

PCT Applicant's Guide

Volume I: Introduction to the International Phase

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CHAPTER I

THIS PUBLICATION, ITS ANNEXES AND OTHER DOCUMENTS ON THE PCT

INTRODUCTION

1. The paper version of the *Guide* consists of two loose-leaf volumes. Volume I contains general information on the Patent Cooperation Treaty (PCT) intended for those interested in filing international patent applications, in particular information on the “international phase” of the PCT procedure. The text of Volume I (which is published in two binders as Volume I/A and B) is supplemented by a number of Annexes containing more detailed information; whenever the word “Annex” followed by a capital letter is used in this publication, it is a reference to an Annex to Volume I. Volume II (which is published in four binders as Volume II/A, B, C and D) contains general information on the “national phase” of the PCT procedure, namely the procedure before the designated (or elected) Offices. A designated (or elected) Office is the national or regional Patent Office of or acting for a State party to the PCT (a “Contracting State”) that is designated (or elected) in an international application. Volume II also indicates the requirements to be complied with before each of these Offices. The *Guide* is also available via the Internet on the PCT website at <http://www.wipo.int/pct/en/>. The Internet version is updated more frequently than the paper version. Users of the paper publication of the *Guide*, who wish to ensure that they have the very latest available information, should compare the date printed at the foot of any individual page in their paper publication with the same date on the Internet version of that page. Each page in the *Guide* is dated in this way.
2. In the text of the *Guide*, “Article” refers to Articles of the PCT, “Rule” refers to the PCT Regulations and “Section” refers to the PCT Administrative Instructions. References to a “paragraph” relate to the text of the relevant Volume of the *Guide*.
3. Although the information contained in this publication is fairly comprehensive, it should be borne in mind that it condenses and interprets rules that are contained in longer, official texts, particularly the PCT itself

and the Regulations under the PCT, and it is those texts which apply in the case of any inconsistency with this *Guide*. Consultation of those texts is indispensable for complete information.

4. Since the text of the PCT and PCT Regulations is sometimes fairly complex, and since the drafting and prosecution of patent applications is itself a complex matter, prospective applicants, unless they are specialists in patent law themselves, are strongly advised to obtain professional advice from patent attorneys or patent agents, and to use the services of such attorneys or agents.

5. Replacement sheets for both Volumes I and II are published from time to time (normally in January and July of each year). Subscribers to this *Guide* automatically receive the replacement sheets published during the year of subscription and receive each year an invoice for their subscription to the updating service for the following year. Readers should make sure that they have the latest replacement sheets, which they can do by consulting the cumulative page tabulation accompanying each set of updated sheets. In case of doubt, inquiries may be addressed to the “International Bureau” (that is, the Secretariat) of WIPO. For the address, see Annex B2 (IB).

6. Up-to-date versions of the PCT and Regulations may be browsed or downloaded from the PCT website at <http://www.wipo.int/pct/en/texts/index.htm>. Internet versions of the PCT, and where available the Regulations, are also on the PCT website in the following languages:

- Arabic at <http://www.wipo.int/ar/pct/index.html>
- French at <http://www.OMPI.int/pct/fr/texts/index.htm>
- German at <http://www.wipo.int/pct/de/documents.htm>
- Russian at <http://www.wipo.int/pct/ru/index.html>
- Spanish at <http://www.OMPI.int/pct/es/texts/index.htm>

Printed brochures of the PCT and Regulations, in the above languages, plus Italian and Portuguese, may be ordered as WIPO publication number 274 from the International Bureau at the address given in Annex B2 (IB), or by e-mail from publications.mail@wipo.int or from the electronic bookshop at <http://www.wipo.int/ebookshop>. Publication orders should also indicate the language of the required publication. Chinese and Japanese versions are available from the Offices in China and Japan. For regular users of the PCT, consulting the *PCT Gazette*, which publishes details of international

applications and various indexes relating thereto, is recommended. Section IV of the *PCT Gazette* contains notices and information of a general character. Accession of new Contracting States, changes in fees and other requirements are promptly published in that Section. The *PCT Gazette* is available as a printed publication and also in a variety of searchable electronic formats from <http://www.wipo.int/pct/en/gazette/gazette.htm>. PCT users wishing to subscribe to the printed version may do so by contacting the International Bureau at the address given in Annex B2(IB), or by e-mail at publications.mail@wipo.int or from the electronic bookshop at <http://www.wipo.int/ebookshop>. For special issues of the *PCT Gazette* (see paragraph 9), which are published in separate English and French versions, publication orders should indicate the required language.

7. Up-to-date news about the PCT is available from the *PCT Newsletter*, a monthly publication (in English only). It includes certain information published in the *PCT Gazette* and advance notice of important changes to the *Guide*. The *PCT Newsletter* also contains subject matter not included in those publications; it is intended to be complementary to them rather than a substitute for them. In addition to matters such as adherence of further States to the PCT and changes in requirements of Offices and Authorities, the *PCT Newsletter* also includes the current list of PCT Contracting States, reports of international meetings concerning the PCT, amendments to the PCT Regulations, changes to PCT forms, statistics relating to the filing of international applications, practical advice for PCT users, information about forthcoming PCT seminars and tables of PCT fees. Important changes to Offices' and Authorities' requirements are reflected in provisional sheets, in tear-out format, for insertion into the *Guide* pending the publication of replacement sheets for the *Guide*. Subscription to the *PCT Newsletter* is highly recommended for regular users of the PCT; inquiries and subscription forms may be addressed to the International Bureau at the address given in Annex B2 (IB). The *PCT Newsletter* is also available on the Internet at the PCT website <http://www.wipo.int/pct/en/newslett/>. This webpage also contains a fully searchable collection of all practical advice published since 1997, plus back issues of the *PCT Newsletter*.

8. Those wishing to know the background to the PCT are advised to consult the "Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty, 1970." This is a printed, bound volume of 728 pages that exists in English and in French. The WIPO publication number is 313.

9. Further useful material is contained in the Administrative Instructions under the PCT (available from the International Bureau as a special issue of

the *PCT Gazette*, No. S-03/2001 (E) and (F) in separate English and French versions), published on 30 August 2001, the PCT Receiving Office. Guidelines (S-02/2002 (E) and (F)), published on 31 January 2002, the PCT International Search Guidelines (S-06/1998 (E) and (F)) and the PCT International Preliminary Examination Guidelines (S-07/1998 (E) and (F)). These texts may be browsed or downloaded from the PCT website in the following languages:

- English at http://www.wipo.int/pct/en/access/legal_text.htm
- French at http://www.OMPI.int/pct/fr/access/legal_text.htm
- Spanish at http://www.OMPI.int/pct/es/access/legal_text.htm

However, the Administrative Instructions and those Guidelines are mainly addressed to the authorities carrying out the various tasks entrusted to them by the PCT. To the extent that they are of interest to applicants, their contents are duly reflected in the notes to some PCT forms and in the text of this *Guide*.

CHAPTER II

WHAT IS THE PCT?

10. The Patent Cooperation Treaty or PCT is a multilateral treaty that was concluded in Washington in 1970 and entered into force in 1978. It is administered by the International Bureau of the World Intellectual Property Organization (WIPO), whose headquarters are in Geneva (Switzerland).

11. The PCT facilitates the obtaining of protection for inventions where such protection is sought in any or all of the PCT Contracting States (see the list in Annex A). It provides for the filing of one patent application (“the international application”), with effect in several States, instead of filing several separate national and/or regional patent applications. At the present time, an international application may include designations for regional patents in respect of States party to any of the following regional patent treaties: the Protocol on Patents and Industrial Designs within the framework of the African Regional Industrial Property Organization (ARIPO) (hereinafter referred to as “the ARIPO Harare Protocol”), the Eurasian Patent Convention, the European Patent Convention, and the Agreement establishing the African Intellectual Property Organization (OAPI) (hereinafter referred to as “the OAPI Agreement”). The PCT does not eliminate the necessity of prosecuting the international application in the national phase of processing before the national or regional Offices, but it does facilitate such prosecution in several important respects by virtue of the procedures carried out first on all international applications during the international phase of processing under the PCT. The formalities check, the international search and (optionally) the international preliminary examination carried out during the international phase, as well as the automatic deferral of national processing which is entailed, give the applicant more time and a better basis for deciding whether and in what countries to further pursue the application.

CHAPTER III

THE “INTERNATIONAL PHASE” AND THE “NATIONAL PHASE” OF THE PCT PROCEDURE

12. The PCT procedure consists of two main phases. It begins with the filing of an international application and ends (in the case of a favorable outcome for the applicant) with the grant of a number of national and/or regional patents: hence the terms “international phase” and “national phase.” (The expression “national phase” is used even if the Office before which it takes place is a regional Office.) The expressions “international phase” and “national phase” are not actually used in the PCT, but they are convenient, short expressions which have become customary and are therefore used in this *Guide*.

13. The international phase, which is the subject of Volume I of this *Guide*, consists (if completed) of four main steps of which the first three occur automatically and the last is optional for the applicant. The first three steps consist of the filing of the international application by the applicant and its processing by the “receiving Office” (see Annex C), the establishment of the international search report by one of the “International Searching Authorities” (see Annex D), and the publication of the international application together with the international search report as well as their communication by the International Bureau of WIPO (hereinafter referred to as “the International Bureau”) to the national (or regional) Offices which the applicant wishes to grant him a patent on the basis of his international application (the so-called “designated Offices”).

14. There is also an optional fourth step, namely the establishment of an international preliminary examination report (which, however, is not published) by one of the “International Preliminary Examining Authorities” (see Annex E). International preliminary examination is available subject to certain conditions and qualifications being met; those are discussed in detail in paragraph 325.

15. On completion of the international phase, further action is required before and in each of the designated Offices. In particular, the applicant has to pay to those Offices the required national (or regional) fees, furnish them with any translations that are required and appoint a representative (patent agent) where required. There are time limits by which those steps must be

taken if the application is to proceed in the national phase (see paragraphs 29 to 31, 46 and 47). If the steps are not taken within the applicable time limit, the effect of the international application may cease in the designated States concerned. The designated Offices then examine the application and grant or refuse the national (or regional) patent on the basis of their national laws. (In the PCT and in this *Guide*, any reference to “national law” is also a reference to a regional treaty such as the ARIPO Harare Protocol, the Eurasian Patent Convention, the European Patent Convention and the OAPI Agreement—see paragraph 11.) These procedures before the designated Offices constitute what is usually referred to as the “national phase” of the PCT procedure and are the subject of Volume II of this *Guide*.

16. It is up to the applicant to decide whether and when to enter the national phase before each designated Office. The international phase continues, for any particular designation, until entry into the national phase before the designated Office concerned or until the expiration of the applicable time limit for entering the national phase before that Office. Since the national phase may be entered before different designated Offices at different times, the international application may simultaneously be in the international phase for some designations and the national phase for others. Where the national phase processing or examination has begun before a particular designated Office, any actions taken on the international application remaining in the international phase have no effect on the proceedings before that Office.

CHAPTER IV

USEFULNESS OF THE PCT FOR APPLICANTS

17. Use of the PCT saves effort—time, work, money—for any person or firm (“the applicant”) seeking protection for an invention in a number of countries.

18. Use of the PCT also helps the applicant to make decisions about the prosecution of the application before the various national Patent Offices in the national phase of processing.

19. The saving arises primarily from the fact that, under the PCT, the applicant files *one* application—the international application—in *one* place, in *one* language and pays *one* initial set of fees, and that this international application has (subject to certain conditions indicated later) the effect of a national or regional application, which, without the PCT, he would have to file separately for each country or region.

20. The help to the applicant in the national phase prosecution of the application follows from the “advice” he obtains from the international search report, a report which is established for each international application, according to high, internationally regulated standards, by one of the Patent Offices that are highly experienced in examining patent applications and that have been specially appointed to carry out international searches. Those Offices are listed in Annex D (“International Searching Authorities”).

21. Even more explicit advice can be obtained in most cases from the international preliminary examination report, a report which is available from equally experienced Offices which have also been appointed to that effect. Those Offices are listed in Annex E (“International Preliminary Examining Authorities”).

22. The advantages offered by the PCT are given in more detail below.

23. By the single act of filing an international application under the PCT, it is possible to secure the very effect that, without the PCT, would require as many filings of separate applications as there are countries or regions in which the applicant seeks protection.

24. The filing of an international application takes place in one of the languages accepted by the Office with which the application is filed; for many applicants that will be the language, or one of the languages, used by the national or regional Patent Office of, or acting for, their country.

25. The international application is filed in a single place; it is generally filed at the national Patent Office of the applicant's country or at a regional Patent Office acting for the applicant's country, or it may be filed direct with the International Bureau in its capacity as a receiving Office under the PCT.

26. There is a prescribed form for the international application. This form must be accepted by all designated Offices for the purposes of the national phase, so that there is no need to comply with a great variety of widely differing formal requirements in the many countries in which protection may be sought.

27. The international fees payable in respect of the filing of an international application may be paid at one time, at one Office and in one currency. The costs and possible complications connected with the payment, on filing, of many fees in many countries, and generally in different currencies, are thus avoided.

28. Before the applicant goes to the effort and expense of having translations prepared, paying the national or regional fees and appointing agents in the various countries, his views are able to mature to a greater extent than would be possible without the PCT, not only because he has more time, but also because the international search report, alone or preferably together with the international preliminary examination report, constitutes a solid basis on which he can judge his chances of obtaining protection. Any patents subsequently granted on the application by the designated or elected Offices can be relied on by the applicant to a greater extent than would have been the case without the benefit of the international search report and the international preliminary examination report. Moreover, because of the longer time the applicant has for making decisions, he is better placed to assess the technical value and economic interest of patent protection and to select the particular countries in which he desires to continue seeking protection for his invention. As a result, substantial savings can be made in both translation and filing costs for those countries which are no longer of interest to the applicant.

29. If an international application is filed in a language which is not both a language accepted by the International Searching Authority which is to carry out the international search and a language of publication, it needs to be translated into an appropriate language shortly after filing, but all the translations required by the Offices of or acting for the countries in which the applicant ultimately wishes to obtain protection need to be prepared only much later. Instead of having to be filed within the 12-month priority period,

they are generally not required until the expiration of the time limit referred to in paragraph 31.

30. Fees payable to national or regional Patent Offices similarly become due later than they do without the PCT, and only in the case where the applicant decides to go ahead with the processing of his international application at the national or regional Patent Office. Generally, such national or regional fees must be paid within the same time limit as referred to in paragraph 31.

31. Since 1 April 2002, the applicable time limit for entering the national phase is 30 months from the priority date (or even later in some cases) for all Offices except those (about 20 at the time of printing of this *Guide*) in respect of which the former 20-month time limit remains applicable unless the applicant files a demand for international preliminary examination before the expiration of 19 months from the priority date, in which case the 30-month time limit (or even later in some cases) will also apply. For regular updates on these applicable time limits, refer to the *PCT Gazette* (Section IV), the *PCT Newsletter*, and the relevant National Chapters (Volume II of the *Guide*); a cumulative table is also available from WIPO's Internet site at <http://www.wipo.int/pct/en/index.html>

32. An international search report which is favorable from the applicant's viewpoint strengthens his position vis-à-vis the various national or regional Patent Offices, and his arguments for the grant of a patent by those Offices are likely to become more convincing.

33. This is even more true in the case of a favorable international preliminary examination report, which contains far more material on which to base an opinion on the chances of obtaining patents than does an international search report.

34. If the international search report is partly favorable and partly unfavorable, the applicant can modify his claims so as to maintain only those which are likely to result in the grant of a patent. If the international search report is unfavorable, and the applicant consequently decides not to proceed any further, he saves the cost of having the application processed in the various countries.

35. The preceding paragraph also applies in the case of international preliminary examination reports.

36. Important other advantages resulting from use of the PCT route are referred to in the text of this Volume of the *Guide* and in Volume II. They consist, among other things, in savings in the procedure before the

designated Offices (for instance, there is no need to provide each Office with original drawings, or certified copies of the priority application, there is a reduction in national fees in several countries and the European Patent Office, etc.).

REGIONAL PATENTS VIA THE PCT

37. Important additional advantages for applicants wishing to protect their inventions in countries party both to any of the various regional patent treaties (see paragraph 11) and to the PCT result from combined use of the PCT system and those regional systems. Not only is the PCT fully compatible with the regional patent systems, but there are possibilities for advantageous combined use of both kinds of system by the applicant, irrespective of the country in which he files. The following paragraphs deal with the combined use of the PCT with the regional patent systems under which patents may be obtained via the PCT, namely, the ARIPO Harare Protocol, the Eurasian Patent Convention, the European Patent Convention and the OAPI Agreement, via the so-called “ARIPO-PCT route,” “Eurasian-PCT route,” “Euro-PCT route” and “OAPI-PCT route.” In the case of the European Patent Convention, it is also possible to obtain patents through combined use of that Convention and the PCT in the States to which a European patent may be extended—see paragraph 41.

38. Applicants filing a PCT application and wishing to obtain protection in countries party to any of those regional patent treaties obtain, from their PCT application filed, for example, with the Japan Patent Office or with the United States Patent and Trademark Office, the effect of a simultaneous filing with each regional Office concerned for the purposes of obtaining a regional patent, provided that they state their wish to obtain the regional patent(s) in the PCT request. In such a case, before taking any action outside his country, the applicant can safely wait until the results of the PCT search (and, optionally, of the international preliminary examination) are known and also make full use of the extended period (see paragraph 46) by the end of which a translation of the PCT application, if it was not filed in one of the official languages of the regional Office (see the various National Chapters in Volume II), must be submitted and an agent appointed for the procedure before that Office.

39. An applicant may file a PCT application with his own national Office as receiving Office, even at the very end of the priority year, and still obtain an immediate automatic filing effect with the regional Office concerned. A

further advantage is that, at the time of filing the PCT application, the applicant pays only one designation fee for each regional patent desired, no matter how many States are designated in respect of each of them. The four regional designations which are presently possible cover more than 50 PCT Contracting States. If, on the other hand, he chooses to file separate regional patent applications on the basis of his first application with his national Office, he will, by the end of the priority year, have to comply with all the requirements of each of the regional treaties as to formalities, fees and appointment of agents.

40. Similar advantages are offered by use of the ARIPO-PCT, Eurasian-PCT, Euro-PCT and OAPI-PCT routes in the reverse direction. In other words, a national of a State party to one of the regional patent treaties or of one of the States to which a European patent may be extended (see paragraph 41) may, instead of filing separate patent applications with his regional Office and, for instance, the Japan Patent Office and the United States Patent and Trademark Office, choose to file, on the basis of a national application or as a first application, an international application under the PCT containing a designation for the purposes of obtaining the regional patent concerned and at the same time designating other Contracting States of the PCT, for instance, Japan and the United States of America.

41. A further advantage of the Euro-PCT route is the possibility of making use, where available, of the procedure for extension of European patents. Agreements on extending the protection conferred by European patents have been concluded between the European Patent Organisation and a number of States which are not party to the European Patent Convention. Provided that the international application contains a designation for a national patent of the State concerned and also a designation for a European patent (designation fees must be paid for both the designation for the European patent and the designation of the State concerned), the applicant may avail himself of the Euro-PCT route with a view to extending to that State a European patent subsequently granted on the basis of the international application (see paragraph 89 and Annex B2 (EP), as well as National Chapter Summary (EP) in Volume II).

CHAPTER V

FILING AN INTERNATIONAL APPLICATION

GENERAL

- Article 2(vii) 42. **What is an international application?** An application
3(1) is “international” when it is filed under and with reference to
the PCT. It is the first step towards obtaining a patent in or for
a State party to the PCT: “in” such a State when a national
patent is desired; “for” such a State when a regional patent
(ARIPO, Eurasian, European or OAPI patent) is desired.
- Article 2(i) 43. **What may be the subject of an international
and (ii) application?** An international application must be an
3(1) application for the protection of an invention. The PCT
encompasses the filing of applications for patents for
inventions, inventors’ certificates, utility certificates, utility
models, and various kinds of patents and certificates of
addition (see Article 2(i)). An international application thus
cannot validly be filed for certain other forms of industrial
property rights which fall outside the scope of “inventions,”
such as, for example, purely ornamental designs.
- Article 44. **What are the main effects of an international
4(1)(ii) application?** Any international application has two main
11(3) effects. One of those effects, generally speaking, is the same
64(4) as that of a national (or regional) application. It occurs on the
Rule 4.9 date accorded as the international filing date (see
paragraph 222). It is produced in or for the “designated
States,” that is, the States which the applicant, desiring to
obtain a patent in or for them, expressly “designates” in his
international application. For the prior art effect of
international applications in the United States of America, see
Volume II, National Chapter (US).
- Article 31(1) 45. Designated States in respect of which international
31(4)(a) preliminary examination has been demanded by the applicant
are called “elected States” in the terminology of the PCT.
- Article 22(1) 46. Subject to what is said in the following sentence, the
23(1) other main effect of an international application is that,

normally, no designated Office may process or examine the international application prior to the expiration of 30 months from the priority date (for the definition of "priority date", see paragraph 96) and that any fees due to a designated Office and any translation of the international application to be furnished to a designated Office will have to be paid and furnished, respectively, only by the expiration of that 30-month period. In respect of certain designated Offices (about 20 at the time of printing of this *Guide*), the applicable time limit is the former 20-month time limit, not the new 30-month time limit because, due to the incompatibility, for the time being, of the modified PCT provision (PCT Article 22(1)) with the relevant national law, those Offices made a declaration of incompatibility which will remain in effect until it is withdrawn by the respective Offices. Furthermore, certain designated Offices have fixed time limits expiring even later than 30 months, or 20 months, as the case may be (for more detailed information, see paragraph 31 and Volume II (Summaries)). This effect of the international application is normally referred to as the effect of "delaying" the patent examination and granting procedure before the national (or regional) Offices.

Article 39(1) 47. If international preliminary examination has been
40(1) demanded, the delaying effect is, normally, 10 months longer, so that any fees due to an elected Office and any translation of the international application will have to be paid and furnished, respectively, only by the expiration of 30 months from the priority date. (For more detailed information see Volume II. Later time limits apply in some Offices.)

Article 8 48. An international application which has been accorded an
11(4) international filing date is the equivalent of a "regular national filing" within the meaning of the Paris Convention for the Protection of Industrial Property and, consequently, may be invoked as the basis of a priority claim in a national, regional or other international application filed subsequently within the time limit and subject to the conditions provided for in that Convention.

Article 10 49. **Where should an international application be filed?**
Rule 19.1(a) Annexes B1 and B2 indicate, for each Contracting State, the

19.2

authorities with which its nationals and residents may, as applicants, file international applications. In the terminology of the PCT, these authorities are called “receiving Offices” (because they receive international applications). They are listed with their full names and addresses, their telephone, facsimile and/or teleprinter numbers and, where available, their e-mail and/or Internet addresses, in Annexes B1 and B2, and the requirements of each receiving Office are listed in Annex C. Where there are several applicants who are not all nationals and/or residents of the same Contracting State, any receiving Office of or acting for a Contracting State of which at least one of the applicants is a resident or national is competent to receive an international application filed by those applicants. Alternatively, at the applicant’s option, the international application may be filed with the International Bureau as receiving Office, regardless of the Contracting State of which the applicant is a resident or national. If there are two or more applicants, the international application may be filed with the International Bureau as receiving Office if at least one of the applicants is a resident or national of a Contracting State. Residents or nationals of States which are party to the PCT and also to the ARIPO Harare Protocol, to the Eurasian Patent Convention or to the European Patent Convention generally also have the option of filing an international application with the ARIPO Office, the Eurasian Patent Office or the European Patent Office, respectively. Compliance with any national security prescriptions applicable under national law is the applicant’s responsibility. As to measures which may be applied by receiving Offices in connection with such prescriptions, see paragraph 226.

Article
31(2)(a)
Rule 18.1
54

50. Applicants may have a choice between several receiving Offices, for example, where there are two or more applicants whose States of nationality and residence include more than one Contracting State, or where a sole applicant has nationality and/or residence in more than one Contracting State.

Article 3(2)
7

51. **What are the elements of an international application?** Any international application must contain the following elements: request, description, claim or claims, one

or more drawings (where drawings are necessary for the understanding of the invention), and abstract. Detailed information on each is given below.

- Section 207(a) 52. **What is the order of the elements of the international application?** The elements of the international application must be arranged in the following order: request, description, claim(s), abstract, drawing(s) (if any). For applications containing sequence listings, see paragraph 490.
- Rule 11.7(a) Section 207(b) 53. **How must the sheets of an international application be numbered?** All the sheets constituting the international application must be numbered in consecutive Arabic numerals with three or, where the international application contains a sequence listing, four separate series of numbers: the first applying to the request, the second applying to the part consisting of the description, the claim(s) and the abstract (see paragraph 121), the third applying to the drawings (see paragraph 155), and the last applying to the sequence listing part, if any, of the description (see paragraph 118).
- Article 3(4)(i) Rule 12.1 48.3(b) 54. **What language must be used for an international application?** The language in which an international application must be filed depends on the receiving Office. Some receiving Offices allow the applicant to choose between two or more languages. The language or languages which may be used for filing an international application with a given receiving Office are indicated in Annex C. If the international application is filed in a language other than Chinese, English, French, German, Japanese, Russian or Spanish (that is, the languages in which international applications may be published—see paragraphs 309 to 312), or if the language in which the international application is filed is not accepted by the International Searching Authority which is to carry out the international search (see paragraph 268 and Annex D), a translation of the international application will need to be furnished for the purposes of international search and/or international publication. (Note that a translation may also be required for the purposes of the international preliminary examination if the language in which the international application is filed or published is not accepted by the International Preliminary Examining

Authority which is to carry out the international preliminary examination (see Annex E.) The requirements in relation to languages and the furnishing of translations are explained in greater detail in paragraphs 229 to 236, 309 to 311 and 332. Those requirements operate, in most cases, in such a way that only one translation would need to be furnished for the purposes of the international phase of processing. All elements of the international application must normally be in the same language. However, the request must be in a language which is both a language accepted by the receiving Office (see Annex C) and a language of publication, and the text matter of the drawings (if any) and the abstract may be in the language in which the international application is to be published (see paragraphs 234 and 235).

Rule 19.4(a)(ii) 55. For the case where an international application is not filed in a language accepted by the receiving Office with which it is filed, see paragraph 241.

THE REQUEST

Rule 3.1 56. **What is the form of the request?** The request must: (a)
3.2 be made on a printed form (Form PCT/RO/101) to be filled in
3.4 with the required indications; or (b) be presented as a
4 computer print-out complying with the Administrative
89ter Instructions; or (c) be presented in the format of the print-out
Section of the computer generated request prepared using the PCT-
102(h)(i), EASY software. A sample completed printed form appears in
and (i) Annex F, and a blank copy of the printed form, Form
PCT/RO/101, which may be photocopied for use in filing
international applications, appears in Annex X. Any
prospective applicant may obtain copies of the printed request
Form PCT/RO/101, free of charge, from the receiving Office
with which he plans to file his international application or
from the International Bureau. To facilitate preparation of the
request, the International Bureau has prepared downloadable
PDF (portable document format) versions on its website.
There are two PDF versions of the form, an editable form,
that may be downloaded and completed using a computer, and
a simple PDF form, that may be printed out and filled in using

a typewriter. The request, and instructions on how to complete the editable version, is available in the following languages:

- English at <http://www.wipo.int/pct/en/forms/index.htm>
- French at <http://www.OMPI.int/pct/fr/forms/index.htm>
- German at <http://www.wipo.int/pct/de/forms/index.htm>
- Spanish at <http://www.OMPI.int/pct/es/forms/index.htm>

A blank print-out of the PCT-EASY format appears in Annex J. (That print-out must not be used for filing an international application; it only appears as an example of a print-out of an international application prepared using the PCT-EASY software; see paragraphs 497 to 504 for further details.) Any prospective applicant may obtain the PCT-EASY software free of charge from the International Bureau or download it directly from the PCT-EASY website at <http://pcteasy.wipo.int/en/index.html> which also provides guidance on using this software.

Article 4(1)
45
Rule 3
4.1

57. The request contains a petition for the international application to be processed according to the PCT and must also contain certain indications. It must contain the title of the invention. It must identify the applicant, (normally) the inventor, and the agent (if any), and must contain the designation of at least one Contracting State. If the applicant wishes to obtain a regional patent rather than, or in addition to, a national patent in respect of one or more designated States, the request must contain a designation for each regional patent concerned. The request should also contain, where applicable, choices of certain kinds of protection in designated States, a priority claim, an indication of the applicant's choice of competent International Searching Authority and a reference to any relevant earlier international, international-type or other search. The request must be signed. Details for the filling in of the request form are given below in respect of each Box of that form. As to the language of the request, see paragraph 54.

Section 109

58. It is recommended that the applicant indicate his file reference, if any, not exceeding 12 characters in length, in the

box provided for this purpose on the first sheet of the request form. The receiving Office, International Bureau, International Searching Authority and International Preliminary Examining Authority will use the file reference in correspondence with the applicant (see also paragraphs 120, 144, 336 and 473 as to the indication of file references on other elements of, or papers relating to, the international application).

Box No. I: Title of Invention

- Rule 4.3
5.1(a) 59. **What are the requirements with respect to the title of the invention?** The title of the invention must be short (preferably two to seven words, when in English or translated into English) and precise. The same title must be given by the applicant in Box No. I of the request and at the beginning of the description (see paragraph 113).

Boxes Nos. II and III: Applicants; Inventors

- Article 9(1)
9(3)
Rule 18.1
18.3 60. **Who may file an international application?** Any resident or national of a Contracting State may file an international application. Where there are two or more applicants, at least one of them must be a national or a resident of a Contracting State. The Contracting States are listed in Annex A. As to questions of residence and nationality, see paragraph 63.
- Article 27(3)
Rule 18.4(c) 61. The national law of any designated State may require that, for the purposes of the designation of that State, the applicant(s) must be the inventor(s). There is presently one such State, namely the United States of America. Where the inventor is deceased, see paragraphs 432 to 435.
- Article 9(3)
Rule 18.4(c)
Section
203(b) 62. In any international application, different applicants may be indicated for the various designated States. This possibility is of great practical importance where the United States of America is designated. As indicated in paragraph 61, the applicant for the purposes of the United States of America must be the inventor. No such requirement exists for other States. Note, however, that where more than one type of

protection is available for a Contracting State (see paragraphs 94 and 95 and Annex B1), different applicants may not be indicated for different types of protection.

Rule 18.1

63. How are questions of residence and nationality determined? The question whether an applicant is a resident or national of a Contracting State depends on the national law of that State and is decided by the receiving Office. In any case, however, possession of a real and effective industrial or commercial establishment in a Contracting State is considered residence in that State, and a legal entity constituted according to the national law of a Contracting State is considered a national of that State. Where a question of the applicant's residence or nationality arises in connection with an international application filed with the International Bureau as receiving Office, the International Bureau will request the national Office of, or acting for, the Contracting State concerned to decide the question and will inform the applicant of such request. The applicant has the opportunity to submit arguments relating to the issue of residence or nationality directly to that national Office, which will decide the question promptly.

Rule 4.5

64. How must the applicant be identified? The applicant must be identified by the indication of his name and address and by marking next to that indication, the check-box "This person is also inventor" in Box No. II, or "applicant and inventor" in Box No. III, where the applicant is also the inventor or one of the inventors, or the check-box "applicant only" where the applicant is not also the inventor or one of the inventors. Where the applicant is a corporation or other legal entity (that is, not a natural person), the check-box "applicant only" must be marked. Where the applicant is registered with the receiving Office, the number or other indication under which the applicant is so registered may also be indicated in Boxes No. II or III. The applicant's nationality and residence must also be indicated (see paragraph 70). For the identification of the inventor, see paragraph 73. For later changes in the person, name and address of the applicant, see paragraphs 427 to 431.

Rule 4.4(a)

65. How must names be indicated in the request? The

- 4.18(a) names of natural persons must be indicated by the family name followed by the given name(s). Academic degrees or titles or other indications which are not part of the person's name must be omitted. The family name should preferably be written in capital letters (see the specimen in Annex F).
- Rule 4.4(b) 66. The name of a legal entity must be indicated by its full official designation (preferably in capital letters).
- Rule 4.4(c) 67. **How must addresses be indicated in the request?** Addresses must be indicated in such a way as to satisfy the requirements for prompt postal delivery at the address indicated and must consist of all the relevant administrative units up to and including the house number (if any). The address must also include the country.
- Rule 4.4(c) 68. **When is the indication of a telephone number, a facsimile machine number or a teleprinter address recommended?** It is recommended that any telephone number, facsimile machine number and teleprinter (telex) address of the applicant named first in the request be given if no agent or common representative is indicated in Box No. IV (see paragraphs 78 to 85).
- Rule 4.4(d) 69. **May a special address be given for the sending of correspondence?** Only one address may be indicated for each applicant in Box No. II or III. However, where no agent is indicated in Box No. IV of the request, a special address for correspondence may be indicated in that Box. Where an applicant is indicated in Box No. IV as common representative, an address for correspondence may be indicated in that Box (see paragraphs 83 and 86) other than the address given for that applicant in Box No. II or III.
- Article 9(1) 70. **Why and how must the nationality and residence of**
Rule 18 **the applicant be indicated in the request?** This information
19 is needed to determine whether the applicant is entitled to file an international application and also to determine the competence of the receiving Office. It must be provided by an indication of the names of the country of which the applicant is a national and of the country of which he is a resident. Where the country of residence is not indicated specifically but a country is indicated in the address, it will be assumed

that the country of residence is the country indicated in the address. For the procedure where an international application is filed with a “non-competent” receiving Office, see paragraph 242. For the manner of indicating names of countries, see paragraph 71.

- Section 115 71. **How must the names of States be indicated?** The name of any State may be indicated either by the full name of the State or by a short title or two-letter code or any combination thereof. This principle applies for the indication of the names of States in all Boxes of the request where such names must be indicated. Annex K contains a comprehensive list of the short names and two-letter codes accepted for use in indicating countries, territories and intergovernmental organizations (and their Offices) in documents relating to international applications under the PCT. The list is as set out in WIPO Standard ST.3, which is published in the *WIPO Handbook on Industrial Property Information and Documentation*.
72. **Which of several applicants should be named first?** It is recommended that the applicant who will represent all the applicants and on whom notifications are to be served be named first, since he will be considered to be the common representative of all the applicants if no common agent or common representative is appointed (see paragraph 84). However, if a common agent representing all applicants or a common representative is indicated in Box No. IV of the request, notices will be sent to that common agent or common representative. (See also paragraphs 424 to 426.)
- Article 73. **When and how must the inventor be identified?**
4(1)(v) Where the person identified in Box No. II as applicant is also
4(4) the inventor, it is sufficient to mark the check-box “This
Rule person is also inventor.” No repetition of the name and
4.1(a)(v) address of the inventor is required in Box No. III. Where the
4.6 inventor is identified in Box No. III, the check-box “applicant
and inventor” must be marked if the inventor is also applicant;
the check-box “inventor only” must be marked if the inventor
is not also applicant. The check-box “applicant and inventor”
must always be marked in Box No. III if the United States of
America is designated, since that State requires the applicant

to be the inventor (see paragraph 61). Where the inventor is not the same for all designated States, see paragraph 76. Where the inventor is deceased, see paragraphs 432 to 435.

Article 4(4) 74. Where the inventor is not also applicant, the check-box
Rule 4.1(c)(i) “inventor only” must be marked and his name and address must be indicated in one of the sub-boxes of Box No. III. The name and address of the inventor may be omitted from the request 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. Annexes B1 and B2 indicate what the requirements are for each Contracting State or intergovernmental organization. However, unless special reasons prevent the indication of the name and address of the inventor, it is recommended that it always be included in the request. Note that all inventors will also be applicants where the United States of America is designated, except in special circumstances because of differing national laws as to inventorship (see paragraph 76).

Rule 4.4 75. As regards the indication of the name and address of the inventor, what is said in this respect for the applicant, in paragraphs 65 and 67, also applies. An indication of the country of which the inventor is a national or resident is not required unless the inventor is also applicant. For later changes in the person, name or address of the inventor, see paragraphs 427 and 429.

Rule 4.6(c) 76. **What must be done if the inventors are not the same for all designated States?** The PCT permits different inventors to be indicated for different designated States where, in this respect, the requirements of the national laws of the designated States are not the same. For the manner of indicating for which designated States the person named is the inventor, see item 1(iii) of the Supplemental Box of the request form (see Annex F). Where, and this is the usual case, all the inventors are the same for all designated States, no special indication in the Supplemental Box is required.

77. **How, in the case of several applicants, are the designated States for which they are applicants to be identified?** Details concerning the designation of States in

general are given in paragraphs 87 to 93 below. At the bottom of Box No. II and of each sub-box of Box No. III, there are four check-boxes (see Annex F). One (but only one) of those check-boxes must be marked for the applicant identified in Box No. II and for each further applicant, if any. None of these four check-boxes should be marked if the person identified in any of the sub-boxes of Box No. III is “inventor only.” The indications to be made in Box No. II and any of the sub-boxes of Box No. III relating to the designated States for which the person is identified as “This person is also inventor,” “applicant only,” “applicant and inventor” or “inventor only” have to be read in conjunction with the designations made in Box No. V. An explanation of each of the four check-boxes is given below, separately for Box No. II and Box No. III.

