Rule 40.2(a))	1,615
Preliminary examination fee (Rule 58.1(b))	550
Additional fee (Rule 68.3(a))	550
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	0.60

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from:

- (i) an earlier national search already made by the Authority on an application whose priority is claimed for the international application: 100% of the national filing fee paid shall be refunded;
- (ii) an earlier international-type search already made by the Authority on an application whose priority is claimed for the international application: 50% or 100% of the international-type search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search;
- (iii) an earlier international search already made by the Authority on an application whose priority is claimed for the international application: 50% or 100% of the earlier international search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Finnish, Swedish or English, depending on the language in which the international application is filed or translated.

JP: Draft Agreement with the Japan Patent Office

Agreement

between the Japan Patent Office
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Japan Patent Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Japan Patent Office and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Japan Patent Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Japan Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the Japan Patent Office gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (ii) if the Director General of the World Intellectual Property Organization gives the Japan Patent Office written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [city], this [date], in two originals in the English and Japanese languages, each text being equally authentic.

For the Japan Patent Office by:

[...]

For the International Bureau by:

[...]

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act, so far as Article 3(1) is concerned:
Japan, Philippines, Republic of Korea;
- (ii) the following States for which it will act, so far as Article 3(2) is concerned:
where the Authority has prepared the international search report, Japan,
Philippines, Republic of Korea;
- (iii) the following languages which it will accept:
 - (a) for international applications filed with the receiving Office of, or acting for, Japan:
Japanese, English;
 - (b) for international applications filed with the receiving Office of, or acting for, Philippines:
English;
 - (c) for international applications filed with the receiving Office of, or acting for, Republic of Korea:
Japanese.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined in Japanese national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Japanese yen)</u>
Search fee (Rule 16.1(a))	97,000
Additional fee (Rule 40.2(a))	78,000
Preliminary examination fee (Rule 58.1(b))	36,000
Additional fee (Rule 68.3(a))	21,000
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per document	1,400

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the Authority benefits from an earlier search to a considerable extent, the amount of 41,000 Japanese yen shall be refunded, upon request.

(3) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(4) As long as the refund of the search fee (in the case where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search) and the refund of the preliminary examination fee (in the case where the international application or the demand is withdrawn before the start of the international preliminary examination) continue not to be compatible with the national law applicable to the Authority, the Authority may abstain from refunding those fees.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Japanese, English.

KR: Draft Agreement with the Korean Intellectual Property Office

Agreement

between the Korean Intellectual Property Office
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Korean Intellectual Property Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Korean Intellectual Property Office and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Korean Intellectual Property Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Korean Intellectual Property Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the Korean Intellectual Property Office gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

- (ii) if the Director General of the World Intellectual Property Organization gives the Korean Intellectual Property Office written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English and Korean languages, each text being equally authentic.

For the Korean Intellectual Property Office
by:

[...]

For the International Bureau by:

[...]

Annex A States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:

Republic of Korea;

Indonesia, Malaysia, Mongolia, New Zealand, Philippines, Singapore, United States of America, Viet Nam;

- (ii) the following languages which it will accept:

Korean, English.

Annex B Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined in Korean national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Korean won)</u>
Search fee (Rule 16.1(a))	225,000
Additional fee (Rule 40.2(a))	225,000
Preliminary examination fee (Rule 58.1(b))	225,000
Late payment fee for preliminary examination	[amount as set in Rule 58bis]
Additional fee (Rule 68.3(a))	225,000
Protest fee (Rules 40.2(e) and 68.3(e))	11,000
Late furnishing fee (Rule 13ter.1(c) and 13ter.2)	112,500
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	100

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search, 75% of the search fee paid shall be refunded.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Korean, English.

RU: Draft Agreement with the Russian Federal Service for Intellectual Property, Patents and Trademarks

Agreement

between the Russian Federal Service for Intellectual Property, Patents and Trademarks
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Russian Federal Service for
Intellectual Property, Patents and Trademarks
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Russian Federal Service for Intellectual Property, Patents and Trademarks and the
International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for
Technical Cooperation, has appointed the Russian Federal Service for Intellectual Property,
Patents and Trademarks as an International Searching and Preliminary Examining Authority
under the Patent Cooperation Treaty and approved this Agreement in accordance with
Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
- (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Russian Federal Service for Intellectual Property, Patents and Trademarks;

(h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

- (1) This Agreement shall terminate before December 31, 2017:
- (i) if the Russian Federal Service for Intellectual Property, Patents and Trademarks gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
 - (ii) if the Director General of the World Intellectual Property Organization gives the Russian Federal Service for Intellectual Property, Patents and Trademarks written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English and Russian languages, each text being equally authentic.

For the Russian Federal Service for
Intellectual Property, Patents and Trademarks
by:

[...]

For the International Bureau by:

[...]

Annex A
Languages

Under Article 3 of the Agreement, the Authority specifies the following languages:

Russian, English.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under national patent law administered by the Russian Federal Service for Intellectual Property, Patents and Trademarks.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(US dollars)</u>
Search fee (Rule 16.1(a)) ¹	500
Additional fee (Rule 40.2(a)) ²	500
Preliminary examination fee (Rule 58.1(b)): ²	
– if the international search report has been prepared by the Authority	200
– if the international search report has been prepared by another International Searching Authority	300
Additional fee (Rule 68.3(a)): ²	
– if the international search report has been prepared by the Authority	200
– if the international search report has been prepared by another International Searching Authority	300
Late furnishing fee (Rule 13 ^{ter} .1(c)) ²	150
Cost of copies of cited documents (except for documents transmitted to the applicant along with the international search report or preliminary examination report) (Rules 44.3(b) and 71.2(b)): ²	
– patent document, per page	0.30
– non-patent document, per page	1.20
Cost of copies of document contained in the file of the international application (Rule 94.2), per page ²	3.00

¹ If payment is made to a receiving Office which accepts payments in Russian roubles, the applicant may, instead of paying the US dollar amount, pay the equivalent amount in Russian roubles at the exchange rate applicable, on the date of payment, at the Central Bank of the Russian Federation.

² The applicant may, instead of paying the US dollar amount, pay the equivalent amount in Russian roubles at the exchange rate applicable, on the date of payment, at the Central Bank of the Russian Federation.

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), or Rules 90bis.1(a) or 90bis.2(c) before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier international, international-type or other search report prepared by it, the following amount of the search fee shall be refunded:

- (i) 75%, if no additional search is required;
- (ii) 50%, if the additional search is confirmed by documents relating to one or two additional IPC subgroups;
- (iii) 25%, if the additional search is confirmed by documents relating to new aspects of the claimed invention.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Russian or English, depending on the language in which the international application is filed or translated, or at the applicant's choice.

SE: Draft Agreement with the Swedish Patent and Registration Office

Agreement

between the Swedish Patent and Registration Office
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Swedish Patent and Registration Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Swedish Patent and Registration Office and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Swedish Patent and Registration Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Swedish Patent and Registration Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the Swedish Patent and Registration Office gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

- (ii) if the Director General of the World Intellectual Property Organization gives the Swedish Patent and Registration Office written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English language.

For the Swedish Patent and Registration
Office by:

[...]

For the International Bureau by:

[...]

Annex A States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:
 - (a) Denmark, Finland, Iceland, Norway, Sweden;
 - (b) the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations, provided that Sweden, in accordance with its obligations undertaken within the framework of the European Patent Organisation, has concluded with those States an agreement for that purpose;
- (ii) the following languages which it will accept:
 - (a) for international applications filed with the receiving Office of, or acting for, any State referred to in subparagraph (i)(a), above:
Danish, English, Finnish, Norwegian, Swedish;
 - (b) for international applications filed with the receiving Office of, or acting for, any State referred to in subparagraph (i)(b), above:
Danish, English, Finnish, French, Norwegian, Swedish.

Annex B Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

none.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Swedish kronor)</u>
Search fee (Rule 16.1(a))	15,230
Additional fee (Rule 40.2(a))	15,230
Preliminary examination fee (Rule 58.1(b))	5,000
Additional fee (Rule 68.3(a))	5,000
Cost of copies (Rule 94.2), per page	4
Cost of copies in paper form (Rules 44.3(b) and 71.2(b)), ¹ per document	50

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier international or international-type search, 50% or 100% of the search fee paid according to Part I shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) Where on an earlier application, the priority of which is claimed, a search report has been issued by the Danish Patent Office, the Icelandic Patent Office, the National Board of Patents and Registration of Finland or the Norwegian Patent Office, and where the Authority benefits from that search report, the amount of SEK 1,400 shall be refunded in respect of the search fee paid according to Part I. Where on an earlier application, the priority of which is claimed, a search report has been issued by the Swedish Patent and Registration Office, and where the Authority benefits from that search report, the amount of SEK 2,800 shall be refunded in respect of the search fee paid according to Part I.

(5) In the cases provided for under Rule 58.3, the following amount of the preliminary examination fee shall be refunded:

- (a) refund of the full amount paid where Rule 54.4(a), 57.4(c) or 58.2(c) applies;
- (b) refund of the amount paid less the current amount of transmittal fee, where Rule 60.1(c) applies.

¹ The applicant will receive free of charge a copy of each document containing non-patent literature. Other documents are available electronically, free of charge, on the website www.prv.se.

(6) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Danish, English, Finnish, French, Norwegian or Swedish, depending on the language in which the international application is filed or translated; however, English or Swedish may be used in all cases.

US: Draft Agreement with the United States Patent and Trademark Office

Agreement

between the United States Patent and Trademark Office
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the United States Patent and Trademark Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The United States Patent and Trademark Office and the International Bureau of the
World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for
Technical Cooperation, has appointed the United States Patent and Trademark Office as an
International Searching and Preliminary Examining Authority under the Patent Cooperation
Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the United States Patent and Trademark Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

The Authority shall indicate the International Patent Classification for the purposes of Rules 43.3(a) and 70.5(b) and may also apply the United States Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, 2008.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the United States Patent and Trademark Office gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

- (ii) if the Director General of the World Intellectual Property Organization gives the United States Patent and Trademark Office written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [city], this [date], in two originals in the English language.

For the United States Patent and Trademark
Office by:

For the International Bureau by:

[...]

[...]

Annex A States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act, so far as Article 3(1) is concerned:

United States of America, Barbados, Brazil, Dominican Republic, Egypt, India, Israel, Mexico, New Zealand, Philippines, Saint Lucia, South Africa, Trinidad and Tobago;

- (ii) the following States for which it will act, so far as Article 3(2) is concerned:

United States of America and,
where the Authority has prepared the international search report, Barbados, Brazil, Dominican Republic, Egypt, India, Israel, Mexico, New Zealand, Philippines, Saint Lucia, South Africa, Trinidad and Tobago;

- (iii) the following language which it will accept:

English.

Annex B Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined in United States national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(US dollars)</u>
Search fee (Rule 16.1(a)):	
– when a corresponding prior United States national application has been filed under 35 USC 111(a), the basic filing fee under 37 CFR 1.16(a) has been paid and the prior US national application is identified by the application number if known, or if the application number is not known, by the filing date, title and name of applicant (and preferably by the application docket number), in the international application or accompanying the papers at the time of filing the international application	300
– in all other cases	1,000
Additional search fee (Rule 40.2(a))	1,000
Preparation of an international-type search report on a United States national application	40
Preliminary examination fee (Rule 58.1(b)):	
– where the international search fee has been paid on the international application to the Authority	600
– where the international search was carried out by another Authority	750
Additional examination fee (Rule 68.3(a))	600
Cost of copies (Rule 94.2):	
– US patent, per copy	3
– non-US patent document, per copy	25

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the demand is considered, under Rule 54.4(a), 57.4(c), 58.2(c) or 60.1(c), as if it had not been submitted, the amount of the preliminary examination fee paid shall be fully refunded.

(4) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid, less a processing fee equivalent to the transmittal fee under Rule 14.1(b), shall be refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following language:
English.

XN: Draft Agreement with the Nordic Patent Institute

Agreement

between the Nordic Patent Institute
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Nordic Patent Institute
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Nordic Patent Institute and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Nordic Patent Institute as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1

Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Nordic Patent Institute;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is prepared to start functioning as an International Searching Authority and as an International Preliminary Examining Authority.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

- (1) This Agreement shall terminate before December 31, 2017:

- (i) if the Nordic Patent Institute gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement;
or
- (ii) if the Director General of the World Intellectual Property Organization gives the Nordic Patent Institute written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [city], this [date], in two originals in the Danish, English, Icelandic and Norwegian languages, each text being equally authentic.

For the Nordic Patent Institute by:

For the International Bureau by:

[...]

[...]

Annex A States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:
 - (a) Denmark, Iceland, Norway;
 - (b) any other Contracting State in accordance with the obligations of Denmark, Iceland and Norway within the framework of the European Patent Organisation;
- (ii) the following languages which it will accept:

Danish, English, Icelandic, Norwegian and Swedish.

Annex B Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined under the national patent grant procedure under the provisions of the Danish, Icelandic and Norwegian Patent Laws.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(...)</u>
Search fee (Rule 16.1(a))	[...]
Additional search fee (Rule 40.2(a))	[...]
Preparation of international-type search report	[...]
Preliminary examination fee (Rule 58.1(b))	[...]
Additional fee (Rule 68.3(a))	[...]
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2)	[...]
Cost of copies in paper form (Rules 44.3(b) and 71.2(b)), per document	[...]

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier international or international-type search, 50% or 100% of the search fee paid according to Part I shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) Where on an earlier application, the priority of which is claimed, a search report has been issued by the Danish Patent Office, the Icelandic Patent Office or the Norwegian Patent Office, and where the Authority benefits from that search report, the amount of [...] shall be refunded in respect of the search fee paid according to Part I.

(5) In the cases provided for under Rule 58.3, the following amount of the preliminary examination fee shall be refunded:

- (a) refund of the full amount paid where Rule 54.4, 54bis.1(b) or 58bis.1(b) applies;
- (b) refund of the amount paid less the current amount of transmittal fee, where Rule 60.1(c) applies.

(6) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Danish, English, Icelandic, Norwegian and Swedish, depending on the language in which the international application is filed or translated; however, English may be used in all cases.

[Annex II follows]

ANNEX II

APPOINTMENT OF THE BRAZILIAN NATIONAL INSTITUTE OF INDUSTRIAL
PROPERTY AS AN INTERNATIONAL SEARCHING AND PRELIMINARY
EXAMINING AUTHORITY UNDER THE PCT

Agreement

between the Brazilian National Institute of Industrial Property
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Brazilian National Institute of Industrial Property
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Brazilian National Institute of Industrial Property and the International Bureau of
the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for
Technical Cooperation, has appointed the Brazilian National Institute of Industrial Property as
an International Searching and Preliminary Examining Authority under the Patent
Cooperation Treaty and approved this Agreement in accordance with Articles 16(3)
and 32(3),

Hereby agree as follows:

Article 1

Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Brazilian National Institute of Industrial Property;

- (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2 *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is prepared to start functioning as an International Searching Authority and as an International Preliminary Examining Authority.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

- (1) This Agreement shall terminate before December 31, 2017:
- (i) if the Brazilian National Institute of Industrial Property gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
 - (ii) if the Director General of the World Intellectual Property Organization gives the Brazilian National Institute of Industrial Property written notice to terminate this Agreement.
- (2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [city], this [date], in two originals in the English and Portuguese languages, each text being equally authentic.

For the Brazilian National Institute of
Industrial Property by:

[...]

For the International Bureau by:

[...]

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:
any Contracting State;
- (ii) the following languages which it will accept:
 - (a) for international applications filed with the Brazilian National Institute of Industrial Property as receiving Office: English, Portuguese, Spanish;
 - (b) for international applications filed with any other receiving Office: Portuguese.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter which is searched or examined under the Brazilian patent grant procedure.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Brazilian reais)</u>
Search fee (Rule 16.1(a))	[...]
Additional fee (Rule 40.2(a))	[...]
Preliminary examination fee (Rule 58.1(b))	[...]
Additional fee (Rule 68.3(a))	[...]
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2)	[...]

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search, [percentages to be determined] of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following language:

English, Portuguese or Spanish, depending on the language in which the international application is filed or translated.

[Annex III follows]

ANNEX III

APPOINTMENT OF THE INDIAN PATENT OFFICE
AS AN INTERNATIONAL SEARCHING AND
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Agreement

between the Government of India
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Indian Patent Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Government of India and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Indian Patent Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1

Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Indian Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is prepared to start functioning as an International Searching Authority and as an International Preliminary Examining Authority.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2017:

- (i) if the Government of India gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

- (ii) if the Director General of the World Intellectual Property Organization gives the Government of India written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at [city], this [date], in two originals in the English language.

For the Government of India by:

[...]

For the International Bureau by:

[...]

Annex A States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following State for which it will act:
India;
- (ii) the following language which it will accept:
English.

Annex B Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter which is searched or examined under the Indian Patent Law administered by the Indian Patent Office.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> <u>(Indian rupees)</u>
Search fee (Rule 16.1(a))	[...]
Additional fee (Rule 40.2(a)):	
– where the international search report was issued by the Authority	[...]
– in other cases	[...]
Preliminary examination fee (Rule 58.1(b))	[...]
Additional fee (Rule 68.3(a))	[...]
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2)	[...]

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search made by the Authority, 25% or 50% of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following language:

English.

[Annex IV follows]

ANNEX IV

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
(to enter into force on July 1, 2008)¹

USE OF RESULTS OF EARLIER SEARCHES;
RESTORATION OF RIGHT OF PRIORITY BY THE RECEIVING OFFICE;
INTERNATIONAL APPLICATIONS CONSIDERED WITHDRAWN

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¹ See paragraph 137(ii) in the main body of this report for details concerning entry into force and transitional arrangements. See also paragraphs 137(iii) and 137(iv) in the main body of this report for details concerning understandings relating to Rules 4.12 and 12bis.1(e).

² The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 4
The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

- (a) [No change]
- (b) The request shall, where applicable, contain:
 - (i) [no change]
 - (ii) indications relating to an earlier search as provided in Rules 4.12(i) and 12bis.1(c) and (f),
 - (iii) and (iv) [no change]
- (c) The request may contain:
 - (i) to (iv) [no change]
 - (v) a request for restoration of the right of priority,
 - (vi) a statement as provided in Rule 4.12(ii).
- (d) [No change]

4.2 to 4.10 [No change]

4.11 *Reference to Continuation or Continuation-in-Part, or Parent Application or Grant*

- (a) If:
 - (i) the applicant intends to make an indication under Rule 49bis.1(a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or
 - (ii) the applicant intends to make an indication under Rule 49bis.1(d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall indicate the relevant parent application or parent patent or other parent grant.

- (b) The inclusion in the request of an indication under paragraph (a) shall have no effect on the operation of Rule 4.9.

4.12 *Taking into Account Results of Earlier Search*

If the applicant wishes the International Searching Authority to take into account, in carrying out the international search, the results of an earlier international, international-type or national search carried out by the same or another International Searching Authority or by a national Office (“earlier search”):

(i) the request shall so indicate and shall specify the Authority or Office concerned and the application in respect of which the earlier search was carried out;

(ii) the request may, where applicable, contain a statement to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language.

4.13 and 4.14 *[Remain deleted]*

4.14bis to 4.19 *[No change]*

Rule 12bis
Copy of Results of Earlier Search
and of Earlier Application; Translation

12bis.1 Copy of Results of Earlier Search and of Earlier Application; Translation

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to paragraphs (c) to (f), submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.

(b) The International Searching Authority may, subject to paragraphs (c) to (f), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:

(i) a copy of the earlier application concerned;

(ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;

(iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;

(iv) a copy of any document cited in the results of the earlier search.

(c) Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copies referred to in paragraphs (a) and (b)(i) and (iv), indicate the wish that the receiving Office prepare and transmit them to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.

(d) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy or translation referred to in paragraphs (a) and (b) shall be required to be submitted under those paragraphs.

[Rule 12bis.1, continued]

(e) Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (b)(i) and (ii) shall be required to be submitted under those paragraphs.

(f) Where a copy or translation referred to in paragraphs (a) and (b) is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library or in the form of the priority document, and the applicant so indicates in the request, no copy or translation shall be required to be submitted under those paragraphs.

Rule 16
The Search Fee

16.1 and 16.2 [No change]

16.3 *Partial Refund*

Where the International Searching Authority takes into account, under Rule 41.1, the results of an earlier search in carrying out the international search, that Authority shall refund the search fee paid in connection with the international application to the extent and under the conditions provided for in the agreement under Article 16(3)(b).

Rule 26bis
Correction or Addition of Priority Claim

26bis.1 and 26bis.2 [No change]

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

(a) to (c) [No change]

(d) The submission of a request under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration, payable within the time limit applicable under paragraph (e). The amount of that fee, if any, shall be fixed by the receiving Office. The time limit for payment of the fee may be extended, at the option of the receiving Office, for a period of up to two months from the expiration of the time limit applicable under paragraph (e).

(e) to (j) [No change]

Rule 29
International Applications Considered Withdrawn

29.1 *Finding by Receiving Office*

If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) or 12.4(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) to (iii) [no change]

(iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy;

(v) no international publication of the international application shall be effected if the notification of the said declaration transmitted by the receiving Office reaches the International Bureau before the technical preparations for international publication have been completed.

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

Rule 41
Taking into Account Results of Earlier Search

41.1 Taking into Account Results of Earlier Search

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12*bis*.1 and:

(i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

(ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

[Annex V follows]

ANNEX V

AMENDMENTS OF THE REGULATIONS UNDER THE PCT:
*(to enter into force on January 1, 2009)*¹

SUPPLEMENTARY INTERNATIONAL SEARCH

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¹ See paragraph 153(ii) in the main body of this report for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 45bis
Supplementary International Searches

45bis.1 Supplementary Search Request

(a) The applicant may, at any time prior to the expiration of 19 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45bis.9. Such requests may be made in respect of more than one such Authority.

(b) A request under paragraph (a) (“supplementary search request”) shall be submitted to the International Bureau and shall indicate:

(i) the name and address of the applicant and of the agent (if any), the title of the invention, the international filing date and the international application number;

(ii) the International Searching Authority that is requested to carry out the supplementary international search (“Authority specified for supplementary search”); and

(iii) where the international application was filed in a language which is not accepted by that Authority, whether any translation furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search.

(c) The supplementary search request shall, where applicable, be accompanied by:

(i) where neither the language in which the international application was filed nor that in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Authority specified for supplementary search, a translation of the international application into a language which is accepted by that Authority;

(ii) preferably, a copy of a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, if required by the Authority specified for supplementary search.

(d) Where the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the supplementary search request may contain an indication of the wish of the applicant to limit the supplementary international search to one of the inventions as identified by the International Searching Authority other than the main invention referred to in Article 17(3)(a).

(e) The supplementary search request shall be considered not to have been submitted, and the International Bureau shall so declare:

(i) if it is received after the expiration of the time limit referred to in paragraph (a); or

(ii) if the Authority specified for supplementary search has not stated, in the applicable agreement under Article 16(3)(b), its preparedness to carry out such searches or is not competent to do so under Rule 45bis.9(b).

45bis.2 Supplementary Search Handling Fee

(a) The supplementary search request shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”) as set out in the Schedule of Fees.

(b) The supplementary search handling fee shall be paid in the currency in which the fee is set out in the Schedule of Fees or in any other currency prescribed by the International Bureau. The amount in such other currency shall be the equivalent, in round figures, as established by the International Bureau, of the amount as set out in the Schedule of Fees, and shall be published in the Gazette.

(c) The supplementary search handling fee shall be paid to the International Bureau within one month from the date of receipt of the supplementary search request. The amount payable shall be the amount applicable on the date of payment.

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the supplementary search request is withdrawn or considered not to have been submitted.

45bis.3 Supplementary Search Fee

(a) Each International Searching Authority carrying out supplementary international searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out such a search.

(b) The supplementary search fee shall be collected by the International Bureau. Rules 16.1(b) to (e) shall apply *mutatis mutandis*.

(c) As to the time limit for payment of the supplementary search fee and the amount payable, the provisions of Rule 45bis.2(c) shall apply *mutatis mutandis*.

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the supplementary search request is withdrawn or considered not to have been submitted.

(e) The Authority specified for supplementary search shall, to the extent and under the conditions provided for in the applicable agreement under Article 16(3)(b), refund the supplementary search fee if, before it has started the supplementary international search in accordance with Rule 45bis.5(a), the supplementary search request is considered not to have been submitted.

45bis.4 Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to International Searching Authority

(a) Promptly after receipt of a supplementary search request, the International Bureau shall check whether it complies with the requirements of Rule 45bis.1(b) and (c)(i) and shall invite the applicant to correct any defects within a time limit of one month from the date of the invitation.

(b) Where, by the time they are due under Rules 45bis.2(c) and 45bis.3(c), the International Bureau finds that the supplementary search handling fee and the supplementary search fee have not been paid in full, it shall invite the applicant to pay to it the amount required to cover those fees, together with the late payment fee under paragraph (c), within a time limit of one month from the date of the invitation.

(c) The payment of fees in response to an invitation under paragraph (b) shall be subject to the payment to the International Bureau, for its own benefit, of a late payment fee whose amount shall be 50% of the supplementary search handling fee.

(d) If the applicant does not furnish the required correction or does not pay the amount in full of the fees due, including the late payment fee, before the expiration of the time limit applicable under paragraph (a) or (b), respectively, the supplementary search request shall be considered not to have been submitted and the International Bureau shall so declare and shall inform the applicant accordingly.

(e) On finding that the requirements of Rule 45bis.1(b) and (c)(i), 45bis.2(c) and 45bis.3(c) have been complied with, the International Bureau shall promptly, but not before the date of receipt by it of the international search report or the expiration of 17 months from the priority date, whichever occurs first, transmit to the Authority specified for supplementary search a copy of each of the following:

- (i) the supplementary search request;
- (ii) the international application;
- (iii) any sequence listing furnished under Rule 45bis.1(c)(ii); and
- (iv) any translation furnished under Rule 12.3, 12.4 or 45bis.1(c)(i) which is to be used as the basis of the supplementary international search;

and, at the same time, or promptly after their later receipt by the International Bureau:

- (v) the international search report and the written opinion established under Rule 43bis.1;
- (vi) any invitation by the International Searching Authority to pay additional fees referred to in Article 17(3)(a); and
- (vii) any protest by the applicant under Rule 40.2(c) and the decision thereon by the review body constituted in the framework of the International Searching Authority.

[Rule 45bis.4, continued]

(f) Upon request of the Authority specified for supplementary search, the written opinion referred to in paragraph (e)(v) shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to that Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

45bis.5 Start, Basis and Scope of Supplementary International Search

(a) The Authority specified for supplementary search shall start the supplementary international search promptly after receipt of the documents specified in Rule 45bis.4(e)(i) to (iv), provided that the Authority may, at its option, delay the start of the search until it has also received the documents specified in Rule 45bis.4(e)(v) or until the expiration of 22 months from the priority date, whichever occurs first.

(b) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation referred to in Rule 45bis.1(b)(iii) or 45bis.1(c)(i), taking due account of the international search report and the written opinion established under Rule 43bis.1 where they are available to the Authority specified for supplementary search before it starts the search. Where the supplementary search request contains an indication under Rule 45bis.1(d), the supplementary international search may be limited to the invention specified by the applicant under Rule 45bis.1(d) and those parts of the international application which relate to that invention.

(c) For the purposes of the supplementary international search, Article 17(2) and Rules 13ter.1, 33 and 39 shall apply *mutatis mutandis*.

(d) Where the international search report is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may exclude from the supplementary search any claims which were not the subject of the international search.

(e) Where the International Searching Authority has made the declaration referred to in Article 17(2)(a) and that declaration is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may decide not to establish a supplementary international search report, in which case it shall so declare and promptly notify the applicant and the International Bureau accordingly.

(f) The supplementary international search shall cover at least the documentation indicated for that purpose in the applicable agreement under Article 16(3)(b).

(g) If the Authority specified for supplementary search finds that carrying out the search is excluded by a limitation or condition referred to in Rule 45bis.9(a), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

45bis.6 Unity of Invention

(a) If the Authority specified for supplementary search finds that the international application does not comply with the requirement of unity of invention, it shall:

(i) establish the supplementary international search report on those parts of the international application which relate to the invention first mentioned in the claims (“main invention”);

(ii) notify the applicant of its opinion that the international application does not comply with the requirement of unity of invention and specify the reasons for that opinion; and

(iii) inform the applicant of the possibility of requesting, within the time limit referred to in paragraph (c), a review of the opinion.

(b) In considering whether the international application complies with the requirement of unity of invention, the Authority shall take due account of any documents received by it under Rule 45bis.4(e)(vi) and (vii) before it starts the supplementary international search.

(c) The applicant may, within one month from the date of the notification under paragraph (a)(ii), request the Authority to review the opinion referred to in paragraph (a). The request for review may be subjected by the Authority to the payment to it, for its own benefit, of a review fee whose amount shall be fixed by it.

(d) If the applicant, within the time limit under paragraph (c), requests a review of the opinion by the Authority and pays any required review fee, the opinion shall be reviewed by the Authority. The review shall not be carried out only by the person who made the decision which is the subject of the review. Where the Authority:

(i) finds that the opinion was entirely justified, it shall notify the applicant accordingly;

(ii) finds that the opinion was partially unjustified but still considers that the international application does not comply with the requirement of unity of invention, it shall notify the applicant accordingly and, where necessary, proceed as provided for in paragraph (a)(i);

(iii) finds that the opinion was entirely unjustified, it shall notify the applicant accordingly, establish the supplementary international search report on all parts of the international application and refund the review fee to the applicant.

(e) On the request of the applicant, the text of both the request for review and the decision thereon shall be communicated to the designated Offices together with the supplementary 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 45bis.6, continued]

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* where the Authority specified for supplementary search decides to limit the supplementary international search in accordance with the second sentence of Rule 45bis.5(b), provided that any reference in the said paragraphs to the “international application” shall be construed as a reference to those parts of the international application which relate to the invention specified by the applicant under Rule 45bis.1(d).

45bis.7 Supplementary International Search Report

(a) The Authority specified for supplementary search shall, within 28 months from the priority date, establish the supplementary international search report, or make the declaration referred to in Article 17(2)(a) as applicable by virtue of Rule 45bis.5(c) that no supplementary international search report will be established.

(b) Every supplementary international search report, any declaration referred to in Article 17(2)(a) as applicable by virtue of Rule 45bis.5(c) and any declaration under Rule 45bis.5(e) shall be in a language of publication.

(c) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2, 43.5, 43.6, 43.6bis, 43.8 and 43.10 shall, subject to paragraphs (d) and (e), apply *mutatis mutandis*. Rule 43.9 shall apply *mutatis mutandis*, except that the references therein to Rules 43.3, 43.7 and 44.2 shall be considered non-existent. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

(d) The supplementary international search report need not contain the citation of any document cited in the international search report, except where the document needs to be cited in conjunction with other documents that were not cited in the international search report.

(e) The supplementary international search report may contain explanations:

(i) with regard to the citations of the documents considered to be relevant;

(ii) with regard to the scope of the supplementary international search.

45bis.8 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority specified for supplementary search shall, on the same day, transmit one copy of the supplementary international search report or the declaration that no supplementary international search report shall be established, as applicable, to the International Bureau and one copy to the applicant.

(b) Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

(c) A supplementary international search report need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

45bis.9 International Searching Authorities Competent to Carry Out Supplementary International Search

(a) An International Searching Authority shall be competent to carry out supplementary international searches if its preparedness to do so is stated in the applicable agreement under Article 16(3)(b), subject to any limitations and conditions set out in that agreement.

(b) The International Searching Authority carrying out the international search under Article 16(1) in respect of an international application shall not be competent to carry out a supplementary international search in respect of that application.

(c) The limitations referred to in paragraph (a) may, for example, include limitations as to the subject matter for which supplementary international searches will be carried out, beyond those which would apply under Article 17(2) to the international search, and limitations as to the total number of supplementary international searches which will be carried out in a given period.

SCHEDULE OF FEES

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,400 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Supplementary search handling fee: (Rule 45 <i>bis</i> .2)	200 Swiss francs
3. Handling fee: (Rule 57.2)	200 Swiss francs

Reductions

4. The international filing fee is reduced by the following amount if the international application is, as provided for in the Administrative Instructions, filed:

(a) on paper together with a copy in electronic form, in character coded format, of the request and the abstract:	100 Swiss francs
(b) in electronic form, the request not being in character coded format:	100 Swiss francs
(c) in electronic form, the request being in character coded format:	200 Swiss francs
(d) in electronic form, the request, description, claims and abstract being in character coded format:	300 Swiss francs

5. The international filing fee under item 1 (where applicable, as reduced under item 4), the supplementary search handling fee under item 2 and the handling fee under item 3 are reduced by 75% if the international application is filed by:

- (a) an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); or
- (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations;

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).

[Annex VI follows]

ANNEX VI

AMENDMENTS OF THE PCT REGULATIONS:
(to enter into force on January 1, 2009)¹

ADDITION OF KOREAN AND PORTUGUESE AS LANGUAGES OF PUBLICATION

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¹ See paragraph 174(ii) in the main body of this report for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 48
International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

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

(b) and (c) [No change]

48.4 to 48.6 [No change]

[End of Annex VI and of document]

WIPO



PCT/A/37/2

ORIGINAL: English

DATE: May 15, 2008

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Thirty-Seventh (21st Extraordinary) Session
Geneva, March 31, 2008**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Agenda (document A/44/1): 1, 2, 3, 4 and 5.
2. The report on the said items, with the exception of the discussions on the proposed amendments of the Schedule of Fees annexed to the PCT Regulations, is contained in the General Report (document A/44/3).
3. The report on the discussions on the proposed amendments of the Schedule of Fees annexed to the PCT Regulations is contained in the present document.
4. In the absence of the Chair of the Assembly (Mrs. Ásta Valdimarsdóttir (Iceland)) and both Vice-Chairs (Mr. Matti Päts (Estonia) and Mr. Yin Xintian (China)), Ambassador Martin Ihoeghian Uhomoibhi (Nigeria), Chair of the General Assembly, was elected acting Chair and presided over the meeting.

AMENDMENTS OF THE SCHEDULE OF FEES

5. Discussions were based on document PCT/A/37/1.

6. The Secretariat, in introducing the proposals contained in document PCT/A/37/1, explained that the proposal to set a time limit (until December 31, 2009) to the availability of the reduction in the international filing fee and the handling fee to applicants from nine countries which at present did not benefit from such reduction (Antigua and Barbuda, Bahrain, Barbados, the Libyan Arab Jamahiriya, Oman, the Seychelles, Singapore, Trinidad and Tobago and the United Arab Emirates) had been included so as to give Member States the opportunity to agree, prior to that date, on a revised set of eligibility criteria for determining the group of developing and least developed countries whose applicants should benefit from a reduction of PCT fees, noting that, at its thirty-sixth (16th ordinary) session, the Assembly had requested the International Bureau to carry out a study on those eligibility criteria and to present that study to the session of the PCT Assembly in September-October 2008 (see paragraph 62 of document PCT/A/36/13).

7. The Secretariat, in response to an intervention by the Delegation of Algeria as to the financial implications for WIPO's budget if the proposed amendments to the Schedule of Fees set out in document PCT/A/37/1 were to enter into force either immediately, on July 1, 2008, or on January 1, 2009, stated that if the amendments were to enter into force immediately, that is, on May 1, 2008, income would be reduced by 21 million Swiss francs, whereas income would be reduced by 18 million Swiss francs and 12 million Swiss francs were the amendments to enter into force on July 1, 2008, or January 1, 2009, respectively.

8. Following informal consultations, the acting Chair summarized the results of those consultations as follows. There had been agreement among delegations to adopt the amendments to the Schedule of Fees as set out in the Annex to document PCT/A/37/1, subject to replacing, in paragraph 4(a) of the Schedule of Fees as proposed to be amended, the words "until December 31, 2009" with the words "pending a decision by the PCT Assembly on the eligibility criteria specified in this sub-paragraph". Furthermore, there had been agreement among delegations, during the informal consultations, that the amendments should enter into force on July 1, 2008.

9. The Assembly:

(i) adopted the amendments of the Schedule of Fees annexed to the Regulations under the PCT set out in the Annex to this report;

(ii) decided that those amendments shall enter into force on July 1, 2008, and shall apply to any international application the international filing date of which is on or after July 1, 2008, provided that the Schedule of Fees as worded before its amendment shall continue to apply to any international application which is received by the receiving Office before July 1, 2008, and which is accorded an international filing date that is on or after July 1, 2008.

10. The Delegation of the Republic of Korea stated that it welcomed the 5% reduction of the PCT international filing fee as adopted by the Assembly. It considered that this would encourage applicants to make use of the PCT more frequently. The Delegation further stated that it considered that the current level of fees was still too high for citizens of developing countries and that it was thus pleased to see the increase in reduction for them from 75% to 90% of the normal level. However, with respect to the nine countries which had been added to the list of beneficiaries, it was not clear to the Delegation on what basis they had been selected. The Delegation stated that it fully understood the situation of countries with small and vulnerable economies and that it was willing to support their inclusion. However, it did

not see how countries whose per capita GDP greatly exceeded US\$ 30,000 could be categorized in the same group. The Delegation stated that, while it did not wish to make an issue of a particular case, it wished to raise the issue as a matter of principle because it was concerned that this apparent lack of coherence and rationale could lead to undue discrimination amongst PCT Contracting States and have a negative impact on the long-term stability of the PCT system itself. The Delegation further stated that it recognized that there had been serious efforts, particularly amongst the group coordinators, to agree on a compromise budget package and that the Republic of Korea was willing to respect the majority will of the Contracting States. However, at the same time, it wished to note that the decision to add the nine countries concerned was a temporary one and that it hoped that a thorough review could be made and an appropriate formula could be agreed upon at the earliest opportunity.

[Annex follows]

ANNEX

AMENDMENTS OF
THE REGULATIONS UNDER THE PCTSCHEDULE OF FEES
(with effect from July 1, 2008)

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,330 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling fee: (Rule 57.2)	200 Swiss francs

Reductions

3. The international filing fee is reduced by the following amount if the international application is, as provided for in the Administrative Instructions, filed:

(a) on paper together with a copy in electronic form, in character coded format, of the request and the abstract:	100 Swiss francs
(b) in electronic form, the request not being in character coded format:	100 Swiss francs
(c) in electronic form, the request being in character coded format:	200 Swiss francs
(d) in electronic form, the request, description, claims and abstract being in character coded format:	300 Swiss francs

4. The international filing fee (where applicable, as reduced under item 3) and the handling fee are reduced by 90% if the international application is filed by:

- an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997) or, pending a decision by the PCT Assembly on the eligibility criteria specified in this sub-paragraph, one of the following States: Antigua and Barbuda, Bahrain, Barbados, the Libyan Arab Jamahiriya, Oman, the Seychelles, Singapore, Trinidad and Tobago and the United Arab Emirates; or
- an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations;

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).

[End of Annex and of document]

WIPO



PCT/A/38/6

ORIGINAL: English

DATE: September 29, 2008

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirty-Eighth (22nd Extraordinary) Session
Geneva, September 22 to 30, 2008

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/45/1): 1, 2, 3, 14, 19, 22, 25 and 26.
2. The report on the said items, with the exception of item 19, is contained in the General Report (document A/45/5).
3. The report on item 19 is contained in the present document.
4. The meeting of the Assembly was presided over by Mrs. Ásta Valdimarsdóttir (Iceland), Chair of the PCT Assembly.

ITEM 19 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

PCT Working Group: Report of the First Session

5. Discussions were based on document PCT/A/38/1.

6. The Assembly:

(i) noted the report of the first session of the PCT Working Group contained in document PCT/WG/1/16 and reproduced in the Annex of document PCT/A/38/1; and

(ii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 31 of document PCT/A/38/1.

Proposed Amendments of the PCT Regulations

7. Discussions were based on documents PCT/A/38/2 and 2 Add.

8. In introducing the documents, the Secretariat proposed two further corrections of a drafting nature to Rule 90*bis* as proposed to be amended, as well as a number of minor corrections of a drafting nature, applicable to the French text only, to various other Rules as proposed to be amended. The corrected texts are set out in Annex I in the English version of this report and Annexes I and II of the French version of this report.

9. The Secretariat further informed the Assembly that, as regards the supplementary search system, it had received confirmation by the Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation), the Swedish Patent and Registration Office and the Nordic Patent Institute in their capacity as International Searching Authorities of their intention to offer the supplementary search service as of January 1, 2009. In addition, the Austrian Patent Office had confirmed its intention to offer that service later in 2009, and both the National Board of Patents and Registration of Finland and the European Patent Office had confirmed their intentions to offer supplementary international searches as of 2010.

10. The Delegation of Finland expressed its support for the proposed amendments of the Regulations.

11. The Assembly:

(i) adopted the amendments of the Regulations under the PCT set out in Annexes I and II to this report;

(ii) decided that the amendments set out in Annex I shall enter into force on January 1, 2009, and shall apply to any international application in respect of which the time limit for making a supplementary search request under new Rule 45*bis*.1(a) expires on or after January 1, 2009;

(iii) decided that the amendments of Rule 29.4 set out in Annex II shall enter into force on July 1, 2009, and shall apply to any international application whose international filing date is on or after July 1, 2009; and

(iv) decided that the amendments of Rules 46.5, 66.8 and 70.16 set out in Annex II shall enter into force on July 1, 2009, and shall apply to any international application in respect of which an amendment under Article 19 or 34 is made on or after July 1, 2009.

Quality Management Systems for PCT International Authorities

12. Discussions were based on document PCT/A/38/3.

13. The Assembly noted the content of document PCT/A/38/3.

Criteria for Any Future Addition of Further Languages of Publication under the PCT

14. Discussions were based on document PCT/A/38/4. The Secretariat proposed a correction to the French text only of the proposed Understanding.

15. The Assembly adopted the Understanding set out in Annex III on criteria for any future addition of further languages of publication under the PCT.

Eligibility Criteria for Reductions in PCT Fees: Proposed Amendments of the Schedule of Fees Annexed to the PCT Regulations

16. Discussions were based on document PCT/A/38/5.

17. The Delegation of Singapore stated that, while the proposal on the eligibility criteria for the reduction of PCT fees for individual applicants from selected States set out in document PCT/A/38/5 reviewed and updated the earlier criteria established in 1997, it had also raised a number of conceptual issues which the Delegation hoped the Secretariat would be able to help clarify. The Delegation stated that, first, the Secretariat's proposal was a departure from the 1997 decision. The proposed criteria, income-based and size-based, were new parameters that had not been discussed amongst Member States. Hence, time should be given for in-depth consideration and discussion to ensure prudent decision-making. Second, the basis of the size-based criteria benchmarks ("not more than 50% above the threshold for establishing the high income category" and "not more than 0.1% of world GDP") was unclear. These benchmarks were based on borrowing concepts and measurements developed in other international organizations for other purposes. Hence, more clarity was needed in terms of the thought process and reasoning behind the proposals to use these borrowed concepts, particularly as regards the determination of the final ceilings under the Secretariat's proposal. In this regard, the Delegation stated that it would be grateful for the Secretariat's clarifications on the rationale, applicability as well as mathematical calculations or formulas in drawing the boundaries at "not more than 50% above the threshold for establishing the high income category" and "not more than 0.1% of world GDP".

18. The Delegation further expressed the view that, third, earlier discussions had highlighted that the overarching objective of the reduction in PCT fees for individuals was to spur innovation. The proposal's focus on economic indicators, such as GNI per capita and GDP, were not definitive in measuring or encouraging innovation. For a more complete picture, work should be done towards identifying criteria that would fulfill the objective of encouraging inventive activities. One aspect that should be explored in greater detail was that of an innovation criterion. Quoting from a study by the Organisation for Economic Co-operation and Development (OECD) (Compendium of Patent Statistics 2007, OECD), the Delegation stated that patent-based statistics provided a measure of innovation output as they reflected the inventive performance of countries. Hence, an in-depth statistical analysis of

parameters, such as the level of PCT filings by individuals and patent trends, should be conducted. This approach would ensure that the reduction in PCT fees served to benefit States with lower levels of filings by encouraging innovation, and the increased usage of the PCT system in patent filings. Fourth, the decision for a 90% reduction in PCT fees for eligible countries had been made in March 2008 and had come into force only on 1 July 2008. In the case of Singapore, 11 individual applicants had already benefited from the 90% reduction over the past two months, and the impact on the PCT income was a negligible 0.008%. More time should be given to allow Member States to assess the impact of the 90% reduction on innovation levels. At least a year should be allowed to pass to allow the impact of the decision to work through the PCT system before going back to the drawing board to refine the March 2008 decision. This would permit more rounded assessments. Meanwhile, the Secretariat could explore new criteria, particularly innovation-related criteria which would provide additional and perhaps more relevant perspectives to this issue.

19. In conclusion, the Delegation of Singapore stated that it was of the view that a decision on eligibility criteria for fee reductions should be deferred to a later stage, as more time should be given for Member States to deliberate on the Secretariat's proposal, to better assess the impact of the recent reduction, and to explore new and conceptually robust criteria. To ensure that the reduction achieved the aim of stimulating innovation, the eventual criteria should be based on patent-based statistics and consider independent evidence, rather than borrowing concepts which may not be relevant, in order to fulfill the overarching objective of spurring innovation.

20. The Delegation of Algeria, speaking on behalf of the African Group, stated that the Group had taken careful note of the proposed eligibility criteria for reductions of the PCT fees. The Group supported the extension of the reductions to developing countries of all categories, including the nine States to which the reductions had been extended pending review. Moreover, it was essential that least developed countries (LDCs) should continue to benefit from the fee reductions for as long as they continued to be classified as LDCs according to the United Nations system. Finally, the Group considered that the proposal for biennial review of the lists of eligible States was too frequent and a period of five years was recommended since it could not be expected that a developing country or LDC would make substantial progress in a period as short as two years.

21. The Delegation of the United Arab Emirates expressed its support for the proposal made by Singapore to conduct further studies. It observed that most inventors from the United Arab Emirates were students.

22. The Delegation of Nigeria endorsed the statement of the African Group. The Delegation supported criteria that would be broad enough to offer fee reductions to all developing countries, including the nine which had been recently added. The Delegation considered that it was important to consider carefully and scientifically what each criterion could do in terms of improvement to the system. It was necessary to look at what could be done to ensure that all developing countries enjoyed this fee reduction. The Delegation considered that a combination of both an income and size-based approach as recommended by the Secretariat would go furthest to embracing all these countries and the Delegation endorsed such an approach. The Delegation observed that a decision might be postponed to do further scientific analysis to find the most correct approach but believed that, even if another 10 years was spent on analysis, it would be impossible to do something definite. What was needed was to apply criteria now that could help extend reductions to all countries in the developing world. This did not preclude a careful review of the criteria, but the important thing was to

apply something which was broad. The Delegation reiterated the view expressed by the African Group that two years was too short for a period for review. Five years would be appropriate for this.

23. The Delegation of Oman observed that Oman would benefit from the criteria that came out of this study. Its authorities had not yet had the time to consider the study in detail, in particular because of the language in which the study was published. Language was, of course, a very important factor in enabling delegations to understand the documents that are published by the Organization. In relation to the study, the Delegation referred to the objectives of the fee reduction as stated in paragraph 4, that it “would contribute to increased access to the PCT system” or increase demand, and that would be a tangible benefit. With regard to the choice of criteria, the Delegation considered that those proposed in the document, based on income and size, were not sufficient. There should be different criteria, such as creativity, which was a key factor. Creativity was, of course, key to development, and that was why it was important to look into that matter as one of the eligibility criteria. The Delegation considered that enlarging the number of different criteria would be useful in finding a sustainable long-term solution, rather than a temporary approach under which the criteria would have to be reviewed frequently. The Delegation hoped that the study would help to find a long term sustainable solution which would only need to be reviewed every three or four years. Such a review should take into account the increasing demand and, importantly, development in the beneficiary countries. The Delegation finally reiterated the importance of language. For countries which were just getting to grips with a new system, it was essential to have effective means of communicating in their own languages. If the benefits of treaties and agreements were going to be felt, it was necessary to receive all of the documents for those treaties in a language that enabled the authorities to understand the fine technical niceties of the agreements so that States would be able to have a fruitful dialog.

24. The Delegation of Barbados stated that the Member States of WIPO were, in this matter, engaging in a norm setting activity, seeking to establish the modalities on the criteria for eligibility for a PCT fee reduction. In that regard, the Delegation wished to congratulate the International Bureau for its attempt to move away from a “one size fits all” approach with respect to the application of the eligibility criteria, and for attempting to provide an appropriate solution for patent applicants in small States which would either not be eligible or which would soon lose their eligibility for the fee reduction if income were the only criterion. The Delegation considered that Member States were beginning to see the emergence of the effect of the development agenda in the work of the International Bureau.

25. The Delegation of Barbados further stated that, notwithstanding its appreciation for the work of the International Bureau, it had concerns about the appropriateness of the criterion suggested in paragraph 28(b) of document PCT/A/38/5 as it applied to patent applicants from high income, small, vulnerable economies. The Delegation wished to elaborate on why such economies did require special and differential treatment with respect to eligibility for a PCT fee reduction, and why a “one size fits all” approach, based on *per capita* income, was inappropriate. The Delegation expressed the view that, in determining which countries should benefit from a PCT fee reduction, one could not afford simply to look at *per capita* income in isolation; otherwise, one would end up with an inequitable result for patent applicants in high income, small, vulnerable economies, such as Barbados. Rather, one had to look at the various circumstances existing in a given country and the challenges which patent applicants in that country faced in the manufacture of an invention, the sale of that invention in the domestic market as well as the export of that product to the markets of other countries, in order to determine whether there was a need for the applicant to benefit from a fee reduction. One had to look at the full picture. The PCT system was not an end in itself but a means to an

end. It was one of the mechanisms through which intellectual property could make a contribution to the economic development of a country. If one looked only at the *per capita* income, one ended up in the situation whereby patent applicants in certain middle-income countries, where the conditions were more favorable to the manufacture and sale of inventions, were in reality in a far better position than applicants in high income, small, vulnerable economies barred from a PCT fee reduction.

