



Treaty Series No. 20 (1993)

Amendments

to the Regulations under the Patent Co-operation
Treaty done at Washington on 19 June 1970
adopted by the Assembly of the International
Patent Co-operation Union (PCT Union)
on 29 September 1992

[In continuation of Treaty Series No. 61 (1992), Cm 2042]

*Presented to Parliament
by the Secretary of State for Foreign and Commonwealth Affairs
by Command of Her Majesty
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**AMENDMENTS
TO THE REGULATIONS UNDER THE PATENT CO-OPERATION TREATY (PCT)¹**

Adopted by the Assembly of the International Patent Co-operation Union (PCT Union)
at its twentieth session (twelfth extraordinary) on 29 September 1992

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¹ Treaty Series No. 78 (1978), Cmnd 7340.

* With effect on the date on which China becomes bound by the PCT.

** With effect on 1 October 1992.

*** With effect on 1 January 1993.

AMENDMENTS

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

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 Property¹. 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 the 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.

¹ Commercial No. 28 (1884), C. 4083.

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 paragraph (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.

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]