– **Box No. II:**

“ all designated States”

This check-box must be marked where the person identified in Box No. II is and qualifies as applicant for all designated States. Where that person is a legal entity or an assignee, this check-box must not be marked if the United States of America is designated in Box No. V.

“ all designated States except the United States of America”

This check-box must normally be marked where the United States of America is designated in Box No. V and the person identified in Box No. II is not “also inventor,” since only the inventor can be the applicant for the United States of America (see paragraphs 61 and 73).

“ the United States of America only”

This check-box must be marked where the United States of America is designated in Box No. V and the person identified in Box No. II is “also inventor” but is not also applicant for the other designated States. Often the inventor is the applicant only for the United States of America and another person (natural person or legal entity) is the applicant for all other designated States. This check-box must not be marked if the

person identified in Box No. II is not “also inventor.”

“ the States indicated in the Supplemental Box”

This check-box must be marked only in special cases not covered by the preceding three check-boxes. Where, for example, each of three applicants is applicant for different States, the indication of the States for which the person identified in Box No. II is applicant must be made in the Supplemental Box of the request form (see the explanation given below in relation to the sub-boxes of Box No. III for the other two applicants in such a case). The manner in which the Supplemental Box is to be used is explained in detail in item 1(ii) of the Supplemental Box itself (see Annex F).

– **Box No. III:**

“ all designated States”

This check-box must be marked where the person identified in the sub-box as “applicant and inventor” or as “applicant only” is and qualifies as applicant for all designated States. Where that person is a legal entity or an assignee, this check-box must not be marked if the United States of America is designated in Box No. V.

“ all designated States except the United States of America”

This check-box must normally be marked where the United States of America is designated in Box No. V and the person identified in the sub-box is “applicant only” (which means that the person is not also the inventor), since only the inventor can be the applicant for the United States of America (see paragraphs 61 and 73).

“ the United States of America only”

This check-box must be marked where the United States of America is designated in Box No. V and the person identified in the sub-box is “applicant and inventor” but is not also applicant for the other designated States. Often the inventor is the applicant only for the United States of America and another person (natural person or legal entity) is the applicant for all other designated States. This check-box must not be

marked if the person identified in the sub-box is “applicant only” or “inventor only” (that is, where the person identified as “inventor only” is inventor for some countries but not for the United States of America).

“ the States indicated in the Supplemental Box”

This check-box must be marked only in special cases not covered by the preceding three check-boxes. Where, for example, each of three applicants is applicant for different States, the indication of the States for which each of the two further applicants identified in a sub-box of Box No. III as “applicant and inventor” or “applicant only” must be made in the Supplemental Box of the request form (see the explanation given above in relation to the sub-boxes of Box No. II for the first applicant). The manner in which the Supplemental Box is to be used is explained in detail in item 1(ii) of the Supplemental Box itself (see Annex F).

Box No. IV: Agent or Common Representative

Article 27(7) 78. **Does the applicant have to be represented by an agent**
49 **before the receiving Office, the International Bureau and**
Rule 2.2 **other International Authorities under the PCT?** Annex C
90.1 indicates, for each receiving Office, whether the applicant has to be represented by an agent. As already stated (see paragraph 4), in view of the importance of careful preparation of the international application and of its proper processing, it is in any case highly advisable for applicants to use the services of a professional patent attorney or patent agent.

Article 49 79. **Who may be appointed to act as an agent?** Any person
Rule 83.1*bis* who can act as an agent before the Office which acts as
Section 106 receiving Office (see Annex C) may be appointed as an agent for any international application filed with that Office. Where the international application is filed with the International Bureau as receiving Office, any person who has the right to practice before the national (or regional) 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 may be appointed as agent (see Annex C). An appointed agent who has the right to represent the applicant

before the receiving Office is automatically also entitled to act before the International Bureau, the International Searching Authority and the International Preliminary Examining Authority.

Article
4(1)(iii)
Rule
4.1(a)(iii)
4.7
90.3

80. How is an agent to be appointed? An agent may be appointed by designation in Box No. IV of the request (see Annex F) if the international application is signed by the applicant (see also paragraphs 107 and 108). Otherwise the appointment of the agent must be in a separate document (“power of attorney”) signed by the applicant. The indication in Box No. IV of the request or in the power of attorney must contain the name and address of the agent in the manner indicated in paragraphs 65 to 68. It is recommended that the agent’s telephone and/or facsimile numbers be indicated. Where the agent is registered with the receiving Office, the number or other indication under which the agent is so registered may also be indicated. Where there are several applicants, an agent representing all of them may be appointed by designation in the request or by a separate power of attorney or by a combination of both methods, provided that all the applicants have signed either the request or a separate power of attorney. Models of powers of attorney are to be found in Annex Z. The separate power of attorney must be submitted to the receiving Office or to the International Bureau or, if the appointment was made specifically for the purposes of the procedure before the International Searching Authority or International Preliminary Examining Authority, to the Authority concerned (see paragraph 81). Where a general power of attorney authorizes an agent to represent the applicant before the Office which acts as receiving Office, and where that general power includes the filing of international applications, a copy of the general power of attorney originally submitted to the receiving Office must accompany any international application in relation to which the appointment made in it is to be exercised, and reference must be made to that copy in Box No. IX of the request. It is to be noted that general powers of attorney must be deposited with the receiving Office (not with the International Bureau, except where the international application is filed with the

International Bureau as receiving Office) or, if the appointment was made specifically for the purposes of the procedure before the International Searching Authority or International Preliminary Examining Authority, with the Authority concerned (see paragraph 81).

Rule 90.5 81. Further agents may be appointed at any time to represent the applicant either generally or specifically before the International Searching Authority or the International Preliminary Examining Authority, and an agent appointed for general purposes, unless otherwise indicated in the document appointing him, may appoint sub-agents to represent the applicant. The appointment of a new agent is treated as revocation of any former appointment of agents, unless otherwise indicated in the power of attorney appointing the new agent.

Article 27(7)
Rule 4.7
90.3
Section 106 82. If representation by an agent before the receiving Office is required (see paragraph 78), the agent must be appointed by the time the international application is filed to ensure that the international application will be accepted for processing by the receiving Office. The practice of the receiving Office with regard to enforcing the requirement that an agent be appointed is the same as that observed by it in the case of national (or regional) applications. If the appointment of an agent is not obligatory, an appointment may be made either at the time of filing the international application or later.

83. **Is the person who signs the request for a corporate applicant regarded as an agent?** The answer depends on the nature of the authorization to act for the corporate applicant—that is, on whether the person signs on behalf of the corporate applicant or as an appointed agent. If the name of that person is indicated in Box No. IV and the check-box “agent” is marked, the person will be regarded as an agent and a power of attorney will be required. If the corporate applicant is indicated in that Box and the check-box “common representative” is marked, the person who signs will not be regarded as an agent. The mere fact that a person is indicated as part of the address for correspondence to the corporate applicant as common representative (see paragraph 86) does not mean that the person will be regarded as an agent.

Rule 2.2bis
90.2

84. **Can one of several applicants represent all of them as a common representative?** If a common agent is not appointed by all the applicants, one of the applicants may be appointed by the other applicants as the common representative of all the applicants (see paragraph 414). If neither a common agent nor a common representative is appointed, the first-named applicant who has a right to file an international application with the receiving Office concerned is automatically considered to be the “deemed” common representative of all the applicants (see paragraph 415).

85. A more detailed explanation of the provisions relating to agents and common representatives appears at paragraphs 410 to 423.

Rule 4.4(d)
Section 108

86. **When and how may a special address for correspondence be given?** Correspondence is sent to the appointed agent or common representative, if any. Where no agent or common representative is appointed, any correspondence will be sent to the address, indicated in Box No. II or III, of the applicant (if only one person is named as applicant) or of the applicant who is considered to be common representative (if there are two or more persons named as applicants) (see paragraphs 84 and 415). However, if the applicant wishes correspondence to be sent to a different address, in such a case, that address must be indicated in Box No. IV instead of the designation of an agent or common representative. In this case, and only in this case, the last check-box of Box No. IV must be marked (that is, the last check-box must not be marked if either of the check-boxes “agent” or “common representative” in Box No. IV has been marked).

Box No. V: Designation of States

Article
4(1)(ii)
Rule
4.1(a)(iv)
and (b)(iv)
4.9(a)

87. **What is the (specific) designation of States?** The designation of States is the indication, in Box No. V of the request, of specific Contracting States in or for which the applicant is seeking protection for his invention. Such a designation is called in this *Guide* a “specific” designation, as distinct from the “precautionary” designations explained in

paragraphs 90 to 92. Designations for the purpose of obtaining national patents are effected by indicating each Contracting State concerned. On the printed form, this is accomplished by marking the appropriate check-boxes next to the names of the States. (Note that Switzerland and Liechtenstein cannot be designated independently of each other.) Where the applicant is seeking an ARIPO patent (for States party to both the PCT and the ARIPO Harare Protocol), a Eurasian patent (for States party to both the PCT and the Eurasian Patent Convention), a European patent (for States party to both the PCT and the European Patent Convention), or an OAPI patent (for States party to both the PCT and the OAPI Agreement), the applicable check-box must be marked.

Article 4(1)
45
Rule
4.1(b)(iv)
4.9(a)(ii)
Section
203(b)

88. Belgium, Cyprus, France, Greece, Ireland, Italy, Monaco and the Netherlands can be designated only for a European patent since only a European patent (and not a national patent) can be obtained via the PCT route for those countries. Likewise, Swaziland can be designated only for an ARIPO patent and not for a national patent. The designation for a Eurasian patent of any State which is party both to the PCT and to the Eurasian Patent Convention automatically has the effect of a designation of all such States for a Eurasian patent; it is not possible to make a designation for a Eurasian patent of only some of those States. Similarly, the designation for an OAPI patent of any State which is party both to the PCT and to the OAPI Agreement automatically has the effect of a designation of all such States for an OAPI patent; it is not possible to make a designation for an OAPI patent of only some of those States. Moreover, the States party to the OAPI agreement can be designated only for an OAPI patent; national patents are not available in those States. Where a State is designated both for national protection and for an ARIPO patent or a European patent, the application has the effect, in the international phase, of an application for national protection in that State and also as an application for an ARIPO or a European patent with effect for that State. Where a State is designated both for national protection and for a Eurasian patent, the application has the effect in the international phase of an application for national protection in

that State and also as an application for a Eurasian patent with effect for all States party to both the PCT and the Eurasian Patent Convention. In such a case where a State is designated twice in the same application, the applicant(s) for both designations must be the same (see paragraph 62). Annexes B1 and B2 contain the relevant information on the type of protection available in each Contracting State. Since only one designation fee is due for an ARIPO patent or a European patent regardless of the number of States designated for that purpose, it is recommended that all such States be designated by marking the check-box “AP” or “EP”; the final selection of the States for which an ARIPO patent or a European patent is sought can be made on entering the regional phase before the ARIPO Office or the European Patent Office (see Volume II).

89. Is the procedure for extending a European patent to a country having an Extension Agreement with the European Patent Organisation available through the filing of an international application?

A European patent granted on an international application may, if the necessary conditions are met, be extended to a State having an Extension Agreement to that effect with the European Patent Organisation. The procedure is available only if the international application contains both a designation for a European patent of at least one State party to the European Patent Convention and a designation for a national patent of the State having the Extension Agreement. Annex B2 (EP) contains information as to the States to which European patents may be so extended. Details of the applicable procedure, including the steps to be taken on entering the national phase and fees payable, have been published in the *Official Journal of the European Patent Office* (No. 1-2/1994, pages 75 to 88, and No. 11/1997, pages 538 to 542); see also the National Chapter Summary (EP) in Volume II.

90. When must States be designated? All designations must be made in the international application on filing; none may be added later. However, there is a safety net designed to protect applicants who make mistakes or omissions among the specific designations made as described in paragraphs 87 and 88, by way of making a “precautionary” designation of all

Rule
4.1(a)(iv)
4.9(b)
32

other States whose designation would be permitted under the Treaty.

Rule 4.9(b)
and (c)

91. **What is a “precautionary designation”?** In addition to specific designations described in paragraphs 87 and 88, the applicant may, under Rule 4.9(b) indicate in the request that all designations which would be permitted under the PCT are also made. Such “precautionary designations” may only be made provided that at least one specific designation is made (see paragraph 87) and that the request also contains a statement declaring that the precautionary designations are subject to confirmation (as provided in Rule 4.9(c)), and that any such 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.

92. Precautionary designations are effected in practice by including the necessary statement in the last sub-box of Box No. V of the request (the statement is set out in the printed request form). Since the precautionary designation system is intended particularly to enable applicants to correct omissions and mistakes in the original list of specific designations, it is strongly recommended that applicants make the precautionary designations indication (by leaving the pre-printed statement in the printed form, if that form is used) unless there is a particular reason for doing otherwise. The request form makes provision for the applicant to omit specified designations from the scope of the precautionary designation indication, if that is desired. It should be noted that no fees are payable in respect of precautionary designations except where the applicant later decides to confirm them. The procedure for confirming precautionary designations is explained in more detail at paragraphs 261 to 266.

Section
321(c)

93. **How may the order of designations be indicated?** Any specific designation of a Contracting State for which a designation fee is due (see paragraph 197(c)) but not paid as required is considered withdrawn by the receiving Office (see paragraph 213). Where the amount paid is sufficient to cover one or more, but not all, designation fees due, the amount paid is applied to the specific designations in the order in which

they appear in the international application unless the applicant has indicated to which designation(s) the amount is to be applied. An order of importance of specific designations may be made in Box No. V of the request by marking the check-boxes of the designated States with sequential Arabic numerals. However, it is strongly recommended, when the designation fees are paid, that an indication be given of which specific designations the fees are intended to cover. Where not all designation fees are paid, the indication should clarify which specific designations are maintained and which are withdrawn in order to avoid the invitation procedure under Rule 16*bis* (see paragraphs 211 and 213).

Article
4(1)(ii)
4(3)
43
Rule
4.1(b)(iii)
and (v)
4.12
4.13
4.14
Section
202(a)

94. Is it possible to choose a kind of protection other than a patent, and if so how is it done? Unless otherwise indicated in the designation of any State, each designation is treated as an expression of the wish to obtain a patent in the designated State. However, if the applicant wishes his international application to be treated in any designated State (whose national law provides for that kind of protection) as an application not for a patent but for another type of protection such as, for example, an inventor's certificate, a utility certificate, a utility model, a "petty patent," a patent of addition, a certificate of addition or an inventor's certificate of addition, he must indicate his wish in Box No. V of the request, on the dotted line following the name of the designated State, and his application will be dealt with accordingly in that State. Annexes B1 and B2 indicate, for each Contracting State, the kinds of protection available. Where a title (patent, certificate, inventor's certificate) of addition is sought, or where the applicant wishes the international application to be treated as an application for a continuation or a continuation-in-part, that fact must be indicated following the name of the designated State, and the parent application must be identified in the "Supplemental Box" (see item 1(v) of that Supplemental Box).

Article 44
Rule 4.12(b)
Section
202(b)

95. Can two kinds of protection be sought in the same designated State, and if so how? The applicant may, in respect of any designated State (whose national law provides for the kinds of protection concerned and admits the

possibility of two kinds of protection being sought), mention two kinds of protection in the request (but see also paragraph 62). Where, in addition to a national patent, a utility model is also desired, the words “and utility model” must be written in Box No. V of the request, on the dotted line following the name of the State concerned.

Box No. VI: Priority Claim

Article 2(xi) Article 8(1) Rule 4.1(b)(I) 4.10 Section 408(b)	<p>96. How may the priority of an earlier application be claimed? "Priority date" means, where the international application contains a priority claim, the filing date of the application whose priority is claimed, and, where it does not contain such a claim, the filing date of the international application. Where the international application contains two or more claims, "priority date" means the filing date of the earliest application whose priority is claimed. Any international application may contain a declaration claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for a member of the World Trade Organization (WTO) that is not party to that Convention. An earlier regional (ARIPO, Eurasian, European or OAPI) application or an earlier international application can also serve as a basis for a priority claim. Any priority claim must be made in the request. The priority claim must contain the necessary indications which allow the earlier application to be uniquely identified. If the earlier application was a national application, it must indicate the country in which it was filed, the date on which it was filed and the number under which it was filed. Where the earlier application was a regional application, the priority claim must indicate the Office with which it was filed; only where not all countries party to the regional patent treaty under which the earlier application was filed are also party to the Paris Convention for the Protection of Industrial Property (the Paris Convention) or are also members of the WTO must the priority claim indicate at least one country party to the Paris Convention or at least one member of the WTO for which that earlier regional application was filed. This is at present the</p>
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case only where the earlier application was an application for an ARIPO patent. Where the earlier application was an international application, the priority claim must indicate the receiving Office with which it was filed. The two-letter code (see Annex K and paragraph 71) may be used for the indication of the country or, where applicable, for the Office of filing. Subject to certain conditions, priority claims may be corrected and added, after the international application has been filed, by a notice submitted to the receiving Office or to the International Bureau (see paragraphs 245 to 250).

Article 8(1)
and (2)(a)
11(3)
11(4)
Rule 4.10

97. What are the principles governing the right of priority for international applications? The PCT makes no change to the provisions which govern the right of priority and are contained in Article 4 of the Paris Convention for the Protection of Industrial Property; WTO members are required to apply Paris Convention Article 4 in accordance with Article 2.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). Since an international application has the effect in each designated State of a regular national application, it may claim priority from another application, and be used as the basis for a priority claim in a later application, just like any regular national application. So far as PCT procedures are concerned, the priority claim is particularly important because it establishes a priority date for the purposes of computing time limits under the PCT. The validity of a priority claim is not determined during the international phase (although the matter is taken into consideration for the purposes of establishing the international preliminary examination report, if any). Also, a priority claim would, subject to the possibility of correction (see paragraphs 245 to 250), be considered for the purposes of the procedure under the PCT not to have been made if the application the priority of which is claimed was not filed either in a country party to the Paris Convention or in a member of the WTO, if the claim fell outside the 12-month priority period provided for by the Paris Convention (see paragraph 245) or if the priority claim did not include the required details concerning the date on which and the country and/or Office, as the case may be, where the earlier

application was filed. Note that where priority is claimed of an earlier filing in or for a WTO member which is not party to the Paris Convention, a PCT Contracting State that is not a Member of the WTO is not required to recognize the effects of such a priority claim. Furthermore, PCT Rule 4.10(d) provides that if, on 29 September 1999, amended paragraphs (a) and (b) of Rule 4.10 (which entered into force on 1 January 2000) are not compatible with the national law applied by any designated Office, those paragraphs will not apply, and those paragraphs as in force until 31 December 1999 will continue to apply, in respect of that Office for as long as the incompatibility continues to exist, provided that such Office informs the International Bureau of the incompatibility as prescribed in Rule 4.10(d). The European Patent Office and the Japan Patent Office, as designated Offices, have informed the International Bureau of such incompatibility.

- Section 110 98. **How must dates be indicated in the priority claim?** Each date appearing in the international application or in any correspondence must be indicated by the Arabic number of the day, the name of the month and the Arabic number of the year, in that order. In the request, after, below or above that indication, the date should be repeated in parentheses with a two-digit Arabic numeral each for the number of the day, the number of the month and the last two figures of the year, in that order and separated by periods, slants or hyphens, for example: “20 March 2001 (20.03.01) or 20 March 2001 (20/03/01) or 20 March 2001 (20-03-01).”
- Rule 4.1(c)(ii) 99. **When and to whom must the priority document be furnished?** Before the expiration of 16 months from the priority date (or, where the applicant requests early processing pursuant to Article 23(2), before that request is made), a certified copy of the earlier application (whether it is a national, regional or international application) must be submitted by the applicant either to the International Bureau or to the receiving Office (unless it has already been filed with the receiving Office together with the international application); any certified copy that reaches the International Bureau after the expiration of 16 months from the priority
- 17.1
- 17.2(a)
- Section 411

date, but before the date of international publication of the international application, will be considered to have reached the International Bureau on the last day of that 16-month period. The copy must be certified by the authority with which the earlier application was filed. Where that authority is the same Office as the receiving Office, the applicant may, instead of submitting the certified copy, request the authority, before the expiration of 16 months from the priority date, to prepare and transmit the certified copy to the International Bureau; in that case, the fee usually charged by the Office should be paid when the request for transmittal is made; the easiest solution for the applicant is to make this request at the time of filing the international application, by marking the check-box provided for the purpose in Box No. VI. The International Bureau notifies the applicant of the date on which the priority document was received. Any designated Office which specifically so requests receives a copy of the priority document from the International Bureau. Provided the applicant has either furnished a certified copy or requested transmittal of a copy and paid the necessary fee as described above, no designated Office may ask the applicant himself to furnish a certified copy of the earlier application. Where neither of those things has been done, any designated Office may disregard the priority claim but only after having first given the applicant an opportunity to furnish the priority document within a time limit which is reasonable under the circumstances. For the obligation of the applicant to furnish a simple (not certified) copy of the priority document to designated Offices (including a copy of the priority certificate), see Volume II.

Rule 17.2(b) 100. For information as to the obtaining of copies of the priority document after international publication, see paragraph 316.

Box No. VII: International Searching Authority

Rule 4.1(b)(vi) 101. **Must an applicant indicate a choice of International Searching Authority?** Where two or more International Searching Authorities are competent to carry out the
4.14*bis*

international search, the applicant must indicate the Authority chosen in the appropriate space in Box No. VII. For details on which International Searching Authorities are competent, see Annex C and paragraph 268.

- Rule 102. **Why is a reference to an earlier search (if any) needed, and how must a reference to an earlier search be indicated?** Certain International Searching Authorities refund part or all of the international search fee where the international search can be based wholly or partly on an earlier search (whether an international, international-type, or other search) made by them (see paragraph 217). For details, see Annex D. Where the earlier search by the International Searching Authority was made in relation to a national, regional or international application, that application (or a translation thereof) must be identified in Box No. VII of the request by an indication of the country of filing (or the regional Patent Office), and the number and filing date of that application. Where the earlier search was made independently of a patent granting procedure (for instance, a standard search by the European Patent Office), a reference must be made to the date of the request for that search and the number given to the request by the International Searching Authority.
- 4.1(b)(ii)
4.11
16.3
41.1

Box No. VIII: Declarations

102A. **What declarations may be referred to in Box No. VIII and included in Boxes Nos. VIII(i) to (v)?** The applicant may, for the purposes of the national law applicable in one or more designated States, include one or more of the following declarations under Rule 4.17, using the prescribed standardized wording and presenting them in the relevant Box or Boxes Nos. VIII(i) to (v), which are all optional declaration sheets:

- Rule 4.17(i) – Box No. VIII(i): declaration as to the identity of the inventor (noting that such declaration need not be made in Box No. VIII(i) if the name and address of the inventor are indicated otherwise in the request, that is, usually in Boxes No. II and/or III);
- 51bis.1(a)(i)
- Rule 4.17(ii) – Box No. VIII(ii): declaration as to the applicant's

51bis.1(a)(ii) entitlement, as at the international filing date, to apply for and be granted a patent;

Rule 4.17(iii) – Box No.VIII(iii): declaration as to the applicant’s
51bis.1(a)(iii) entitlement, as at the international filing date, to claim priority of the earlier application;

Rule 4.17(iv) – Box No.VIII(iv): declaration of inventorship (only for the
51bis.1(a)(iv) purposes of the United States of America), noting that that declaration must be signed;

Rule 4.17(v) – Box No.VIII(v): declaration as to non-prejudicial
51bis.1(a)(v) disclosures or exceptions to lack of novelty.

No other declaration(s) may be included in any of Boxes Nos. VIII(i) to (v). If no declaration is made, none of the optional declaration sheets should be included in the request as filed. The applicant must indicate, in each declaration, those designations for the purposes of which it is made; the applicant may indicate all designations or only some of them, noting that some declarations may not be made for the purposes of certain designations (see paragraph 102C).

Rule 4.17 102B. **What purpose do declarations referred to in Rule**
51bis.1 **4.17 serve?** The purpose of declarations referred to in Rule
51bis.2(a) 4.17, if they are made using the standardized wording (see
and (b) paragraphs 102E to 102G), is to simplify the processing of international applications in the national phase. The matters in respect of which such declarations may be made are matters in respect of which designated Offices are entitled to require documents or evidence during the national phase. Where the declaration in question is one of those referred to in Rule 4.17(i) to (iv), the designated Office for the purposes of which the declaration is made may not require any document or evidence relating to the subject matter of such declaration unless it may reasonably doubt the veracity of that declaration. Where the declaration in question is that referred to in Rule 4.17(v), the designated Office for the purposes of which the declaration is made is free to nevertheless require further documents or evidence, noting that the matter of non prejudicial disclosures and exceptions to lack of novelty is a substantive matter of patentability. It is to be noted that the fact that a declaration is made does not of itself establish the

matters declared: those matters remain for determination by the designated Offices in accordance with the applicable national law.

Rule
51bis.2(a)
and (c)

102C. **Do all designated Offices accept declarations made under Rule 4.17 for the purposes of fulfillment of national phase requirements?** Most of the designated Offices accept such declarations; however, certain Offices have informed the International Bureau, in accordance with Rule 51bis.2(c), that, even if one or more of the declarations are made as provided in the request, they may still require further documents or evidence in the national phase since, and as long as, the respective national laws applied by them are not compatible with Rule 51bis.2(a) or parts thereof. For more information, see Volume II, general part, and the corresponding Summary in the National Chapter for the designated Office concerned.

Rule 47.1(a-
ter)
48.2(a)(x)
48.2(b)(iv)

102D. **How do designated Offices receive the declarations relevant to them?** For all declarations except that relating to non-prejudicial disclosures and exceptions to lack of novelty, the International Bureau will communicate to each designated Office concerned copies of the relevant declarations made by the applicant, at the time of the communication of the international application (see paragraph 319). A declaration as to non-prejudicial disclosures and exceptions to lack of novelty will be published as part of the pamphlet (see paragraph 307) and will therefore not be communicated also separately to each Office concerned.

Rule 4.17
Section 211
212
213
214
215

102E. **How must the declarations be presented in the request?** Each declaration should be made in the appropriate sub-box (i) to (v) of Box No. VIII; a “continuation sheet for declaration” (Continuation of Box No. VIII (i) to (v)) should be used in case any single declaration does not fit in the corresponding sub-box. The declarations must be worded using the standardized wording provided for in Sections 211 to 215. Except in respect of the declaration of inventorship for the purposes of the designation of the United States of America (see paragraph 102F for details), the applicant must chose those items and elements of the standardized wording that apply and place them in the appropriate order, taking into account the facts of the case, the chronology of events, etc. As

part of the standardized wording, the applicant must also indicate the designated State(s) to which the declaration applies. Detailed guidance on making these declarations is contained in the Notes to the request form. Refer to the relevant Summaries in the National Chapters contained in Volume II for information as to which declaration(s) may be made in respect of which designated States.

Rule 4.17(iv) 102F. The text of the declaration of inventorship for the purposes of the designation of the United States of America only is pre-printed in Box No. VIII (iv) of the request form since that text must be used as shown in Section 214, no parts may be omitted or presented in an order different from that used in the form. In addition, all of the inventors must be named in that declaration, even if they do not sign the same (copy of the) declaration, and bibliographic data (such as, but not limited to, address of residence and citizenship) must be included for each inventor; the declaration must be signed and dated directly by the inventor(s) unless they have signed in Box No. X of the request; a signature by an appointed agent is not sufficient for this purpose. See also paragraph 110.

Rule 51*bis*.2 102G. **Must the standardized wordings of declarations always be used?** The standardized wordings should always be used, otherwise, the designated Offices are entitled, even though they are not obliged, to require the applicant to furnish a new declaration or further evidence in the national phase. It should be noted, however, that even if a declaration has not been made using the standardized wording, the International Bureau will nevertheless communicate it to the designated Offices concerned (in the case of those declarations referred to in Rule 4.17(i) to (iv)) or include it with the international application as published in the form of the pamphlet (in the case of the declaration referred to in Rule 4.17(v)). It will then be up to each designated Office concerned to determine whether it can accept the declaration or not; in other words, the applicant will not have any guarantee that such Office will accept it. If the circumstances of a particular case are such that the standardized wording is not applicable for making a particular declaration, the applicant should not attempt to make that declaration under Rule 4.17 but should, instead,

comply with the requirements concerned in the national phase of the application.

102H. **What is the purpose of the check-boxes in Box No. VIII?** The check-boxes in Box No. VIII should be completed by the applicant to allow the receiving Office to verify that the declaration(s) referred to correspond to those made in Boxes No. VIII (i) to (v), as the case may be.

102I. **What if the applicant chooses not to make any declaration at the time of filing the international application or if declarations are not yet available at the time of filing?** In both cases, the request should not include the optional sheets for declarations and nothing should be marked in the list contained in Box No. VIII.

Rule 26*ter*.1 102J. **Can a declaration referred to in Rule 4.17 be corrected or added during the international phase?** A declaration may be corrected, or a new (missing) declaration added, by a notice submitted to the International Bureau. For further details, see paragraphs 250A to 250G.

Box No. IX: Check List

Rule 3.3
Section 313 103. **What is the purpose of the check list?** Box No. IX should be completed by the applicant to allow the receiving Office to verify the completeness of the documents constituting and/or accompanying the international application and, in particular, to check whether the international application as filed actually contains the number of sheets in paper form indicated in item (a), and whether the sequence listing part of the description, if any, is filed in computer readable form only or in computer readable form in addition to being filed in paper form where indicated in item (b), including the check of the type and number of carriers (diskettes, CD-ROMs, or other) where also indicated in item (b).

104. The actual number of sheets constituting each element of the international application as well as their total should be indicated (for the numbering of sheets, see paragraph 53). As for the sheets of the request, they are at least four in number

(the “first sheet,” the “second sheet,” the “third sheet” and the “last sheet”). There may be more sheets if one or more optional sheets are used (the “continuation sheet” for Box No. III, the “supplemental sheet,” the “declaration sheet” or the “continuation sheet for declaration”).

Article 27(2) 105. For details on the completion of Box No. IX and on the
Rule 13*bis* kinds of items which may need to be filed with the
51*bis*.1 international application, see the Notes to the request form
Section 209 which are included in Annex X. [See also Volume II for
details concerning certain matters in relation to designated
Offices].

Rule 106. The applicant must further indicate in Box No. IX the
3.3(a)(iii) number of that figure of the drawings (if any) which is
8.2 suggested to accompany the abstract for publication (see
Section 201 paragraph 185) and preferably also the language of filing of
the international application.

Box No. X: Signature of Applicant or Agent

Article 107. **Who must sign the international application and
14(1)(a)(i) when?** The international application must be signed in Box
Rule 4.1(d) No. X of the request by the applicant, or, where there are two
4.15 or more applicants, by all of them. Subject to certain
90.3 conditions indicated in paragraph 108, the request may be
signed by the agent instead of the applicant(s).

Rule 2.1 108. **May the international application be signed by an
4.1(d) agent?** The international application may be signed by an
4.15 agent, but in that case the agent must be appointed as such by
90.3 the applicant in a separate power of attorney signed by the
applicant himself (see paragraphs 78 to 86, and 410 to 423). If
there are two or more applicants, the request may be signed
by an agent on behalf of all or only some of them; in that case
the agent must be appointed as such in one or more powers of
attorney signed by the applicants on whose behalf the agent
signs the application. Where a power of attorney appointing
an agent who signs an international application is missing, the
signature is treated as missing until the power of attorney is
submitted. For the case where an inventor who is an applicant
for the purposes of the designation of the United States of

America refuses to sign the request or cannot be found or reached, see paragraphs 437 to 442. For the case of a general power of attorney, see paragraphs 80 and 418.

109. How must the international application be signed?

The signature should be executed indelibly in a dark color, preferably in black ink, so that it will appear clearly in a photocopy. The name of each person signing the international application should be indicated (preferably typewritten) next to the signature. Where the person signs on behalf of a legal entity, the capacity in which that person signs should also be indicated.

Rule 2.3

110. When must or may a seal be used instead of a

signature? In international applications filed with the China Intellectual Property Office as receiving Office, a seal may be used instead of a signature. In the case of international applications filed in English with the Japan Patent Office as receiving Office and in respect of which the European Patent Office has been chosen by the applicant as International Searching Authority, a signature must be furnished instead of a seal. In international applications filed with the Korean Intellectual Property Office as receiving Office, a seal must be used instead of a signature.

Notes to the Request Form

111. What are the Notes to the request form? The Notes to the request form (see Annex X) are intended to facilitate the completion of that form. They indicate, in relation to each Box of that form, what indications are required and how they are to be made. The Notes are not required to be submitted with the request, however, and should not be numbered as part of the request.

Fee Calculation Sheet

112. What is the fee calculation sheet? The fee calculation sheet is intended to help the applicant to calculate the total amount of fees payable to the receiving Office. The sheet is usually annexed to the request form which the applicant obtains from the receiving Office. It is not part of the form and is not counted as a sheet of the request, however, and its use is not mandatory. Nevertheless, it is strongly

recommended that the applicant complete the fee calculation sheet and submit it to the receiving Office. This will help the receiving Office to verify the calculations and identify any errors. Where two or more International Searching Authorities are competent for searching the international application (see paragraph 268), the Authority which was chosen by the applicant and indicated in Box No. VII of the request form (see paragraph 101) should also be indicated in the fee calculation sheet, together with the amount of the applicable search fee (see paragraph 201). See the Notes to the fee calculation sheet in Annex X for details about completion of the sheet. For information about the payment of fees generally, see paragraphs 197 to 218.

THE DESCRIPTION

Article 5
11(1)(iii)(d)
Rule 5
Section 204

113. **How must the description be drafted?** The description must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. It must start with the title of the invention as appearing in Box No. I of the request. Rule 5 contains detailed requirements as to the “manner and order” of the description, which, generally, should be in six parts. Those parts should have the following headings: “Technical Field,” “Background Art,” “Disclosure of Invention,” “Brief Description of Drawings,” “Best Mode for Carrying Out the Invention” or, where appropriate (see paragraph 115), “Mode(s) for Carrying Out the Invention,” “Industrial Applicability,” and, where applicable, “Sequence Listing” and “Sequence Listing Free Text.”

114. The details required for the disclosure of the invention so that it can be carried out by a person skilled in the art depend on the practice of the national Offices. It is therefore recommended that due account be taken of national practice (for instance in Japan and the United States of America) when the description is drafted. The need to amend the description during the national phase (see paragraph 126) may thus be avoided.

Rule 5.1(a)(v)

115. What is said in paragraph 114 applies likewise to the

need to indicate the “best mode for carrying out the invention.” If at least one of the designated Offices requires the indication of the “best mode” (for instance, the United States Patent and Trademark Office), that best mode must be indicated in the description.

116. A description drafted with due regard to what is said in paragraphs 113 to 115 will be accepted by all the designated Offices. It might require more care than the drafting of a national patent application, but certainly much less effort than the drafting of multiple applications, which is necessary where the PCT route is not used for filing in several countries.

117. The requirement of unity of invention is discussed, in connection with the claims, in paragraphs 129 to 138.

118. **What special requirements apply to nucleotide and/or amino acid sequence listings?** Where the international application contains disclosure of a nucleotide and/or amino acid sequence, the description must contain a listing of the sequence which complies with the standard provided for in Annex C of the Administrative Instructions (Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in International Patent Applications Under the PCT) and which is presented as a separate part of the description in accordance with that standard. Where the international application contains the disclosure of sequence listings, the “sequence listing part” of the description should be headed “Sequence Listing.” Where applicable, the main part of the description should, under the heading “Sequence Listing Free Text,” repeat the free text contained in the sequence listing. For further information relating to nucleotide and/or amino acid sequence listings, including any requirements for their presentation in computer readable form, see below and paragraphs 271 to 278.

118A. **Must voluminous sequence listings always be filed on paper, for the purposes of obtaining an international filing date?** Where the sequence listing part of the description is voluminous (hundreds or even thousands of pages), the applicant has the option either to file that part on paper (even though a copy of that part may be furnished also in computer

Rule 5.2
13ter.1
Section 208
513

Rule 89bis
Section 801
804(a) and (b)

readable form but only for the purposes of international search, see paragraph 119) or, under Section 801, to file that part only on an electronic medium, or both in that form and also on paper (see paragraphs 119A to 119E). In the three options mentioned above, the legally determinative copy of the sequence listing part will be, respectively, the sequence listing part on paper, the sequence listing part on electronic medium and the sequence listing part on paper.

119. How should the applicant proceed where the sequence listing part is to be furnished in computer readable form but only for the purposes of international search? If the applicant is aware that the International Searching Authority requires a listing of the sequence in computer readable form (see Annex D), it is advisable to submit such a listing in the prescribed format on a computer diskette (see Annex C of the Administrative Instructions) to the receiving Office, together with the international application, rather than to wait for an invitation from the Authority. The receiving Office will then include the diskette, which does not form part of the international application, with the copy of the international application transmitted by the receiving Office to the Authority.

Section 801(b) and (c)

119A. Do all receiving Offices accept the filing of sequence listing parts of descriptions on an electronic medium in computer readable form under Section 801? Receiving Offices which are prepared, for the purposes of according an international filing date, to accept such filings have notified the International Bureau accordingly (relevant information, including the types of electronic medium acceptable to them, is contained in Annex C in this Volume); however, any receiving Office may nevertheless decide in a particular case to accept such filings, in which case no specific information would be available from Annex C in this Volume (the applicant should inquire directly at the receiving Office concerned).