26. The Delegation of Barbados further noted that the *per capita* income of Barbados was high. According to the figures provided by the International Bureau for 2006, Barbados was 175 Swiss francs above the threshold for the high income category. However, while the *per capita* income might be high, the cost of living was also high. The cost of living in Barbados was a factor that ought not to be ignored. In addition, the cost of production was high and, because of the small market, production often suffered from diseconomies of scale. The result was that the level of competitiveness with larger economies was low, which had implications for the export and sale of the manufactured invention to persons in other countries. It was therefore rather difficult for a patent applicant in Barbados to recoup what he had invested in bringing his invention to the stage of patentability. In the view of the Delegation of Barbados, the challenges which patent applicants in Barbados faced with respect to the manufacture and sale of their inventions nullified the benefits of a higher *per capita* income. A patent applicant in Barbados was, in reality, in the same or a worse position than that of patent applicants in certain middle-income countries. The criterion to be suggested for high income, small, vulnerable economies, as well as the duration of that criterion, should therefore not be arbitrary in nature but should reflect reality and exist as long as the special challenges which patent applicants faced remained.

27. The Delegation of Barbados further stated that many small economies were least developed countries, whose needs for special and differential treatment were already addressed in paragraph 28(c) of document PCT/A/38/5. The needs of a number of middle income small economies were addressed under paragraph 28(a) of that document, as their *per capita* income fell below the threshold for the high income category. What needed to be done was to find an appropriate solution for patent applicants in high income, small, vulnerable economies, such as Barbados; otherwise, inequity would result, a fact which had to be underscored. The Delegation of Barbados therefore proposed that, in light of the need to address the challenges faced by patent applicants in high income, small, vulnerable economies, there should be an additional economic criterion in paragraph 28 of document PCT/A/38/5, to read as follows: "... an international application should benefit from the 90% fee reduction if it is filed by an applicant who is a natural person and who is a national of and resides in a State that is classified as a small, vulnerable economy".

28. As to the question of how to determine which country belonged to the group of small, vulnerable economies, the Delegation of Barbados expressed the view that significant progress had been made in the World Trade Organization's Non-Agricultural Market Access (WTO/NAMA) negotiations on this issue. In the United Nations Conference on Trade and Development (UNCTAD), there was a broader category of countries known as the Structurally Weak Vulnerable Small Economies, which included all the least developed countries, as well as some Latin American and Caribbean countries and others, but more work needed to be done on that issue. The Delegation stated that, in WIPO, Member States had to be creative. The International Bureau could propose the additional criteria and report back to Member States at the next PCT Assembly, or Member States could use the WTO/NAMA criteria as set out in paragraph 23 of the study. In NAMA, a small vulnerable economy was defined as one that had a share of less than 0.1% of the World NAMA trade for the reference period of 1999 to 2001; a different reference period could be used. The International Bureau, by referring to the NAMA trade-related criterion in the study, had not gone on to explore this

criterion because, according to paragraph 24 of the document, it would not be possible to classify all States whose applicants could potentially benefit from the PCT fee reduction as some WIPO Member States were not members of the WTO. In that regard, the Delegation of Barbados wished to point out that the figures used by the WTO were, as stated in WTO document TN/MA/S/18, from the United Nations Comtrade database and could be accessed by the International Bureau from that database. The Delegation stated that it would not like this criterion determined by a percentage of world trade to be rejected out of hand simply because some WIPO Member States were not members of the WTO. It encouraged the International Bureau to address the special challenges which individual patent applicants in high income, small, vulnerable economies faced in the manufacture and sale of their inventions both in the domestic market and abroad. These challenges would not necessarily go away should Barbados's *per capita* income reach 50% above the threshold used by the World Bank for establishing the "high income" category. The duration of the criteria that were proposed should be one which was linked to the existence of these challenges.

29. In conclusion, the Delegation of Barbados stated that, while it welcomed the efforts of the International Bureau to take into account not only the concerns of patent applicants in large and medium-sized developing economies but also those of applicants in small economies, it was unable to join any consensus on the criteria as proposed in paragraph 28 of the study. The Delegation expressed the view that what was needed were more appropriate criteria which took into account and addressed the challenges faced by patent applicants in high income, small, vulnerable economies such as Barbados.

30. Following a proposal by the Director General-elect, the Assembly agreed that the issue should be placed on the agenda of the PCT Working Group in 2009.

[Annexes follow]

ANNEX I

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on January 1, 2009)¹

SUPPLEMENTARY INTERNATIONAL SEARCH

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¹ See paragraph 11 in the main body of this report for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 45bis
Supplementary International Searches

45bis.1 [No change]

45bis.2 *Supplementary Search Handling Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted.

45bis.3 *Supplementary Search Fee*

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted.

(e) [No change]

45bis.4 to 45bis.9 [No change]

Rule 90
Agents and Common Representatives

90.1 *Appointment as Agent*

(a) A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority.

(b) [No change]

(b-bis) A person having the right to practice before the national Office or intergovernmental organization which acts as the Authority specified for supplementary search may be appointed by the applicant as his agent to represent him specifically before that Authority.

(c) [No change]

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office, as the case may be;

(ii) specifically before the International Searching Authority, any Authority specified for supplementary search or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

90.2 and 90.3 [No change]

90.4 *Manner of Appointment of Agent or Common Representative*

(a) [No change]

(b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (b-bis), (c) or (d)(ii), it shall be submitted to the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

(c) [No change]

(d) Subject to paragraph (e), any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches, any International Preliminary Examining Authority and the International Bureau may waive the requirement under paragraph (b) that a separate power of attorney be submitted to it, in which case paragraph (c) shall not apply.

(e) [No change]

90.5 *General Power of Attorney*

(a) [No change]

(b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (b-bis), (c) or (d)(ii), it shall be deposited with the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

(c) Any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 to the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be, a copy of the general power of attorney shall be submitted to that Office or Authority.

90.6 [No change]

Rule 90bis
Withdrawals

90bis.1 to 90bis.3 [No change]

90bis.3bis Withdrawal of Supplementary Search Request

(a) The applicant may withdraw a supplementary search request at any time prior to the date of transmittal to the applicant and to the International Bureau, under Rule 45bis.8(a), of the supplementary international search report or the declaration that no such report will be established.

(b) Withdrawal shall be effective on receipt, within the time limit under paragraph (a), of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration referred to in paragraph (a), the communication of that report or declaration under Article 20(1), as applicable by virtue of Rule 45bis.8(b), shall nevertheless be effected.

90bis.4 [No change]

90bis.5 Signature

(a) [No change]

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant ("the applicant concerned") if it is signed by at least one applicant and

(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau, the Authority carrying out the supplementary international search or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or

(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d), 90bis.3(c) or 90bis.3bis(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or

(iii) [No change]

90bis.6 *Effect of Withdrawal*

(a) and (b) [No change]

(b-bis) Where a supplementary search request is withdrawn under Rule 90bis.3bis, the supplementary international search by the Authority concerned shall be discontinued.

(c) [No change]

90bis.7 [No change]

[Annex II follows]

ANNEX II

AMENDMENTS OF THE REGULATIONS UNDER THE PCT
(to enter into force on July 1, 2009)¹

PROCESSING OF THE INTERNATIONAL APPLICATION UNDER ARTICLE 14(4);
AMENDMENT OF CLAIMS

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¹ See paragraph 11 in the main body of this report for details concerning entry into force and transitional arrangements.

² The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 29
International Applications Considered Withdrawn

29.1 to 29.3 [No change]

29.4 *Notification of Intent to Make Declaration under Article 14(4)*

(a) Before the receiving Office issues any declaration under Article 14(4), it shall notify the applicant of its intent to issue such declaration and the reasons therefor. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within two months from the date of the notification.

(b) Where the receiving Office intends to issue a declaration under Article 14(4) in respect of an element mentioned in Article 11(1)(iii)(d) or (e), the receiving Office shall, in the notification referred to in paragraph (a) of this Rule, invite the applicant to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 4.18. For the purposes of Rule 20.7(a)(i), the invitation sent to the applicant under this paragraph shall be considered to be an invitation under Rule 20.3(a)(ii).

(c) Paragraph (b) shall not apply where the receiving Office has informed the International Bureau in accordance with Rule 20.8(a) of the incompatibility of Rules 20.3(a)(ii) and (b)(ii) and 20.6 with the national law applied by that Office.

Rule 46
Amendment of Claims before the International Bureau

46.1 to 46.4 [No change]

46.5 *Form of Amendments*

(a) The applicant, when making amendments under Article 19, shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed.

(b) The replacement sheet or sheets shall be accompanied by a letter which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended;

(ii) shall identify the claims originally filed which, on account of the amendments, are cancelled.

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 to 66.7 [No change]

66.8 *Form of Amendments*

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) [No change]

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

66.9 [No change]

Rule 70
International Preliminary Report on Patentability
by the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) Each replacement sheet under Rule 66.8(a) or (b) shall, unless superseded by later replacement sheets under Rule 66.8(a) or (b) or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report.

(a-bis) Replacement sheets under Rule 46.5(a) shall, unless superseded or considered as reversed by replacement sheets under Rule 66.8(c), be annexed to the report. Replacement sheets under Rule 66.8(c) shall, unless superseded by later replacement sheets under Rule 66.8(c), be annexed to the report. Letters under Rule 46.5(b) or Rule 66.8(a) or (c) shall not be annexed to the report.

(b) Notwithstanding paragraphs (a) and (a-bis), each superseded or reversed replacement sheet referred to in those paragraphs shall also be annexed to the report where the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c). In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

70.17 [No change]

[Annex III follows]

ANNEX III

UNDERSTANDING CONCERNING CRITERIA FOR ANY FUTURE ADDITION
OF FURTHER LANGUAGES OF PUBLICATION UNDER THE PCT

A new language of publication under PCT Rule 48.3 should only be added if all of the following criteria are met:

- (i) the language is accepted for processing by at least one International Searching Authority;
- (ii) the combined number of applications which are first filed in that language (that is, without claiming priority from another application, whether in that language or another) in all Offices which accept that language (including under the PCT) represent at least 2.5% of total first filings worldwide in the most recent year for which statistics are available;
- (iii) adequate machine translation tools are publicly available for translation from that language into at least English, which can be integrated into at least one public database providing free access to international applications freely or at acceptable cost to the database supplier.

[End of Annex III and of document]

WIPO



PCT/A/40/7

ORIGINAL: English

DATE: October 1, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Fortieth (17th Ordinary) Session
Geneva, September 22 to October 1, 2009

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/47/1): 1, 2, 3, 4, 5, 10, 12, 13, 14, 15, 16, 17, 18, 19, 30, 39 and 40.
2. The report on the said items, with the exception of item 30, is contained in the General Report (document A/47/16).
3. The report on item 30 is contained in the present document.
4. Ms. Anne Rejnhold Jørgensen (Denmark) was elected Chair of the Assembly; Mr. Li Yuguang (China) and Mr. Miklós Bendzsel (Hungary) were elected Vice-Chairs.

ITEM 30 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Appointment of the Egyptian Patent Office and the Israel Patent Office as International Searching and Preliminary Examining Authorities under the PCT

5. Discussions were based on documents PCT/A/40/4 and 5.
6. The Chair reported to the Assembly the unanimous positive recommendations given by the Committee for Technical Cooperation as to the requests by the Egyptian Patent Office and the Israel Patent Office for appointment as International Searching and Preliminary Examining Authorities under the PCT (see document PCT/CTC/24/4) and stated that, given those unanimous recommendations, she proposed that the requests for appointment of the Egyptian Patent Office and the Israel Patent Office be dealt with at the same time.
7. The Delegation of the Syrian Arab Republic stated that, although it might seem that the issue at stake was of a technical nature, a political matter of fact imposed itself and should not be disregarded. In view of the existing conflict in the region, continuing occupation by Israel of Arab territories, in addition to the fact that Israel did not enjoy a sound legal status in the region, and the political situation between Israel and countries of the region – particularly the fact that, according to the rules of procedure, Israel was not considered among countries of the region, nor did it belong to that Group – the Delegation considered that it seemed impossible for the Israeli Patent Office to adequately undertake its work or function as an Authority that served the countries of the region. This would result in a burden on the Organization and a failure to provide the expected services. The fact that, as mentioned in the relevant document, the headquarters of the said Office would be Jerusalem, an occupied city subject to numerous UN resolutions, made the issue even more difficult to accept at this stage. The Delegation requested to put on record its objection to the request made by Israel that the Israeli Patent Office be appointed as an International Searching and Preliminary Examining Authority under the PCT, and that the said objection be officially recorded in related documents.
8. The Delegations of Sudan and Algeria aligned themselves with the statement of the Delegation of Syrian Arab Republic.
9. The Delegation of Egypt stated that it wished it to be clear from the record that the reservations expressed by the Delegations of the Syrian Arab Republic, Sudan and Algeria concerned the request for appointment of the Israel Patent Office but not the request for appointment of the Egyptian Patent Office.
10. The Delegation of the United States of America stated that it wished to clarify its understanding that this matter involved two countries' Offices and thus, in its view, should be dealt with as a package, so that there would be no action on the request by one Office if action on the other was still pending, so the action was pending with regard to both Offices.
11. The Delegation of Egypt, referring to the previous appointments of the Offices of Brazil and India as International Authorities, stated that, in its view, there was precedent for requests by several Offices to be taken one by one, Office by Office.
12. The Delegation of Israel stated that, having heard the intervention by the Delegation of Algeria, if there was no agreement on the request to appoint the Israel Patent Office as an International Authority, then there could be no agreement on other matters on the agenda.

13. The Delegation of Australia stated that it supported the approach by the Chair to take the two requests for appointment together, noting that the question whether or not an Office qualified for appointment as an International Authority was a technical question, and that there had been unanimous support for both requests in the Committee for Technical Cooperation.
14. The Delegation of Egypt stated that advice should be sought from the Legal Counsel of WIPO on the question whether the requests by two countries to have their respective Offices appointed as International Authorities were to be decided upon together or separately and independently.
15. In response, the Legal Counsel of WIPO stated that, in the past, requests by different countries to appoint their respective Offices as International Authorities had been considered individually; however, it was up to the Chair of the PCT Assembly and the Assembly itself to decide how it wished to proceed.
16. The Delegation of Egypt stated that, having heard the advice by the Legal Counsel, the Assembly should decide now on its practice as to how to handle this matter, that is, whether requests by countries should be dealt with individually and separately, or in a package.
17. The Delegation of Romania stated that it found it difficult to understand why two countries in similar positions should be treated differently and in this context wished to support the intervention by the Delegation of the United States of America. In addition, noting the technical nature of the decision at hand, it wished to support the statement by the Delegation of Australia.
18. The Delegation of Germany suggested that the meeting be suspended to deal with the matter in an informal way.
19. The Delegation of Canada stated that, noting the unanimous support in the Committee for Technical Cooperation for both requests, the Assembly should approve the appointment of both Offices as International Authorities, while noting the reservations expressed by three countries with regard to the appointment of the Israel Patent Office.
20. Following informal consultations, the Legal Counsel of WIPO clarified that the applications presented by Egypt and Israel for appointment as International Authorities under the PCT were entirely independent and that under established practice they would be considered separately and independently.
21. The Chair summarized the results of the informal consultations, stating that she understood that the Members of the PCT Assembly were in agreement with the following decisions:
 - (i) the Egyptian Patent Office is unanimously appointed as an International Authority under the PCT;
 - (ii) the Israel Patent Office is appointed as an International Authority under the PCT, with reservations expressed by the Delegations from Algeria, Sudan and the Syrian Arab Republic.

22. The Assembly, having heard the representative of the Egyptian Patent Office and taking into account the advice of the PCT Committee for Technical Cooperation:

(i) unanimously appointed the Egyptian Patent Office as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of the required Agreement with the International Bureau until December 31, 2017; and

(ii) approved the text of the draft Agreement between the Egyptian Academy of Scientific Research and Technology and the International Bureau set out in Annex VI to this report.

23. The Assembly, having heard the representative of the Israel Patent Office and taking into account the advice of the PCT Committee for Technical Cooperation, and noting the reservations expressed by the Delegations of Algeria, Sudan and the Syrian Arab Republic:

(i) appointed the Israel Patent Office as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of the required Agreement with the International Bureau until December 31, 2017;

(ii) approved the text of the draft Agreement between the Government of Israel and the International Bureau set out in Annex VII to this report.

PCT Working Group: Report of the Second Session

24. Discussions were based on document PCT/A/40/1.

25. The Delegation of Cuba expressed the importance of undertaking studies on the need, or otherwise, for continuing reform and on identifying the impact of proposals on Contracting States. It stated that nothing in the process should imply substantive harmonization. It was important to allow States to maintain reservations and to take into account the recommendations of the Development Agenda.

26. The Delegation of Sweden, speaking on behalf of the European Community and its Member States, reiterated its strong support for the initiative of the WIPO Secretariat on the future of the PCT. The Delegation welcomed the outcome of the second session of the PCT Working Group and stated that it agreed that the emphasis of the Working Group should be on improvements within the existing legal framework of the Treaty provisions, without limiting the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability, and without seeking substantive patent law harmonization or harmonization of national searching and examination procedures.

27. The Delegation of Norway noted with satisfaction the commitment of the Working Group to continuing work towards making the PCT system more efficient. The Delegation supported further work, as recommended by the Working Group and set out in document PCT/A/40/1. It also strongly supported the initiative of the Director General set out in the document entitled "The Future of the PCT" (document PCT/WG/2/3). It considered that much could be achieved without any changes to the PCT Regulations. The Delegation encouraged Member States to work actively in the Working Group on concrete and necessary steps for making the PCT system more efficient.

28. The Delegation of Brazil emphasized its support for multilateral initiatives designed to enhance the quality of the reports prepared by International Authorities and the non-binding effect of such reports. It made clear that the improvement of the PCT should not in anyway interfere with the national examination phase, and in particular should not minimize the ability of countries to partially or totally reject these international reports. In summary, the Delegation supported the Summary by the Chair in the terms expressed by the Working Group, which provided guidance for future work without reopening any of the topics which would risk compromising the success of the exercise. The Delegation indicated that at the next session of the PCT Working Group it would submit the results of a comprehensive reflection exercise carried out by the Government of Brazil with respect to the objectives of the so called PCT Roadmap (document PCT/WG/2/3).

29. The Delegation of Barbados welcomed the decision of the Working Group to request the Secretariat to carry out further studies on the eligibility criteria for determining the group of developing countries whose applicants should benefit from reduction of certain PCT fees. The Delegation reiterated that any criteria to be established should be equitable and balanced, taking into account the special needs of developing countries, including small, high income, vulnerable economies such as Barbados.

30. The Delegation of the Russian Federation reiterated its support for the work on further developing the PCT system. It considered that improvements to the system should be undertaken in stages and should meet the interests of both users and Patent Offices. Furthermore, the work should neither affect the national legislation of countries nor limit their freedom to apply national criteria for patentability. The Delegation recalled that, at the last session of the Working Group, it had made a statement about a single standard designed to lead to the reduction of costs and duplication of work and increase the quality of the work carried out under the PCT.

31. The Delegation of China expressed its support for the reform of the PCT. The Delegation believed that at the heart of the reform should be improvements in the quality of work of the International Authorities and the provision of additional support to developing countries, rather than altering the existing legislative framework of the PCT. This work should seek to avoid overlap and duplication of work but should not stand in the way of the independence of national authorities.

32. The Delegation of Egypt emphasized that the hallmark of transparency should guide preparations for and the work of the PCT Working Group. The Delegation considered that, in the second session of the Working Group, there had been a lack of transparency. The documents that were communicated had not been properly presented. The Delegation believed that the Working Group at its next session should make use of more transparent mechanisms in its work. Second, as had been emphasized by previous delegations, the exercise should in no way constitute a harmonization of substantive patent law provisions. The issue was to avoid back-door harmonization, and the Delegation of Egypt, along with other like-minded delegations, would pursue that objective. Third, the Delegation emphasized that the work should be carried out in a member-driven process. The Secretariat's assistance was appreciated but the Delegation considered that work on normative issues on the agenda of WIPO was the exclusive domain of Member States and that the process should be conducted accordingly. Finally, the Delegation noted with concern the apparent delinking of development issues and development agenda recommendations from the work of the PCT and of PCT reform. The Delegation noted that there had been reservations as to the introduction of the Development Agenda recommendations and principles into the work of the Working Group. Egypt, as a recently appointed International

Authority, along with other developing country Authorities, placed extreme importance on the issue of development, and believed that the Development Agenda recommendations would make a big contribution in this regard. The Delegation would pursue its vision of PCT reform within the scope of the Development Agenda recommendations.

33. The Delegation of Switzerland associated itself with previous speakers and expressed its support for continuing work on PCT reform, along the lines of the Director General's draft roadmap. The Delegation believed that the Working Group should continue to focus on issues related strictly to that reform so as to achieve specific results as soon as possible because, as had previously been stated during the Assemblies, the PCT system was very important for the whole international patent system and it needed to be strengthened so as to perform better in the future.

34. The Delegation of the Philippines, while acknowledging the need for continuing efforts to improve the working of the PCT system, believed that this should be done within the existing legal framework. The Delegation stood together with other delegations which participated in the second session of the PCT Working Group in expressing the need for further studies which clearly identified the current problems and challenges facing the PCT system, analyzed the causes underlying those problems, outlined possible options to address them, and assessed the impact of the proposed options. More importantly, it joined other delegations in stressing the need for an appropriate process involving broad-based consultations with all stakeholder groups. The studies should focus on the international phase without limiting the freedom of Contracting States to prescribe their own national substantive conditions of patentability. The work should take into account the Development Agenda recommendations, in particular recommendations 15, 17, 20, 21, 22 and 44. The Delegation finally expressed its full engagement with the Assembly and with the Working Group.

35. The Delegation of Australia noted the Summary by the Chair and the Report of the second session of the PCT Working Group and strongly supported the recommendations concerning the further work of that Group. It supported the undertaking of further work in the Working Group on the basis of the reforms outlined in the International Bureau's "Future of the PCT" document. Those reforms would provide practical ways of improving the PCT system without affecting the substantive law of Contracting States. They would make a significant contribution to more effective functioning of the PCT within the existing framework. The Delegation considered it vital that the Contracting States work together to achieve a system that would deliver results which meet the needs of applicants, offices and third parties in all Contracting States.

36. The Delegation of Morocco associated itself with those delegations which had stated that reform of the PCT should focus on improvement of the system within the existing framework and should not address matters of substantive patent law harmonization.

37. The Delegation of Indonesia expressed its support for the proposals in the "Future of the PCT" document for improving the quality of international search and preliminary examination. However, in this regard it emphasized that the work of the PCT Working Group should focus on improvement of the system within the existing framework and should not address matters of substantive patent law harmonization or of unified international patents. It should concentrate on the international phase without limiting the freedom of Contracting States to prescribe and appraise substantive national conditions of patentability. It was emphasized that this flexibility at the national stage was an important factor in the substance of the Treaty.

38. The Delegation of India recognized the need for improvement of the PCT system, through the PCT Working Group, to cope with contemporary challenges. It considered that this initiative went in the right direction but needed considerable deliberation and consensus. The Delegation believed that the Chair's summary appropriately clarified that the whole exercise should in no way limit the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability, and should not seek substantive patent law harmonization or harmonization of national search and examination procedures. The Delegation considered this to be a useful statement which would facilitate the process of consensus building as the Working Group considered the complex issues involved.

39. The Delegation of France recalled the importance which it attached to the PCT system. The system had proved very successful over the years and as a result of this success it had to face new challenges. Consequently, the Delegation emphasized its support for the initiative of the Director General and his proposal to reform the PCT. It approved the roadmap set out document PCT/WG/2/3 and supported further work by the Working Group. The Delegation would work to achieve results that were profitable to all as soon as possible.

40. The Delegation of El Salvador recalled the proposal discussed by the Working Group to reduce or eliminate duplication of work by national Offices so as to increase confidence in the work of Patent Offices. El Salvador's technical experts had been carefully examining the roadmap, which it considered a good starting point for discussions. However, the Delegation counted itself among those who consider that, before making any decision on a reform, more information was needed, particularly for the benefit of recently joined members of the PCT such as El Salvador. The Delegation clarified that it was not opposed to the proposals, but needed to be fully informed before any decision was made. Such information might be made through intersectional meetings or informal meetings or workshops of some type, or in other ways that we would support proper analysis in the PCT Working Group. The Delegation recognized that problems existed for Offices, especially large ones, and expressed its solidarity and support in principle for the roadmap, while reiterating the need for more information. The Delegation confirmed that it had no objections to the reforms which were adopted by the Working Group in May and that it would be in a position to withdraw some of its reservations to other matters at the next session of the Working Group.

41. The Delegation of the United States expressed its appreciation for the efforts of the PCT Working Group and the International Bureau to further improve and refine the PCT. It also generally supported the PCT roadmap. The Delegation urged the International Bureau and the Working Group to continue their work and looked forward to working closely with the members to refine and improve the PCT.

42. The Delegation of the United Kingdom strongly supported reform of the PCT to increase its effectiveness and consequently approved the recommendations concerning further work of the PCT Working Group. The Delegation reported that the United Kingdom government was consulting users concerning PCT reform proposals and hoped to see progress on the Roadmap accelerated.

43. The Delegation of Finland, representing an Office which acted as an International Authority, expressed its full support for the work done by the PCT Working Group. It also supported the initiatives by the Director General to reform the PCT. The Delegation echoed the views of the Delegation of France with regard to the importance of the PCT and its success story, as well as the importance that this success should continue.

44. The Assembly:

(i) noted the Summary by the Chair and the report of the second session of the PCT Working Group contained in documents PCT/WG/2/13 and 14 and reproduced in the Annexes of document PCT/A/40/1; and

(ii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 22 of document PCT/A/40/1.

Proposed Amendments of the PCT Regulations; Proposed Modifications of the Directives of the Assembly Relating to the Establishment of Equivalent Amounts of Certain Fees; Proposed Amendments of PCT Article 16(3) Agreements

45. Discussions were based on document PCT/A/40/2 Rev.

46. In introducing the documents, the Secretariat proposed a number of minor corrections to the spelling and typography of the Rules, Directives and Agreements as proposed to be amended, as well as three minor corrections of a drafting nature to the French versions of the text of PCT Rule 96 and the introduction and paragraph (2) of the Directives as proposed to be amended. The corrected texts are set out in Annex IV of the English version and Annexes I to V of the French version of this report.

47. The Assembly:

(i) adopted the amendments of the Regulations under the PCT set out in Annexes I to III to this report;

(ii) adopted the proposed modifications of the Directives Relating to the Establishment of Equivalent Amounts of Certain Fees set out in Annex IV;

(iii) approved the inclusion in the applicable agreements under PCT Article 16(3) of the provisions set out in Annex V;

(iv) decided that the amendments of Rules 45*bis* and 96 set out in Annex I shall enter into force on July 1, 2010 and shall apply to any international application, regardless of its international filing date, in respect of a supplementary search request under Rule 45*bis*.1(a) made on or after July 1, 2010;

(v) decided that the amendments of Rules 46, 66 and 70 set out in Annex II shall enter into force on July 1, 2010 and shall apply to any international application, regardless of its international filing date, in respect of an amendment of the claims, description or drawings made on or after July 1, 2010;

(vi) decided that the amendments of Rules 15, 16, 16*bis*, 19 and 57 set out in Annex III and the modifications of the Directives of the Assembly Relating to the Establishment of Equivalent Amounts of Certain Fees set out in Annex IV:

(a) shall enter into force on July 1, 2010, and shall apply to the establishment of equivalent amounts which, in accordance with the Regulations and the Directives as in force as of July 1, 2010, are established according to an exchange rate prevailing on, or on a date after, July 1, 2010;

(b) shall not apply to the establishment of equivalent amounts which, in accordance with the Regulations and the Directives as in force prior to July 1, 2010, are established according to an exchange rate prevailing on a date prior to July 1, 2010; in respect of the establishment of such equivalent amounts, the Regulations and the Directives as in force prior to July 1, 2010 shall continue to apply until the new equivalent amounts so established become applicable; and

(vii) recommended that, with regard to the approved inclusion of amended Articles 11(2) and (4) in the applicable agreements under PCT Article 16(3) between the International Bureau and Offices in relation to their functioning as International Searching and Preliminary Examining Authorities set out in Annex V, with effect from a date to be agreed upon by each Authority and the Director General, such amendments should be made to the applicable agreements and should, where possible, become effective on July 1, 2010.

Quality Management Systems for PCT International Authorities

48. Discussions were based on document PCT/A/40/3.

49. The Assembly noted the content of document PCT/A/40/3.

Proposal for a Loan to the Hague Union

50. Discussions were based on document PCT/A/40/6.

51. The Assembly granted a loan of 3 million Swiss francs from the PCT Union Reserve Fund to the Hague Union, to be reimbursed by the Hague Union to the PCT Union as soon as the level of reserves of the Hague Union Reserve Fund so allowed.

Other matters

52. The Secretariat informed the Assembly of the deposit of the instrument of accession to the PCT by Thailand on September 24, 2009, and welcomed Thailand, which would become bound by the PCT on December 24, 2009, as its 142nd Contracting State.

[Annexes follow]

ANNEX I

AMENDMENTS OF THE PCT REGULATIONS
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¹ The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 45bis
Supplementary International Searches

45bis.1 Supplementary Search Request

(a) to (c) [No change]

(d) Where the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the supplementary search request may contain an indication of the wish of the applicant to restrict the supplementary international search to one of the inventions as identified by the International Searching Authority other than the main invention referred to in Article 17(3)(a).

(e) [No change]

45bis.2 Supplementary Search Handling Fee

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or is considered not to have been submitted under Rule 45bis.1(e).

45bis.3 Supplementary Search Fee

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or is considered not to have been submitted under Rules 45bis.1(e) or 45bis.4(d).

(e) The Authority specified for supplementary search shall, to the extent and under the conditions provided for in the applicable agreement under Article 16(3)(b), refund the supplementary search fee if, before it has started the supplementary international search in accordance with Rule 45bis.5(a), the supplementary search request is considered not to have been submitted under Rule 45bis.5(g).

45bis.4 Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to Authority Specified for Supplementary Search

(a) to (f) [No change]

45bis.5 Start, Basis and Scope of Supplementary International Search

(a) [No change]

(b) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation referred to in Rule 45bis.1(b)(iii) or 45bis.1(c)(i), taking due account of the international search report and the written opinion established under Rule 43bis.1 where they are available to the Authority specified for supplementary search before it starts the search. Where the supplementary search request contains an indication under Rule 45bis.1(d), the supplementary international search may be restricted to the invention specified by the applicant under Rule 45bis.1(d) and those parts of the international application which relate to that invention.

(c) to (f) [No change]

(g) If the Authority specified for supplementary search finds that carrying out the search is entirely excluded by a limitation or condition referred to in Rule 45bis.9(a), other than a limitation under Article 17(2) as applicable by virtue of Rule 45bis.5(c), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

(h) The Authority specified for supplementary search may, in accordance with a limitation or condition referred to in Rule 45bis.9(a), decide to restrict the search to certain claims only, in which case the supplementary international search report shall so indicate.

45bis.6 Unity of Invention

(a) to (e) [No change]

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* where the Authority specified for supplementary search decides to restrict the supplementary international search in accordance with the second sentence of Rule 45bis.5(b) or with Rule 45bis.5(h), provided that any reference in the said paragraphs to the “international application” shall be construed as a reference to those parts of the international application which relate to the invention specified by the applicant under Rule 45bis.1(d) or which relate to the claims and those parts of the international application for which the Authority will carry out a supplementary international search, respectively.

45bis.7 and 45bis.8 [No change]

45bis.9 International Searching Authorities Competent to Carry Out Supplementary International Search

(a) and (b) [No change]

(c) The limitations referred to in paragraph (a) may, for example, include limitations as to the subject matter for which supplementary international searches will be carried out, other than limitations under Article 17(2) as applicable by virtue of Rule 45bis.5(c), limitations as to the total number of supplementary international searches which will be carried out in a given period, and limitations to the effect that the supplementary international searches will not extend to any claim beyond a certain number of claims.

Rule 96
The Schedule of Fees

96.1 *Schedule of Fees Annexed to Regulations*

The amounts of the fees referred to in Rules 15, 45*bis*.2 and 57 shall be expressed in Swiss currency. They shall be specified in the Schedule of Fees which is annexed to these Regulations and forms an integral part thereof.

[Annex II follows]

ANNEX II

AMENDMENTS OF THE PCT REGULATIONS
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¹ The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 46
Amendment of Claims before the International Bureau

46.1 to 46.4 [No change]

46.5 *Form of Amendments*

(a) [No change]

(b) The replacement sheet or sheets shall be accompanied by a letter which:

(i) [no change]

(ii) shall identify the claims originally filed which, on account of the amendments, are cancelled;

(iii) shall indicate the basis for the amendments in the application as filed.

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 to 66.7 [No change]

66.8 *Form of Amendments*

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets, shall indicate the basis for the amendment in the application as filed and shall preferably also explain the reasons for the amendment.

(b) and (c) [No change]

66.9 [No change]

Rule 70
International Preliminary Report on Patentability
by the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 [No change]

70.2 *Basis of the Report*

(a) to (c) [No change]

(c-bis) If the claims, description or drawings have been amended but the replacement sheet or sheets were not accompanied by a letter indicating the basis for the amendment in the application as filed, as required under Rule 46.5(b)(iii) as applicable by virtue of Rule 66.8(c), or Rule 66.8(a), as applicable, the report may be established as if the amendment had not been made, in which case the report shall so indicate.

(d) and (e) [No change]

70.3 to 70.17 [No change]

[Annex III follows]

ANNEX III

AMENDMENTS OF THE PCT REGULATIONS
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¹ The Table of Contents is included for convenience; it does not form part of the amendments.

Rule 15
The International Filing Fee

15.1 [No change]

15.2 *Amount*

(a) [No change]

(b) The international filing fee shall be payable in the currency or one of the currencies prescribed by the receiving Office (“prescribed currency”).

(c) Where the prescribed currency is the Swiss franc, the receiving Office shall promptly transfer the said fee to the International Bureau in Swiss francs.

(d) Where the prescribed currency is a currency other than the Swiss franc and that currency:

(i) is freely convertible into Swiss francs, the Director General shall establish, for each receiving Office which prescribes such a currency for the payment of the international filing fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the receiving Office to the International Bureau;

(ii) is not freely convertible into Swiss francs, the receiving Office shall be responsible for the conversion of the international filing fee from the prescribed currency into Swiss francs and shall promptly transfer that fee in Swiss francs, in the amount set out in the Schedule of Fees, to the International Bureau. Alternatively, if the receiving Office so wishes, it may convert the international filing fee from the prescribed currency into euros or US dollars and promptly transfer the equivalent amount of that fee in euros or US dollars, as established by the Director General according to directives given by the Assembly as referred to in item (i), to the International Bureau.

15.3 *Time Limit for Payment; Amount Payable*

The international filing fee shall be paid to the receiving Office within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

15.4 *Refund*

[Text of existing Rule 15.6, renumbered as Rule 15.4]

Rule 16
The Search Fee

16.1 *Right to Ask for a Fee*

(a) [No change]

(b) The search fee shall be collected by the receiving Office. The said fee shall be payable in the currency prescribed by that Office (“prescribed currency”).

(c) Where the prescribed currency is the currency in which the International Searching Authority has fixed the said fee (“fixed currency”), the receiving Office shall promptly transfer the said fee to that Authority in that currency.

(d) Where the prescribed currency is not the fixed currency and that currency:

(i) is freely convertible into the fixed currency, the Director General shall establish, for each receiving Office which prescribes such a currency for the payment of the search fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the receiving Office to the International Searching Authority;

(ii) is not freely convertible into the fixed currency, the receiving Office shall be responsible for the conversion of the search fee from the prescribed currency into the fixed currency and shall promptly transfer that fee in the fixed currency, in the amount fixed by the International Searching Authority, to the International Searching Authority.

(e) Where, in respect of the payment of the search fee in a prescribed currency, other than the fixed currency, the amount actually received under paragraph (d)(i) of this Rule by the International Searching Authority in the prescribed currency is, when converted by it into the fixed currency, less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

(f) As to the time limit for payment of the search fee and the amount payable, the provisions of Rule 15.3 relating to the international filing fee shall apply *mutatis mutandis*.

16.2 and 16.3 [No change]

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), 15.3 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.

(b) and (c) [No change]

(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), 15.3 or 16.1(f), as the case may be.

(e) [No change]

16bis.2 [No change]

Rule 19
The Competent Receiving Office

19.1 to 19.3 [No change]

19.4 *Transmittal to the International Bureau as Receiving Office*

(a) and (b) [No change]

(c) For the purposes of Rules 14.1(c), 15.3 and 16.1(f), where the international application was transmitted to the International Bureau under paragraph (b), the date of receipt of the international application shall be considered to be the date on which the international application was actually received by the International Bureau. For the purposes of this paragraph, the last sentence of paragraph (b) shall not apply.

Rule 57
The Handling Fee

57.1 [No change]

57.2 *Amount*

(a) [No change]

(b) The handling fee shall be payable in the currency or one of the currencies prescribed by the International Preliminary Examining Authority ("prescribed currency").

(c) Where the prescribed currency is the Swiss franc, the Authority shall promptly transfer the said fee to the International Bureau in Swiss francs.

(d) Where the prescribed currency is a currency other than the Swiss franc and that currency:

(i) is freely convertible into Swiss francs, the Director General shall establish, for each Authority which prescribes such a currency for the payment of the handling fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the Authority to the International Bureau;

(ii) is not freely convertible into Swiss francs, the Authority shall be responsible for the conversion of the handling fee from the prescribed currency into Swiss francs and shall promptly transfer that fee in Swiss francs, in the amount set out in the Schedule of Fees, to the International Bureau. Alternatively, if the Authority so wishes, it may convert the handling fee from the prescribed currency into euros or US dollars and promptly transfer the equivalent amount of that fee in euros or US dollars, as established by the Director General according to directives given by the Assembly as referred to in item (i), to the International Bureau.

57.3 [No change]

57.4 *Refund*

[Text of existing Rule 57.6, renumbered as Rule 57.4]

[Annex IV follows]

ANNEX IV

DIRECTIVES OF THE ASSEMBLY RELATING TO
THE ESTABLISHMENT OF EQUIVALENT AMOUNTS OF CERTAIN FEES

The Assembly establishes in the following terms the directives relating to the establishment of equivalent amounts of the international filing fee, the handling fee, the search fee and the supplementary search fee (see Rules 15.2(d)(i), 16.1(d)(i), 45bis.3(b) and 57.2(d)(i)), it being understood that, in the light of experience, the Assembly may at any time modify these directives:

Establishment of Equivalent Amounts

(1) The equivalent amounts of the international filing fee and the handling fee in any currency other than Swiss franc, and of the search fee and the supplementary search fee in any currency other than the fixed currency, shall be established by the Director General, in the case of:

- (i) the international filing fee, after consultation with each receiving Office which prescribes payment of that fee in such currency;
- (ii) the search fee, after consultation with each receiving Office which prescribes payment of that fee in such currency;
- (iii) the handling fee, after consultation with each International Preliminary Examining Authority which prescribes payment of that fee in such currency.

In the case of the international filing fee, the search fee and the handling fee, the equivalent amounts shall be established according to the exchange rates prevailing on the day preceding the day on which the consultations are initiated by the Director General. In the case of the supplementary search fee, the equivalent amounts shall be established according to the exchange rates prevailing on the day on which the Director General receives the notification of the amount of the supplementary search fee or prevailing on the day two months prior to the entry into force of the supplementary search fee, whichever is the later.

- (2) The amounts so established shall be the equivalent, in round figures,
- (i) of the amount of the international filing fee and of the handling fee, respectively, in Swiss franc set out in the Schedule of Fees;
 - (ii) of the amount of the search fee and the supplementary search fee (if applicable) established by the International Searching Authority in the fixed currency.

[Directives, paragraph (2), continued]

They shall be notified by the International Bureau to each receiving Office, International Searching Authority and International Preliminary Examining Authority, as applicable, prescribing payment or establishing fees in the currency concerned and shall be published in the Gazette.

Establishment of New Equivalent Amounts Consequential on Changes in the Amount of the Fee Concerned

(3) Paragraphs (1) and (2) shall apply *mutatis mutandis* where the amount of the international filing fee, the handling fee, the search fee or the supplementary search fee is changed. The new equivalent amounts in the prescribed currencies shall be applied from the same date as the changed amount of the international filing fee or of the handling fee set out in the amended Schedule of Fees, or from the same date as the changed amount of the search fee or the supplementary search fee in the fixed currency.

Establishment of New Equivalent Amounts Consequential on Changes in Exchange Rates

(4) In the month of October of each year, the Director General shall, where applicable, after consultations with the Offices or Authorities referred to in paragraph (1), establish new equivalent amounts of the international filing fee, the handling fee, the search fee and the supplementary search fee according to the exchange rates prevailing on the first Monday in the month of October. Unless otherwise decided by the Director General, any adjustment under this paragraph shall enter into force on the first day of the subsequent calendar year.

(5) Where, for more than four consecutive Fridays (midday, Geneva time), the exchange rate between Swiss franc (in the case of the international filing fee and the handling fee) or the fixed currency (in the case of the search fee and the supplementary search fee) and any applicable prescribed currency is by at least 5% higher, or by at least 5% lower, than the last exchange rate applied, the Director General shall, where applicable, after consultations with the Offices or Authorities referred to in paragraph (1), establish new equivalent amounts of the international filing fee, the search fee, the supplementary search fee and/or the handling fee, as applicable, according to the exchange rate prevailing on the first Monday following the expiration of the period referred to in the first sentence of this paragraph. The newly established amount shall become applicable two months after the date of its publication in the Gazette, provided that the receiving Offices or the International Preliminary Examining Authorities concerned, as applicable, and the Director General may agree on a date falling during the said two-month period, in which case the said amount shall become applicable from that date.

[Annex V follows]

ANNEX V

ARTICLE 11 OF THE AGREEMENTS UNDER PCT ARTICLE 16(3)
BETWEEN THE INTERNATIONAL BUREAU AND OFFICES
IN RELATION TO THEIR FUNCTIONING AS INTERNATIONAL SEARCHING
AND PRELIMINARY EXAMINING AUTHORITIES

Article 11
Amendment

(1) [No change]

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; and, notwithstanding paragraph (4), they shall take effect on the date agreed upon by them.

(3) [No change]

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any change in the currency or amount of fees or charges contained in Annex C, for any addition of new fees or charges, and for any change in the conditions for and the extent of refunds or reductions of fees contained in Annex C, that date is at least two months later than the date on which the notification is received by the International Bureau.

[Annex VI follows]

ANNEX VI

DRAFT AGREEMENT

between the Egyptian Academy of Scientific Research and Technology
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Egyptian Patent Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Egyptian Academy of Scientific Research and Technology and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Egyptian Patent Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Egyptian Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on a date to be notified to the Director General of the World Intellectual Property Organization by the Authority, that date being at least one month later than the date on which the notification is made.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; and, notwithstanding paragraph (4), they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any change in the currency or amount of fees or charges contained in Annex C, for any addition of new fees or charges, and for any change in the conditions for and the extent of refunds or reductions of fees contained in Annex C, that date is at least two months later than the date on which the notification is received by the International Bureau.

Article 12
Termination

- (1) This Agreement shall terminate before December 31, 2017:
- (i) if the Egyptian Academy of Scientific Research and Technology gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
 - (ii) if the Director General of the World Intellectual Property Organization gives the Egyptian Academy of Scientific Research and Technology written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the Arabic and English languages, each text being equally authentic.

For the Egyptian Academy of Scientific
Research and Technology by:

[...]

For the International Bureau by:

[...]

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:
Any African, Asian and/or Arab Contracting State;
- (ii) the following languages which it will accept:
 - (a) Arabic or English for international applications filed with the receiving Office of, or acting for any member of the League of Arab States;
 - (b) Arabic for international applications filed with any other receiving Office.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined in Egyptian national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Egyptian pounds)</i>
Search fee (Rule 16.1(a))	...
Additional fee (Rule 40.2(a))	...
Preliminary examination fee (Rule 58.1(b))	...
Additional fee (Rule 68.3(a))	...
Late payment fee for preliminary examination	[amount as set out in Rule 58bis]
Protest fee (Rules 40.2(e) and 68.3(e))	...
Late furnishing fee (Rules 13ter.1(c) and 13ter.2)	...
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	...

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search taken into account in accordance with Rule 4.12, [50%] of the search fee paid shall be refunded [upon request by the applicant].

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Arabic, English.

[Annex VII follows]

ANNEX VII

DRAFT AGREEMENT

between the Government of Israel
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Israel Patent Office
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Government of Israel and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Israel Patent Office as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Hereby agree as follows:

Article 1
Terms and Expressions

- (1) For the purposes of this Agreement:
 - (a) “Treaty” means the Patent Cooperation Treaty;
 - (b) “Regulations” means the Regulations under the Treaty;
 - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
 - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) “Rule” means a Rule of the Regulations;
 - (f) “Contracting State” means a State party to the Treaty;
 - (g) “the Authority” means the Israel Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization.

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2
Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3
Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State specified in Annex A to this Agreement, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

Article 4
Subject Matter Not Required to Be Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) A schedule of all fees of the Authority, and all other charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search (Rules 16.3 and 41.1);
- (ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6
Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7
Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9
Entry into Force

This Agreement shall enter into force on a date to be notified to the Director General of the World Intellectual Property Organization by the Authority, that date being at least one month later than the date on which the notification is made.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, start negotiations for its renewal.

Article 11
Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; and, notwithstanding paragraph (4), they shall take effect on the date agreed upon by them.

(3) The Authority may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any change in the currency or amount of fees or charges contained in Annex C, for any addition of new fees or charges, and for any change in the conditions for and the extent of refunds or reductions of fees contained in Annex C, that date is at least two months later than the date on which the notification is received by the International Bureau.

Article 12
Termination

- (1) This Agreement shall terminate before December 31, 2017:
- (i) if the Government of Israel gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
 - (ii) if the Director General of the World Intellectual Property Organization gives the Government of Israel written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, which corresponds to *[date]* of the Jewish year *[.....]*, in two originals in the English and Hebrew languages, each text being equally authentic.

For the Government of Israel by:

For the International Bureau by:

[...]

[...]

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following State for which it will act:
Israel;
- (ii) the following language which it will accept:
English.

Annex B
Subject Matter Not Excluded from Search or Examination

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

subject matter which is searched or examined in Israeli national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Israeli new sheqel)</i>
Search fee (Rule 16.1(a))	...
Additional fee (Rule 40.2(a))	...
Preliminary examination fee (Rule 58.1(b))	...
Additional fee (Rule 68.3(a))	...
Late payment fee for preliminary examination	[amount as set out in Rule 58bis]
Protest fee (Rules 40.2(e) and 68.3(e))	...
Late furnishing fee (Rules 13ter.1(c) and 13ter.2)	...
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2), per page	...

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search taken into account in accordance with Rule 4.12, [50%] of the search fee paid shall be refunded [upon request by the applicant].

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following language:

English.

[End of Annex VII and of document]

International Patent Cooperation Union (PCT Union)

Assembly

Forty-First (24th Extraordinary) Session Geneva, September 20 to 29, 2010

REPORT

prepared by the International Bureau

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/48/1): 1, 3 to 6, 9 to 13, 15 to 17, 19 to 21, 30, 38 and 39.
2. The report on the said items, with the exception of item 30, is contained in the General Report (document A/48/26).
3. The report on item 30 is contained in the present document.
4. The meeting of the Assembly was presided over by Ms. Anne Rejnhold Jørgensen (Denmark), Chair of the PCT Assembly.

ITEM 30 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

PCT Working Group: Report of the Third Session

5. Discussions were based on document PCT/A/41/1 Rev.
6. In introducing document PCT/A/41/1 Rev., Deputy Director General Pooley stated that, of the great variety of issues discussed by the Working Group at its third session, he wished to particularly highlight the discussions in the Working Group on the study "The Need to Improve the Functioning of the PCT System". That study had been prepared by the Secretariat following agreement by the Working Group at its second session in May 2009 that efforts should continue on improving the PCT, noting that the system could and should function more effectively on behalf of all stakeholders, within the existing legal framework, without limiting the freedom of Contracting States to control substantive patent law issues as well as national search and examination procedures, and that further dialog should be informed by an in-depth study to be prepared by the International Bureau on how the PCT was measuring up to its stated aims.
7. Based on the study prepared by the Secretariat, and following an intensive debate characterized by a constructive spirit of cooperation and compromise, the Working Group had unanimously endorsed a set of recommendations as to the further work aimed at improving the PCT. Those recommendations included measures to help reduce the unsustainable backlogs of some 4.2 million unprocessed patent applications around the world and improve the quality of granted patents. The patent Offices of PCT Member States would play a key role in implementing many of these recommendations.
8. The Working Group had endorsed a number of practical steps to be undertaken by WIPO in close cooperation with Member States for implementation in the near future. These included the deployment of computer systems that would allow third parties to alert patent Offices about information which they believed showed that a patent application did not meet the conditions of patentability. Other electronic systems to be developed would support technology transfer by promoting the licensing of inventions and by helping to identify information about technologies which were in the public domain.
9. The Working Group had also commissioned a series of studies to assess how successful the PCT system had been in disseminating technical information, in facilitating access to technology and in providing technical assistance for developing countries. These studies would include recommendations on ways to boost the PCT's performance in these areas and would also explore the possibility of extra-budgetary funding arrangements to finance technical assistance projects.
10. Deputy Director General Pooley further stated that the recommendations were an important step towards improving the operation of the international patent system for the benefit of all WIPO Member States.
11. Other issues considered by the Working Group included revised proposals concerning the "Eligibility Criteria for Reductions in Certain PCT Fees". Unfortunately, the Working Group had not been able to reach a consensus. The Secretariat would thus further consider the issue with a view to finding alternative solutions which could be agreed upon by all Member States, pending which the *status quo* would remain.
12. The Delegation of El Salvador expressed its support for the Member States' efforts towards optimizing the work of international and national Offices. The Delegation considered that this work should take place constructively in a way supported by Member States so that the desired results could be achieved. In order to do that, WIPO should intensify the process of consultation and schedule workshops and information seminars for

officials responsible for administering the Treaty. With regard to the languages policy, the Delegation reiterated the request which had been made by both the Delegation of El Salvador and the Group of Latin American and Caribbean Countries in the Working Group and in the Program and Budget Committee that an assessment be made of the introduction of Spanish as a working language in the PCT Working Group.

