



Treaty Series No. 40 (1994)

## 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 1993

[In continuation of Treaty Series No. 20 (1993) Cm 2179]

*Presented to Parliament  
by the Secretary of State for Foreign and Commonwealth Affairs  
by Command of Her Majesty  
August 1994*

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AMENDMENTS TO THE REGULATIONS UNDER THE  
PATENT CO-OPERATION TREATY (PCT)<sup>1</sup>

Adopted by the Assembly of the International Patent Co-operation Union (PCT  
Union) at its twenty-first session (ninth ordinary) on September 29, 1993

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<sup>1</sup> Treaty Series No. 78 (1978) Cmnd. 7340

## Amendments<sup>1</sup>

### 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]

### 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.

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<sup>1</sup> The following reproduces the text as amended of each Rule that was amended. Where a paragraph or item of any such Rule has not been amended, the indication "[No change]" appears.

18.2 [Deleted]

18.3 and 18.4 [No change]

## 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), 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.

## 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).

#### 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]

#### 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]

## RULE 83

### Right to Practice Before International Authorities

83.1 [No change]

83.1bis *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]

## 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]

## 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:

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- (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]