Rule 19.4(a)(iii), (b) and (c)
Section 333(b) and (c)
801(e)

119B. What happens if the applicant files an international application containing a sequence listing part filed under Section 801 whereas the receiving Office does not accept such filings? If the receiving Office has not

notified the International Bureau that it is prepared to accept such filings (see paragraph 119A) or if it is not prepared to use the possibility to accept the particular case at hand, it may request the International Bureau in its capacity as receiving Office to agree to the transmittal of the international application. The International Bureau will then proceed in the same manner as where the international application is transmitted to it for reasons of language (see paragraph 241) or for reasons of nationality or residence of the applicant (see paragraph 242).

Rule 13ter.1
Schedule of Fees
Section 801
803

119C. Is there a fee incentive for the applicant to file a sequence listing part on an electronic medium under Section 801? Where the sequence listing part of the description is filed on an electronic medium in the computer readable form referred to in Annex C of the Administrative Instructions, the basic fee payable will comprise two components: a basic component calculated as provided in the Schedule of Fees in respect of all sheets filed on paper (but excluding the sequence listing part even if also filed on paper) and an additional component for the sequence listing part only. That additional component is set at 400 times the fee per sheet as referred to in item 1(b) of the Schedule of Fees and is payable, irrespective of the actual length of the sequence listing part, both where that part is filed on an electronic medium only and where it is filed on an electronic medium and also on paper. Should the sequence listing part be significantly less than 400 pages in length, the applicant should not file it under Section 801 since the basic fee payable would then include the two components mentioned above and would always be much higher than the amount payable, had the calculation been made taking into account the actual number of sheets of the sequence listing part filed only on paper (also, in that case, the sequence listing part could still be submitted in computer readable form but only for the purposes of the international search; see paragraphs 119 and 271 to 278).

Section 801(a)
801(d)
802
Annex C of the
Administrative

119D. How must a sequence listing part filed on an electronic medium in computer readable form under Section 801 be presented? Any sequence listing part in

Instructions

computer readable form must be filed on an electronic medium specified by the receiving Office; if it is not, the Office will invite the applicant to furnish a replacement on a specified medium. The sequence listing part must comply with the standard provided for in Annex C of the Administrative Instructions (see paragraphs 272 to 275). In addition, the label provided for in that Annex (see paragraph 275) must indicate that the sequence listing part is filed under Section 801(a). If the sequence listing part is contained on more than one electronic carrier, each carrier should be numbered (for example, “DISK 1/3,” “DISK 2/3,” “DISK 3/3”). Where more than one copy of the sequence listing part is filed, each copy must be numbered (for example, “COPY 1/3,” “COPY 2/3,” “COPY 3/3”). Where a replacement sequence listing part containing a relevant correction, rectification or amendment is furnished in computer readable form, the label must be marked accordingly (for example, “SUBMITTED FOR CORRECTION”).

Section 802(a)
806

119E. Will all designated Offices accept, for the purposes of the national phase, an international application containing a sequence listing part of the description filed only on an electronic medium in computer readable form under Section 801? Where the sequence listing part of the description is filed only on an electronic medium in computer readable form under Section 801, any designated Office which does not accept the filings of sequence listings in computer readable form may require that the applicant furnish to it, for the purposes of the national phase, a copy of such sequence listing part on paper in written form. The listing on paper must comply with the standard provided for in Annex C of the Administrative Instructions (see paragraphs 272 to 275); it must also be accompanied by a statement that the sequence listing part in written form is identical to the sequence listing part in computer readable form.

Rule 11
Section 109

120. What are the physical requirements for the description? Rule 11 lists the physical requirements which have to be met by an international application. The paper must be of A4 size, white and durable. The minimum margins must be 2 cm on the top, the bottom and the right side of the

sheet, and 2.5 cm on the left side of the sheet. The margins should not exceed 3 cm on the bottom and the right side of the sheet and 4 cm on the top and the left side of the sheet. The margins must be completely blank, except that a file reference not exceeding 12 characters in length may be placed by the applicant in the left-hand corner of the top margin within 1.5 cm from the top of the sheet.

Rule 11.7
11.8
Section 207

121. How should the pages and lines be numbered? The page number must be centered at the top or bottom of the sheet, but not in the 2 cm margin (that is, a page number, if at the top of the sheet, must be below the 2 cm margin, and if at the bottom of the sheet, above the 2 cm margin). It is strongly recommended that every fifth line of each sheet be numbered in the right half of the left margin. The description must be typewritten or printed. The typing must be 1½ spaced and in dark indelible color so as to permit direct reproduction. The capital letters of the characters must be a minimum of 0.21 cm high.

Rule 11.9(b)
11.10(b)

122. How are chemical or mathematical formulae to be represented? The description, the claims and the abstract may contain chemical or mathematical formulae. Such formulae may be written by hand or drawn if necessary but it is recommended that appropriate drafting aids or materials such as stencils or transfers be used. For practical reasons formulae may be grouped together on one or more sheets in the description and paginated with it. It is recommended in such cases that each formula be designated by a reference sign and the description should contain references to such formulae whenever necessary. Chemical or mathematical formulae may also be grouped together and be placed after the claims as drawings. In such a case, the chemical or mathematical formulae must be drawn to comply with the requirements for drawings and the sheets must be numbered as drawing sheets (see paragraph 172).

Rule 11.9(b)
11.13(h)

123. Chemical or mathematical formulae must employ symbols in general use and must be drawn in such a way that they are completely unambiguous. Numerals, letters and signs which are not typed must be legible and identical in form in the various formulae, irrespective of the element of the

international application in which they appear. Chemical or mathematical formulae appearing in the text of the international application must have symbols the capital letters of which are at least 0.21 cm high. Where they appear on sheets of drawings, these symbols must be at least 0.32 cm high. All mathematical symbols used in a formula which appear in a description or on sheets of drawings should be explained in the description, unless their significance is clear from the context. In any case, the mathematical symbols used may be collated in a list.

Rule 11.10(c)
and(d)

124. How are tables to be represented? For the sake of convenience, tables may be grouped together in one or more sheets of the description and paginated with it. If two or more tables are necessary, each should be identified by a Roman numeral (independently of the pagination of the description or drawings or of the figure numbering) or by a capital letter, or by a title indicating its contents, or by some other means. Each line and column in a table should begin with an entry explaining what it represents and, if necessary, the units used. As far as possible, all tables should be set out upright on the sheets. Where the tables cannot be presented satisfactorily in an upright position, they may be placed sideways, with the top of the tables on the left-hand side of the sheet.

Rule 91.1

125. How can obvious errors in the description be rectified? The procedure for rectification of obvious errors is explained in paragraphs 443 to 448. The omission of an entire sheet of the description cannot be rectified without affecting the international filing date (see paragraphs 238 and 239). Changes other than the rectification of obvious errors are considered amendments (see paragraph 126).

Article 28
34(2)(b)
41(1)
Rule 52
78

126. Can the description be amended during the international phase? The description can be amended during the international phase only if the applicant files a demand for international preliminary examination (see paragraph 322). The description can also be amended during the national phase before each designated or elected Office (see Volume II). Different provisions apply to amendment of the claims in the international phase—see paragraph 142.

THE CLAIMS

Article 6
11(1)(iii)(e)
Rule 6.1
6.2
6.3
6.4

127. **How must claims be drafted?** The claim or claims must “define the matter for which protection is sought.” Claims must be clear and concise. They must be fully supported by the description. Rule 6 contains detailed requirements as to the number and numbering of claims, the extent to which any claim may refer to other parts of the international application, the manner of claiming, and dependent claims. As to the manner of claiming, the claims must, whenever appropriate, be in two distinct parts; namely, the statement of the prior art and the statement of the features for which protection is sought (“the characterizing portion”).

Rule 6.4(a)

128. In principle, under the PCT, any dependent claim which refers to more than one other claim (“multiple dependent claim”) must refer to such claims in the alternative only, and multiple dependent claims cannot serve as a basis for any other multiple dependent claim. However, the national laws of most Contracting States permit a manner of claiming which is different from that provided for in the preceding sentence, and the use of that different manner of claiming is in principle also permitted under the PCT. For the purposes of those designated States where that different manner of claiming is not permitted, the applicant must decide which drafting style to adopt. If that different manner of claiming is used, amendments may need to be made to the claims during the national phase in those States which do not permit it. Moreover, the national Offices of such States, when they act as International Searching Authorities, may indicate under Article 17(2)(b) that a meaningful search could not be carried out if that different manner of claiming is used (see paragraph 280).

Article 3(4)(iii)
Rule 13

129. **What is meant by the requirement of “unity of invention”?** An international application should be drafted so that the claims relate to only one invention or to a group of inventions so linked as to form a single general inventive concept. This principle is laid down in Rule 13. Observance of this requirement is checked by neither the receiving Office

nor the International Bureau, but it is checked by, and is important to the procedure before, the International Searching Authority (see paragraphs 281 to 287) and the International Preliminary Examining Authority (see paragraph 398), and may be relevant in the national phase before the designated and elected Offices. Since separate searches and examinations are required for distinctly different inventions, additional fees are required if the international search or international preliminary examination is to cover two or more inventions (or groups of inventions linked as just described).

Rule 13.2
13.3
Section 206

130. How is the requirement of unity of invention satisfied? Unity of invention is present only when there is a “technical relationship” among the claimed inventions involving one or more of the same or corresponding “special technical features.” The expression “special technical features” means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The determination whether a group of inventions is so linked as to form a single inventive concept is made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. An initial determination of unity of invention based on the assumption that the claims avoid the prior art will be made before the prior art search but may be reconsidered on the basis of the results of the search. Annex B of the Administrative Instructions contains detailed criteria governing the determination whether an international application complies with the requirement of unity of invention under Rule 13. The following paragraphs set out a summary of some of the more important criteria discussed in that Annex. Illustrations of three particular situations are explained in detail below:

- (i) combinations of different categories of claims (for example—product, process, use, and apparatus or means),
- (ii) so-called “Markush practice,” and
- (iii) the case of intermediate and final products.

131. May different categories of claims be combined in an international application? The method for determining unity of invention contained in Rule 13 is construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, 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, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

132. An apparatus or means is considered to be “specifically designed for carrying out” a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process.

133. What is permitted under the “Markush Practice”? Rule 13.2 also governs the “Markush practice” wherein a single claim defines alternatives of an invention—a common drafting practice for inventions in the chemical field. In this

special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, is considered to be met when the alternatives are of a similar nature.

134. When the Markush grouping is for alternatives of chemical compounds, they are regarded as being of a similar nature where the following criteria are fulfilled:

(i) all alternatives have a common property or activity, and

(ii) (a) a common structure is present—that is, a significant structural element is shared by all of the alternatives, or

(b) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

135. When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention will be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity will be raised.

136. **Can both intermediate and final products be claimed?** The situation involving intermediate and final products is also governed by Rule 13.2. The term “intermediate” is intended to mean intermediate or starting products. Such products have the ability to be used to produce final products through a physical or chemical change in which the intermediate loses its identity. Unity of invention should be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

(i) the intermediate and final products have the same essential structural element, in that:

(a) the basic chemical structures of the intermediate and the final products are the same, or

(b) the chemical structures of the two products are

technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(ii) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

137. Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known—for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there must be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

Article 2(x)
27(1)
Rule 13

138. An international application which complies with the unity of invention requirements laid down in Rule 13 must be accepted by all the designated and elected Offices, since Article 27(1) does not allow any national law (as defined in Article 2(x)) to require compliance with requirements relating to the contents of the international application different from or additional to those provided for in the PCT.

Rule 11
11.4(a)

139. **What are the physical requirements for the claims?** The physical requirements are the same as those for the description as outlined in paragraph 120. Note that the claims must commence on a new sheet.

Rule 11.10(c)

140. **May claims include tables?** The claims may include tables if this is desirable in view of the subject matter involved. In this case, the tables must be included in the text of the relevant claim; they may not be annexed to the claims nor may reference be made to tables contained in the description (see paragraph 124).

Rule 91.1

141. How can obvious errors in the claims be rectified?
The procedure for rectification of obvious errors is explained in paragraphs 443 to 448. The omission of an entire sheet of the claims cannot be rectified without affecting the international filing date (see paragraphs 238 and 239). It is recommended that a request for rectification of obvious errors in the claims be made only if the error is liable to affect the international search; otherwise, the rectification should be made by amending the claims (see paragraph 142).

Article 19
28
34(2)(b)
41(1)

142. Can the claims be amended during the international phase? Yes, the claims may be amended under Article 19 on receipt of the international search report (see paragraphs 296 to 303); they may also be amended during international preliminary examination if the applicant has filed a demand (see paragraphs 345 and 393) and during the national phase (see Volume II).

THE DRAWINGS

Article 3(2)
7
Rule 7.1

143. When is the inclusion of drawings required in the international application? The international application must contain drawings when they are necessary for the understanding of the invention. Moreover where, without drawings being actually necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings, the applicant may include such drawings and any designated Office may require the applicant to file such drawings during the national phase.

Rule 7.1

144. Perspectives, exploded views, sections and cross-sections, and details on a different scale are all considered to be drawings. Drawings also cover flow sheets and diagrams, such as functional diagrams and graphic representations of a given phenomenon which express the relationship between two or more parameters.

Rule 11.10

145. Where chemical or mathematical formulae and tables are included in the description, claims or abstract, they are not considered to be drawings and are thus not subject to the same requirements as drawings (see paragraphs 146 to 148).

However, such graphic forms may be submitted as drawings, in which case they are subject to the same requirements as drawings.

Rule 11.10
11.11
11.13

146. **How must the drawings be presented?** Drawings must be presented on one or more separate sheets. They may not be included in the description, the claims or the abstract. They may not contain text matter, except a single word or words when absolutely indispensable. Rules 11.10 to 11.13 contain detailed requirements as to further physical requirements of drawings. Any drawing meeting those requirements must be accepted in the national phase by the designated Offices. Drawings newly executed according to national standards may not be required during the national phase if the drawings filed with the international application comply with Rule 11. A file reference may be indicated on each sheet of the drawings as for the description (see paragraph 120).

Rule 11.2(a)

147. The drawings must be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset and microfilming, in any number of copies.

Rule 11.2(a)
11.2(b)
and (c)
11.3
11.5
11.6(c)
11.12

148. Drawings must be on sheets of A4 paper (29.7 cm x 21 cm) which must be flexible, strong, white, smooth, non-shiny and durable. The sheets must be free from creases and cracks; they must not be folded. Each sheet must be reasonably free from erasures and must be free from alterations, overwriting and interlineations. Only one side of each sheet may be used. The usable surface of sheets must not exceed 26.2 cm x 17.0 cm. The sheets must not contain frames around the usable surface. The minimum margins which must be observed are: top and left side: 2.5 cm; right side: 1.5 cm; bottom: 1.0 cm.

Rule
11.10(d)
11.13(j)

149. **Should figures of drawings be arranged in a particular manner?** All the figures constituting the drawings must be grouped together on a sheet or sheets without waste of space, but clearly separated from each other. However, figures should not be separated by lines.

Rule
11.10(d)
11.13(j)

150. As far as possible, all figures of the drawings should be set out upright on the sheets. Where the drawings cannot be presented satisfactorily in an upright position, they may be

placed sideways, with the tops of the drawings on the left-hand side of the sheet. Thus, a figure which is broader than it is high, may be set out so that the bottom of the figure lies parallel to and along the right-hand side of the sheet. In this case, if other figures are drawn on the same sheet, they should be set out in the same way, so that all the figures on a single sheet lie in the same position. Similar considerations apply to tables and chemical and mathematical formulae (see paragraphs 122 and 124).

151. The drawings should contain as many figures as may be necessary to adequately show the claimed invention. The views may be plan, elevation, section, or perspective views; detail views of portions or elements, on a larger scale if necessary, may be used. Exploded views, with the separated parts of the same figure embraced by a bracket, to show the relationship or order of assembly of various parts, are permissible. One figure should not be placed upon or within the outline of another figure.

152. Where an invention concerns improvements to details of existing devices and machines, a general figure may be desirable to indicate where on the device or machine the improvement is situated, in order to ensure that the drawings are readily understood. If, for example, the invention relates to the fixing of an elastic diaphragm in a diaphragm pump, a figure—generally the first—may represent the entire pump, as improved by the invention, the details of which will then be given in the other figures. On the other hand, it would be unnecessary to represent the entire machine comprising this diaphragm, for example the automobile in which the diaphragm pump circulates the fuel.

153. It is sufficient to choose the views which are the most representative and contain the minimum of hidden parts, so that the object is completely and unambiguously defined by means of the smallest possible number of views. To this end, it is sometimes sufficient to replace the various views of an object by a single perspective view. The simplest view compatible with the desired result should be chosen.

Rule 11.13(i) 154. Where figures on two or more sheets form in effect a

single complete figure, the figures on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the figures appearing on the various sheets. Partial figures drawn on separate sheets must always be capable of being linked edge to edge, that is to say, no partial figure may contain parts of another partial figure. A very long figure may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous. It is therefore recommended that a smaller scale figure be included showing the whole formed by the partial figures and indicating the positions of the parts shown.

Rule 11.7
Section
207(b)

155. **How must drawings be numbered?** All sheets of drawings must be numbered in the center of either the top or the bottom of each sheet but not in the margin (as for the sheets of the description—see paragraph 121) in numbers larger than those used as reference signs in order to avoid confusion with the latter. For drawings, a separate series of numbers is to be used (see paragraph 53). The number of each sheet of the drawings must consist of two Arabic numerals separated by an oblique stroke, the first being the sheet number and the second being the total number of sheets of drawings. For example, “2/5” would be used for the second sheet of drawings where there are five sheets in all and “1/1” would be used in the case of a single sheet.

Rule
11.13(k)
49.5(f)

156. Different figures on the sheets of drawings must be numbered in Arabic numerals consecutively and independently of the numbering of the sheets and, if possible, in the order in which they appear. The numbers of the figures should be preceded by the expression “Fig.,” whatever the language of the international application. Where a single figure is sufficient to illustrate the claimed invention, it should not be numbered and the abbreviation “Fig.” should not appear. Numbers and letters identifying the figures must be simple and clear and may not be used in association with brackets, circles, or inverted commas, except as regards partial figures intended to form one complete figure, irrespective of whether they appear on one or several sheets. In this case the complete figure may be identified by the same

number followed by a capital letter (for example, Fig. 7B).

157. The different figures should preferably be set out, as far as possible, on each sheet in ascending numerical order from left to right and from top to bottom. If one of two figures illustrates on a larger scale a detail from the other, each figure should be numbered separately, and if possible, consecutively.

Rule 11.13

158. **How should drawings be executed?** The drawings must be executed in durable, black, uniformly thick and well-defined lines and strokes. In all cases, the thickness of the lines and strokes must take into account the scale, nature, execution and perfect legibility of the drawing and of the reproductions. All lines in the drawings must, ordinarily, be drawn with the aid of a drafting instrument, except those which by their nature do not permit the use of such instruments, for example, irregular diagrams, ornamental structures and curved reference lines (see paragraph 160).

159. **May lines of different thicknesses be used in the same drawing?** Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning. One could, for instance, use:

- a continuous thick line for edging and outlining views and cross-sections;
- a continuous thin line for reference lines (see paragraph 160 for further details), hatching, outlining parts of adjoining elements, fictitious lines of intersection of surfaces connected by curved or rounded edges;
- a continuous thin line drawn freehand for delimiting views, part sections or interrupted views;
- a thin broken line made up of short dashes for hidden edges and contours;
- a dot-dash thin line for axes and planes of symmetry, extreme positions of movable elements, in front of a cross-section;
- a thin line terminating in two thick lines for outlines of cross-sections.

160. **How should reference lines be shown?** Reference lines (also referred to as leading lines), that is, lines between

the reference signs (for example, reference numerals) and the details referred to, may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference sign and extend to the feature indicated. Reference lines for certain reference signs may be omitted. Reference signs of this type, which are not connected to anything, will then indicate the surface or cross-section on which they are placed. In such cases the reference sign may be underlined to make it quite clear that the line has not been left out by mistake. Reference lines must be executed in the same way as other lines in the drawing (see paragraph 158).

161. Arrows may be used at the end of the reference lines provided that their meaning is clear. They may indicate a number of points:

(a) a freestanding arrow indicates the entire section towards which it points;

(b) an arrow touching a line indicates the surface shown by the line looking along the direction of the arrow;

(c) arrows may also be used in appropriate cases to show the direction of movement.

Rule
11.13(b)

162. **How are cross-sections to be represented?** In making and representing cross-sections, certain conditions must be observed with regard to the indication and identification of the figures concerned and how they are to be represented, as more fully explained in paragraphs 163 and 164.

163. Where a figure is a cross-section on another figure, the latter should indicate the position of the section and may indicate the viewing direction by arrows at each end. In addition, in order to allow each sectional figure to be quickly identified, especially where several cross-sections are made on the same figure, each end of the cross-section line should be marked on the diagram with the same single Arabic or Roman numeral which identifies the figure in which the section is illustrated. A cross-section represents that part of an object which is situated on a cutting surface. In industrial drawings, the cross-section is that part of the object which is behind the cutting surface from the point of view of the person looking at it. Cutting surfaces are generally plane

surfaces and if they are not, they must be defined precisely. Cross-sections must always follow the cutting surface, whatever it may be.

164. A cross-section must be set out and drawn in the same manner as a normal view whose parts in cross-section are hatched with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. Hatching should not impede the clear reading of the reference signs and reference lines. Consequently, if it is not possible to place reference signs outside the hatched area, the hatching may be broken off wherever reference signs are inserted. Certain types of hatching may be given a specific meaning. The hatching should be at a substantial angle to the surrounding axes or principal lines, preferably 45°. The various parts of a cross-section of the same item should be hatched in the same manner. The hatching of juxtaposed different elements should be angled in a different way. In the case of large areas, hatching can be confined to an edging drawn around the inside of the outline of the area to be hatched.

Rule 11.13(c) 165. **What should be the scale of figures of the drawings?**

The scale of the figure should be such that all the essential details can be clearly distinguished in a linear reduction in size to two-thirds. In exceptional cases, where required, the scale of the drawing may be graphically represented. Indications such as “actual size” or “scale ½” on the drawings or in the description, are not permitted, since these lose their meaning with reproduction in different format.

Rule
11.13(g)

166. Each element of each figure must be in proportion to each of the other elements in the figure, except where the use of a different proportion is indispensable for the clarity of the figure. As a preferred alternative to a difference in proportion within one figure for the purpose of achieving the necessary clarity, a supplementary figure should be added giving a larger scale illustration of the element of the initial figure. In such cases, it is recommended that the enlarged element shown in the second figure be surrounded by a finely drawn or “dot-dash” circle in the first figure pinpointing its location without obscuring the figure.

- Rule 11.13(e) 167. **How should numbers, letters, reference signs and like indications be presented and applied to drawings?**
Numbers, letters and reference signs and any other data given on the sheets of drawings, such as the numbering of figures, and of the sheets of the drawings, acceptable text matter, graduations on scales, etc., must be simple and clear, and not used in association with any brackets, inverted commas, circles or outlines whatsoever. Signs indicating minutes, seconds or degrees are permitted. Numbers, letters and reference signs should be laid out in the same direction as the diagram so as to avoid having to rotate the sheet. Such numbers, letters and reference signs should not be so placed in the closed and complex parts of the drawings as to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. As a general rule, numbers, letters and reference signs should be placed as closely as possible to the part in question.
- Rule 11.13(h) 168. A minimum size of 0.32 cm is required for all numbers and letters used on the drawings so that their reduction in size to two-thirds remains easily legible. The Latin alphabet should normally be used for letters. The Greek alphabet is to be accepted, however, where it is customarily used, for example, to indicate angles, wavelengths, etc.
- Rule 11.13(l) 169. Reference signs are to be used in a manner which is consistent as between the description, claims and drawings. In particular, reference signs not mentioned in the description must not appear in the drawings, and vice versa. Features of a drawing should not be designated by a reference sign in cases where the feature itself has not been described. This situation may arise as a result of amendments to the description involving the deletion of pages or whole paragraphs. One solution would be to delete reference signs on the drawing which have been deleted in the description. Where for any reason a figure is deleted, all reference signs relating solely to that figure appearing in the description and claims should also be deleted.
- Rule 11.13(m) 170. The same features, when denoted by reference signs, must, throughout the international application, be denoted by the same signs. However, where several variants or

embodiments of a claimed invention are described, each with reference to a particular figure, and where each variant contains features whose function is the same or basically the same, the features may, if this is indicated in the description, be identified by reference numbers made up of the number of the figure to which it relates followed by the number of the feature, which is the same for all variants, so that a single number is formed. For example, the common feature “15” would be indicated by “115” in Fig. 1, while the corresponding feature would be indicated by “215” in Fig. 2, thereby allowing the individual feature and the figure on which it is to be considered to be indicated at the same time. Complex cases involving many pages of drawings may be made easier to read if, when the individual variants or embodiments are described with reference to particular groups of figures, the common reference sign is prefixed by the number of the particular variant or embodiment to which it relates; however, this should, if used, be explained in the description.

Rule 11.11 171. **May drawings contain text matter?** The drawings must not contain text matter, except a single word or words when absolutely indispensable, such as “water,” “steam,” “open,” “closed,” “section on AB” and in the case of electric circuits and block schematic or flow sheet diagrams, a few short catch words indispensable for understanding. Any words used must be so placed that if translated, they may be pasted over without interfering with any lines of the drawings.

Rule 10.1(d) and (e) 172. **May symbols be used in drawings?** Known devices may be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art provided no further detail is essential for understanding the subject matter of the claimed invention. Other signs and symbols may be used provided that they are not likely to be confused with existing conventional symbols, that they are readily identifiable, that is, simple, and providing that they are clearly explained in the text of the description. Different types of hatching may also have different conventional meanings as regards the nature of a material seen in cross-section.

173. **Is the use of shading permitted?** The use of shading in figures is allowed provided this assists in their understanding and is not so extensive as to impede legibility. Shading may, for instance, be used to indicate the shape of spherical, cylindrical, conical elements, etc. Flat parts may also be lightly shaded. Such shading is allowed in the case of parts shown in perspective but not for cross-sections. Only spaced lines may be used for shading, not fully blacked out areas. These lines must be thin, as few in number as possible and they must contrast with the rest of the drawings.

174. **May a photograph be presented instead of a drawing?** The PCT makes no provision for photographs. Nevertheless, they are allowed where it is impossible to present in a drawing what is to be shown (for instance, crystalline structures). Where, exceptionally, photographs are submitted, they must be black and white, must be on sheets of A4 size, and must respect the minimum margins (see paragraph 148) and admit of direct reproduction. Color photographs are not accepted, nor are color drawings. Photographs are retained by the International Bureau as part of the record copy.

Rule
11.13(n)

175. **May a list of reference signs used in the drawings be included in the description?** In the case of international applications dealing with complex subjects and incorporating a large number of drawings, a separate sheet listing all reference signs may be included at the end of the description as a part thereof. This list may take whatever form is appropriate and contain all the reference signs together with the designation of the features which they denote. This method could have the advantage of allowing an easier reference to the meaning of the various reference signs employed and understanding of the drawings.

Rule 91.1

176. **How can obvious errors in the drawings be rectified?** The procedure for rectification of obvious errors is explained in paragraphs 443 to 448. The omission of an entire sheet of drawings cannot be rectified without affecting the international filing date (see paragraphs 238(b) and 239). Changes other than the rectification of obvious errors are considered amendments (see paragraph 177).

Article 28
34(2)(b)
41(1)

177. **Can the drawings be amended during the international phase?** The drawings can be amended during the international phase only if the applicant files a demand for international preliminary examination (see paragraph 322). The drawings can also be amended during the national phase (see Volume II).

178. As regards the figure or, exceptionally, figures to accompany the abstract, see paragraph 186.

THE ABSTRACT

Article 3(3)
14(1)(a)(iv)
Rule 8

179. **How must the abstract be drafted?** The abstract must consist of a summary of the disclosure as contained in the description, the claims and any drawings. Where applicable, it must also contain the most characteristic chemical formula. The abstract must be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English). As a rule of thumb, it can be said that the volume of the text of the abstract, including one of the figures from the drawings (if any), should not exceed what can be accommodated on an A4 sheet of typewritten matter, 1½ spaced. The other physical requirements must correspond to those for the description, outlined in paragraph 120. The abstract must be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art. These and other requirements concerning the abstract are spelled out in detail in Rule 8.

180. The abstract should be primarily related to what is new in the art to which the invention pertains. Phrases should not be used which are implicit (for instance, “the invention relates to ...”).

181. If the invention is in the nature of a modification to an apparatus, process, product or composition, the abstract should be directed to the technical disclosure of the modification. If the invention is of a basic nature, the entire technical disclosure may be new in the art and the abstract should be directed to the entire disclosure. If an international application relating to a product, particularly a compound or composition, also contains significant disclosure of its method

of preparation or use, this matter should also be abstracted. If the disclosure involves alternatives, the abstract should deal with the preferred alternative and identify the others if this can be done succinctly; if this cannot be done, it should mention that they exist and whether they differ substantially from the preferred alternative.

182. Where applicable, and provided the international application contains the information, the abstract should include at least the following: (1) if the invention is a machine, apparatus, or system, its organization and operation; (2) if the invention is an article, its method of making; (3) if the invention is a chemical compound, its identity and preparation; (4) if the invention is a mixture, its ingredients; (5) if the invention is a process, the steps. Extensive mechanical and design details of apparatus should not be given.

Rule
8.1(a)(ii)

183. With regard particularly to chemical inventions for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof, for example, “the compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics.” Exemplification of a class should be by a typical example. For processes, the type of reaction, reagents and process conditions should be stated, generally illustrated by a single example. Wherever applicable, the chemical formula should be given which, among all the formulae contained in the international application, best characterizes the invention.

Rule 8.1(c)

184. The abstract must not contain statements on the alleged merits or value of the claimed invention or on its speculative application.

Rule
3.3(a)(iii)
8.2

185. **When must a figure be suggested to accompany the abstract?** Where the international application contains drawings, the applicant must indicate, in the check list of the request, the number of the figure in the drawings which the applicant suggests should be published with the abstract. Reference is made to the PCT International Search Guidelines, Chapter XI, paragraph XI-5.

186. The figure illustrating the abstract must be the figure

which best characterizes the claimed invention and must be chosen from the drawings accompanying the international application. Only one figure should be indicated. The abstract may exceptionally be illustrated by more than one figure. If none of the figures is found useful for the understanding of the abstract, no figure need be indicated in the check list. The figure or figures that will accompany the abstract at the time the international application is published may not be included in the abstract.

Section 207 187. The abstract must be presented on a separate sheet which must appear after the claims and be numbered accordingly (see paragraph 53).

Article 14(1)(a)(iv) and (b)
Rule 26
38.2 188. **What happens if the abstract is missing or defective?** Where the receiving Office finds that the abstract is missing, it invites the applicant to furnish it within a time limit fixed in the invitation. The international application is considered withdrawn if no abstract is furnished to the receiving Office within the time limit fixed. Where the receiving Office has not invited the applicant to furnish an abstract, the International Searching Authority establishes one. The same applies where the abstract does not comply with the requirements outlined in the preceding paragraphs (see also paragraph 288). Where the abstract is established by the International Searching Authority, the applicant may submit comments on it within one month from the date of mailing of the international search report.

OTHER FORMAL REQUIREMENTS

Article 21(6)
Rule 9 189. **What other formal requirements does the international application have to meet?** The international application may not contain matter contrary to morality or public order, disparaging statements or obviously irrelevant or unnecessary matter. The details are set out in Rule 9.

Rule 10 190. There are certain requirements as to the technical terminology and signs to be used (metric system, etc.). They are specified in Rule 10. The use of such prescribed technical terminology will be accepted by all designated Offices.

Article 191. The international application must comply with certain

- 3(4)(ii)
14(1)(a)(v)
Rule 11
- physical requirements, such as requirements concerning fitness for reproduction, the paper to be used, the manner of writing (generally typewritten or printed), etc. The details are spelled out in Rule 11. They are, in general, very similar to the requirements applied by the major Patent Offices for national applications (and by the Eurasian Patent Office and the European Patent Office for Eurasian and European patent applications, respectively).
- Rule 4.16
192. Where any name or address is written in characters other than those of the Latin alphabet (for example, Chinese, Cyrillic or Japanese), it must be transliterated or translated into English. For details, see Rule 4.16.
- Rule 11.1(a)
and (b)
21
193. **In how many copies must an international application be filed?** An international application, and, where applicable, a translation of the international application, must be filed in one, two or three copies, depending on the requirements of the receiving Office. Annex C contains the relevant information. See also Rule 21.
- Article 12
Rule 21.1
22.1(a)
23.1(a)
Section 305
194. It is to be noted that there must eventually be three copies of every international application: one is kept by the receiving Office (the “home copy”), one is transmitted by the receiving Office to, and is kept by, the International Bureau (the “record copy”), and one is transmitted by the receiving Office to, and kept by, the International Searching Authority (the “search copy”). If less than the required number of copies is filed by the applicant (see paragraph 193), the receiving Office is responsible for preparing the additional copies and may charge a fee to the applicant.
- Rule 12
12.3
Rule 21.1
22.1(a)
23.1(a)
Section
305*bis*
195. Where the international application was filed in a language which is accepted by the receiving Office but not by the International Searching Authority which is to carry out the international search, the applicant has to furnish a translation of the international application (see paragraphs 229 to 236 for details). In that case, the receiving Office forwards, of the international application in the language of filing, a copy to the International Bureau (the “record copy”), and retains one copy (the “home copy”). When the receiving Office receives the translation of the international application, it forwards one

copy to the International Bureau (the “record copy—translation (Rule 12.3)”), keeps one copy for its files (the “home copy—translation (Rule 12.3)”) and forwards the third copy, together with a copy of the request (the “search copy—translation (Rule 12.3)”) to the International Searching Authority. If the translation is filed by the applicant in fewer than the required number of copies (see paragraph 193), the receiving Office is responsible for preparing the additional copies and may charge a fee to the applicant.

Section 420 196. Where the International Preliminary Examining Authority is not part of the same national Office or intergovernmental organization as the International Searching Authority, the International Bureau will, promptly upon receipt of the international search report or, if the demand was received after the international search report, promptly upon receipt of the demand, send a copy of the international application and the international search report to the International Preliminary Examining Authority. Where neither the language in which the international application was 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 must furnish with the demand a translation of the international application into a language which is both a language accepted by that Authority and a language of publication. No such translation is required where the International Searching Authority and the International Preliminary Examining Authority are part of the same national Office or intergovernmental organization. In cases where, instead of the international search report, a declaration under Article 17(2)(a) was issued, references in the preceding sentences to the international search report shall be considered references to the said declaration.

FEES

Article 3(4)(iv) 197. **What fees are due in respect of an international application?** There are three kinds of fee which must be paid in connection with every international application.

- Rule 14 (a) The “transmittal fee” is fixed by, and accrues to, the receiving Office for the performance of its tasks in connection with the receipt and checking of the international application, and for the transmittal of copies of it to the International Bureau and the International Searching Authority.
- Rule 16.1 (b) The “search fee” is fixed by, and accrues to the benefit of, the International Searching Authority for the carrying out of the international search and the establishment of the international search report.
- Rule 15.1 (c) The “international fee” is fixed in the Schedule of Fees annexed to the PCT Regulations and accrues to the International Bureau for the performance of various tasks, including the publication of the international application and the communication of various notifications to the applicant, the receiving Office, the International Searching Authority, the International Preliminary Examining Authority, and the designated and elected Offices. The international fee comprises the “basic fee” and “designation fees.”
- 96 (i) The “basic fee” consists of a fixed amount plus an additional amount for each sheet in the international application in excess of 30 sheets (counting the request but not the fee calculation sheet). For the basic fee payable where the sequence listing part of the description of an international application is filed on an electronic medium, see paragraph 119C.
- Section 210 (ii) As many designation fees are payable as there are specific designations (see paragraph 87 for the meaning of “specific” designation) in the international application for the purposes of a national (or regional) patent. Only one designation fee is due in respect of a designation
- 803

for an ARIPO patent, a Eurasian patent, a European patent or an OAPI patent, regardless of the number of States designated in the request for the purposes of such a patent. Where a Contracting State is designated twice (for instance, for both European and national protection), two designation fees are due for that State. As a rule of thumb for the computation of the designation fees, it can be said that the number of designation fees is equal to the number of designated Offices resulting from the specific designations and thus to the number of check-boxes marked in the main sub-box of Box No. V of the printed request form (see paragraphs 87 and 88). The maximum amount due, however, is five designation fees (effective as of January 1, 2002). All further specific designations for which a designation fee is due are free of charge (for the confirmation of precautionary designations see paragraph 198).

Rule 4.9(c) 198. Different provisions for fee payment apply at a later
15.5 stage to precautionary designations (see paragraphs 91 and 92); no fees are due for such designations at the time of filing of the international application. Fees are payable in respect of such designations only if and when they are later confirmed—see paragraphs 261 to 266 for details of the manner of confirmation and the fees payable. Note that the maximum payment of five designation fees does not apply to precautionary designations; a designation fee and a confirmation fee are payable for each precautionary designation confirmed.