13. The Delegation of Egypt thanked the Director General for the support which had been provided to the Egyptian Patent Office by the International Bureau. Egypt, as an International Authority under the PCT, had taken certain steps to ensure that it could fulfill that role and had been very much involved in quality control since 2008. The Delegation noted that there were proposals to make certain amendments to the PCT in order to allow it to provide increased benefits to developing countries, particularly with respect to technology transfer. The studies that had been undertaken needed to be followed up with more studies and more research in order to allow the national Offices to work on the basis of the results that were obtained. The Egyptian Patent Office had already begun to undertake the kind of review that was required internationally, but to go further, Egypt needed to be able to count on appropriate support from WIPO. A number of meetings had been held on quality issues, intending to ensure that national Offices reached the required level of quality. The Meeting of International Authorities held recently in Brazil had been very useful indeed. The Delegation invited all participants to bear this in mind and to assist Egypt as it sought to apply the quality framework of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines.
14. The Delegation of Egypt further expressed the view that additional steps were required in order to ensure that Egypt could properly process patent applications under the PCT system within its national Office. The Delegation believed that the Office was on the right track but needed further work to move ahead. The Delegation was pleased with the recommendations adopted at the third session of the PCT Working Group, especially those which called on the International Bureau to undertake a study into the implementation of Article 51 of the PCT setting up a committee to look at technical assistance issues.
15. The Delegation of Iran stated that it was convinced that there were several possibilities to improve the functionality of the PCT system, within its legal framework, for the benefit of applicants, Offices and third parties in all Contracting States, without limiting the policy space for IP Offices in determining substantive conditions of patentability. Certainly, IP Offices, in examining the patentability of a claim, could consider international reports as a subsidiary and complementary means for their examination, taking into account their national patent laws and executive procedures. There was not, however, any legal obligation for the countries to accept these reports. The Delegation of Iran further stated that it also believed that any reform of the PCT system should amplify the basic aims of the Treaty, which were in the field of procedures for obtaining legal protection for inventions and in the field of the dissemination of technical information and organization of technical assistance, particularly for developing countries. Moreover, since the PCT was a procedural Treaty, the result of its reform should be confined to procedural matters and should not lead to the harmonization of national search and examination procedures.
16. The Delegation welcomed the proposal and recommendations put forward in the PCT Working Group to improve the functionality of the system. In this context, establishment of a third-party observation system could improve the accuracy and efficiency of international reports. It also had taken note of the study of the Secretariat presented to the PCT Working Group which stated that, over the past years, the PCT system had been constantly improved, notably from the viewpoint of applicants. The issue of dissemination of technical information, which linked to important issues for developing countries, should be more elaborated in the future process. In this context, it was important to emphasize that the PCT was intended to encourage technology transfer by a variety of means, and that many stakeholders had benefited from the system. Nevertheless, in several instances, there had been challenges, particularly on access to technologies to be used

freely by developing countries, without seeking a license. A practical solution for encountering these challenges should be elaborated in the course of improving the functionality of the PCT system.

17. The Delegation of Iran further stated that it wished to encourage the International Bureau to increase its activities in the field of capacity building for IP offices, by devoting more related resources in this respect. Moreover, for the success of the system, it was imperative to explore practical and affordable ways for national Offices to develop their online searching capabilities and access to effective search systems.
18. The Delegation stated that offering realistic reductions to developing countries in the fees required for the filing of international applications would encourage wider use of the PCT system by these countries; this would not contradict the interests of developed countries but encourage nationals of developing countries to further participate and contribute to the development of technology and related activities and consequently to the improvement of the world economy, from which ultimately all countries would benefit.
19. The Delegation of South Africa stated that it supported the deliberations towards the improvement of the PCT system in a balanced and objective manner. The Delegation welcomed the principles entrenched at the last session of the Working Group, namely, the work for the improvement of the PCT, following an incremental and member-driven approach, within the legal framework of the existing Treaty, which was procedural in nature and did not limit the freedom of the Contracting States regarding substantive patent law issues. The Delegation also highly appreciated the facilitative role of the WIPO Secretariat in preparing the working documents and carrying out the consultative process for the PCT Working Group. The Delegation emphasized that mainstreaming the Development Agenda and addressing the development concerns in all aspects of the work related to improving the PCT was important to it.
20. The Delegation of South Africa expressed the view that there already was a positive example of synergy between the work to improve the PCT and the Development Agenda. The Delegation wished to thank the Director General and the PCT Sector of WIPO for the prompt response to its request for capacity building and awareness seminars, which would take place at the end of October 2010 at a number of South African universities and in the South African Patent Office. The Delegation pointed out that, in fact, cooperation activities between the PCT Sector of WIPO and the Companies and Intellectual Property Registration Office of South Africa had been going on for a number of years. Outreach activities had been organized in various universities with the objective of encouraging universities to utilize the international patent system, including the PCT, to stimulate technology transfer and to obtain commercial returns from research. The Delegation stated that it was now able to add more value by aligning the program to the strategic objectives of the PCT system and the strategic goals under the WIPO Medium Term Strategic Plan.
21. The Delegation of Sweden stated that the Swedish Patent and Registration Office, being one of the International Authorities under the PCT, wished to congratulate the PCT Working Group for endorsing the recommendations drawn from the study "The Need for Improving the Functioning of the PCT System". The Delegation further stated that it wished to again reiterate its support for the ongoing work and its willingness to collaborate in this important work to develop the PCT system.
22. The Delegation of Brazil stated that it had participated actively in the discussions of the PCT Working Group and thus limited itself to a short statement. It wished to reiterate Brazil's interest in the improvement of the functioning of the PCT system, which could contribute to raising the quality of patent examinations in all jurisdictions, within the limits of national legislation. Progress made in the PCT Working Group showed that members

were finding a way forward in a subject not free of divisive issues. Key to the good disposition prevailing in this process was the member-driven nature of the discussions in the Working Group.

23. The Delegation of Barbados wished to place on record its thanks to the International Bureau for its efforts to arrive at criteria for determining which countries should be entitled to benefit from PCT fee reductions. It stated that it wished to reiterate that the criteria which were to be developed had to be fair and balanced, taking into account the special circumstances that existed in certain developing countries.
24. The Delegation of Trinidad and Tobago stated that the PCT continued to be a very important mechanism for Trinidad and Tobago as it continued to benefit from the utilization of the PCT system. In 2009, 97% of all patent applications arrived through the PCT route. Recognizing the flourishing rate of PCT filing of patent applications, Trinidad and Tobago willingly welcomed any positive alteration to the PCT system from which the operations of the Intellectual Property Office would benefit. It had noted the great enthusiasm PCT Contracting States had exhibited in continuing to propose enhancements to the PCT system and stated that it would like to encourage the International Bureau to continue in its quest to improve the PCT System so that all stakeholders benefitted.
25. The Delegation of Trinidad and Tobago further stated that it believed that whatever modifications were sought to improve the functioning of the PCT, they had to take into account the needs of developing countries, particularly those with smaller technical capacities. It therefore requested that ample consideration be given to the circumstances under which the smaller IP Offices operated, so that, when new systems were developed, it was ensured that all Offices could benefit from their use.
26. Even though the numbers of nationals making use of the PCT system was minimal, the Trinidad and Tobago Intellectual Property Office had promoted the system to facilitate PCT filings. Additionally, the Trinidad and Tobago Intellectual Property Office had actively embarked on public awareness programs to encourage the citizens of Trinidad and Tobago to make use of the PCT system. Further encouragement would, of course, come from the continuation of the 90% discount on international filing fees that applicants from Trinidad and Tobago currently enjoyed. Further confidence would come once Member States had arrived at consensus to retain and extend discounted fees. The Delegation noted that it appreciated the strenuous and well thought-out contributions to the discussions on the eligibility criteria for fee reductions by the Delegation from Barbados and stated that it supported the positions put forward by that Delegation. Trinidad and Tobago would continue to make use of the PCT system and endorsed whatever changes would be required for the future further development of the system.
27. The Delegation of Switzerland, speaking on behalf of Group B, stated that the global IP services that WIPO provided to Member States, in particular the registration system for patents, were of paramount importance to all stakeholders. Group B commended the performance of these systems but, at the same time, questioned how the system could do better for the users on the ground. If it did not keep pace with technological and business evolution, there was the risk of not only disappointing existing users but also of losing opportunities to grow. The increase in demand on WIPO's capacity meant that it was important that all worked together in identifying how to improve service delivery, since it was WIPO's services, in particular the PCT, that generated around 90% of its revenue. The continued enhancement of such services and their quality in a cost effective manner had always been and would remain a major strategic goal that WIPO members fully supported.
28. The Delegation further stated that, in this regard, the confirmation of the support by WIPO's Member States for the PCT roadmap during the last session of the PCT Working Group was very promising for the further development of the PCT system. It was of fundamental importance to ensure that the PCT was able to continue to deliver results

which met the needs of applicants, Offices and third parties. This would enable the PCT to remain effective and attractive in the future and retain the central place that it had in the international patent framework and the financing of WIPO. Group B members were therefore looking forward to continuing to progress the work at the next session of the PCT Working Group.

29. The Delegation concluded by expressing the view that, besides the functioning of the PCT system itself, there had also been an interesting exchange of views during the last session of the Working Group on the need to coordinate with other development activities and, in particular, the need to review the technical assistance activities provided so far in connection with the PCT. Due to the importance of WIPO members having the capacity to properly use and benefit from the PCT system, Group B members were interested in interacting with other WIPO members - within currently existing WIPO Committees - in order to better understand their current needs and to see how to better allocate available resources for technical assistance. In this regard, the Delegation recalled the specific technical assistance proposals presented by the African Group during the last session of the PCT Working Group.
30. The Delegation of China welcomed the fact that the PCT Working Group had made significant progress and reached consensus on a set of recommendations on how to improve the PCT system, and welcomed the fact that the Member States of the PCT had made such great efforts to reach that consensus. It expressed the view that the improvements to the PCT system should be done within its current legal framework, and that improvements should be gradual, pragmatic and coherent to ensure that the PCT system could adopt its role as a patent application system at a global level. The Delegation further stated that it believed that the PCT system should provide better services for its users, and that the evolution of the system should also take into account the needs of users from developing countries. The Delegation concluded by stating that it would continue to actively support the improvement of the PCT system.
31. The Delegation of Egypt, speaking on behalf of the Development Agenda Group, stated that the Development Agenda Group believed that the adoption of the WIPO Development Agenda contributed to challenging the universal applicability of "one size fits all" IP protection models or the advisability of the harmonization of laws leading to higher protection standards in all countries, irrespective of the level of development. In this regard, the PCT Member States had an interest in the reform and the improvement of the functioning of the PCT system. The Development Agenda Group was avidly interested in the ongoing discussions in the PCT Working Group and favored deepening the analysis and continuing the debate on the reform of the PCT, within the parameters agreed during previous sessions of the PCT Working Group. In addition to the above mentioned principle, the Development Agenda Group underlined the need to ensure that the reform of the PCT system did not entail any harmonization of patent law in substance or in practice, as stipulated in Article 27(5) of the PCT.
32. The Delegation wished to thank the Secretariat for the study that had been prepared for the third session of the PCT Working Group entitled "The Need for Improving the Functioning of the PCT System" (document PCT/WG/3/2). It believed that this study was a good basis for discussion on the issue of the reform of the PCT. The study pointed to problems in the processing of applications, where an increasing number of applications on the one hand and inadequate manpower capacity in Offices on the other, had led to unsustainable backlogs and the increased possibility of the grant of invalid patents. This was an issue of concern. It noted, however, that while improving the quality of international reports addressed partly the supply side by dealing with the problems of backlogs, the causal problems leading to the backlogs on the demand side also needed to be addressed in order to come up with sustainable long-term solutions. The reasons behind the flood of patent applications, which seemed to far exceed the level of actual innovation in the world, needed to be addressed. It needed to be recognized that an

effective, long-term and sustainable resolution of the problems of backlogs and quality would require augmenting the capacity of Offices to conduct search and examination as comprehensive as possible for every application in a timely manner. This would require enhanced support for Offices, especially in developing countries, which had to be provided in accordance with the provisions of PCT and the recommendations of the Development Agenda.

33. The Delegation further stated that PCT Article 51 called for the setting up of a Committee for Technical Assistance, which had not been established so far. It believed that it should be set up now so as to enable the Secretariat to look at technical assistance requirements comprehensively and address them in a focused manner. With regard to the outcome of the third session of the PCT Working Group on the study proposals, the Delegation supported the recommendations as adopted in the report of the session. It particularly supported the introduction of a new recommendation introduced as paragraph 149*bis* that a follow-up study be conducted by the International Bureau, which should involve WIPO's Chief Economist, to analyze the root causes behind the surge of patent applications and the consequent heavy load on the international patent system. It also fully supported the introduction of another new recommendation included in paragraph 204*bis* that a study be conducted by the International Bureau to look into the issue of coordination of technical assistance for developing countries, as envisaged in PCT Article 51, in a focused manner and guided by the Development Agenda recommendations, and to make recommendations on terms of reference for the possible establishment of the Committee for Technical Assistance. This study would be presented for decision to the 4th session of the Working Group. The study should also identify and assess existing agreements with relevant international financing organizations and intergovernmental organizations for financing of technical assistance projects under PCT Article 51(4) and make recommendations regarding the possibility of seeking further such agreements. The Delegation looked forward to the studies by the Chief Economist as well as the study on the coordination of technical assistance envisaged in PCT Article 51. It also looked forward to the terms of reference to be prepared by the Secretariat for the possible establishment of the Committee for Technical Assistance. In concluding, the Delegation stated that it looked forward to a positive outcome during the forthcoming session of the PCT Working Group.
34. The Delegation of Japan stated that it supported the statement made by Switzerland on behalf of Group B. It further wished to compliment the initiative by Director General Gurry and Deputy Director General Pooley and their team. It welcomed the recommendations on how to improve the PCT system which had been approved by the PCT Working Group at its meeting in June 2010. Noting that the PCT was one of the core pillars of WIPO's international IP systems, the Delegation wished to express its full support for the recommendations and related activities aimed at providing better services for PCT Member States as well as users.
35. The Delegation of Algeria stated that Algeria welcomed the detailed study by the Secretariat on the need for improving the functioning of the PCT system. It thanked Deputy Director General Pooley for the informal consultations which had been initiated shortly before the session of the PCT Working Group in May 2010. Algeria had taken note of the numerous problems facing the PCT system which had been identified in the study, such as the shortage of examiners, the problems related to quality of international search and examination reports, the duplication of work, the backlogs and dealing with patent applications by intellectual property Offices, but in the view of the Delegation the study had not gone into a detailed analysis of intrinsic causes of these problems.
36. Algeria was particularly interested in improving the functioning of the PCT system, which was the main source of income for the Organization, and believed that any solution designed to achieve such an improvement should be overall, comprehensive, balanced and consensus-based. It should also be viewed in the context of the recommendations of

the Development Agenda, respecting PCT Article 27(5) which guaranteed the freedom for Contracting States to set the substantive conditions of patentability. The Delegation supported improving the quality of international search and examination reports and was of the view that improved dissemination of patent information was just one of the elements that could actually facilitate achieving that objective. With regard to the systematic validation of international search reports by intellectual property Offices of developing countries, the Delegation expressed the view that this would risk restricting the room for maneuver for Offices in developing countries, given the interpretation of patentability criteria. This was why the Delegation felt that it was important to strengthen the capacities of Offices of developing countries, in particular by way of WIPO providing training to examiners. The Delegation also supported the implementation of the Committee for Technical Assistance provided for in PCT Article 51 and the organization by WIPO of workshops and seminars on how to use the PCT System for users in developing countries, and on practical solutions for improving the functioning of the system.

37. The Representative of the Third World Network expressed the view that the PCT system should be understood in the wider context of the emerging inequitable international patent regime. Statistics on PCT applications clearly showed that developed countries were the clear beneficiaries of the system. Out of 155,000 international applications, 92,000 originated from just three developed countries, namely, the United States of America, Japan and Germany. This clearly showed that the PCT system was a tool to obtain patent protection for corporations from developed countries in a cost-effective manner. Any reform of the PCT should not result in shifting the burden, in the name of efficiency, from developed countries to developing countries. Furthermore, it should not result in any way in the harmonization of substantive aspects of patent law. It should clearly address the unfulfilled Treaty obligation related to technology transfer.

38. The Assembly:

- (i) noted the report of the third session of the PCT Working Group contained in document PCT/WG/3/14 Rev. and reproduced in the Annex to document PCT/A/41/1 Rev.; and
- (ii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 13 of document PCT/A/41/1 Rev.

Proposed Amendments of the PCT Regulations

39. Discussions were based on document PCT/A/41/2 Rev.

40. The Assembly:

- (i) adopted the proposed amendments of the Regulations under the PCT set out in the Annex to this report;
- (ii) decided that the amendments of Rules 12.2, 48.2, 53.9, 55.3, 62.1, 62.2, 66.9, 70.2 and 92.2 set out in the Annex to this report shall enter into force on July 1, 2011, and shall apply to international applications whose international filing date is on or after July 1, 2011;
- (iii) decided that the amendments of Rule 49.5 set out in the Annex to this report shall enter into force on July 1, 2011, and shall apply to international applications in respect of which the applicant has performed the acts referred to in Article 22 or Article 39 on or after July 1, 2011, and in respect of which an amendment under Article 19 or 34 was filed on or after July 1, 2009; and

- (iv) decided that the amendments of Rule 70.16 set out in the Annex to this report shall enter into force on July 1, 2011, and shall apply to any international preliminary examination report which is completed in accordance with Rule 70.4 on or after July 1, 2011, irrespective of the international filing date of the international application concerned.

Quality Management Systems for the PCT International Authorities

- 41. Discussions were based on document PCT/A/41/3.
- 42. In introducing document PCT/A/41/3, the Secretariat stated that document PCT/A/41/3 had been drawn-up so as to draw attention to the fact that, as in previous years, the annual reports by PCT International Authorities on their quality management systems had been published on WIPO's website. Furthermore, document PCT/A/41/3 informed on recent efforts by PCT International Authorities to improve their quality management systems and, most notably, the quality of the PCT work products, namely, international search reports, written opinions and international preliminary examination reports.
- 43. Both issues had featured prominently on the agenda of the most recent Meeting of International Authorities (PCT/MIA) held in February 2010 in Rio de Janeiro, Brazil, where it had been agreed to introduce a new common template for future reports on quality management systems. Furthermore, it had been agreed to set up a Quality Sub-group to discuss quality related issues in greater detail, noting the importance of the PCT as a work sharing tool, that confidence in the high quality of international reports was essential to effective use of those reports by Offices during national phase processing, and that confidence was best served by an effective evaluation of the value of the reports for the purposes of assisting Offices of PCT Member States in processing international applications which had entered the national phase. As its first two concrete projects, this Quality Sub-group would discuss the possible establishment of quality feedback systems and third party observation systems, in line with the recommendations to set up such systems as agreed by the PCT Working Group.
- 44. The Assembly took note of the content of document PCT/A/41/3.

[Annex follows]

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¹ The Table of Contents is included for convenience; it does not form part of the amendments.

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Rule 12
Language of the International Application
and Translations for the Purposes of International Search
and International Publication

12.1 to 12.1ter [No change]

12.2 *Language of Changes in the International Application*

(a) Any amendment of the international application shall, subject to Rules 46.3 and 55.3, be in the language in which the application is filed.

(b) and (c) [No change]

12.3 and 12.4 [No change]

Rule 48
International Publication

48.1 [No change]

48.2 *Contents*

(a) to (h) [No change]

(i) If the authorization by the receiving Office, the International Searching Authority or the International Bureau of a rectification of an obvious mistake in the international application under Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2, as the case may be, and the front page shall be republished.

(j) and (k) [No change]

48.3 to 48.6 [No change]

Rule 49
Copy, Translation and Fee under Article 22

49.1 to 49.4 [No change]

49.5 Contents of and Physical Requirements for the Translation

(a) For the purposes of Article 22, the translation of the international application shall contain the description (subject to paragraph (a-*bis*)), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b), (c-*bis*) and (e),

(i) [no change]

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended (the claims as amended shall be furnished in the form of a translation of the complete set of claims furnished under Rule 46.5(a) in replacement of all the claims originally filed), and

(iii) [no change]

(a-*bis*) to (l) [No change]

49.6 [No change]

Rule 53
The Demand

53.1 to 53.8 [No change]

53.9 *Statement Concerning Amendments*

(a) If amendments under Article 19 have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments:

(i) to be taken into account, in which case a copy of the amendments and of the letter required under Rule 46.5(b) shall preferably be submitted with the demand; or

(ii) [no change]

(b) and (c) [No change]

Rule 55
Languages (International Preliminary Examination)

55.1 and 55.2 [No change]

55.3 *Language and Translation of Amendments and Letters*

(a) Subject to paragraph (b), if the international application has been filed in a language other than the language in which it is published, any amendment under Article 34, as well as any letter referred to in Rule 66.8(a), Rule 66.8(b) and Rule 46.5(b) as applicable by virtue of Rule 66.8(c), shall be submitted in the language of publication.

(b) Where a translation of the international application is required under Rule 55.2:

- (i) any amendment and any letter referred to in paragraph (a); and
- (ii) any amendment under Article 19 which is to be taken into account under Rule 66.1(c) or (d) and any letter referred to in Rule 46.5(b);

shall be in the language of that translation. Where such amendments or letters have been or are submitted in another language, a translation shall also be submitted.

(c) If an amendment or letter is not submitted in a language as required under paragraph (a) or (b), the International Preliminary Examining Authority shall invite the applicant to submit the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d) If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

Rule 62

Copy of the Written Opinion by the International Searching Authority and of Amendments under Article 19 for the International Preliminary Examining Authority

62.1 Copy of Written Opinion by International Searching Authority and of Amendments Made before the Demand Is Filed

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

- (i) a copy of the written opinion established under Rule 43*bis*.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and
- (ii) a copy of any amendment under Article 19, any statement referred to in that Article, and the letter required under Rule 46.5(b), unless that Authority has indicated that it has already received such a copy.

62.2 Amendments Made after the Demand Is Filed

If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments, any statement referred to in that Article and the letter required under Rule 46.5(b). In any case, the International Bureau shall promptly transmit a copy of such amendments, statement and letter to that Authority.

Rule 66
Procedure before the International Preliminary Examining Authority

66.1 to 66.8 [No change]

66.9 *[Deleted]*

Rule 70
International Preliminary Report on Patentability by the International Preliminary
Examining Authority (International Preliminary Examination Report)

70.1 [No change]

70.2 *Basis of the Report*

(a) to (c) [No change]

(c-*bis*) If the claims, description or drawings have been amended but the replacement sheet or sheets were not accompanied by a letter indicating the basis for the amendment in the application as filed, as required under Rule 46.5(b)(iii), Rule 46.5(b)(iii) being applicable by virtue of Rule 66.8(c), or Rule 66.8(a), as applicable, the report may be established as if the amendment had not been made, in which case the report shall so indicate.

(d) and (e) [No change]

70.3 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) The following replacement sheets and letters shall be annexed to the report:

- (i) each replacement sheet under Rule 66.8 containing amendments under Article 34 and each letter under Rule 66.8(a), Rule 66.8(b) and Rule 46.5(b) as applicable by virtue of Rule 66.8(c);
- (ii) each replacement sheet under Rule 46.5 containing amendments under Article 19 and each letter under Rule 46.5; and
- (iii) each replacement sheet under Rule 26.4 as applicable by virtue of Rule 91.2 containing a rectification of an obvious mistake authorized by that Authority under Rule 91.1(b)(iii) and each letter under Rule 26.4 as applicable by virtue of Rule 91.2;

unless any such replacement sheet has been superseded or considered reversed by a later replacement sheet or an amendment resulting in the cancellation of an entire sheet under Rule 66.8(b); and

- (iv) where the report contains an indication referred to in Rule 70.2(e), any sheet and letter relating to a rectification of an obvious mistake which is not taken into account pursuant to Rule 66.4*bis*.

[Rule 70.16, continued]

(b) Notwithstanding paragraph (a), each superseded or reversed replacement sheet referred to in that paragraph and any letter referred to in that paragraph relating to such superseded or reversed sheet shall also be annexed to the report where:

- (i) the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c);
- (ii) the relevant superseding or reversing amendment was not accompanied by a letter indicating the basis for the amendment in the application as filed and the report is established as if the amendment had not been made and contains an indication referred to in Rule 70.2(c-bis).

In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

Rule 92
Correspondence

92.1 [No change]

92.2 *Languages*

(a) Subject to Rules 55.1 and 55.3 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

(b) [No change]

(c) *[Remains deleted]*

(d) and (e) [No change]

92.3 and 92.4 [No change]

[End of Annex and of document]

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Second (18th Ordinary) Session Geneva, September 26 to October 5, 2011

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/49/1): 1 to 6, 9 to 22, 27, 34, 44 and 45.
2. The report on the said items, with the exception of item 34, is contained in the General Report (document A/49/18).
3. The report on item 34 is contained in the present document.
4. Ms. Susanne Ås Sivborg (Sweden) was elected Chair of the Assembly; Mr. LI Yuguang (China) and Mr. Rimvydas Naujokas (Lithuania) were elected Vice-Chairs.

PCT WORKING GROUP: REPORT ON THE FOURTH SESSION

5. Discussions were based on document PCT/A/42/1.
6. In introducing the document, the Secretariat pointed out that, since the publication of document PCT/A/42/1, which contained in its Annex I the draft report of the fourth session of the PCT Working Group, the final version of that report had been adopted by Member States by way of correspondence and had been made available on WIPO's website as document PCT/WG/4/17, containing only minor changes compared to the draft version.

7. The Delegation of Brazil stated that it supported multilateral initiatives aimed at improving international search and preliminary examination reports. Such reports, however, had to serve as a reference only and must not be legally binding. The Delegation further stated that it considered that improvements to be made to the PCT system must not interfere with the national patent examination procedures; Member States had to keep their autonomy to reject, either partially or entirely, the results of international search and preliminary examination reports. The Delegation expressed its appreciation for the cooperative spirit that had prevailed in the most recent session of the PCT Working Group, due to the high level of engagement of all delegations. This positive environment had made it possible to reach consensus among delegations on proposed amendments to the PCT Regulations designed to improve the level of services to users of the PCT system.

8. The Delegation of Iran (Islamic Republic of) observed that it was convinced that there were several possibilities to improve the functionality of the PCT system within its legal framework, to the benefit of applicants, Offices and third parties in all Contracting States without limiting the policy space for IP Offices in determining substantive conditions of patentability. It also believed that any reform of the PCT system should amplify the basic aims of the Treaty in the field of procedures for obtaining legal protection for inventions and in the field of the dissemination of technical information and organization of technical assistance, particularly for developing countries. Moreover, since the PCT was a procedural Treaty, the results of its reform should be confined to procedural matters as well and should not lead to the harmonization of national search and examination procedures. The Delegation further stated that it wished to encourage the International Bureau to increase its activities in the field of capacity building for IP Offices by devoting more resources in this respect. It was imperative for the success of the PCT system to explore practical and affordable ways for national Offices to develop their online searching capabilities and access to effective search systems. Furthermore, although a bare minimum of hard and soft infrastructures had to be put in place to undertake national registration, WIPO's assistance in the area of translation of documents pertaining to international applications and matching the reports of International Authorities with domestic substantive legal criteria of patentability was essential. The Delegation further observed that, in the past years, the Islamic Republic of Iran had spared no efforts to put in place the needed infrastructure to implement the PCT. However, special attention from WIPO was required to help the country to overcome the remaining problems. Such provision of technical and legal assistance might assist the Islamic Republic of Iran to deposit its instrument of accession to the PCT in the shortest time possible.

9. The Assembly:

- (i) noted the Summary by the Chair of the fourth session contained in document PCT/WG/4/16 and reproduced in Annex I of document PCT/A/42/1, and the draft report of the fourth session of the PCT Working Group contained in document PCT/WG/4/17 Prov. and reproduced in Annex II of document PCT/A/42/1;
- (ii) noted the report by the International Bureau on the financial and operational situation of the supplementary international search system contained in document PCT/WG/4/11 and reproduced in Annex III of document PCT/A/42/1;
- (iii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 6 of document PCT/A/42/1.

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

10. Discussions were based on document PCT/A/42/2.

11. In introducing the document, the Secretariat stated that it wished to draw particular attention to the proposal to amend PCT Rule 34, made at the request of the Government of the People's Republic of China, to add patent documents of China to the PCT minimum documentation to be consulted by the PCT International Authorities in carrying out international searches. This constituted an important change, given that Chinese patent documents now formed a substantial component of the global prior art. The Secretariat further wished to draw attention to the proposal to amend Rule 82 and to add new Rule 82^{quater} so as to add a general provision to the PCT Regulations which would offer protection to applicants by excusing delays in meeting PCT time limits when that delay resulted from *force majeure* circumstances, prompted by the recent series of disasters in Japan.

12. The Delegation of Japan stated that it fully supported the recommendation by the PCT Working Group that this Assembly adopt the proposed amendments of the PCT Regulations set out in Annex I to document PCT/A/42/2 and the proposed decisions relating to entry into force and transitional arrangements set out in Annex II to the same document.

13. With regard to the proposal to add a general provision to the PCT Regulations which offered protection to applicants by excusing delays in meeting PCT time limits when that delay resulted from *force majeure* circumstances, the Delegation of Japan further stated that it understood that this measure would be applicable to Japanese applicants who had suffered from the Great East Japan earthquake and the resulting tsunami in Japan. In this context, the Delegation wished to express its deepest appreciation to all Delegations for the heartfelt condolences and support extended immediately after the series of natural disasters, not only by the WIPO Secretariat but also Member States all over the world. Japan had requested countries where Japanese companies filed patent applications to take bail-out measures for earthquake victims, and many of them had reacted by taking such measures, accompanied by warm words of encouragement. The Delegation stated that it wished to extend, on behalf of Japanese applicants and the nation of Japan, its utmost gratitude.

14. With regard to the work program of WIPO's PCT related bodies, such as the PCT Working Group and the PCT Meeting of International Authorities, the Delegation of Japan noted that it expected that those WIPO bodies would continue to consider issues such as measures to enhance the usability of international search and examination reports, amendments to the PCT Regulations such as those set out in document PCT/WG/42/2, and measures by International Authorities to improve quality management systems, and expressed the hope that those considerations would eventually achieve tangible and valuable results.

15. The Delegation of China thanked the International Bureau and all PCT International Authorities as well as PCT Member States for their support to include China's patent documentation into the PCT minimum documentation. As had been stated by the Commissioner of the State Intellectual Property Office of China in his general statement, the inclusion of China's patent documentation in the PCT minimum documentation contributed positively to the future development of the PCT system. In recent years, the number of patent applications from China had grown, which in turn resulted in a rapid increase of patent documentation. By the end of August 2011, the number of documents for patents, utility models and industrial designs had reached a total of 6.65 million documents, which constituted a rate of increase of about 100,000 per year. In the view of the Delegation, the inclusion of Chinese patent documentation would enable patent examiners all over the world to search more complete prior art collections and thereby increase the efficiencies and quality of PCT searches,

contributing to improving global technological innovation, invention creation and the development of the IP system.

16. The Delegation of the Republic of Korea expressed its full support to the proposed amendments of the PCT Regulations set out in document PCT/A/42/2. It fully supported the inclusion of the Chinese patent documentation into the PCT minimum documentation and appreciated the efforts by the State Intellectual Property Office of the People's Republic of China to make Chinese patent documents available for this purpose, noting that the number of patent applications filed in China had rapidly increased and that the Chinese patent documentation had enriched the global prior art. The Delegation therefore fully agreed with the view that Chinese patent documents were important to conduct appropriate prior art searches. The Delegation further stated that it welcomed the proposal for the addition of new PCT Rule 82*quater* to excuse the delay in meeting time limits in *force majeure* circumstances, noting that the present Regulations were not sufficiently flexible to deal with major natural disasters, such as the disaster in Japan on March 11, 2011. It thus wished to again express its sympathy for the reasons behind the proposal.

17. The Assembly:

- (i) adopted the proposed amendments of the Regulations under the PCT set out in the Annex to this report;
- (ii) decided that the amendments of Rule 17.1(b-bis) set out in the Annex shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which the time limit under amended Rule 17.1(b-bis) expires on or after July 1, 2012;
- (iii) decided that the amendments of Rule 20.7(b) set out in the Annex shall enter into force on July 1, 2012, and shall apply to any international application whose international filing date is on or after July 1, 2012;
- (iv) decided that the amendments of Rule 34 set out in the Annex shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which an international search is carried out on or after July 1, 2012;
- (v) decided that Rule 82.2 shall be deleted with effect from July 1, 2012, provided that Rule 82.2 shall continue to apply to any international application whose international filing date is before July 1, 2012, and in respect of which the six months time limit for the submission of evidence referred to in Rule 82.1(c) as applicable by virtue of Rule 82.2(b) expires on or after July 1, 2012;
- (vi) decided that new Rule 82*quater* set out in the Annex shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which the six months time limit for the submission of evidence referred to in new Rule 82*quater*.1(a) expires on or after July 1, 2012.

QUALITY MANAGEMENT SYSTEMS FOR THE PCT INTERNATIONAL AUTHORITIES

18. Discussions were based on document PCT/A/42/3.

19. The Assembly noted the contents of document PCT/A/42/3.

[Annex follows]

AMENDMENTS OF THE PCT REGULATIONS TO ENTER INTO FORCE ON JULY 1, 2012

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Rule 17
The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) and (b) [No change]

(b-*bis*) Where the priority document is, in accordance with the Administrative Instructions, made available to the International Bureau from a digital library prior to the date of international publication of the international application, the applicant may, instead of submitting the priority document, request the International Bureau, prior to the date of international publication, to obtain the priority document from such digital library.

(c) and (d) [No change]

17.2 [No change]

Rule 20
International Filing Date

20.1 to 20.6 [No change]

20.7 *Time Limit*

(a) [No change]

(b) Where neither a correction under Article 11(2) nor a notice under Rule 20.6(a) confirming the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) is received by the receiving Office prior to the expiration of the applicable time limit under paragraph (a), any such correction or notice received by that Office after the expiration of that time limit but before it sends a notification to the applicant under Rule 20.4(i) shall be considered to have been received within that time limit.

20.8 [No change]

Rule 34
Minimum Documentation

34.1 Definition

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) [no change]

(ii) the patents issued by the Federal Republic of Germany, the People’s Republic of China, the Republic of Korea and the Russian Federation,

(iii) to (vi) [no change]

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Chinese, Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of the People’s Republic of China, Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

Rule 82
Irregularities in the Mail Service

82.1 [No change]

82.2 [Deleted]

Rule 82^{quater}
Excuse of Delay in Meeting Time Limits

82^{quater}.1 Excuse of Delay in Meeting Time Limits

(a) Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.

(b) Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be, not later than six months after the expiration of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the addressee, delay in meeting the time limit shall be excused.

(c) The excuse of a delay need not be taken into account by any designated or elected Office before which the applicant, at the time the decision to excuse the delay is taken, has already performed the acts referred to in Article 22 or Article 39.

[End of Annex and of document]

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Third (25th Extraordinary) Session Geneva, October 1 to 9, 2012

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/50/1): 1, 3 to 8, 10 to 12, 15 to 21, 29, 37 and 38.
2. The report on the said items, with the exception of item 29, is contained in the General Report (document A/50/18).
3. The report on item 29 is contained in the present document.
4. The meeting of the Assembly was presided over by Ms. Susanne Ås Sivborg (Sweden), Chair of the PCT Assembly.

PCT WORKING GROUP: REPORT ON THE FIFTH SESSION

5. Discussions were based on document PCT/A/43/1.
6. The Secretariat explained that the purpose of document PCT/A/43/1 was to inform the Assembly about the discussions and agreements reached during the fifth session of the PCT Working Group, held in Geneva in May/June 2012. The Summary by the Chair, set out in Annex I to the document, contained an overview and summary of the items discussed and the agreements reached during that session. In addition, since the publication of document PCT/A/43/1, the final report of the fifth session of the Working Group (document PCT/WG/5/22)

had been adopted by Member States by correspondence, having been made available as draft report (document PCT/WG/5/22 Prov.), in both English and French, for comments by all participants in the meeting on the Working Group's electronic forum.

7. The Secretariat further stated that, as could be seen from the Summary by the Chair, in addition to a number of more technical issues, the focus of the discussions in the Working Group had again been on the continued implementation of the Recommendations which had been endorsed by the Working Group at its third session in 2010 on how to improve the quality of the services offered by the PCT system, for the benefit of all stakeholders. The Working Group further had agreed on a number of proposed amendments to the PCT Regulations for adoption by the Assembly, as set out in document PCT/A/43/2. Finally, Annex II to the document reproduced the statements made by delegations during the fifth session of the Working Group on the agenda item "Contribution of the Working Group to the Implementation of the Respective Development Agenda Recommendations", further to the decision by the 2010 WIPO General Assembly on the Development Agenda Reporting Mechanism.

8. The Delegation of China expressed its support for the work of the PCT Working Group.

9. The Delegation of Brazil, speaking on behalf of the Development Agenda Group, stated that in order to be fully integrated into the PCT system, and to benefit from it, developing countries needed to promote capacity building and invest in human resources. Having access to technical assistance was one of the advantages accruing to Member States under the PCT. Technical assistance was also necessary for implementing the objectives of the Treaty, allowing all countries to use and reap the benefits of the patent system. Therefore, the Working Group necessarily had to take PCT Article 51 into account in its debates. The Delegation stated that technical assistance should include, *inter alia*, the training of personnel at the Offices and should facilitate access to appropriate tools for search and examination, such as patent databases and technological infrastructure. To conclude, the Delegation highlighted the need for improvements to allow for small and medium-sized enterprises as well as individuals to benefit adequately from the PCT system. The Development Agenda Group supported deeper discussions to provide concrete solutions for these actors responsible for a substantial amount of growth, employment and innovation, particularly in developing countries.

10. The Delegation of Japan stated that it wished to deliver a brief general statement on the PCT system. The Delegation stated that many of the PCT applications were filed by Japanese applicants and Japan was one of a few nations recording an increase in the number of PCT filings, even in the midst of the recent severe economic circumstances. Fees from the PCT accounted for 70 per cent of the revenue in WIPO, making the PCT system an indispensable tool for WIPO in the promotion of innovation in developing countries, for small and medium-sized enterprises (SMEs) in all countries, and an important tool for business development and economic growth for key players. The Delegation expressed the expectation that meaningful and valuable fruits would be borne through practical and productive discussions in the Working Group and that the PCT system would subsequently become truly user-friendly. To that end, the Delegation welcomed the proposals on PCT improvements made by the United States of America and the United Kingdom and also by the European Patent Office. The Delegation concluded by affirming its commitment to constructive discussions in the PCT-related bodies in WIPO.

11. The Delegation of the Republic of Korea stated that it wished to make a general statement on the operation of the PCT system, which had been through major changes mainly arising from progress in automation and rule changes. For example, the revision of roles among international Offices and designated officials kept evolving, including formalities examination by receiving Offices and the International Bureau, with the transmission of documents and also the responsibility of formalities examiners changing accordingly. Moreover, the Delegation

expected the ePCT project currently being undertaken by WIPO to accelerate the changes of PCT systems of operation. The Delegation therefore considered it very helpful for WIPO to share the big picture of the PCT system at an operational level.

12. The Delegation of Sweden emphasized the great importance of the PCT system and its commitment to the valuable work of the PCT Working Group striving to improve the functioning of the system. The Delegation therefore stated that it was committed to improving the quality of the PCT system to the benefit of the users and other stakeholders. It was important that International Authorities, such as the Swedish Patent and Registration Office, continuously improved the work processes and the quality of the results delivered, and looked forward to continuing the cooperation with other International Authorities. The Delegation also wished to support the candidacy of the National Institute of Industrial Property of Chile to become an International Authority.

13. The Delegation of Iran (Islamic Republic of) stated that it had noted with appreciation the activities of the PCT Working Group to improve the functioning of the PCT system. Proposed amendments needed to be based on the Development Agenda and consider the interests of all parties involved, namely, the applicants, the users and the public. The different levels of development among Member States should also be taken into account. The Delegation believed that improvement of the functional capacity of the national intellectual property Offices of developing countries through providing technical assistance was one of the core goals of the PCT and patent system. This also fostered the economic development of the developing countries by encouraging their domestic innovation capacities and assisting them in ensuring high quality patents through a meaningful examination of the technical aspects of innovations. Indeed, technical assistance of WIPO to the industrial property Offices of Member States lay at the heart of its functions; paragraph (v) of Article 4 of the Convention Establishing the World Intellectual Property Organization explicitly stated that it "shall offer its cooperation to States requesting legal-technical assistance in the field of intellectual property". Furthermore, this issue was also highlighted in Article 51 of the PCT. This principle needed to be respected by all members and attempts to blur this function had to be prevented. The Working Group therefore needed to give priority to the improvement of the human resources of the national intellectual property Offices, consider establishing organizational connections between intellectual property Offices to exchange experiences and to collaborate on issues of common interest, especially on technical examination and collaborative searches.

14. The Delegation of Sudan stated that it agreed with the intervention by the Islamic Republic of Iran and, as a least developed country, requested the Organization to provide technical assistance with regards to the PCT procedures. Sudan had been receiving international applications since 1984 which were not subjected to objective examination in the national phase. The Delegation therefore asked the Organization to provide technical assistance and training in favor of the Office of the Registrar General of Sudan.

15. The Delegation of Peru highlighted the efforts made by many developing countries – including Peru – despite their very meager resources, to avoid blatant cases of biopiracy, as well as the incorrect grant of patents, frequently owing to the lack of inventive step of a patent application that the examiner responsible failed to observe adequately. In that regard, the Delegation called on national intellectual property Offices to strengthen still further their cooperation links and information exchange, and was of the opinion that that was a challenge in relation to which WIPO could be of great assistance. For that reason, a "global observatory" or an "information exchange center" could be set up which, while respecting the principles of territoriality and confidentiality that governed the process of patent evaluation, but emphasizing the cooperative nature of WIPO members, would be of use to national intellectual property Offices in their analysis of the state of the art for the patent applications filed with them. Such cooperation mechanisms would be of particular importance with regard to applications concerning genetic resources, derivatives thereof or associated traditional knowledge.

16. The Assembly:

- (i) noted the Summary by the Chair of the fifth session contained in document PCT/WG/5/21 and reproduced in Annex I of document PCT/A/43/1;
- (ii) noted the excerpts from the draft report of the fifth session of the Working Group contained in document PCT/WG/5/22 Prov. and reproduced in Annex II of document PCT/A/43/1, concerning the contribution by the Working Group to the implementation of the respective Development Agenda Recommendations; and
- (iii) approved that, subject to the availability of sufficient funds, one session of the Working Group should be convened between the October 2012 and September/October 2013 sessions of the Assembly; and that the same financial assistance that had been made available to enable attendance of certain delegations at the fifth session of the Working Group should be made available to enable attendance of certain delegations at that next session.

QUALITY MANAGEMENT SYSTEMS FOR INTERNATIONAL AUTHORITIES

17. Discussions were based on document PCT/A/43/2.

18. The Secretariat, in introducing document PCT/A/43/2, noted that the purpose of the document was threefold. Firstly, to inform Member States of the availability, on WIPO's web site, of the latest reports by International Authorities on the state of their existing quality management systems. A summary of the main points of interest, prepared by the Quality Subgroup of the Meeting of International Authorities, was contained in Annex I to the document. Secondly, to report on the outcome of the second meeting of the Quality Subgroup, which took place in Canberra in February 2012, as set out in Annex II to the document. As could be seen from the report, the focus of this second meeting of the quality subgroup had again been on effective quality improvement measures, that is, measures to improve the overall quality and usefulness of the international work products of the PCT, that is, the PCT international search reports and the international preliminary reports on patentability. Finally, the document also reproduced, in its Annex III, the relevant sections (in relation to the quality framework) of the Summary by the Chair of the nineteenth session of the Meeting of International Authorities, held in Canberra in February 2012.

19. The Delegation of Australia stated that it had enjoyed hosting the Quality Subgroup meeting which had been held in Canberra in warm February conditions. Australia strongly supported the international phase of the PCT and believed that high quality work in the international phase was essential to enable the PCT to fulfill its aim of minimizing the duplication of work. That is, for international work to be relied on, applicants and other Offices needed to have confidence that it was both relevant and done properly. Australia supported the Quality Subgroup and believed that the work being carried out therein would help to improve the quality management systems in place in IP Offices around the world. The Delegation also believed that a robust exchange on quality issues was essential for International Searching Authorities to achieve consistent production of high quality work.

20. The Delegation of the United States of America supported the continued work of the Meeting of International Authorities and the Quality Subgroup and their efforts to find ways to improve work product quality within the PCT system. In particular, the Delegation placed great importance on the value of transparency in the search and examination process and believed that transparency was key to quality improvement. The United States Patent and Trademark Office had published search strategies for domestic and international searches for some time through its Patent Application Informational Retrieval (PAIR) system and would begin to submit search strategies for international applications for publication in PATENTSCOPE in the near

future. The Delegation commended the Quality Subgroup and the Meeting of International Authorities for supporting the voluntary publication of search strategies and encouraged all International Authorities to take advantage of this option.

21. The Assembly noted the contents of document PCT/A/43/2.

REVIEW OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

22. Discussions were based on document PCT/A/43/3.

23. The Secretariat, in introducing document PCT/A/43/3, recalled that the PCT Union Assembly, at its thirty-sixth session held in September/October 2007, adopted amendments to the Regulations so as to introduce a supplementary international search system to the PCT. These amendments had entered into force on January 1, 2009. Along with adopting these amendments, the Assembly had decided that the International Bureau should report on the financial and operational situation of the supplementary international search system and that the Assembly should review the supplementary international search system three years after the date of entry into force of the system. Annex I to document PCT/A/43/3 set out the requested report by the International Bureau on the financial and operational situation of the supplementary international search system, three years after its entry into force; that report had been reviewed and extensively discussed by the Working Group at its fifth session.

24. The Secretariat further stated that, clearly, the very low uptake by applicants of the supplementary international search system during the first three years of its existence was disappointing, in particular in view of the strong demand by the user community for the establishment of such a system. On the other hand, the statistics for the first three years and the feedback received by the International Bureau in reply to a Questionnaire sent out to all major stakeholders suggested that there were very concrete reasons for the low uptake, notably the very limited mix of languages offered by the Authorities currently carrying out supplementary searches. In addition, there were a number of further developments, as set out in the document (such as the fact that some Authorities had only recently begun to offer the service, and that work-sharing arrangements such as PPH might provide a stronger incentive to use the system) which suggested that it might be too early to "give up" on the eventual acceptance and success of the system. Thus, based on a recommendation by the PCT Working Group, the document invited the Assembly to take the decision to continue to monitor the operation of the system for a further three years, during which time Offices should seek to raise awareness of the system and International Authorities should review the scope and cost of the services which they offer under that system.

25. The Delegation of China thanked the IP Offices of those countries and regions that offered supplementary international searches for the wealth of experience that they had built up in the process. The Delegation considered it of great utility to continue tracking and studying the supplementary international search system. China supported the International Bureau's proposal to monitor the supplementary international search system for another period of three years and was ready to offer its cooperation to the International Bureau in promoting the service to users. The Delegation suggested that future refinements and modifications of the PCT system should go by the principle of orderly and incremental progress and feasibility in the context of reality, taking into account the needs of all stakeholders and the potential problems that might exist, so that the rules that entered into force could function in practice as they had been intended.

26. The Assembly noted the report by the International Bureau on the financial and operational situation of the supplementary international search system contained in paragraphs 7 to 34 of document PCT/WG/5/8 and reproduced in the Annex to document PCT/A/43/3.

27. The Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system, decided:

- (a) to invite the International Bureau to continue to closely monitor the system for a period of another three years, and to continue to report to the Meeting of International Authorities and the Working Group on how the system is developing;
- (b) to invite the International Bureau, International Authorities and national Offices and user groups to increase their efforts to raise awareness of and promote the service to users of the PCT system;
- (c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;
- (d) to review the system again in 2015, taking into account further developments until then, notably in relation to efforts to move towards collaborative search and examination models and in relation to efforts to improve the quality of the “main” international search.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

28. Discussions were based on document PCT/A/43/4.

29. The Secretariat, in introducing document PCT/A/43/4, explained that the effect of the proposed amendments would be a simplification of PCT procedures for applicants from all Contracting States. In particular, inventors no longer had to be named as applicants solely for the purposes of the designation of the United States of America, with consequential impact on signature requirements and with regard to the furnishing of certain documents containing oaths or declarations of inventorship. All of these changes were consequential on the recent enactment in the United States of America of the America Invents Act.

30. The Secretariat further stated that the proposed amendments had been discussed in great detail by the PCT Working Group, which had unanimously agreed to recommend that this Assembly should adopt the amendments as proposed. Annex I contained a marked-up text of the proposed amendments of the Regulations, with changes highlighted by underlining and strikethrough. Annex II contained a clean text of the amended Rules as they would stand after amendment. A proposed draft decision with regard to entry into force and transitional arrangements was set out in paragraph 7 of the document.

31. The Delegation of the United States of America stated that it appreciated the work of the PCT Working Group in addressing the challenges and opportunities presented by the American Invents Act. The proposed changes to the PCT Regulations represented a significant simplification for the applications from all Contracting States and the United States of America supported their adoption.

32. The Delegation of El Salvador expressed its thanks for the work that had been done in the PCT Working Group. El Salvador recognized that the Treaty needed improvement to make it more effective and to satisfy the needs of the applicants, the patent Offices and third parties in all Contracting States. In all such improvements, El Salvador believed that the level of development of the Member States of the Treaty needed to be taken into account and asked that the work of adopting amendments to the PCT should be done gradually through a

member-driven process that involved third parties and all of those interested through consultations, seminars and information workshops.

33. The Assembly:

- (i) adopted the proposed amendments to the Regulations under the PCT set out in the Annex to this report;
- (ii) decided that the amendments of Rules 4.15, 51*bis*.1, 51*bis*.2, 53.8 and 90*bis*.5 set out in the Annex to this report shall enter into force on January 1, 2013, and shall apply to any international application whose international filing date is on or after that date.

APPOINTMENT OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY OF CHILE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

34. Discussions were based on document PCT/A/43/5 Rev.

35. The Chair stated that the PCT Committee on Technical Cooperation had held its twenty-fifth session to give advice to the PCT Union Assembly on the request of the National Institute of Industrial Property of Chile to be appointed as an International Searching and Preliminary Examining Authority under the PCT. Having listened to the presentation by the Delegation of Chile, all delegations which had taken the floor on the matter had expressed their support for the appointment; some delegations had made constructive proposals aimed at strengthening and further developing the quality of the work carried out by International Authorities. The Committee had given a unanimous favorable advice on the appointment of the National Institute of Industrial Property of Chile as an International Searching and Preliminary Examining Authority under the PCT.

36. The Delegation of Chile expressed its sincere thanks to the PCT Union Assembly and to the 26 delegations that had taken the floor, including one speaking on behalf of GRULAC. It was an honor for Chile to now become part of the group of International Searching Authorities and International Preliminary Examining Authorities. It was the personal commitment of the Director of the National Institute of Industrial Property of Chile and the commitment of the Government of Chile to ensure that the appointment was going to be of great benefit to the entire PCT system and to ensure that the Institute did good work. It was also a commitment to promote the Latin America region. The Delegation again wished to thank all who had given their support over the recent months to the Institute's candidacy.

37. The Delegation of Trinidad and Tobago stated that it applauded the continuous efforts of the International Bureau, the Authorities and the Member States to evolve the PCT system as the needs of users changed. It wished to also support the appointment of the National Institute of Industrial Property of Chile as an International Searching Authority and International Preliminary Examining Authority under the PCT. It had every confidence in the Institute's capacity based on its track record. Even though its working language was not Spanish, Trinidad and Tobago appreciated the diversity of Authorities available to applicants. It noted the efforts of Authorities with respect to setting up a quality management systems and fully appreciated the steps taken by many Authorities to meet the demands of both growing workloads and the ever present need for a high degree of validity of their work. It anticipated that the National Institute of Industrial Property of Chile, like all other Authorities, would follow in that direction as well. More important would be its commitment to the quality management process. It therefore welcomed related PCT quality initiatives and looked forward to working closely with WIPO with respect to their implementation. It further requested that ample consideration be given to the

differing developmental levels of the various PCT Member States so that new developments were able to accommodate those differences.

38. The Delegation of New Zealand stated that it wished to join other delegations in supporting the appointment of the National Institute of Industrial Property of Chile as an International Authority and congratulated the National Institute of Industrial Property on its success in modernizing its operations. The Delegation hoped that the appointment of the National Institute of Industrial Property of Chile would encourage greater use of the PCT by applicants from Latin America.

39. The Representative of the European Patent Office stated that it had intended to make its statement during the session of the PCT Committee on Technical Cooperation but had not been able to do so. The European Patent Office supported the comments made by the Delegation of the Russian Federation during the session of the PCT Committee on Technical Cooperation on the importance of quality in the PCT, that the PCT rules for becoming an International Searching and Preliminary Examining Authority were outdated and that a review thereof now appeared necessary. It therefore wished to encourage this issue to be dealt with by a PCT working group in the near future.

40. The PCT Assembly, having heard the Representative of the National Institute of Industrial Property of Chile and taking into account the advice of the PCT Committee for Technical Cooperation, unanimously

(i) approved the text of the draft Agreement between the National Institute of Industrial Property of Chile and the International Bureau as set out in Annex III to document PCT/A/43/5 Rev; and

(ii) appointed the National Institute of Industrial Property of Chile as an International Searching Authority and an International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2017.

41. The Director General of WIPO stated that he wished to formally, on behalf of the International Bureau, congratulate Chile, the Delegation of Chile and the National Institute of Industrial Property of Chile. The International Bureau would be delighted to work with the Institute to bring its status as an International Authority into operation.

LOAN GRANTED BY THE PCT UNION TO THE HAGUE UNION

42. Discussions were based on document PCT/A/43/6.

43. The Secretariat, in introducing document PCT/A/43/6, recalled that, in 2008, the PCT Union Assembly had authorized the granting of a loan to the Hague Union of an amount of 3 million Swiss francs to cover the share of the Hague Union in the financing of an IT modernization program. The purpose of the present document was to inform the Assembly that, earlier during the day, the Madrid Union Assembly had decided that the Madrid Union should assume the financing of the Hague Union's contributions to the IT modernization project, rather than the PCT Union. Consequently, the loan would no longer be "on the PCT's books".

44. The Assembly noted the contents of document PCT/A/43/6.

[Annex follows]

AMENDMENTS OF THE PCT REGULATIONS TO
ENTER INTO FORCE ON JANUARY 1, 2013

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Rule 4

The Request (Contents)

4.1 to 4.14*bis* [No change]

4.15 *Signature*

The request shall be signed by the applicant or, if there is more than one applicant, by all of them.

4.16 to 4.19 [No change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iii) [no change]

(iv) where the international application designates a State whose national law requires, on October 9, 2012, the furnishing of an oath or declaration of inventorship, any document containing an oath or declaration of inventorship,

(v) to (vii) [no change]

(b) to (f) [No change]

51bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required

The designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is contained in the request or is submitted directly to the designated Office;

[Rule 51bis.2, continued]

(ii) [no change]

(iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;

(iv) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.

51bis.3 [No change]

Rule 53

The Demand

53.1 to 53.7 [No change]

53.8 *Signature*

The demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.

53.9 [No change]

Rule 90bis

Withdrawals

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall not be entitled to sign such a notice on behalf of the other applicants.

90bis.6 and 90bis.7 [No change]

[End of Annex and of document]

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Fourth (19th Ordinary) Session
Geneva, September 23 to October 2, 2013

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/51/1): 1 to 6, 8, 11 to 16, 19 to 23, 37, 47 and 48.
2. The report on the said items, with the exception of item 37, is contained in the General Report (document A/51/20).
3. The report on item 37 is contained in the present document.
4. Ms. Susanne Ås Sivborg (Sweden) was re-elected Chair of the Assembly; Mr. Tian Lipu (China) and Mr. Toomas Lumi (Estonia) were elected Vice-Chairs.

PCT WORKING GROUP: REPORT OF THE SIXTH SESSION

5. Discussions were based on document PCT/A/44/1.
6. The Secretariat, in introducing document PCT/A/44/1, referred to the Summary by the Chair of the sixth session of the PCT Working Group, which was annexed to the document and which gave a good overview and a summary of the items discussed and the agreements reached during the meeting. The full final report of the session, taking into account the minor comments the International Bureau had received from delegations on the draft report, would be available on the WIPO web site shortly. In addition to a number of more technical and legal issues, the focus of the discussions in the Working Group at its sixth session had again been on

various proposals by Member States aimed at strengthening the role of the PCT as the central node of the international patent system; discussions by Member States on most of these proposals would continue in the Working Group at its upcoming 2014 session.

7. The Secretariat highlighted the issue of criteria and procedures for appointment of International Authorities, which had been discussed by the Working Group at its sixth session. In this regard, the Working Group had agreed to recommend to the Assembly that the International Bureau should undertake a review of the current criteria and procedures, in coordination, where appropriate, with the Meeting of International Authorities, for discussion by the Working Group at its next session in 2014. Consequently, the Assembly was invited to approve this specific recommendation by the Working Group. Finally, the Working Group had agreed on a number of proposed amendments to the PCT Regulations for approval by the Assembly at its present session, as set out in document PCT/A/44/3.

8. The Delegation of Japan stated that the number of international patent applications filed under the PCT had increased and the PCT was now a truly global framework, enabling applicants to file patent applications worldwide. However, there was still room for improvement of the PCT system. Member States had an important mission to fulfill, which was to maximize the benefits of the PCT system and to further improve it in order to create a more user-friendly system. Against this background, Japan had submitted the PCT Kaizen proposal at the most recent session of the PCT Working Group, aimed at creating a common understanding of the future direction of the PCT system. Having obtained broad support for its PCT Kaizen proposal from Member States, Japan wished to further elaborate on the proposal at the next session of the PCT Working Group. The Delegation also welcomed the proposals on PCT improvements which had been made by the United States of America, the United Kingdom, the European Patent Office (EPO) and Brazil. The Delegation expected practical and productive discussions to bear meaningful and valuable fruit, allowing the PCT to become a truly user-friendly system. The Delegation further agreed that the issue of the criteria and the procedures for the appointment of International Searching and Preliminary Examining Authorities should be discussed at the next session of the PCT Working Group. It expressed the view that it was important to review whether the existing criteria and procedures were adequately addressing not only the technical scope of applications, which had expanded and become more complicated in recent years, but also the development of information technology.

9. The Delegation of Belgium, speaking on behalf of Group B, stated that it wished to thank the Chair of the most recent session of the PCT Working Group for his efficient chairing of the meeting. In a similar vein, it wished to thank the Secretariat for the work done over the past year. Group B welcomed the progress that had been made towards improving the operation of the PCT system. It believed that a more efficient PCT system could bring benefits to both Offices and users. It believed that further work and discussions on the issue of fee reductions were urgently needed in order to develop a system of fee reductions that took into account changes that had occurred in the economy worldwide. It therefore looked forward to the study by the International Bureau on this issue, linking the topic of fee reductions with notions such as, firstly, the variety of definitions of small and medium-sized enterprises (SMEs) that are used for fee reductions granted under national and regional patent legislation; secondly, descriptions of mechanisms that were already in place in some countries in this area; and thirdly, the elasticity of fee reductions covering non-profit research institutes and universities. The Delegation reiterated that fee reductions should be financially sustainable and income neutral.

10. The Delegation of Chile stated that it wished to take this opportunity to once again thank the Member States and the Secretariat for the trust they had placed last year in appointing the National Institute of Industrial Property of Chile (INAPI) as an International Searching and Preliminary Examining Authority. INAPI would begin its operations as an International Authority in October 2014, as already had been announced earlier (see document A/51/20). The Delegation had made available a brochure, setting out the progress INAPI had made in recent years, notably in terms of access to the PCT minimum documentation and examiner training, for

which the Delegation particularly liked to thank the IP Offices of the United States of America, Canada, China and Austria. Furthermore, INAPI had continued to improve the design of its quality control systems.

11. The Delegation of El Salvador stated that, while it generally supported further work in the PCT Working Group, including modifications to the PCT Regulations, Member States needed to consider what had been achieved so far in terms of implementation of the PCT Roadmap. In this context, Member States needed to take into account, in particular, the development aims of the Treaty before taking any further steps.

12. The Delegation of the United States of America stated that it supported the statement by the Delegation of Belgium on behalf of Group B. It had noted the summary by the Chair of the sixth session of the PCT Working Group contained in document PCT/WG/6/23 and looked forward to the report of the session. The Delegation supported approval of the recommendation by the Working Group concerning the review of the criteria and procedures for appointment of an Office as an International Searching and Preliminary Examining Authority under the PCT. Attention to work product quality as well as timeliness was critical to the continuous success of the PCT system. The Delegation further supported the approval of the recommendation by the Working Group that, subject to sufficient funds, one session of the Working Group should be convened between the 2013 and 2014 sessions of the Assembly. The Delegation further stated that, in 2013, the Working Group had considered matters related to transparency and maintenance of expected quality within the PCT system and had agreed on ways to improve the system in these areas. This work had resulted in the amendments to the PCT Regulations as set out in document PCT/A/44/3. It commended the Working Group for its efforts over the past year and looked forward to continuation of this work in the year ahead. Mandatory recordation of search strategies and incorporation of the Patent Prosecution Highway (PPH) into the PCT system were reforms which should improve transparency and efficiency; notably, the proposal to incorporate the PPH into the PCT would be an effective mechanism to promote increased and more effective use of the PCT Chapter II procedure. Thus, both proposals warranted further consideration.

13. The Delegation of South Africa stated that South Africa had acceded to the PCT on March 16, 1999. Gradually, the number of patent applications received in South Africa through the PCT route had increased and now constituted more than 80 per cent of total patent applications filed. Over the years, South Africa had received, and continued to receive, excellent technical assistance, including educational and outreach programs provided by WIPO. The Companies and Intellectual Property Commission in South Africa had cooperated with WIPO to offer training on PCT issues, which the Delegation hoped would continue. The Delegation commended the Secretariat for the outstanding work done to facilitate the development of the PCT system, as well as the valuable contribution of Member States that had submitted proposals for future development of the PCT system. The Delegation further expressed the view that the agenda of the sixth session of the PCT Working Group on substantive topics had been quite intense and ambitious and had been aimed at introducing drastic changes to the PCT system. These topics could be divided into two groups: on the one hand, issues concerning the operation of rules and introducing new levels of automation and information technology; and, on the other hand, issues concerning the improvement of the quality of patents, work sharing and patent search and examination, as well as the link between the international and national phase procedures. The second group of issues had a big impact on national Offices. Therefore, a number of delegations from developing countries, including South Africa, had felt that they had not been ready to participate effectively in such developments and had expressed their concerns that this would lead to harmonization of substantive patent laws. The Delegation drew attention to the fact that the PCT Roadmap had been approved in 2009 by the PCT Union Assembly with the proviso that it should deliver results which met the needs of applicants, Offices and third parties in all Contracting States without limiting the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability and without seeking substantive patent law harmonization or

harmonization of national search and examination procedures, taking an incremental approach in a member driven process, involving broad based consultations with all stakeholder groups, including regional consultation workshops and taking into account the recommendations contained in the WIPO Development Agenda (DA). In light of the above, the Delegation wished to caution against the linkage between national and international phases, especially with regard to proposals which would affect the manner of national phase processing, such as PCT Kaizen, the formal integration of the PPH into the PCT, and the mandatory response to negative comments in the national phase. The Delegation further expressed its concern that the rapid development of the PCT system would pose a substantive hardship on developing countries to cope with such a development. That process was not in line with the proviso set out in the approval of the PCT Roadmap given by the PCT Union Assembly at its 2009 session, according to which an incremental approach should be taken in the development of the PCT system.

14. The Delegation of Sweden thanked the Secretariat for the work in the area of the PCT. It emphasized the great importance of the PCT system and its commitment to the valuable work of the PCT Working Group, striving to improve the functioning of the system. In that vein, the Delegation supported the recommendation of the PCT Working Group that the International Bureau should undertake a review of the criteria and procedures for appointment of Offices as International Searching and Preliminary Examining Authorities, as suggested in document PCT/A/44/1, paragraph 5(ii), as well as the recommendation for future work set out in paragraph 5(iii). For the sake of efficiency, the Delegation further wished to comment on the other documents related to the work of the PCT Working Group yet to be discussed during the present session of the Assembly. It was important that International Authorities, such as the Swedish Patent and Registration Office, continuously improved the work processes and the quality of the results delivered to improve the overall quality of the PCT system, for the benefit of the users and other stakeholders. The Delegation therefore noted with appreciation the report on ongoing quality-related work set out in document PCT/A/44/2. Furthermore, the Delegation supported the proposed amendments to the PCT Regulations set out in document PCT/A/44/3.

15. The Delegation of India stated that it wished to take this opportunity to express its appreciation of the work being carried out by the PCT Working Group as announced by the Secretariat. As it had mentioned in its opening statement, the Delegation was pleased to announce that the Indian Patent Office would commence functioning as International Searching and Preliminary Examining Authority from October 15, 2013. Furthermore, the Delegation expressed the view that the PCT system needed to be made more accessible, in particular for applicants from developing and least developed countries (LDCs), and in this regard emphasized the importance of technical assistance as well as fee reductions for SMEs, universities and research institutes, and individuals from developing and LDCs. With respect to the proposal to integrate the PPH into the PCT, India had, time and time again, expressed its concerns about harmonization of examination procedures for patent applications and considered that this would impede the process of examination in developing countries where the capacity to examine was yet to achieve the maturity that was seen in the patent Offices of developed countries.

16. The Delegation of Egypt expressed its appreciation for the cooperation which had made it possible for the Egyptian Patent Office to commence acting as an International Searching and Preliminary Examining Authority in 2013. This had been the result of the good cooperation between Egypt and WIPO; in this context, it expressed the hope that technical assistance and training by WIPO would continue. The Delegation had some ideas as to how to develop bilateral cooperation with WIPO so that the Egyptian Patent Office's activities could be expanded throughout the Arab region and Africa. The Delegation further stated that it supported the intervention made by the Delegation of India with regard to the issue of fee reductions for SMEs, universities and research institutions, which it felt could be very useful in the context of the PCT system.

17. The Delegation of Spain stated that it wished to endorse the statement by the Delegation of Belgium, on behalf of Group B, and statements by other delegations with regard to the following points: firstly, the revision of fees to make the system more efficient for users; and secondly, further work to ensure quality and sustainability of the PCT system, which would have an effect on the trust placed in it.

18. The Delegation of Trinidad and Tobago stated that it concurred with the Secretariat that the PCT was the central node of the international patent system. In fact, PCT applications constituted 97 per cent of all patent applications in Trinidad and Tobago. The Delegation commended the work of the PCT Working Group and the evolution of the PCT system. As technology and innovations evolved, the work of the PCT continued to evolve in a thoughtful and progressive manner. It looked forward to continue working with other Member States on these new initiatives. It further supported the expansion of the options among a growing group of International Searching and Preliminary Examining Authorities and welcomed the inclusion of the State Intellectual Property Service of Ukraine as an International Authority under PCT. In closing, it urged that future PCT improvements that were presently under discussion needed to continue to take in account the capacities of all Contracting States; it looked toward to the continued utility of the PCT to all Contracting States.

19. The Assembly:

(i) noted the Summary by the Chair of the sixth session of the PCT Working Group contained in document PCT/WG/6/23 and reproduced in the Annex of document PCT/A/44/1;

(ii) approved the recommendation by the Working Group concerning the review of the criteria and procedures for appointment of an Office as an International Searching and Preliminary Examining Authority under the PCT set out in paragraph 3 of document PCT/A/44/1; and

(iii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 4 of document PCT/A/44/1.

QUALITY-RELATED WORK BY INTERNATIONAL AUTHORITIES

20. Discussions were based on document PCT/A/44/2.

21. The Secretariat stated that the main purpose of document PCT/A/44/2 was to report on the outcome of the third informal session of the Quality Subgroup of the Meeting of International Authorities under the PCT, which had taken place in Munich in February of this year. The Summary by the Chair of the session was attached in the Annex to the document. The focus of this third informal session had again been on effective quality improvement measures, that is, measures to improve the overall quality and usefulness of the PCT's work products, namely, international search reports and international preliminary reports on patentability. The Quality Subgroup had further focused on the development of quality metrics for international search reports and the development of quality metrics for the entire PCT system, covering the work of receiving Offices, International Authorities, designated and elected Offices, and the International Bureau. The document further informed Member States of the availability on the WIPO web site of the latest reports by International Authorities on the state of their existing quality management systems, as had been the practice for a number of years. Those reports had also been discussed by the Quality Subgroup, as set out in paragraphs 1 to 6 of the Summary by the Chair.

22. The Delegation of Japan stated that, in order to improve the quality of search and examination results in each International Authority, it believed that it was extremely important to establish an international framework that could give feedback on international search reports

and written opinions by International Searching Authorities, as referred to in paragraph 5 of document PCT/A/44/2. The Delegation was grateful for the hard work by the Secretariat on this issue. Based on such a feedback mechanism, Offices would be able to easily provide feedback on examination results to one another. As a result, the addition of such a feedback mechanism would further enhance the value of the PCT system in the future. Against this background, the Japan Patent Office (JPO) was now considering a pilot program aimed at analyzing and utilizing feedback from Offices and then providing feedback on the results to those Offices at the earliest possible time through the cooperation with other offices. Over time, as a number of pilot programs were implemented and the feedback framework became more sophisticated, it expected that the framework would develop into an effective and efficient system that would be conducive to improving the quality of search and examination results of International Authorities.

23. The Delegation of the United States of America noted with appreciation the important work of the Quality Subgroup. It especially noted the work of the Quality Subgroup with regard to the availability of search strategies and continued to encourage all Authorities to make their search strategies available, as this was an important tool to aid examiners in evaluating the sufficiency of the search performed during the international phase.

24. The Assembly noted the contents of document PCT/A/44/2.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

25. Discussions were based on document PCT/A/44/3.

26. The Secretariat, in introducing document PCT/A/44/3, explained that the effect of the proposed amendments to the PCT Regulations would be, firstly, to require International Preliminary Examining Authorities to conduct a top-up search during the PCT Chapter II procedure, subject to various exceptions set out in the Rule as proposed to be amended; and, secondly, to allow opinions of the International Searching Authority and informal comments submitted by the applicant in response to such opinions to be available on PATENTSCOPE from the date of international publication. The proposed amendments had been discussed in great detail by the PCT Working Group, which had unanimously agreed that the Assembly should adopt the amendments as proposed.

27. The Delegation of Japan stated that it supported the proposed amendments to the PCT Regulations. It requested that, as a next step, detailed discussions on the implementation of top up searches should be held at the earliest opportunity; in this context, it was necessary to study further the discretion of each International Preliminary Examining Authority whether to conduct top-up searches on specific international applications, and possible transitional arrangements if practices were to be changed.

28. The Delegation of the United States of America supported the adoption of the proposed amendments of the Regulations under the PCT set out in Annex I to document PCT/A/44/3. The proposed amendments of Rules 66 and 70 related to top-up searching would help to maintain work product quality within the PCT system; the amendment of Rule 94 and deletion of 44ter, relating to the making available of written opinions by the International Searching Authority at the time of international publication, would promote transparency within the system. The Delegation further supported adoption of the decisions concerning entry into force and transitional arrangements in respect to the proposed amendments, as set out in Annex I to document PCT/A/44/3.

29. The Delegation of Norway considered that the proposed amendments relating to mandatory top-up searches for International Preliminary Examining Authorities would improve the quality of the PCT services provided during the national phase, for the benefit of third parties and national Offices. It thus supported the proposal to introduce such top-up searches. Furthermore, it supported the proposal to make the written opinions of the International

Searching Authorities available at the same date as the international publication of the international application.

30. The Assembly:

- (i) adopted the proposed amendments to the Regulations under the PCT set out in the Annex to this report;
- (ii) decided that the amendments of Rules 66 and 70 set out in the Annex to this document shall enter into force on July 1, 2014, and shall apply to any international application, irrespective of its international filing date, in respect of which a demand for international preliminary examination is made on or after July 1, 2014.
- (iii) decided that the deletion of Rule 44~~ter~~ and the amendment of Rule 94 set out in Annex I to this document shall enter into force on July 1, 2014, and shall apply to any international application whose international filing date is on or after July 1, 2014.

APPOINTMENT OF THE STATE INTELLECTUAL PROPERTY SERVICE OF UKRAINE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

31. Discussions were based on document PCT/A/44/4 Rev.

32. The Secretariat stated that the only changes in document PCT/A/44/4 Rev. compared to the original document PCT/A/44/4 were to be found in Appendix 4 of the document, setting out the draft Agreement between the Intellectual Property Service of Ukraine and the International Bureau; those changes were highlighted by the usual underlining and strike through of the text concerned.

33. The Chair referred to the twenty-sixth session of the PCT Committee for Technical Cooperation (PCT/CTC) which had been held earlier and the fact that that Committee had given a favorable opinion on the proposed appointment of the State Intellectual Property Service of Ukraine as an International Searching and Preliminary Examining Authority under the PCT.

34. The Delegation of Ukraine expressed its most sincere gratitude to the Director General of WIPO and to the Delegations of Japan, Austria, Finland, Chile and Hungary, all of which had expressed their favorable opinion and comments during the session of the PCT/CTC. The State Intellectual Property Service of Ukraine considered it as a great honor to be appointed as an International Searching and Preliminary Examining Authority under the PCT, and saw its appointment as an obligation to make a contribution to the development of the global patent system. The Delegation highly appreciated the support by all delegations that had assisted the State Service in its endeavor to be appointed as an International Authority.

35. The Assembly, having heard the Representative of the State Intellectual Property Service of Ukraine and taking into account the advice of the PCT Committee for Technical Cooperation, unanimously:

- (i) approved the text of the draft Agreement between the State Intellectual Property Service of Ukraine and the International Bureau as set out in Appendix IV to document PCT/A/44/4 Rev; and
- (ii) appointed the State Intellectual Property Service of Ukraine as an International Searching Authority and an International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2017.

36. The Director General of WIPO, Mr. Francis Gurry, congratulated the Delegation of Ukraine and the State Intellectual Property Service of Ukraine on the appointment of the State Intellectual Property Service of Ukraine as an International Searching and Preliminary Examining Authority under the PCT, and welcomed the State Intellectual Property Service of Ukraine to the family of International Authorities.

[Annex follows]

AMENDMENTS OF THE PCT REGULATIONS
TO ENTER INTO FORCE ON JULY 1, 2014

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Rule 44~~ter~~

[Deleted]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 and 66.1.bis *[No Change]*

66.1~~ter~~ *Top-up Searches*

The International Preliminary Examining Authority shall conduct a search (“top-up search”) to discover documents referred to in Rule 64 which have been published or have become available to the said Authority for search subsequent to the date on which the international search report was established, unless it considers that such a search would serve no useful purpose. If the Authority finds that any of the situations referred to in Article 34(3) or (4) or Rule 66.1(e) exists, the top-up search shall cover only those parts of the international application that are the subject of international preliminary examination.

66.2 to 66.8 *[No change]*

Rule 70

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

70.1 *[No change]*

70.2 *Basis of the Report*

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

(f) The report shall indicate the date on which a top-up search under Rule 66.1~~ter~~ was made, or else state that no top-up search was made.

70.3 to 70.17 *[No change]*

Rule 94

Access to Files

94.1 *Access to the File Held by the International Bureau*

(a) [No change]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

(c) [No change]

94.2 and 94.3 *[No change]*

[End of Annex and of document]

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Sixth (27th Extraordinary) Session
Geneva, September 22 to 30, 2014

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/54/1): 1, 3 to 6, 10, 12, 18, 26 and 27.
2. The report on the said items, with the exception of item 18, is contained in the General Report (document A/54/13).
3. The report on item 18 is contained in the present document.
4. The meeting of the Assembly was presided over by Ms. Susanne Ås Sivborg (Sweden), Chair of the PCT Assembly.

PCT WORKING GROUP: REPORT OF SEVENTH SESSION

5. Discussions were based on document PCT/A/46/1.
6. The Secretariat, in introducing document PCT/A/46/1, referred to the Summary by the Chair of the seventh session of the PCT Working Group, which was annexed to the document and provided an overview and summary of the items discussed and agreements reached during the session. There had been a full agenda for the session, with 34 agenda items and 28 working documents, more than any previous session of the PCT Working Group. This again confirmed the great interest in the further development of the PCT System as the backbone and central node of the international patent system. The focus of discussions at the sessions had been on two items which had been submitted to the Assembly as separate working documents, namely: (i) amendments to the PCT Regulations, notably to the Schedule of Fees, proposing a

new set of criteria determining the eligibility of applicants from certain countries for fee reductions (document PCT/A/46/3); and (ii) procedures for the appointment of International Searching and Preliminary Examining Authorities under the PCT (document PCT/A/46/4). The Secretariat also highlighted two issues which the Working Group had discussed in addition to a large number of detailed proposals of a legal or technical nature, many requiring further discussions. First, the Working Group had discussed possible fee reductions for small and medium-sized enterprises (SMEs), universities and research institutes. For SMEs, the Working Group had agreed there was no clear way forward. In particular, the Working Group had noted the need to find possible ways to introduce such fee reductions in a financially-sustainable, income-neutral way for the Organization, and the absence of an internationally-recognized common definition of what constituted an SME which could be used for the purpose of determining eligibility for PCT fee reductions. The Working Group had, therefore, agreed that no further work would take place on fee reductions for SMEs until a Member State made a concrete proposal. Discussions in the Working Group would, however, continue on possible new fee reductions for universities, where the Working Group had requested the Secretariat to work with the Chief Economist of WIPO to provide a supplementary study for discussion at next year's session of the Working Group. Second, the Working Group had further discussed a proposal by the United Kingdom and the United States of America to formally integrate the Patent Prosecution Highway into the PCT. However, there had been no consensus in the Working Group to take this proposal forward at this stage. Finally, in addition to the Summary by the Chair, the full draft report of the session had now been made available on the WIPO web site in all six UN languages, for comments by delegations by October 22, 2014.

7. The Delegation of Sweden emphasized the importance of the PCT System and its commitment to the valuable work of the PCT Working Group striving to improve the functioning of the system. The Delegation, therefore, welcomed the report from the seventh session of the PCT Working Group and supported the recommendations in the document. In relation to quality, the Delegation underlined the importance of International Authorities, such as the Swedish Patent and Registration Office, continuously improving work processes and the quality of results delivered to enhance the quality of the PCT System for the benefit of users and other stakeholders. This was of great importance to maintaining the attractiveness of the system as one which added value and to ensuring the long-term stability of WIPO. The Delegation, therefore, noted with appreciation the report on ongoing quality-related work in document PCT/A/46/2. In the same vein, the Delegation supported the Understanding on the procedures for the appointment of International Authorities recommended by the PCT Working Group set out in document PCT/A/46/4, which, it believed, was a valuable component to assure the efficiency and quality of the PCT System. Furthermore, the Delegation supported the amendments of the PCT Regulations proposed in document PCT/A/46/3, which, it believed, would increase the accessibility of the PCT System at a global level. Finally, the Delegation congratulated the Intellectual Property Office of Singapore on its appointment as an International Searching and Preliminary Examining Authority under the PCT.

8. The Assembly:

- (i) noted the Summary by the Chair of the seventh session contained in document PCT/WG/7/29 and reproduced in the Annex of document PCT/A/46/1; and
- (ii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 3 of document PCT/A/46/1.

QUALITY-RELATED WORK BY INTERNATIONAL AUTHORITIES

9. Discussions were based on document PCT/A/46/2.

10. The Secretariat stated that the main purpose of document PCT/A/46/2 was to report on the outcome of the fourth informal meeting of the Quality Subgroup of the Meeting of International Authorities, which had taken place in Tel Aviv in February 2014. The Summary by the Chair of that meeting was attached in the Annex to the document. The focus of the fourth meeting of the Quality Subgroup had again been on effective quality improvement measures, that is, measures to improve the overall quality and usefulness of international search reports and international preliminary reports on patentability for the benefit of all stakeholders in the PCT System. The work had, in particular, focused on measures helping designated Offices to better understand the work products of the International Authorities, so as to increase confidence of those Offices in these reports, which would allow them to make best use of these products in the national phase: Issues discussed in this context included, for example, the sharing of search strategies and the use of standardized clauses in reports. Work had also focused on further quality improvement measures, that is, measures to improve the quality of the work products of the International Authorities: Issues discussed in this context included, for example, the proposal to establish formal mechanisms for feedback by designated Offices on the quality of the reports of the International Authorities. Finally, the Quality Subgroup had discussed the latest report compiled by the International Bureau on characteristics of international search reports prepared by the various International Authorities, a “self-reflecting tool” for Authorities not to measure quality but to see what can be learned from such characteristics in order to assist the direction of further work to improve quality, either internally within an Authority or collectively between all Authorities. The Quality Subgroup had also continued its discussions relating to the development of quality metrics for the entire PCT System, covering the work of receiving Offices, International Authorities, designated/elected Offices and the International Bureau. As for the further work of the Quality Subgroup, the Meeting of International Authorities at its February 2014 session approved the continuation of the mandate of the Quality Subgroup, including the convening of a further physical meeting in 2015.

11. The Delegation of Japan acknowledged the importance of continuously improving the PCT System as a foundation in terms of generating stable income to support the activities of WIPO and also as an essential tool for users to acquire rights across the world. It was, therefore, the responsibility of Member States to work on improving the PCT System. In order to improve the quality of search and examination results at every International Searching Authority, it was extremely important to establish an international framework that would enable feedback on international search reports and written opinions by International Searching Authorities to be sent from designated Offices, as referred to in paragraph 5 of the document. The Delegation was, therefore, grateful for the work by the Secretariat on this issue. Based on this framework, Offices would be able to provide feedback on examination results to one another. As a result, the quality of searches and examinations at Offices would improve, thereby further enhancing the value of the PCT System in the future. The Japan Patent Office had started a pilot program with the Swedish Patent and Registration Office this year to provide feedback on the results of examination. Moreover, the Japan Patent Office and the European Patent Office had collaborated last year on the detailed analysis of files in which examination results between the two Offices differed by searching for the causes of the discrepancies. This exercise was being repeated this year as part of phase 3 of the collaborative metrics study. The Delegation, therefore, hoped that this framework would develop into an effective and efficient system that would be conducive to improving the quality of search and examination results at every International Searching Authority and serve to advance cooperative activities with other Offices.

12. The Delegation of the United States of America was pleased with the work carried out by the Quality Subgroup at its meeting in February 2014, particularly the discussions on making search strategies available and on forming a proposed contact group led by the European

Patent Office tasked with planning a pilot project to develop ways to disseminate the search strategies and evaluate their effectiveness. The Delegation reiterated its belief that all International Authorities should voluntarily make available their full search strategies on PATENTSCOPE. With respect to the use of standardized clauses by International Authorities, the Delegation supported the recommendation that the International Bureau should finalize the clauses which should be available online and which could be used at the discretion of each Authority. Furthermore, the Delegation supported the recommendation that the International Bureau should modify Chapter 21 of the International Search and Preliminary Examination Guidelines to provide for the optional use of checklists as part of the quality assurance process, which should be tailored to the needs of individual Authorities. The Delegation acknowledged that many other topics of great interest and usefulness to improving the quality of the PCT System were discussed during the most recent physical meeting of the Quality Subgroup and it concluded by expressing support for continuing the work agreed to at that meeting and thanking the International Bureau for its ongoing good work on the PCT System.

13. The Delegation of China stated that the Quality Subgroup had had fruitful discussions at its fourth informal session, notably on various items aimed at promoting the sharing of quality management information among International Authorities. The Delegation expressed its appreciation for the efforts by the Quality Subgroup and International Authorities to improve the quality of the PCT System, increasing the attractiveness of the system and accumulating valuable experience for future work. As an International Authority, the State Intellectual Property Office of the People's Republic of China (SIPO) had undertaken work to improve the quality of PCT search and preliminary examination. For example, this year, SIPO and the European Patent Office had carried out a joint study on indicators, which analyzed the differences between the two Offices in search and preliminary examination at the international and national phases.

14. The Assembly took note of the report on the Quality-Related Work by International Authorities as set out in document PCT/A/46/2.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

15. Discussions were based on document PCT/A/46/3.

16. The Secretariat introduced the document, which outlined the proposed amendments to the PCT Regulations set out in Annex I. All of the proposed amendments had been discussed in detail by the PCT Working Group, which had unanimously agreed to recommend that the Assembly at this session should adopt the amendments as proposed. The Secretariat continued by explaining the proposed revision of the eligibility criteria for fee reductions for certain applicants from certain states, notably developing and least developed countries. The amendments to item 5 of the Schedule of Fees as agreed by the PCT Working Group would update the income-based criterion used since the mid-1990s and introduce an innovation-based criterion to determine the States whose nationals and residents would be eligible for reductions of the fees listed in the Schedule of Fees in respect of international applications filed by applicants who are natural persons. All applicants, whether natural persons or not, from States classified as being least developed countries, would continue to benefit from the fee reductions as was presently the case. During the most recent session of the Working Group, it was generally acknowledged that the agreed set of new criteria were perhaps not perfect, but struck a good balance between the various interests of Member States and were a step in the right direction, following year-long, detailed and at times difficult discussions in the Working Group. Taking into account this "compromise nature" of the agreed new set of criteria, Member States agreed that the criteria for fee reductions should be reviewed by the Assembly every five years and that two years after the implementation of the new criteria, a progress report by the International Bureau should be presented to the Working Group to assess the effect of the fee reductions based on the new criteria. In relation to the text of the proposed amendments, the Secretariat proposed two minor changes. First, in sub-item 5(a) of the Schedule of Fees, the International Bureau proposed to replace the words "or 50 international applications per year"

with "or less than 50 international applications per year" to avoid any possible ambiguity. Second, in paragraph 2 of the Directives in Annex II to the document, the International Bureau proposed to replace the erroneous reference in that paragraph to "Rule 15.4" by the correct reference to "Rule 15.3". As for the proposed first list of States whose applicants would become eligible for the fee reductions under the new criteria as of the date of entry into force of the proposed amendments to the Schedule of Fees on July 1, 2015, that list of States was in Annex III to the document. In accordance with the main principles of the Directives set out in Annex II to the document, Contracting States and States entitled to observer status in the Assembly were invited to comment on the list of States set out in Annex III before the end of this session of the Assembly. The Secretariat reported that it had not, so far, received any comments on the proposed list, and any State that had comments to provide should do so before the end of this session of the Assembly. Taking into account any comments received, the Director General would establish the first list of States eligible for fee reductions under the proposed new criteria shortly after this session of the Assembly, to apply as of the date of entry into force of the amended Schedule of Fees, that is, as of July 1, 2015.

17. The Assembly:

- (i) adopted the proposed amendments to the Regulations under the PCT set out in Annex I to this report;
- (ii) decided that the amendments of Rules 49~~ter~~ and 76 set out in Annex I to this report shall enter into force on July 1, 2015, and shall apply to any express request under Article 23(2) or Article 40(2) received on or after July 1, 2015;
- (iii) decided that the amendments of Rule 90.3 set out in Annex I to this report shall enter into force on July 1, 2015;
- (iv) decided that amendments of Rule 90.5 set out in Annex I to this report shall enter into force on July 1, 2015, and shall apply to any notice of withdrawal referred to in Rules 90~~bis~~.1 to 90~~bis~~.4 received on or after July 1, 2015;
- (v) decided that amendments of the Schedule of Fees set out in Annex I to this report shall enter into force on July 1, 2015; in the case of reductions to the international filing fee, the Schedule of Fees as amended with effect from July 1, 2015 shall apply to any international application received by the receiving Office on or after July 1, 2015, but the Schedule of Fees as in force until June 30, 2015 shall continue to apply to any international application received before July 1, 2015, irrespective of what international filing date might later be given to such application (Rule 15.3); in the case of reductions to the handling fee and the supplementary search handling fee, the Schedule of Fees as amended with effect from July 1, 2015 shall apply to any international application in respect of which the fee was paid on or after July 1, 2015, irrespective of when the request for supplementary international search or the demand for international preliminary examination, respectively, was submitted (Rules 45~~bis~~.2(c) and 57.3(d));
- (vi) decided that the Director General shall establish the first list of States which meet the criteria referred to in items 5(a) and (b) of the amended Schedule of Fees set out in Annex I to this report following the end of this session of the Assembly, taking into account any comments received before the end of this session of the Assembly from Contracting States and States entitled to observer status on the draft list set out in Annex III to document PCT/A/46/3, and that the first list of States shall be published in the Gazette and become applicable on July 1, 2015;

(vii) took note that the draft list of States whose applicants would become eligible for fee reductions under the amended Schedule of Fees, set out in Annex III to document PCT/A/46/3, was available to Contracting States and States entitled to observer status for comment before the end of this session of the Assembly;

(viii) adopted the proposed Directives of the Assembly for updating the list of States meeting the criteria for reduction of certain PCT fees set out in Annex II to this report; and

(ix) decided that the Directives for updating the lists of States meeting the criteria for reduction of certain PCT fees set out in Annex II to this report shall enter into force on July 1, 2015.

PROCEDURES FOR APPOINTMENT OF INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES UNDER THE PCT

18. Discussions were based on document PCT/A/46/4.

19. The Secretariat, in introducing document PCT/A/46/4, recalled that the Assembly, at its forty-fourth session in 2013, had requested the International Bureau to undertake a review of the criteria and procedures for appointment of an Office as an International Authority and make proposals for necessary changes, if any, in coordination, where appropriate, with the Meeting of International Authorities, for discussion by the Working Group at its 2014 session. Accordingly, the International Bureau had undertaken the requested review and, following a first round of discussions at the February 2014 Meeting of International Authorities, had presented a working document for discussion at the June 2014 session of the Working Group. With regard to the substantive criteria for appointment, the Working Group had agreed that it was premature to recommend any changes. Noting that the key issue at stake was to ensure that Offices were able to perform international search and preliminary examination to the necessary level of quality, the Working Group had agreed to await the outcome of discussions in the Quality Subgroup, which had been tasked by the PCT/MIA to further consider the quality requirements to act effectively as an Authority and how these could be better expressed in the criteria for appointment. However, with regard to the procedures for appointment, the Working Group had agreed that the procedures for appointment would greatly benefit from the inclusion of a proper expert review of the application of an Office prior to a decision being taken by the Assembly. The Working Group had thus recommended that the PCT Assembly adopt an Understanding, as set out in the document, to ensure that the PCT/CTC, entrusted by the Treaty to give its advice to the Assembly on any application for appointment, should always meet as a true expert body, well in advance of the PCT Assembly, to ensure that the process leading up to the decision by the Assembly was more useful and efficient. In addition, the Working Group further recommended that Offices seeking appointment should meet all the necessary criteria at the time of appointment, save for a specific exception regarding quality management systems as indicated in paragraph (d) of the draft Understanding, since such systems could not be brought into effective operation until the Office seeking appointment commenced operation as an International Authority. This issue was also covered in the Understanding. Finally, the Working Group had recommended that the new procedures for appointment of International Authorities as set out in the Understanding should apply to any application for appointment as an International Authority submitted after the closure of the present session of the PCT Assembly.

20. The Delegation of the United States of America expressed the view that the current requirements and procedures for becoming an International Authority should be updated to reflect the realities of the twenty-first century in order to continue the increasing acceptance of international search and examination. As a step towards updating these requirements and procedures, the Delegation supported the adoption of the procedures for appointment of International Authorities recommended by the Working Group in paragraph 6 of the document, particularly the changes resulting in the PCT Committee for Technical Cooperation meeting as a true expert body in advance of the PCT Assembly to consider a request for appointment of an

Office as an International Authority. Regarding the substantive criteria, the Delegation agreed with the Working Group that it would be premature to attempt to revise the requirements at this time and to await the outcome of the discussions by the Quality Subgroup, which had been tasked by the Meeting of International Authorities to consider the quality requirements to act effectively as an Authority.

21. The Delegation of Spain congratulated the Intellectual Property Office of Singapore on their appointment as an International Searching and Preliminary Examining Authority. The Delegation affirmed the continued commitment of Spain in supporting the PCT System, for example, by the work of the Spanish Patent and Trademark Office as an International Searching and Preliminary Examining Authority and through training programs, such as the IP in Latin America program, which had often been the first contact for Latin American countries with the PCT System and had encouraged them to become a PCT Contracting State. The Delegation welcomed and supported the conclusions of the seventh session of the PCT Working Group in the document. Cooperation was essential yet it had been underused and in practice did not correspond to the way provided by the PCT Regulations. The Delegation, therefore, believed that it was necessary to maintain the present requirements for appointment as an International Authority, as outlined in the PCT Treaty and Regulations, but emphasized that there needed to be greater rigor in compliance with these requirements. On this basis, the Delegation supported the adoption of the Understanding set out in paragraph 6 of the document.

22. The Delegation of Chile announced that the National Institute of Industrial Property of Chile (INAPI) would begin operations as an International Searching and Preliminary Examining Authority on October 22, 2014, within the planned timeframe of two years after its appointment by the Assembly. The Delegation stated that the President of Chile and the Director General of WIPO would be present at INAPI to mark this event. Arriving at this stage had not been easy; it had involved hard work over several years, but this had allowed INAPI to ensure that it was truly in a position to make its capacities available to the international patent system, especially for countries in the Latin American region, whom the Delegation thanked in particular for their support. In order to achieve the objective of becoming an operational International Searching and Preliminary Examining Authority, INAPI had designed and implemented a modernization program. This had included redesigning its internal structure and procedures, increasing the number of expert professionals in search and examination across different areas of technology, using new databases and quality control systems for the management and review of international patent applications filed under the PCT, and using the online ePCT System developed by WIPO, among other measures. The Delegation thanked the IP Offices of Australia, Canada, Israel and the United States of America for their cooperation in implementing these processes, as well as the International Bureau for its continued support for the project. The Delegation underscored its belief that INAPI operating as an International Searching and Preliminary Examining Authority under the PCT would serve foreign applicants in Latin America who, based on the reputation of INAPI and the use of the Spanish language, may choose INAPI for international search and preliminary examination. Moreover, innovators in Chile would be able to use their national Office both as a receiving Office and an International Searching and Preliminary Examining Authority, facilitating the processing of their patent applications. Finally, the Delegation reaffirmed its commitment to continue to participate actively in the international patent system and the PCT, contributing its work and experience to the continual improvement of the system, within the frameworks of national legislation and the interests of its users.

23. The Delegation of the Republic of Korea supported the revised procedure pertaining to appointment of new International Authorities. The new procedure would facilitate participation of experts and strengthen the technical support for the candidate Office, leading to improvements in international search and preliminary examination. Furthermore, even though it might be premature at this moment, the Delegation hoped that discussions would continue on the substantive criteria at some point in the near future, since the current criteria, first established in the 1970s, might not fully reflect the modern examination environment.

24. The Delegation of China supported the adoption of the Understanding concerning procedures for appointment of International Authorities, which would strengthen the role of the Committee for Technical Cooperation by meeting as an expert body. This would be useful for the Offices wishing to become International Authorities to fulfill the requirements and become operational as soon as possible after their appointment.

25. The Assembly adopted the following Understanding:

“Procedures for Appointment of International Authorities”:

“(a) A national Office or an intergovernmental organization (“Office”) seeking appointment is strongly recommended to obtain the assistance of one or more existing International Authorities to help in the assessment of the extent to which it meets the criteria, prior to making the application.

“(b) Any application for appointment of an Office as an International Authority is to be made well in advance of its consideration by the PCT Assembly so as to allow time for an adequate review by the Committee for Technical Cooperation (PCT/CTC). The PCT/CTC should meet as a true expert body at least three months in advance of the PCT Assembly, if possible back-to-back with a session of the PCT Working Group (usually convened around May/June of any given year), with a view to giving its expert advice on the application to the PCT Assembly.

“(c) Consequently, a written request to the Director General to convene the PCT/CTC is to be sent by the Office preferably by March 1 of the year in which the application is to be considered by the PCT Assembly and in any case in time to allow the Director General to send out letters of convocation of the PCT/CTC not less than two months prior to the opening of the session.

“(d) Any such application should be made on the understanding that the Office seeking appointment must meet all substantive criteria for appointment at the time of the appointment by the Assembly and is prepared to start operation as an International Authority as soon as reasonably possible following appointment, at the latest around 18 months following the appointment. With regard to the requirement that the Office seeking appointment must have in place a quality management system and internal review arrangements in accordance with the common rules of international search, where such system is not yet in place at the time of the appointment by the Assembly, it shall be sufficient that such system is fully planned and, preferably, that similar systems are already operational in respect of national search and examination work to demonstrate the appropriate experience.

“(e) Any document by the Office in support of its application for consideration by the PCT/CTC should be submitted to the Director General at the latest two months prior to the opening of the session of the PCT/CTC.

“(f) Any such application is then to be submitted to the PCT Assembly (usually convened around September/October of any given year), together with any advice given by the PCT/CTC, with a view to deciding on the application.”

26. The Assembly decided that the procedures for appointment of International Authorities set out in the above Understanding shall apply to any application for appointment as an International Authority submitted after the closure of the present session of the PCT Assembly.

APPOINTMENT OF THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

27. Discussions were based on document PCT/A/46/5.

28. The Chair referred to the twenty-seventh session of the PCT Committee for Technical Cooperation (PCT/CTC) which had been held earlier and the fact that the Committee had given a favorable opinion on the proposed appointment of the Intellectual Property Office of Singapore as an International Searching and Preliminary Examining Authority under the PCT.

29. The Delegation of Singapore expressed its appreciation for the interventions made in support of the appointment of the Intellectual Property Office of Singapore as an International Searching and Preliminary Examining Authority under the PCT, and the favorable opinion from the PCT Committee for Technical Cooperation.

30. The Assembly, having heard the Representative of the Intellectual Property Office of Singapore and taking into account the advice of the PCT Committee for Technical Cooperation, unanimously:

- (i) approved the text of the draft Agreement between the Intellectual Property Office of Singapore and the International Bureau as set out in Annex II to document PCT/A/46/5; and
- (ii) appointed the Intellectual Property Office of Singapore as an International Searching Authority and an International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2017.

[Annex I follows]

AMENDMENTS OF THE PCT REGULATIONS
TO ENTER INTO FORCE ON JULY 1, 2015

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Rule 49ter

Effect of Restoration of Right of Priority by Receiving Office;

Restoration of Right of Priority by Designated Office

49ter.1 [No change]

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

(a) [No change]

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

(i) be filed with the designated Office within a time limit of one month from the applicable time limit under Article 22 or, where the applicant makes an express request to the designated Office under Article 23(2), within a time limit of one month from the date of receipt of that request by the designated Office;

(ii) and (iii) [No change]

(c) to (h) [No change]

Rule 76

Translation of Priority Document;

Application of Certain Rules to Procedures before Elected Offices

76.1 to 76.4 *[No change]*

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

Rules 13^{ter}.3, 20.8(c), 22.1(g), 47.1, 49, 49^{bis}, 49^{ter} and 51^{bis} shall apply, provided that:

- (i) *[No change]*;
- (ii) any reference in the said Rules to Article 22, Article 23(2) or Article 24(2) shall be construed as a reference to Article 39(1), Article 40(2) or Article 39(3), respectively;
- (iii) to (v) *[No change]*

Rule 90

Agents and Common Representatives

90.1 and 90.2 *[No Change]*

90.3 *Effects of Acts by or in Relation to Agents and Common Representatives*

(a) and (b) *[No change]*

(c) Subject to Rule 90bis.5, second sentence, any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

90.4 *[No Change]*

90.5 *General Power of Attorney*

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

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 to the receiving Office, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau, as the case may be, a copy of the general power of attorney shall be submitted to that Office, Authority or Bureau.

90.6 *[No change]*

SCHEDULE OF FEES

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,330 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Supplementary search handling fee: (Rule 45 <i>bis</i> .2)	200 Swiss francs
3. Handling fee: (Rule 57.2)	200 Swiss francs

Reductions

4. The international filing fee is reduced by the following amount if the international application is, as provided for in the Administrative Instructions, filed:

(a) in electronic form, the request not being in character coded format:	100	Swiss francs
(b) in electronic form, the request being in character coded format:	200	Swiss francs
(c) in electronic form, the request, description, claims and abstract being in character coded format:	300	Swiss francs

5. The international filing fee under item 1 (where applicable, as reduced under item 4), the supplementary search handling fee under item 2 and the handling fee under item 3 are reduced by 90% if the international application is filed by:

- (a) an applicant who is a natural person and who is a national of and resides in a State that is listed as being a State whose per capita gross domestic product is below US\$ 25,000 (according to the most recent 10-year average per capita gross domestic product figures at constant 2005 US\$ values published by the United Nations), and whose nationals and residents who are natural persons have filed less than 10 international applications per year (per million population) or less than 50 international applications per year (in absolute numbers) according to the most recent five-year average yearly filing figures published by the International Bureau; or
- (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is listed as being classified by the United Nations as a least developed country;

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b). The lists of States referred to in sub-items (a) and (b) shall be updated by the Director General at least every five years according to directives given by the Assembly. The criteria set out in sub-items (a) and (b) shall be reviewed by the Assembly at least every five years.