Rule 14.1(a) 199. **To whom are the fees payable?** All three kinds of fee
15.1 referred to in paragraph 197 are payable to the receiving
16.1(b) Office with which the international application is filed. The receiving Office then transmits the search fee to the International Searching Authority and the international fee to the International Bureau.

- Rule 14.1(b) 200. **What is the currency in which the fees are payable?**
15.2 Generally, the fees referred to in paragraph 197 are payable in
16.1(b) the currency of the country in which the receiving Office is
located. Complete information on this question is contained in
Annex C and, for the search fee, Annex D.
- Rule 14.1(b) 201. **What are the amounts of the fees?** Annex C and, for
15.2 the search fee, Annex D indicate the amounts of the fees
16.1(a) referred to in paragraph 197. Where the applicant has the
choice between two or more International Searching
Authorities (see paragraph 268), the amount of the search fee
depends on which International Searching Authority is chosen
and indicated in Box No. VII of the request form (see
paragraphs 101 and 112) and in the fee calculation sheet (see
paragraph 112).
202. **What fee reductions are available?** 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 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) is entitled, in accordance with the Schedule of
Fees annexed to the PCT Regulations, to a reduction of 75%
of certain fees including the international fee (basic fee and
designation fees). However, an applicant who qualifies for the
75% reduction in the international fee will not have to pay the
transmittal fee in respect of an international application filed
with the International Bureau as receiving Office. If there are
several applicants, each must satisfy the above-mentioned
criteria. The reduction of those fees will be automatically
available to any applicant (or applicants) who is (or are) so
entitled on the basis of the indications of name, nationality
and residence given in the request. The fee reduction will be
available even if one or more of the applicants are not from
PCT Contracting States, provided that each of them satisfies
the above-mentioned criteria and that at least one of them is a
national or resident of a PCT Contracting State and thus is
entitled to file an international application. The PCT
Contracting States whose nationals and residents are eligible
for the fee reduction, as outlined above, are listed in

Annex C (IB). As far as other States are concerned, inquiries should be addressed to the International Bureau.

Rule 89^{ter}
Section
102(i)

202A. An applicant who files an international application is entitled to a reduction in the international fee provided that:

(i) the request is presented as a computer print-out prepared using the PCT-EASY software (“request in PCT-EASY format”);

(ii) the request in PCT-EASY format is filed together with a computer diskette, prepared using the PCT-EASY software, containing a copy in electronic form of the data contained in the request and of the abstract (“PCT-EASY diskette”); and

(iii) the international application is filed with a receiving Office which is prepared to accept the filing of international applications containing the request in PCT-EASY format together with the PCT-EASY diskette.

The reduction is 200 Swiss francs or the equivalent in the currency in which the international fee is paid to the receiving Office. See paragraphs 219A, 223A, 240A and 497 to 504 for further details about the use of the PCT-EASY software.

203. Similarly, a reduction of the search fee charged by certain International Searching Authorities may be available to applicants from the States mentioned in paragraph 202—see Annex D for details.

Rule 14
15.4
16.1(f)

204. **When are the fees due?** All fees referred to in paragraph 197 may be paid at the same time, and, if they are paid upon filing of the international application by the receiving Office, no problems can arise. However, all fees can be paid as much as one month from the date of receipt of the international application by the receiving Office, and in certain cases the designation fee part of the international fee can be paid even later (see paragraph 205). The dates on which payments are deemed to have been received are determined by the receiving Office. The latter applies the

same rules as are applied in the case of payments for national applications.

- Rule 15.4(b) 205. For the due date of the designation fee payable in respect of specific designations, a distinction has to be made between two cases:
- (i) where the international application does not contain a priority claim, the designation fee must be paid within one year from the date of receipt of the international application;
 - (ii) where the international application contains a priority claim, the designation fee must be paid within one year from the priority date or within one month from the date of receipt of the international application, whichever expires later.

- Rule 4.9(b) and (c) 15.5 206. **When are the fees for confirming precautionary designations due?** The designation and confirmation fees payable for confirming precautionary designations (see paragraphs 91 and 92) must be paid, if any of those designations are to be confirmed, before the expiration of 15 months from the priority date (see paragraphs 261 to 266 for an explanation of that procedure).
207. **What are the advantages of the possibility of paying the designation fee within the one-year period?** Where the applicant, at the time of filing the international application, cannot determine with precision in what countries he will eventually seek protection for the invention claimed in the international application, he can designate at the time of filing—at no cost at that time—not only those States where he is sure that he wants protection but also those States in respect of which he has doubts, or even all Contracting States. A selection from the designated States can be made at the end of the one-year period by the payment of only those designation fees that correspond to the specific designations which the applicant wants to pursue. The applicant must then clearly identify, at the time of payment, the specific designations for which the designation fees are paid. At the same time, the applicant should consider withdrawing the other specific

designations (see paragraph 454) in order to avoid any unnecessary work, for both himself and the receiving Office, arising from the procedure under Rule 16*bis* outlined in paragraph 211. Another advantage is that, where the international application does not contain any priority claim or is filed within five months from the priority date, the applicant receives the international search report before the due date for payment of the designation fees. If that report shows that there is no chance, or only a slight chance, of obtaining valid protection for the invention, the applicant may decide to withdraw the application and thus completely avoid the payment of the designation fees, which—depending on the number of specific designations—may save a lot of money.

208. The system of precautionary designations outlined at paragraphs 261 to 266 enables designations to be confirmed even after the one-year period. However, the confirmation of precautionary designations attracts additional fees compared with specific designations. The precautionary designation system is designed more particularly for the correction of mistakes made in compiling the original list of specific designations.

Rule 4.9(c)
90*bis*.2

209. **What must be done if the applicant does not want to pay designation fees for all designated States?** Where the applicant has decided, by the time the designation fees are due, not to maintain all specific designations made at the time of filing, those in which he is no longer interested should be withdrawn. (For the manner of withdrawal of specific designations, see paragraph 454.) The applicant should also, when paying the designation fees to the receiving Office, indicate the specific designations for which the designation fees are intended. This may be done either on the fee calculation sheet (see paragraph 112) or in a separate notification together with the withdrawal of the designations which the applicant wishes to abandon. Failure to expressly withdraw any of the specific designations in respect of which the applicant does not wish to pay designation fees will result in the sending of an invitation to the applicant to pay the missing amount (see paragraphs 211 and 213). Precautionary

designations, however, will lapse automatically unless they are confirmed (see paragraphs 261 to 266). They need not be expressly withdrawn and are not subject to the invitation procedure just mentioned.

Rule 15.4(a)
to (c)

210. What happens if the amounts of the fees are changed? Where the amount of the international fee or of the search fee, in the currency in which the fee is payable, changes, the new amount must be paid as from the date of its entry into force. However, where the amount of any such fee changes between the date on which the international application was received and the date of payment, the amount payable, in respect of the basic fee and of the search fee, is the amount applicable on the date of receipt of the international application, and the amount payable in respect of any designation fee paid within one month from the date of receipt of the international application is also the amount applicable on the date of receipt of the international application; in respect of any designation fee (whether it is for a specific or a precautionary designation) paid after the expiration of that one-month period, the amount payable is the amount applicable on the date on which the designation fee is paid. This system allows the applicant to pay all the fees for the international application, within the one-month period, on the basis of the amounts applicable on the date on which the application was filed with the receiving Office.

Rule 16*bis*.1
16*bis*.2

211. What happens if the fees are not paid or not paid in full? Where, within the time they are due, the applicant has not paid any or all of the fees, the receiving Office invites the applicant to pay the missing amount, together with a late payment fee, within a time limit of one month from the date of the invitation. If the applicant pays the amount (including the late payment fee) specified in the invitation, the deficiency in payment has no consequences for the international application. The amount of the late payment fee is 50% of the missing amount or, if that 50% is less than the transmittal fee, an amount equal to the transmittal fee; but the amount of the late payment fee may not exceed the amount of the basic fee (see Annex C).

212. Where, within the time by which they are due, the

applicant has not paid any or all of the fees, any payment relating to the missing amount must be considered to have been received within the time by which those fees are due, if the payment is received by the receiving Office before that Office sends the invitation, referred to in the preceding paragraph, to pay the missing amount.

Article 14(3) 213. If the transmittal fee, the search fee, the basic fee part of the international fee and the designation fee for at least one specific designation are not paid in the prescribed currency and within the prescribed time limits, including the time limit set in the invitation from the receiving Office to pay the missing amount together with the late payment fee (see paragraph 211), the international application is considered withdrawn, and the receiving Office promptly informs the applicant accordingly. However, any payment must be considered to have been received before the expiration of the applicable time limit if it is received by the receiving Office before that Office makes the applicable declaration, under Article 14(3), that the international application is considered withdrawn.

Rule

16bis.1(c)

27.1

29.1

Section 321

214. If the amounts paid cover the transmittal fee, the search fee, the basic fee part of the international fee and the designation fee for at least one designation, but do not cover the designation fees for all the designations, the moneys paid will be allocated among the designations as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions; any designations not covered after such allocation are considered withdrawn by the receiving Office, which promptly notifies the applicant accordingly.

215. It is up to the applicant to take action, if he wishes, to confirm any or all precautionary designations which were made in the request (the procedures and applicable fees are explained at paragraphs 261 to 266). The invitation procedure described in paragraphs 211 and 213 does not apply to precautionary designations.

Rule 15.6

16.2

216. **In what cases are fees refunded?** There is no rule in the PCT concerning the possibility of asking for a refund of

the transmittal fee. The search fee and the international fee (including the basic fee and the designation fees) are refunded where, due to prescriptions concerning national security, the international application is not treated as such, or where the receiving Office refuses to accord an international filing date to the international application under Article 11(1). Such refusal occurs, generally speaking, where the international application is defective in certain respects (see paragraph 222). The receiving Office will also refund the international fee or the search fee to the applicant if the international application is withdrawn or considered withdrawn before the transmittal of the record copy to the International Bureau or the transmittal of the search copy to the International Searching Authority, as the case may be.

Rule 16.3
41.1

217. Most International Searching Authorities will refund part or all of the search fee if the international application is withdrawn or considered withdrawn after transmittal of the search copy but before the start of the international search (see Annex D for details for each International Searching Authority). Moreover, where the international search can be based wholly or partly on an earlier search made by the International Searching Authority, that Authority makes a full or partial refund of the search fee. Particulars of an earlier search on which it is desired that the international search be based should be given in the request (Box No. VII). Details as to the refunds which are given by each of the International Searching Authorities, where the international search can be based on an earlier search, are contained in Annex D.

218. For refunds or reductions of fees in the national phase, see Volume II.

CHAPTER VI

PROCESSING OF THE INTERNATIONAL APPLICATION BY THE RECEIVING OFFICE

GENERAL

219. **What are the main procedural steps at the receiving Office?** The main procedural steps that any international application goes through at the receiving Office are the following:

- | | |
|--|---|
| Article 10 | (i) the international application and the related fees are received by the receiving Office; |
| Article 11(1)
14(1)(a) | (ii) the international application is checked by the receiving Office to determine whether it meets the requirements prescribed by the PCT as to the language, form and contents of international applications (the checks performed by the receiving Office are of a formal nature and do not go into the substance of the invention); |
| Article 11(2)(a)
14(1)(b)
Rule 20.6
26.1(a) | (iii) where the checks made by the receiving Office show that the international application does not meet certain requirements as to fees, language, form and contents, that Office invites the applicant to furnish the necessary corrections; |
| Article 11(1)
11(2)(b)
Rule 20.3
20.4
20.5 | (iv) where—possibly after correction (see paragraphs 237 to 253)—the checks made by the receiving Office show that the international application meets the requirements prescribed for that purpose by the PCT, an international filing date is accorded to the international application by the receiving Office; |
| Article 12
Rule 22
23 | (v) copies of the international application, its translation, where applicable, and other related documents are transmitted by the receiving Office to the International Searching Authority and to the International Bureau so |

that they may carry out the procedural steps for which they are responsible in the further processing of the international application.

Rule 3.1 219A. **What are the additional procedural steps at the**
11 **receiving Office for processing a request prepared using the**
19 **PCT-EASY software?** For those receiving Offices which have
89ter indicated that they are prepared to accept requests in PCT-
EASY format, in addition to those procedural steps listed in
paragraph 219, the receiving Office will review each request
prepared using the PCT-EASY software to ensure that:

- (i) the request is presented as a computer print-out prepared using the PCT-EASY software—that is, the request is in PCT-EASY format;
- (ii) the request is filed together with a computer diskette prepared using the PCT-EASY software; and
- (iii) the computer diskette contains a copy in electronic form of the data contained in the request and the abstract.

See paragraphs 223A, 240A and 497 to 504 for further details about the processing of requests prepared using the PCT-EASY software.

Rule 92.4 220. **How does the international application reach the**
receiving Office? The international application may be deposited with or mailed to the receiving Office. It may also be filed by other means of rapid communication, notably by facsimile machine, provided that the receiving Office places such facilities at the disposal of applicants and that the original is furnished within 14 days, if so required by the receiving Office (see Annexes B1 and B2). The requirements in relation to filing the international application and any subsequent documents by facsimile machine are explained in more detail in paragraphs 469 to 472.

Article 30 221. **Is the international application treated as confidential by the receiving Office?** Yes, it is. Third parties are not permitted to have access to the international application, unless requested or authorized by the applicant, before the date of international publication. Designated Offices are, however,

permitted to publish the fact that they have been designated, together with a limited amount of bibliographic data. For further details as to confidentiality, see Article 30 and paragraphs 474 to 476.

INTERNATIONAL FILING DATE

Article
11(1)
Rule 20.4

222. What are the conditions that must be fulfilled for the international application to be entitled to an international filing date? The receiving Office must accord an “international filing date” to the international application if it finds that the following conditions are fulfilled:

(i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office (see paragraphs 49, 60 and 63);

(ii) the international application is in the prescribed language (see paragraph 223);

(iii) the international application contains at least the following elements:

(a) an indication that it is intended as an international application,

(b) a specific designation (under Rule 4.9(a)—see paragraph 87) of at least one Contracting State,

(c) the name of the applicant (for this purpose it is sufficient if the name of the applicant is indicated in a way which allows his identity to be established, even if the name is misspelled, or the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete),

(d) a part which on the face of it appears to be a description,

(e) a part which on the face of it appears to be a claim or claims.

Article
11(1)(ii)
and (iii)
Rule 12.1
20.4(c)
and (d)

223. For the purposes of according an international filing date, the requirement that the international application be in a prescribed language is met, in most receiving Offices, if the description and claims (but not necessarily the other elements of the international application) are in a language accepted by the receiving Office under Rule 12.1(a) or (c) (see Rule 20.4(c) and paragraph 54). If any of the other elements of the international application are not in a language accepted by the receiving Office, they may be corrected later without affecting the international filing date (see paragraphs 240 and 241). A translation will need to be furnished by the applicant in respect of any international application which is filed in a language which is not a language accepted by the International Searching Authority which is to carry out the international search and/or a language of publication; see paragraphs 229 to 236). In certain Offices, however, Rule 20.4(c) is incompatible with the applicable national law. For as long as that incompatibility continues, that Rule will not apply for those Offices; all elements of an international application filed with those Offices as receiving Office must therefore comply with the language requirements of Rule 12.1 before an international filing date can be accorded (see Annex C for details).

Article
11(1)
Rule 3.1
11.3
20

223A. What is the effect of failing to file a paper copy of the international application when the request is prepared using the PCT-EASY software? A PCT-EASY diskette filed alone—without any corresponding application papers—does not meet the requirements for according an international filing date. The paper form of the international application remains the legally determinative version. Thus, the paper form of the international application which accompanies a request prepared filed using PCT-EASY must contain the required elements in order to receive an international filing date. See paragraph 240A for further details about receiving an international filing date for requests prepared using the PCT-EASY software.

Article
11(1)
11(2)(b)
Rule 20.1
20.2

224. What date is accorded as the international filing date? The reply to this question depends on whether the requirements for according an international filing date (see paragraph 222) were fulfilled on the date on which the international application was received by the receiving Office or—following correction

20.3 of defects in relation to those requirements—on a later date.
20.4 The international filing date will, in the former case, be the date
20.5 on which the international application was received by the
20.6 receiving Office and, in the latter case, the date on which the
correction was received by the receiving Office. Naturally, any
correction has to comply with some conditions; in particular it
has to be filed within a certain time limit. More is said about
this in paragraph 238. Where all the sheets pertaining to the
same international application are not received on the same day
by the receiving Office, see Rule 20.2 and paragraphs 238(b)
and 239.

Article 225. **Does non-payment, incomplete payment or late
11(3) payment of fees influence the international filing date?** The
11(4) reply to this question is in the negative. However, those defects
14(3) will eventually lead the receiving Office to declare that the
Rule 27 international application is, or certain designations are,
considered withdrawn (see paragraphs 213 and 214). Although
an international application which has not been accorded an
international filing date and an international application which
is considered withdrawn are both excluded from further
processing in the international phase, an international
application which fulfills the requirements necessary for it to be
accorded an international filing date may be invoked as a
priority application under the Paris Convention for the
Protection of Industrial Property (if the conditions laid down by
that Convention are fulfilled) even where the international
application is considered withdrawn under the PCT (for non-
payment of fees or other reasons).

Article 226. **Can the receiving Office refuse to treat an
27(8) international application as such for reasons of national
Rule 22.1 security?** Each Contracting State is free to apply measures
Section 330 deemed necessary for the preservation of its national security.
For example, each receiving Office has the right not to treat an
international application as such and not to transmit the record
copy to the International Bureau and the search copy to the
International Searching Authority. Compliance with national
security prescriptions where the international application is
filed with the International Bureau as receiving Office will not
be checked by the International Bureau; such compliance is the

applicant's responsibility. Where an international filing date has been accorded but national security considerations prevent transmittal of the record copy, the receiving Office must so declare to the International Bureau before the expiration of 13, or at the latest 17, months from the priority date.

Rule 20.5(c)
20.7(i)
22.1
29.1(a)(ii)

227. How does the applicant know whether his application has been accorded an international filing date or that his application is not treated as an international application or is considered to have been withdrawn? Where the receiving Office accords an international filing date to the international application, it promptly notifies the applicant of that date and of the international application number; where it decides that the international application is not to be treated as an international application (because of a negative determination for lack of compliance with Article 11, or because national security considerations prevent it from being treated as such) or is to be considered withdrawn, it promptly notifies the applicant accordingly.

Article 14(4)
Rule 29.1
29.4
30.1
82*ter*.1
Section 312

228. Can an international filing date once accorded be “taken away”? If, after having accorded an international filing date, the receiving Office finds that it should not have accorded it, the international application is considered withdrawn and the receiving Office so declares and promptly notifies the applicant. However, such a finding may validly occur only during the four months following the international filing date and must be preceded by notification to the applicant of the intention to make the declaration. The applicant has the right to submit arguments within one month from the notification. For the rectification of errors made by the receiving Office in according the international filing date, see Rule 82*ter*.1 and Volume II.

TRANSLATION OF INTERNATIONAL APPLICATIONS

Rule 12.1

229. When is a translation of the international application required? Every receiving Office must accept, for the purpose of filing international applications, at least one language which is both a language of publication and 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. In addition, any receiving Office may accept one or more other languages for the purpose of filing international applications. A translation of the international application is required when the language in which the international application is filed is a language which is not a language of publication and/or a language accepted by the International Searching Authority which is to carry out the international search.

Rule 12.3 230. **What are the translation requirements if the international application is filed in a language which is not accepted by the International Searching Authority?** 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 must furnish, to the receiving Office, a translation of the international application into a language which is both a language accepted by that Authority and a language of publication. Moreover, unless the international application was filed in a language of publication (see paragraph 309), the language into which the international application is translated must also be a language in which international applications may be filed with the receiving Office concerned. No translation is required of any sequence listing part of the description which complies with the standard provided for in Annex C of the Administrative Instructions. (Concerning translation of the request, see paragraph 235.)

231. The translation of the international application must be furnished to the receiving Office within one month from the date on which the international application was received by that Office. Where, by the time the receiving Office notifies the applicant of the international application number and international filing date, the applicant has not furnished the required translation, the receiving Office will, preferably together with that notification, invite the applicant to furnish the required translation either within the time limit of one month from the date on which the international application was received by the receiving Office, or, in the event that the required translation is not furnished within that time limit, to furnish it and to pay, where applicable, the late furnishing fee

(see paragraph 233), 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.

232. Where the receiving Office has sent to the applicant an invitation to furnish the translation and, where applicable, pay the late furnishing fee, and the applicant has not done so within the applicable time limit, the international application will be considered withdrawn and the receiving Office will so declare. However, any translation and any payment which are received by the receiving Office before that Office makes the declaration that the international application is considered withdrawn, and before the expiration of 15 months from the priority date, will be considered to have been received before the expiration of the applicable time limit.

233. The late furnishing fee which any receiving Office may collect for translations which are furnished after the expiration of the time limit of one month from the date on which the international application is received by the receiving Office, is equal to 50% of the basic fee.

Rule
26.3ter(c)

234. What are the translation requirements if the abstract or text matter in the drawings of the international application are in a language which is different from the language of the description and claims? If the abstract or text matter in the drawings of the international application is in a language which is different from the language of the description and claims, then the receiving Office will 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. However, no such invitation will be issued if the abstract or text matter in the drawings is in the language in which the international application is to be published, or if a translation of the international application is required because the language in which the international application was filed is not accepted by the International Searching Authority which is to perform the international search.

Rule

235. What are the translation requirements if the request

12.1(c) **is in a language which is not both a language of publication**
26.3ter(c) **and a language accepted by the receiving Office for the**
purpose of filing international applications? Whatever the language in which the description and claims are filed, the request must always be filed in a language which is both a language of publication and a language accepted by the receiving Office for the purposes of filing international applications. If the request is in a language which does not fulfill both these requirements, the receiving Office invites the applicant to file a translation that complies with both requirements.

Rule 48.3 236. **What are the translation requirements if the international application is filed in a language which is accepted by the International Searching Authority, but is not a language of publication?** If the international application is filed in a language which is not a language of publication but is a language accepted by the International Searching Authority which is to carry out the international search, that application will be published in English translation. The translation is prepared under the responsibility of the International Searching Authority, which is 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. The International Searching Authority may charge the applicant a fee for preparing the translation. The International Searching Authority must give the applicant an opportunity to comment on the draft translation within a time limit, fixed by it, which is reasonable under the circumstances of the case. If there is no time to take the comments of the applicant into account before the translation is communicated to the International Bureau, or if there is a difference of opinion between the applicant and the International Searching 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 publishes the relevant portions of the comments together with, or after, the translation prepared by the International Searching Authority.

CORRECTION OF DEFECTS

237. **What defects in the international application may be corrected and within what time limits?** The following paragraphs attempt to give general answers to those questions in the characteristic cases of possible defects.

238. **What defects influence the international filing date?**

(a) Where the receiving Office finds that the international application does not comply with the requirements for according an international filing date—in other words:

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| Article
11(1)(i) | (i) that the applicant obviously lacks, for reasons of residence and nationality, the right to file an international application with the receiving Office (but see also paragraphs 242 and 243), |
| Article
11(1)(iii)(a) | (ii) that the international application does not contain an indication that it is intended as an international application, |
| Article
11(1)(iii)(b) | (iii) that the international application does not contain a specific designation (under Rule 4.9(a)—see paragraph 87) of at least one Contracting State, |
| Article
11(1)(iii)(c) | (iv) that the international application does not contain the name of the applicant or does not contain at least the minimum indications concerning the name of the applicant which are indicated in paragraph 222(iii)(c), |
| Article
11(1)(iii)(d)
and (e) | (v) that the international application does not contain a part which, on the face of it, appears to be a description and a part which, on the face of it, appears to be a claim or claims, |
| Article
11(1)(ii)
Rule 19.4
20.6 | the receiving Office invites the applicant to correct the defect. The time limit for filing the correction is fixed by the receiving Office. It must be reasonable under the circumstances; it may not be less than 10 days and not more than one month from the date of the invitation to correct. If the correction is made within |

the time limit, the date of receipt of the correction becomes the international filing date; otherwise, the application is not treated as an international application (but see also paragraphs 242 and 243 in relation to the applicant's residence and nationality, and paragraphs 229 to 236 regarding applications filed in a language which is accepted by the receiving Office but which is not both a language accepted by the International Searching Authority which is to carry out international searching, and a language of publication). Where the required elements of the international application are not in a language accepted by the receiving Office, that Office will transmit the international application to the International Bureau as receiving Office under Rule 19.4 (noting that the International Bureau as receiving Office is prepared to accept international applications filed in any language; see paragraph 241 and Annex C).

Article
14(2)
Rule 4.10
20.2(a)(iii)

(b) Where the receiving Office finds that any of the drawings referred to in the international application are not, in fact, included in the application, it notifies the applicant accordingly. The time limit for furnishing such drawings is 30 days from the date on which papers were first received by the receiving Office. If the drawings are furnished within that time limit, the date of their receipt becomes the international filing date; otherwise, any reference to drawings in the international application is considered non-existent and the international filing date remains as originally accorded. Note, however, that the priority claim will be considered, for the purposes of the procedure under the PCT, not to have been made, if the accorded international filing date falls outside the 12-month priority period for claiming priority (see paragraphs 97 and 245).

Rule
20.1(a)
and (b)

239. What happens if all sheets of the international application are not received on the same day? The receipt of further sheets after an invitation to correct has been sent under Article 11(2)(a) or 14(2) generally results in the date of receipt of those further sheets being accorded as the international filing date, provided that they are received within the applicable time

limit (see paragraph 238(a) and (b)). If no invitation to correct has been sent but all the sheets relating to the same purported international application (apart from the abstract) are not received on the same day by the receiving Office, that Office corrects the request by marking on it the date on which the papers completing the international application were received, and that later date is accorded as the international filing date, provided that the later sheets were received within 30 days from the date on which sheets were first received. Each sheet is marked with the date on which it was actually received. The absence or late receipt of the abstract does not, of itself, result in correction of the date marked on the request or in the according of a later international filing date.

240. What defects do not influence the international filing date? Where the receiving Office finds that

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| Article
14(1)(a)(i)
Rule 2.3
4.1(d)
4.15 | (i) the international application is not signed (or, in the cases referred to in paragraph 110, does not bear a seal; see also paragraphs 436 to 442 for cases where an applicant refuses to sign or cannot be found or reached), |
| Article
14(1)(a)(ii)
Rule 4.4
4.5 | (ii) the international application does not contain the name of the applicant presented in the prescribed way, or the prescribed indications concerning the applicant (other than those referred to in paragraph 222(iii)(c), for which case see paragraph 238(a)(iv))—these indications are specified in Rules 4.4 and 4.5; they include, in particular, the applicant’s address, residence and nationality, |
| Article
14(1)(a)(iii)
Rule 4.3 | (iii) the international application does not contain a title (that is, a title for the claimed invention), |
| Article
14(1)(a)(iv)
Rule 8 | (iv) the international application does not contain an abstract, |
| Article
14(1)(a)(v)
Rule 11
26.3 | (v) the international application and, where applicable, the translation of the international application, does not comply, to the extent provided for in the Regulations, |

with the prescribed physical requirements (the physical requirements are specified in detail in Rule 11; compliance with them must be checked only to the extent that such compliance is necessary for the purpose of reasonably uniform international publication, and no international application will be considered withdrawn for lack of such compliance if it complies to the extent necessary for the purpose of reasonably uniform international publication),

Article
3(4)(i)
Rule 12.1
26.3*ter*(a)

(vi) any element of the international application, other than the description and claims, is not in an admitted language (see paragraphs 54, 222(ii) and 223),

Article
14(1)(b)
Rule
26.1(a)
26.2
26.3*ter*(b)
26.5
29.1

the receiving Office invites the applicant to correct the defect (however, regarding international applications which are filed in a language which is accepted by the receiving Office but require translation, see paragraphs 229 to 236). The time limit for filing the correction is fixed by the receiving Office. It must be reasonable under the circumstances; it may not be less than one month and normally not more than two months from the date of the invitation. If the correction is made within the time limit (including any extension—see paragraph 244), the international filing date remains the date on which the international application was received by the receiving Office; otherwise, the international application is considered withdrawn. In certain Offices, however, the provisions of Rule 26.3*ter*(a) for correction of elements not in an admitted language are incompatible with the applicable national law. For as long as that incompatibility continues, that Rule will not apply for those Offices; all elements of an international application filed with those Offices as receiving Office must therefore comply with the language requirements of Rule 12.1 before an international filing date can be accorded (see also paragraph 223 and see Annex C for details).

Article
11(1)
Rule 89*ter*
Section

240A. **What defects in requests prepared using the PCT-EASY software do not affect the international filing date?**
The following defects in requests prepared using the PCT-EASY software do not affect the international filing date:

102(i)
102bis

- (i) the request in PCT-EASY format is filed without the PCT-EASY diskette;
- (ii) the PCT-EASY diskette does not contain an abstract;
or
- (iii) the PCT-EASY diskette, accompanying a paper copy of the request, is defective or incomplete.

These defects may render the applicant ineligible to receive the fee reduction for PCT-EASY. However, if the applicant furnishes, before the receiving Office transmits the record copy to the International Bureau, a PCT-EASY diskette which is not defective and which contains the required indications, the applicant is eligible to receive the fee reduction although he did not provide the diskette at the time of filing the application. See paragraph 202A for further information on the fee reduction associated with PCT-EASY; see paragraph 219A for further details on the processing of requests prepared using the PCT-EASY software.

Rule
19.4(a)(ii),
(b) and (c)

241. What happens if the application is filed in a language which is not accepted by the receiving Office? If the international application is filed in a language which is not a language accepted by the national (or regional) Office with which it is filed, but is in a language accepted by the International Bureau as receiving Office, that international application will be considered to have been received by that Office on behalf of the International Bureau as receiving Office. In fact, the International Bureau as receiving Office accepts international applications filed in any language (see Annex C). In such a case, the international application will be date-stamped by the national (or regional) Office concerned and promptly transmitted to the International Bureau (unless this is prevented by national security prescriptions). That transmittal may be subjected to the payment of a fee equal to the transmittal fee (see paragraph 197(a) and Annex C), but other fees paid will be refunded by the national (or regional) Office to the applicant and the applicable fees will then have to be paid to

the International Bureau as receiving Office (see Annex C). The international application so transmitted will be considered to have been received by the International Bureau as receiving Office on the date on which it was received by the national (or regional) Office, except that, for the purposes of calculating the time limits for paying the fees due on filing the international application to the competent receiving Office, the date of receipt of the international application is considered to be the date on which the international application was actually received by the International Bureau as receiving Office.

Rule
19.4(a)(i),
(b) and (c)

242. What happens if the applicant is a resident or national of a Contracting State but files the application with a “non-competent” receiving Office? If the international application is erroneously filed with a national (or regional) 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 Office is not competent under Rule 19.1 or 19.2 (having regard to the applicant’s residence and nationality) to receive the international application, the international application will be considered to have been received by the Office with which it was filed on behalf of the International Bureau as receiving Office (see paragraphs 49 and 50). In such a case, the international application will be date-stamped by the national (or regional) Office concerned and promptly transmitted to the International Bureau (unless this is prevented by national security prescriptions). That transmittal may be subjected by the national Office to the payment of a fee equal to the transmittal fee (see paragraph 197(a) and Annex C), but other fees paid will be refunded by the national Office to the applicant and the applicable fees will then have to be paid to the International Bureau as receiving Office (see Annex C (IB)). The international application so transmitted will be considered to have been received by the International Bureau as receiving Office on the date on which it was received by the national (or regional) Office, except that, for the purposes of calculating the time limits for paying the fees due on filing the international application, the date of receipt of the international application is considered to be the date on which the international application was actually received by the International Bureau as receiving

Office.

Article 11(1)(i) 243. **May the applicant correct indications of residence and nationality?** If the indications of the applicant's residence and nationality as stated in the request do not support the applicant's right to file an international application (see paragraphs 60, 63 and 222(i)), that is, if the applicant appears not to be (or, where there are two or more applicants, none of the applicants appears to be) a resident or national of a Contracting State, there is *prima facie* a defect under Article 11(1)(i) and the receiving Office issues an invitation accordingly to correct that defect (see paragraph 238(a)(i)). In such a case, it may be that the applicant is able to show that he had, on the date on which the international application was actually received by the receiving Office, the right to file an international application with that receiving Office. In those circumstances, the applicant should submit evidence to the receiving Office accordingly, together with a proposed correction of the indications concerning his residence and/or nationality. If the receiving Office is satisfied, on the basis of that evidence, of the applicant's right to file the international application, the invitation to correct the defect under Article 11(1)(i) will be considered to be an invitation to correct a defect under Article 14(1)(a)(ii) and Rule 4.5 in the prescribed indications concerning the applicant's residence and/or nationality, and the indications may be corrected accordingly. If such a correction is made, no defect will be considered to exist under Article 11(1)(i), and the defect will thus not prevent the accordancy of the actual date of receipt of the international application as the international filing date. Note, however, that the United States Patent and Trademark Office as receiving Office has stated that it will not apply the procedure outlined above.

Rule 20.6 244. **Can a time limit fixed by the receiving Office be extended?** The time limit fixed by the receiving Office for the correction of defects under Article 14(1) (see paragraph 240) may be extended by the receiving Office. The receiving Office may extend the time limit *ex officio* or at the request of the applicant at any time—even after the time limit fixed in the invitation has expired—before a decision is taken on whether

26.2

the applicant has submitted the correction within the time limit and whether or not the international application so corrected is to be considered withdrawn. On the other hand, the time limits fixed by the receiving Office for the correction of defects under Article 11 or Article 14(2) (see paragraph 238) and for the payment of missing or underpaid fees under Rule 16*bis* (see paragraphs 211 and 213) may not be extended.

Rule
26*bis*.1(a)

245. **Can defects in priority claims be corrected?** Any defective priority claim may be corrected and any missing priority claim added by a notice which may be submitted to the receiving Office or the International Bureau. The time limit for correcting or adding a priority claim is 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 a notice correcting or adding a priority claim may in any event be submitted until the expiration of four months from the international filing date. To correct a priority claim, any indication relating to that priority claim may be changed, added or deleted.

246. Where the applicant has made a request for early publication of the international application, any notice to correct or add a priority claim received by the receiving Office or the International Bureau after that request was made will be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed.

247. 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 will be computed from the priority date as so changed.

Rule
26*bis*.2

248. **Can the applicant be invited to correct a priority claim?** 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 (see paragraph 96) 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, will invite the applicant to correct the priority claim.

249. If the applicant fails to respond to an invitation from the receiving Office or the International Bureau to correct a priority claim before the expiration of the time limit for doing so, that priority claim will, 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, will so declare and inform the applicant accordingly. However, a priority claim will not be considered not to have been made only because the indication of the number of the earlier application is missing or because an indication in the priority claim is not the same as the corresponding indication appearing in the priority document.

250. Where the receiving Office or the International Bureau has made a declaration that a priority claim will be considered, for the purposes of the procedure under the PCT, not to have been made, the applicant may request the International Bureau to publish, together with the international application, information concerning the priority claim which was considered not to have been made. The request must be received by the International Bureau prior to the completion of the technical preparations for international publication, and is subject to the payment of a special fee whose amount is fixed in the Administrative Instructions.

Rule
26ter.1

250A. Can defects in declarations referred to in Rule 4.17 be corrected? Can declarations be added? Any defective declaration may be corrected and any new (missing) declaration may be added by a notice submitted to the International Bureau by the applicant, either in response to an invitation to correct (see paragraph 250B) or on his own initiative. The time limit for correcting or adding a declaration is 16 months from the priority date. Any correction or addition which is received by the International Bureau after that time limit is considered to have been received on the last day of the time limit if it reaches the International Bureau before the technical preparations for international publication have been completed.

Rule 250B. **Which are the defects in declarations made under Rule 4.17 in respect of which the applicant may be invited to submit a correction?** Where the receiving Office or the International Bureau finds that any declaration contained in the request appears to be defective or incomplete, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within the time limit referred to in paragraph 250A. The kinds of defects which may give rise to an invitation are, for example, the fact that a declaration does not contain the standardized wording as prescribed, or that the blank spaces have not been filled in with names, dates, etc., that it does not contain the indication of at least one designation for the purposes of which it is made; furthermore, in respect of the declaration of inventorship for the purposes of the designation of the United States of America, that it is not signed as prescribed.

Section 216 250C. **How should a correction or addition of a declaration referred to in Rule 4.17 be presented?** Any correction or addition of a declaration must be made by way of a notice consisting of the corrected or added declaration itself accompanied by a letter explaining the correction or addition. Such notice should be submitted directly to the International Bureau in all cases, even if that notice is in response to an invitation issued by the receiving Office. Any notice nevertheless submitted to the receiving Office will be date stamped by that Office and transmitted to the International Bureau.

Section 214(c) 250D. In the case of a corrected declaration, the applicant must submit a replacement sheet, using the relevant Box (amongst Boxes Nos. VIII (i) to (v)). In the case of an added declaration, the applicant may either use the relevant sub-box mentioned above or a blank sheet of paper. Any corrected or added declaration of inventorship for the purposes of the designation of the United States of America should be signed and dated by the inventor (even if the inventor, as applicant for the purposes of the designation of the United States of America, has already signed the request) and should be entitled “Supplemental declaration of inventorship (Rules 4.17(iv) and 51*bis*.1(a)(iv))”.