[Annex II follows]

DIRECTIVES FOR UPDATING THE LISTS OF STATES
MEETING THE CRITERIA FOR REDUCTION OF CERTAIN PCT FEES

The Assembly establishes in the following terms the directives referred to in the Schedule of Fees, it being understood that, in the light of experience, the Assembly may at any time modify these directives:

1. Five years after the establishment of the first list of States which meet the criteria referred to in items 5(a) and (b) of the Schedule of Fees, and every five years thereafter, the Director General shall prepare draft lists of States which appear to meet the criteria referred to in:

(i) item 5(a) of the Schedule of Fees according to the most recent 10-year average per capita gross domestic product figures from the United Nations and according to the most recent five-year average yearly PCT filing figures by the International Bureau, respectively, published at least two weeks prior to the first day of the session of the Assembly in September/October of that year;

(ii) item 5(b) of the Schedule of Fees according to the most recent list of countries classified as least developed countries by the United Nations published at least two weeks prior to the first day of the session of the Assembly in September/October of that year;

and shall make those lists available to the PCT Contracting States and States entitled to observer status in the Assembly for comment before the end of that session of the Assembly.

2. Following the end of that session of the Assembly, the Director General shall establish new lists, taking into account any comments received. The revised lists shall become applicable on the first day of the calendar year subsequent to that session and shall be used to determine, in accordance with Rules 15.3, 45*bis*.2(c) and 57.3(d), the eligibility for the fee reduction under items 5(a) and (b), respectively, of the Schedule of Fees of any relevant fee payable. Any revised list shall be published in the Gazette.

3. Where any State is not included in a particular list but subsequently becomes eligible for inclusion in that list due to the publication, after the expiration of the period of two weeks prior to the first day of the session of the Assembly referred to in paragraph 1, above, of revised per capita gross domestic product figures by the United Nations or revised PCT filing figures by the International Bureau, or of a revised list of States that are being classified as least developed countries by the United Nations, that State may request the Director General to revise the relevant list of States so as to include that State in the relevant list. Any such revised list shall become applicable on a date to be specified by the Director General, that date being no more than three months from the date of receipt of the request. Any revised list shall be published in the Gazette.

[End of Annex II and of document]

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Seventh (20th Ordinary) Session
Geneva, October 5 to 14, 2015

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/55/1): 1 to 6, 10, 11, 19, 31 and 32.
2. The report on the said items, with the exception of item 19, is contained in the General Report (document A/55/13).
3. The report on item 19 is contained in the present document.
4. Ms. Susanne Ås Sivborg (Sweden) was re-elected Chair of the Assembly; Ms. Zheng Huifen (China) and Mr. Sandris Laganovskis (Latvia) were elected Vice-Chairs. In the absence of the Chair and both Vice-Chairs, the Chair of the WIPO General Assembly, Ambassador Gabriel Duque (Colombia), acted as Chair on an *ad hoc* basis and presided over those parts of the discussions referred to in paragraphs 84 and 85.

ITEM 19 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

Report on the PCT Working Group

5. Discussions were based on document PCT/A/47/1.
6. The Secretariat introduced the document, which set out a report of the eighth session of the PCT Working Group. The session had a full agenda, with 30 agenda items and 24 working documents. This again confirmed the great interest in the further development of the PCT System as the backbone and central node of the international patent system. For a number of issues discussed and agreed by the Working Group, separate working documents had been submitted to this Assembly, namely documents PCT/A/47/3, 4 Rev. and 5 Rev. An overview of all items discussed and agreements reached was provided in the Summary by the Chair attached to the document.
7. The Assembly:
 - (i) took note of the Summary by the Chair of the eighth session of the Working Group contained in document PCT/WG/8/25; and
 - (ii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 5 of document PCT/A/47/1.

Quality-Related Work by International Authorities

8. Discussions were based on document PCT/A/47/2.
9. The Secretariat explained that the document set out a brief report on the ongoing quality work by the International Searching and Preliminary Examining Authorities, pursued mainly through the work of the Meeting of International Authorities and, notably, its Quality Subgroup. The main purpose of the document was to report on the outcome of the fifth informal meeting of the Quality Subgroup, which was held in Tokyo in February 2015. During that meeting, International Authorities had continued their discussions on possible measures to improve the overall quality and usefulness of the international work products of the PCT, namely, the international search reports and the international preliminary reports on patentability established by the International Authorities.
10. The Delegation of Japan, representing the host country for the Meeting of International Authorities and its Quality Subgroup in 2015, expressed its gratitude to the participants of both these meetings. In order to improve the quality of search and preliminary examination results of International Searching Authorities, the Japan Patent Office (JPO) had conducted a pilot study with the Swedish Patent and Registration Office in 2014. This pilot was designed to give feedback from designated Offices on international search reports and written opinions of International Searching Authorities, as was referred to in paragraph 6 of the document. Moreover, the JPO and the European Patent Office (EPO) had collaborated by performing a detailed analysis of files in which examination results between the two Offices differed from the search results to investigate the causes of discrepancies. This analysis, which was part of the joint collaborative metrics project referred to in paragraph 7 of the document, had been performed in 2014 and would be repeated in 2015. The Delegation concluded by expressing the hope that this initiative would be conducted to improve the quality of search and examination in every International Searching and Preliminary Examining Authority.

11. The Delegation of the United States of America stated that it was pleased with the work carried out by the Quality Subgroup at its February 2015 meeting in Tokyo and believed that the results obtained would lead to improving the PCT System. In particular, the Delegation expressed satisfaction that the three track approach to evaluate options for making available search strategies had been approved, and added that this approach should provide data to identify an effective way to share information between Offices. On this issue, the Delegation requested the International Bureau to conduct a survey of all users – applicants, patent examiners and third parties – to compare and contrast the search recordation formats used in the three tracks so as to understand better their needs. The Delegation favored gathering additional experience on the voluntary use of standardized clauses by International Authorities before conducting an evaluation of their effectiveness. In addition, the Delegation agreed with the development of improved PCT metrics, as long as they were not excessively burdensome for Offices and properly reflected the issues of importance to Offices and users. Finally, regarding the substantive criteria for appointment of International Authorities, the Delegation supported further work on improving the requirements for quality management systems and on developing a standard application form for requesting appointment as an International Authority.

12. The Assembly took note of the report “Quality-Related Work by International Authorities” contained in document PCT/A/47/2.

Review of the Supplementary International Search System

13. Discussions were based on document PCT/A/47/3.

14. The Secretariat introduced the document, which set out a report by the International Bureau on the supplementary international search system. The report intended to serve as a basis for a review of that system by the Assembly, as had been decided by the Assembly in 2012, following the Assembly’s first review of the system three years after its date of entry into force back in 2009. As the report indicated, the uptake of supplementary international search had remained very low. Replies to a questionnaire on the supplementary international search system which the International Bureau had sent to all stakeholders suggested a number of reasons for the low interest, notably, the requirement to translate an international application if it was not in one of the languages offered by International Authorities for supplementary international search, the level of fees, the lack of an International Authority working in one of the Asian languages offering the service, and possible lack of awareness amongst applicants. None of the responses to the questionnaire suggested that supplementary international search should be discontinued at this stage. The report had been discussed in detail by the PCT Working Group at its most recent session in May 2015. Based on the report, the Working Group had recommended to the Assembly to adopt the decision set out in paragraph 5 of the document. This decision invited the International Bureau to continue to monitor the supplementary international search system for a further five years and to review the system again in 2020, to encourage Offices to continue their efforts to raise awareness of and promote the service to users of the PCT System, and to encourage International Authorities to review the scope and cost of the services that they offer under the system.

15. The Delegation of China stated that the development of the supplementary international search service should increase benefit for users. The Delegation therefore supported a further review of the supplementary international search system in 2020.

16. The Assembly took note of the Review of the Supplementary International Search System contained in document PCT/A/47/3.

17. The Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system and again in 2015, decided:

“(a) to invite the International Bureau to continue to closely monitor the system for a period of a further five years, and to continue to report to the Meeting of International Authorities and the Working Group on how the system is developing;

“(b) to invite the International Bureau, International Authorities and national Offices and user groups to continue their efforts to raise awareness of and promote the service to users of the PCT system;

“(c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;

“(d) to review the system again in 2020, taking into account further developments until then, notably in relation to developments in collaborative search and examination, and in relation to efforts to improve the quality of the ‘main’ international search.”

Proposed Amendments to the PCT Regulations

18. Discussions were based on document PCT/A/47/4 Rev.

19. The Secretariat introduced the document, which set out proposed amendments of the PCT Regulations. These amendments had been discussed in great detail by the PCT Working Group, which had unanimously agreed to recommend that this Assembly should adopt the amendments as proposed. The proposed amendments in the document related to the following: Transmittal by the Receiving Office of Earlier Search and/or Classification Results to the International Searching Authority (set out in Annex I); Omission of Certain Information from Public Access (set out in Annex II); Transmittal to the International Bureau of Copies of Document Received in the Context of a Request for Restoration of Right of Priority (set out in Annex III); Delays and Force Majeure for Electronic Communications (set out in Annex IV); Languages for Communication with the International Bureau (set out in Annex V); and Information Concerning National Phase Entry and Translations (set out in Annex VI). The Secretariat further explained that the document was a revised version (“Rev.”) of document PCT/A/47/4 as originally published in August. The only change compared to that document was the addition of some minor corrections concerning the proposals for entry into force and transitional arrangements in respect of the proposed amendments to the Rules set out in Annex I to the document, as further explained on the front page of the document.

20. The Assembly:

(i) adopted the amendments to the Regulations under the PCT set out in Annexes I and II to this report;

(ii) decided that the amendments of Rules 9, 26*bis*, 48, 82*quater*, 92 and 94 set out in Annex I to this report shall enter into force on July 1, 2016, and shall apply to any international application whose international filing date is on or after July 1, 2016;

(iii) decided that the amendments of Rule 82*quater* shall also apply to international applications whose international filing date is before July 1, 2016, where the event referred to in Rule 82*quater*.1(a), as amended, occurs on or after July 1, 2016;

(iv) decided that the amendments of Rule 92.2(d) shall also apply to correspondence received by the International Bureau on or after July 1, 2016, in

respect of international applications whose international filing date is before July 1, 2016, to the extent provided at the time of promulgation of any Administrative Instructions made under that Rule;

(v) decided that the amendments of Rules 12*bis*, 23*bis*, 41, 86 and 95 set out in Annex II to this report shall enter into force on July 1, 2017, and shall apply to any international application whose international filing date is on or after July 1, 2017;

(vi) decided that the amendments of Rules 86 and 95 shall also apply to any international application whose international filing date is before July 1, 2017, in respect of which the acts referred to in Article 22 or Article 39 are performed on or after July 1, 2017;

(vii) adopted the following Understanding concerning the provisions regarding the excuse of a delay in meeting a time limit due to a general unavailability of electronic communication services in accordance with the amended Rule 82*quater*:

“In adopting the amendments to Rule 82*quater*.1, the Assembly noted that the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau should, in considering a request under Rule 82*quater*.1 to excuse a delay in meeting a time limit that has not been met due to a general unavailability of electronic communication services, interpret general unavailability of electronic communications to apply to outages that affect widespread geographical areas or many individuals, as distinct from localized problems associated with a particular building or single user.”

(viii) adopted the following Understanding concerning the information which is to be provided in accordance with the amended Rules 86 and 95:

“In adopting the amendments to Rule 86.1(iv), the Assembly noted that the information concerning national phase entry will be made available to the public not only by way of inclusion in the Gazette on the PATENTSCOPE website but also as part of the bulk PCT bibliographic data offered to Offices and other subscribers to the PATENTSCOPE subscription data services.”

Proposed Modifications of the Directives of the Assembly Relating to the Establishment of Equivalent Amounts of Certain Fees

21. Discussions were based on document PCT/A/47/5 Rev.

22. The Secretariat explained the submission by the International Bureau of revised document PCT/A/47/5 Rev. The revised document proposed to postpone a decision on the modifications of the Directives of the Assembly Relating to the Establishment of Equivalent Amounts of Certain Fees, which the PCT Working Group had recommended to be adopted at the present session of the Assembly. The aim of those modifications was to enable the International Bureau to commence hedging of international filing fees as far as the risk resulting from transactions in euro, Japanese yen and United States dollar was concerned. Document PCT/A/47/5, published on August 4, 2015, had originally proposed to modify the Directives as agreed by the Working Group at its eighth session in May 2015, including clarifications on some minor issues which had been identified after that session. Following the eighth session of the Working Group, the WIPO Program and Budget Committee (PBC), at its July 2015 session, had requested the Secretariat to provide an update to its September 2015 session on the progress made in respect of the implementation of the proposed hedging strategy for PCT fee income. The requested update had been provided by way of document WO/PBC/24/INF.3, which was reproduced in document PCT/A/47/5 Rev. Document WO/PBC/24/INF.3 had identified several

concerns and risks which, in the view of the Secretariat, required further research and thorough analysis before committing to a particular hedging strategy and entering into contractual relationships with hedging counterparties. Given the complexity of the issues involved, such work would require time and resources, which could be significant. In the view of the International Bureau, if the hedging strategy were to be implemented without having limited the risks associated with the issues identified, the potential financial cost to the Organization could be considerable. The PBC had discussed document WO/PBC/24/INF.3 at its September 2015 session. In view of the concerns and risks identified therein, the PBC had recommended to the PCT Assembly to allow for more time for the Secretariat to further analyze the issues and to postpone its decision on the proposed modifications of the Directives until such analysis had been undertaken. The International Bureau agreed with this recommendation. Document PCT/A/47/5 Rev. therefore replaced document PCT/A/47/5 and proposed that the PCT Assembly should postpone a decision to adopt the proposed modifications to the Directives. Instead, document PCT/A/47/5 Rev. invited the Secretariat to further analyze the issues regarding the implementation of a hedging strategy for PCT fee income set out in document WO/PBC/24/INF.3 and to submit a progress report to the 2016 session of the Working Group.

23. The Assembly:

- (i) took note of the contents of document PCT/A/47/5 Rev.;
- (ii) invited the Secretariat to further analyze the issues regarding the implementation of a hedging strategy for PCT fee income set out in document WO/PBC/24/INF.3;
- (iii) postponed any decision on the proposed modifications to the Directives of the Assembly Relating to the Establishment of Equivalent Amounts of Certain Fees, as agreed by the PCT Working Group, until such analysis had been undertaken; and
- (iv) invited the Secretariat to submit a progress report to the 2016 session of the PCT Working Group.

Appointment of the Visegrad Patent Institute as an International Searching and Preliminary Examining Authority under the PCT

24. Discussions were based on documents PCT/A/47/6 and 6 Add.

25. The Chair referred to the twenty-eighth session of the PCT Committee for Technical Cooperation in May 2015, which had unanimously agreed to recommend to the Assembly of the PCT Union that the Visegrad Patent Institute (VPI) be appointed as an International Searching and Preliminary Examining Authority under the PCT, as stated in paragraph 5 of document PCT/A/47/6.

26. The Delegation of Hungary, speaking on behalf of the Delegations of the Czech Republic, Hungary, Poland and Slovakia (Visegrad Group, or "V4"), introduced the application for the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT. The Delegation acknowledged the Understanding concerning procedures for appointment of International Authorities adopted by the Assembly in 2014 (see paragraph 25 of document PCT/A/46/6) and stated that it was in full observance of these procedures that the VPI had submitted its application. The PCT Committee for Technical Cooperation had made a unanimous recommendation that the VPI be appointed as an International Searching and Preliminary Examining Authority. The VPI was an intergovernmental organization or co-operation in the field of patents established by the V4 countries. The VPI's main task would be to serve as an International Authority for Central and Eastern Europe in order to attain a wide range of important objectives at various levels. The VPI would fill a territorial gap within the PCT by acting as an International Authority for Central and Eastern Europe, it being noted that

the Group of Central European and Baltic States was the only regional group of WIPO within which there was no functioning International Authority under the PCT. In addition, the VPI would make up for the missing link in the network of PCT International Searching and Preliminary Examining Authorities in Europe, adding further competent resources to those already available, especially in respect of a region currently not having its own International Authority. Through completing the global coverage of International Authorities, the appointment of the VPI would contribute to a better understanding and wider use of the PCT System within the Central and Eastern European region, as well as leading to an improvement in quality of international applications originating from this region. Based on the long established traditions and expertise of the national Offices participating in the Visegrad cooperation, as well as under good quality management, the VPI would seek to become a reliable, efficient and constructive partner in the efforts to improve further the quality and efficiency of the global patent system. The VPI intended to participate actively in other international initiatives and projects aimed at workload sharing, quality improvements, further harmonization and better tailor-made services, for the benefit of users. In addition, the establishment of the VPI would fit in with the concept of the European Patent Network within the European Patent Organisation (EPO), and would also ensure a smooth interaction with the newly emerging regime of the unitary patent protection within the European Union. The VPI would serve the goals of fostering innovation and creativity, as well as promoting economic growth and competitiveness in the Central and Eastern European region. To achieve these goals, the VPI intended to offer applicants a favorable and efficient option for entering the PCT System. Users in all the Visegrad Group Contracting States fully supported the establishment of the VPI and its appointment as an International Searching and Preliminary Examining Authority under the PCT. The Delegation further highlighted the greater role that the Visegrad countries were well placed to play in the international patent system as emerging economies with growing economic output, intensifying participation in European global trade, improving competitiveness and sharpening the focus on innovation. The establishment of the VPI and its request for appointment as an International Authority followed the overall high level political objectives of the Visegrad or V4 co-operation, as recently confirmed by a joint declaration of the Prime Ministers of the Visegrad countries. In terms of its structure and tasks, the VPI would be an intergovernmental organization within the meaning of Article 16 and Rule 36. It would have legal personality and an extensive legal capacity necessary for the fulfillment of its tasks, including the possibility of acting on its own through the Director as its representative in all the matters concerning its role as an International Authority. It was envisaged that the VPI would act as an International Searching and Preliminary Examining Authority for international applications filed not only with the V4 Offices, but also the receiving Offices of European Patent Convention Contracting States adjacent to the V4 countries, provided the latter specified the VPI for that purpose. In fact, Lithuania and Romania had already indicated and confirmed their willingness to do so. When setting up the VPI, the Visegrad countries intended to act in full compliance with their obligations under the European Patent Convention (EPC) and its Protocol on Centralisation, and would do so in concluding and implementing the Agreement with the International Bureau of WIPO in relation to the functioning of the VPI as an International Searching and Preliminary Examining Authority. The structure of the VPI would follow the existing and successful model of the Nordic Patent Institute (NPI), as shown in Table 2 in Annex II to document PCT/CTC/28/2 attached to document PCT/A/47/6. Under the umbrella of the intergovernmental layer, the national Offices of the Contracting States would perform international search and examination on behalf of the VPI. Through harmonization of search and examination tools and practices, as well as through rigorous quality management at all stages of the procedure, it would be ensured that applicants would always receive a uniform VPI service of consistently high quality. The main task of the VPI would be to act as an International Searching and Preliminary Examining Authority, and it was planned that the VPI would also offer international-type searches and supplementary international searches. Concerning the new element for procedures for appointment International Authorities, namely, the involvement of existing International Authorities in the preparations for appointment, the VPI had requested the assistance of the JPO and the NPI to help in the assessment of the extent to which the VPI would meet the

appointment criteria. The JPO's involvement had been based on a Memorandum of Cooperation between the national industrial property Offices of the V4 countries and the JPO, which had been signed in September 2014. The NPI's assistance had been sought in view of the similarities between its structure, organization, principles, objectives and those of the VPI, as well as of the well-established cooperation between the Nordic countries and the V4 countries. After visiting the V4 Offices, these International Authorities reported to the PCT Committee for Technical Cooperation on the VPI's ability to meet the requirements of appointment, which had revealed no particular issue in respect of which any serious doubt would arise about the VPI's compliance with the appointment criteria. The Delegation thanked the JPO and the NPI for their invaluable assistance in this regard. Referring to the minimum requirements for appointment as an International Searching and Preliminary Examining Authority set out in Rule 36.1, the VPI was confident that, through the joint resources of the participating Offices, it was in full compliance with these criteria. This had been unanimously confirmed by the PCT Committee for Technical Cooperation on the basis of an expert level assessment, and also with regard to the reports of two existing International Authorities. The documents submitted in support of the VPI's application contained a great deal of information on the VPI's search and examination resources and the qualifications of its examiners, on its access to documentation for search and examination purposes, and on the quality management system and internal review arrangements, including those applied at the participating national Offices. Furthermore, the VPI would establish its own quality management system to cover all its procedures and services, which would be certified according to the ISO 9001 standard. Besides the resounding support from the Committee of Technical Cooperation for the appointment of the VPI as an International Authority, references were made by the Committee to the importance of developing appropriate mechanisms to ensure consistency of approach for four Offices as well as procedures between the four Offices in order to ensure smooth work flow and production of work products. Following that advice, the V4 national Offices had stepped up their efforts to establish a working environment ensuring consistency and smooth work flow at the VPI. Various work streams had been launched to that effect and had already delivered a number of tangible results, laying the groundwork for the VPI's efficient and high quality operation. The details of this work were contained in document PCT/A/47/6 Add. Before concluding, the Delegation informed the Assembly that the Agreement on the Visegrad Patent Institute had been ratified by all four countries. The instruments of ratification had been duly deposited by three of the countries, with Poland being expected to be final State to deposit its instrument of ratification in the coming days. The Agreement would therefore enter into force in early December, two months after the final instrument was deposited. This would therefore not hinder the Assembly from taking a positive decision on the appointment of the VPI as an International Authority, since the appointment would only take effect from entry into force of the Agreement between the VPI and the International Bureau as set out in the Annex to document PCT/A/47/6, and this Agreement would only be signed after the VPI Agreement had entered into force and the VPI formally established. This would enable the VPI to become operational as an International Searching and Preliminary Examining Authority on July 1, 2016, as planned. In conclusion, the V4 countries wished to express their firm view that the VPI would be able to meet all the applicable requirements of appointment as an International Searching and Preliminary Examining Authority. The VPI's operation as an International Authority would make an important contribution to economic growth, competitiveness and innovation in the region and beyond, as well as to the proper functioning of the global patent system established under the PCT. The V4 countries therefore requested the Assembly to take a positive decision on the request and appoint the VPI as an International Searching and Preliminary Examining Authority.

27. The Delegation of Romania, speaking on behalf of the Group of Central European and Baltic States (CEBS), supported the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT. The Delegation strongly believed that the VPI fulfilled the criteria provided for International Authorities under the PCT and would offer high quality services to applicants at more attractive costs, which was especially important for small and medium sized enterprises (SMEs) and for individual inventors. Moreover, the new Institute would contribute to spurring innovation and creativity in the region, for the benefit of users of the

patent system, and would be an active and constructive partner in the field of international cooperation. The Group looked forward to support from all members.

28. The Delegation of Austria thanked the representative of the VPI for his report providing additional information which, together with the documentation already available at the meeting of the Committee for Technical Cooperation, provided convincing evidence that the Institute fully met the requirements for appointment as International Searching and Preliminary Examining Authority under the PCT. Based on this documentation and on the positive experience which had been gained during various cooperation activities with the participating Offices, the Delegation of Austria, representing an existing Authority, reiterated its position already stated in the session of the CTC that it fully supported the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT. The Delegation looked forward to welcoming the VPI into the family of PCT Authorities and stood ready to offer support and assistance to the Institute in becoming operational as soon as possible. The Delegation wished all the best to the Institute and to the participating Offices of the Czech Republic, Hungary, Poland and Slovakia.

29. The Delegation of Iceland, speaking as the Chair of the Board of the NPI, thanked the Delegation of Hungary for the presentation of the request for appointment. In the recently adopted Understanding on procedures for appointment of International Authorities, it was stated that Offices seeking appointment were strongly recommended to obtain the assistance of one or more existing International Authorities to help in the assessment to the extent to which the Office met the criteria set out in PCT Rule 36.1. In accordance with the new procedures, the NPI had been invited to visit two of the four Offices forming the VPI, namely the Industrial Property Office of the Czech Republic and the Patent Office of the Republic of Poland. During the visit, representatives from the NPI were presented with detailed information on the setup of the VPI, quality management, legal framework and other information relevant in to compliance with requirements for appointment as International Searching and Preliminary Examining Authority through the involvement of the four participating Offices. The main findings in assessing the VPI and its readiness to meet the requirements for appointment according to PCT Rule 36.1 were outlined in the NPI's report attached to document PCT/CTC/28/2, as annexed to document PCT/A/47/6. The cooperation model of the VPI was based on the NPI cooperation model which, as earlier stated by the Delegation of Hungary, had proved to be quite successful. The NPI's visit to the Industrial Property Office of the Czech Republic and Patent Office of the Republic of Poland had revealed no particular issue in respect of the VPI's compliance with the appointment criteria set out in PCT Rule 36.1. On the contrary, it revealed competence and high standards that the members of the VPI set out as a foundation for their organization. The NPI fully supported the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT.

30. The Delegation of Japan stated that it heartily welcomed any efforts that the VPI could make in terms of contributing to the further development of the PCT, which was an important instrument to all innovators seeking patent protection internationally. As had been mentioned by the Delegation of Hungary, the Japan Patent Office (JPO) had signed a Memorandum of Cooperation with the V4 Offices in September 2014. In accordance with the Memorandum, the JPO had sent experts to the Hungarian Intellectual Property Office and the Industrial Property Office of the Slovak Republic. Based on the observations of the experts, it was noted that the VPI met the minimum requirements to be appointed as International Searching and Preliminary Examining Authority in terms of the number of examiners, PCT minimum documentation and the capacities of examiners. At the session of the PCT Committee for Technical Cooperation held in May, the Committee had unanimously agreed to recommend to the Assembly of the PCT Union that the VPI be appointed as International Searching and Preliminary Examining Authority under the PCT. In addition, taking into account the fact that the quality management system, as well as internal review arrangements, were fully planned at the VPI, the Delegation believed that the VPI as a whole met the minimum requirements for appointment. Therefore, the Delegation fully supported the VPI's appointment as an International Searching and Preliminary Examining

Authority. It was also observed that the cooperation had been beneficial to Japan as well and that the JPO would like to make use of the experience to contribute to discussions in the PCT Working Group and the Quality Subgroup of the Meeting of International Authorities.

31. The Delegation of Ukraine observed that the State Intellectual Property Service of Ukraine had been appointed as an International Searching and Preliminary Examining Authority under the PCT in October 2013 and fully supported the appointment of the VPI as an International Authority. The Delegation was sure that the VPI would carry out its functions successfully in accordance with all of the requirements.

32. The Delegation of Chile stated its firm support for the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT, believing that it had everything necessary in order to perform the functions of an International Authority. The Delegation had noted how the Institute had prepared for appointment and believed that it could close an apparent gap, giving coverage to the countries that made up the Institute. The National Institute of Industrial Property of Chile (INAPI) had been through the same process recently and now operated as an International Searching and Preliminary Examining Authority for its region. The results of this had been far greater and better than initially expected. The Delegation hoped that the VPI would be as successful and as lucky as INAPI and confirmed that the VPI could count on its cooperation. The Delegation looked forward to the participation of the VPI at the upcoming session of the Meeting of International Authorities under the PCT, which would take place in Chile in January 2016.

33. The Delegation of China stated that it had always believed that the PCT's international searching service should be convenient and accessible, so that different regions, languages and countries at different development level could benefit as much as possible from the PCT System. The VPI had met the relevant conditions and therefore the Delegation supported the appointment of VPI as International Searching and Preliminary Examining Authority and expected that the VPI would play a greater role.

34. The Delegation of Singapore supported the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT. There were strong merits to building on the expertise of the participating national Offices. With the harmonization of search and examination tools and practices the VPI would be well placed to deliver consistent, high quality service in the Central and Eastern European region and perhaps even beyond. The VPI's diverse multi lingual and technically qualified staff, together with the visits by the JPO and NPI, had given further confidence that the VPI would comply with all the criteria. The VPI had put in a huge amount of effort to ensure that its bid was credible and of high quality. The Delegation therefore expressed its unequivocal support for the bid and was confident that the appointment would greatly boost the value of the PCT.

35. The Delegation of the Russian Federation thanked the Delegation of Hungary for presenting very detailed information on the VPI. The Delegation believed that the VPI had the appropriate technical resources and supported the appointment of the VPI as an International Searching and Preliminary Examining Authority. This would open additional possibilities for users of the PCT System in Central and Eastern Europe. The Delegation wished colleagues from the VPI every success in their work.

36. The Delegation of Montenegro supported the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT and wished the four constituent Offices smooth work and smooth production of consistent work products towards fulfilling their efforts to become operational on July 1, 2016, as planned. This appointment was of great significance for the region of the CEBS Group, including for Montenegro. The Delegation informed the Assembly that, at the end of July, Montenegro had adopted a new law on patents which required patent owners to submit evidence of patentability by the end of the ninth year. Collaboration with the VPI was a great opportunity for Montenegro. Considering intellectual

property issues, the Delegation expressed its appreciation of the VPI logo and wished the Institute well with its marketing image and marketing goals.

37. The Delegation of the United States of America joined with the delegates of Romania, Australia, Japan, Ukraine, Chile, Montenegro and others in support of the VPI becoming an International Searching and Preliminary Examining Authority. The Delegation also supported approval of the draft agreement between VPI and the International Bureau and looked forward to VPI beginning its operations as an International Authority next year.

38. The delegation of Finland wholeheartedly supported the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT. The hard work that the four countries had done in preparing their application was noted. The Delegation had the greatest confidence that the VPI would achieve excellent results and warmly welcomed the Institute to the family of International Authorities.

39. The Delegation of Spain fully supported the request from the VPI to be appointed as an International Searching and Preliminary Examining Authority. The Delegation was also satisfied with the documents presented, which provided sufficient documentary evidence that the Institute met the necessary requirements.

40. The Delegation of Greece supported the appointment of the VPI and was confident that the Institute would further foster innovation and contribute to the development of the Central and Eastern European region.

41. The Delegation of Australia supported the appointment of the VPI as an International Searching and Preliminary Examining Authority. The Delegation had supported their application through the PCT Working Group and Meeting of International Authorities and looked forward to them being involved in the Quality Subgroup and the Meeting of International Authorities in the future.

42. The Delegation of Uganda supported the establishment of the VPI, which was a step in the right direction towards furthering the aims of the PCT. The Institute would no doubt play a large role as an International Searching and Preliminary Examining Authority.

43. The Delegation of the Republic of Korea joined with other delegations in supporting the appointment of the VPI as an International Authority.

44. The Delegation of Ghana supported the VPI in its application to serve as an International Searching and Preliminary Examining Authority for its region and thanked the Institute for the comprehensive information provided on how it fulfilled all the requirements. The Delegation was confident that the VPI had the capacity to perform the tasks ahead and to further improve the quality and efficiency of their individual Offices.

45. The Assembly, having heard the Representative of the Visegrad Patent Institute and taking into account the advice of the PCT Committee for Technical Cooperation set out in paragraph 5 of document PCT/A/47/6:

(i) approved the text of the draft Agreement between the Visegrad Patent Institute and the International Bureau as set out in the Annex to document PCT/A/47/6; and

(ii) appointed the Visegrad Patent Institute as an International Searching Authority and an International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2017.

46. The Director General congratulated the Delegations of the Czech Republic, Hungary, Poland and Slovakia and the VPI on the appointment of the VPI as an International Searching and Preliminary Examining Authority under the PCT, and stated that the International Bureau looked forward to working with the VPI in its new capacity as an International Searching and Preliminary Examining Authority.

47. The Delegation of Hungary, speaking on behalf of the Delegations of the Czech Republic, Hungary, Poland and Slovakia (Visegrad Group, or "V4"), thanked all delegations for their unequivocal and unanimous support to the appointment of the VPI as an International Searching and Preliminary Examining Authority and stated that it felt encouraged and honored by the level of support that it had received. The Delegation gave assurance that the VPI would work hard to deserve the confidence and live up to the trust of the PCT membership to make the VPI a reliable partner in the field of international patent co-operation under the PCT. The Delegation also thanked the Director General and the Secretariat for their continuous and highly valuable assistance provided throughout the process. Finally, the Delegation concluded by stating that the application of the VPI had confirmed that the new procedures for appointment of International Authorities were efficient, transparent and enabled a proper assessment of the appointment criteria. The procedures also helped the candidate Office or intergovernmental organization prepare for the procedure and its future tasks. The Assembly and other competent PCT bodies were well advised to apply these procedures to any future appointments of International Authorities.

Amendment of the Agreement Concerning the Functioning of the State Intellectual Property Service of Ukraine as an International Searching and Preliminary Examining Authority under the PCT

48. Discussions were based on document PCT/A/47/7.

49. The Secretariat introduced the document, which set out proposed amendments of the Agreement concerning the functioning of the State Intellectual Property Service of Ukraine as an International Authority. The Secretariat recalled the appointment by the Assembly in 2013 of the State Intellectual Property Service of Ukraine as an International Searching Authority and International Preliminary Examining Authority under the PCT, and the approval of the text of a draft agreement between the State Intellectual Property Service of Ukraine and the International Bureau. The agreement had been signed on September 30, 2013. Since then, the part of the Service responsible for administration of patent processing had become a separate unit titled "State Enterprise 'Ukrainian Institute of Intellectual Property'". The State Enterprise was independent of the State Service, but the State Service remained responsible for policy and oversight. The document therefore requested the Assembly to approve amendments to the Agreement to reflect the change of name of the part of the Office responsible for conducting the international search and preliminary examination. The amendments did not change the substance of the Authority or the Agreement. The State Enterprise retained all the examiners, search facilities, IT systems and other facilities and expertise and is substantively the body which was appointed by the Assembly as an International Searching and Preliminary Examining Authority back in 2013.

50. The Delegation of Ukraine underscored that the Agreement remained one between the State Intellectual Property Service of Ukraine and the International Bureau of WIPO. However, the State Enterprise would operate as an International Searching Authority and International Preliminary Examining Authority. In accordance with Article 11 of the Agreement, the present Agreement between the parties could be amended subject to the approval by the Assembly. The Delegation therefore requested the Assembly to approve the proposed amendments as set out in the document.

51. The Assembly:

- (i) took note of the contents of document PCT/A/47/7; and
- (ii) approved the amendments to the agreement between the State Intellectual Property Service of Ukraine and the International Bureau as set out in the Annex to document PCT/A/47/7.

Matters concerning the Lisbon Union: Proposal of the United States of America to the Patent Cooperation Treaty Assembly

52. Discussions were based on document PCT/A/47/8.

53. The Delegation of the United States of America, in introducing document PCT/A/47/8, stated that it was concerned that excess PCT receipts were funding the expenses of the Lisbon Union without the consent of the PCT Union, contrary to the provisions of Regulations 4.6, 4.7 and 4.8 of the WIPO Financial Regulations and Rules. Before it explained the background of its proposal, it wished to first state part of its opening statement, which the Ambassador of the United States of America had not had time to deliver on the floor. The Ambassador had been about to say, and the Delegation quoted: "Let me be clear, we support PCT revenue being used to support the overall activities of the organization because these activities have continually been supported by the full WIPO membership. We are objecting only to PCT revenue being used to support the Lisbon System, which by its own Treaty is required to be self-funding, and which recently has been expanded in an undemocratic manner. In contrast the Madrid and Hague systems represent global consensus solutions." Its proposal would not entail any need to raise the unitary contribution, because WIPO's global protection services which were truly global, namely, the PCT, Madrid and Hague Systems, continued to grow in popularity and generated the bulk of the funding for WIPO's non-registration activities. The Lisbon Union had repeatedly shown a deficit, not covered out of the Lisbon Union reserves, and thus should decide measures to redress the financial situation. The Delegation had identified possible sources of funds to cover the 2016-17 Lisbon Union deficit. These funds were currently at WIPO. The first source of funding was the Madrid Union surplus, which was far above the Madrid Union surplus target. This would be taken up under the Madrid Union Assembly. Another source that it had identified was available funds-in-trust for the 2016-2017 biennium, which were available for that biennium in the accounts of certain Lisbon Union Member States. The PCT Union had a surplus and it could decide to allow the Lisbon Union to use some part of that surplus, rather than having it placed in the PCT reserve fund. But that use was for the PCT Union to decide. The United States of America, as a member of the PCT Union, did not support the Lisbon Union using the funds of the PCT Union. Should the Hague Union request a loan, as it had previously done, from the Madrid Union, the Delegation could support such a loan. However, the Delegation could not support a loan to the Lisbon Union, for several reasons. At the Assemblies in 2014, the Lisbon Union had declared that no other union had an interest in its actions and as such it did not have to seek the advice of the WIPO Coordination Committee under Article 8.3(i) of the WIPO Convention; it then had claimed the right to use Madrid and PCT Unions reserves to fund its closed diplomatic conference. The Lisbon Union was the same Union that had consistently refused to meet the financial terms of its own Agreement. Instead, it had retained its subsidization by the other more successful unions without explicit consent of those unions. The Delegation was concerned about the lack of transparency that had been tolerated historically when it came to the low functioning Lisbon Union and the expectation held by its members that such a lack of transparency as well as a lack of accountability should be allowed to continue. The Delegation thought that this should be an institutional concern for all WIPO Members, and questioned how WIPO could allow one union to spend resources of the Organization and refuse to allow other Member States which had a real and significant interest in its activities to participate. The Lisbon Union itself had decided that it did not have to consult with the Coordination Committee because no other union had an interest in the Lisbon Agreement's revision effort. The Lisbon Union itself had decided

to hold a diplomatic conference. The Program and Budget Committee (PBC) had agreed to fund that Conference on assurances that it would be open to equal and full participation by all Paris Union members; all knew how that had turned out. The diplomatic conference had ultimately not been open to all WIPO members or Paris Union members, though oddly, it had been open to two non-Paris Union members, namely, the European Union and the African Intellectual Property Organisation (OAPI). Other Unions' fee income had funded the effort to create a new geographical indications registry. For that reason, among others, other Unions clearly had an interest in what the Lisbon Union was doing. The Lisbon Union should not be able to have it both ways, using general revenue to fund a closed diplomatic conference. If the Lisbon Agreement were of no interest to other unions, then the budget of those unions should not be used to fund its operations. In conclusion, the Delegation was asking the PCT Assembly to take a decision to require its consent before other fee-funded registration unions obligated PCT fee income to cover the under-performing Lisbon Union's expenses.

54. The Delegation of Switzerland stated that, as it had explained at another point in time, it was very much attached to the unitary budget of the Organization and believed this principle was essential for WIPO. The principle of a unitary budget allowed activities which were under WIPO's mandate to be carried out without necessarily generating their own surplus. This had been the case for many years for the Hague System, as was clearly shown in the documents that were mentioned in the proposal that the Assembly had before it. With regard to other parts of the proposal, the Delegation did not believe that those resulted in a violation of PCT Article 57(1), as that Article was changed by the constitutional reform in 2003 by the Assemblies, which also decided on the unitary budget principle. In fact, the quote in this document with regard to Article 57(1)(c) was changed at that point. The Delegation believed that the budgetary documents had been fully in accordance with the practices of this Organization over the last 20 years, which had been unanimously adopted by the Assemblies in 2003. The Delegation was thus not in a position to support the proposal set out in document PCT/A/47/8. However, it wished to make some comments with regard to the fees and financing of the Lisbon System, and would like to recall that there were proposals on this subject which would be examined by the Lisbon Union Assembly which would be meeting soon.

55. The Delegation of Iran (Islamic Republic of) stated that, in its understanding, the Lisbon Union was an independent union and the PCT Union was another independent union. There was no hierarchy between these unions. It thus wished to seek clarification through the Chair as to the relationship between the PCT Union and the Lisbon Union, and the reason for putting forward the proposal under this agenda item. Furthermore, in accordance with the program and budget, 76 per cent of the budget of WIPO was provided by the PCT; the Delegation thus sought clarification and information as to which committees, treaties and unions this budget was allocated to, and what the legal base for allocation of PCT revenues to other sections of WIPO was. The Delegation, of course, strongly supported the unitary contribution system. It understood that system; it only sought clarification in detail as to which sections of WIPO, which treaties and which unions were using the revenue of the PCT.

56. The Delegation of Australia stated that it wished to briefly make a more general statement on these issues. It shared a lot of the concerns raised by the Delegation of the United States of America, especially those that surrounded the transparency of the budget and the sustainability of the Lisbon Union. It wished to encourage the Lisbon Union to develop a plan to promote the sustainability of the system and expressed the view that this should be based on the excellent document that had been provided by the Secretariat and should also take into account some of the proposals raised by the Delegation of the United States of America in its intervention.

57. The Delegation of Mexico stated that it supported what was expressed by the Delegation of Switzerland. It was not in a position to accept the proposal that was under discussion at this point in time. The Delegation wished to continue to support the unitary budget, which was part of the solidarity principle of the UN system. It was thus not in a position to support the proposal.

58. The Delegation of Cuba stated that it supported the principle of the unitary budget adopted by the General Assembly.
59. The Delegation of Italy stated that it supported the position expressed by the Delegation of Switzerland. It was not in the position to support the proposal contained in document PCT/A/47/8, for the same reasons already expressed by the Delegation of Switzerland.
60. The Delegation of Hungary stated that it had noted the proposal put forward by the Delegation of the United States of America. It was of the view that it would represent an unwarranted and unjustifiable departure from the unitary budget for this Organization. It was for that reason that it was unable to support this proposal. It further wished to comment on some elements of the statement by the Delegation of the United States of America. It believed that it was wrong to state that, with the exception of the Lisbon System, all registration systems were self-financing. In fact, the Hague Union had generated a deficit 20 times higher than that of the Lisbon Union, while its membership was only around double that of the Lisbon Union. It further wanted to point out that the anxiety about the Lisbon Union's financial situation emerged in an Organization that had a surplus for the last year of 37 million Swiss francs. It further wanted to react to the comments made by the Delegation of the United States of America on the way the diplomatic conference had been convened and conducted. It could not subscribe to the view that the diplomatic conference had been convened in an illegal manner or that it had been held in an undemocratic manner. The Conference had been convened in full accordance with the applicable legal provisions and never ever in the history of WIPO Diplomatic Conferences had observer delegations been able to play such an active role and contribute to the negotiations to such a large extent as at the Diplomatic Conference for the Adoption of the Geneva Act of the Lisbon Agreement.
61. The Delegation of Japan stated that, considering that most of WIPO's activities were supported by fees paid by PCT applicants, Member States had a responsibility to show them how their money was used to promote worldwide protection of IP and to develop business infrastructure. In this context, the Delegation generally supported enhancing the fairness and transparency of each union's financial situation. It further was necessary for each union to make sincere efforts to achieve balanced revenues and expenditures. At the same time, however, taking into account the need to supply enough resources to enable every program to be effectively implemented and to promote the global IP system, and the need to make the Organization fully functional as a whole, the Delegation was satisfied with WIPO's current practices.
62. The Delegation of France thanked the Delegation of the United States of America for the proposal that it had made to the PCT Assembly. At this point in time, it did not want to talk about how other unions operated; each union would have its own assembly. With regard to the proposal by the Delegation of the United States of America, it had been carefully examined by the National Institute of Industrial Property (INPI) in Paris. As a matter of principle, the Delegation was not in a position to support the proposal because it opened a Pandora's box, namely, the need to come back every two years to ask the PCT Union whether it was willing to finance certain activities or not. The Delegation recalled that the Permanent Missions had had a session with the Delegation of the United States of America and had looked at the way the budget was built. 76 per cent of the income was from the PCT; in its view, this Pandora's box could not be opened, as it would set a precedent, for example, in a couple of years, for expenses for the WIPO Academy or for development expenses. The Delegation thus wished to stick with the unitary budget principle, which was a central motor that generated resources and benefits for most of the 12 programs which were not financed by their own revenue. Nevertheless wished to thank the Delegation of the United States of America for having brought this discussion to the Assembly, which had allowed a greater understanding by everybody as to how the WIPO budget was constructed.

63. The Delegation of Portugal stated that, with regard to the proposal put forward in document PCT/A/47/8, it reiterated the importance of keeping the unitary budget principle, which had many advantages for the Organization. The Delegation was thus not in a position to support the proposal, similar to other delegations which had already spoken.

64. The Delegation of Montenegro expressed its support for the statement made by the Delegations of Switzerland and Hungary on the proposal by the Delegation of the United States of America. It particularly supported the statement made by the Delegation of Hungary on the Diplomatic Conference for the Adoption of Geneva Act of the Lisbon Agreement. It further was in favor of the principle of a unitary budget.

65. The Delegation of the Dominican Republic stated that it supported the principle of the unitary budget.

66. The Delegation of Uganda stated that, as much as the proposal by the Delegation of the United States of America looked persuasive, the Delegation was unable to support it for the simple reason that it was a departure from the hitherto adhered to principle of the unitary budget.

67. The Delegation of the Democratic People's Republic of Korea stated that it could not support the proposal and that it supported the unitary budget of WIPO.

68. The Delegation of Monaco stated that, as the great majority of delegations that had taken the floor so far, it was not in a position to support the proposal put forward by the Delegation of the United States of America. This position of principle was based on the points that had been raised by other delegations. The Delegation was very much attached to the principle of the unitary budget, in accordance with the reforms adopted in 2003, which Monaco had accepted formally in 2004.

69. The Delegation of Georgia stated that it fully aligned itself with the statements made by the Delegations of Switzerland and Hungary and that it supported unitary budget principle of WIPO.

70. The Delegation of Serbia stated that it supported the unitary budget.

71. The Delegation of Bulgaria stated that it aligned itself with the statements made by the Delegations of Switzerland and Hungary.

72. The Delegation of Croatia stated that it associated itself with the statements by those delegations that supported the unitary budget principle, in an Organization that had a dozen unions and 130 programs and in which around three quarters of income came from one of the systems, namely, the PCT System. In its view, it would seriously undermine the sound financial system of the Organization if the proposal by the Delegation of the United States of America were adopted. It could therefore not support the proposal.

73. The Delegation of the Slovakia aligned itself with the statements by the Delegations of Hungary, Switzerland and France and other delegations that had supported the unitary budget principle. It was its understanding that the proposal by the United States of America sought to change the entire methodology as to how finances were distributed throughout all of the unions. From its point of view, that would seriously undermine the principle which had been agreed with regard to areas which were not creating any surplus. The Delegation thus expressed the view that the system should be kept as it was now.

74. The Delegation of Tunisia stated that it had listened to those delegations that had supported the unitary budget for WIPO and that it supported those delegations.

75. The Delegation of the United States of America thanked all delegations that had addressed its proposal. The Delegation had heard some questions posed to the Secretariat and had a couple of questions that it would like to pose. It further wished to address some misunderstandings with regard to what had been referred to as the unitary budget. The United States of America had consistently supported what was known as the unitary contribution system and had submitted an information document to this session of the Assemblies as well as to the PBC which expressed its understanding. Nevertheless, it was keen to hear from the Secretariat as to its understanding of the unitary contribution system and whether that system was meant to fund the fee-funded registration unions. A second question was whether any concept referred to as the unitary budget was indeed in force. It was the Delegation's understanding that the 2003 constitutional reform was not in force and that in fact the concept of a unitary budget had been rejected. The Delegation fully supported the unitary contribution system and, as the Delegation had mentioned in an earlier statement, it fully supported revenues of the PCT being used to fund all WIPO activities supported by the full WIPO membership. It further requested clarification by the Secretariat on the questions posed by the Delegation of Iran (Islamic Republic of), because it also had some confusion in that regard. Finally, the Delegation requested that this item be kept open pending resolution of all of the budgetary items on the agenda.

76. The Director General referred to the two questions raised by the Delegation of Iran (Islamic Republic of). The first question referred to the relationship between the PCT Union and the Lisbon Union and the reasons for tabling the proposal to the PCT Assembly on matters concerning the Lisbon Union. This question was a matter for the Delegation of the United States of America that had submitted the proposal. The second question, concerned the basis for allocation of PCT revenues to other programs undertaken within WIPO. This issue was considered in the PBC. The International Bureau had published financial statements to the Member States along with a draft Program and Budget. The draft Program and Budget presented two views: a unitary presentation of the budget by reference to the programs, and in its Annexes, a view of the source of funding by reference to the unions.

77. The Secretariat responded to the question raised by the Delegation of the United States of America on the unitary contribution system. This system referred to the practice concerning the contributions of WIPO Member States since 1994. In 1993, the Assemblies of Member States decided that any country that adhered to the contribution-financed WIPO Convention as well as any of the six contribution-financed unions (Paris, Berne, IPC, Nice, Locarno and Vienna) would pay one single contribution to the Organization rather than the amount of contributions corresponding to the number of treaties that it was party to.

78. The Delegation of the United States of America clarified the questions that it asked the Secretariat. First, the Delegation wished to know the authority under which the PCT Union funded other programs outside of the Union. Second, the Delegation asked for further clarification of the unitary budget and whether that prescribed any particular allocation from one union to another, or whether an income-funded union needed to discuss funding another union. In this regard, the Delegation believed that there had been a misunderstanding that its proposal would affect the so-called unitary budget. The Delegation believed that the unitary budget that had been proposed as part of constitutional reform had never been adopted.

79. The Director General responded to the questions raised by the Delegation of the United States of America by explaining that the authority for expenditure derived from the process for agreeing the Program and Budget. WIPO was unusual as contributions from Member States accounted for 5 per cent of income, the remainder coming as a consequence of the operations of the PCT, Madrid and Hague systems. The authority for allocations therefore came from Member States by approval of the budget, which had been the case since the Organization came into its present incarnation in 1970. As far as the so-called unitary budget was concerned, the Delegation of the United States of America was correct that the expression "unitary budget" was an expression used by WIPO members to refer to the presentation of the

Program and Budget in a single document which showed the finances of the Organization in which the revenue was derived by the different unions and the proposed expenditure made by the different programs. As indicated in the response to the question by the Delegation of Iran (Islamic Republic of), the draft Program and Budget set out two views, first a unitary presentation by program, and second the view by source of funding with respect to the various unions. This was complicated by common expenses incurred by all of the unions like buildings, human resources, administration and finance. These common expenses were for the benefit of all the different unions, treaties and programs in the Organization. In this respect, the Director General referred to a presentation made by the Secretariat at the request of Member States the previous week, the slides of which had been made available. The allocation of the common expenses was made by a complex allocation formula which had been explained at the presentation.

80. The Delegation of the United States of America thanked the Director General for his response and wished to clarify that the PCT Assembly taking the decision proposed not to subsidize an income-producing union would not undermine the unitary budget, and asked under what authority the Lisbon Union received a subsidy from other income-producing unions absent their expressed consent.

81. The Director General responded to the further questions raised by the Delegation of the United States of America. A decision of the PCT Union not to subsidize a specific income-producing union such as the Lisbon Union would not affect any other part of the so-called “unitary budget”, even though there was no such thing as a unitary budget, but rather a unitary presentation of the budget. It would also not affect the sharing of revenue from other unions to the Lisbon Union, nor would it affect the sharing of PCT revenue with unions other than the Lisbon Union. In terms of the authority under which the Lisbon Union received subsidies from other income-producing unions, this was given in the adoption of the Program and Budget, where the decision paragraph specified the approval of all the unions administered by WIPO. The various unions, including the PCT Union, therefore gave explicit consent to the expenditure of the Lisbon Union when adopting the budget for the Organization.

82. The Delegation of the United States of America considered the response of the Director General and the Secretariat to be helpful to explain any apparent confusion about the unitary contribution system, the non-existent “unitary budget” and the process in WIPO to ensure coherence among income-producing and contribution-financed unions. The Delegation concluded by requesting this agenda item to be left open pending the other open items relating to the budget of the Organization.

83. The Chair announced that Agenda Item 19 “PCT System” would remain open, pending informal consultations on document PCT/A/47/8 (being undertaken together with related issues covered under other agenda items).

84. During the session, the Chair of the General Assembly provided regular updates on the evolution of those informal consultations to the plenary of the Assemblies, including the Assembly of the PCT Union. The updates are reported under Agenda Item 11 “Report of the Program and Budget Committee”.

85. The Assembly of the PCT Union considered document PCT/A/47/8 and did not reach consensus

[Annexes follow]

AMENDMENTS TO THE PCT REGULATIONS
TO ENTER INTO FORCE JULY 1, 2016

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Rule 9
Expressions, Etc., Not to Be Used

9.1 *[No change] Definition*

The international application shall not contain:

- (i) expressions or drawings contrary to morality;
- (ii) expressions or drawings contrary to public order;
- (iii) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person (mere comparisons with the prior art shall not be considered disparaging *per se*);
- (iv) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

9.2 *Noting of Lack of Compliance*

The receiving Office, the International Searching Authority, the Authority specified for supplementary search and the International Bureau may note lack of compliance with the prescriptions of Rule 9.1 and may suggest to the applicant that he voluntarily correct his international application accordingly, in which case the receiving Office, the competent International Searching Authority, the competent Authority specified for supplementary search and the International Bureau, as applicable, shall be informed of the suggestion.

9.3 *[No change] Reference to Article 21(6)*

"Disparaging statements," referred to in Article 21(6), shall have the meaning as defined in Rule 9.1(iii).

Rule 26bis
Correction or Addition of Priority Claim

26bis.1 and 26bis.2 [No change]

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

(a) to (e) [No change]

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

(g) [No change]

(h) The receiving Office shall promptly:

(i) [no change] notify the International Bureau of the receipt of a request under paragraph (a);

(ii) [no change] make a decision upon the request;

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

(iv) subject to paragraph (h-bis), transmit to the International Bureau all documents received from the applicant relating to the request under paragraph (a) (including a copy of the request itself, any statement of reasons referred to in paragraph (b)(ii) and any declaration or other evidence referred to in paragraph (f)).

[Rule26bis.3, continued]

(h-bis) The receiving Office shall, upon a reasoned request by the applicant or on its own decision, not transmit documents or parts thereof received in relation to the request under paragraph (a), if it finds that:

- (i) this document or part thereof does not obviously serve the purpose of informing the public about the international application;
- (ii) publication or public access to any such document or part thereof would clearly prejudice the personal or economic interests of any person; and
- (iii) there is no prevailing public interest to have access to that document or part thereof.

Where the receiving Office decides not to transmit documents or parts thereof to the International Bureau, it shall notify the International Bureau accordingly.

(i) and (j) *[No change]*

Rule 48
International Publication

48.1 [No change]

48.2 *Contents*

(a) [No change]

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

(i) to (vi) [No change]

(vii) where applicable, an indication that the published international application contains information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request;

(viii) [deleted]

(c) to (k) [No change]

(l) The International Bureau shall, upon a reasoned request by the applicant received by the International Bureau prior to the completion of the¹ technical preparations for international publication, omit from publication any information, if it finds that:

(i) this information does not obviously serve the purpose of informing the public about the international application;

(ii) publication of such information would clearly prejudice the personal or economic interests of any person; and

(iii) there is no prevailing public interest to have access to that information.

Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the applicant shall present the information which is the subject of a request made under this paragraph.

¹ An editorial change has been made by the Secretariat beyond the text agreed by the Assembly to align the text in new Rule 48.2(l) with other references to "the completion of the technical preparations for international publication" used elsewhere in Rule 48.2; the word "the" has been inserted following the words "prior to the completion of" and before the words "technical preparations ...". This editorial change only concerns the English version of this document.

(m) Where the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Bureau notes any information meeting the criteria set out under paragraph (l), that Office, Authority or Bureau may suggest to the applicant to request the omission from international publication in accordance with paragraph (l).

[Rule 48.2, continued]

(n) Where the International Bureau has omitted information from international publication in accordance with paragraph (l) and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly.

48.3 to 48.6 *[No change]*

Rule 82^{quater}
Excuse of Delay in Meeting Time Limits

82^{quater}.1 Excuse of Delay in Meeting Time Limits

(a) Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity, a general unavailability of electronic communications services or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.

(b) [No change] Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be, not later than six months after the expiration of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the addressee, delay in meeting the time limit shall be excused.

(c) [No change] The excuse of a delay need not be taken into account by any designated or elected Office before which the applicant, at the time the decision to excuse the delay is taken, has already performed the acts referred to in Article 22 or Article 39.

Rule 92
Correspondence

92.1 *[No change]*

92.2 *Languages*

(a) *[No change]* Subject to Rules 55.1 and 55.3 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

(b) *[No change]* Any letter from the applicant to the International Searching Authority or the International Preliminary Examining Authority may be in a language other than that of the international application, provided the said Authority authorizes the use of such language.

(c) *[Remains deleted]*

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

(e) *[No change]* Any letter or notification from the International Bureau to the applicant or to any national Office shall be in English or French.

92.3 and 92.4 *[No change]*

Rule 94
Access to Files

94.1 Access to the File Held by the International Bureau

(a) [No change] At the request of the applicant or any person authorized by the applicant, the International Bureau shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 and paragraphs (d) to (g), furnish copies of any document contained in its file. The furnishing of copies may be subject to reimbursement of the cost of the service.

(c) [No change] The International Bureau shall, if so requested by an elected Office, furnish copies of the international preliminary examination report under paragraph (b) on behalf of that Office. The International Bureau shall promptly publish details of any such request in the Gazette.

(d) The International Bureau shall not provide access to any information contained in its file which has been omitted from publication under Rule 48.2(l) and to any document contained in its file relating to a request under that Rule.

(e) Upon a reasoned request by the applicant, the International Bureau shall not provide access to any information contained in its file and to any document contained in its file relating to such a request, if it finds that:

- (i) this information does not obviously serve the purpose of informing the public about the international application;
- (ii) public access to such information would clearly prejudice the personal or economic interests of any person; and
- (iii) there is no prevailing public interest to have access to that information.

Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the applicant shall present the information which is the subject of a request made under this paragraph.

(f) Where the International Bureau has omitted information from public access in accordance with paragraphs (d) or (e), and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly.

[Rule 94.1, continued]

(g) The International Bureau shall not provide access to any document contained in its file which was prepared solely for internal use by the International Bureau.

94.1bis Access to the File Held by the Receiving Office

(a) At the request of the applicant or any person authorized by the applicant, the receiving Office may provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) The receiving Office may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The receiving Office shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule 94.1(d) or (e).

94.1ter Access to the File Held by the International Searching Authority

(a) At the request of the applicant or any person authorized by the applicant, the International Searching Authority may provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) The International Searching Authority may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The International Searching Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule 94.1(d) or (e).

(d) Paragraphs (a) to (c) shall apply *mutatis mutandis* to the Authority specified for supplementary search.

94.2 Access to the File Held by the International Preliminary Examining Authority

(a) At the request of the applicant or any person authorized by the applicant, the International Preliminary Examining Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) At the request of any elected Office, but not before the establishment of the international preliminary examination report and subject to paragraph (c), the International Preliminary Examining Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The International Preliminary Examining Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(l) or from public access in accordance with Rule 94.1(d) or (e).

94.2bis Access to the File Held by the Designated Office

If the national law applicable by any designated Office allows access by third parties to the file of a national application, that Office may allow access to any documents relating to the international application, contained in its file, to the same extent as provided by the national law for access to the file of a national application, but not before the earliest of the dates specified in Article 30(2)(a). The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

94.3 Access to the File Held by the Elected Office

If the national law applicable by any elected Office allows access by third parties to the file of a national application, that Office may allow access to any documents relating to the international application, including any document relating to the international preliminary examination, contained in its file, to the same extent as provided by the national law for access to the file of a national application, but not before the earliest of the dates specified in Article 30(2)(a). The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

[Annex II follows]

AMENDMENTS TO THE PCT REGULATIONS
TO ENTER INTO FORCE JULY 1, 2017

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Rule 12bis
Submission by the Applicant of Documents Relating to Earlier Search

12bis.1 Furnishing by the Applicant of Documents Related to Earlier Search in Case of Request under Rule 4.12

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to paragraphs (b) to (d), submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.

(b) Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copy referred to in paragraph (a), indicate the wish that the receiving Office prepare and transmit it to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.

(c) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy referred to in paragraph (a) shall be required to be submitted under that paragraph.

(d) Where a copy referred to in paragraph (a) is available to the receiving Office or the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, and the applicant so indicates in the request, no copy shall be required to be submitted under that paragraph.

12bis.2 Invitation by the International Searching Authority to Furnish Documents Related to Earlier Search in Case of Request under Rule 4.12

(a) The International Searching Authority may, subject to paragraphs (b) and (c), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:

- (i) a copy of the earlier application concerned;
- (ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;
- (iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;

[Rule 12bis.2(a), continued]

(iv) a copy of any document cited in the results of the earlier search.

(b) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, or where a copy or translation referred to in paragraph (a) is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, or in the form of the priority document, no copy or translation referred to in paragraph (a) shall be required to be submitted under that paragraph.

(c) Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (a)(i) and (ii) shall be required to be submitted under those paragraphs.

Rule 23bis
Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 Transmittal of Documents Relating to Earlier Search in Case of Request under Rule 4.12

(a) The receiving Office shall transmit to the International Searching Authority, together with the search copy, any copy referred to in Rule 12bis.1(a) related to an earlier search in respect of which the applicant has made a request under Rule 4.12, provided that any such copy:

- (i) has been submitted by the applicant to the receiving Office together with the international application;
- (ii) has been requested by the applicant to be prepared and transmitted by the receiving Office to that Authority; or
- (iii) is available to the receiving Office in a form and manner acceptable to it, for example, from a digital library, in accordance with Rule 12bis.1(d).

(b) If it is not included in the copy of the results of the earlier search referred to in Rule 12bis.1(a), the receiving Office shall also transmit to the International Searching Authority, together with the search copy, a copy of the results of any earlier classification effected by that Office, if already available.

23bis.2 Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2

(a) For the purposes of Rule 41.2, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, the receiving Office shall, subject to paragraphs (b), (d) and (e), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are available to the Office, and a copy of the results of any such earlier classification effected by the Office, if already available. The receiving Office may also transmit to the International Searching Authority any further documents relating to such an earlier search which it considers useful to that Authority for the purposes of carrying out the international search.

(b) Notwithstanding paragraph (a), a receiving Office may notify the International Bureau by April 14, 2016 that it may, on request of the applicant submitted together with the international application, decide not to transmit the results of an earlier search to the International Searching Authority. The International Bureau shall publish any notification under this provision in the Gazette.

[Rule 23bis.2, continued]

(c) At the option of the receiving Office, paragraph (a) shall apply *mutatis mutandis* where the international application claims the priority of one or more earlier applications filed with an Office different from the one which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, and the results of any such earlier search or classification are available to the receiving Office in a form and manner acceptable to it, for example, from a digital library.

(d) Paragraphs (a) and (c) shall not apply where the earlier search was carried out by the same International Searching Authority or by the same Office as that which is acting as the International Searching Authority, or where the receiving Office is aware that a copy of the earlier search or classification results is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library.

(e) To the extent that, on October 14, 2015, the transmission of the copies referred to in paragraph (a), or the transmission of such copies in a particular form, such as those referred to in paragraph (a), without the authorization by the applicant is not compatible with the national law applied by the receiving Office, that paragraph shall not apply to the transmission of such copies, or to the transmission of such copies in the particular form concerned, in respect of any international application filed with that receiving Office for as long as such transmission without the authorization by the applicant continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 14, 2016. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 41
Taking into Account Results of Earlier Search and Classification

41.1 *Taking into Account Results of Earlier Search in Case of a Request under Rule 4.12*

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12*bis*.1 and:

(i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

(ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

41.2 *Taking into Account Results of Earlier Search and Classification in Other Cases*

(a) Where the international application claims the priority of one or more earlier applications in respect of which an earlier search has been carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take the results of any such earlier search into account in carrying out the international search.

(b) Where the receiving Office has transmitted to the International Searching Authority a copy of the results of any earlier search or of any earlier classification under Rule 23*bis*.2(a) or (b), or where such a copy is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, the International Searching Authority may take those results into account in carrying out the international search.

Rule 86
The Gazette

86.1 *Contents*

The Gazette referred to in Article 55(4) shall contain:

(i) to (iii) *[no change]*

(iv) information concerning events at the designated and elected Offices notified to the International Bureau under Rule 95.1 in relation to published international applications;

(v) *[no change]*

86.2 to 86.6 *[No change]*

Rule 95
Information and Translations from Designated and Elected Offices

95.1 *Information Concerning Events at the Designated and Elected Offices*

Any designated or elected Office shall notify the International Bureau of the following information concerning an international application within two months, or as soon as reasonably possible thereafter, of the occurrence of any of the following events:

- (i) following the performance by the applicant of the acts referred to in Article 22 or Article 39, the date of performance of those acts and any national application number which has been assigned to the international application;
- (ii) where the designated or elected Office explicitly publishes the international application under its national law or practice, the number and date of that national publication;
- (iii) where a patent is granted, the date of grant of the patent and, where the designated or elected Office explicitly publishes the international application in the form in which it is granted under its national law, the number and date of that national publication.

95.2 *Furnishing of Copies of Translations*

(a) *[No change]* At the request of the International Bureau, any designated or elected Office shall provide it with a copy of the translation of the international application furnished by the applicant to that Office.

(b) *[No change]* The International Bureau may, upon request and subject to reimbursement of the cost, furnish to any person copies of the translations received under paragraph (a).

[End of Annex II and of document]

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Eighth (28th Extraordinary) Session
Geneva, October 3 to 11, 2016

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/56/1): 1, 3 to 6, 9, 10, 19, 30 and 31.
2. The report on the said items, with the exception of item 19, is contained in the General Report (document A/56/17).
3. The report on item 19 is contained in the present document.
4. In the absence of the Chair of the PCT Assembly, Ms. Susanne Ås Sivborg (Sweden), the meeting of the Assembly was presided over by Mr. Sandris Laganovskis (Latvia), Vice-Chair of the PCT Assembly.
5. The Chair welcomed all delegations, especially the three Contracting States which had acceded to the PCT since the previous session of the Assembly in October 2015, namely Cambodia, Djibouti and Kuwait.

REPORT ON THE PCT WORKING GROUP

6. Discussions were based on document PCT/A/48/1.
7. The Secretariat introduced the document, which set out a report of the ninth session of the PCT Working Group. The session had a full agenda, with 32 agenda items and 26 working documents. This confirmed the great interest in the further development of the PCT System as a cornerstone in the international patent system. A separate working document

(document PCT/A/48/3) setting out changes to the PCT Regulations approved by the Working Group had been submitted to this Assembly for decision. An overview of all items discussed during the session was provided in the Summary by the Chair attached to the document.

8. The Delegation of Chile, speaking on behalf of the Group of States of Latin America and the Caribbean (GRULAC), stated that it valued and supported the proposal by Brazil set out in document PCT/WG/9/25 for fee reductions for universities and publicly funded research institutions in developing countries. GRULAC hoped that the studies requested of the Secretariat would be undertaken as quickly as possible with a view to continuing with the analysis and moving towards a speedy decision on the matter. GRULAC also expressed its pleasure that the PCT Working Group was being chaired by a delegate from one of its member countries.

9. The Delegation of China supported the improvement of the criteria for fee reductions in the PCT to stimulate patent filings from certain countries, notably developing and least developed countries (LDCs). The proposal by Brazil set out in document PCT/WG/9/25 would act as a first step in stimulating patent filing by universities and publicly funded research institutions in these countries. The Delegation believed that the fee reduction would further encourage applicants from all countries to use the PCT System, thereby promoting a sustainable growth in volume of applications. This would be a win/win situation for both Contracting States and the International Bureau. Regarding the extension of appointment of International Searching and Preliminary Examining Authorities, the Delegation agreed with the procedures, timetable and substantive criteria for the extension of appointments, and undertook to provide the relevant documents required for the process on time to the International Bureau.

10. The Delegation of India supported the proposal by Brazil set out in document PCT/WG/9/25 for fee reductions for universities and publicly funded research institutions in developing countries. The number of patent filings had increased in recent years, but the percentage of applications originating from India was low despite the large talent pool based in research and development institutions over the country. There was a need to exploit the technology developed and to stimulate IP applications. As the proposal under consideration would stimulate patent filing by universities and publicly funded research institutions in developing countries and LDCs, it was a welcome step in the right direction in boosting creativity and innovation. Therefore, the Delegation wished to see a positive outcome on this proposal, which was also likely to benefit the public at large.

11. The Delegation of Brazil thanked the Central Asian, Caucasus and Eastern European Countries (CACEEC), GRULAC, China, Cameroon, Egypt and India for their support for the proposal set out in document PCT/WG/9/25 for fee reductions for universities and publicly funded research institutions in developing countries, as well as States that had supported the proposal during the ninth session of the PCT Working Group. The proposal was based on a study of PCT fee elasticity showing that universities and public research organizations were more price-sensitive than other applicants. Considering this fact, document PCT/WG/9/25 proposed the establishment of a reduction in PCT fees of at least 50 per cent for universities and public funded research institutions from certain countries, notably developing countries and LDCs, taking advantage of the current country based criteria used for fee reductions. The adoption of the proposal would, according to estimates by the Secretariat, generate 139 additional filings per year with a decrease in revenue of 1.508 million Swiss francs, in stark contrast to the 70.3 million Swiss franc surplus announced for the 2014-2105 biennium. The decrease in revenue therefore represented a small amount of this surplus. Taking these facts into account, it could be concluded that a fee discount for universities and publicly funded research institutions was the most efficient possible change in the fee policy for WIPO. After formally presenting the proposal at the Working Group, the Delegation had engaged in informal discussions to share ideas on PCT fee policy, and was pleased to hear general support for the proposal. On this aspect, the Delegation understood that the tiered formula was a staged approach, allowing for fine tuning of the fee reduction according to results obtained. The

Delegation called on all Member States to support and approve the proposal that would create a smart fee reduction for the benefit of the international community, promoting use of the patent system and taking a first concrete step on discussions related to PCT fee elasticity.

12. The Delegation of Greece stated its support for the proposed amendments to the PCT Regulations to make the system more responsive to the needs of users and patent Offices. The changing needs of users, third parties and patent Offices should be the guiding force for continuously improving the PCT System. Access to the PCT system needed to be further accommodated for those universities and public research institutes which had restricted resources and could not finance the entry costs. For this reason, the Delegation welcomed the determination of possible fee reductions to stimulate the patent filing on the understanding that the impact to the PCT income would be minimal.

13. The Delegation of South Africa supported the proposal by Brazil set out in document PCT/WG/9/25 for fee reductions for universities and publicly funded research institutions in developing countries.

14. The Delegation of Iran (Islamic Republic of) noted the report and supported the efforts of the PCT Working Group. Concerning proposed amendments to the PCT Regulations, the Delegation believed that amendments needed to observe factors such as disclosure of as much technical information as possible in patents and avoid dealing with the substantive patent law issues. It was important to provide technical and legal assistance and greater access of countries to different data banks and online research tools, assuring maximum equality by the sharing of patent data banks and reducing the related costs of patent examination to encourage developing countries to use the PCT System more.

15. The Delegation of Mongolia supported the proposed amendments to the PCT Regulations as well as the proposal by Brazil for fee reductions for universities and publicly funded research institutions set out in document PCT/WG/9/25, which would have a big impact for the promotion of innovation in developing countries.

16. The Delegation of Kuwait expressed its pleasure in participating at the Assembly for the first time as a PCT Contracting State and thanked the International Bureau for the facilities and assistance to facilitate accession of Kuwait to such an important international treaty given its positive impact on development. Kuwait had deposited its instrument of accession to the Treaty on June 9, 2016, which had entered into force in Kuwait on September 9, 2016. This accession was the result of Kuwait's wish to promote, foster and benefit from country-wide innovation and creativity, building on the successful experience of the Cooperation Council for the Arab States of the Gulf. Kuwait recognized the importance of the role of intellectual property and acknowledged that the Treaty offered many advantages to developing countries. Indeed, it was an international system that allowed eligible inventors under PCT provisions to file their applications in 150 countries and define the desired scope of protection. In that regard, Kuwait's accession could be seen as the embodiment of the country's will to support innovation and creativity conducive to national economic development. Cognizant of the importance of IP in defining a country's level of development, efforts were being made to develop creative skills through outreach and awareness-raising programs targeted at schools, universities and research institutions. In addition, Kuwait looked forward to starting cooperation with PCT Contracting States on patent examination, and continuing working with the International Bureau in the area of technical assistance to fulfill its obligations. In conclusion, the Delegation hoped the Organization's work would be met with success, thanked WIPO experts for their advice and commended the efforts undertaken to enhance the performance of the Kuwait Intellectual Property Office.

17. The Assembly:

- (i) took note of the “Report on the PCT Working Group” (document PCT/A/48/1); and
- (ii) approved the convening of a session of the PCT Working Group as set out in paragraph 6 of that document.

QUALITY-RELATED WORK BY INTERNATIONAL AUTHORITIES

18. Discussions were based on document PCT/A/48/2.

19. The Secretariat explained that the document set out a brief report on the ongoing quality work by the International Searching and Preliminary Examining Authorities, pursued mainly through the work of the Meeting of International Authorities and, notably, its Quality Subgroup. The main purpose of the document was to report on the outcome of the sixth informal meeting of the Quality Subgroup, which was held in Santiago, Chile in January 2016. During that meeting, International Authorities had continued their discussions on possible measures to improve the overall quality and usefulness of the international work products of the PCT, namely, the international search reports and the international preliminary reports on patentability established by the International Authorities.

20. The Assembly took note of the report “Quality-Related Work by International Authorities” contained in document PCT/A/48/2.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

21. Discussions were based on document PCT/A/48/3.

22. The Secretariat introduced the document, which set out proposed amendments of the PCT Regulations. These amendments had been discussed by the PCT Working Group, which had unanimously agreed to recommend that this Assembly should adopt the amendments as proposed. The proposed amendments in Annex I to the document related to the following: extension of the time limit for requesting supplementary international search from 19 to 22 months from the priority date; clarification of the relationship between, on the one hand, Rule 23*bis*.2(a) and, on the other hand, Article 30(2) as applicable by virtue of Article 30(3) in relation to the transmittal by the receiving Office of earlier search and/or classification results to the International Searching Authority; and deletion of “incompatibility provisions” following the withdrawal of the remaining notifications of incompatibility under those provisions.

23. The Assembly:

- (i) adopted the amendments to the Regulations under the PCT set out in Annex I to document PCT/A/48/3; and
- (ii) adopted the decisions set out in paragraph 7 of document PCT/A/48/3 relating to entry into force and transitional arrangements.

24. For ease of reference, Annex I to this report contains a “clean” version of the PCT Regulations as amended by the decision set out in paragraph 23(i), above, and Annex II to this report contains the decisions relating to entry into force and transitional arrangements referred to in paragraph 23(ii), above.

APPOINTMENT OF THE TURKISH PATENT INSTITUTE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

25. Discussions were based on document PCT/A/48/4.

26. The Chair referred to the twenty-ninth session of the PCT Committee for Technical Cooperation in May 2016, which had unanimously agreed to recommend to the Assembly that the Turkish Patent Institute (TPI) be appointed as an International Searching and Preliminary Examining Authority under the PCT, as stated in paragraph 5 of the document.

27. The Delegation of Turkey extended its gratitude to the Director General, Mr. Francis Gurry, for adding the matter of the proposal of the appointment of the TPI as an International Searching and Preliminary Examining Authority (ISA/IPEA) to the agenda of PCT Union Assembly for decision at the fifty-sixth series of meetings of the Assemblies of the Member States of WIPO, pursuant to letter of the TPI dated December 15, 2015. It was pleased to inform the Assembly that the PCT Committee on Technical Cooperation (PCT/CTC), at its twenty-ninth session, had produced a unanimous recommendation by the Member States to the PCT Assembly that the TPI be appointed as an ISA/IPEA under the PCT. In this context, the Delegation wished to reaffirm the TPI's commitment to remaining in full compliance with the minimum requirements for appointment set out in PCT Rules 36.1 and 63.1. The Delegation introduced its application in three main parts. The first part provided general information about Turkey in terms of economic indicators and the IP system. The second part focused on the institutional capacity of the TPI in performing its functions. The final part gave information on how the TPI met the minimum requirements for appointment.

28. The Delegation of Turkey stated that Turkey, with its high population (around 80 million), historical background, geographical location and economic development, was an advanced country in the region, where the neighborhood of Turkey comprised a variety of countries with different social and cultural background from Europe, Asia and the Middle East. Turkey's geographical location, logistical capabilities and its unique positioning at the intersection of three continents were the major factors contributing to Turkey's role in the region. Turkey's economic performance over the last decade had resulted in an average annual real Gross Domestic Product (GDP) growth rate of around 5 per cent. In addition, research and development (R&D) expenditure in Turkey had gone up around 20 per cent in 2014 to reach more than 6 billion United States dollars and was expected to account for 3 per cent of the country's GDP by 2023. The history of IP in Turkey dated back to the 19th century, with initial IP legislation on trademarks coming into force in 1871 and with patent law first being enacted in 1879. In 1994, the TPI had been established as an autonomous body and IP legislation had been revised in line with international standards. Turkey now had a well-functioning IP system, strengthened by specialized IP courts, enforcement bodies and an institutionalized attorney system with around 1000 registered IP attorneys and other stakeholders. A new and modernized draft law, merging all industrial property rights into a single Act, was now on the agenda of the Turkish National Assembly and was currently being elaborated. The Turkish IP infrastructure, particularly the patent system, had shown significant development and expansion at both the national and the international level. According to the IP indicators published by WIPO, resident patent applications had grown by around 20 times in the last 15 years and Turkey had improved its ranking from 45th to 15th in this period. The number of international patent applications filed under the PCT that originated from Turkey had increased around 13 times over the last 15 years, with 1013 international applications filed in 2015, representing an increase of 25 per cent compared to 2014 figures. Especially, among middle-income countries, notable increases had been seen in 2015, and Turkey ranked first according to the number of PCT applications among middle-income countries.

29. The Delegation of Turkey stated that the TPI had the potential to take a role in enhancing the awareness and wider use of the PCT in its region, as well as fostering innovation, dissemination of knowledge, further harmonization and higher quality services in the patent system, and the transfer of technology. Appointment of the TPI as an ISA/IPEA would be

beneficial not only for local users but also for the PCT System as a whole. With its unique location at the intersection of the continents, the TPI might take the role as a bridge to convey IP knowledge and information between Europe and Asia. In addition, the technology bank, to be established in Turkey under the umbrella of the United Nations and dedicated to LDCs in order to support their technological development through the establishment of a patent bank, a science and technology depository facility and a science technology and innovation supporting mechanism, would take advantage of the expansion in patent services. In this context, Turkey aimed at transforming itself into an IP knowledge and information dissemination hub for the region through sharing and exchanging its experience, parallel to becoming an International Authority.

30. The Delegation of Turkey continued by providing some detailed information about the TPI's institutional capacity. The TPI served as a public institution, responsible for the administration of intellectual property rights under the Ministry of Science, Industry and Technology. Further to its flexible management structure, with its own financial resources, the TPI had made a substantial investment in human resources and IT tools to increase the quality of its services. It had a paperless system and received 99 per cent of applications online. The TPI had started to prepare search and examination reports in 2005, with a limited capacity in certain technical fields. Since 2005, the TPI's search and examination capacity had increased as a result of strategic planning in human resources and other necessary technical infrastructure. Search and examination capacity in terms of human resources had increased more than 10 times; currently, search and examination capacity of the TPI covered all technical fields, with well-trained patent examiners in the respective areas. In order to manage the procedures for obtaining appointment as an International Authority, the TPI had prepared a business plan, listing the priorities and milestones for the necessary tasks to be completed. In the context of this business plan, the TPI had established three working groups dedicated to making necessary preparations and arrangements to carry out the functions and tasks required of an International Authority. The TPI had cooperated with the Korean Intellectual Property Office (KIPO) and the Spanish Patent and Trademark Office (SPTO), with reference to the procedures for appointment of International Authorities as agreed at the forty-sixth session of the PCT Union Assembly, which strongly recommended to obtain the assistance of one or more existing International Authorities. At the end of several study visits with an intensive evaluation process, both KIPO and the SPTO had individually come to the conclusion in their reports that the TPI satisfied the minimum requirements. The Delegation took this opportunity to extend its gratitude to the management and representatives of the respective Offices, for their close cooperation and insightful comments, which had assisted the TPI in implementing its business plan.

31. The Delegation of Turkey continued with a brief overview of how the TPI met the requirements for appointment, in conformity with the evaluation reports by KIPO and the SPTO. Currently, the TPI employed 112 full time examiners with sufficient technical qualifications to carry out search and examination work. Additionally, the TPI planned to recruit 50 more examiners and complete their training by the end of 2018. Currently, the average working experience of the patent examiners was seven years and around 50 per cent of the TPI's examiners had masters or PhD degrees. Almost half of the examiners had more than five years of experience in search and examination work. The requirements for being a patent examiner were strictly regimented through an exhaustive recruitment process, which was followed by an intensive training program related to the skills, knowledge and strategies concerning patent search and examination principles. This procedure was also in line with the requirement to be met in terms of human resources. Furthermore, the TPI cooperated with other national Offices to provide training on the technicalities and procedures of PCT applications. Recently, a training program by two patent examiners from KIPO to the TPI examiners had been conducted on September 26 and October 5, 2016. In order to further raise the capacity of the TPI's examiners, the TPI was pursuing additional training activities with the patent Offices of Japan, the Republic of Korea, Spain and the United States of America, in addition to benefiting from training activities by the European Patent Office and by WIPO. In this context, it was assured

that the TPI met the requirements set out in PCT Rules 36.1(i) and 63.1(i). With regard to the minimum documentation accessible for search and examination, the TPI enjoyed full access to EPOQUE-Net, with Turkey being a Contracting State of the European Patent Convention. Furthermore, fundamental commercial databases were available to the TPI. In addition, the TPI had access to the library and databases of the Turkish Scientific and Technological Research Council, which provided official bulletins, periodicals, journals and books in various fields of science and technology. Therefore, as regards the PCT minimum documentation, the TPI had access to patent and non-patent literature databases, as required under Rule 34 of the PCT Regulations.

32. The Delegation of Turkey continued by highlighting that, with regard to the required quality management system (QMS) for international search and examination purposes, the TPI had obtained the ISO 9001 certification as a normative reference. Studies to meet the criteria for ISO 27001 concerning IT security systems were in the pipeline and expected to be completed in the first half of 2017. The pillars of the TPI's search and examination quality policy were based on reliability, consistency, transparency, legal compliance, timeliness and continual improvement. In this regard, the TPI had adopted the Plan-Do-Check-Act (PDCA) cycle methodology as the basic principle for the implementation of the QMS. In the quality control process, all reports were reviewed by a second examiner in order to ensure high quality results before issuing the reports. Within the planned quality assurance process under operations as an International Authority, 5 per cent of the reports would be randomly selected and controlled according to determined parameters by the quality team. The results would be recorded and reported periodically. In this regard, the TPI ensured that the QMS requirements set out in Chapter 21 of the PCT Search and Examination Guidelines would be met.

33. The Delegation of Turkey added that, globally, there had been a steady increase in the number of PCT applications in recent years, with 218,000 applications filed in 2015, representing an increase of around 2 per cent on 2014 figures, and marking the sixth consecutive year of growth. In parallel to growth in the number of PCT applications, the workload for search and examination activities had been growing each year. In order to meet the demand and strike a balance with the quality standards, an increase in the number of PCT International Authorities and work-sharing among patent Offices was the way forward. With its extensive resources for search and examination work, the TPI was willing to contribute to handle this workload, in cooperation with other national Offices. In this regard, the TPI had recently entered into bilateral agreements for work-sharing with the national patent Offices of China, Japan and Spain to enable patent applicants to request expedited processing in the national phase under the Patent Prosecution Highway (PPH), which would be launched by the TPI as soon as it became functional as an International Authority. Additionally, the TPI was looking forward to starting PPH negotiations with KIPO. The TPI also welcomed the opportunity to contribute to the global system by taking on national search work from other Offices, such as Bosnia and Herzegovina, and was willing to extend its services to other neighboring countries in the region under its existing 30 bilateral cooperation agreements.

34. The Delegation of Turkey concluded by stating that it strongly believed that acting as an International Authority would allow the TPI to function as a bridge between Europe and Asia, and to contribute to the dissemination of PCT knowledge by creating a network between local and regional users and to support the development and promotion of the PCT System in its region. The Delegation reiterated its highest considerations and gratitude to KIPO Office and to the SPTO for their impartial cooperation and assistance. Thanks to their excellent assistance, the TPI stood before the Assembly fully ready for appointment, without any need for additional work or requiring additional time to meet the criteria. The Delegation further extended its thanks to the Secretariat and, in particular, to the staff of the PCT International Cooperation Division for their excellent guidance during the process. The Delegation offered its application up to the professional and objective assessment of the other delegations on the issues of the technical criteria for appointment and stated that it would be pleased to provide any further clarifications that might be requested by the Assembly of the PCT Union.

35. The Delegation of the Republic of Korea expressed appreciation to the Delegation of Turkey for the presentation of the request for the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT. KIPO had been able to confirm that the TPI met the minimum requirements under PCT Rules 36.1 and 63.1 to be appointed to as an International Authority. The TPI had more than the minimum number of 100 patent examiners with sufficient technical qualifications. At the same time, the TPI had a quality management system as specified in the PCT International Search and Preliminary Examination Guidelines. Moreover, the TPI had a strong willingness to improve its quality management system. Experts from KIPO had visited the TPI twice and checked their systems. Based on the observations of these experts, the Delegation was able to determine that the TPI was competent to perform as International Searching and Preliminary Examining Authority. Additionally, examiners at KIPO had been able to pass down their experience of international search by providing training to the TPI examiners last month. Therefore, the Delegation firmly supported the appointment of the TPI as an International Authority and expected that the TPI would contribute to the development of the PCT System in this role, as well as KIPO extending its cooperation with the TPI.

36. The Delegation of Spain stated that it had worked closely with the TPI to provide technical support and to consider its viability as an International Authority. Throughout the process, the SPTO had become familiar with the professionalism of the TPI and recognized that it met the requirements in order to be an International Searching and Preliminary Examining Authority. The Delegation also thanked the Delegation of Turkey for its kind words regarding the SPTO and the advice that it had been able to provide to support the candidacy of the TPI.

37. The Delegation of India supported the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT. The Delegation believed that the TPI fulfilled the criteria provided for acting as an International Searching and Preliminary Examining Authority under the PCT and would offer high quality services to applicants at more attractive costs, which would be especially important for small and medium-sized enterprises (SMEs) and individual inventors.

38. The Delegation of Iran (Islamic Republic of) supported the proposal of the TPI to be appointed as an International Searching and Preliminary Examining Authority under the PCT and stated that neighboring countries could take advantage of this new International Authority.

39. The Delegation of Mongolia supported the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.

40. The Delegation of Saudi Arabia expressed its support for the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.

41. The Delegation of Sudan supported the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT and stated that it was confident that the TPI would play an effective role in this regard.

42. The Delegation of the Philippines believed that, with the expanding role of the patent system, there was a need for a more robust, balanced and strategic presence of International Searching and Preliminary Examining Authorities across the world regions and continents. In this regard, the Delegation manifested its strong support for the appointment of the TPI as an International Searching and Preliminary Examining Authority, which had met the minimum requirements under the PCT. The Delegation welcomed the active role that the TPI could play in the promotion and protection of patentable inventions in the global IP system. The appointment of a new International Authority in one of the emerging market economies would bolster the role of the IP system in sharing economic and technological development and be a rigorous and dynamic channel to a competent, credible search and preliminary examination.

43. The Delegation of Georgia thanked the Delegation of Turkey for its comprehensive report on the activities undertaken by the TPI to fulfil the minimum requirements for appointment as an International Searching and Preliminary Examining Authority under the PCT, and expressed full support for the appointment.

44. The Delegation of Austria stated that the Austrian Patent Office, as an International Authority, had been carefully examining the documentation accompanying the request under consideration and had listened with great interest to the additional information provided by the Representative of the TPI. As the Delegation had already expressed at the twenty-ninth session of the PCT Committee for Technical Cooperation, it supported the proposal to appoint the TPI as an International Searching and Preliminary Examining Authority under the PCT and wished the management of the TPI all the best in this future task and challenge.

45. The Delegation of China believed that the TPI met the requirements set out in the PCT Regulations on the number of examiners, minimum documentation, language skills of examiners as well as having in place a quality management system. The Delegation therefore supported the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.

46. The Delegation of Chile thanked the Delegation of Turkey for the information that it had provided and endorsed the request for the TPI to be appointed as an International Searching and Preliminary Examining Authority under the PCT.

47. The Delegation of Israel stated that it supported the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.

48. The Delegation of Japan supported the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT. The Delegation welcomed any efforts that the TPI could make in terms of enhancing the PCT System, which was an important instrument to all innovators seeking patent protection internationally, and expected the TPI to play an important role in the development of the PCT system between Europe and Asia.

49. The Delegation of Tajikistan supported the request of the Delegation of Turkey for the TPI to be appointed as an International Searching and Preliminary Examining Authority under the PCT.

50. The Delegation of Brazil associated itself the comments of other delegations in supporting the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.

51. The Delegation of Mexico endorsed the proposal made by the TPI to be appointed as an International Searching and Preliminary Examining Authority under the PCT.

52. The Delegation of Tunisia thanked the Delegation of Turkey for the information provided by the TPI and the efforts it had put forward to promote the patent system, and endorsed the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.

53. The Delegation of Oman aligned itself with the interventions made by other delegations in support of the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.

54. The Delegation of Morocco aligned itself with the interventions made by other delegations in support of the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.

55. The Delegation of Senegal endorsed the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.
56. The Delegation of South Africa stated its support for the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.
57. The Delegation of Singapore expressed support for the TPI to become an International Searching and Preliminary Examining Authority under the PCT, as it had previously done during the twenty-ninth session of the PCT Committee for Technical Cooperation. Turkey had historically served as a gateway between east and west and this continued in the modern age, being able to promote PCT services across the boundaries of Europe, Asia, and the Middle East. The Delegation was confident that the TPI complied with the minimum requirements for appointment as an International Authority, which would greatly boost the value of the PCT.
58. The Delegation of Finland thanked the Delegation of Turkey for the comprehensive presentation and noted the hard work that the TPI had carried out in preparing for the role as an International Authority. As the Delegation had already stated in the PCT Committee for Technical Cooperation, it fully supported the appointment of the TPI as an International Searching and Preliminary Examining Authority under the PCT.
59. The Delegation of Cyprus, in accordance with the General Rules of Procedures of WIPO and the Rules of the PCT Union, stated that the Republic of Cyprus declared its reservations for the decisions referred to in paragraphs 9(ii) and (iii) of document PCT/A/48/4. Turkey questioned the existence of the Republic of Cyprus and refused any contact and cooperation with the Cypriot authorities and services in all matters, including those on the agenda of WIPO. Any decision on the appointment of the TPI as an International Searching Authority and International Preliminary Examining Authority should be considered and interpreted in the context of UN Security Council Resolutions on Cyprus, notably Resolutions 541 (1983) and 550 (1984). In this regard, Cyprus was not joining the consensus concerning the approval of the Draft Agreement between the TPI and the International Bureau of WIPO in relation to the functioning of the TPI as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty. Consequently, Cyprus was not in agreement with the appointment of the TPI as an International Searching Authority and International Preliminary Examining Authority. The Delegation concluded by requesting these objections to be recorded in the report of the meeting.
60. The Assembly, in accordance with Articles 16(3) and 32(3) of the PCT, having heard the Representative of the Turkish Patent Institute and taking into account the advice of the PCT Committee for Technical Cooperation set out in paragraph 5 of document PCT/A/48/4, and noting the reservations expressed by the Delegation of Cyprus:
- (i) approved the text of the draft Agreement between the Turkish Patent Institute and the International Bureau set out in the Annex to document PCT/A/48/4; and
 - (ii) appointed the Turkish Patent Institute as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2017.
61. The Director General of WIPO, Mr. Francis Gurry, on behalf of the International Bureau, congratulated the Delegation of Turkey on the appointment of TPI as an International Searching and Preliminary Examining Authority under the PCT, and stated that the International Bureau looked forward to the commencement of operations and working with TPI in its new capacity as an International Searching and Preliminary Examining Authority.
62. The Delegation of Turkey stated that it appreciated the positive statements by the member States of the PCT Union and expressed its warm thanks to all member States for their objective assessment of the proposal to appoint TPI as an International Searching and Preliminary

Examining Authority. It expressed its special thanks to KIPO and to the SPTO, which had shown a perfectly professional and impartial approach in assessing the TPI's capacity for this function. Thanks to their impartiality in highlighting a number of areas, the TPI had had the chance to improve itself even before submitting its application. In that regard, the TPI's commitment and resolve to provide high quality search and examination services had never been stronger. The Delegation wished to take this opportunity to inform the Members of the PCT Union that the TPI had already entered into bilateral agreements for establishing a Patent Prosecution Highway with the patent Offices of China, Japan and Spain and that it was continuing its negotiations with the patent Office of the Republic of Korea. It had no doubt that the TPI would considerably benefit from working with these Offices and assist the functioning of the global patent system. The Delegation concluded by saying that it felt that the confidence entrusted to the TPI on this day would be its persistent driving force to improve its services even further and by thanking Member States once more for their constructive approach.

63. The Delegation of United States of America welcomed the appointment of TPI as an International Searching and Preliminary Examining Authority under the PCT and congratulated the TPI on this achievement.

64. The Delegation of Sweden congratulated TPI on its appointment as an International Searching and Preliminary Examining Authority under the PCT. The Swedish Patent and Registration Office had had fruitful cooperation with the TPI for almost 20 years and it welcomed and looked forward to continue cooperation within the framework of PCT International Authorities.

65. The Delegation of Romania joined the Delegations of the United States of America and Sweden in congratulating TPI on its appointment as an International Authority.

ePCT

66. The Director General of WIPO, Mr. Francis Gurry, introduced a short video explaining the new "look and feel" of ePCT to be launched in early 2017. The new "look and feel" marked a substantial improvement to the environment of ePCT and to the PCT System, providing a more comfortable and accessible interface for users, who would be given a time to transition to the new version.

[Annex I follows]

AMENDMENTS TO THE PCT REGULATIONS
TO ENTER INTO FORCE ON JULY 1, 2017

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Rule 4

The Request (Contents)

4.1 to 4.9 *[No change]*

4.10 *Priority Claim*

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

(d) *[Deleted]*

4.11 to 4.19 *[No change]*

Rule 23bis

Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 *[No change]*

23bis.2 *Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2*

(a) For the purposes of Rule 41.2, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, the receiving Office shall, subject to Article 30(2)(a) as applicable by virtue of Article 30(3) and paragraphs (b), (d) and (e), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are available to the Office, and a copy of the results of any such earlier classification effected by the Office, if already available. The receiving Office may, subject to Article 30(2)(a) as applicable by virtue of Article 30(3), also transmit to the International Searching Authority any further documents relating to such an earlier search which it considers useful to that Authority for the purposes of carrying out the international search.

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

Rule 45bis

Supplementary International Searches

45bis.1 Supplementary Search Request

(a) The applicant may, at any time prior to the expiration of 22 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45bis.9. Such requests may be made in respect of more than one such Authority.

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

45bis.2 to 9 [No change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

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

(f) *[Deleted]*

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

[Annex II follows]

DECISIONS RELATING TO THE ENTRY INTO FORCE OF THE AMENDMENTS IN ANNEX I

“The amendment of Rule 45*bis*.1(a) shall enter into force on July 1, 2017, and shall apply to any international application, irrespective of its international filing date, in respect of which the time limit for filing a request for supplementary international search under Rule 45*bis*.1(a) as in force until June 30, 2017, has not yet expired on July 1, 2017.”

“The amendments of Rule 23*bis*.2 shall enter into force on July 1, 2017, and shall apply to any international application whose international filing date is on or after July 1, 2017.”

“The amendments of Rules 4.10 and 51*bis*.1 shall enter into force on July 1, 2017.”

[End of Annex II and of document]

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Ninth (21st Ordinary) Session
Geneva, October 2 to 11, 2017

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/57/1): 1 to 6, 10(ii), 12, 21, 30 and 31.
2. The report on the said items, with the exception of item 21, is contained in the General Report (document A/57/12).
3. The report on item 21 is contained in the present document.
4. Mr. Sandris Laganovskis (Latvia) was elected Chair of the Assembly; Mr. He Zhimin (China) and Mr. Lamin Ka Mbaye (Senegal) were elected Vice-Chairs..

ITEM 21 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

5. The Chair welcomed all delegations, especially the Delegation of Jordan, which had acceded to the PCT since the previous session of the Assembly in October 2016.

Report on the PCT Working Group

6. Discussions were based on document PCT/A/49/1.

7. The Secretariat introduced the document, which set out a report of the tenth session of the PCT Working Group. The session had a full agenda, with 25 agenda items and 23 working documents. This demonstrated the continued interest in the development of the PCT System as the central pillar of the international patent system to bring about further improvements for the benefit of Offices and users. A separate document (document PCT/A/49/4), setting out changes to the PCT Regulations approved by the Working Group, had been submitted to the Assembly for decision. An overview of all items discussed during the session was provided in the Summary by the Chair attached to the document.

8. The Delegation of Costa Rica, speaking on behalf of the Group of Latin America and the Caribbean (GRULAC), stated its support for the approval and rapid implementation of the proposal by Brazil set out in document PCT/WG/10/18, which proposed fee reductions for universities in developing countries.

9. The Delegation of Chile expressed support for the statement by the Delegation of Costa Rica on behalf of GRULAC. Since the National Industrial Property Institute of Chile had been appointed as an International Searching and Preliminary Examining Authority under the PCT, it had made important improvements to be at the forefront of patenting and had been playing an important role in Latin American and the Caribbean region. As a country, Chile wished to continue to contribute to the improvement of patent systems, providing a quality service not only for Latin American countries but also for the countries of the Caribbean if they so required. For this reason, the Delegation hoped for the extension of the appointment of the National Industrial Property Institute of Chile as an International Searching and Preliminary Examining Authority under the PCT during this session. The Delegation concluded by reiterating its support for the proposal by Brazil set out in document PCT/WG/10/18 for fee reductions for universities in developing countries and hoped that discussions could continue about facilitating the participation of universities in the international patent system and providing incentives for innovation.

10. The Delegation of China, speaking on behalf of Brazil, Russian Federation, India, China and South Africa (BRICS), reiterated its support for the proposal by Brazil set out in document PCT/WG/10/18 for fee reductions for universities in developing countries, which would adjust the fee reduction policy in the right direction for the development of the PCT System. It would not only give greater encouragement to university innovation and creativity, but also further promote technology dissemination and expand accessibility and the influence of the PCT System through extending the scope of fee reductions to universities, especially those in developing countries. As indicated in the proposal, the reductions would also give potential applicants from universities the opportunity to file more PCT applications, which may, to a great part, balance the revenue loss from WIPO in this field. The proposed fee reduction for universities would be a real assistance by WIPO for developing countries in enhancing innovative activities, as a valuable supplement to training and education programs carried out by the Organization.

11. The Delegation of Brazil supported the statements made by the Delegation of Costa Rica on behalf GRULAC and the Delegation of China on behalf of BRICS. A basic element of the

international intellectual property system was to stimulate technological innovation and creativity by fostering cooperation between Member States. This was reflected in the major relevant international treaties, such as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) as well as the PCT. In the preamble of the PCT it stated “that cooperation among nations will greatly facilitate the attainment of these aims”; these aims included “to make a contribution to the progress of science and technology” and also “to facilitate and accelerate access by the public to the technical information contained in documents describing new inventions”. However, challenges remained with regard to the need to increase the use of WIPO’s global registration systems by developing countries. There was a clear and concrete necessity of action by WIPO and its Member States to address this issue, in particular in the PCT. A very effective way for doing so was through fees. As stated by the International Bureau during the PCT Working Group, fees in essence served two distinct functions: first, to recover costs, and second, to serve as a regulatory tool to influence filing behavior. The proposal for fee reductions for universities in developing countries aimed at making full use of PCT fees as a regulatory tool by positively influencing the filing behavior of universities, but without substantially affecting the cost recovery function of those fees. The targeted fee reductions would generate concrete improvements by bringing about a 7 per cent increase in PCT applications from developing countries, advancing innovation and stimulating activity. It would also be in line with several of the strategic goals of WIPO, such as strategic goals 2, 3, 5 and 7, as well as the stated goal of WIPO of ensuring a more widespread use of services provided by WIPO’s global registration systems. At the tenth session of the PCT Working Group, the proposal had received the support of delegations speaking on behalf of a total of 108 countries, representing more than two thirds of all PCT Member States. There was an urgent need of providing a response to the legitimate demand of those countries, which came from different regions and had different levels of development. Furthermore, as proposed in document PCT/WG/10/18, Brazil understood that a fee reduction for universities from developed countries could also be discussed, taking into account estimations regarding the financial impact made by the WIPO Chief Economist. The implementation of such a fee policy would enable the use of a large pool of scientific and technological talent in these universities. There was a genuine need to tap this knowledge source and to create additional incentives to enable the production of innovative products and services. The proposed fee reduction would encourage the use of the PCT System and increase the diversity in the geographical composition of applications, generating additional demand in the medium term for PCT services. In conclusion, the Delegation called on all Member States to support and approve the discussion of this proposal, that, when implemented, would create a small fee reduction for the benefit of the international community, promote the use of the patent system and take a first concrete step following the discussions related to PCT fee elasticity.