- Rule 47.1(a-ter) 48.2(b)(iv) 250E. **What happens when the applicant fails to correct a declaration referred to in Rule 4.17?** Except in respect of declarations as to non-prejudicial disclosures and exceptions to lack of novelty (see paragraph 250F), the International Bureau will communicate copies of declarations, either as originally filed, or as corrected, to the designated Office(s) concerned, whether or not the declarations comply with Rule 4.17. Furthermore, an indication about the fact that declarations were made and the designations for the purposes of which they were made will be included in the front page of the pamphlet.
- Rule 48.2(a)(x) 48.2(b)(iv) 250F. Any declaration as to non-prejudicial disclosures or exceptions to lack of novelty will be referred to in the front page of the pamphlet and included as part of the pamphlet, either as originally filed, or as corrected, irrespective of whether it complies with Rule 4.17(v).
- Rule 26ter.1 Section 419(c) 250G. **What happens where the International Bureau receives a correction or addition of a declaration referred to in Rule 4.17 after the applicable time limit?** Where the International Bureau receives a correction or addition of a declaration after the applicable time limit (see paragraph 250A), it will notify the applicant accordingly. It does not communicate that declaration to the designated Office(s) but informs the applicant that any such declaration should be submitted directly by him to the designated Office(s) concerned. In the case of a declaration of inventorship signed by at least one of the inventors, the International Bureau will return the declaration to the applicant. In the case of a declaration as to non-prejudicial disclosures or exceptions to lack of novelty, the International Bureau will not include it as part of the pamphlet.
- Rule 28 29.3 251. **Is the receiving Office the only authority which may note any of the above defects during the international phase?** If, in the opinion of the International Bureau or the International Searching Authority, the international application is not signed as provided in the Regulations, or does not contain the name of the applicant presented in the prescribed way, or the prescribed indications concerning the applicant, or does not comply to the extent provided in the Regulations with the prescribed physical requirements, the International Bureau or

the International Searching Authority, as the case may be, brings such defects to the attention of the receiving Office. Unless that Office believes that there is no defect, it must then invite the applicant to correct it, and fix a time limit for correction (see paragraph 240).

Rule 26.4
92.1

252. How should a correction be presented? According to the nature of the defect, the correction may have to be filed in the form of one or more replacement sheets incorporating the correction and accompanied by a letter, or it may be merely stated in a letter. The letter accompanying a replacement sheet must explain the differences between the replacement sheet and the one it replaces. Correction by letter without replacement sheets is possible only where the correction is of such a nature that it can be transferred from the letter to the request or other part of the record copy without any adverse effect on the clarity and the direct reproducibility of the sheet onto which the correction is to be transferred. As to the signature and other requirements of such letters, see Rule 92.1.

253. Does a correction entail the payment of a fee? Both the request for and the making of any correction are free of charge. There is also no fee for the extension of a time limit for correction (see paragraph 244).

254. Can the applicant appeal or file a petition against an unfavorable decision of the receiving Office? The PCT does not expressly provide for any appeal or petition during the international phase. However, practice has shown that receiving Offices reconsider their decisions on petition, and that some national courts or appeal boards have accepted appeals against decisions taken by national (or regional) Offices in their capacity as receiving Offices. However, the latter possibility, even where the applicant is successful in obtaining a revision of the decision of the receiving Office in his favor, may remain without effect in the States designated in the international application, particularly when the applicant has not performed the acts required under Article 22(1), 39(1)(a) or 25 within the applicable time limit.

Article 25
Rule 51

255. The PCT provides for the review by designated Offices of any decision of the receiving Office refusing to accord an

international filing date or declaring that the international application, or the designation of the State concerned, is considered withdrawn. (For details of the procedure, including the time limit for requesting such review, see Volume II.)

- Article 256. **Can failure to meet a time limit in the proceedings before the receiving Office or a delay in furnishing documents to that Office be excused?** The PCT provides that any Contracting State must, as far as that State is concerned, excuse, for reasons allowed by the national law, any delay in meeting any time limit. Moreover, any Contracting State may, as far as it is concerned, excuse for other reasons any delay in meeting any time limit. Finally, any designated Office may maintain the effect of an international application (see paragraphs 44 to 48), even where the decision of the receiving Office to the effect that the international application, or the designation of the State concerned, is considered withdrawn is found to be correct. (For details, see Volume II.)
- Article 24(2)
48(2)
Rule 82*bis*

RECORD COPY AND SEARCH COPY

- Article 257. **How does the record copy reach the International Bureau? What are the consequences if it does not reach the International Bureau within the prescribed time limit?** The record copy (see paragraph 194), which incidentally is, for the purposes of the procedure under the PCT, considered the true copy of the international application, must reach the International Bureau in time because, if the record copy has not been received by that Bureau within the prescribed time limit, the international application is considered withdrawn. However, no international application is considered withdrawn in such a case without the applicant having been informed beforehand (see paragraph 258). Failure to transmit the record copy does not relieve the applicant of the obligation to enter the national phase before the designated Offices within the applicable time limit (see Volume II).
- Article 12(2)
12(3)
22(1)
24(1)(ii)
and (iii)
Rule 22.1
22.3
- Rule 258. **How does the International Bureau monitor the receipt of the record copy?** The International Bureau, once informed by the receiving Office of the international application number and of the international filing date, monitors the receipt of the record
- Rule 20.5(c)
22.1(e)

copy. If the International Bureau has not received the record copy within 13 months from the priority date, it urges the receiving Office to send it. If, one month later, the record copy has still not been received, the International Bureau notifies the applicant of the fact. The applicant can then ask the receiving Office either to transmit the record copy or to issue—and this must be done free of charge—a certified copy of the international application which he can himself transmit to the International Bureau. Only after the expiration of three months from the above-mentioned notification from the International Bureau to the applicant may the International Bureau make the finding that no record copy has been received within the prescribed time limit. Thus the applicant will always have been warned and offered the possibility of taking care of the transmittal of the record copy himself before any loss of rights can occur. The certification of a copy of the international application must be made free of charge in such a case, and may be refused only in certain cases (for instance where national security considerations prevent the international application from being treated as such; for details, see Rule 22.1(e)).

- Article 12(1)
Rule 12.1(c)
23.1
25.1
- 259. How does the search copy reach the International Searching Authority?** The search copy (see paragraph 194) is transmitted by the receiving Office to the International Searching Authority. The search copy is only transmitted if the international search fee has been fully paid to the receiving Office (see paragraphs 197(b), 211, 213 and 217), and, where the international application was filed in a language not accepted by the International Searching Authority, only after the required translation has been furnished (see paragraph 195). Therefore, it is in the applicant's interests to pay the search fee promptly, and, where applicable, furnish the translation promptly, in order to avoid any delay in establishment of the international search report. The International Searching Authority notifies the International Bureau, the applicant and the receiving Office of the fact and date of receipt of the search copy.
- Rule 20.9
- 260. Can the applicant obtain certified copies of the international application?** On payment of a fee, the receiving Office must furnish to the applicant, at his request, certified copies of the international application as filed and of any

corrections to it. The certified copy of the international application is the priority document where the applicant claims the priority of that international application. For copies of priority documents referred to in the international application, see paragraph 99.

CONFIRMATION OF “PRECAUTIONARY” DESIGNATIONS

Rule
4.9(b)
and (c)

261. Are precautionary designations required to be confirmed? Precautionary designations will be regarded as withdrawn by the applicant unless they are confirmed as described in the following paragraphs, but the applicant is not obliged to confirm them. As explained in paragraphs 91 and 92, the precautionary designation procedure enables the applicant to make, in the request, all designations permitted by the PCT in addition to those made specifically. For this purpose, the request must also contain a statement that any precautionary designations so made are subject to confirmation as provided in Rule 4.9(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. Noting that the confirmation of designations is entirely at the applicant’s discretion, no notification is sent to the applicant reminding him that the time limit for confirming precautionary designations is about to expire.

Rule
4.9(b)
and (c)
24.2(a)

262. In what circumstances should any or all precautionary designations be confirmed? No reasons need be given by the applicant for confirming any or all precautionary designations made in the request. Confirmations can be used, in effect, to rectify omissions or other mistakes made by the applicant in completing Box No. V of the request in relation to specific designations. However, the confirmation procedure can also be used where the applicant decides for any other reason that designations other than those already made specifically should proceed. As explained in paragraph 294, the applicant receives from the International Bureau a notification of the latter’s receipt of the record copy. That notification contains a list of the designated Offices, and the applicant should check carefully for

any omissions or other mistakes compared with his intentions. Such mistakes might occur, for example, because of clerical or typing errors, confusion between some countries' two-letter codes, use of an out-of-date printed form, or failure to take into account accessions to the PCT which took place after the form was printed.

Rule
4.9(b)
and (c)

263. When and how must precautionary designations be confirmed? Precautionary designations (see paragraphs 91 and 261) are automatically regarded as withdrawn by the applicant if they are not confirmed by the applicant before the expiration of 15 months from the priority date. Confirmation involves filing with the receiving Office a written notice containing an indication of the States or regional patents in relation to which the applicant wishes to confirm designations, and paying to the receiving Office the prescribed fees. A suitable form for confirmation of precautionary designations is contained in Annex Z.

264. What fees are due in respect of the confirmation of precautionary designations? The fees payable in respect of the confirmation of precautionary designations are:

(i) as many "designation fees" (see Annex C) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, similarly to the designation fees paid in respect of specific designations made in the request (see paragraph 197(c)(ii)), except that the maximum of five designation fees (see paragraph 198) does not apply in respect of confirmed precautionary designations—that is, a designation fee is due for the confirmation of each precautionary designation, even if the total number of designations in respect of the international application exceeds five or if the maximum (of five designation fees) has already been paid in respect of specific designations;

Rule 15.5

(ii) the "confirmation fee," which amounts to 50% of the sum of the designation fees payable in respect of the confirmed designations.

265. The reduction applicable in connection with specific designations applies also in respect of the confirmation of precautionary designations (see paragraph 202).

Rule
15.5(b)
Section
321(e)
and (f)

266. If the applicant purports to confirm designations but the moneys paid within the applicable time limit are not sufficient to cover the fees due, the moneys are allocated as specified by the applicant or, in the absence of such specification, as provided in Section 321(e) and (f).

CHAPTER VII

THE INTERNATIONAL SEARCH PROCEDURE: PROCESSING OF THE INTERNATIONAL APPLICATION BY THE INTERNATIONAL SEARCHING AUTHORITY

GENERAL

- Article 15 267. **What are the main procedural steps before the**
18 **International Searching Authority?** The main procedural
Rule 43 steps that any international application goes through before the
International Searching Authority are the following:
- (i) the making of the international search, and
 - (ii) the preparing of the international search report.
- Article 16 268. **Which International Searching Authority is**
Rule 35 **competent?** Each receiving Office (except the International
Bureau as receiving Office—see paragraph 49) specifies one or
more International Searching Authorities as competent to carry
out international searches on international applications filed
with it. For some receiving Offices, different International
Searching Authorities are competent depending on the
language in which the international application is filed or,
where the international application is filed in a language
accepted by the receiving Office but not by the International
Searching Authority, translated. Where several International
Searching Authorities are specified as competent by the
receiving Office, the applicant may choose between them
(subject to any such language restriction). Annex C indicates
the International Searching Authority or Authorities specified
as competent by each receiving Office, and the languages in
which international applications filed with that Office are
accepted for international search by those Authorities. Where
the international application is filed with the International
Bureau as receiving Office, the competent International
Searching Authority (or Authorities) is that (or are those)
which would have been competent if the international
application had been filed with a competent national (or

regional) Office as receiving Office. All of the languages accepted for search by each International Searching Authority are set out in Annex D. Where two or more International Searching Authorities are competent to carry out the international search, the applicant must indicate the Authority of his choice in the request form (see paragraph 101) and should also indicate it in the fee calculation sheet (see paragraphs 112 and 201). Finally, within the framework of the respective agreements relating to the functioning of certain Offices as International Searching Authorities, these Authorities may provide for limitations of their competence in respect of certain international applications. In practice, the European Patent Office has limited its competence in respect of international applications filed on or after 1 March 2002 by applicants who are nationals or residents of certain States where these applications contain one or more claims relating to certain fields of technology. For more detailed information, see Annex D.

Article
15(4)
Rule 33

269. What is the purpose of the international search? The purpose of the international search is to discover relevant prior art. "Prior art" consists of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations); it is "relevant" in respect of the international application if it can help determine whether or not the claimed invention is new, whether or not it involves an inventive step (in other words, whether it is or is not obvious), and whether the making available to the public occurred prior to the international filing date (for further details, see Rule 33). The international search is made on the basis of the claims, with due regard to the description and the drawings (if any) contained in the international application. The results of the international search are set out in the international search report (see paragraphs 289 to 292 and, for a sample report, Annex G).

Article
15(4)
Rule 34.1

270. What documents are searched by the International Searching Authority? The International Searching Authority must endeavor to discover as much of the relevant prior art as its facilities permit, and it must in any case consult the so-called "minimum documentation." Roughly stated, the latter

comprises the published patent documents issued after 1919 by France, by Germany from 1920 to 1945 and by the Federal Republic of Germany since 1945, by Japan (for International Searching Authorities other than the Japan Patent Office, only those documents for which English abstracts are generally available), by the former Soviet Union and now by the Russian Federation (for International Searching Authorities other than the Russian Patent Office only those documents for which English abstracts are generally available), by Switzerland (except documents in Italian), by the United Kingdom, by the United States of America, by the African Intellectual Property Organization (OAPI), by the African Regional Industrial Property Organization (ARIPO), by the Eurasian Patent Office and by the European Patent Office; published international (PCT) applications; and, from various dates, about 135 technical periodicals. It is emphasized, however, that, where the International Searching Authority has more than the “minimum documentation” at its disposal, it is obliged also to consult that additional documentation to the extent permitted by its facilities.

NUCLEOTIDE AND/OR AMINO ACID SEQUENCE LISTINGS

Rule 5.2 271. **What special requirements apply during the**
13ter.1(a)(i) **international search to nucleotide and/or amino acid**
Section 208 **sequence listings?** Where the International Searching
513(a) Authority finds that an international application contains
801 disclosure of one or more nucleotide and/or amino acid
sequences and that a listing of such sequences complying with
the standard provided for in Annex C of the Administrative
Instructions (see paragraph 118) has not already been furnished
(either as part of the international application or separately for
the purposes of international search—see paragraphs 118A and
119), that Authority may invite the applicant to furnish a
listing complying with that standard. What is said above
applies also where the sequence listing part of the international
application is filed on electronic medium only or both on that
medium and on paper, as provided for under Section 801 (see
paragraphs 119A to 119E). The listing required by the

International Searching Authority is for the purpose of carrying out the international search; the application of the requirements of national law in relation to disclosure of inventions involving sequence listings is a matter for the national phase of processing.

Rule 13ter.1(a)(ii) 272. **Can the International Searching Authority require a sequence listing to be provided in computer readable form?**

Section 208 If the International Searching Authority finds that the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in Annex C of the Administrative Instructions, it may invite the applicant to furnish a listing to it in such a form.

Section 208 273. **What computer readable forms for sequence listings are acceptable?** Annex C to the Administrative Instructions requires that the entire printable copy of the sequence listing in computer readable form must be contained within one electronic file preferably on a single diskette or any other electronic medium that is acceptable to the competent International Searching Authority. The file recorded on the diskette or any other electronic medium that is acceptable to the competent Authority must be encoded using IBM Code Page 437, IBM Code Page 932 (both of which are *de facto* standards for personal computers), or a compatible code page (IBM is a registered trademark of International Business Machines Corporation, United States of America). A compatible code page, as would be required for, for example, Japanese, Chinese, Cyrillic, Arabic, Greek or Hebrew characters, is one that assigns the Roman alphabet and numerals to the same hexadecimal positions as do the specified code pages.

274. The computer readable form of a sequence listing must preferably be created by dedicated software such as “PatentIn” or other custom computer programs; it may be created by any means, as long as the sequence listing on a submitted diskette or any other electronic medium that is acceptable to the competent International Searching Authority is readable under a personal computer operating system that is acceptable to the competent Authority. File compression is acceptable when using diskette media, so long as the compressed file is in a

self-extracting format that will decompress on a personal computer operating system that is acceptable to the competent Authority.

275. The diskette or any other electronic medium that is acceptable to the competent International Searching Authority must have a label permanently affixed thereto on which has been typed, or hand-printed in block capitals, the name of the applicant, the title of the invention, a reference number, the date on which the data were recorded, the computer operating system and the name of the competent Authority. If the diskette or any other electronic medium that is acceptable to the competent Authority is submitted after the date of filing of an application, the labels must also include the filing date of the application and the application number.

Rule
13ter.1(a)
13ter.1(c)

276. **What is the procedure for furnishing a sequence listing upon invitation?** An invitation from the International Searching Authority to furnish a sequence listing complying with the standard provided for in Annex C to the Administrative Instructions (see paragraphs 271 to 275), will specify a time limit for response to the invitation. Any sequence listing furnished by the applicant must 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. If the applicant does not comply within that time limit, the search undertaken by the International Searching Authority may be restricted (see paragraph 279).

Rule
13ter.1(f)

277. **Does a sequence listing furnished to the International Searching Authority form part of the international application?** Any sequence listing, furnished separately to the International Searching Authority, is used only for the purposes of the international search and does not form part of the international application.

Rule
13ter.1(e)
13ter.2

278. **Will a sequence listing furnished to the International Searching Authority also meet any requirements of the International Preliminary Examining Authority or, in the national phase, of a designated Office?** The same requirements in relation to sequence listings for the purposes

of international search apply during international preliminary examination (see paragraph 389). The International Preliminary Examining Authority may, for example, invite the applicant to furnish to it a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions for the purposes of international preliminary examination. Concerning designated Offices, no designated Office may 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. If a designated Office finds that a sequence listing does not comply with the standard provided for in the Administrative Instructions and/or is not in a computer readable form provided for in the Administrative Instructions, it may invite the applicant to furnish a listing complying with the requirements (see Volume II).

LIMITATIONS ON INTERNATIONAL SEARCH

Article
17(2)(a)(i)
and (b)
Rule
13ter.1(c)
39.1

279. May the International Searching Authority refuse to search certain subject matter? The International Searching Authority is not required to perform an international search on claims which relate to any of the following subject matter: (i) scientific and mathematical theories, (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes, (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games, (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods, (v) mere presentation of information, and (vi) computer programs to the extent that the Authority is not equipped to search prior art concerning such programs. However, certain International Searching Authorities do, in practice, search these fields to varying extents—for example, several International Searching Authorities search subject matter which is normally searched under the national (or regional) procedure (for details, see Annex D). In addition, the International Searching Authority is not required to search the international application, to the extent that a meaningful search

cannot be carried out, in certain cases where a nucleotide and/or amino acid sequence listing is not furnished in accordance with the prescribed standard or in a computer readable form (see paragraphs 271 to 278). If the International Searching Authority is not required to search any of the claims, it may declare that it will not establish an international search report. It should, nevertheless, be noted that the lack of an international search report in such a case does not, in itself, have any influence on the validity of the international application, the processing of which, including its communication to the designated Offices, continues. In respect of the possibility for the International Searching Authority to limit its competence, see paragraph 268.

Article
17(2)(a)(ii)
and (b)
Rule 6.4(a)

280. May the International Searching Authority refuse to search international applications which are unclear or have other defects? If the International Searching Authority considers that the description, the claims or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out, it may declare that it will not establish a search report (such a declaration may also be made in respect of some of the claims only). This may in particular occur where the description or the claims are unclear. The lack of an international search report does not, of itself, have any influence on the validity of the international application, the processing of which, including its communication to the designated Offices, continues. Where only some of the claims are found to be “unsearchable,” the International Searching Authority will not search them but will search the rest of the international application. The same may apply in the case of multiple dependent claims which do not comply with the manner of drafting provided for in the second and third sentences of Rule 6.4(a) (see paragraph 128).

UNITY OF INVENTION

Article
17(3)(a)
Rule 13

281. What is the purpose of the requirement of “unity of invention”? The search fee (see paragraph 197(b) and Annex D) is intended to compensate the International Searching Authority for carrying out an international search on

the international application, but only where the international application meets the requirement of “unity of invention.” That means that the international application must relate to only one invention or must relate to a group of inventions which are so linked as to form a single general inventive concept. The requirement of unity of invention is explained in detail in paragraphs 129 to 138.

Article
17(3)(a)
Rule 13
40.1
40.2(a)
and (b)
40.3

282. What happens where the International Searching Authority considers that the international application does not meet the requirement of unity of invention? If the International Searching Authority finds that the international application does not meet the requirement of unity of invention, it invites the applicant to pay additional fees, specifying the reasons for its finding and indicating the number of additional fees to be paid. Such additional fees are payable direct to the International Searching Authority within a time limit fixed by that Authority, which may not be shorter than 15 or, in certain cases, 30 days and not longer than 45 days from the date of the invitation. Annex D indicates the amount of the additional search fee per additional invention charged by each International Searching Authority.

283. When the International Searching Authority invites the applicant to pay additional fees, it may annex to the invitation the results of a partial international search limited to the invention first mentioned in the claims (the relevant claims are identified in the invitation). The results of such a partial search will be included in the international search report when it is established, together with the results of the search of any further invention for which the applicant pays additional fees within the time limit fixed in the invitation.

Article
17(3)(a)
Rule 13

284. The International Searching Authority establishes the international search report in any case on those parts of the international application which relate to the “main invention,” that is, the invention—or group of inventions so linked as to form a single general inventive concept—first mentioned in the claims. Moreover, the International Searching Authority establishes the international search report also on those parts of the international application which relate to any invention—or any group of inventions so linked as to form a single general

inventive concept—in respect of which the applicant has paid the additional fee within the time limit fixed in the invitation.

Rule 40.2(c) and (d) 285. **May the applicant protest against payment of the additional fees?** Yes, any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the number of the required additional fees is excessive. Any such protest is examined by a three-member board or other special organ of the International Searching Authority or by any competent higher authority, and a decision is taken on it. To the extent that the applicant's protest is found to be justified, the additional fee is totally or partly reimbursed. At the request of the applicant, the texts of both the protest and the decision on it are notified to the designated Offices together with the international search report.

Rule 40.2(e) 286. Where the applicant has paid an additional fee under protest, the International Searching Authority may require the applicant also to pay a fee for the examination of the protest ("protest fee"). Details of the protest fee, if any, charged by the International Searching Authorities appear in Annex D. If a protest fee is chargeable by the International Searching Authority, it will only be required in a particular case after a prior review of the justification for the invitation to pay additional search fees, before the formal examination of the protest.

Article 17(3)(b) 287. **What happens if the applicant does not pay the additional fees as invited?** Where, within the prescribed time limit, the applicant does not pay all the additional fees indicated by the International Searching Authority, but pays only some of them, or does not pay any additional fee at all, certain parts of the international application are not searched by that Authority. The lack of an international search report in respect of those parts of the international application does not, of itself, have any influence on the validity of the international application, the processing of which, including its communication to the designated Offices, continues in respect of all claims. Nevertheless, the national law of any designated State may provide that such unsearched parts of the

international application will be considered withdrawn as far as that State is concerned unless a special fee is paid by the applicant to its national Office. There are only a few Offices which apply such provisions. Details are given in Volume II.

TITLE AND ABSTRACT

Rule 37
38
44.2

288. What happens if the International Searching Authority finds that the title of the invention or the abstract is missing or defective? In such cases, and in certain circumstances, it is the International Searching Authority which eventually establishes an appropriate title or abstract. For details, see Rules 37, 38 and 44.2, and paragraph 188.

INTERNATIONAL SEARCH REPORT

Article
18(1)
Rule 42

289. When must the international search report be established? The international search report must be established within three months from the receipt of the search copy by the International Searching Authority (see paragraph 259) or nine months from the priority date, whichever time limit expires later.

Rule 43

290. What are the contents of the international search report? The international search report contains, among other things, the citation of the documents considered relevant, the classification of the subject matter of the invention (at least according to the International Patent Classification, that being carried out by the International Searching Authority itself) and an indication of the fields searched (those fields being identified by a reference to their classification) as well as any electronic data base searched (including, where practicable, the search terms used). Citations of particular relevance must be indicated specially. Citations which are not relevant to all the claims must be indicated in relation to the claim or claims to which they are relevant. If only certain passages of the document cited are relevant or particularly relevant, they must be identified, for example by an indication of the page on which, or the column or lines in which, the passage appears. A sample international search report is given in Annex G, which

also contains an explanation of the manner of indicating references of particular relevance and other categories. It is important to note that an international search report must not contain any expression of opinion, reasoning, argument or explanation of any kind whatsoever. For full details, see Rule 43.

Article
18(2)
Rule 44.1

291. **How do the applicant and the International Bureau receive the international search report?** The International Searching Authority transmits copies of the international search report (or, where none is established, a declaration to that effect—see paragraphs 279 and 280) to the applicant and to the International Bureau on the same day. The latter publishes it with the pamphlet (see paragraph 307) and sends a copy to the designated Offices.

Article
20(3)
Rule 44.3

292. **How can the applicant obtain copies of the documents cited in the international search report?** The applicant can obtain copies of the documents cited in the international search report by requesting them from the International Searching Authority. Certain International Searching Authorities, however, transmit such copies automatically without extra charge to the applicant, together with the international search report. Annex D indicates those International Searching Authorities and indicates for the other Authorities the fees charged for furnishing copies on request.

CHAPTER VIII

INTERNATIONAL PUBLICATION, AMENDMENT OF CLAIMS, AND OTHER PROCESSING OF THE INTERNATIONAL APPLICATION BY THE INTERNATIONAL BUREAU

GENERAL

293. **What are the main procedural steps at the International Bureau?** The main procedural steps that any international application goes through at the International Bureau are the following:

- | | |
|-----------------------------|--|
| Rule 22.1
24.2 | (i) the International Bureau monitors the receipt of the record copy of the international application and notifies the fact, and the date of receipt, to the applicant and the authorities concerned; for details, see paragraph 294; |
| Article 19
Rule 46 | (ii) the applicant may amend the claims of the international application under Article 19 by means of a communication addressed to the International Bureau; for details, see paragraphs 296 to 303; |
| Article 21
Rule 48 | (iii) the international application is published by the International Bureau (such publication usually takes place just after the expiration of 18 months from the priority date); for details, see paragraphs 304 to 317; |
| Article 20
Rule 47 | (iv) copies of the international application and the international search report pertaining to it are transmitted by the International Bureau to the designated Offices; for details, see paragraphs 319 to 321; |
| Article 36
Rule 72
73 | (v) where a demand for international preliminary examination has been filed, the International Bureau notifies the elected Offices, transmits the international preliminary examination report to them and makes a translation of that report into English (if required by any |

elected Office); for further details, see paragraphs 327, 370, 404 and 405.

Rule 24.2 294. **When and to whom does the International Bureau 47.1(a-bis) notify its receipt of the record copy of the international application? When are designated Offices notified?** How the International Bureau receives the record copy and how it monitors that receipt is explained in paragraphs 257 and 258. The record copy of the international application should normally reach the International Bureau before the expiration of 13 months from the priority date. After receiving the record copy, the International Bureau notifies the applicant, the receiving Office and the International Searching Authority (unless it has informed the International Bureau that it wishes not to be so notified) of the fact and of the date of receipt of the record copy. The International Bureau also notifies these facts to each designated Office which has informed the International Bureau that it wishes to receive such a notification prior to the communication sent with the pamphlet at the time of international publication; otherwise the designated Offices will be informed only at the time of that communication (see paragraphs 319 to 321). All those notifications are effected promptly (that is, within a few days—normally not more than five working days) after the International Bureau's receipt of the record copy. Precautionary designations (see paragraphs 91 and 92) are taken into account for the purposes of those notifications only if they have already been confirmed (see paragraphs 261 to 266) before the record copy is received. If any precautionary designations are confirmed after that time, a separate notification will be sent by the International Bureau after it has been informed by the receiving Office of the confirmation of the designations.

Rule 24.2(a) 295. **What should be done by the applicant when he receives the notification of receipt of the record copy?** The notification sent to the applicant (Form PCT/IB/301) contains the list of the designated Offices, which allows the applicant to check whether the list is correct and complete and whether the designations made in the request correctly reflect the applicant's intentions. Any errors or mistakes made in the designations may, in effect, be corrected by confirming the appropriate precautionary

designations (see paragraphs 261 to 266).

AMENDMENT OF THE CLAIMS UNDER ARTICLE 19

Article
19(1)
Rule 46

296. When and how may the claims of the international application be amended in the international phase? The applicant is entitled, under Article 19, to one opportunity to amend the claims of the international application in the international phase. (Further opportunities to amend the claims, and also the description and the drawings, are available during the international phase under Article 34 if, and only if, the applicant files a demand for international preliminary examination—see paragraphs 303, 345 to 349, and 393 to 397). Any amendment to the claims under Article 19 must be filed with the International Bureau, and must be in the language in which the international application is published (Chinese, English, French, German, Japanese, Russian or Spanish—see paragraphs 309 to 311). The opportunity to make amendments under Article 19 is available after the applicant has received the international search report and remains available until the end of 16 months from the priority date or two months after the transmittal (that is, the date of mailing) of that report, whichever expires later. Amendments received by the International Bureau after the time limit are still accepted if they have been received before the technical preparations for international publication have been completed. Amendments to the claims under Article 19 are not allowed where the International Searching Authority has declared, under Article 17(2), that no international search report would be established (see paragraph 280). (As to amendments in the national phase, see paragraphs 126, 142 and 178, and Volume II.)

Rule 6.1
46.5
Section
205

297. When filing amendments to the claims under Article 19, the applicant is required to file a replacement sheet for every sheet containing a claim which is amended. The replacement sheet or sheets must be accompanied by a letter drawing attention to the differences between the replaced sheets and the replacement sheets. Where an amendment results in the cancellation of an entire sheet of the international application as originally filed, the amendment (that is, the cancellation) is

evidenced only by the letter addressed to the International Bureau. Amendments may consist in the cancellation of one or more entire claims, in the addition of one or more new claims, or in the amendment of the text of one or more of the claims as filed. All the claims appearing on a replacement sheet must be numbered in Arabic numerals (corresponding to the order of the claims). Where a claim is cancelled, no renumbering of the other claims is required. However, where the applicant does renumber claims, they must be renumbered consecutively.

Section
205

298. The letter which must accompany the replacement sheets containing amendments to the claims must indicate the differences between the claims as filed and those as amended. This should be done by stating, in connection with each claim appearing in the international application, whether:

- (i) the claim is unchanged,
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed, etc.

Identical indications concerning several claims may be grouped. Samples are given in the Notes to Form PCT/ISA/220, which the applicant receives together with the international search report.

Article
19(1)
Rule 46.4
48.2(a)(vi)

299. **What is a statement accompanying an amendment?**

Any amendment may be accompanied by a brief statement by the applicant explaining the amendment and indicating any impact it might have on the description and the drawings. Such a statement is published together with the international application itself (see paragraphs 304 to 317). Statements not referring to a specific amendment are not permitted. The statement must not exceed 500 words if in English or when translated into English. It may not contain disparaging comments on the international search report or on the relevance of any of the citations contained in that report. References to certain citations in the report may be made only in connection with an amendment made to a specific claim. The statement must be in the language

in which the international application is published (see paragraphs 309 and 310).

Rule 300. A statement explaining the amendment is not to be
46.4(a) confused with and must be clearly distinguished from the letter
48.2(a)(vi) indicating the differences between the claims as filed and as
amended (see paragraph 298) and from the statement concerning
amendments which must be included in a demand for
international preliminary examination (see paragraphs 345 to
348). It must therefore be identified as such by a heading
“Statement under Article 19(1).” Where the statement does not
comply with the requirements, it is neither published by the
International Bureau nor communicated to the designated
Offices.

Article 301. **May the amended claims include new matter?** The
19(2) PCT provides that amendments are not to go beyond the
and (3) disclosure in the international application as filed. This
Rule requirement is not directly enforceable during Chapter I of the
66.2(a)(iv) international phase, but failure to comply with it may have
adverse consequences for the applicant during the international
preliminary examination and in the national phase (see
paragraphs 396 and 451).

Rule 302. **Should a copy of amendments under Article 19 be filed
53.9(a)(i) with the International Preliminary Examining Authority?** If
55.3 the applicant submits a demand for international preliminary
62.1 examination, he should file a copy of the amendment to the
62.2 claims under Article 19 with the International Preliminary
Examining Authority with the demand (if the amendment has
already been filed) or at the same time as he files the
amendment with the International Bureau (if the amendment is
filed after the demand). Where the International Preliminary
Examining Authority requires a translation of the international
application under Rule 55.2, the applicant should also furnish a
translation of any amendments made under Article 19 if he
wishes those amendments to be taken into account for
international preliminary examination under Rule 53.9(a)(i). The
International Bureau transmits a copy of any amendment
received prior to the filing of the demand to the International
Preliminary Examining Authority unless that Authority indicates
that it has already received a copy. If an amendment is received

after the demand has been filed, the International Bureau transmits a copy to the International Preliminary Examining Authority in any event, but timely filing of a copy by the applicant direct with that Authority ensures that the international preliminary examination will proceed without undue delay or uncertainty. See paragraphs 345 to 349 in connection with the demand form.

Article 34(2)(b)
Rule 48.2(f)
66.1(b)

303. In what circumstances should the claims be amended under Article 19? Since any amendments of the claims under Article 19 are published with the international application (see paragraph 307), such amendment may be useful to the applicant if there is a reason to better define the scope of the claims for the purposes of provisional protection in those designated States whose national law provides for such protection (see paragraph 317). It is to be noted that, where international preliminary examination takes place, the applicant has the right under Article 34(2)(b) to file amendments to the claims (as well as to the description and the drawings) with the International Preliminary Examining Authority, regardless of whether or not he has filed amendments to the claims under Article 19 with the International Bureau (see paragraphs 345, 349, 393 to 397, 449 to 451). There is therefore normally no need to amend the claims under Article 19 where a demand for international preliminary examination is filed, unless there is a particular reason related to provisional protection or otherwise for amending the claims before international publication.

INTERNATIONAL PUBLICATION

304. When and how is the international application published by the International Bureau? International applications are published by the International Bureau except in any of the following cases:

- Rule 20.7
- (i) if the international application is not accorded an international filing date by the receiving Office (see paragraphs 222 to 228);
- Article 21(5)
- (ii) if the international application is considered withdrawn before the technical preparations for

	publication have been completed;
Article 21(5)	(iii) if the international application is withdrawn by the applicant (see paragraphs 452 and 453) before the technical preparations for publication have been completed;
Article 64(3)	(iv) if the only designated State, or the only designated State remaining at the time of the completion of the technical preparations for publication, is the United States of America (since the United States of America made a declaration under Article 64(3)(a)), unless any of the exceptions specified in Article 64(3)(c) applies.
	305. When are the technical preparations for international publication completed? The technical preparations for publication are generally completed by the 15th day prior to the date of publication.
Article 21(2)	306. When does international publication take place? International publication takes place promptly after the expiration of 18 months from the priority date. However, when the applicant asks the International Bureau to publish his international application earlier, the International Bureau does so. If the applicant asks for early publication and the international search report or the declaration referred to in Article 17(2)(a) is not available for publication with the international application, a special fee, the amount of which is indicated in Annex B2 (IB), is payable to the International Bureau.
Rule 48.2(h) 48.4	
Section 113	
Article 21(3)	307. What constitutes international publication? International publication is effected in the form of a pamphlet containing the international application and, if available at the time of publication, the international search report or declaration by the International Searching Authority to the effect that no international search report will be established, and also any amendment, including any statement, under Article 19. Where the time limit for amending the claims has not expired at the time of the completion of the technical preparations for publication, the international application is published with an annotation accordingly, and any amendment received within the
Rule 48.1 48.2(a), (g) and (h)	
Section 404	

time limit is published later. Similarly, if the international search report or declaration by the International Searching Authority is not available, the international application is published with an annotation accordingly and the report or declaration is published separately after it has been received by the International Bureau. Each published international application is assigned an international publication number consisting of the code WO followed by an indication of the year and a serial number (for example, WO 02/123456). For further details governing international publication, see Article 21 and Rule 48.

Rule 308. On the same date as that on which the pamphlet is published, a corresponding entry is published in the *PCT Gazette* (a publication of the International Bureau). The *PCT Gazette* is published in electronic form and in paper form. In the *PCT Gazette* in electronic form, the entry corresponding to each published international application contains bibliographic data, the title of the invention, the abstract and a characteristic drawing (if any) of the international application; in the *PCT Gazette* in paper form, each entry contains the bibliographic data and the title of the invention.

Rule 86.1(a)(i)
Section 407(b)

Article 309. **In what language is the international application published?** If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish, it is published in the language in which it was filed. Where the language of publication is Chinese, French, German, Japanese, Russian or Spanish, the International Bureau prepares English translations of the title of the invention, the abstract and the international search report (or the declaration referred to in paragraph 280) and includes the translations in the pamphlet. The International Bureau also prepares, where applicable, French translations of the title and the abstract. The title and abstract are published in the *PCT Gazette* in electronic form (see paragraph 312).

Article 21(4)
Rule 45.1
48.3

Rule 310. If the international application is filed in a language which is a language other than Chinese, English, French, German, Japanese, Russian or Spanish and is a language accepted by the International Searching Authority for international search, it is published in English translation only. The English translation is prepared under the responsibility of the International Searching

Rule 48.3(b)

Authority against payment of a fee by the applicant (see paragraph 236). The applicant has an opportunity to make comments on the draft translation and, if he has any, the essence of his comments is included in the pamphlet in which the international application is published (see paragraph 307).

311. If the international application is filed in a language which is neither a language of publication (Chinese, English, French, German, Japanese, Russian or Spanish) nor a language accepted by the International Searching Authority for international search, it is published in the language of the translation furnished by the applicant (see paragraphs 229 to 236).

Rule 86.2(a) 312. The *PCT Gazette* in electronic form is published in English and in French, so that all bibliographic data, titles and abstracts, and any figure which appears on the front page of the pamphlet, are published in both languages. The *PCT Gazette* in paper form is published in a single bilingual (English/French) edition. Special Issues of the *PCT Gazette* (see paragraph 9) are published in separate English and French versions.

Rule 86.1(a)(i) 86.4 313. **How can copies of the pamphlet containing the published international application be obtained?** Anyone may obtain a copy of the pamphlet by ordering it from the International Bureau, preferably referring to its international publication number (if available). Published international applications are also available in CD-ROM form; details are available from the International Bureau.

Rule 86.1(a)(i) 86.4 314. **How can copies of the *PCT Gazette* in paper form be obtained?** The *PCT Gazette* in paper form may be obtained by subscription from the International Bureau (for the address, see Annex B2 (IB)). Single issues of the *PCT Gazette*, including special issues containing information of a general character, may also be obtained.

Rule 86.1(a)(i) 86.4 315. **How can the *PCT Gazette* in electronic form be accessed?** The *PCT Gazette* in electronic form is available on-line directly at <http://ipdl.wipo.int>. or via WIPO's Internet website at <http://www.wipo.int/pct/en/>. Information from the *PCT Gazette* in electronic form is reproduced also on CD-ROM; details are available from the International Bureau.

Rule 316. **How can copies of the priority document be obtained?**

4.10(b) Third parties who wish to receive a copy of the priority
17.2(c) document may apply to the Office with which the earlier application was filed, to certain designated Offices or to the International Bureau. The International Bureau furnishes copies of priority documents, after international publication of the international application, to any person upon request and subject to reimbursement of the cost. However, the International Bureau does not furnish such copies if, prior to the international publication, the international application was withdrawn, or the relevant priority claim was withdrawn or was considered not to have been made, or the relevant declaration of the priority claim was cancelled.

Article 29 **317. What are the legal effects of international publication?**
Article 29 has the effect of ensuring, with certain qualifications, that provisional protection is available after the international publication of an international application in the same way as it is after national publication of unexamined national applications. The qualifications are such as to enable Contracting States to make such protection conditional on the furnishing of translations (in some circumstances), on the expiration of 18 months from the priority date, and/or on receipt by the designated Office of a copy of the international application as published under the PCT. For further details, see Article 29. Annexes B1 and B2 indicate what the position is in each Contracting State.

Rule 94 **318. Can access be gained at the International Bureau to the file of an international application?** For international applications filed before 1 July 1998, the applicant or any person authorized by the applicant may, subject to reimbursement of the cost of the service, obtain copies from the International Bureau of any document contained in its file. For international applications filed on or after 1 July 1998, the International Bureau will, at the request of any person but not before the international publication of the international application and subject to Article 38, furnish, upon reimbursement of the cost of the service, copies of any document contained in its file (see paragraphs 474 to 476 for details concerning the confidentiality of international applications).

COMMUNICATION OF COPIES TO THE DESIGNATED OFFICES

- Article 20(1)(a) 319. **How and when do the designated Offices receive copies of the international application?** Subject to what is said in this paragraph and in paragraph 321, the International Bureau communicates a copy of the international application in the language in which the international application is published, to each designated Office, except for any Offices which have waived the requirement that they be sent the communication. Where the language in which the international application is published is different from the language in which it was filed, the International Bureau will furnish to any designated Office, upon the request of that Office, a copy of that application in the language in which it was filed. In practice, the communication is effected by sending a copy of the pamphlet (for details concerning the contents of the pamphlet, see paragraph 307). The International Bureau also sends a notice (Form PCT/IB/308) to the applicant informing him of the Offices to which the communication has been effected and of the date of such communication. Each designated Office is informed, separately from the communication, about the sending and the date of mailing of the notice to the applicant. The notice must be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notice. On receiving the notice, the applicant knows that he does not have to send a copy of the international application to any of the designated Offices indicated on it as having been sent the communication.
- Rule 47.1(a) and (c) 47.2
- Rule 47.1(b) 320. Again subject to what is said in paragraph 321, the International Bureau effects the communication of the international application promptly after its international publication. In any case, the International Bureau must effect the communication by the end of the 19th month from the priority date.
- Article 13 23(2) 40(2) Rule 31 321. A copy of the international application (albeit without the international search report) is communicated by the International Bureau, prior to the communication referred to in the preceding paragraphs, to any designated Office which so requests; this

47.4
61.2(d) transmittal may not be done before the expiration of one year from the priority date. It should be noted that, to date, no national or regional Office has asked for a copy of all the international applications designating it to be the subject of such an early communication. If he wishes, the applicant may at any time transmit, or ask the International Bureau to transmit, a copy of his international application to any designated Office. Such special transmittal by the International Bureau requires the payment of a fee, the amount of which is indicated in Annex B2 (IB). Further details are to be found in Article 13 and Rule 31. It is to be noted that transmittal in this way does not, unless expressly requested by the applicant, entitle the designated Office to start its processing of the international application. If, however, the applicant makes an express request to a designated or elected Office (under Article 23(2) or 40(2), respectively) for early commencement of national processing, the International Bureau then promptly effects the communication to the Office concerned upon request by the applicant or the designated or elected Office.

CHAPTER IX

INTERNATIONAL PRELIMINARY EXAMINATION UNDER CHAPTER II OF THE PCT

GENERAL

- Article 322. **What is international preliminary examination?**
31(1) International preliminary examination of an international
31(4)(a) application may be requested under Chapter II of the PCT to
32(1) obtain “a preliminary and non-binding opinion on the questions
33(1) whether the claimed invention appears to be novel, to involve an
inventive step (to be non-obvious), and to be industrially
applicable” (Article 33(1)). It is carried out by an “International
Preliminary Examining Authority” at the request—called
“demand”—of the applicant, for use before the “elected”
Offices, that is, those designated Offices which may be, and are
in fact, elected by the applicant for that purpose. Not every
applicant who has the right to file an international application
has the right to demand international preliminary examination,
and not every designated Office may be elected: the following
paragraphs explain who may make a demand and which
designated Offices may be elected.
- Article 323. **What are the main effects of the international
preliminary examination?** Since the criteria on which the
39(1) international preliminary examination is based (see
40(1) paragraph 322) correspond to internationally accepted criteria
64(2)(a)(i) for patentability, the international preliminary examination
and (ii) report gives the applicant the opportunity to evaluate the
chances of obtaining patents in elected Offices before incurring
the expense and trouble of entering the national phase.
Moreover, the fact that the carrying out of such an examination
has been demanded has the result that the national phase in each
designated State elected in the demand is normally delayed until
the expiration of 30 months from the priority date (longer times
apply in some elected Offices), provided that the demand is
submitted before the expiration of 19 months from the priority
date (Note, however, that the 30-month time limit applies in any
case, to a large number of designated Offices even if they have

not been elected within the 19-month time limit; see paragraph 46 for details). For further details, see paragraph 331, and also Volume II.

Article 38
Rule 94 324. With the exception that the fact that a demand has been filed and the names of those designated States that have not been elected are published in the *PCT Gazette*, the international preliminary examination procedure remains confidential between the applicant, the International Preliminary Examining Authority and the International Bureau. In respect of international applications filed before 1 July 1998, a copy of the international preliminary examination report, when it has been established, is sent by the International Bureau to each elected Office as well as the applicant, but is not available from the International Preliminary Examining Authority or the International Bureau to any other persons or Offices. In respect of international applications filed on or after 1 July 1998, copies of all documents contained in the file of the International Preliminary Examining Authority may be obtained by third parties via those elected Offices whose national law provides for access to the files of national applications (see also paragraphs 406 and 407, and 474 to 476).

MAKING A DEMAND FOR INTERNATIONAL PRELIMINARY EXAMINATION

Article
31(2)(a)
Rule 18.1
54 325. **On what conditions may a demand for international preliminary examination be submitted?** There are two conditions which have to be fulfilled for a demand to be submitted. First, the applicant—or, if there are two or more applicants, at least one of them—must be a resident or a national of a Contracting State bound by Chapter II of the PCT. Second, the international application must have been filed with the receiving Office of, or acting for, a Contracting State bound by Chapter II. Annexes A and B1 indicate whether or not each Contracting State is bound by Chapter II. Potential applicants who have residence and/or nationality in more than one Contracting State, and thus generally have a choice of receiving Office, should therefore file the international application with a receiving Office of or acting for a Contracting State bound by Chapter II if they wish to take advantage later of the international preliminary examination procedure. However, it should be

noted that the right to make a demand may be lost if, following a change in the applicants named in the international application, there is no longer, at the time the demand is made, at least one applicant who is resident or national of a Contracting State bound by Chapter II. The concepts of residence and nationality are defined in Rule 18.1 (see paragraph 63). If the applicant does not have the right to make a demand, the demand is considered not to have been submitted.

Article 31(4) 64(1) 326. **Which States may be elected?** Any Contracting State which has been designated in the international application and is bound by Chapter II of the PCT may be elected. Annexes A and B1 show, for each State, whether it is bound by Chapter II. In practice, the printed demand form (see Annex Y) contains a pre-marked check-box effecting the election of all eligible States (see paragraphs 350 to 352).

Article 31(3) 31(6)(a) 32(2) Rule 59 327. **Where should the demand for international preliminary examination be submitted?** The demand must be made separately from the international application, and be submitted directly to an International Preliminary Examining Authority which is competent to carry out international preliminary examination on the international application concerned. Each receiving Office (except the International Bureau as receiving Office—see paragraph 49) specifies one or more International Preliminary Examining Authorities as competent to carry out international preliminary examination on international applications filed with it. In addition, different International Preliminary Examining Authorities may be competent in relation to an international application depending on the language in which the international application was filed and on which International Searching Authority carried out the international search. Where several International Preliminary Examining Authorities are competent in relation to a particular international application, having regard to which receiving Office the international application was filed with and the language of the international application, the applicant may choose between them. Where the international application is filed with the International Bureau as receiving Office, the competent International Preliminary Examining Authority (or Authorities) is that (or are those) which would have been competent if the international application had been filed with a competent national (or regional) Office as receiving Office. The International Preliminary Examining Authority or Authorities competent for international applications filed with each national (or regional) Office acting as receiving Office, and the languages accepted for international preliminary examination by each International Preliminary

Examining Authority, may be ascertained by consulting Annexes C and E. Finally, within the framework of the respective agreements relating to the functioning of certain Offices as International Preliminary Examining Authorities, these Authorities may provide for limitations of their competence in respect of certain international applications. In practice, the European Patent Office has limited its competence in respect of international applications for which demands are filed on or after 1 March 2002 by applicants who are nationals or residents of certain States where these applications contain one or more claims relating to certain fields of technology. For more detailed information, see Annex E.

- Rule 59.3(a), (b) and (e) 328. If a demand is submitted to a receiving Office, an International Searching Authority, an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, or the International Bureau, that Office or that Authority or the International Bureau, as the case may be, will mark on it the date of receipt, which will be considered to be the date on which the demand was received on behalf of the competent International Preliminary Examining Authority.
- Rule 59.3(c) and (f) 329. When a demand is filed with 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 may send the demand either directly to the competent International Preliminary Examining Authority, or to the International Bureau which will in turn forward the demand to the competent International Preliminary Examining Authority.
- Rule 59.3(c) and (d) 330. If two or more International Preliminary Examining Authorities are competent, the applicant will be invited, by the Office or Authority to which the demand was submitted, or by the International Bureau, as the case may be, 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. Where the applicant furnishes that indication, the demand will promptly be transmitted to the competent International Preliminary Examining Authority. Where no indication is so furnished, the demand will be considered not to have been submitted, and the Office or Authority to which the demand was submitted, or the International Bureau, as the case may, will declare that the demand is considered not to have been submitted.

Article
39(1)
Rule 69.2

331. At what stage of the procedure should the demand for international preliminary examination be submitted? There are no time limits in the PCT before or after which the demand must be submitted. However, in respect of some Offices (see paragraph 46), in order to secure the full effect of the demand—including the delaying of the national phase until 30 months from the priority date—it must be submitted before the expiration of 19 months from the priority date. Since international preliminary examination will normally not start before the international search report is available (see paragraphs 377 to 381), the applicant will normally wish to take cognizance of that report before deciding whether to proceed further on his quest for patent protection. On the other hand, the length of time available for the international preliminary examination depends on the earliest possible submission of the demand after the international search report is available, since the international preliminary examination report must in most cases be established before the expiration of 28 months from the priority date (see paragraph 400). The more time is available for the international preliminary examination, the better will be the result and quality which can be expected. Therefore, a demand should be filed as soon as possible after the applicant's evaluation of the international search report has shown that it is worthwhile to pursue the international application further.

TRANSLATION OF INTERNATIONAL APPLICATION FOR THE PURPOSES OF INTERNATIONAL PRELIMINARY EXAMINATION

Rule 55.2

332. What happens if the international application was filed or published in a language which is not accepted by the International Preliminary Examining Authority? Where neither the language in which the international application was 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 must furnish with the demand a translation of the international application into a language which is both a language accepted by that Authority, and a language of publication. No such translation is required where the International Searching Authority and the International Preliminary Examining Authority are part of the same national Office or intergovernmental organization, in which case the international preliminary examination will be carried out on the basis of the translation furnished for the purposes of the international search (see

paragraphs 230 to 233). Details about the languages accepted for international preliminary examination by the various International Preliminary Examining Authorities appear in Annex E. See paragraph 302 in connection with the need to file a translation of amendments under Article 19.

THE DEMAND

Article
31(3)
Rule 53
Section
102(b)(i)
and (j)

333. **What requirements as to form, contents and language must the demand for international preliminary examination comply with?** The demand must either be made on a printed form to be filled in with the required indications or be presented as a computer print-out complying with the Administrative Instructions. To facilitate preparation of the demand, the International Bureau has prepared downloadable PDF (portable document format) versions on its website. There are two PDF versions of the form, an editable form, that may be downloaded and completed using a computer, and a simple PDF form, that may be printed out and filled in using a typewriter. The demand, and instructions on how to complete the editable version, is available in the following languages:

- English at <http://www.wipo.int/pct/en/forms/index.htm>
- French at <http://www.OMPI.int/pct/fr/forms/index.htm>
- German at <http://www.wipo.int/pct/de/forms/index.htm>
- Spanish at <http://www.OMPI.int/pct/es/forms/index.htm>

A specimen completed form appears in Annex H, and a blank copy of the printed form, which may be photocopied for use in requesting international preliminary examination, appears in Annex Y. Copies of printed forms may also be obtained, free of charge, from the receiving Office or the International Preliminary Examining Authority. Details of the requirements for the demand if presented as a computer print-out are set out in Annex J.

Rule 53
55.1

334. The completed demand must identify the applicant and the international application to which it relates. Applicants for States which are not elected in the demand are not required to be indicated. The demand contains a petition that the international application be the subject of international preliminary examination. It must indicate at least one elected State from among the States designated in the international application; that is automatically accomplished by the pre-printed

statement appearing in Box No. V of the printed demand form—see paragraphs 350 to 352 and Annex Y. It must, where applicable, contain a statement concerning amendments, on the basis of which the international preliminary examination will start (see paragraphs 346 and 347) and an indication of the language in which international preliminary examination will be carried out. The demand must 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, where a translation of the international application is required because the International Preliminary Examining Authority accepts neither the language in which the international application is filed nor the language in which the international application is published (see paragraphs 54 and 332), the demand must be in the language of that translation. The demand must be signed (see paragraphs 354, 355, and 436 to 442). Details for the filling in of the demand form are given below in respect of each Box of that form. Where more than one International Preliminary Examining Authority is competent in relation to the international application (see paragraph 327), the Authority chosen by the applicant, and with which the demand is filed, should be identified, preferably by an indication of the name or two-letter code of the Authority (see Annex K), at the top of the first sheet of the demand form in the space provided for that purpose.

Box No. I: Identification of the International Application

- Rule 53.6 335. **What are the requirements with respect to the identification of the international application?** The international application must be identified by its international application number, filing date and title. If the international application number is not known to the applicant at the time of filing of the demand, the name of the receiving Office with which the international application was filed must be indicated. The title of the invention must be the same as that which appears in the pamphlet (that is, the same as that indicated in the request, unless it was modified by the International Searching Authority—see paragraph 288).
336. It is recommended that the applicant indicate his file reference, if any, not exceeding 12 characters in length, in the box provided for this purpose on the first sheet of the demand form (see paragraphs 58 and 120 in relation to the request and the description).
337. Indication of the priority date on the demand is not mandatory, but

is recommended since it will assist the International Preliminary Examining Authority to ascertain promptly whether or not the demand was filed before the expiration of 19 months from the priority date.

Box No. II: Applicant(s)

Article
31(2)
Rule 4
53.4
53.5
54.1
54.2

338. Who may file a demand for international preliminary examination? What indications are required? If there is a sole applicant, he must be a resident or national of a Contracting State bound by Chapter II of the PCT. If there are two or more applicants, it is sufficient that one of them be a resident or national of a Contracting State bound by Chapter II, regardless of the elected State(s) for which each applicant is indicated. Only applicants for the elected States are required to be indicated in the demand. The detailed requirements for the various indications required in connection with each applicant (full names and addresses, telephone, facsimile and/or teleprinter numbers and, where available, e-mail and/or Internet addresses, nationality and residence) are the same as those required under Rule 4 in connection with the request (see paragraphs 63 to 72). Where the applicant is registered with the International Preliminary Examining Authority, the number or other indication under which the applicant is so registered may also be indicated in Box No. II. Note that any inventor who is not also an applicant is not indicated in the demand. Where a question of the applicant's residence or nationality arises, the International Preliminary Examining Authority will 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 and will inform the applicant of such request. The applicant has the opportunity to submit arguments relating to the issue of residence or nationality directly to the Office concerned, which will decide the question promptly.

Rule
92bis.1

339. Who should be indicated if there has been a change in the name or person of the applicant? If the recording of a change in the name or person has been requested under Rule 92bis.1 before the demand was filed (see paragraphs 427 to 431), it is the applicant(s) of record at the time when the demand is filed who must be indicated in the demand.

Box No. III: Agent or Common Representative

340. **Does the applicant have to be represented by an agent before the International Preliminary Examining Authority?** No, the applicant is not obliged to be represented by an agent, but he may be, and in most cases it is highly advisable for him to be represented (see paragraph 4).

Article 49
Rule 2.2
90.1(a)
and (c)

341. **May the applicant be represented by an agent before the International Preliminary Examining Authority?** Yes, he may. He may be represented by the agent who represented him for the filing of the international application (if any) or by another agent having the right to practice before the receiving Office with which the international application was filed (see Annex C). He may also be represented by an agent appointed specifically for the purposes of the international preliminary examination procedure and chosen from among those persons who have the right, according to the rules applicable in the national or regional Office acting as International Preliminary Examining Authority, to practice before that Office (see Volume II). See paragraphs 410 to 423 for more information about representation.

Rule
53.2(a)(ii)
53.5
90

342. **When and how may an agent be appointed for the purposes of the procedure concerning the international preliminary examination?** If an agent has already been appointed for the filing of the international application, that agent may also represent the applicant for the purposes of the international preliminary examination procedure and may sign the demand on behalf of the applicant. Alternatively, a different agent or an additional agent may be designated in the demand for international preliminary examination or in a separate power of attorney. The detailed requirements for the various indications required in connection with each agent (full names and addresses, telephone, facsimile and/or teleprinter numbers and, where available, e-mail and/or Internet addresses) are the same as those required under Rule 4 in connection with the request (see paragraph 80). Where the agent is registered with the International Preliminary Examining Authority, the number or other indication under which the agent is so registered may also be indicated in Box No.III. Further information about the manner of appointing agents, including sub-agents, appears in paragraphs 410 to 423.

Rule 2.2*bis*
90.2

343. **May the applicants be represented by a common representative?** The provisions relating to common representatives which apply at earlier stages (see paragraph 84) continue to be applicable during the international preliminary examination procedure. That is, if no common agent is appointed, one of the applicants may be appointed by the other applicants as the common representative of all the applicants,

and if neither a common agent nor a common representative is appointed, the applicant named first in the request who is entitled to file an international application with the receiving Office concerned will be considered to be the common representative (“deemed common representative”) (see paragraph 415).

344. What other provisions apply to agents and common representatives during the international preliminary examination procedure? The same general provisions apply to agents and common representatives during the international preliminary examination as apply during other stages of the international phase (for example, in relation to their legal position and revocation and renunciation of appointments—see paragraphs 410 to 423).

**Box No. IV: Basis for International Preliminary Examination
(Statement Concerning Amendments and Indication of the Language
for the Purposes of International Preliminary Examination)**

Article
34(2)(b)
Rule
66.1(b)
and (d)

345. Can the applicant amend the claims, the description and the drawings before and during the international preliminary examination? The applicant has the right, under Article 34(2)(b), to amend the claims, the description and the drawings before the start of the international preliminary examination and also during the examination, if time permits, until the preparation of the international preliminary examination report. (As far as the claims are concerned, this is in fact the second opportunity to amend them before the international preliminary examination starts; the first opportunity is offered by the possibility of submitting amendments under Article 19 to the International Bureau as described in paragraphs 296 to 301, and 303.) For further details concerning amendments under Article 34(2)(b), see paragraphs 349, 393 to 397, 449 to 451.

Rule
53.2(a)(v)
53.9

346. What is the purpose of indicating the basis for international preliminary examination? Do the statement concerning amendments and the indication of the language for the purposes of the international preliminary examination have to be filled in?

(i) The statement concerning amendments should be completed, since it enables the International Preliminary Examining Authority to identify those documents which will serve as the basis for the start of the international preliminary examination with a view to starting it as soon as possible after receipt of the demand. However, failure to complete the

statement or to complete it correctly is not fatal to the application. In particular, if no amendments have been filed under Article 19 or Article 34 and if the applicant does not wish to file such amendments at the time when he files the demand, the result will simply be that the international preliminary examination will start on the basis of the international application as originally filed. The applicant will not be precluded from making amendments at a later stage of the international preliminary examination, provided that they reach the International Preliminary Examining Authority in sufficient time to be taken into account. On the other hand, if there have been amendments but they are not indicated, or if the applicant wishes later to file amendments but does not so indicate, the start of the international preliminary examination may be delayed or the applicant may find that there is insufficient time at a later stage to have his intended amendments taken into account.

(ii) Completing the indication of the language for the purposes of the international preliminary examination and its associated check-boxes helps the International Preliminary Examining Authority determine quickly, with a view to starting international preliminary examination as soon as possible after receipt of the demand, whether the demand and the international application are in a language accepted by that Authority, or whether a translation of the international application is required. Completing the indication also helps the International Preliminary Examining Authority decide whether any amendments filed with the demand (see paragraph (i) above) are in the appropriate language.

347. How should the statement concerning amendments be completed? If amendments to the claims have been made under Article 19 (see paragraphs 296 to 301) prior to the filing of the demand, the statement must indicate whether, for the purposes of the international preliminary examination, the applicant wishes the amendments to be taken into account (in which case a copy of the amendments should be filed with the demand) or to be considered as reversed by an amendment under Article 34. If no amendments under Article 19 have been made but the time limit for filing such amendments (see paragraph 296) has not expired at the time when the demand is filed, the statement may, if the applicant so chooses, indicate that the applicant wishes the start of the international preliminary examination to be postponed (see paragraph 380). If any amendments under Article 34 are submitted with the demand, the statement must so indicate. A more detailed explanation is given below for each of the check-boxes in Box No. IV.

“1. The applicant wishes the international preliminary examination to start on the basis of:

“ the international application as originally filed”

This check-box should be marked either where the applicant has not made any amendments under Article 19 and does not intend at the time of filing the demand to file any amendments, or where the applicant has already made amendments under Article 19 but is no longer interested in pursuing them.

“the description as originally filed

as amended under Article 34

the claims as originally filed

as amended under Article 19 (together with any accompanying statement)

as amended under Article 34

the as originally filed

drawings

as amended under Article 34”

These check-boxes should be marked only where the applicant wishes amendments to be taken into account for the start of the international preliminary examination. Where the applicant wishes amendments which have previously been made under Article 19 to be taken into account, a copy of the amendments, and any statement accompanying such amendments, should be attached to the demand. Amendments under Article 34 should be submitted with, and attached to, the demand. The applicant should also indicate, by marking the appropriate check-box(es), which parts of the international application are so amended.

Rule
53.9(a)(ii)

“2. The applicant wishes any amendments to the claims made under Article 19 to be considered as reversed.”

This check-box should be marked only where the applicant, after having previously made amendments under Article 19, no longer wishes them to be considered for international preliminary examination. Marking this check-box will have the effect that those amendments will be considered as reversed by an amendment under Article 34.

Rule

“3. The applicant wishes the start of the international preliminary

53.9(b)
69.1(d)

examination to be postponed until the expiration of 20 months from the priority date unless the International Preliminary Examining Authority receives a copy of any amendments made under Article 19 or a notice from the applicant that he does not wish to make such amendments (Rule 69.1(d)). *(This check-box may be marked only where the time limit under Article 19 has not yet expired.)*”

This check-box should be marked only where, at the time when the demand is filed, the time limit for filing amendments under Article 19 has not expired (see paragraph 296) and the applicant intends to file such amendments after filing the demand. In practice, this situation is only likely to arise if the demand is filed before the international search report is available. If this check-box is marked but the applicant later decides not to file amendments under Article 19, he should send a notice to the International Preliminary Examining Authority that he does not wish to file such amendments and the international preliminary examination will then start. If, at the expiration of 20 months from the priority date, the International Preliminary Examining Authority has received neither amendments under Article 19 nor a notice that the applicant does not wish to file such amendments, the international preliminary examination will start in any event.

348. **May several check-boxes be marked in Box No. IV?** Yes—for example, under item (1), two or three check-boxes may be marked if the applicant has already filed amendments to the claims under Article 19 and wishes those amendments to be taken into account along with further amendments under Article 34 to the description and/or drawings (and possibly further amendments to the already amended claims).

Rule
66.1(b)
66.4bis

349. **May the applicant make amendments during the international preliminary examination in addition to any amendments mentioned in Box No. IV?** Yes. The applicant is not precluded from later making amendments, or further amendments, during the course of the international preliminary examination (see paragraphs 393 to 397), whatever appears in the statement concerning amendments, and in this sense the statement is not binding on the applicant or the conduct of the international preliminary examination. For example, the applicant may choose to file amendments under Article 34 at a later stage which supersede amendments previously made under Article 19, even though the statement indicates that those previous amendments should be taken into

account. However, the information contained in the statement is used by the International Preliminary Examining Authority to determine when, and on what basis, the international preliminary examination is to start (see paragraphs 377 to 381). Moreover, 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 the Authority has begun to draw up that opinion or report (see paragraph 394). Since the time available for international preliminary examination is limited, it is in the applicant's interests to be as definite as possible, at the time of filing the demand, as to what should form the basis of the international preliminary examination. If the applicant intends to file amendments under Article 34 but is not in a position to submit them with the demand, that intention should preferably be mentioned in a letter filed with the demand.

Box No. V: Election of States

- Rule 350. **Which States may be elected?** Only Contracting States which are bound by Chapter II of the PCT (see Annexes A and B1) and which have been designated in the international application (that is, States which have been specifically designated under Rule 4.9(a) in the request (see paragraphs 87 to 90), States whose designations have been confirmed under Rule 4.9(c) (see paragraphs 91, 92 and 261 to 266), and States whose designations are considered as having been made under Rule 32.2(a)(i) (see paragraphs 491 to 496)) can be elected. They are the “eligible States.”
- Rule 351. **How should elections be indicated in the demand?** For the convenience and protection of applicants, Box No. V of the printed demand form (see Annex Y) contains a pre-printed statement to the effect that all eligible States are automatically elected. It is only if the applicant does not wish to elect certain eligible States that the names or two-letter codes of the States concerned must be indicated in Box No. V, after the words “excluding the following States which the applicant wishes not to elect”. Note that the fees payable in respect of filing the demand do not include any separate fee for electing States and do not depend on the number of elections made (see paragraphs 360 to 368). For more details about the ways in which elections may be indicated, see Rule 53.7(b).
352. **Should an indication be made of the kind of protection sought?**

The indication in the demand of the kind of protection or treatment desired for any elected State is not required since it follows from the indication made when designating that State in the international application.

Box No. VI: Check List

353. **What is the purpose of the Check List?** The Check List in Box No. VI should be completed by the applicant to allow the International Preliminary Examining Authority to verify the completeness of the documents filed with the demand. Of particular importance in the Check List are the indications relating to amendments referred to in the statement concerning amendments. The indications given in the Check List should correspond with the indications given in Box No. IV.

Box No. VII: Signature of Applicant, Agent or Common Representative

- Rule 53.4
53.8
90.3
354. **Who must sign the demand?** The demand must be signed by the applicant or, if there is more than one applicant, by all the applicants making the demand—that is, the applicants for the States which are elected. However, an agent or common representative may sign the demand on behalf of the applicant or applicants who appointed him. The demand may be signed on behalf of all the applicants by an appointed common agent or common representative, or by the applicant who is considered to be the common representative (“deemed common representative”) if no common agent or common representative has been appointed (see paragraph 415). For the case where an applicant/inventor for the United States of America is unwilling to sign or cannot be found or reached, see paragraphs 436 to 442.
- Rule 2.3
355. **When must or may a seal be used instead of a signature?** In the demand or other papers filed with the China Intellectual Property Office as International Preliminary Examining Authority, a seal may be used instead of a signature. In the case of a demand or other papers filed in English with the European Patent Office as International Preliminary Examining Authority in respect of international applications filed with the Japan Patent Office as receiving Office, a signature must be furnished instead of a seal. In the demand or other papers filed with the Korean Intellectual Property Office as International Preliminary Examining

Authority, a seal must be used instead of a signature (see paragraph 110 in respect of the request).

Notes to the Demand Form

356. **What are the Notes to the demand form?** The Notes to the demand form (see Annex Y) are intended to facilitate the completion of that form. They indicate, in relation to each Box of the form, what indications are required and how they are to be made. The Notes are not required to be filed with the demand.

Fee Calculation Sheet

357. **What is the fee calculation sheet?** The fee calculation sheet is intended to help the applicant calculate the total amount of fees payable to the International Preliminary Examining Authority. The sheet is usually annexed to the printed demand form which the applicant obtains from the receiving Office or the International Preliminary Examining Authority. It is not part of the form, however, and its use is not mandatory. Nevertheless, it is strongly recommended that the applicant complete the fee calculation sheet and submit it to the International Preliminary Examining Authority. This will help the International Preliminary Examining Authority verify the calculations and identify any errors. See the Notes to the fee calculation sheet at Annex Y for details about completion of the sheet. For further information about the payment of fees, see paragraphs 360 to 368.

LATER ELECTIONS

Article
31(4)(a)
and (6)(b)
Rule 56

358. **Can designated States be elected after the submission of the demand for international preliminary examination? How? How long after?** As stated in paragraph 334, the demand must contain the election of at least one designated State. Additional States may be elected later, provided that they qualify for election as indicated in paragraph 326. In practice, however, since the printed demand form includes a pre-printed statement in Box No. V which has the effect that all eligible States are automatically elected, later elections will generally not need to be made unless a designated State which was not bound by Chapter II at the time when the demand was filed subsequently becomes bound by that Chapter. Such "later election" is effected by a notice signed as for the demand (see

paragraphs 354 and 355) submitted to the International Bureau (not to the International Preliminary Examining Authority). It must be made in the language in which the demand has been submitted. A blank copy of the printed form which may be photocopied and used for effecting later elections appears in Annex Z. Copies of the form may also be obtained free of charge from the International Bureau. For further details, see Rule 56. If the start of the national phase is to be delayed in the elected Office concerned until 30 months from the priority date (see paragraphs 46 and 331), the later election must be effected before the expiration of 19 months from the priority date. As to the later election of a successor State to which the effects of the international application have been extended under Rule 32, see paragraphs 491 to 495.

Rule 359. Later elections must be made:
53.7(b)(ii)
56.1(a)

(i) in the case of States which have been designated for the purpose of obtaining national patents, by an indication of those eligible States (see paragraph 350) that are elected, and

(ii) 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.

FEES

Article 360. **What fees are payable in respect of a demand for international preliminary examination?** There are two kinds of fees which have to be paid in connection with the demand:

Rule 58.1(a) and (c) (i) the “preliminary examination fee,” which is fixed by and accrues to the International Preliminary Examining Authority, mainly for carrying out the international preliminary examination and for establishing the international preliminary examination report;

Rule 57.1 (ii) the “handling fee,” which is fixed in the Schedule of Fees to the PCT Regulations and accrues to the International Bureau for carrying out various tasks, including, where required, the translation

of the international preliminary examination report into English (see paragraph 364).

361. Is any fee payable for effecting an election or a later election? There is no “election fee” similar to the designation fee due in connection with designations made in the request. The only fees payable for filing a demand are those specified in paragraph 360. No fees are payable in connection with the making of later elections.

Rule 57.1
58.1(c) **362. To whom are these fees payable?** The preliminary examination fee and the handling fee are payable to the International Preliminary Examining Authority, which forwards the handling fee to the International Bureau.

Rule 57.2(c)
58.1(c) **363. In what currency are these fees payable?** Generally, the preliminary examination fee and the handling fee are payable in the currency or one of the currencies prescribed by the International Preliminary Examining Authority. Complete information on this question is contained in Annex E.

Rule 57.2(a)
57.3
58.1(b) **364. What are the amounts of these fees?** Annex E indicates the amounts of the preliminary examination fee and the handling fee.

365. A reduction of the preliminary examination fee charged by certain International Preliminary Examining Authorities may be available to applicants from the States mentioned in paragraph 366—see Annex E for further details.

366. 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 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) is entitled, in accordance with the Schedule of Fees annexed to the PCT Regulations, to a reduction of 75% of the handling fee. A list of such PCT Contracting States may be found in the Notes to the Fee calculation sheet annexed to the demand form. If there are several applicants, each must satisfy the above-mentioned criteria. The reduction of the fee will be automatically available to any applicant (or applicants) who is (or are) so entitled on the basis of the indications of name, nationality and residence given in the international application. The fee reduction will be available even if one or more of the applicants are not from PCT Contracting States, provided

that each of them satisfies the above-mentioned criteria and that at least one of them is a national or resident of a PCT Contracting State bound by Chapter II and thus is entitled to file a demand. The PCT Contracting States whose nationals and residents are eligible for the fee reduction, as outlined above, are listed in Annex C (IB). As far as other States are concerned, inquiries should be addressed to the International Bureau.

Rule 57.3
58.1(b) 367. **When are these fees due?** The preliminary examination fee and the handling fee must be paid within one month from the date on which the demand was submitted, provided that, where the demand was transmitted to the competent International Preliminary Examining Authority under Rule 59.3, the handling fee must be paid within one month from the date of receipt by that Authority. As to the consequences of non-payment or late payment of these fees, see paragraphs 372 and 375.

Rule 54.4
57.6
58.3 368. **In what cases are these fees refunded?** The International Preliminary Examining Authority will refund the handling fee if the demand is withdrawn before being sent to the International Bureau or if the demand is considered not to have been submitted because none of the applicants had the right to file a demand (see paragraph 325). Each International Preliminary Examining Authority decides at its discretion whether it will refund the preliminary examination fee, or any part thereof, in other circumstances. Details are indicated in Annex E.

PROCESSING OF THE DEMAND FOR INTERNATIONAL PRELIMINARY EXAMINATION

Rule
60.1(a)
60.2(a)
61.1 369. **What happens to the demand for international preliminary examination and any later election once they are received?** The International Preliminary Examining Authority promptly notifies the applicant of the date of receipt of the demand, and then examines the demand to ascertain whether it meets all the requirements. If it does not, the International Preliminary Examining Authority invites the applicant to comply. The International Bureau observes a similar procedure for later elections submitted to it. For full details on the correction of defects in the demand, see Rule 60.1 and paragraphs 372 to 376.