12. The Delegation of the Russian Federation expressed its support for the statement made by the Delegation of China on behalf of BRICS and other delegations that had spoken on the subject of reduced fees for universities, which would be an additional stimulus for the development of the PCT System.

13. The Delegation of the United States of America stated that it looked forward to continuing to discuss the proposal from Brazil for a fee reduction for universities and related issues in the PCT Working Group.

14. The Delegation of Greece expressed satisfaction with the performance of the PCT System, noting that increased PCT filings had contributed to the positive financial result of WIPO in 2016. The PCT System was robust, thanks to the tireless efforts and commitment of the staff at the International Bureau. For a system to remain robust, continuous improvement needed to take place to respond to new challenges and to the changing needs of users. At the same time, it needed to be conducive to innovation and provide incentives to ensure accessibility to any interested user, especially those with limited financial resources. In the past two years, reductions in the international filing fee for eligible natural persons had enabled Greek applicants to file international applications and pursue the protection of innovative

products worldwide. University-driven innovation also needed to be stimulated through lowering the entry costs, so it was necessary to explore fee reductions for university applicants, on the understanding that the impact to the PCT revenue would be minimal. The Delegation welcomed the discussions initiated in the PCT Working Group and looked forward to a positive outcome.

15. The Delegation of Egypt supported the proposal from Brazil for a fee reduction for universities, as this would incentivize the increase of applications, especially in developing countries.

16. The Delegation of India aligned itself with the statement made by the Delegation of China on behalf of BRICS.

17. The Delegation of South Africa associated itself with the statement made by the Delegation of China on behalf of BRICS.

18. The Assembly of the PCT Union:

(i) took note of the "Report on the PCT Working Group" (document PCT/A/49/1); and

(ii) approved the convening of a session of the PCT Working Group, as set out in paragraph 4 of that document.

Proposed Amendments to the PCT Regulations

19. Discussions were based on document PCT/A/49/4.

20. The Secretariat introduced the document, which set out proposed amendments of the PCT Regulations and an Understanding to be adopted by the Assembly. The amendments had been discussed by the PCT Working Group, which had unanimously agreed to recommend that this Assembly should adopt the amendments as proposed. The proposed amendments in Annex I to the document related to the following: correction of references in Rules 4.1(b)(ii) and 41.2(b) to properly reflect changes in numbering, consequential to the amendments to Rules 12*bis* and 23*bis* adopted by the Assembly at its forty-seventh (held in October 2015) and forty-eighth sessions (held in October 2016), respectively; and amendment to the Schedule of Fees to make clear that the 90 per cent fee reductions in item 5 were intended only for persons filing an international application in their own right and not for those filing an international application on behalf of a person or entity which was not eligible for the reduction, such as a director or employee of a company filing an international application on behalf of a company in order to obtain the reduction in item 5(a). In addition to the proposed amendment of the Schedule of Fees, the document also invited the Assembly to adopt an Understanding that the fee reductions in item 5 were intended to apply only in cases where the applicants were the sole and true owners of the application, and not under obligation to assign, grant, convey or license the rights in the invention to another party which was not eligible for the fee reduction. This Understanding had been approved by the PCT Working Group and was set out in paragraph 3 of the document.

21. The Delegation of the United States of America stated that it was in favor of adopting the proposed amendments to the Regulations under the PCT set out in the document, along with the proposed decisions relating to entry into force and transitional arrangements. The Delegation also supported adoption of the Understanding set out in paragraph 3 of the document as a step towards clarifying the applicability of the 90 per cent fee reduction intended for national person applicants from certain countries with a goal of reducing the incidence of improperly claimed fee reductions.

22. The Assembly of the PCT Union:

- (i) adopted the proposed amendments to the Regulations under the PCT set out in Annex I to document PCT/A/49/4, and the proposed decision set out in paragraph 6 of document PCT/A/49/4 relating to entry into force and transitional arrangements; and
- (ii) adopted the Understanding set out in paragraph 3 of document PCT/A/49/4 with effect from October 11, 2017.

23. For ease of reference, Annex I to this report contains a “clean” version of the PCT Regulations as amended by the decision set out in paragraph 22(i), above; Annex II to this report contains the decision relating to the entry into force and transitional arrangements referred to in paragraph 22(i), above, and the Understanding referred to in paragraph 22(ii), above.

Appointment of the Intellectual Property Office of the Philippines as an International Searching and Preliminary Examining Authority under the PCT

24. Discussions were based on document PCT/A/49/3.

25. The Chair referred to the thirtieth session of the PCT Committee for Technical Cooperation in May 2017, which had unanimously agreed to recommend to the Assembly that the Intellectual Property Office of the Philippines (IPOPHL) be appointed as an International Searching and Preliminary Examining Authority under the PCT, as stated in paragraph 4 of the document.

26. The Delegation of the Philippines presented the application of IPOPHL for appointment as an International Searching and Preliminary Examining Authority under the PCT, as had been endorsed by the PCT Committee for Technical Cooperation at its thirtieth session in May 2017. The Delegation stated that the Philippines was strategically located at the gateway of Asia and had a highly literate population of 104 million, whose capabilities and competences were recognized over the entire spectrum of professions. The country was home to 2,180 colleges and universities and top multinational corporations conducting robust research and development activities. The appointment of IPOPHL as an International Searching and Preliminary Examining Authority complemented government policy of mainstreaming science, technology and innovation platforms across national and local development agendas and would help to further foster research and development. It also fitted into the Philippine Development Plan 2017-2022 towards a global competitive knowledge economy. Currently, there were 152 PCT Contracting States and the membership was expected to increase in the years to come, which would present considerable demand in international work. Asia accounted for 43.5 per cent of PCT applications in 2015, and the South East Asia region had registered continuous growth in recent years, which translated to higher demand for international PCT work. With about 70 years of search and examination experience, IPOPHL was well-placed to assist the system in responding to this increasing demand. As the technical information of the application had been reviewed and considered by the PCT Committee for Technical Cooperation in May, the Delegation wished to briefly outline the institutional capacity to be designated as an International Searching Authority and International Preliminary Examining Authority pursuant to the PCT Regulations, which IPOPHL had achieved with utmost diligence for the past four years. First, IPOPHL had the sufficient technical and manpower to carry out search and examination in the required technical fields, pursuant to Rule 34 of the PCT Regulations. Second, the patent examiners at IPOPHL used comprehensive commercial and publicly accessible databases covering patent and non-patent science and engineering databases for search and examination, which collectively covered the PCT minimum documentation and more. Third, a comprehensive quality management system, namely in-process quality check, ISO 9001:2008 and an internal patent quality review system (PQRS),

exceeded the common rules of international search and preliminary examination defined by Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. And fourth, the recommendations by the Japan Patent Office (JPO) and IP Australia as existing International Searching and Preliminary Examination Authorities with regard to the appointment of IPOPHL, which had been made at the thirtieth session of the PCT Committee for Technical Cooperation. On this note, the Delegation expressed utmost gratitude for JPO and IP Australia for their support and guidance in its preparations for the appointment and was pleased that both Offices had expressed their willingness and interest in continuing to assist IPOPHL in the years ahead. In addition, the Delegation expressed appreciation for other bilateral partners, such as the United States Patent and Trademark Office (USPTO) and the Intellectual Property Office of Singapore (IPOS), for their support. It was this spirit of cooperation and partnership within the PCT Union that had encouraged the Philippines to take a larger role in the PCT System. In addition, the Delegation thanked the Secretariat for its assistance in the process. In sum, if appointed as an International Searching and Preliminary Examination Authority, IPOPHL would positively contribute to the PCT System as follows: first, by greatly helping to address the demand for PCT work, particularly the increasing volume of applications, by providing quality and timely services; second, by serving as a strategic partner of other International Searching and Preliminary Examining Authorities in the region, specifically the Intellectual Property Office of Singapore; third, by acting as a strategic link in the PCT System in the growing Asian market, by promoting the system in Asia, particularly to individual applicants, start-up companies and the new breed of innovators in the region, as well as by providing a platform to use the PCT System for the expanding network of 85 Technology and Innovation Support Centers in the region; and fourth, by laying down the necessary institutional structure in the region to pave the way for increasing the use of the IP system for developing and emerging economies.

27. The Delegation of Australia stated that IP Australia had a longstanding and constructive relationship with IPOPHL, which had been reinforced over recent years by collaboration on the Regional Patent Examiner Training Program. The Philippines had been a Contracting State of the PCT since 2001 and had considerable experience of the PCT. The Delegation noted that the application of IPOPHL for appointment as an International Searching and Preliminary Examination Authority underpinned policies aimed at the development of innovation and prosperity in the Philippines. This, in turn, could encourage increased use of the international patent system in the Asian region and potentially add value to the network of existing International Authorities. The Delegation noted that IPOPHL had further strengthened its operations recently by adding searching tools, such as the Scientific and Technical Information Network (STN) and by trialing the EPOQUE-Net query services, and the Delegation was confident that the search and examination carried out by IPOPHL as an International Search and Preliminary Examination Authority would be consistent with the ideals of the PCT. As part of the longstanding and cooperative relationship with the Philippines, IP Australia looked forward to providing further ongoing assistance to IPOPHL to help with the transition required to become an operational International Searching and Preliminary Examining Authority. IP Australia was pleased to have been involved in the journey with IPOPHL leading up to the appointment and the Delegation wished IPOPHL all the best in this endeavor going forward.

28. The Delegation of Japan stated that, as one of the International Authorities that had assessed the eligibility of IPOPHL to be appointed as an International Searching Authority and International Preliminary Examining Authority, it fully supported the appointment of IPOPHL. The close cooperation in the field of Intellectual Property between the JPO and IPOPHL went back a long time, and had involved a wide range of activities, such as development of human resources and automation of processes. As part of cooperation with IPOPHL in the PCT, the JPO had used not only the WIPO Japan Funds-in-Trust but had also signed a bilateral Memorandum of Cooperation with IPOPHL. The JPO had conducted an assessment of IPOPHL in an objective manner on various aspects to determine whether IPOPHL met the minimum requirements, in line with the PCT Rules 36.1 and 63.1. The result of this assessment had been included in Appendix 3 of the Annex to document PCT/CTC/30/2 Rev., which concluded that IPOPHL met the minimum requirements under the relevant PCT Rules on the

assumption that it would have examiners with sufficient capability to conduct searches and would have access to some non-patent document databases by the time the PCT Assembly was held in October 2017. IPOPHL had advised the JPO that this requirement had already been met. The Delegation concluded by congratulating IPOPHL on its effort to strengthen its capabilities as an International Searching and Preliminary Examining Authority and wished that the PCT System would develop further with the appointment of the IPOPHL as an International Searching and Preliminary Examining Authority. The JPO would continue to be committed to assisting IPOPHL in its operations as a competent International Searching and Preliminary Examining Authority.

29. The Delegation of the Republic of Korea stated that the PCT Committee for Technical Cooperation had reviewed the application for IPOPHL to be appointed as an International Searching Authority and International Preliminary Examining Authority and had determined that the minimum criteria for appointment had been sufficiently met. The Delegation therefore agreed with the appointment.

30. The Delegation of Oman stated that it supported the appointment of IPOPHL as an International Searching and Preliminary Examining Authority under the PCT. The Delegation considered that this was an important step forward to meet the growing number of PCT applications in Asia, which had witnessed a 43 per cent increase in recent times.

31. The Delegation of Singapore reiterated its support for the application of IPOPHL to become an International Searching Authority and International Preliminary Examining Authority under the PCT. Through close bilateral and regional cooperation with IPOPHL, the Delegation was confident that IPOPHL would be capable of discharging its duties as an International Searching and Preliminary Examining Authority. The Delegation believed that having another International Authority in the region would be synergistic with efforts to improve quality and efficiency of patents in the region. The Delegation therefore supported the application and looked forward to the continued contribution by IPOPHL to the PCT System.

32. The Delegation of Ukraine expressed its support for the appointment of IPOPHL as an International Searching Authority and International Preliminary Examining Authority under the PCT, wished it success in this work and also indicated its wish for further close cooperation.

33. The Delegation of the United States of America joined with the other delegations in their support for the appointment of IPOPHL as an International Searching Authority and International Preliminary Examining Authority under the PCT and looked forward to IPOPHL beginning operations in this capacity soon.

34. The Delegation of Brazil expressed its support for the appointment of IPOPHL as an International Searching Authority and International Preliminary Examining Authority under the PCT.

35. The Delegation of Austria joined with the other delegations in expressing support for the appointment of IPOPHL as an International Searching Authority and International Preliminary Examining Authority under the PCT. The Austrian Patent Office looked forward to cooperating with IPOPHL as a member of the family of PCT International Authorities.

36. The Delegation of Egypt expressed its support for the appointment of IPOPHL as an International Searching Authority and International Preliminary Examining Authority under the PCT.

37. The Delegation of Indonesia joined the other delegations in expressing support for the appointment of IPOPHL as an International Searching Authority and International Preliminary Examining Authority under the PCT.

38. The Assembly of the PCT Union, in accordance with Articles 16(3) and 32(3) of the PCT:

- (i) heard the Representative of the Intellectual Property Office of the Philippines and took into account the advice of the PCT Committee for Technical Cooperation set out in paragraph 4 of document PCT/A/49/3;
- (ii) approved the text of the draft Agreement between the Intellectual Property Office of the Philippines and the International Bureau set out in the Annex to document PCT/A/49/3; and
- (iii) appointed the Intellectual Property Office of the Philippines as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2027.

39. The Delegation of the Philippines stated that it was honored and humbled by the decision of the Assembly to appoint IPOPHL as an International Searching and Preliminary Examining Authority. The journey to becoming an International Authority had been truly challenging and fulfilling. IPOPHL had been diligently working on necessary institutional and organizational preparations to ensure that it had met, and in certain aspects exceeded, the minimum requirements for designation. The appointment was a significant milestone, not only for IPOPHL, but for the Philippines as well. The Philippines National Development Plan aimed to transform the Philippines into a knowledge-driven and innovative society, and the appointment by the Assembly would complement research and innovation activities in the country, and in the South East Asian region. The Delegation expressed extreme gratitude and profound appreciation to its partner Offices, IP Australia and the JPO, for their invaluable assistance and collaboration, providing guidance and support in the process. The generosity of both Offices in sharing their wealth of experience, efficient practices and policies had greatly benefited IPOPHL during the whole process. IPOPHL was also greatly inspired by their positive and constructive engagement to further enhance capacity and competence in the future, and it was reassuring to know that both Offices had committed to continue working with IPOPHL in benchmarking international operations and building of capacities and competencies as an International Searching and Preliminary Examining Authority. The Delegation also thanked the USPTO for its support, assistance and helpful insights, and conveyed its gratitude to IPOS for its statement of support and encouragement. As the first International Searching and Preliminary Examining Authority in the South East Asian region, support from Singapore had been of utmost importance. The Delegation also thanked the Delegations from the Republic of Korea, Oman, Ukraine, Brazil, Austria, Egypt and Indonesia for their statements of support. In addition, the Delegation conveyed its appreciation to the Secretariat at the International Bureau for its valuable assistance and support, and to the Chair of the PCT Working Group and PCT Committee for Technical Cooperation. In closing, the Delegation looked forward to working with other International Searching and Preliminary Examining Authorities and all PCT Contracting States in ensuring an efficient patent system.

40. The Director General, on behalf of the International Bureau, congratulated the Delegation of the Philippines on the appointment of IPOPHL as an International Searching and Preliminary Examining Authority under the PCT, and looked forward to the commencement of operations and working with IPOPHL in its new capacity.

Extension of Appointment of the International Searching and Preliminary Examining Authorities

41. Discussions were based on documents PCT/A/49/2 and PCT/A/49/2 Corr.

42. The Chair referred to the thirtieth session of the PCT Committee for Technical Cooperation in May 2017, which had unanimously agreed to recommend to the Assembly the extension of the appointment of all national Offices and intergovernmental organizations

currently acting as International Searching and Preliminary Examining Authorities under the PCT, as stated in paragraph 4 of the document. The Chair explained that the Australian Patent Office and the Canadian Commissioner of Patents had informed the International Bureau that they would be unable to complete their respective national processes for approval of their new agreements with the International Bureau in relation to their operation as an International Searching and Preliminary Examining Authority before the expiry of their existing agreements on December 31, 2017. Consequently, the document proposed that, in addition to approving the extension of appointment of these two Authorities until December 31, 2027, also to approve the extension of the existing agreements of both Authorities for a period of up to one year, pending ratification of the new agreements. The Chair concluded by stating that all International Authorities had presented a detailed application for their extension of appointment, which had been considered by the PCT Committee for Technical Cooperation when giving its favorable advice to the Assembly. The Chair therefore suggested that the statements made by the International Authorities during the thirtieth session of the PCT Committee for Technical Cooperation should be considered as having already been “heard” by the Assembly in accordance with the procedures for extension of appointment as an International Searching Authority and International Preliminary Examining Authority under PCT Articles 16(3)(e) and 32(3), respectively.

43. The Assembly of the PCT Union, in accordance with Articles 16(3) and 32(3) of the PCT:

- (i) heard the Representatives of the International Authorities and took into account the advice of the PCT Committee for Technical Cooperation set out in paragraph 4 of document PCT/A/49/2;
- (ii) approved the text of the draft agreements between the International Authorities and the International Bureau set out in Annexes I to XXII of document PCT/A/49/2 (as modified by document PCT/A/49/2 Corr.); and
- (iii) extended the appointment of the present International Searching and Preliminary Examining Authorities until December 31, 2027.

[Annexes follow]

AMENDMENTS TO THE PCT REGULATIONS
TO ENTER INTO FORCE ON JULY 1, 2018

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No table of contents entries found.

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) [No change]

(b) The request shall, where applicable, contain:

(i) a priority claim, or

(ii) indications relating to an earlier search as provided in Rules 4.12(i) and 12*bis*.1(b)

and (d),

(iii) a reference to a parent application or parent patent,

(iv) an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) [No change]

4.2 to 4.19 *[No change]*

Rule 41

Taking into Account Results of Earlier Search and Classification

41.1 *[No change]*

41.2 *Taking into Account Results of Earlier Search and Classification in Other Cases*

(a) *[No change]*

(b) Where the receiving Office has transmitted to the International Searching Authority a copy of the results of any earlier search or of any earlier classification under Rule 23*bis*.2(a) or (c), or where such a copy is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, the International Searching Authority may take those results into account in carrying out the international search.

SCHEDULE OF FEES

Fees

Amounts

1. to 3. [No change]

Reductions

4. [No change]

5. The international filing fee under item 1 (where applicable, as reduced under item 4), the supplementary search handling fee under item 2 and the handling fee under item 3 are reduced by 90% if the international application is filed by:

- (a) [No change] an applicant who is a natural person and who is a national of and resides in a State that is listed as being a State whose per capita gross domestic product is below US\$ 25,000 (according to the most recent 10-year average per capita gross domestic product figures at constant 2005 US\$ values published by the United Nations), and whose nationals and residents who are natural persons have filed less than 10 international applications per year (per million population) or less than 50 international applications per year (in absolute numbers) according to the most recent five-year average yearly filing figures published by the International Bureau; or
- (b) [No change] an applicant, whether a natural person or not, who is a national of and resides in a State that is listed as being classified by the United Nations as a least developed country;

provided that, at the time of filing of the international application, there are no beneficial owners of the international application who would not satisfy the criteria in sub-item (a) or (b) and provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b). The lists of States referred to in sub-items (a) and (b)¹ shall be updated by the Director General at least every five years according to directives given by the Assembly. The criteria set out in sub-items (a) and (b) shall be reviewed by the Assembly at least every five years.

[Annex II follows]

¹ *Editor's Note:* The first lists of States were published in the Gazette of February 12, 2015, page 32 (see www.wipo.int/pct/en/official_notices/index.html).

DECISIONS RELATING TO THE ENTRY INTO FORCE OF THE AMENDMENTS IN ANNEX I

“The amendment of Rules 4.1(b)(ii) and 41.2(b) and of the Schedule of Fees shall enter into force on July 1, 2018, and shall apply to any international application the international filing date of which is on or after that date.”

UNDERSTANDING RELATING TO ITEM 5 OF THE SCHEDULE OF FEES

“It is the understanding of the PCT Assembly that the fee reduction in item 5 of the Schedule of Fees is intended to apply only in the case where the applicants indicated in the request are the sole and true owners of the application and under no obligation to assign, grant, convey or license the rights in the invention to another party which is not eligible for the fee reduction.”

[End of Annex II and of document]



PCT/A/50/5
ORIGINAL: ENGLISH
DATE: DECEMBER 7, 2018

International Patent Cooperation Union (PCT Union)

Assembly

**Fiftieth (29th Extraordinary) Session
Geneva, September 24 to October 2, 2018**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/58/1): 1, 2, 4, 5, 6, 11(ii), 12, 21, 29 and 30.
2. The reports on the said items, with the exception of item 21, are contained in the General Report (document A/58/11).
3. The report on item 21 is contained in the present document.
4. Mr. Sandris Laganovskis (Latvia), Chair of the PCT Assembly, presided over the meeting.

ITEM 21 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

Report on the PCT Working Group

5. Discussions were based on document PCT/A/50/1.

6. The Secretariat introduced the document, which set out a report of the eleventh session of the PCT Working Group. The session had a full agenda, with 29 agenda items and 25 working documents. This demonstrated the continued interest in the development of the PCT System as the central pillar of the international patent system to bring about further improvements for the benefit of Offices and users. A separate document (document PCT/A/50/2), setting out changes to the PCT Regulations approved by the Working Group, had been submitted to the Assembly for decision. The Working Group had also invited the International Bureau to prepare a document (document PCT/A/50/3) for consideration by the Assembly proposing to introduce an application form for appointment as an International Searching and Preliminary Examining Authority under the PCT. An overview of all items discussed during the session was provided in the Summary by the Chair attached to the document.

7. The Delegation of El Salvador, speaking on behalf of the Group of Latin America and Caribbean Countries (GRULAC), reiterated its support for the proposal by Brazil in document PCT/WG/11/18 on PCT fees to encourage patent applications by universities. The proposal was based on solid estimations carried out by the WIPO Economic and Statistics Division and supported by other documentation. As indicated in studies by the WIPO Chief Economist, universities of developing countries were seven times more sensitive to fee levels than other applicants. This implied that a fee reduction for these applicants was the most effective way to help them increase PCT filings. The revised proposal included language which took into account comments and observations made by delegations during the ninth and tenth sessions of the Working Group regarding the beneficiaries and financial impact of the proposed reduction. The changes that had been made broadened the beneficiaries to include universities in both developing and developed countries. In addition, the fee reductions were limited to a maximum number of applications for a university in a given year, with a different ceiling for universities in developing and developed countries. This therefore took into account concerns regarding the financial implications to WIPO of reducing fees. The implementation of a fee reduction would enable the use of a great reserve of talent and ability at universities and meet a real need to make better use of knowledge resources and encourage research into new products and services. GRULAC therefore urged the proposal to be given due consideration.

8. The Delegation of Brazil thanked the Delegation of El Salvador for the statement that it had made on behalf of GRULAC in support of Brazil's proposal on fee reductions for universities. The positive impact of universities on productivity growth in national economies was consolidated in academic literature. Studies had consistently found that the knowledge generated by universities enhanced the output of industry, with a strong and positive spillover effect on innovation across the economy. This had led to countries adopting numerous policies aimed at encouraging research and development efforts by universities. Yet the share of universities in the total number of PCT applications remained stubbornly low – 4.15 per cent in 2016. This indicated that universities still faced many challenges in the process of patent filings. Moreover, a study by the European Commission highlighted that patent costs were the main barrier to patenting for universities in the United States of America, the United Kingdom, Germany, France, Spain, Sweden, Poland, India, the Republic of Korea, Japan and China. If that was the case in these countries, it was even more so in countries with fewer resources. Based on such evidence and to complement policies adopted at domestic level, Brazil had tabled a proposal to facilitate access of universities to the PCT System. The proposal aimed at

making full use of PCT fees as a regulatory tool, positively influencing the filing behavior of universities, but without substantially affecting the cost recovery function of PCT fees. Consequently, the targeted fee reduction would generate a concrete effect in the form of a 7 per cent increase of PCT applications from universities, most notably from developing countries, advancing innovation and stimulating creativity, which were among the core goals of WIPO. It would positively influence the filing behavior of universities, without substantially affecting the flow of revenues. The fee reduction was also in line with several of WIPO's Strategic Goals, such as Strategic Goals II (Provision of Premier Global IP Services), III (Facilitating the Use of IP for Development), V (World Reference Source for IP Information and Analysis) and VII (Addressing IP in Relation to Global Policy Issues), as well as with the stated goal of WIPO of ensuring a more widespread use of the services provided by the Organization's global registration systems. In the eleventh session of the PCT Working Group, the proposal had received the support of 108 countries, representing more than two-thirds of all PCT Contracting States. There was therefore an urgent need to provide a response to the legitimate expectations of these countries which came from different world regions with differing levels of development. The Delegation understood that fee reductions for universities from developed countries could be discussed, again taking into account the estimations made by the WIPO Chief Economist on the financial impact to the Organization. The openness of all regional groups to discuss the proposal encouraged the Delegation to continue this discussion in the next session of the Working Group. The implementation of such a fee policy would enable the use of a large pool of scientific and technological talent in these universities, where there was a genuine need to tap this knowledge source and to create additional incentives for the production of innovative products and services. The proposed fee reduction would encourage the use of the PCT System and increase the diversity in the geographical composition of applications, thus generating additional demand in the medium term for PCT services. This was fully in line with WIPO's mission. Finally, the Delegation called on all Member States to support and approve discussion of the proposal. When implemented, taking into account input made by all Member States, the proposal would create a smart fee reduction for the benefit of the international community, thereby promoting the use of the patent system and taking a first concrete step on discussions related to PCT fee elasticity. The Delegation underlined that every Member State should be encouraged to share its own experiences and thoughts, and contribute to the discussions so that an inclusive proposal could be reached that reflected everyone's views to the extent possible.

9. The Delegation of Cuba expressed its support for the proposal by Brazil on fee reductions for universities.

10. The Delegation of the Democratic People's Republic of Korea referred to the agenda item discussed in the PCT Working Group titled "International Applications Linked to United Nations Security Council Sanctions" and reiterated its position in this regard. First, the Delegation stated that the Democratic People's Republic of Korea had consistently rejected United Nations Security Council resolutions on sanctions against the Democratic People's Republic of Korea as they had no legal grounds and no impartiality. Meanwhile, the Delegation stated that the international environment was now greatly improving in creating peace on the Korean peninsula, and that the voices to stop the brutal United Nations sanctions against the Democratic People's Republic of Korea were ever increasing among UN Member States. Second, the Delegation stated that patents were not themselves materials or services but instead were solely intended to protect the intellectual property of human beings. Therefore, the Delegation stated that delegations at the PCT Working Group meeting had emphasized that the recommendations of the Panel of Experts should not have a negative impact on the PCT System and the mandate of WIPO for an effective international IP system; it further noted that some delegations even raised concerns about going beyond the requirements of the UN sanctions. Proceeding from this perspective, the Delegation once again urged that UN sanctions should not be applied at WIPO in the field of IP protection, including patents, under

any circumstances, and that such an agenda item related to illegal and illogical recommendations should be removed from the agenda of the PCT Working Group.

11. The Delegation of Uganda expressed appreciation to the Director General of WIPO and the Secretariat for the robust performance of the PCT System. For the system to remain robust, continuous improvement needed to take place to correspond to new challenges and changing needs of users. At the same time, it should be conducive and inclusive to innovation and ensure accessibility to any interested user, especially those with limited financial resources. In line with this, the Delegation was particularly impressed with the ongoing discussions on fee reductions for certain applicants from certain countries, notably developing countries and least developed countries (LDCs). The Delegation strongly believed that a fee reduction for applicants from universities in Uganda, and in many developing countries and LDCs, could go a long way in increasing the use of this system. The reduction could also greatly contribute to university-driven innovation in Uganda. The Delegation believed that the fee reduction could be compensated by the increase in the number of applications. Regarding future developments of the PCT System, Uganda had been and would remain open to legal developments necessary to support the implementation of technical assistance-related recommendations of the PCT Roadmap and the WIPO Development Agenda to eliminate differences in search and examination. On a case by-case basis and in line with the Industrial Property Act 2014, patent examiners in Uganda were currently using search results from other Offices. The Uganda Registration Services Bureau was interested in receiving technical support on systems to assist national phase entry, and on PCT online services to strengthen its role as a receiving Office. The Delegation concluded by reiterating its commitment to the continuous development and utilization of the PCT system.

12. The Assembly of the PCT Union:

- (i) took note of the "Report on the PCT Working Group" (document PCT/A/50/1); and
- (ii) approved the convening of a session of the PCT Working Group, as set out in paragraph 8 of that document.

Proposed Amendments to the PCT Regulations

13. Discussions were based on document PCT/A/50/2.

14. The Secretariat introduced the document, which set out proposed amendments to Rule 69 of the PCT Regulations. The amendments had been discussed by the PCT Working Group, which had unanimously agreed to recommend that this Assembly should adopt the amendments as proposed. The proposed amendments, as set out in Annex I to the document, aimed to increase the time available for dialogue between the applicant and the examiner during international preliminary examination. The amendments would allow the International Preliminary Examining Authority to start the international preliminary examination as soon as it had received all the required documents and fees, without needing to wait until the time limit had expired for filing a demand for international preliminary examination.

15. The Delegation of Austria highlighted the specific role of Austria in the framework of the PCT through the long experience of the Austrian Patent Office as an International Searching and Preliminary Examining Authority under the PCT. Serving as an International Authority had proven to be beneficial both for applicants using the Austrian Patent Office as an International Searching Authority or International Preliminary Examining Authority, as well as for the Austrian Patent Office itself, where providing these services was an incentive to constantly improve the quality of patent search and examination. In its endeavor to serve the PCT community, the Austrian Patent Office was obliged to provide search and preliminary examination reports which

would usually decide the fate of a PCT application. While it was obvious that the different national patent rules and legal provisions provided the ultimate reason whether or not a patent application should become a granted patent, in most cases, the assessment of novelty and inventiveness of an application in practice proved to be of utmost importance. The Delegation thus had a special interest in the development of the PCT System and its constant development to serve the international community. Austria had been able to participate actively in the considerations and endeavors of the PCT Working Group. The Delegation welcomed and supported the proposed amendments to the PCT Regulations, as contained in document PCT/A/50/2, along with the recommendations concerning future work of the PCT Working Group in document PCT/A/50/1. Furthermore, as an International Searching and Preliminary Examining Authority under PCT, the Austrian Patent Office was especially satisfied with the Working Group's decision to entrust the International Bureau with the preparation of a proposal for consideration by the Assembly in relation to the introduction of an application form for the appointment of an Office or intergovernmental organization as an International Searching and Preliminary Examining Authority, as contained in document PCT/A/50/3. In summary, the Delegation looked forward to continuing its service as a reliable partner in the PCT System.

16. The Assembly of the PCT Union adopted the proposed amendments to the Regulations under the PCT set out in Annex I to document PCT/A/50/2, and the entry into force and transitional arrangements set out in paragraph 4 of the same document.

Application Form for Appointment as an International Searching and Preliminary Examining Authority under the PCT

17. Discussions were based on document PCT/A/50/3.

18. The Secretariat introduced the document, which set out a proposal to introduce an application form for an Office or intergovernmental organization to use when seeking appointment as an International Searching and Preliminary Examining Authority under the PCT. The draft application form, which was set out in the Annex to the document, had been used in an earlier version as the basis for the applications by the Turkish Patent and Trademark Office and the Intellectual Property Office of the Philippines for appointment by the Assembly as International Searching and Preliminary Examining Authorities. In addition, the form had also been used by many International Searching and Preliminary Examining Authorities in their applications for extension of appointment at the forty-ninth session of the Assembly in 2017. To introduce the draft application form into the procedure for appointment of an International Authority, the document proposed that the Assembly adopt a decision to modify paragraph (e) of the Understanding concerning procedures for appointment of International Authorities that was adopted by the Assembly at its forty-sixth session in 2015. In addition, the decision set out the procedure for modifying the application form in the future.

19. The Assembly of the PCT Union adopted the proposed decision set out in paragraph 10 of document PCT/A/50/3, relating to the introduction of an application form for appointment of an Office or intergovernmental organization as an International Searching and Preliminary Examining Authority under the PCT.

Amendment of the Agreement in Relation to the Functioning of the Canadian Commissioner of Patents as an International Searching and Preliminary Examining Authority under the PCT

20. Discussions were based on document PCT/A/50/4.

21. The Secretariat introduced the document by referring to the extension by the Assembly at its forty-ninth session in 2017 of the appointment of all International Searching and Preliminary Examining Authorities until the end of 2027. At that session, the Assembly had approved a new agreement in relation to the functioning of the Canadian Commissioner of Patents as an

International Searching and Preliminary Examining Authority. In addition, as it had not been possible for Canada to complete the relevant national processes for ratification of the new agreement, the Assembly had approved an extension of the existing agreement between the Canadian Commissioner of Patents and the International Bureau until the end of 2018, pending completion of the necessary procedures. During the ratification of the new agreement in Canada, it had become apparent that it might not be possible to complete the procedure for ratification of the new agreement by the end of 2018. In addition, in order to complete the ratification, the Government of Canada required amendment to certain procedural and formal matters in the agreement that had been approved by the Assembly. Consequently, the document invited the Assembly to approve a draft amendment to the existing agreement between the Canadian Commissioner of Patents and the International Bureau, as set out in Annex I of the document, to extend it for a further period of one year pending ratification of the new agreement. In addition, the document invited the Assembly to approve the proposed amendments to the new agreement that was approved by the Assembly in 2017, as set out in Annex II to the document.

22. The Assembly of the PCT Union:

- (i) approved the text of the draft amendment to the agreement in relation to the functioning of the Canadian Commissioner of Patents as an International Searching and Preliminary Examining Authority, as set out in Annex I to document PCT/A/50/4; and
- (ii) approved the proposed amendments to the agreement in relation to the functioning of the Canadian Commissioner of Patents as an International Searching and Preliminary Examining Authority, as set out in Annex II to the same document.

[End of document]



PCT/A/51/4
ORIGINAL: ENGLISH
DATE: DECEMBER 13, 2019

International Patent Cooperation Union (PCT Union)

Assembly

Fifty-First (22nd Ordinary) Session
Geneva, September 30 to October 9, 2019

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items from the Consolidated Agenda (document A/59/1): 1, 2, 3, 4, 5, 6, 8, 11(ii), 13, 14, 23, 32 and 33.
2. The reports on the said items, with the exception of item 23, are contained in the -General Report (document A/59/14).
3. The report on item 23 is contained in the present document.
4. Mr. Sandris Laganovskis (Latvia) was elected Chair of the Assembly; Mr. Abdulaziz Mohammed Alswailem (Saudi Arabia), Ms. Grace Issahaque (Ghana) (period 2019-2020) and Mr. Shen Changyu (China) (period 2020-2021) were elected Vice-Chairs.

ITEM 23 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

5. The Chair welcomed the accession of Samoa to the PCT Union following the deposit of its instrument of accession on October 2, 2019, bringing the number of PCT Contracting States to 153. The Chair also wished the Intellectual Property Office of the Philippines success in its operations as an International Searching and Preliminary Examining Authority that had started since the previous session of the Assembly in October 2018.

Report on the PCT Working Group

6. Discussions were based on document PCT/A/51/1.

7. The Secretariat introduced the document, which set out a report of the twelfth session of the PCT Working Group. The session had a full agenda, with 25 agenda items and 23 working documents. This demonstrated the continued interest in the development of the PCT System as the central pillar of the international patent system to bring about further improvements for the benefit of Offices and users. A separate document (document PCT/A/51/2), setting out changes to the PCT Regulations approved by the Working Group, had been submitted to the Assembly for decision. The Working Group had also considered the criteria for certain fee reductions that the Assembly was required to review periodically, and a separate document (document PCT/A/51/3) had been submitted to the Assembly for decision on this matter. The Summary by the Chair attached to the document provided an overview of all items discussed during the session.

8. The Delegation of Colombia stated its support for the convening of a PCT Working Group between the present session of the Assembly and that in autumn 2020, and for the same financial assistance that had been made available in previous sessions of the Working Group to be offered again to enable participation of more delegations. The Delegation also believed it to be appropriate to adopt the proposed modifications to the PCT concerning safeguards in the case of outages that might affect Offices, correction or addition of indications in the request under Rule 4.11, erroneously-filed elements and parts of an international application, and transfer of PCT fees. Finally, the Delegation expressed support for maintaining the criteria for establishing the lists of States whose nationals and residents were eligible for reductions of PCT fees. The Delegation added that the data presented to the PCT Working Group showed the importance of applying fee reductions to natural persons resident in those countries benefitting from such reductions, given the reduction in numbers of international applications from countries where these fee reductions had ceased to apply.

9. The Delegation of the Russian Federation noted the document, which reflected questions concerning the functioning of the PCT System, and expressed appreciation for the activities of the International Bureau on PCT-related issues. In particular, the Delegation noted the online services provided to applicants and Offices. The Federal Service for Intellectual Property (ROSPATENT), which acted as a receiving Office, an International Searching Authority and an International Preliminary Examining Authority, used WIPO and PCT online services, for example, in the exchange of documents between Offices. The Delegation noted that the number of Russian applicants using ePCT was increasing. It further supported the projects to ensure effective use of the PCT System in the international phase and for setting up services for the translation of documents used in the national phase and hoped that this work would be continued. The Delegation expressed gratitude to the International Bureau for its constructive work towards seeking a compromise decision for introducing reductions of PCT fees for universities and research and scientific institutions in developing and least developed countries (LDCs), and hoped that this proposal could gain the support needed to be adopted.

Finally, the Delegation stated that it had no objection to the amendments to the Regulations proposed for adoption at the session.

10. The Assembly of the PCT Union:

- (i) took note of the "Report on the PCT Working Group" (document PCT/A/51/1); and
- (ii) approved the convening of a session of the PCT Working Group, as set out in paragraph 4 of that document.

Proposed Amendments to the PCT Regulations

11. Discussions were based on document PCT/A/51/2.

12. The Secretariat introduced the document, which set out proposed amendments to the PCT Regulations. The PCT Working Group had discussed these amendments and had unanimously agreed to recommend that this Assembly should adopt the amendments as proposed. The amendments fell into five groups. Annex I of the document set out provisions concerning safeguards in case of outages affecting Offices, based on a proposal originally submitted by the European Patent Office to allow Offices to simplify the process of excusing failures to meet certain time limits due to outages of electronic systems. Annex II set out provisions concerning correction or addition of indications in the request under Rule 4.11, based on a proposal originally submitted by the United States of America to allow correction of errors or omissions in indications of the type of protection to be sought in the national phase. Annex III set out provisions concerning erroneously-filed elements and parts of the international application. These amendments were aimed at aligning the practices of receiving Offices and designated or elected Offices in the special case where an applicant had erroneously filed a wrong element or part of the international application. In addition, paragraph 7 of the document set out two proposed Understandings by the Assembly aimed at further improving the consistency of application by Offices of the Regulations as amended. Annex IV set out provisions concerning the transfer of PCT Fees. These were enabling provisions, allowing for Administrative Instructions to be made, setting out consistent procedures on transferring fees from one Office to another *via* the International Bureau. This would formalize the "netting pilot" that many Offices had been participating in and had welcomed. The Secretariat emphasized that these Rules would assist Offices that wished to use the new arrangement, but did not provide new obligations on Offices that faced legal or administrative barriers to adopting that approach. Annex V set out provisions concerning availability of the file held by the International Preliminary Examining Authority, based on a proposal originally submitted by Singapore to allow greater transparency by permitting more documents related to the international preliminary examination procedure to be made available to the public. The document proposed that all of the proposed amendments to the Regulations should enter into force on July 1, 2020, and be subject to transitional provisions set out in paragraph 6 of the document, aimed at providing the desired effects as soon as practical, while minimizing the administrative burdens for national Offices.

13. The Representative of the International Federation of Intellectual Property Attorneys (FICPI) stated that FICPI believed that applicants should be permitted to correct very formal and obvious mistakes without losing substantive rights. In this regard, FICPI supported the objectives of the Patent Law Treaty (PLT) and welcomed the introduction of PLT-type provisions into the PCT. Clearly, those provisions that had been added to the PCT had been intended to serve the same purpose as the PLT, namely to make the patent system more user-friendly while preserving a proper balance between the interests of the various stakeholders. For FICPI, this extended to the substitution of erroneously-filed elements or parts thereof with the correct element or part as contained wholly in one or more priority applications, provided that the

requirements of Rule 20 were met, with certain safeguards, as indicated by FICPI at the workshop organized by the International Bureau in June 2018. The Representative expressed concern that the proposed amendments to the PCT Regulations that the PCT Working Group had recommended to be submitted to be considered at this session of the Assembly would not achieve the intended purpose of aligning practices with respect to the incorporation by reference of elements or parts to be found in a priority application. Instead, the proposals would introduce further uncertainty and divergence of practices within Offices. The increased use of ePCT increased the risk for incorrect documents to be uploaded from a computer. Accordingly, there was a need for a remedial provision. Of particular concern was the situation where the incorrect element was a different kind of document, for example, a set of claims instead of a description, or was clearly related to a different invention, possibly for a different client. In such circumstances, there would still be uncertainty as to whether the “element” of the subject application was missing or erroneously filed, even with the proposed rule changes. In the business world, if such a document had been inadvertently sent to a party, it would be either returned by that party without keeping a copy, or all copies would be destroyed by the party. FICPI believed that it was appropriate for the International Bureau or a receiving Office to take similar action and therefore did not support a process that would result in retaining such an incorrect document in WIPO’s database. In the view of FICPI, neither publishing the document marked “erroneously filed” as proposed, nor retaining the document unpublished in the WIPO file following a request under Rule 48.2(I), served the interests of any stakeholders. Therefore, FICPI believed it was appropriate for the International Bureau and the PCT Working Group to resolve this problem by introducing additional or alternative rule changes into the PCT Regulations to achieve a better alignment between the various PCT authorities with respect to the incorporation by reference of elements or parts to be found in a priority application. The incorrect document should be totally removed from the application, possibly by introducing a new Rule to cover such removal.

14. The Secretariat, in response to the comments by Representative of FICPI, stated that the International Bureau believed that the Rules proposed for adoption were a step forward for applicants in mitigating the problems caused by mistakes in the filing process. The Secretariat acknowledged that the proposals did not go as far as FICPI might have liked. However, it appeared clear in discussions during the PCT Working Group that Member States had not been willing to see any matter removed entirely from the file without also changing the international filing date to reflect the timing of the relevant change. Consequently, the Secretariat continued to recommend that the amendments be adopted as proposed. The Secretariat nevertheless encouraged user groups to continue to discuss their concerns about this type of issue with their respective national and regional Offices. If Member States considered that there was a realistic opportunity for further improving these safeguard provisions in the future, the International Bureau would be pleased to introduce further proposals to the PCT Working Group. In the meantime, the International Bureau would make clear in the PCT Applicant’s Guide the means by which errors in filing could best be mitigated, but also emphasized the importance of taking the utmost care to select the correct documents when filing an international application as some mistakes could not be corrected.

15. The Representative of Knowledge Ecology International (KEI) suggested considering different areas where more information within the PCT System could be made available in patent databases, even if this was on a voluntary basis. For example, information about licenses connected to a patent, information on prior art searches in the various jurisdictions where the patent application had been filed, or the international nonproprietary name for medical treatments related to the patent could be more visible to the public.

16. The Secretariat, in response to the comments by the Representative of KEI, pointed out that some of the information referred to was already made publicly available from WIPO databases. The Secretariat expressed willingness to discuss with KEI or other stakeholders how applicants and the general public could be made more aware of the options available to

provide or access such information, as well as how to improve those options in future, whether administratively, or by bringing new proposals to the PCT Working Group to improve the Regulations further in a way that would make the PCT System more useful for all stakeholders.

17. The Assembly of the PCT Union:

(i) adopted the proposed amendments to the Regulations under the PCT set out in Annexes I to V to document PCT/A/51/2, and the entry into force and transitional arrangements set out in paragraph 6 of the same document; and

(ii) adopted the Understanding set out in paragraph 7 of document PCT/A/51/2.

Review of the Criteria for PCT Fee Reductions for Applicants from Certain Countries

18. Discussions were based on document PCT/A/51/3.

19. The Secretariat introduced the document by explaining that at its forty-sixth session back in 2014, the Assembly had adopted amendments to the Schedule of Fees concerning the criteria for determining eligibility for reductions in certain PCT fees. The Schedule of Fees so amended required the Assembly to review the criteria at least every five years. The document provided information concerning the criteria for determining eligibility for fee reductions under item 5 of the Schedule of Fees, the number of applications benefiting from those fee reductions and the number of applications made by different classes of applicant before and after the changes to the lists of eligible States came into effect from July 1, 2015. The PCT Working Group had discussed the information shown in the document and had unanimously recommended to the Assembly to maintain the criteria in their current form and to review them again in five years' time. The document invited the Assembly to review the criteria and follow the recommendation by the Working Group.

20. The Assembly of the PCT Union:

(i) decided, having reviewed the criteria set out in item 5 of the PCT Schedule of Fees, that those criteria be maintained; and

(ii) decided that those criteria be reviewed again by the Assembly in five years' time, as required by that Schedule.

[End of document]

WO/CF/41/1 P/EC/60/1 B/A/50/1 B/EC/66/1 N/A/40/1 LI/A/37/1 LO/A/40/1 IPC/A/41/1 PCT/A/52/1 BP/A/37/1
VA/A/33/1 WCT/A/20/1 WPPT/A/20/1 PLT/A/19/1 STLT/A/13/1

ORIGINAL: ENGLISH

DATE: DECEMBER 15, 2020

WIPO Conference – Forty-First (17th Extraordinary) Session

**International Union for the Protection of Industrial Property (Paris Union) –
Executive Committee – Sixtieth (56th Ordinary) Session**

**International Union for the Protection of Literary and Artistic Works (Berne Union)
– Assembly – Fiftieth (26th Extraordinary) Session**

**International Union for the Protection of Literary and Artistic Works (Berne Union)
– Executive Committee – Sixty-Sixth (51st Ordinary) Session**

**Special Union for the International Classification of Goods and Services for the
Purposes of the Registration of Marks (Nice Union) – Assembly – Fortieth
(16th Extraordinary) Session**

**Special Union for the Protection of Appellations of Origin and their International
Registration (Lisbon Union) – Assembly – Thirty-Seventh (14th Extraordinary)
Session**

**Special Union for the International Classification for Industrial Designs (Locarno
Union) – Assembly – Fortieth (17th Extraordinary) Session**

**Special Union for the International Patent Classification (IPC Union) – Assembly –
Forty-First (19th Extraordinary) Session**

**International Patent Cooperation Union (PCT Union) – Assembly – Fifty-Second
(30th Extraordinary) Session**

**Union for the International Recognition of the Deposit of Microorganisms for the
Purposes of Patent Procedure (Budapest Union) – Assembly – Thirty-Seventh
(17th Extraordinary) Session**

**Special Union for the International Classification of the Figurative Elements of
Marks (Vienna Union) – Assembly – Thirty-Third (15th Extraordinary) Session**

**WIPO Copyright Treaty (WCT) – Assembly – Twentieth (11th Extraordinary)
Session**

**WIPO Performances and Phonograms Treaty (WPPT) – Assembly – Twentieth
(11th Extraordinary) Session**

Patent Law Treaty (PLT) – Assembly – Nineteenth (11th Extraordinary) Session

**Singapore Treaty on the Law of Trademarks Assembly (STLT) –Thirteenth
(7th Extraordinary) Session**

Geneva, September 21 to 25, 2020

REPORTS

adopted by the respective Bodies

1. Each of the above-mentioned bodies met in the sessions indicated for the purpose of considering the following items of the Consolidated Agenda of the Sixty-First Series of Meetings of the Assemblies of WIPO (document A/61/1): 1, 2, 4, 5, 6, 8, 10(ii), 11, 21 and 22. Furthermore, the Paris and Berne Executive Committees also considered item 3.
2. The reports on the said agenda items are consolidated in the General Report of the Assemblies (document A/61/10).

[End of document]

International Patent Cooperation Union (PCT Union)

Assembly

Fifty-Third (23rd Ordinary) Session
Geneva, October 4 to 8, 2021

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/62/1): 1 to 6, 10(ii), 11, 12, 21, 32 and 33.
2. The reports on the said items, with the exception of item 21, are contained in the General Report (document A/62/13).
3. The report on item 21 is contained in the present document.
4. Ms. María Loreto Bresky (Chile) was elected Chair of the Assembly;
Ms. Florence Galtier (France) and Mr. GAN Shaoning (China) were elected Vice-Chairs.

ITEM 21 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

Appointment of the Eurasian Patent Office (EAPO) as an International Searching and Preliminary Examining Authority under the PCT

5. Discussions were based on document PCT/A/53/1.

6. The Secretariat introduced the document by explaining that the Committee for Technical Cooperation had met in October 2020 to consider an application for appointment of the Eurasian Patent Office (EAPO) as an International Searching and Preliminary Examining Authority under the PCT. The Committee had reviewed the application and unanimously agreed to recommend the appointment to the Assembly. Following the advice of the Committee, Article 16(3)(b) and Article 32(3) required the Assembly to hear the Representative of the EAPO, and then to decide on the appointment and approve the text of a draft agreement between the Eurasian Patent Organization and the International Bureau, as set out in the Annex to the document. With regard to the agreement, the proposed draft followed the same form as the agreements in place with the existing International Authorities. The agreement would remain in force until December 31, 2027, in line with the review and renewal of the other existing agreements.

7. The Representative of the EAPO explained that the application for appointment of the EAPO as an International Searching and Preliminary Examination Authority under the PCT was the result of more than 26 years of work. The possibility of EAPO to apply for the status as an International Searching and Preliminary Examining Authority was stipulated in Article 20 of the Eurasian Patent Convention (EAPC) of September 9, 1994, which was drafted together with WIPO, including the personal involvement of the then Director General, Dr. Arpad Bogsch. The States party to the EAPC, at the creation of the EAPO, had set the objective of such participation in the PCT System. At the thirty-fifth meeting of the Eurasian Patent Organization Administrative Council, held on September 10 and 11, 2019, these States unanimously voted to allow the EAPO to apply for the status of an International Searching and Preliminary Examining Authority. The Eurasian Patent Organization represented an economically-developing region with over 200 million people and an economically-active population of more than 100 million people. The Global Innovation Index consistently noted the advantages of the countries of the Eurasian region in the field of human capital. The Eurasian region had scientific schools with a rich history and traditionally strong positions in education. In general, there were about 2,500 organizations in the region engaged in scientific research, half of which were higher educational institutions (with about 2,000 universities in the region), bringing together a faculty of more than 350,000 people. Given that the EAPC Member States had more than 62 million people under the age of 25, the region had strong potential in the development of human resources that was far from fully realized. All the EAPC Member States were committed to development as reflected in the state programs and plans for the development of national economies adopted in the countries of the region. This approach was already yielding practical results. For example, in most EAPC Member States, there was a high level of development and use of information and telecommunication technologies. If appointed as an International Searching and Preliminary Examining Authority, innovators in the Eurasian region would be able to use the EAPO at all stages of the PCT from filing the international application, international search and preliminary examination, and in the regional phase. As a designated Office, an applicant would be able to rely on previous interaction with the EAPO using the same communication channels and information resources, and be able to communicate with experts using their national language. The appointment of the EAPO as an International Searching Authority and an International Preliminary Examination Authority would expand and improve the efficiency of the use of the PCT System by inventors and companies from the countries of the region. This, in turn, was one of the important prerequisites for the development of science-intensive

technologies and high-tech and innovative sectors of the economies of the Eurasian region. In terms of the technical aspects of the appointment, the Representative noted that the Committee for Technical Cooperation, at its thirty-first session from October 5 to 8, 2020, had made a positive recommendation to the Assembly. Moreover, the COVID-19 pandemic had not resulted in a negative impact on the activities of EAPO and its readiness to perform the functions of an International Authority. EAPO had well-developed electronic systems that ensured full electronic interaction with applicants, the possibility of remote working for any employee and a paperless patent procedure. EAPO received more than 90 per cent of its applications electronically, and this figure continued to grow. In addition, EAPO had extensive experience in using the electronic services provided by the International Bureau, being the first Office in the region to use the ePCT system and the WIPO Digital Access Service (DAS) for the retrieval of priority documents. The EAPO was now ready to begin work as an International Searching Authority and International Preliminary Examining Authority as soon as possible at the beginning of 2022. The Representative concluded by thanking the China National Intellectual Property Administration (CNIPA) and the Federal Service for Intellectual Property (ROSPATENT) for their advice and assistance with the application to ensure that the EAPO was compliant with all the requirements to become an International Searching and Preliminary Examining Authority. The Representative also thanked the 14 States whose national IP Offices had given written support for the application, namely, Kazakhstan, Colombia, the Russian Federation, Azerbaijan, China, the Czech Republic, Armenia, Chile, the Republic of Moldova, Belarus, Canada, Brazil, Egypt and Mexico. Finally, the Representative acknowledged the assistance and advice from the Secretariat and the trust and confidence that the PCT membership would place in the EAPO performing the duties of an International Searching and Preliminary Examining Authority.

8. The Delegation of the Russian Federation aligned itself with the statement made by the Delegation of Belarus on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC) under item 5 of the Consolidated Agenda (document A/62/1) expressing support for the appointment of the EAPO as an International Searching and Preliminary Examining Authority under the PCT (see paragraph 5 of document A/62/13). The appointment would serve the interests of applicants and the countries in the Eurasian region and promote greater use of the PCT System. The Delegation stated that expanding the functions of the EAPO within the PCT System would create additional advantages for applicants because EAPO would be able to carry out all the stages in examination of an international application. The EAPO met all the requirements for appointment set out in the PCT Regulations, having a sufficient number of highly qualified patent examiners, the required technical and information infrastructure and an effective quality management system.

9. The Delegation of Spain underlined the important and valuable contribution of all Member States in developing the international intellectual property registration systems. In line with this, the Spanish Patent and Trademark Office (OEPM) had been working collaboratively over many years to develop and improve the patent system in general with its representatives taking an active role in the WIPO decision-making bodies within the PCT System. The OEPM participated in the WIPO Fee Transfer Service as both a receiving Office and as an International Searching Authority to reduce the risks related to foreign currency exchange rates. Furthermore, the Office had actively participated as part of the Delegation of Spain at the PCT Working Group, notably working closely with the European Patent Office, and the Delegations of France, Switzerland and the United Kingdom towards the amendment of Rule 82*quater*. This was important as it helped to strengthen the safeguards for applicants and third parties when there were general disruptions, as had been the case of COVID-19, which stood in the way of meeting time limits set out in the PCT Regulations. The Delegation also supported the amendments to Rules 12, 13*ter*, 19, and 49 required for the implementation in the PCT of WIPO Standard ST.26 for the presentation of nucleotide and amino acid sequence listings using XML. The Delegation supported the appointment of the EAPO as an International Searching and Preliminary Examining Authority in accordance with the unanimous recommendation of the

thirty-first session of the Committee for Technical Cooperation, since the Office met the technical requirements set out in Rule 36. The Federal Service for Intellectual Property of the Russian Federation as well as the China National International Property Administration had reported on this matter favorably. The appointment would benefit the PCT System in the Eurasian region making it easier for applicants from the region to file international applications and give them further incentive to use the PCT System. The Delegation indicated that it opposed the continuation of the supplementary international search system because the costs were not justified and the OEPM did not have the information it needed to provide to its users. Use of the service had been low and the Delegation therefore supported the decision of the Working Group to review the system no later than 2027.

10. The Delegation of Japan supported the appointment of the EAPO as an International Searching and Preliminary Examining Authority under the PCT. The Delegation welcomed the EAPO's contribution to enhancing the PCT System, which was an important instrument for all innovators seeking patent protection internationally. The appointment of the EAPO would bring benefits to the large number of applicants from the region by increasing their options of International Searching and Preliminary Examining Authorities. The Delegation hoped that the EAPO would play an important role in the future development of the PCT System.

11. The Delegation of China supported the appointment of the EAPO as an International Searching and Preliminary Examining Authority under the PCT. This would further promote the development and use of the PCT System.

12. The Delegation of the United States of America supported the appointment of the EAPO as an International Searching and Preliminary Examining Authority under the PCT and approval of the agreement between the EAPO and the International Bureau contained in the Annex to document PCT/A/53/1. The Delegation also supported the adoption of the proposed decision set forth in paragraph 7 of document PCT/A/53/2, whereby the International Bureau would continue to monitor and report to the Meeting of International Authorities and the PCT Working Group on significant developments relating to the supplementary international search system, and would review the system again as recommended by the International Bureau or by a Contracting State, no later than 2027. Finally, the Delegation supported the adoption of the proposed amendments to the PCT Regulations set out in Annexes I to III of document PCT/A/53/3 and the entry into force and transitional arrangements set forth in that document.

13. The Delegation of the Republic of Korea supported the appointment of the EAPO as an International Searching Authority and an International Preliminary Examining Authority. The Korean Intellectual Property Office and the EAPO had been closely cooperating in the field of PCT, in particular, through a Memorandum of Understanding on bilateral cooperation and a Memorandum of Understanding on the Patent Prosecution Highway signed on September 25, 2018. The Delegation believed that the appointment of the EAPO as an International Searching and Preliminary Examining Authority would make the PCT System more convenient for users, and the Republic of Korea wished to take the opportunity of the appointment to strengthen its cooperation with the EAPO in the area of the PCT.

14. The Representative of the Intellectual Property Latin American School (ELAPI) stated that ELAPI intended to collaborate in the development of new strategies to accelerate discussions on "Patents and Health". In this work, there was a need to consider both the perspective of the protection and the diffusion of new relevant technologies, and the urgent need to be able to face global emergencies like the COVID-19 pandemic and probably others in the future, with the sole objective of recognizing the importance of condensing many months or years of research into a single document. This would allow the patent applicant who has developed the technology to benefit from their efforts, and likewise enable other researchers and developers where the patent was not protected to use the knowledge in the patent to develop technology around the invention or even disruptive technologies based on the advances to date in the specific field of

the invention. ELAPI believed that regulation would always be better than any prohibition. ELAPI hoped to use its experience in Latin America, particularly as it relates to PCT applications at the National Institute of Industrial Property of Chile, as well as global experience during the COVID-19 pandemic, to contribute to improving the system of protecting technology through patents by incorporating tools that connect, enable and facilitate the transfer of technology in a cross-cutting way. This started from the early diffusion of new technologies towards allowing licenses to ensure that technologies developed for human health could finally fulfil their intended objectives, both for those developing the technology and those benefiting from it internationally. Incentivizing the incorporation of IP protection mechanisms in scientific research such as patents for inventions was key to the agile development of new technologies which otherwise could remain secret for more than 10 years, as could have been the case with vaccine technologies based on viral mRNA. ELAPI offered its academic support to the Assembly, Committees and Member States, especially the Group of Latin American and Caribbean Countries (GRULAC), in order to help strengthen the patent system, as an axis and vehicle for global technological development.

15. The Assembly of the PCT Union, in accordance with Articles 16(3) and 32(3) of the PCT:

- (i) approved the text of the draft Agreement between the Eurasian Patent Organization and the International Bureau set out in the Annex to document PCT/A/53/1; and
- (ii) appointed the Eurasian Patent Office as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2027.

16. The Director General of WIPO, Mr. Daren Tang, congratulated the EAPO on its appointment as an International Searching Authority and International Preliminary Examining Authority under the PCT on behalf of the International Bureau. The EAPO and the International Bureau had a long history of fruitful cooperation, with the EAPO operating as a receiving Office and as a designated and elected Office since its establishment more than 25 years ago. The International Bureau looked forward to strengthening cooperation with the EAPO in its new role as an International Searching and Preliminary Examining Authority.

17. The Delegation of Saudi Arabia congratulated the EAPO on its appointment as an International Searching and Preliminary Examining Authority.

18. The Representative of the EAPO thanked the delegations for their trust and confidence in approving the appointment of EAPO as an International Searching and Preliminary Examining Authority. The Representative stated that the EAPO would endeavor to justify this new responsibility. EAPO would work with the International Bureau and other Offices and organizations as an International Authority, with the aim of strengthening intellectual property and the way it supported innovation in the Eurasian region and worldwide.

Review of the Supplementary International Search System

19. Discussions were based on document PCT/A/53/2.

20. The Secretariat explained that the document represented a third review by the Assembly of the supplementary international search system, which began operation in 2009. The thirteenth session of the PCT Working Group had considered this matter and details of these considerations were in documents PCT/WG/13/4 Rev. and PCT/WG/13/14. The system had never been widely used and had certain costs to maintain. Some delegations had wished to end supplementary international search. Other delegations had considered that it remained beneficial to some applicants and should be maintained pending further developments, such as

the outcome of the collaborative search and examination pilot or the making available of further options within the supplementary international search system. In the absence of consensus on the substance of a way forward, the Working Group had agreed with the proposal of the Chair of the Working Group to recommend that the International Bureau should continue to monitor the system and report on significant developments. Furthermore, the Working Group had recommended that the Assembly should review the system again at a time to be recommended by the International Bureau, or on request by a PCT Contracting State, but no later than 2027. The Secretariat observed that 2027 had been chosen to allow time for the PCT Working Group to receive a final report from the collaborative search and examination pilot. The Working Group could then consider whether an arrangement based on that experience might form a useful part of the PCT System, addressing aspects of the issues that the supplementary international search had aimed to cover.

21. The Representative of the Health and Environment Program (HEP) supported the proposal and commended the progress of WIPO towards achieving gender parity, as seen by both Ms. Bresky as Chair and Ms. Jorgenson as Deputy Director General on the podium, which set a good example to other organizations, showing that women in high places could do an excellent job.

22. The Assembly of the PCT Union:

- (i) noted the review of the supplementary international search system (document PCT/A/53/2); and
- (ii) adopted the proposed decision set out in paragraph 7 of that document.

Proposed Amendments to the PCT Regulations

23. Discussions were based on document PCT/A/53/3.

24. The Secretariat introduced the document, which presented two sets of proposed amendments to the PCT Regulations. The amendments proposed in Annex I related to the move from WIPO Standard ST.25 to WIPO Standard ST.26 for the presentation of sequence listings in applications containing disclosure of nucleotides and amino acids. The amendments proposed in Annex II provided for strengthening safeguards for applicants and third parties in the case of general disruption that affected their ability to meet time limits in the international phase of PCT processing. The PCT Working Group had reviewed and approved both sets of proposals. The proposed entry into force of the amendments was set out in paragraph 5 of the document. Since the General Assembly had approved the proposal in document WO/GA/54/14 to set the implementation date for WIPO Standard ST.26 as July 1, 2022, both sets of amendments would come into force on that date. The amendments relating to WIPO Standard ST.26 would apply to international applications filed on or after that date. The amendments relating to safeguards would apply to time limits that expired on or after that date.

25. The Assembly of the PCT Union adopted the proposed amendments to the Regulations under the PCT set out in Annexes I and II of document PCT/A/53/3, and the entry into force and transitional arrangements set out in paragraph 5 of the same document, noting that the date decided by the WIPO General Assembly relating to the entry into force of the amendments in Annex I of the document was July 1, 2022.

[End of document]

**WO/CF/43/1 P/A/58/1 P/EC/62/1 B/A/52/1 B/EC/68/1 N/A/42/1 LO/A/42/1 IPC/A/43/1 PCT/A/54/1 VA/A/35/1
WCT/A/22/1 WPPT/A/22/1 PLT/A/21/1 STLT/A/15/1 MVT/A/7/1 BTAP/A/3/1
ORIGINAL: ENGLISH
DATE: SEPTEMBER 30, 2022**

WIPO Conference – Forty-Third (18th Extraordinary) Session

International Union for the Protection of Industrial Property (Paris Union) – Assembly – Fifty-Eighth (33rd Extraordinary) Session

International Union for the Protection of Industrial Property (Paris Union) – Executive Committee – Sixty-Second (58th Ordinary) Session

International Union for the Protection of Literary and Artistic Works (Berne Union) – Assembly – Fifty-Second (27th Extraordinary) Session

International Union for the Protection of Literary and Artistic Works (Berne Union) – Executive Committee – Sixty-Eighth (53rd Ordinary) Session

Special Union for the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Union) – Assembly – Forty-Second (17th Extraordinary) Session

Special Union for the International Classification for Industrial Designs (Locarno Union) – Assembly – Forty-Second (18th Extraordinary) Session

Special Union for the International Patent Classification (IPC Union) – Assembly – Forty-Third (20th Extraordinary) Session

International Patent Cooperation Union (PCT Union) – Assembly – Fifty-Fourth (31st Extraordinary) Session

Special Union for the International Classification of the Figurative Elements of Marks (Vienna Union) – Assembly – Thirty-Fifth (16th Extraordinary) Session

WIPO Copyright Treaty (WCT) – Assembly – Twenty-Second (12th Extraordinary) Session

WIPO Performances and Phonograms Treaty (WPPT) – Assembly – Twenty-Second (12th Extraordinary) Session

Patent Law Treaty (PLT) – Assembly – Twenty-First (12th Extraordinary) Session

Singapore Treaty on the Law of Trademarks (STLT) – Assembly – Fifteenth (8th Extraordinary) Session

Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled (Marrakesh Treaty) – Assembly – Seventh (7th Ordinary) Session

Beijing Treaty on Audiovisual Performances (BTAP) – Assembly – Third (3rd Ordinary) Session

Geneva, July 14 to 22, 2022

REPORTS

adopted by the respective Bodies

1. Each of the above-mentioned bodies met in the sessions indicated for the purpose of considering the following items of the Consolidated Agenda of the Sixty-Third Series of Meetings of the Assemblies of WIPO (document A/63/1): 1, 2, 3, 4, 6, 8, 10(ii), 11, 19, 20 and 21. Furthermore, the Paris and Berne Executive Committees also considered item 5.
2. The reports on the said agenda items are consolidated in the General Report of the Assemblies (document A/63/10).

[End of document]

International Patent Cooperation Union (PCT Union)

Assembly

Fifty-Fifth (24th Ordinary) Session
Geneva, July 6 to 14, 2023

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items from the Consolidated Agenda (document A/64/1): 1 to 6, 9, 10(ii), 12, 14, 21, 26 and 27.
2. The reports on the said items, with the exception of item 14, are contained in the General Report (document A/64/14).
3. The report on item 14 is contained in the present document.
4. Ms. María Loreto Bresky (Chile) presided over the meeting. Mr. Abdulaziz Algabbaa (Saudi Arabia) was elected Chair of the Assembly; Mr. Shen Changyu (China) and Mr. Konstantinos Georgaras (Canada) were elected Vice-Chairs.

ITEM 14 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

5. The Chair welcomed all delegations to the Assembly, particularly the States that had recently acceded to the Patent Cooperation Treaty (PCT), namely, Jamaica in 2021, and Iraq, Cabo Verde, and Mauritius in 2022, bringing the number of Contracting States to 157.

Appointment of the Saudi Authority for Intellectual Property (SAIP) as an International Searching and Preliminary Examining Authority under the PCT

6. Discussions were based on document [PCT/A/55/1](#).

7. Introducing the document, the Secretariat explained that the Committee for Technical Cooperation met in October 2022 to consider an application for appointment of the Saudi Authority for Intellectual Property (SAIP) as an International Searching and Preliminary Examining Authority under the PCT. The Committee had reviewed the application and unanimously agreed to recommend the appointment to the Assembly. Following the advice of the Committee, Article 16(3)(b) and Article 32(3) of the Treaty required the Assembly first to hear the representative of SAIP, and then to decide on the appointment of the Office and to approve the text of the draft agreement between the Saudi Authority for Intellectual Property and the International Bureau set out in the Annex to document PCT/A/55/1. With regard to the agreement, the proposed draft followed the same form as those in place with the existing International Authorities, and would remain in force until December 31, 2027, in line with the review and renewal of the other agreements.

8. The Delegation of the Saudi Arabia explained that the Kingdom of Saudi Arabia, under the directives of its wise leadership, had drawn a roadmap towards comprehensive and integrated national development through the Kingdom's "Vision 2030". The Vision had been cascaded into strategic goals, most notably supporting and diversifying the economy, creating an attractive competitive environment, and promoting and supporting a culture of innovation and entrepreneurship. As a result, SAIP had been established as the authority concerned with regulating all areas of intellectual property (IP) in the Kingdom and supporting, developing, protecting, enforcing and upgrading them in accordance with international best practices. During the past year, His Highness the Prime Minister had announced the National Strategy for Intellectual Property. The Kingdom was also working on developing laws and regulations related to intellectual property rights (IPRs), in addition to working on registering rights and granting them protection, providing information related to IP and making it available to the public, and playing an effective role in raising awareness of IP. Interest in IP in Saudi Arabia began 82 years ago. The first IP system was introduced in 1939, and Saudi Arabia joined WIPO in 1982. Work then began on enacting laws and regulations for the various fields of IP protection. Saudi Arabia acceded to the Paris Convention and the Berne Convention in 2003, and to the World Trade Organization (WTO) in 2005 and is currently party to 13 treaties administered by WIPO. Saudi Arabia acceded to the PCT in 2013 and received its first international application as a receiving Office in early 2015. SAIP was also considered one of the first IP Offices to use the ePCT system for processing international applications. Preparations for the appointment of SAIP as an International Searching and Preliminary Examining Authority occurred through many important stages in order to meet the minimum requirements. The first criterion was to find highly-qualified employees with sufficient technical qualifications to carry out search and examination where SAIP had put in place appropriate recruitment and training plans, enabling SAIP to have more than 100 qualified examiners producing work in accordance with the required standards in line with international treaties and agreements. The examiners were distributed across five areas of expertise according to their technical files based on the International Patent Classification and had the appropriate language skills and required experience, with an average of 12.9 years across all examiners. All

examiners had access to the most important global databases, enabling them to perform their tasks to the required timeliness and quality in accordance with the standards stipulated in the Regulations under the PCT. SAIP regularly reviewed the used databases to ensure their suitability and efficiency, and considered the importance and appropriateness of new sources. SAIP also enjoyed the existence of a systematic and integrated quality management system that monitored all procedures and ensured their performance was in accordance with the highest standards. SAIP was also committed to continuous improvement in the quality of its work, periodically issuing operational quality reports. The quality management system at SAIP complied with the requirements of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines, and SAIP attained ISO 9001 certification for its operational processes in the past year. The continual growth in the number of patent applications in the region and in the world, including applications filed in the Arabic language, increased the importance of having more International Searching and Preliminary Examining Authorities working in Arabic to increase cooperation and strengthen the role of the PCT. As an International Searching and Preliminary Examining Authority, SAIP hoped that it would have an influential and prominent role in promoting the PCT and the various services that it provided to beneficiaries. The Delegation thanked the Korean Intellectual Property Office (KIPO) for its support over the past year to ensure that SAIP fulfilled all the minimum requirements for appointment. KIPO had reviewed the criteria with accuracy and transparency, making recommendations that would contribute to raising the quality of operational work, and advising on prominent features, including operational quality systems, current technical systems and risk management. SAIP was proud to be recognized by one of the largest IP Offices. The Delegation also extended its thanks to all States that expressed their support for the appointment of SAIP at the thirty-second session of the PCT Committee for Technical Cooperation Committee in October 2022. In conclusion, the Delegation looked forward to the formal appointment of SAIP as an International Searching and Preliminary Examining Authority, and gave assurance that the Authority was fully prepared to carry out its operational tasks in international search and preliminary examination. The appointment would contribute to the promotion of the PCT by meeting the rapid growth in patent applications in the region and the world, increasing the number of applications in the Arabic language, and developing investment in technology in Saudi Arabia and at a regional level.

9. The Delegation of the Republic of Korea stated that KIPO had assessed the capacity of SAIP to be appointed as an International Searching and Preliminary Examining Authority through an onsite visit and online discussions. The Delegation recognized that SAIP satisfied all the minimum requirements for appointment and therefore supported its appointment as an International Searching and Preliminary Examining Authority under the PCT. The Delegation was confident that the appointment would strengthen the PCT System, taking into account Saudi Arabia's research and development capability, global economic standing, and its vision to become a regional IP hub by 2030. The Delegation stated that the Republic of Korea remained committed to cooperating with Member States to develop the PCT System further and welcomed the contribution of SAIP to this endeavor.

10. The Delegation of China recalled the advice of the PCT Committee for Technical Cooperation that SAIP had met all of the requirements for appointment as an International Searching and Preliminary Examining Authority under the PCT. The Delegation supported the approval of the appointment and wished SAIP success in its future work.

11. The Delegation of the Russian Federation supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT, and added that the appointment of SAIP would expand opportunities, particularly for Arab users, by enhancing the quality of expertise and search.

12. The Delegation of Japan supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT and welcomed any efforts from

SAIP to enhance the PCT System. Since signing a Memorandum of Cooperation with SAIP in 2019, the Japan Patent Office (JPO) had established an annual work plan based on the Memorandum, with cooperation taking place in areas such as data exchange and human resources development. As with previous collaborations, the Delegation expressed willingness to share the knowledge of JPO in order to help SAIP grow as an International Searching and Preliminary Examining Authority in the future. Finally, the Delegation stated that it expected that SAIP would play an important role in the development of the PCT System.

13. The Delegation of Tunisia expressed support for the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT.

14. The Delegation of Qatar supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT and wished SAIP all the success in its new function.

15. The Delegation of Iraq supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT. The appointment would help promote the patent system in the region and SAIP could count on the assistance of Iraq's national IP authority.

16. The Delegation of Iran (Islamic Republic of) congratulated SAIP on meeting the criteria for appointment as an International Searching and Preliminary Examining Authority under the PCT and wished SAIP all the success in its future work.

17. The Delegation of Kuwait supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT, which would have positive impact on the region in the short term.

18. The Delegation of Libya supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT and wished SAIP much success.

19. The Delegation of Mauritania supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT and expressed confidence in SAIP carrying out this important role.

20. The Delegation of Egypt supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT and wished their counterparts in Saudi Arabia all the success in their work.

21. The Delegation of Algeria supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT and wished SAIP every success.

22. The Delegation of Syrian Arab Republic supported the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT and wished SAIP much success.

23. The Assembly of the PCT Union, in accordance with Articles 16(3) and 32(3) of the PCT:

(i) approved the text of the draft Agreement between the Saudi Authority for Intellectual Property and the International Bureau set out in the Annex to document PCT/A/55/1; and

(ii) appointed the Saudi Authority for Intellectual Property as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2027.

24. The Secretariat congratulated SAIP on its appointment as an International Searching Authority and International Preliminary Examining Authority under the PCT. Saudi Arabia had joined the Paris Union less than 20 years ago, had become a PCT Contracting State in 2013, and a further 10 years on from joining the PCT, it had reached a new milestone in offering international search and preliminary examination. The Secretariat wished SAIP well in the start of a new journey and looked forward to strengthened cooperation between the International Bureau and SAIP in the years ahead.

25. The Delegation of Saudi Arabia thanked all delegations for supporting the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT and the technical committees at WIPO that had assisted SAIP during the evaluation process to reach this result. This was one of the objectives that SAIP had wished to achieve, and the Delegation promised more services to be provided by SAIP and to become one of the most distinguished bodies in its work.

26. The Representative of the Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent Office) congratulated the Delegation of Saudi Arabia on the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT. The achievement of SAIP as the first IP Office of a GCC State to be appointed as an International Searching and Preliminary Examining Authority reflected the comprehensive development of IP in Saudi Arabia and the other countries of the GCC. Including the Arabic language as one of the accepted languages at SAIP in its Agreement with the International Bureau of WIPO would provide additional value for Arabic speakers during their use of the PCT, and would strengthen the knowledge base in the Arabic language in the various fields of technology. The GCC Patent Office wished SAIP every success in its new function.

Proposed Amendments to the PCT Regulations

27. Discussions were based on document [PCT/A/55/2](#).

28. The Secretariat introduced the document, which presented two sets of proposed amendments to the PCT Regulations and an amendment to the French text of Rule 82*quater*.3. The proposed entry into force of each of these amendments was set out in paragraph 7 of the document. The amendments proposed in Annex I of the document provided for a procedure where an international application contained parts in different languages and all such languages were accepted by the competent receiving Office. The amendments proposed in Annex II of the document set out a revised definition of the minimum documentation that an International Searching Authority was required to consult during international search, along with changes to the minimum requirements that an International Searching Authority and an International Preliminary Examining Authority needed to satisfy before it could be appointed and had that it would need to continue to satisfy during its appointment. With regard to the amendments in Annex II, paragraph 8 of the document proposed that the Assembly adopt an Understanding with regard to interpretation of one of the minimum requirements in the case of an intergovernmental organization (IGO) established to represent a collaboration between national Offices but did not itself issue patents or publish patent applications. Both sets of proposals in the Annexes and the Understanding had been reviewed and approved by the PCT Working Group. Finally, the proposal to amend the French text of Rule 82*quater*.3(c) in paragraph 6 of the document intended to resolve an inconsistency between the English and French texts of this Rule as adopted by this Assembly in 2021, so the French text would correspond with the intended effect of this Rule.

29. The Delegation of the Russian Federation welcomed the proposals for expansion of the languages used in the PCT System and wished to see further promotion of multilingualism under the PCT. Specifically, the Delegation welcomed the initiative by the International Bureau in the PCT Working Group to expand the number of languages used for communication with the

International Bureau by applicants and national Offices towards using all 10 PCT languages of publication, one of which was Russian. This initiative was in line with the policy of promoting multilingualism at WIPO and the revised linguistic program of the Organization, which was covered by a number of documents including the Medium-Term Strategic Plan (MTSP) 2022-2026. The Delegation considered that this initiative would enhance the quality of services and the convenience of using the PCT System, increasing the number of languages for applicants and Offices. It would also help ensure that applicants had access to PCT services. The Delegation considered that the expansion of the number of languages would have a positive impact on the PCT System as a whole, enhancing its convenience and attractiveness for users. The Russian Federation, together with the Eurasian Patent Office, were continuing work on the translation of templates and improving machine translation tools for the PCT. The Delegation hoped that there would be constructive dialogue at the next session of the PCT Working Group on languages of communication to be able to achieve compromise on this matter.

30. The Representative of the Eurasian Patent Organization (EAPO) congratulated and welcomed the appointment of SAIP as an International Searching and Preliminary Examining Authority under the PCT, and wished it success with its new status. The Representative was thankful that applicants, particularly Arabic speakers, had additional choice in terms of selecting an International Searching Authority and that the use of languages in the PCT System had been expanded. The Representative also stated that EAPO supported the proposed amendments in the document updating the definition of the PCT minimum documentation. EAPO believed that it was important that the International Bureau should act as a single coordinator for the availability of patent data, and the creation of a centralized repository for such data would be the simplest and most effective solution to meet this goal. The Representative also thanked the International Bureau for the proposal discussed in the PCT Working Group to expand the number of languages for correspondence with applicants and national Offices. The proposal to communicate in any of the 10 PCT publication languages in international applications, including the Russian language, was in line with the linguistic policies of WIPO to promote multilingualism. The Representative considered that it was important to facilitate communication with Russian-speaking users, because the Russian language was widely used by the Contracting States of the Eurasian Patent Convention and was the official language of EAPO. The Representative reiterated the readiness of the Eurasian Patent Office to work with the International Bureau regarding translations into Russian.

31. The Representative of Intellectual Property Latin American School (ELAPI) supported the proposed amendments, particularly regarding the language criteria, because that would enable more efficient search and examination of the applications without unnecessary translations or corrections that increase the cost of national phase processing. The Representative also supported the amendments concerning the provision of information by patent Offices. This should improve not only the information available for examiners, but should also feed into the WIPO public database. This would help to democratize and disseminate information coming from the PCT System on a daily basis, allowing scientists, academics, innovators and students to learn of the development of new technologies. ELAPI was fully ready to support any PCT Contracting State and the Assembly with its expertise.

32. The Assembly of the PCT Union:

- (i) adopted the proposed amendments to the Regulations under the PCT set out in Annexes I and II and paragraph 6 of document PCT/A/55/2, and the entry into force and transitional arrangements set out in paragraph 7 of the same document; and
- (ii) adopted the Understanding set out in paragraph 8 of document PCT/A/55/2.

Amendment of the Agreement concerning the Functioning of the Ukrainian Intellectual Property Institute as an International Searching Authority and International Preliminary Examining Authority under the PCT

33. Discussions were based on document [PCT/A/55/3](#).

34. The Secretariat introduced the document, which proposed amendments to the Agreement between the Ministry of Economic Development and Trade of Ukraine and the International Bureau concerning the Functioning of the Ukrainian Intellectual Property Institute as an International Searching and Preliminary Examining Authority under the PCT. With effect from November 8, 2022, the State Organization “Ukrainian National Office for Intellectual Property and Innovations” had taken over responsibility from the “Ukrainian Intellectual Property Institute” for patent processing, including its roles as receiving Office, International Searching Authority and International Preliminary Examining Authority, while retaining the examiners, search facilities, IT systems and other expertise of the Ukrainian Intellectual Property Institute. The document proposed to amend the Agreement to reflect the current names of the Ministry, now the “Ministry of Economy of Ukraine”, and of the Office, respectively.

35. The Delegation of Switzerland, speaking on behalf of Group B, supported the proposed amendments to the Agreement between the Ministry of Economic Development and Trade of Ukraine and the International Bureau as set out in the Annex to the document. The Assembly had approved this Agreement in 2017 and Group B agreed with the proposed updates.

36. The Delegation of Poland, speaking on behalf of the Group of Central European and Baltic States (CEBS), supported the proposed amendments. The CEBS Group perceived the proposed amendments as being of a technical and formal nature, reflecting changes made in the Ukrainian IP regulatory institutional architecture. The document reflected no changes with regard to the existing Agreement concerning all technical and formal criteria required to function as an International Searching and Preliminary Examining Authority. The CEBS Group therefore saw no basis for the Assembly to object to the approval of the amendments. The Delegation reiterated the need to finalize this procedural matter, which was important for compliance of Member States with the existing legal and procedural order within the PCT Union.

37. The Assembly of the PCT Union:

- (i) noted the contents of document PCT/A/55/3; and
- (ii) approved the amendments to the agreement between the Ministry of Economic Development and Trade of Ukraine and the International Bureau as set out in the Annex to document PCT/A/55/3.

38. The Delegation of Ukraine thanked the Delegations of Switzerland and Poland for the supportive statements made on behalf of Group B and the CEBS Group, respectively. The Delegation appreciated their support and thanked all delegations for the decision, which was important for the Ukrainian government and national IP institution.

[End of document]

International Patent Cooperation Union (PCT Union)

Assembly

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

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document [A/65/1](#)): 1, 2, 3, 4, 6, 8(ii), 9, 11, 18, 21 and 22.
2. The reports on the said items, with the exception of item 11, are contained in the General Report (document [A/65/11](#)).
3. The report on item 11 is contained in the present document.
4. Mr. Abdulaziz Algabbaa (Saudi Arabia), Chair of the PCT Union Assembly, presided over the meeting.

ITEM 11 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

Review of Criteria for PCT Fee Reductions for Applicants from Certain Countries and Modification of Directives for Updating the Lists of States Meeting the Criteria

5. Discussions were based on document [PCT/A/56/1](#).
6. The Secretariat introduced the document by recalling that, at its forty-sixth session in 2014, the Assembly adopted amendments to the PCT Schedule of Fees concerning the criteria for determining eligibility for certain fee reductions. The Schedule of Fees required the Assembly to review the criteria at least every five years. As the Assembly had last performed this review in 2019, it was therefore required to review the eligibility criteria for fee reductions in 2024. In preparation for the review, the PCT Working Group, at its seventeenth session in February 2024, had reviewed the criteria set out in item 5 of the Schedule of Fees. The Working Group had recommended to the Assembly to maintain the criteria and review them again in five years' time. The document invited the Assembly to follow that recommendation. The document also proposed modifications to the Directives for establishing the lists of the States whose nationals and residents were eligible for fee reductions. When the lists were updated, the Directives required the Director General to make draft lists available before the session of the Assembly, inviting comments before the close of the Assembly. For the update that year, the draft lists had been made available by Circular C. PCT 1670, issued on June 25, 2024. When the previous update to the lists of States took place, the WIPO Assemblies had met in September/October and the Directives referred to the Assembly taking place in those months. As the WIPO Assemblies meetings currently took place in July, the Annex to the document proposed modifications to the Directives to take that into account. The proposals referred to the annual series of meetings of the Assemblies of the Member States of WIPO instead of a specific time during the year, and therefore would allow for any changes to the timing that might happen in the future.
7. The Delegation of the Russian Federation stated that the criteria set out in item 5 of the PCT Schedule of Fees were appropriate and effective, and agreed for the criteria to be reviewed in five years' time, as required by the Schedule.
8. The Delegation of Greece was pleased to note that the PCT System remained robust, contributing to the positive financial results of WIPO. The Delegation underlined that the PCT System should continue to provide incentives to ensure easy access to any interested user, especially those with limited financial resources. Maintaining the established criteria for fee reductions was therefore of paramount importance to secure early access to the PCT System. The Delegation supported maintaining the criteria and their review in five years' time and concluded by reiterating its commitment to work towards development of the PCT System.
9. The Delegation of France supported maintaining the criteria in item 5 of the PCT Schedule of Fees and performing a review of the criteria in five years' time.
10. The Delegation of China expressed its appreciation to the International Bureau for its work regarding PCT fee reductions and highlighted that the policy was instrumental to encourage innovators to use the PCT System to protect the results of their innovation. The Delegation also encouraged the International Bureau to continue to improve and optimize the PCT System by offering more convenience to applicants.
11. The Delegation of the Bahamas recalled its statement at the opening of the Assemblies, reporting that over the past year, the regulatory framework governing intellectual property (IP) in the Bahamas had been undergoing significant reform and enhancement. The Delegation

thanked the International Bureau for the technical support in capacity building, aiding review and reform of its local legislation and other areas to renew and refine the mandate of the Bahamas Registry with respect to IP. With this support, the Bahamas had tabled new patent legislation in its parliament, which would pave the way for the country to accede to the PCT in the coming months. The Delegation was pleased to note that, following the most recent review of the Schedule of Fees annexed to the PCT Regulations, applicants from the Bahamas would qualify for the reduced rate fees for international applications. This was largely due to a reduction in Gross Domestic Product (GDP) in recent years as a result of the impact of the COVID-19 pandemic on the Bahamian economy. The Delegation took great interest in the methodology and framework used to determine countries eligible for the reduced international application filing fee, which was primarily based on the old, outdated framework of assessing a country's GDP per capita. As a Small Island Developing State (SIDS), the Bahamas like many others, was acutely vulnerable to climate and other shocks on a perpetual basis. It was only necessary to look at the recent news headlines with the impact of hurricane Beryl on fellow Caribbean countries and to see the devastating impact of hurricane Dorian on the Bahamas in 2019 to understand the need to go beyond the sole consideration of the GDP per capita as metric for determining vulnerability, and hence the need for support in various aspects such as fee reductions. The Delegation stated that the issue of going beyond the sole consideration of the GDP per capita for determining vulnerability had also been recognized by the United Nations (UN) General Assembly no later than that week, where the latter Assembly had supported the adoption of Multidimensional Vulnerability Index as a means of assessing the well-being of SIDS. The Delegation encouraged WIPO to consider a similar approach in its PCT fee reduction framework as part of the next five-year review, which would ensure a more robust framework of analysis and aid in providing more equitable benefits in the fee reduction mechanism, such that institutions that required support were more likely to receive it.

12. The Representative of the Intellectual Property Latin American School (ELAPI) expressed its firm support for any action that enabled inventors and applicants to have greater access to protection offered by the PCT at the national and international levels. As a means of incentivizing new technologies, the PCT System needed to continue to take into account inventors with insufficient financial resources to invest adequately to access systems for the protection of their rights. The Representative further noted that it was essential to provide assistance that promoted the dissemination and protection of innovative technologies. In its view, continuing the reductions of the international filing fee, the supplementary search handling fee and the handling fee for nationals and residents of beneficiary countries was important because, according to UN data, it encouraged inventive activity in less developed countries. That, in turn, allowed innovators responsible for future solutions and stakeholders working to improve the quality of life in those societies to overcome any obstacles they may face. In that regard, the Representative underscored that ELAPI agreed that the established criteria for assessing fee reductions should be maintained, and that the proposed modifications to the Directives for Updating the Lists of States Meeting the Criteria for Reduction of Certain PCT Fees should be adopted, which would continue to encourage inventive activity as a driver for development in those countries. Finally, the Representative encouraged the submission of documents in electronic format, which had significant advantages over physical documents, providing immediate access to documents and contributing to a more sustainable future.

13. The Assembly of the PCT Union:

- (i) decided, having reviewed the criteria set out in item 5 of the PCT Schedule of Fees, that those criteria be maintained and reviewed again by the Assembly in five years' time, as required by that Schedule; and
- (ii) adopted the proposed modifications to the Directives for Updating the Lists of States Meeting the Criteria for Reduction of Certain PCT Fees set out in the Annex of document PCT/A/56/1.

Proposed Amendments to the PCT Regulations

14. Discussions were based on document [PCT/A/56/2](#).

15. The Secretariat introduced the document, which presented four sets of proposed amendments to the PCT Regulations. The amendments proposed in Annex I would allow an Office to require international applications and subsequently-filed documents to be submitted in electronic form only, or to require that any document submitted on paper be resubmitted in electronic form within two months. The proposals explicitly excluded the International Bureau from that possibility. Applicants would therefore continue to be able to use the International Bureau to file on paper if their national or regional Office decided to require submissions in electronic form only. The amendments proposed in Annex II would allow the International Bureau to correspond with applicants or Offices in any of the 10 languages of international publication, instead of only in English or French. That would apply to certain communications to be set out in future Administrative Instructions. By expanding the languages of correspondence for communications that were limited to the applicant or an Office, the International Bureau aimed to improve the services it offered to users of the PCT. At the same time, where a wider group of Offices received correspondence, the International Bureau intended to continue using English and French. The amendments proposed in Annex III concerned international applications where the abstract or text matter of the drawings was in a different language from the language of the description and claims. The proposals would enable a receiving Office to request the applicant to furnish a translation of the abstract or text matter of the drawings into the publication language in more situations to ensure that the international application would be published in a single language. The amendments proposed in Annex IV broadened the definition of prior art for international search and preliminary examination to include non-written disclosures. This would make the PCT System more like national patent systems in the treatment of non-written disclosures. Paragraph 4 of the document proposed that the provisions should enter into force on July 1, 2025, except for the amendments relating to the definition of prior art for international search and preliminary examination, which were proposed to enter into force on January 1, 2026, at the same time as the amendments to the definition of the minimum documentation to consult during international search that were adopted by the Assembly in 2023.

16. The Delegation of India welcomed all the proposed amendments to the PCT Regulations in the document. The amendments to Rules 33 and 64 incorporated non-written disclosures into the definition of prior art for the purposes of international search and preliminary examination. The acknowledgement of non-written disclosures presented a significant advancement in the protection of traditional knowledge (TK), recognizing transmission by oral tradition across generations, strengthening the TK system against undue appropriation. As a result, it would ensure that patents were not conferred on innovations that were already in the public domain through oral disclosure. The Delegation also welcomed the proposed amendments mandating international applications and subsequent submissions to be exclusively in electronic format or requiring paper submissions to be resubmitted electronically within two months, which would offer streamlined document processing, environmental sustainability, global standardization, and expedited processing times. The Delegation also expressed its appreciation for the proposal to narrow the exceptions regarding the requirement of the receiving Office to request a translation of the abstract and text matter of the drawings when provided in a different language, thereby ensuring the international application was published in a single language. Finally, the Delegation indicated that the proposed amendments to Rules 89*bis* and 92 would be beneficial for the IP system, and it looked forward to participating in future discussions.

17. The Delegation of Spain thanked the International Bureau and PCT Contracting States for the work undertaken in the PCT Working Group to develop the PCT System to make it more accessible and user-friendly to applicants. In the Delegation's view, the proposed amendments

would improve communication between applicants, receiving Offices and the International Bureau by expanding the possibility to communicate in any of the 10 languages of publication. The Delegation likewise underlined the interest of the PCT Working Group to update the PCT System to new technologies and realities, while reinforcing legal certainty. In this sense, one of the proposed amendments provided for the expansion of the definition of relevant prior art to include non-written disclosures, taking into account the increasing forms of disclosure. The Delegation further expressed appreciation to the commitment of the International Bureau to continuing to advance as many proposals as possible that resulted in improvement of the PCT System to the benefit of users.

18. The Delegation of Brazil conveyed its appreciation to the International Bureau for the excuse of delay in meeting time limits in the PCT that had been granted upon request of the National Institute of Industrial Property (INPI), Brazil, in light of the tragic floods that affected people in the Brazilian state of Rio Grande do Sul. The Delegation of Brazil supported the proposed amendments in the document and thanked PCT Contracting States for their support for the proposal that Brazil had submitted to amend Rule 89*bis* regarding the filing medium of international applications, which sought to optimize the digitization of requests during the international phase while maintaining flexibility to allow Offices to tailor their processes according to their own context and national legislation.

19. The Delegation of the Russian Federation thanked the Secretariat for preparing the document containing proposed amendments to the PCT Regulations. The Delegation appreciated the initiative to increase the number of languages used for communication by the International Bureau with applicants and national IP Offices to all 10 languages of international publication, including Russian. The Delegation highlighted that this initiative corresponded to promoting multilingualism and to the updated linguistic policy of WIPO, also included in the Medium-Term Strategic Plan (MTSP) 2022-2026. The Delegation expressed its confidence that the adoption of that amendment would improve the quality of services and the convenience of the PCT System by expanding the languages of correspondence for applicants and Offices, ensuring the rights of applicants and facilitating their easy access to PCT services. The increase in the number of languages would have a positive effect on the PCT System in general and would improve its convenience and attractiveness to users. The Russian Federation continued to offer language support to the International Bureau and had provided a translation of the PCT forms into Russian. In addition, the Delegation appreciated the proposed amendments to Rule 89*bis*.¹ relating to the filing methods of international applications and corresponding documents. These amendments took into consideration the interests of all receiving Offices and would provide them with more flexibility to determine the appropriate filing method for applications. The Delegation hoped to see a further expansion of languages of correspondence in other aspects of the PCT System, as well as the use of that experience by other international registration systems administered by WIPO. The Delegation also counted on continuation of the constructive dialogue, exchange of views and practices to improve the PCT System. Finally, the Delegation stated that it was deeply concerned about the destructive actions of the European Union regarding the registration and protection of patent rights of applicants and rights holders from the Russian Federation. The Delegation condemned these actions as contrary to international IP law and in violation of the provisions regarding national treatment provided for in Article 2 of the Paris Convention. The Delegation reiterated that, in its view, such actions were unacceptable, impermissible, and unworthy of WIPO Member States.

20. The Delegation of China supported the proposed amendments to the PCT Regulations set out in the document, including the expansion of languages of correspondence for the International Bureau. The proposed amendments were conducive to improving efficiency of the international filing process and provided many conveniences to users. The Delegation also encouraged other registration systems to learn from the good experience and practices in the PCT System.

21. The Delegation of Greece stated that, despite the slight decline in PCT filings in 2023, the PCT System remained robust, which could be attributed to the commitment of staff of the International Bureau. The Delegation observed that PCT online services increased the functionality of the system for applicants and IP Offices. To remain robust, the PCT System needed to continuously improve to correspond to the changing needs of users. The proposed amendments to Rules 26, 33, 64, 89*bis* and 92 would facilitate the processing of applications and the use of the system to the benefit of users. The Delegation therefore endorsed the proposed amendments in the document and their proposed entry into force.

22. The Delegation of Iran (Islamic Republic of) expressed its appreciation for the document. The proposed amendments to Rule 89*bis* allowing Offices to require electronic submission of applications and subsequent documents were a significant step in reducing administrative bureaucracy and expediting the patent granting process. The Delegation further stated that, by reducing administrative burden, expediting the patent granting process and making the PCT System more accessible, those changes held the promise of fostering innovation and efficiency in the global IP landscape. Accordingly, and considering that patent applications were already received electronically under its domestic law, the Delegation supported those amendments. The Delegation also expressed support for the amendments to Rules 33 and 64 to extend the definition of relevant prior art to include non-written disclosures. Under national law in Iran (Islamic Republic of), the definition of prior art included everything made available to the public anywhere in the world by any means. In the view of the Delegation, the changes aimed to enhance the quality of patents, ensure a fairer assessment of innovations, and foster a more dynamic and inclusive innovation ecosystem. The Delegation believed that, while the proposed amendments might come with challenges, these could be overcome, and the broad benefits of the amendments could be realized through the development of new methods, proper training and enhanced international cooperation.

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

[End of document]



**WO/CF/46/1 P/A/61/1 P/EC/65/1 B/A/55/1 B/EC/71/1 N/A/45/1 LO/A/45/1 IPC/A/46/1 PCT/A/57/1 BP/A/42/1
VA/A/38/1 WCT/A/25/1 WPPT/A/25/1 PLT/A/24/1 MVT/A/10/1 BTAP/A/6/1
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WIPO Conference – Forty-Sixth (27th Ordinary) Session

International Union for the Protection of Industrial Property (Paris Union) – Assembly – Sixty-First (27th Ordinary) Session

International Union for the Protection of Industrial Property (Paris Union) – Executive Committee – Sixty-Fifth (61st Ordinary) Session

International Union for the Protection of Literary and Artistic Works (Berne Union) – Assembly – Fifty-Fifth (27th Ordinary) Session

International Union for the Protection of Literary and Artistic Works (Berne Union) – Executive Committee – Seventy-First (56th Ordinary) Session

Special Union for the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Union) – Assembly – Forty-Fifth (27th Ordinary) Session

Special Union for the International Classification for Industrial Designs (Locarno Union) – Assembly – Forty-Fifth (26th Ordinary) Session

Special Union for the International Patent Classification (IPC Union) – Assembly – Forty-Sixth (25th Ordinary) Session

International Patent Cooperation Union (PCT Union) – Assembly – Fifty-Seventh (25th Ordinary) Session

Union for the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (Budapest Union) – Assembly – Forty-second (23rd Ordinary) Session

Special Union for the International Classification of the Figurative Elements of Marks (Vienna Union) – Assembly – Thirty-Eighth (23rd Ordinary) Session

WIPO Copyright Treaty (WCT) – Assembly – Twenty-Fifth (12th Ordinary) Session

WIPO Performances and Phonograms Treaty (WPPT) – Assembly – Twenty-Fifth (12th Ordinary) Session

Patent Law Treaty (PLT) – Assembly – Twenty-Fourth (11th Ordinary) Session

Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled (Marrakesh Treaty) – Assembly – Tenth (10th Ordinary) Session

Beijing Treaty on Audiovisual Performances (BTAP) – Assembly – Sixth (6th Ordinary) Session

Geneva, July 8 to 17, 2025

REPORTS

adopted by the respective Bodies

1. Each of the above-mentioned bodies met in the sessions indicated for the purpose of considering the following items of the Consolidated Agenda of the Sixty-Sixth Series of Meetings of the Assemblies of WIPO (document [A/66/1](#)): 1 to 7, 10(ii), 11, 20, 23 and 24. Furthermore, the WIPO Conference and the Paris and Berne Union Assemblies also considered item 8.
2. The reports on the said agenda items are consolidated in the General Report of the Assemblies (document A/66/11).

[End of document]