Article
31(7)
Rule
61.1(a)
61.2 370. The International Preliminary Examining Authority sends the demand or a copy thereof to the International Bureau. The International Bureau then notifies Offices of their election and informs the applicant that it has done so. For full details, see Rules 61.2 and 61.3. In addition, where the demand has been filed before the expiration of 19 months from

61.3	the priority date, the International Bureau, promptly after the filing of the
61.4	demand but not before the international publication, publishes in the <i>PCT</i>
Section	<i>Gazette</i> information on the demand and the elected States concerned, as
431	provided in the Administrative Instructions.
Article	371. What action can the applicant take if the indications on the
31(2)(a)	demand form do not support the applicant's right to file the demand?
Rule	If the indications of the applicant's residence and nationality given in Box
61.1(b)	No. II of the demand form do not support the applicant's right to file a
Section	demand with the International Preliminary Examining Authority
614	concerned (see paragraph 325), the International Preliminary Examining
	Authority notifies the applicant that the demand is considered not to have
	been submitted. It may happen, however, that those indications were
	incorrectly stated or that the applicant in fact had a residence and/or
	nationality supporting the applicant's right to file the demand. In such a
	case, evidence should immediately be submitted indicating that, in fact,
	the applicant had, on the date on which the demand was received by the
	International Preliminary Examining Authority, the right to file the
	demand with that Authority. If that evidence is to the satisfaction of the
	Authority, it will then regard the requirements of Article 31(2)(a) as
	having been fulfilled on the date of actual receipt of the demand, and the
	indications in the demand can be corrected.
	372. Can defects in the demand for international preliminary
	examination, non-compliance with certain language requirements,
	non-payment of certain fees and defects in later elections be
	corrected, and if so how? What are the consequences? If the
	International Preliminary Examining Authority finds that
Article	(i) the demand does not meet the requirements as to form, contents
31(3)	and languages (see paragraph 333),
Rule 53	
55.1	
Rule 57.3	(ii) the handling fee was not paid within one month from the date
	on which the demand was submitted or, where the demand was
	transmitted to the competent International Preliminary Examining
	Authority under Rule 59.3, within one month from the date of
	receipt by that Authority, or was not paid in the prescribed currency
	(see paragraphs 360 and 363), or
Rule	(iii) the preliminary examination fee was not paid within one month

58.1(b)
Rule 58*bis*
60.1(b)

from the date on which the demand was submitted or, where the demand was transmitted to the competent International Preliminary Examining Authority under Rule 59.3, within one month from the date of receipt by that Authority, or was not paid in the prescribed currency (fixed by the International Preliminary Examining Authority—see paragraphs 360 and 363), it invites the applicant to correct the defect(s) and comply with the requirements and/or to pay the required fee(s). In the case of defects as to form or language, the invitation specifies a time limit of at least one month from the date of the invitation, which time limit may be extended by the International Preliminary Examining Authority at any time before a decision is taken. In the case of defects as to fee payment, the invitation specifies a time limit of one month from the date of the invitation; a late payment fee may also be required; no extension of this time limit is available. However, any payment must be considered to have been received before the expiration of the applicable time limit if it is received by the International Preliminary Examining Authority before the expiration of the time limit for paying the fee(s) or, where an invitation to pay missing fees has been sent, before that Authority makes the declaration that the demand is considered not to have been made.

Rule
60.1(b)
61.1(b)

373. There is no adverse consequence for the applicant, other than possibly delaying the start of the international preliminary examination (see paragraph 376), if he complies with the invitation within the time limit so specified (including any extensions, where applicable), except where the defect was that the demand did not contain the election of at least one State (see paragraph 334) or did not permit the international application to be identified. In the latter cases, the demand is considered to have been received on the date on which the required correction to it is received, and the International Preliminary Examining Authority informs the applicant of that date.

Rule
60.1(c)
and (d)
61.1(b)

374. If, after the expiration of the time limit specified (including any extensions), a signature or other required indication is still lacking in respect of an applicant for a certain elected State, the election concerned will be considered as if it had not been made. If there are other defects which have not been corrected within that time limit, the demand is

considered not to have been submitted and the International Preliminary Examining Authority will so declare.

Rule 56
60.2 375. A similar invitation procedure, with similar consequences, is initiated by the International Bureau if it finds that a notice effecting a later election does not comply with the requirements as to form, contents and language (see paragraph 358).

Article
39(1)(a) 376. Where the demand or later election is considered to have been received, as described in paragraph 373, on a date later than that on which it was actually submitted, the effect of postponing the commencement of the national phase (see paragraph 323) is lost if that later date is after the expiration of 19 months from the priority date. That effect is also lost where the demand or notice effecting the later election is considered not to have been submitted, or (in relation to the elected State concerned) where an election is considered not to have been made (see paragraphs 374 and 375).

THE INTERNATIONAL PRELIMINARY EXAMINATION

Rule
69.1(a) 377. **When does the international preliminary examination start?** Subject to the exceptions mentioned in paragraphs 378 to 381, the International Preliminary Examining Authority starts the international preliminary examination when it is in possession both of the demand and of the international search report or a declaration by the International Searching Authority that no international search report will be established. Substantive examination will not commence, however, until any defects in the demand have been corrected and any unpaid fees have been paid (see paragraphs 372 to 376).

Rule
69.1(b) 378. If the competent International Preliminary Examining Authority is part of the same (national or regional) Office as the competent International Searching Authority, the international preliminary examination may, if the Office wishes and except where the applicant has requested that the international preliminary examination be postponed (see paragraph 380), start at the same time as the international search (often called a “telescoped” procedure since the international search and international preliminary examination partly overlap).

Rule
53.9(a)(i)
62 379. Where the statement concerning amendments made in the demand contains an indication that amendments under Article 19 are to be taken into account, the International Preliminary Examining Authority will not

69.1(c) start the international preliminary examination before it has received a copy of the amendments concerned. Therefore, a copy of those amendments should be attached to the demand by the applicant in order to allow as much time as possible for the international preliminary examination (see paragraphs 302, 346 and 347). The International Bureau will, in any event, send a copy of those amendments to the International Preliminary Examining Authority unless that Authority has indicated that it has already received a copy (see paragraph 302), but waiting for that copy to be sent may delay the start of the international preliminary examination.

Rule 380. Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (see paragraph 347), the International Preliminary Examining Authority will not start the international preliminary examination before whichever of the following occurs first:

53.9(b)
69.1(d)

- (i) it has received a copy of any amendments 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.

Therefore, where the applicant gives such an indication in the demand, he should ensure that the International Preliminary Examining Authority is informed promptly of any amendments or of any decision on his part not to file amendments, in order to gain the maximum time possible for the international preliminary examination procedure.

Rule 381. Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (see paragraph 347), but no such amendments are, in fact, submitted with the demand, the International Preliminary Examining Authority will not start the international preliminary examination before it has received the amendments or before it has invited the applicant to file them and the time limit fixed in that invitation has expired, whichever occurs first. Where the international preliminary examination is carried out on the basis of a translation of the international application (see paragraph 332), any such amendments, and any amendments under Article 19 which are to be taken into account, must be in the language of that translation. Where such amendments have been or are filed in another language, a translation of the amendments into the language in which the international preliminary

examination is carried out must also be furnished (see also paragraph 450).

Rule 66.7 382. **May the International Preliminary Examining Authority ask for the priority document and a translation of it?** If the International Preliminary Examining Authority needs a copy of an application the priority of which is claimed in the international application (“the priority document”) and the International Bureau already has the priority document in its possession (see paragraph 99), the International Bureau furnishes a copy of it to the Authority on request. Should the applicant have failed to provide the priority document under Rule 17.1, the international preliminary examination report may be established as if the priority had not been claimed, but no elected Office may later disregard the priority claim under those circumstances before giving the applicant an opportunity to furnish the priority document within a time limit which is reasonable under the circumstances. Where the priority document is in a language other than the language or one of the languages indicated for the International Preliminary Examining Authority in Annex E, and that Authority is of the opinion that the validity of the priority claim is relevant for the formulation of the opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable, the Authority may invite the applicant to furnish to it a translation in that language. The applicant must comply with that invitation within two months from its date; otherwise, the international preliminary examination report may be established as if the priority had not been claimed.

Article 33(1) 383. **What is the purpose of the international preliminary examination?** As already stated in paragraph 322, the purpose of the international preliminary examination is to formulate an opinion—which is “preliminary” (since a final opinion will be formulated only in the national phase by the national or regional Patent Office or by a competent national or regional court) and “non-binding” (on anyone, including elected Offices)—on whether the claimed invention appears (i) to be novel, (ii) to involve an inventive step (to be non-obvious), and (iii) to be industrially applicable. While there is not a fully uniform approach to these criteria in national laws, their application under the PCT during the international preliminary examination procedure is such that the international preliminary examination report gives a good idea of the likely results in the national phase.

Article 384. For the purposes of the international preliminary examination, a

- 33(2) claimed invention is considered novel if it is not anticipated by the prior art. Rule 64 defines “prior art” for the purposes of the examination.
- Rule 64
- Article 385. For the purposes of the international preliminary examination, a claimed invention is considered to involve an inventive step if, having regard to the prior art as defined in the Regulations (see paragraph 384), it is not, at the prescribed relevant date, obvious to a person skilled in the art. For further details, see Rule 65.
- 33(3) Rule 65
- Article 386. For the purposes of the international preliminary examination, a claimed invention is considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry.
- 33(4)
- Rule 66.1 387. **What documents form the basis of the international preliminary examination?** The international preliminary examination is based on the claims, the description and the drawings comprised in the international application. Amendments to the claims under Article 19 made before the demand was filed are taken into account unless they are superseded by a subsequent amendment under Article 34 (see paragraph 349) or considered as reversed by an amendment under Article 34 (see paragraph 347). Amendments made after the demand is filed, whether under Article 19 or under Article 34, are also taken into account for the purposes of the international preliminary examination, except that they need not be taken into account for the purposes of a written opinion or the international preliminary examination report if they are received after the International Preliminary Examining Authority has begun to draw up that opinion or report. As to the allowability of amendments in general, see paragraph 451.
- 66.4bis
- Rule 66.2(a)(vi) 388. **What happens if no international search report has been established in respect of certain claims?** Claims relating to inventions in respect of which no international search report has been established (see paragraphs 279 to 287) need not be the subject of international preliminary examination and any written opinion, as well as the international preliminary examination report, will so indicate.
- Rule 13ter.1(e) 389. **What special requirements apply during the international preliminary examination to nucleotide and/or amino acid sequence listings?** Where the International Preliminary Examining Authority finds that an international application contains disclosure of a nucleotide and/or amino acid sequence and that a listing of the sequences complying with the standard provided for in Annex C of the Administrative Instructions

(see paragraph 118) has not already been furnished (either as part of the international application or for the purposes of international search—see paragraphs 119 to 119D—or for the purposes of international preliminary examination, as the case may be), that Authority may invite the applicant to furnish a listing complying with that standard. If the International Preliminary Examining Authority finds that the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in Annex C of the Administrative Instructions, it may invite the applicant to furnish a listing to it in such a form. The listing(s) (in paper and/or in computer readable form) required by the International Preliminary Examining Authority is (are) for the purposes of carrying out the international preliminary examination; the application of the requirements of national law in relation to disclosure of inventions involving sequence listings is a matter for the national phase of processing.

- Rule 66.2 390. **What matters concerning the international application may be the subject of comment by the International Preliminary Examining Authority?** The International Preliminary Examining Authority notifies the applicant in a “written opinion” if it considers that
- Article 34(4)(a)(i)
35(3)(a)
Rule 66.2(a)(i)
67 (i) the international application relates to subject matter on which it is not required to carry out an international preliminary examination, and decides not to carry out such an examination (this situation being the same as the one described in paragraph 279 in relation to the international search),
- Article 34(4)(a)(ii)
Rule 66.2(a)(i) (ii) the description, the claims or the drawings are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness) or industrial applicability of the claimed invention (this situation being the same as the one described in paragraph 280 in relation to the international search),
- Rule 66.2(a)(ii) (iii) the international preliminary examination report should be “negative” (see paragraph 401) 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 (be non-obvious), or does not appear to be industrially applicable,
- Rule (iv) any amendment goes beyond the disclosure in the international

- 66.2(a)(iv) application as filed (see paragraphs 396 and 451),
- Rule 66.2(a)(v) (v) the international preliminary examination report should be accompanied by (unfavorable) observations on the clarity of the claims, the description and the drawings, or on the question of the claims being fully supported by the description,
- Rule 66.2(a)(vi) (vi) a claim relates to an invention in respect of which no international search report has been established (see paragraphs 279 to 287) and the International Preliminary Examining Authority has decided not to carry out the international preliminary examination in respect of that claim,
- Rule 66.2(a)(vii) (vii) 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 (similarly to paragraph 118 in relation to the international search),
- Rule 66.2(a) (viii) the national law applied by the national Office which acts as the 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) (this situation being the same as the one described in paragraphs 128 and 280 in relation to the international search).
- Rule 66.2(a)(iii) 391. The Authority also proceeds as indicated in paragraph 390 where it notices some defect in the form or contents of the international application. Where observance of the unity of invention requirement (see paragraphs 129 to 138) is in question, see paragraph 398.
- Rule 66.2 66.4(a) 392. **What is a “written opinion”?** A “written opinion” is a notification, issued by the International Preliminary Examining Authority to the applicant, which indicates any comments by the Authority on the matters mentioned in paragraph 390. The written opinion must fully state the reasons for it, must invite the applicant to submit a written reply and must fix a time limit for the reply (usually two months, but extendible at the applicant’s request—for more details, see Rule 66.2(d)). There may be no written opinion if the Authority has no such comments to make (in which case the Authority will proceed direct to the issuance of the international preliminary examination report). The Authority may issue one or more additional written opinions if time permits, particularly if the applicant

makes a prompt and serious attempt to address the Authority's comments by argument or amendment.

Article 34(2)(a) and (d)
Rule 66.2(b), (c) and (d)
66.3
66.4
66.5
66.6
66.8

393. How may the applicant react to a written opinion by the International Preliminary Examining Authority? May the applicant amend the international application at this stage? The applicant may ask for further clarifications from the International Preliminary Examining Authority and may himself give clarifications to it, since the PCT expressly provides that the applicant has a right to communicate orally, by telephone or personally, or in writing with the Authority (Article 34(2)(a); see also Rule 66.6). More specifically, where the applicant receives a written opinion from the Authority on any of the matters referred to in paragraphs 390 and 391, he may respond to that written opinion (see Article 34(2)(d)). The response may consist of amendments and/or arguments. Any change—other than the rectification of obvious errors (see paragraphs 443 to 448)—in the claims, the description or the drawings (including cancellation of claims, omission of passages in the description or omission of certain drawings) is considered an amendment. For the form of amendments, see paragraph 397. If the International Preliminary Examining Authority issues one or more additional written opinions, the applicant's reaction possibilities are the same as in the case of the first written opinion. The applicant may request the International Preliminary Examining Authority to give him one or more additional opportunities to submit amendments or arguments if sufficient time remains.

Rule 66.4*bis*

394. Will amendments and arguments always be taken into account? Amendments and arguments submitted will be taken into account if they are received in sufficient time. In view of the limited time available for international preliminary examination, however, it is in the applicant's interest to reply as soon as possible to any written opinion. 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 the Authority has begun to draw up that opinion or report.

395. It should be noted that the International Preliminary Examining Authority cannot force the applicant to make any change in the international application. In other words the applicant may disregard any opinion of the said Authority, either wholly or in part. Such an attitude may lead to an unfavorable or less favorable international preliminary examination report. but

the applicant may prefer such a report (in the hope that he will overcome, in the national phase, any difficulties that it may cause him) to a change which he does not believe in.

Article 34(2)(b) 396. **May amendments include new matter in the international application?** As for amendments under Article 19 (see paragraph 301), amendments under Article 34(2)(b) may not go beyond the disclosure in the international application as filed. If the International Preliminary Examining Authority considers that any amendments do not comply with this requirement, it will comment accordingly in any written opinion and in the international preliminary examination report, and the report will be established as if such amendment had not been made (see also paragraph 451).

Rule 11.14 397. **What must be done to effect amendments to the international application before the International Preliminary Examining Authority?** The applicant must submit a replacement sheet for every sheet which, on account of an amendment, differs from the sheet previously filed. The amendment must be submitted with a letter which explains the difference between the replaced sheet and the replacement sheet and which preferably explains the reasons for the amendment. Where the amendment consists in the deletion of passages or in minor alterations or additions, the alterations or additions 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. No replacement sheet is required where the amendment results in the cancellation of an entire sheet; such an amendment may be communicated in a letter which preferably explains the reasons for the amendment. For amendments to the claims, see also paragraphs 297 and 298 in relation to the international search, which apply *mutatis mutandis*. Where the international preliminary examination is carried out on the basis of a translation of the international application, any amendments must be in the language of that translation. Where such amendments have been or are filed in another language, a translation of the amendments into the language in which the international preliminary examination is carried out must also be furnished (see paragraphs 54, 332 and 450). No fee is payable in respect of filing any amendments

under Article 34(2)(b).

Rule 68
70.13

398. What happens where the International Preliminary Examining Authority finds that “unity of invention” is lacking? If the International Preliminary Examining Authority considers that the international application does not comply with the unity of invention requirement (see paragraphs 129 to 138 for the notion of “unity of invention”), it may choose between two courses of action: it may carry out the international preliminary examination on the entire international application and express its views on the lack of unity of invention in the international preliminary examination report, or it may invite the applicant, at his option, either to restrict the claims so that they meet the requirement (in which case the Authority must specify at least one possibility of restriction) or to pay additional fees (since the preliminary examination fee is calculated to cover cases where unity of invention exists). If the applicant chooses to restrict the claims as required, the examination is carried out on the claims as restricted. If the applicant chooses to pay the additional fees, the international preliminary examination report is carried out on the claims for the main invention and those claims in respect of which additional fees were paid, and the report will indicate that such additional fees have been paid. The additional fees may be paid under protest, in which case procedures similar to those explained in relation to the international search apply (see paragraphs 285 and 286). If the applicant neither restricts the claims nor pays additional fees, the examination is carried out on the main invention as identified by the International Preliminary Examining Authority or the applicant, or in cases of doubt as defined in Rule 68.5 (namely, the invention first mentioned in the claims is considered to be the main invention).

Article
34(3)

399. A finding of lack of unity of invention may continue to be important during the national phase. Any elected Office which agrees with the finding of lack of unity may, during the national procedure, require the applicant to restrict the claims or to divide the application into a number of divisional applications, or to pay special fees in order to maintain those parts of the international application which do not relate to the main invention (for further details, see Article 34(3)).

THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT

Article 35(1) Rule 69.2 **400. When must the international preliminary examination report be established?** The international preliminary examination report must be established within 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date or eight months from the date of payment of the handling and preliminary examination fees or eight months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2, whichever expires last (see paragraphs 377 to 381). Thus, under normal circumstances, the applicant receives the report, at the latest, two months before national processing at the elected Offices may start. This ensures that he has time to consider whether, and in which elected Offices, he wants to enter the national phase and to prepare the necessary action (for details, see Volume II).

Article 35(1) and (2) Rule 70 Section 604 **401. What are the form and contents of the international preliminary examination report?** The international preliminary examination report contains, among other things, a statement (in the form of a simple “yes” or “no”), in relation to each claim which has been examined, on whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability. The statement is, where appropriate, accompanied by the citation of relevant documents together with concise explanations pointing out the criteria to which the cited documents are applicable and giving reasons for the International Preliminary Examining Authority’s conclusions. Other matters which may be included in the report are listed in paragraphs 390 and 391. Where applicable, the report also includes remarks relating to the question of unity of invention (see paragraph 398). A filled-in sample of an international preliminary examination report is shown in Annex I. For more details, see Article 35(1) and (2), Rule 70 and Section 604.

Rule 70.16 **402. How are amendments to the international application referred to in the international preliminary examination**

report? The international preliminary examination report identifies the basis on which it is established—that is, whether, and if so, which, amendments have been taken into account. Replacement sheets containing amendments under Article 19 and/or Article 34 which have been taken into account and replacement sheets containing rectifications of obvious errors authorized under Rule 91 are attached as “annexes” to the international preliminary examination report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 (see paragraph 347) or which have been superseded by later replacement sheets, or amendments resulting in the cancellation of entire sheets, are not annexed to the report; neither are the letters which accompany replacement sheets.

Article 35(2) 403. **May the international preliminary examination report express a view on the patentability of the invention?** No, it may not. Article 35(2) expressly states that “the international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law.” It should be noted that, in this context, “national law” includes regional patent treaties (the ARIPO Harare Protocol, the Eurasian Patent Convention, the European Patent Convention and the OAPI Agreement).

Rule 70.17 404. **In what language is the international preliminary examination report established? Are translations prepared?**
72 The international preliminary examination report and any
74 annexes are established in the language in which the international application is published—see paragraphs 309 to 312)—except where the international preliminary examination is carried out on the basis of a translation (see paragraphs 54, 332 and 334), in which case the international preliminary examination report and annexes are established in the language of that translation. Each elected State may require that the report, if it is not in (one of) the official language(s) of its national Office, be translated into English. If this is the case, the translation of the body of the report is prepared by the International Bureau, which transmits copies to the applicant and to each interested elected Office. If any elected Office requires a

translation of annexes to the report, the preparation and furnishing of that translation is the responsibility of the applicant.

Article 36(1)
Rule 71.1
72.3

405. How do the applicant, the International Bureau and the elected Offices receive the international preliminary examination report and, where applicable, its translation?

The International Preliminary Examining Authority transmits, on the same day, copies of the international preliminary examination report (and any annexes—see paragraph 402) to the applicant and the International Bureau. The latter transmits copies of the report (including any annexes) to the elected Offices, as well as a translation into English of the body of the report where that is required by any elected Office; a translation of any annexes, if required, must be prepared and sent to the elected Offices concerned by the applicant himself (see paragraph 404 and Volume II of the *Guide*). If, in the opinion of the applicant, there are errors in the translation of the international preliminary examination report, he may send written observations on such errors to any interested elected Office and must send a copy of such observations to the International Bureau. As far as comments on the content of the international preliminary examination report itself are concerned, they should be addressed to the elected Offices during the national phase.

Article 38(1)
Rule 94

406. Is the preliminary examination report accessible to persons other than the applicant and the elected Offices?

The report is not published by the International Bureau, and the International Bureau may give copies of it only to the elected Offices. The International Preliminary Examining Authority may not, unless requested or authorized by the applicant, give copies to anyone other than the applicant and the International Bureau. Once the international preliminary examination report becomes part of the file in the elected Office, however, the national law applicable by that Office applies as to access to that report and the international preliminary examination file by persons other than the applicant, as indicated in paragraph 474.

Article 38(2)
Rule 94

407. To what extent is the international preliminary examination confidential?

Neither the International Bureau nor the International Preliminary Examining Authority may, unless

requested or authorized to do so by the applicant, give information on the issuance or non-issuance of an international preliminary examination report or on the withdrawal or non-withdrawal of the demand or of any election. Information from the international preliminary examination file may, however, be available through some elected Offices. For further explanation of the extent to which the international application is treated as confidential and of the possibilities for third parties to obtain information concerning the international preliminary examination, see paragraphs 474 to 476.

Article 36(4) Rule 71.2 408. **How can the applicant obtain copies of the documents cited in the international preliminary examination report?**

The applicant may obtain copies of those documents cited in the international preliminary examination report which were not cited in the international search report by requesting them from the International Preliminary Examining Authority. Annex E indicates the fees charged by such Authorities for furnishing copies on request.

409. **What is the effect and usefulness of the international preliminary examination report in the national phase?** Since the international preliminary examination report contains an opinion on the compliance of the international application with internationally accepted criteria of novelty, inventive step (non-obviousness) and industrial applicability, it provides the applicant with a strong basis on which to evaluate the chances of obtaining patents in the various Offices in the national phase. The additional time before entry into the national phase which is achieved by the use of the international preliminary examination procedure also affords the applicant a greater opportunity of assessing the technical value and commercial prospects of the invention. While the international preliminary examination report is not binding on elected Offices, it carries considerable weight with them, and a favorable international preliminary examination report will assist the prosecution of the application before the elected Offices. An elected Office which is the same national or regional Office as that which carried out the international preliminary examination as International Preliminary Examining Authority under the PCT will generally proceed rapidly to the grant of a patent in the national phase if

the international preliminary examination report is favorable to
the international application

CHAPTER X

MISCELLANEOUS QUESTIONS CONCERNING THE INTERNATIONAL PHASE

REPRESENTATION BY AGENTS AND COMMON REPRESENTATIVES

Rule 90.1 410. **For what purposes may an agent be appointed?** The applicant may appoint an agent or agents to represent him before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority—that is, for the purposes of the international phase generally. The applicant may also appoint an agent or agents to represent him specifically before the International Searching Authority or before the International Preliminary Examining Authority. Agents appointed for the purposes of the international application during the international phase will not be automatically regarded as agents by national Offices during the national phase; other agents may thus have to be appointed for the purposes of the national phase before each of the various designated Offices (see Volume II).

Article 49
Rule 83.1*bis*
90.1 411. **Who may be appointed as an agent?** A person may be appointed as agent for the international phase generally if he has the right to practice before the Office with which the international application is filed. Where the international application is filed with the International Bureau as receiving Office (see paragraph 49), any person who has the right to practice before the national (or regional) 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 (see Annex C) may be appointed as agent. A person may be appointed as agent to represent the applicant specifically before the International Searching Authority or before the International Preliminary Examining Authority if he has the right to practice before the Office or intergovernmental organization which acts as that Authority.

The right to practice before an Office or organization is governed by the national law applied by the Office or organization concerned.

412. Are all applicants required to have the same agent?

Each applicant is free to appoint his own agent. Ordinarily, however, it will be convenient for all of two or more applicants to appoint the same person to represent all of them as their “common agent” (or to appoint a number of common agents—for example, the partners in the firm of patent attorneys or patent agents which acts for the applicant).

Rule 90.1(d)

413. Can an agent appoint a sub-agent? Any agent who has been appointed to represent the applicant for the international phase in general may appoint a sub-agent to represent the applicant, unless there is an indication otherwise in the document by which the original agent was appointed. Sub-agents may be appointed to represent the applicant either generally or before a specific International Searching Authority or International Preliminary Examining Authority. A sub-agent’s appointment is subject to the same qualifications as to the right to practice as are set out in paragraph 411.

Article 9
Rule 2.2bis
90.2(a)

414. What is a “common representative” of the applicants? Where there are two or more applicants and they have not appointed a common agent representing all of them for the purposes of the international phase in general, one of the applicants may be appointed by the other applicants as their common representative. A person may only be appointed as common representative if he is a national or resident of a Contracting State and thus is entitled himself to file an international application.

Rule 2.2bis
90.2(b)
90bis.5

415. What happens if no common agent or common representative is specifically appointed? If there are two or more applicants and they do not appoint a common agent or a common representative, the first-named applicant who has the right to file an international application with the receiving Office concerned (see paragraphs 60 to 63) will automatically be considered to be the common representative of all the applicants (“deemed common representative”). Such “deemed

common representative” may do most of the things which an appointed agent or an appointed common representative may do on behalf of all the applicants, including signing the demand and many other documents for the purposes of the PCT. However, the “deemed common representative” may not validly sign, on behalf of the other applicants, the request itself or a notice effecting withdrawal of the international application, a designation, a priority claim, the demand or an election. If the “deemed common representative” has himself appointed an agent, that agent is able to perform any act which could be performed by the “deemed common representative” himself on behalf of the other applicants, including the signing of certain documents with effect for all the applicants (but, similarly, not the request or a notice of withdrawal).

- Rule 90.4(a) 416. **How is an agent or common representative appointed?** The appointment of an agent or common representative may be effected in the request and or the demand (see paragraphs 78 to 85, and 340 to 344) in a separate power of attorney (see paragraph 417) or in a general power of attorney (see paragraph 418). Where there are two or more applicants, a common agent or common representative, representing all of them, may be appointed by a combination of those methods, provided that each applicant signs either the request, the demand or a power of attorney.
- Rule 90.4 417. **What are the requirements with respect to a separate power of attorney?** Where an appointment of an agent or common representative is effected by a separate power of attorney, that power of attorney must be submitted to either the receiving Office or the International Bureau. However, a separate power of attorney appointing an agent or sub-agent to represent the applicant specifically before the International Searching Authority or the International Preliminary Examining Authority must be submitted to that Authority. See Annex Z for a suitable model form for a separate power of attorney.
- Rule 90.5 418. **Can an agent be appointed by a general power of attorney to represent the applicant in relation to any international application filed by that applicant?** Yes, such

a general appointment can be made. The original general power of attorney must be filed with the receiving Office if the appointment was for the purposes of the international phase generally, or with the International Searching Authority or International Preliminary Examining Authority if the appointment was specifically to represent the applicant before that Authority. The appointment will then be effective in relation to any particular application filed by that applicant provided that the general power of attorney is referred to in the request, the demand or a separate notice, and that a copy of the general power of attorney is attached to that request, demand or separate notice. That copy of the signed original need not, itself, be separately signed. See Annex Z for a suitable model form for a general power of attorney.

Rule 90.3

419. What is the legal position of an agent or common representative? Any act by or in relation to an agent or common representative has the effect of an act by or in relation to the applicant or applicants whom the agent represents for the purposes of the procedure before the receiving Office, International Bureau, International Searching Authority and/or International Preliminary Examining Authority, depending on whether the appointment was for general purposes or for the purposes of the procedure before a particular authority (see paragraph 410). In particular, an agent or common representative is able to sign documents in connection with the international application on behalf of the applicants. However, an applicant who is the “deemed common representative” (see paragraph 415) may not sign notices of withdrawal on behalf of the other applicants (see paragraphs 452, 454, 460 and 462). If there are two or more agents representing the same applicant or applicants, an act by or in relation to any of those agents has the effect of an act by or in relation to that applicant or those applicants.

Rule 90.6(a)

420. Can the appointment of an agent or a common representative be revoked? Yes, it can. The document containing the revocation must be signed by the persons who made the appointment or by their successors in title. The appointment of a sub-agent may also be revoked by the

applicant concerned. If the appointment of an agent is revoked, any appointment of a sub-agent by that agent is also considered revoked.

Rule 90.6(b) and (c) 421. The appointment of an agent for the international phase in general automatically has the effect, unless otherwise indicated, of revoking any earlier such appointment of an agent. The appointment of a common representative similarly has the effect, unless otherwise indicated, of revoking any earlier appointment of a common representative.

422. The rules for signing and submission of a power of attorney apply *mutatis mutandis* to a revocation of an appointment (see paragraphs 416 and 417).

Rule 90.6(d) and (e)
Section 425 423. **How can an agent or common representative renounce his appointment?** Renunciation of an appointment may be made by means of a notification signed by the agent or common representative. The rules for signing and submission of a power of attorney apply *mutatis mutandis* to a renunciation (see paragraphs 416 and 417). The applicant is informed of the renunciation by the International Bureau.

CORRESPONDENCE TO THE APPLICANT

Section 108(b) 424. **To whom will correspondence be addressed by the various authorities under the PCT?** Where there is a sole applicant in relation to an international application, correspondence will be sent to the applicant at his indicated address; or, if he has appointed one or more agents, to that agent or the first-mentioned of those agents; or, if he has not appointed an agent but has indicated a special address for notifications (see paragraphs 69 and 86), at that address.

Section 108(c) 425. Where there are two or more applicants who have appointed one or more common agents, correspondence will be addressed to that agent or the first-mentioned of those agents. Where no common agent has been appointed, correspondence will be addressed to the common representative (either the appointed common representative or the applicant who is the “deemed common representative”— see paragraphs 414 and 415) at his indicated address; or, if the

common representative has appointed one or more agents, to that agent or the first-mentioned of those agents; or, if the common representative has not appointed an agent but has indicated a special address for notifications, at that address.

Section
108(d)

426. Where one or more agents have been appointed specifically to represent the applicant(s) before the International Searching Authority or the International Preliminary Examining Authority, correspondence will be addressed by the Authority concerned to that agent or the first-mentioned of those agents.

CHANGES CONCERNING THE APPLICANT, INVENTOR, AGENT OR COMMON REPRESENTATIVE

Rule 92*bis*
Section 422

427. **What should be done where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative?** Where there is a change in the person, name, residence, nationality or address of the applicant, or in the person, name or address of the inventor, agent or common representative, the applicant or the receiving Office should ask the International Bureau to record the change. If so requested, the International Bureau records the change and notifies all Offices and PCT Authorities interested in the change accordingly. Any such recording is free of charge. If the request for a change in the person of the applicant is made by the applicant himself or by his agent, it is not necessary to produce for the International Bureau any assignment or other document by means of which the change in the person of the applicant was effected. Assignments and other documents relating to the right to file the international application may, however, be required by the designated Offices once national processing has started; Volume II gives the details on this matter.

428. It is not necessary, in order for a change in the person of the applicant to be recorded, that the new applicant be a resident or national of a PCT Contracting State; the PCT does not contain any restriction as to whom an international

application may be assigned. The applicant's right to file the international application is determined on the basis of the applicant(s) indicated in the request at the time when the international application is filed (see paragraph 60). However, the residence and nationality of the new applicant must be borne in mind in considering whether that applicant has the right to file a demand for international preliminary examination (see paragraphs 338 and 339).

- Article 22(1) 429. The request for recording of the change must be made
39(1)(a) in writing and may be sent either
Section to the receiving Office or to the International Bureau. The
422(a)(iii) International Bureau records the change if the request for
recording is received by it before the expiration of the
applicable time limit, which, with effect from 1 April 2002
and in respect of applications for which the period of 20
months from the priority date expires on or after 1 April 2002,
is exactly 30 months (regardless of the precise time limit
applicable, Office by Office, such as 31 months or later) from
the priority date, regardless of whether a demand for Chapter
II has been filed before the expiration of 19 months from the
priority date, and regardless of whether any of the Offices
designated has notified the International Bureau that the
modification of PCT Article 22(1) is incompatible with its
applicable national law. The International Bureau will also
notify all designated Offices of any such changes. The legal
effect of the recorded change will vary from Office to Office.
In any case, as is generally the case, Offices are entitled to
require additional evidence or documents in the national
phase regarding any change requested during the international
phase (for information on the Offices which require additional
documents in the national phase, including a new request for
change specifically for the national phase before a particular
Office, see the relevant Summary). If the request is made
shortly before the expiration of the time limit indicated above,
it is recommended that it be sent directly to the International
Bureau so as to be actually received by the latter on time.
- Rule 90.3 430. Where the request for a change in the person of the
applicant is made by a person not yet named in the request
(hereinafter referred to as "the new applicant") without the

written consent of the applicant, a copy of an assignment or other documentary evidence supporting the change in person must be filed with the request for the change. Where the request for a change in the person of the applicant is made by an agent of the new applicant, a power of attorney signed by the new applicant must be furnished at the same time.

Rule 90.3
92*bis*.1(a)

431. Where the request for a change in the person of the applicant is made by the agent of record, a power of attorney appointing the agent, signed by the new applicant, should be furnished at the same time, if the agent is to represent the new applicant.

DEATH OF APPLICANT OR INVENTOR

Article 27(2)
Rule
92*bis*.1(a)

432. **What should be done in the case of the death of the applicant during the international phase?** The answer to this question depends on the national law applicable in such a case. The successor to the rights of the applicant (whether his heir, a legal representative, the estate represented by a legal representative, etc.) should be indicated as the new applicant, and a request for such a change to be recorded accordingly should be made under Rule 92*bis*.1 (see the procedure outlined in paragraphs 427 to 431). The reason for the requested change must be indicated. Documentary evidence proving the right to the application is not required during the international phase (although it may be required by any designated Office for the purposes of the national phase of processing) except in the case referred to in paragraph 430.

Article 27(3)
Rule 18.4(c)
92*bis*.1(a)

433. If the deceased applicant was the inventor and if the United States of America, which requires that the applicant be the inventor, is designated, the legal representative or the heir of the deceased applicant/inventor must be named as the new applicant for the United States of America. A request should be made for the recording of a change in the person of the applicant in such a case, as follows (for instance): “SMITH, Alfred, legal representative of JONES, Bernard (deceased)” or “SMITH, Alfred, heir of JONES, Bernard (deceased),” and the residence, nationality and address of the legal representative or heir should be indicated rather than those of

the deceased applicant/inventor.

Article 9
Rule 18.1

434. What should be done if the inventor died before the international application was filed? In such a case, the request must indicate the name of the deceased inventor with an indication that he is deceased, for instance: “JONES, Bernard (deceased).” For the case of a designation for which the inventor must be the applicant, see paragraph 433. In the latter case, since the right of the applicant to file the international application (see paragraph 60) depends on the nationality or residence of the heir or the legal representative, his nationality and residence must be indicated.

435. What should be done in the case of the death of the inventor during the international phase? In such a case, no action is required, except if the United States of America is designated (in which case, what is said in paragraph 433 applies).

APPLICANT/INVENTOR UNAVAILABLE OR UNWILLING TO SIGN THE INTERNATIONAL APPLICATION OR OTHER DOCUMENTS

Article
14(1)(a)(i)
14(1)(b)
Rule 26.2
Section 316

436. What must be done if the applicant is temporarily unavailable to sign the international application? Where an applicant is temporarily unavailable, the international application can be filed without his signature. The lack of an applicant’s signature or of a power of attorney signed by him is a correctable defect under Article 14(1)(a)(i) and (b), and can be remedied by filing a copy of the request (or, where the request has been signed by an agent, of a power of attorney) duly signed by the applicant within the time limit fixed by the receiving Office for the correction of this defect (see paragraph 240).

Rule 4.15(b)

437. Can the international application proceed if an applicant/inventor for the United States of America refuses to sign the request or cannot be found or reached? The PCT provides a special procedure, where two or more applicants file an international application designating the United States of America, which enables the international application to proceed if an applicant/inventor for the United

States of America refuses to sign or cannot be found or reached after diligent effort. This procedure makes an exception to the general rule that all applicants must sign the request (or a separate power of attorney appointing an agent who does sign the request). Its operation is limited to signature of the request by applicants for the purposes of the designation of a State whose national law requires that national applications be filed by the inventor (the United States of America is the only Contracting State to have such a requirement in its national law—see paragraphs 61 and 73).

Rule 4.15(b) 438. It is provided by Rule 4.15(b) that, where an applicant/inventor for the designation of the United States of America refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant/inventor 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. If such a statement is furnished to the satisfaction of the receiving Office, the international application complies with the requirements of Article 14(1)(a)(i) for the purposes of all designated States (including the United States of America) without adverse consequences in the international phase. However, additional proofs may be required by the United States Patent and Trademark Office after entry into the national phase if the required oath or declaration by the inventor (see Volume II) is not signed by all the applicant/inventors.

Article 14(1)(b)
Rule 26.2 439. **What time limit applies for the furnishing of a statement explaining a lack of signature of an applicant/inventor for the United States of America?** The lack of a signature constitutes a defect under Article 14(1)(a)(i), and the statement must thus be filed within the time limit set by the receiving Office for correction of such defects in accordance with Article 14(1)(b) and Rule 26.2. That time limit is fixed, in each case, in the invitation by the receiving Office to correct any defects under Article 14(1)(a); the time limit must be reasonable under the circumstances, must be not less than one month from the date of the invitation, and may be extended by the receiving Office

at any time before a decision is taken under Rule 26. (See paragraphs 240 and 244.)

440. What is the consequence if a satisfactory statement explaining a lack of signature of an applicant/inventor for the United States of America cannot be furnished? If the request lacks the signature of an applicant/inventor for the United States of America and a satisfactory statement cannot be furnished for the purposes of Rule 4.15(b), the international application will be considered withdrawn.

Rule 53.8(b)
56.1(c)
90bis.5

441. Do similar provisions apply to excuse non-signature of other documents connected with the international application? Provisions similar to Rule 4.15(b) apply to excuse a lack of signature by an applicant/inventor for the United States of America of certain other documents connected with the international application, provided that a similar statement is furnished explaining the lack of signature to the Office or Authority concerned. These documents are the demand, any notice of a later election, and a notice of withdrawal of the international application, a designation, a priority claim, the demand or an election. Note, however, that the signatures of all the applicants are not required for all of those documents—for example, the demand may be signed by the common representative (including an applicant who is the “deemed common representative”—see paragraph 415).

442. The following documents will also be accepted without the signature of an applicant/inventor for the United States of America in the circumstances specified:

Rule
53.8(b)(ii)

(i) the demand need not, under Rule 53.8(b), be signed by the applicant/inventor concerned if he did not sign the request but that lack of signature was explained in a statement, to the satisfaction of the receiving Office, under Rule 4.15(b) (see paragraph 438);

Rule
56.1(c)(ii)

(ii) a notice effecting a later election need not, under Rule 56.1(c), be signed by the applicant/inventor concerned if he did not sign the request or the demand but that lack of signature was explained in a statement, to the satisfaction of the receiving Office or the

- International Preliminary Examining Authority, under Rule 4.15(b) or 53.8(b), respectively;
- Rule 90*bis*.5(b)(ii) (iii) a notice of withdrawal of the international application, a designation or a priority claim need not be signed by the applicant/inventor concerned if he did not sign the request but that lack of signature was explained in a statement, to the satisfaction of the receiving Office, under Rule 4.15(b);
- Rule 90*bis*.5(b)(iii) (iv) a notice of withdrawal of the demand or of an election need not be signed by the applicant/inventor concerned if he did not sign the demand or the later election, but that lack of signature was explained in a statement, to the satisfaction of the International Preliminary Examining Authority or the International Bureau under Rule 53.8(b) or 56.1(c), respectively.

RECTIFICATION OF OBVIOUS ERRORS

- Rule 91 443. **Can obvious errors be rectified by the applicant?** Obvious errors in the international application or other papers submitted by the applicant may generally be rectified if the rectification is authorized, as required, within the applicable time limit. Any such rectification is effected free of charge.
- Rule 91.1(b) and (c) 444. Only errors due to the fact that something other than what was obviously intended was written in the international application or other paper can be rectified. The rectification itself must be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification. Omissions of entire elements or sheets of the international application are not rectifiable, even if clearly resulting from inattention at the stage, for example, of copying or assembling sheets.
- Rule 91.1(e) 445. **Do rectifications of obvious errors need to be authorized by a PCT authority?** Rectifications must be authorized:
- (i) if the error is in the request—by the receiving

Office;

(ii) if the error is in the description, the claims, the drawings or the abstract—by the International Searching Authority, or by the International Preliminary Examining Authority where the international application is pending before the latter Authority;

(iii) if the error is in any paper other than the international application or amendments or corrections to it—by the International Bureau.

446. Where and when must a request for rectification be sent? The request for rectification must be addressed to the authority competent to authorize the rectification (see paragraph 445). It must be filed in time for the rectification to be authorized and for notification of the authorization to reach the International Bureau before the expiration of the applicable time limit, namely:

Rule
91.1(g)(i)
and (g-*bis*)

(i) where the authorization is given by the receiving Office or the International Searching Authority—its notification must reach the International Bureau before the expiration of 17 months from the priority date (or later, before the technical preparations for international publication have been completed);

Rule
91.1(g)(ii)

(ii) where the authorization is given by the International Preliminary Examining Authority—it must be given before the establishment of the international preliminary examination report;

Rule
91.1(g)(iii)
and (g-*bis*)

(iii) where the authorization is given by the International Bureau—it must be given before the expiration of 17 months from the priority date (or later, before the technical preparations for international publication have been completed).

Rule 91.1(g-*ter*)
and

See also Rule 91.1(g-*ter*) and (g-*quater*) for the time limits for cases where the applicant has requested early international publication (see paragraph 306) or where the international

- (g-*quater*) application is not published by virtue of Article 64(3) (see paragraph 304(iv)).
- Rule 91.1(f) 447. **What can be done if the authorization of a**
Section **rectification is refused?** If the authorization of a rectification
113(b) is refused, the applicant may request the International Bureau, in writing, to publish the request for rectification, as submitted to and refused by the Office or Authority competent to authorize the rectification, together with the international application. Such a request for publication may be made only if the international application has not yet been published and must reach the International Bureau before the completion of the technical preparations for international publication of the international application. It is subject to the payment at the same time of a special fee, the amount of which is indicated in Annex B2 (IB).
448. Once the request for rectification has been published, the applicant may pursue it further before the designated Offices under the conditions applied by those Offices under their national law and practice for the rectification of errors.

AMENDMENTS OF THE CLAIMS, DESCRIPTION AND DRAWINGS

- Article 19 449. **How, and at what stages, may the claims,**
34(2)(b) **description and drawings in an international application**
be amended? As described elsewhere in this Volume, during the international phase the applicant has one opportunity to amend the claims under Article 19 after receiving the international search report (see paragraphs 296 to 303). Amendments may also be made under Article 34(2)(b) to the description, claims and drawings before and during the international preliminary examination procedure (see paragraphs 345 to 349, and 393 to 397). Such amendments are in addition to the possibilities for correction of defects under Article 11 and Rule 20 (see paragraphs 237 to 239) and Article 14 and Rule 26 (see paragraph 240), and to the possibility for rectification of obvious errors under Rule 91.1 (see paragraphs 443 to 448). Applicants are also guaranteed the opportunity to amend the international application for the

purposes of the national phase by virtue of Articles 28 and 41 (see Volume II).

Rule 46.3
55.3
66.9

450. In what language should amendments be submitted during the international phase? Concerning the language in which amendments of the claims under Article 19 must be submitted, see paragraphs 296 and 309 to 311; concerning the language in which amendments of the description, claims and/or drawings under Article 34 must be submitted, see paragraph 397.

Article 19(2)
and (3)
34(2)(b)
Rule
66.2(a)(iv)
70.2(c)

451. May amendments to the claims, description or drawings during the international phase introduce new matter into the international application? Article 19(2) and Article 34(2)(b) both provide that amendments are not to go beyond the disclosure in the international application as filed. Compliance will not be checked during the international phase unless the applicant requests international preliminary examination. If the International Preliminary Examining Authority considers that any amendments go beyond the original disclosure, it will comment accordingly in any written opinion and in the international preliminary examination report, and the report will be established as if such amendment had not been made (see paragraphs 390(iv) and 396). Compliance with the requirement may be important during the national phase, when it may be checked by the designated Offices, and non-compliance may result at that stage in adverse consequences such as disallowance of the amendments or the according of a later filing date for any new matter claimed as a result of the amendments concerned. On the other hand, if the national law applicable in a designated Office permits amendments to go beyond the disclosure in the application as filed, non-compliance with the requirement has no consequence in the State concerned. Although customary in most national laws and contained in the European Patent Convention, the requirement is not one which—by virtue of the PCT—would bind any of the Contracting States. It is contained in the PCT because most laws provide for it, and it therefore seems to be a useful warning to all applicants planning to make amendments in the international phase.

WITHDRAWALS

- Rule 90*bis*.1
90*bis*.5 452. **Can the applicant withdraw the international application?** The applicant may withdraw the international application by a notice addressed to the International Bureau or to the receiving Office or, where PCT article 39.1) applies, to the International Preliminary Examining Authority, and received before the expiration of 30 months (see paragraph 46) from the priority date. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is the "deemed common representative" (see paragraph 415) may not sign such a notice on behalf of the other applicants. As to the case where an applicant/inventor for the United States of America refuses to sign or cannot be found or reached, see paragraphs 436 to 442.
- Rule
90*bis*.1(c) 453. **How can international publication be prevented?** The applicant may prevent international publication by withdrawing the international application, provided that the notice of withdrawal reaches the International Bureau before the completion of technical preparations for that publication (see paragraph 305). The notice of withdrawal may state that the withdrawal is to be effective only on the condition that international publication can still be prevented. In such a case the withdrawal is not effective if the condition on which it was made cannot be met—that is, if the technical preparations for international publication have already been completed. International publication may be postponed by withdrawing the priority claim as outlined in paragraphs 460 and 461.
- Rule 90*bis*.2
90*bis*.5 454. **Can the applicant withdraw designations?** The applicant may withdraw the designation of any State by a notice addressed to the International Bureau or to the receiving Office or, where PCT article 39.1) applies, to the International Preliminary Examining Authority, and received before the expiration of 30 months (see paragraph 46) from the priority date. Any such withdrawal is free of charge. A

notice of withdrawal must be signed by all the applicants. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is the "deemed common representative" (see paragraph 415) may not sign such a notice on behalf of the other applicants. As to the case where an applicant/inventor for the United States of America refuses to sign or cannot be found or reached, see paragraphs 436 to 442.

- Rule 455. Withdrawal of the designation of a State which has been elected for the purposes of international preliminary examination automatically results in withdrawal of the corresponding election.
- 90*bis*.2(a)
- Rule 456. Where a State has been designated for the purposes of obtaining both a national patent and a regional patent (see paragraphs 88 and 95), withdrawal of the designation of that State is taken to mean withdrawal only of the designation for the purpose of obtaining a national patent, unless otherwise indicated. In practice, the applicant should always make it clear which of the designations is intended to be withdrawn.
- 90*bis*.2(b)
- Rule 457. If all designations are withdrawn, the international application itself will be treated as withdrawn.
- 90*bis*.2(c)
- Rule 458. A designation will not be published if the notice of its withdrawal reaches the International Bureau before the technical preparations for international publication have been completed (see paragraph 305).
- 90*bis*.2(e)
459. Where the international application indicates different applicants for different designated States, the withdrawal of a designation may result in the applicant for the designation which is withdrawn being no longer an applicant for any designated State. In such a case, replacement sheets for the request indicating only the remaining applicants, namely those for the States the designations of which have not been withdrawn, should be furnished together with the notice of withdrawal. For example, where the designation of the United States of America has been withdrawn, the corrected request must show that the person who was named as applicant for that State only (and that person must be the inventor) is no

longer “applicant and inventor” but “inventor only.” Should the applicant fail to submit a replacement sheet, the request is corrected by the receiving Office or by the International Bureau. Whichever authority makes the correction notifies the other and the applicant accordingly.

Rule 90*bis*.3
90*bis*.5 460. **Can the applicant withdraw priority claims made in the international application?** The applicant may withdraw a priority claim made in the international application by a notice addressed to the International Bureau or to the receiving Office or, where PCT article 39.1) applies, to the International Preliminary Examining Authority, and received before the expiration of 30 months (see paragraph 46) from the priority date. Any or all of the priority claims may be so withdrawn. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is the "deemed common representative" (see paragraph 415) may not sign such a notice on behalf of the other applicants. As to the case where an applicant/inventor for the United States of America refuses to sign or cannot be found or reached, see paragraphs 436 to 442.

Rule
90*bis*.3(d)
and (e) 461. Where the withdrawal of a priority claim 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 yet expired—for example, the time limit before which processing in the national phase cannot start—is computed from the priority date resulting from the change. (It is not possible to extend the time limit concerned if it has already expired when the priority claim is withdrawn.) However, if the notice of withdrawal reaches the International Bureau after the completion of the technical preparations for international publication, the International Bureau may proceed with the international publication on the basis of the time limit for international publication as computed from the original priority date.

Article 37
Rule 90*bis*.4 462. **Can the applicant withdraw the demand for international preliminary examination or the election of**

90bis.5

any State? The applicant may withdraw the demand or the election of any State at any time prior to the expiration of 30 months from the priority date by a notice addressed to the International Bureau. Any such withdrawal is free of charge. A notice of withdrawal must be signed by all the applicants. An appointed agent or appointed common representative may sign such a notice on behalf of the applicant or applicants who appointed him, but an applicant who is the “deemed common representative” (see paragraph 415) may not sign such a notice on behalf of the other applicants. As to the case where an applicant/inventor for the United States of America refuses to sign or cannot be found or reached, see paragraphs 436 to 442.

Article 37(4) 463. The applicant should exercise care in withdrawing the demand or elections after the expiration of the time limit under Article 22 for entry into the national phase, since such withdrawal is treated in each of the elected States concerned as a withdrawal of the international application for that State unless the national phase has already started in that State. If withdrawal of the demand or elections is effected before the expiration of that time limit, however, the international application will not be considered withdrawn, but the applicant will, of course, have to take the usual steps before the expiration of that time limit to enter the national phase (see paragraph 46 and Volume II). For further details, see Article 37(4).

COMPUTATION OF TIME LIMITS

Rule 80

464. **What are the rules concerning the computation of time limits?** There are detailed provisions in Rule 80 concerning the computation of time limits (whether expressed in years, months or days), including the case where a time limit expires on a non-working day. The days which are non-working days for the International Bureau are published periodically in Section IV of the *PCT Gazette* and in the *PCT Newsletter*. Where a period starts on the date of a notification, that period may be extended if the notification was actually mailed on a later date or was received more than seven days

after the date it bears; see Rule 80.6 for details. For computation of time limits based on the priority date in cases where the priority claim is withdrawn, see paragraph 461.

IRREGULARITIES IN THE MAIL SERVICE

Article 48(1) 465. **Can a delay or loss in the mail be excused?** Rule 82
Rule 82.1 contains detailed provisions governing the situation where a letter arrives late or gets lost due to irregularities in the mail service, for example, because the mail service was interrupted due to a strike. The provisions operate to excuse failure to meet a time limit for filing a document for up to six months after the expiration of the time limit concerned, provided that the document was mailed at least five days before the expiration of the time limit. In order to take advantage of these provisions, the mailing must have been by registered airmail or, where surface mail would normally arrive at the destination concerned within two days of mailing, by registered surface mail. Evidence is required to satisfy the Office or organization concerned, and a substitute document must be filed promptly—see Rule 82.1(b) and (c) for details.

Rule 82.1(d) 466. **Can a delay or loss be excused where a delivery**
and (e) **service is used?** Some national Offices and intergovernmental organizations also apply these provisions where a delivery service other than the postal authorities is used to mail documents or letters—see Rule 82.1(d) and (e) for details, and Annexes B1 and B2 for information about which Offices and organizations recognize use of delivery services for this purpose, and in what circumstances Rule 82.1 will apply to such use.

Rule 82.2 467. Special provisions also apply to mail interruptions caused by war, revolution, civil disorder, strike, natural calamity or other like reasons—see Rule 82.2 for details.

FILING OF LETTERS, DOCUMENTS AND PAPERS

Rule 12.1 468. **What are the rules concerning the filing of letters,**
55.2 **documents and papers?** There are detailed provisions in
92 Rule 92 concerning letters, documents or papers submitted by

Section 104 the applicant in the course of the international procedure: letters must be signed; any other paper submitted must be accompanied by a letter; letters and documents from the applicant to the receiving Office, the International Searching Authority and the International Preliminary Examining Authority must generally be in the language of the international application or, where a translation of the international application has been transmitted or furnished for the purposes of the international search or international preliminary examination (see paragraphs 54 and 332), in the language of that translation. However, any letter addressed to the International Bureau must be in English or French. As to the language of any amendments to the claims under Article 19 (and their accompanying statement), see paragraphs 296 and 299. As to the language of the demand and of any amendments under Article 34, see paragraphs 334 and 397.

Rule 92.4 469. **Can documents be filed by telegraph, teleprinter, facsimile machine, etc?** Rule 92.4 governs the use of telegraph, teleprinter, facsimile machine and other like means of communication resulting in the filing of a printed or written document. These means of communication may only be used where the national Office or intergovernmental organization concerned is prepared to receive correspondence by these means. Some Offices and organizations require, for certain or all kinds of documents, that a communication by such admitted means of communication must, in any event, be confirmed by the applicant within 14 days; otherwise the communication may be considered not to have been made. However, failure to comply with such a requirement may be waived in some cases. Even where there is no standing requirement for originals to be furnished, an Office or organization may require the originals in any particular case. Further details on these requirements are set out in Rule 92.4, and information as to the practice and requirements applied in particular Offices and organizations is given in Annexes B1 and B2.

470. Applicants should, before sending a document by a means of telecommunication, check in Annex B1 or B2 to

ascertain what the requirements of the addressee are. Where the papers to be submitted are documents making up the international application or replacement sheets containing amendments or corrections to the international application, the original should in any event be mailed as a matter of course on the same or the following day.

Rule 92.4(d) 471. Where an original is sent to an Office or organization of a document previously transmitted to that Office or organization by a means of telecommunication, the original must be accompanied by a letter identifying the date and means of the earlier transmission.

472. If part or all of a document received by such means of transmission is illegible, or if part of the document is not received, the document is treated as not having been received to the extent that it is illegible or that the attempted transmission failed, and the Office or organization promptly notifies the applicant accordingly.

Section 109 473. **May a file reference be used in correspondence?** The applicant or his agent may mark a file reference in the box provided for the purpose on the first sheet of the request form (see paragraph 58), on each page of the other elements of the international application (see paragraphs 120, 139 and 144), on the first sheet of the demand form (see paragraph 336), and in any other correspondence relating to the international application. The file reference may be composed either of letters of the Latin alphabet or Arabic numerals, or both. It may not exceed 12 characters. The receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority will use the file reference in correspondence with the applicant.

CONFIDENTIALITY OF INTERNATIONAL APPLICATIONS

Article 30 474. **To what extent are international applications**
38 **treated as confidential?** An international application is
Rule 94.1(a) confidential in relation to third parties until the international
publication date, with only limited and specified exceptions
(see Article 30). The International Bureau will at any time, at

the request of the applicant or any person authorized by the applicant, furnish copies of any document contained in its file, subject to reimbursement of the cost of the service. An order for access made by a court with competent jurisdiction would be taken by the International Bureau as substituting for the applicant's authorization.

Rule 17.2
48
94.1(b)

475. After international publication, the international application itself is publicly available, as are any published amendments under Article 19 (see Rule 48.2(f)), the international search report (see Article 21(3) and Rule 48.2(a)(v)) (these elements are included in the published pamphlet) and copies of priority documents (noting the exceptions mentioned in paragraph 316; see Rule 17.2). Additionally, in respect of international applications filed on or after 1 July 1998, the International Bureau will, after international publication, furnish copies of any document contained in its file at the request of any person and upon reimbursement of the cost of the service, but subject to the restrictions imposed by Article 38 in respect of documents relating to the international preliminary examination.

Article
36(3)(a)
38
Rule 94.2
94.3

476. **To what extent is the international preliminary examination confidential?** Where the applicant requests international preliminary examination, Article 38 expressly provides that the International Bureau and the International Preliminary Examining Authority may not allow unauthorized access to the file of the international preliminary examination. Access by third parties to papers relating to the international preliminary examination held in the files of the International Bureau and the International Preliminary Examining Authority thus will be permitted only if that is requested or authorized by the applicant. Once the international preliminary examination report has been established, the report is communicated to elected Offices. Third parties may be able, if the national law applicable by an elected Office so provides or permits, to gain access to the report as part of the application file of the elected Office. Moreover, after the international preliminary examination report has been established, elected Offices may themselves gain access to the file of the International Preliminary Examining Authority. In

addition, in respect of international applications filed on or after 1 July 1998, an elected Office may, in turn, allow access by any person to documents on its file which relate to the international preliminary examination. Such access may be allowed only to the same extent as provided by the national law for access to the file of a national application, and may not be given 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.

REFERENCES TO DEPOSITED BIOLOGICAL MATERIAL

Rule 13*bis*.1 477. **When must an international application include a reference to biological material and/or to its deposit with a depositary institution?** The PCT does not require the inclusion of such a reference in an international application; it merely prescribes the contents of any “reference to deposited biological material” (defined as “particulars given ... with respect to the deposit of biological material ... or to the biological material so deposited”) which is included in an international application, and when such a reference must be furnished. It follows that the applicant will see a need to make such a reference only when it is required for the purpose of disclosing the invention claimed in the international application in a manner sufficient for the invention to be carried out by a person skilled in the art—that is, when the law of at least one of the designated States provides for the making, for this purpose, of a reference to deposited biological material if the invention involves the use of biological material that is not available to the public. Annex L lists those national (or regional) Offices of, or acting for, the Contracting States whose national law provides for the making of a reference to deposited biological material for the purposes of patent procedure; those national (or regional) Offices whose laws do not provide for such references are indicated in Annexes B1 and B2 (in some cases together with information given by those Offices on the possibility of referring in the international application to deposits of

biological material even though the applicable national law does not provide specially for it). Where any indications are furnished separately from the description and are received by the International Bureau before the completion of technical preparations for international publication, the date of receipt by the International Bureau and the relevant data from the indication will be included in the pamphlet containing the published international application.

Rule 13*bis*.2 478. **What effect does the PCT give to such a reference?** A reference to deposited biological material made in accordance with the requirements of the PCT must be regarded by each of the designated Offices as satisfying the requirements of the national law applicable in that Office with regard to the contents of such references and the time for furnishing them.

Rule 13*bis*.5 479. **May the reference be made for the purposes of only some of the designated States?** A reference may be made for the purposes of all designated States or for one or only some of the designated States. A reference is considered to be made for the purpose of all designated States unless it is expressly made for certain designated States only. References to different deposits may be made for the purposes of different designated States.

Rule 13*bis*.3 480. **What are the indications which must be given in the reference with regard to the deposit of biological material?** There are two kinds of indication which may have to be given, namely:

(a) indications specified in the PCT Regulations themselves; and

(b) additional indications which have been notified by the national (or regional) Office of (or acting for) a State designated in the international application and which have been published in the *PCT Gazette*; these additional indications may relate not only to the deposit of the biological material but also to the biological material itself (see paragraph 481).

The indications in the first category are:

- (i) the name and address of the depositary institution with which the deposit was made;
- (ii) the date of the deposit with that institution; and
- (iii) the accession number given to the deposit by that institution.

Annex L sets out, for each national (or regional) Office, the additional indications (if any) in the second category which are required to be given.

Rule 481. **What are the indications concerning biological material itself which must be given in the reference?** The national laws of some of the national (or regional) Offices require that, besides indications concerning the deposit of biological material, an indication be given concerning the biological material itself, such as, for example, a short description of its characteristics, at least to the extent that this information is available to the applicant. These requirements must be met in the case of international applications for which any such Office is a designated Office, provided that the requirements have been notified to the International Bureau and published in the *PCT Gazette*. Annex L indicates, for each of the national (or regional) Offices, the requirements (if any) of this kind which have been so notified and published.

Rule 482. **At what time must the reference (with the indications which must be contained therein) be made?** If any indication is not included in a reference to deposited biological material contained in the international application as filed, it may be furnished to the International Bureau within 16 months from the priority date unless the International Bureau has been notified (and, at least two months prior to the filing of the international application, has published in the *PCT Gazette*) that the national law applicable by a designated Office requires in relation to national applications that the indication be furnished earlier. If any of the indications are furnished to the International Bureau after the expiration of 16 months from the priority date but before the technical preparations for international publication have been completed, those indications will be considered by any

designated Office to have been furnished on the last day of the 16-month time limit. If the applicant makes a request for early publication (see paragraph 306), all indications should be furnished by the time the request is made, since any designated Office may regard any indication not furnished when the request is made as not having been furnished in time. Annex L specifies, for each national (or regional) Office whose national law requires a reference to deposited biological material to be furnished earlier than 16 months after the priority date, the applicable time limit(s) for furnishing such indications.

Rule
13bis.3(b)
13bis.4
48.2(a)(viii)

483. **What is the consequence of failure to furnish an indication in time?** No check is made in the international phase to determine whether a reference has been furnished within the prescribed time limit. However, where the indications were received after the technical preparations for international publication have been completed, the International Bureau notifies the designated Offices of the date(s) on which indications not included in the international application as filed were furnished to it. Failure to include a reference to deposited biological material (or any indication required in such a reference) in the international application as filed, or failure to furnish it (or the indication) within the prescribed time limit, has no consequence if the national law does not require the reference (or indication) to be furnished in a national application. Where there is a consequence, it is the same as that which applies under the national law.

Section 209

484. **Where should the reference be made?** To the extent that indications relating to the deposit of biological material are not given in the description, they may be furnished on a separate sheet, for which purpose Form PCT/RO/134 (see Annex Z) should preferably be used. That separate sheet may be filed after the international application is filed. If the sheet is submitted when the international application is filed, a reference to it should be made in the check list contained on the last sheet of the request form (see Annexes F and X). Certain designated Offices require that the indications relating to the deposit of biological material must be included in the description at the time of filing (see Annex L) so the sheet, if

submitted when the international application is filed, may need to be included as one of the sheets of the description; otherwise the indications given in it will not be taken into account by those Offices in the national phase. If the sheet is furnished to the International Bureau later (see paragraph 482), it must be enclosed with a letter. Form PCT/RO/134 may also be prepared using the PCT-EASY software (see paragraph 56).

Rule
13bis.7(b)

485. How does the applicant decide on the depositary institution with which to deposit the biological material?

Each national (or regional) Office whose national law provides for deposits of biological material for the purposes of patent procedure notifies the International Bureau of the depositary institutions with which the national law permits such deposits to be made. Information on the institutions notified by each of those Offices is published by the International Bureau in the *PCT Gazette*. Annex L indicates the institutions with which deposits may be made.

Rule
13bis.5(c)

486. A reference to a deposit cannot be disregarded by a designated Office for reasons pertaining to the institution with which the biological material was deposited if the deposit referred to is one made with a depositary institution notified by that Office. Thus, by consulting the *PCT Gazette* (or Annex L), the applicant can be sure that he has deposited the biological material with an institution which will be accepted by the designated Office.

Rule 13bis.6

487. Does a reference in an international application to the deposit of biological material involve the possibility of a sample being obtained by the International Searching Authority or the International Preliminary Examining Authority? International Searching Authorities and International Preliminary Examining Authorities may not require the furnishing of a sample of deposited biological material for the purposes of international search or international preliminary examination, respectively.

Rule 13bis.6

488. What possibility is there, when a reference is made in an international application to the deposit of biological material, of third persons obtaining a sample? The

furnishing of samples is governed by the national laws applicable in the designated Offices. Rule 13*bis*.6, however, provides for the delaying of any furnishing of samples under the national law applicable in each of the designated (or elected) Offices until the start of the national phase, subject to the ending of this “delaying effect” brought about by the occurrence of either of the following two events:

(i) the applicant has, after international publication of the international application, taken the steps necessary to enter the national phase before the designated Office (see Volume II);

(ii) international publication of the international application has been effected, and that publication has the same effects, under the national law applicable in the designated Office, as the compulsory national publication of an unexamined national application (in other words, the international application has qualified for the grant of “provisional protection”); for the Contracting States whose national laws provide for “provisional protection,” and the conditions which have to be met for an international application to qualify for that protection, see Annexes B1 and B2.

489. With respect to certain designated Offices (for instance, the European Patent Office), the applicant may take advantage of the procedure whereby, until the occurrence of a certain event, the biological material may be made available only by the issue of a sample to an expert nominated by the requester. For details, see Annex L.

REQUIREMENTS FOR SEQUENCE LISTINGS

Rule 5.2
13*ter*
Section 208
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490. **What special requirements apply to nucleotide and/or amino acid sequences disclosed in international applications?** See paragraphs 118 to 119E, 271 to 278, and 389. See Volume II in relation to the national phase.

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Annex C of
the
Administrative
Instructions

EXTENSION OF INTERNATIONAL APPLICATIONS TO SUCCESSOR STATES OF FORMER CONTRACTING STATES

Rule 32.1(a) 491. **What is a successor State?** A successor State is a State whose territory was, before its independence, part of the territory of a PCT Contracting State that subsequently ceased to exist (the predecessor State), and which (successor State) has deposited with the Director General of WIPO a declaration indicating that the PCT continues to be applicable in that State (“declaration of continuation”). As from the date of the deposit of such a declaration, the successor State may be designated in international applications. Moreover, the effects of international applications filed during a certain period may be extended to the successor State.

Rule 32.1(b) 492. **Which are the international applications whose effects can be extended to a successor State?** Rule 32 provides that the effects of any international application filed during a certain period may be extended to a successor State, irrespective of which States have been designated in the international application. This period, for those successor States whose date of independence is later than the date of the day following the last day of the existence of the predecessor State, begins on the day following the last day of the existence of the predecessor State and ends two months after the date on which the Director General notifies the Governments of the States party to the Paris Convention for the Protection of Industrial Property of the successor State’s declaration of continuation. For those States whose date of independence is earlier than the date of the day following the

last day of the existence of the predecessor State, the successor State may, in conjunction with its declaration of continuation, declare that the period referred to above starts on the date of its independence.

Rule 32.1(c) 493. **How will an applicant know of the possibility to extend the effects of his international application to a successor State?** Any applicant whose international application filing date falls within the period referred to in the preceding paragraph will receive from the International Bureau a notification informing him that he may request the extension of the effects of his international application to the successor State concerned. The notification will include a detailed explanation of the requirements and time limits for the filing of the request.

Rule 32.1(c) 494. **What must an applicant do to have the effects of his international application extended to a successor State?** In brief, the applicant must request the extension by filing directly with the International Bureau a written request for extension (preferably using Form PCT/IB/363, a copy of which will accompany the notification sent to him by the International Bureau) and paying to the International Bureau an extension fee in Swiss francs equivalent to the amount of the designation fee fixed in the Schedule of Fees annexed to the PCT Regulations (see paragraph 197(c)(ii) and Annex C (IB)) for each international application covered by the request. As to the possibility of a reduction in the designation fee, and hence of the extension fee, for certain applicants, see paragraph 202. The request for extension and the extension fee must reach the International Bureau within three months from the date of the mailing of the notification.

Rule 32.2 495. **What is the effect of an extension?** When the requirements of Rule 32 are met, the successor State is considered as having been designated in the international application on the international filing date. The applicable time limits under Article 22 or 39(1) are extended until the expiration of at least three months from the date of the request for extension. Where the successor State is bound by Chapter II, if the request for extension was made after but the demand was filed before the expiration of the 19th month

from the priority date and a later election of the successor State is made within three months from the date of the request for extension, the applicable time limit under Article 39(1) shall be at least 30 months from the priority date. The successor State may fix time limits which expire later and, if it does so, the International Bureau will publish this information in the *PCT Gazette*.

496. The procedure for extension of the effects of international applications to certain successor States (as explained above) should not be confused with the extension of European patents to States which are bound by the PCT and which have Extension Agreements with the European Patent Organisation (see paragraph 89 and Annex B2 (EP)).

FILING OF REQUESTS IN PCT-EASY FORMAT

Article 11(1) 497. Together with a paper copy of an international
Rule 3.1 application, an applicant may prepare and file a request
11.3 using the PCT-EASY software (see paragraph 56). An
20 applicant who files a request prepared using the PCT-EASY
89ter software and also files a copy of the abstract in electronic
Section 102(i) form may be eligible to receive a fee reduction (see
paragraph 202A for details about the fee reduction for PCT-
EASY). However, a PCT-EASY diskette filed alone—
without any corresponding application papers—does not
meet the requirements for according an international filing
date. An international application in paper form remains the
legally determinative version (see paragraph 223A). For
information on what defects in requests prepared using the
PCT-EASY software do not affect the international filing
date, see paragraph 240A. For information on how to correct
defects in the filing of requests in PCT-EASY format, see
paragraphs 498 to 504, below. For further information on
PCT-EASY, to download the software, report bugs, resolve
other problems and suggest improvements, please visit the
PCT-EASY web site on the Internet at
<http://pcteasy.wipo.int>.

Rule 3.1 498. **Can defects in the filing of requests in PCT-EASY**
11.3 **format be corrected?** Although requests in PCT-EASY format

- 89ter are filed together with a computer diskette containing the request and abstract, it is the paper copy of the request and abstract which is the legally determinative version. Thus, the general procedures for correction of defects in the paper applications should be followed (see paragraphs 237 to 256). See paragraph 219A for details on the procedural steps at the receiving Office for requests prepared using the PCT-EASY software.
- Section 102(i) 499. **How should defects in the request filed in PCT-EASY format be corrected?** To correct a defect in the request, the applicant should submit a replacement print-out of the entire request prepared using the PCT-EASY software in order to correct defects in the request. A correction which is stated in a letter and is not accompanied by a replacement print-out of the entire request prepared using the PCT-EASY software is acceptable only if it is of such a nature that it can be transferred from the letter to the record copy without affecting the clarity and direct reproducibility of the sheet onto which the correction is to be transferred. A replacement diskette should not be furnished when correcting defects in the request or abstract.
- Article 11(1) 500. **What happens where the receiving Office does not accept requests in PCT-EASY format?** If the receiving Office does not accept the filing of requests in PCT-EASY format but the request is filed in that format, the international application does not comply with the requirements of Article 14 and the receiving Office will invite the applicant to file a request which does comply with Article 14. The international application in such cases is treated like any other international application containing a request which does not comply with the physical requirements under Article 14. It should be noted that the use of the PCT-EASY format does not, of itself, have any adverse effect in connection with the according of an international filing date.
- Article 14(1) 501. Instead of inviting the applicant to file an application in paper form, any receiving Office which does not accept the filing of requests in PCT-EASY format may decide to seek the authorization of the applicant to transmit the international application to the International Bureau as receiving Office under Rule 19.4(a)(iii) (see paragraph 242).
- Rule 20 89ter
- Rule 19.4(a)(iii)

Article 12 502. **What happens when the request in PCT-EASY format**
14 **is filed without a corresponding PCT-EASY diskette?** The
Rule 89ter use of the PCT-EASY format for the request is not permitted if
the PCT-EASY diskette is not filed together with the request.
Section Thus, if the applicant fails to provide a corresponding PCT-
102(i) EASY diskette when filing the request in PCT-EASY format,
the applicant will be invited to furnish a request in paper form
which complies with the requirements of Article 14. Only if the
applicant furnishes the PCT-EASY diskette immediately after
filing the request—that is, before the receiving Office transmits
the record copy to the International Bureau—is the use of the
PCT-EASY format for the request permissible and the fee
reduction related to the use of PCT-EASY applicable. If the
missing diskette is not filed before transmission of the record
copy of the international application to the International Bureau,
the applicant is not entitled to the fee reduction.

Article 11 503. **What happens when the request is not in PCT-EASY**
12 **format but it is filed with a PCT-EASY diskette?** If the
international application contains a request which is not in PCT-
Rule 3.1 EASY format, but is in another format such as Form
11.3 PCT/RO/101, and a PCT-EASY diskette is furnished together
89ter with the application papers, the applicant will be notified that
the conditions for applying the fee reduction related to the use of
Section PCT-EASY software are not satisfied and that the fee reduction
102(i) is not applicable since the request is not in PCT-EASY format.
However, if the applicant responds by furnishing the request in
PCT-EASY format before the receiving Office transmits the
record copy to the International Bureau, the applicant is entitled
to the PCT-EASY fee reduction. A PCT-EASY diskette filed
alone, without any application papers, does not meet the
requirements for according a filing date.

Section 504. **What happens when the PCT-EASY diskette is**
102(i) **incomplete or defective?** A PCT-EASY diskette must contain
the appropriate data, including the text of the abstract, and be
readable if the fee reduction related to the use of the PCT-EASY
software is to apply. If the receiving Office finds that a diskette
purporting to be a PCT-EASY diskette contains incomplete data
or is unreadable, the receiving Office will proceed as though the
request in PCT-EASY format had been filed without a diskette.

