

**Reprint  
as at 24 February 2017**



## Patents Act 1953

Public Act      1953 No 64  
Date of assent    26 November 1953  
Commencement    see section 1(2)

Patents Act 1953: repealed, on 24 February 2017, by section 7(1) of the Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89).

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Changes authorised by subpart 2 of Part 2 of the Legislation Act 2012 have been made in this official reprint.  
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**This Act is administered by the Ministry of Business, Innovation, and Employment.**

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## **An Act to consolidate and amend certain enactments relating to patents**

### **1 Short Title and commencement**

- (1) This Act may be cited as the Patents Act 1953.
- (2) This Act shall come into force on a day to be appointed for the commencement thereof by the Governor-General by Proclamation.

Section 1(2): this Act brought into force, on 1 January 1955, by the Patents Act Commencement Order 1954 (SR 1954/220).

### **2 Interpretation**

- (1) In this Act, unless the context otherwise requires,—

**applicant** includes a person in whose favour a direction has been given under section 24 and the personal representative of a deceased applicant

**article** includes any substance or material, and any plant, machinery, or apparatus, whether affixed to land or not

**assignee** includes the personal representative of a deceased assignee; and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person

**Commissioner** means the Commissioner of Patents

**convention application** has the meaning assigned to it by subsection (4) of section 7

**convention country**, in any provision of this Act, means an entity for the time being declared by an order under section 77 to be a convention country for the purposes of that provision

**court** means the High Court

**date of filing**, in relation to any document filed under this Act, means the date on which the document is filed or, where it is deemed by virtue of any provision of this Act or of regulations made thereunder to have been filed on any different date, means the date on which it is deemed to be filed

**exclusive licence** means a licence from a patentee which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention; and **exclusive licensee** shall be construed accordingly

**government department** means any department or instrument of the Executive Government of New Zealand

**integrated circuit** means a circuit, in its final or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in or on a piece of material and that is intended to perform an electronic function

**international application** means an application made under the Patent Cooperation Treaty for the protection of an invention

**International Bureau** means the International Bureau of the World Intellectual Property Organization

**international filing date** means the international filing date given to an international application under Article 11 or Article 14(2) of the Patent Cooperation Treaty

**invention** means any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies and any new method or process of testing applicable to the improvement or control of manufacture; and includes an alleged invention

**IPONZ** means the Intellectual Property Office of New Zealand

**journal** means the journal published under section 206 of the Patents Act 2013

**Minister** means the Minister of Commerce

**patent** means letters patent for an invention

**Patent Cooperation Treaty**—

- (a) means the Patent Cooperation Treaty, signed at Washington on 19 June 1970, the text of which, as amended on 2 October 1979 and modified on 3 February 1984, is set out in Schedule 1 of the Patents Amendment Act 1992; and

- (b) includes any amendments, modifications, and revisions from time to time made to the Treaty, being amendments, modifications, and revisions to which New Zealand is a party and by which New Zealand is bound

**patent of addition** means a patent granted in accordance with section 34

**Patent Attorney** means a person carrying on for gain in New Zealand the business of acting as agent for other persons for the purpose of applying for or obtaining patents in New Zealand or elsewhere

**patentee**, in relation to any patent, means the person or persons for the time being entered on the register of patents as grantee or proprietor of the patent

**prescribed** means prescribed by this Act or by regulations made under this Act

**priority date** has the meaning assigned to it by section 11

**published**, except in relation to a complete specification, means made available to the public; and without prejudice to the generality of the foregoing provision a document shall be deemed for the purposes of this Act to be published—

- (a) if it can be inspected as of right at any place in New Zealand by members of the public whether upon payment of a fee or otherwise; or
- (b) if it can be inspected in a library of a government department or of any institution or public authority and the library is one which is open generally to members of the public who are interested in matters to which the document relates and is a library in which members of the public in search of information related to the subject of the document would ordinarily seek and do in fact seek the information

**receiving Office** has the same meaning as in Article 2(xv) of the Patent Cooperation Treaty

**the Statute of Monopolies** means the Act of the 21st year of the reign of King James the First, chapter 3, intituled “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”

**Treaty application** means an international application—

- (a) which contains a request specifying New Zealand as a designated State under Article 4(1)(ii) of the Patent Cooperation Treaty; and
- (b) which has been given an international filing date

**Treaty regulations**—

- (a) means the regulations made under the Patent Cooperation Treaty and set out in Schedule 2 of the Patents Amendment Act 1992; and
- (b) includes any amendments from time to time made to those regulations.
- (2) For the purposes of subsection (3) of section 7, so far as it relates to a convention application, and for the purposes of section 81, the expression **personal representative**, in relation to a deceased person, includes the legal representative of the deceased appointed in any country outside New Zealand.

- (3) In the case of an entity that is a convention country but is not a State, part of a State, or a territory for whose international relations a State is responsible,—
- (a) a reference in this Act to—
    - (i) application for protection in a country; or
    - (ii) application for protection in respect of a country,—must be read as a reference to application for protection under the rules of the entity:
  - (b) a reference in this Act to filing a specification in a convention country must be read as a reference to filing a specification under the rules of the entity:
  - (c) a reference in this Act to the law of a convention country must be read as a reference to the rules of the entity:
  - (d) a reference in this Act to the Government of a convention country must be read as a reference to the governing body of the entity.

Compare: 1921–22 No 18 s 2; Patents Act 1949 s 101 (UK)

Section 2(1) **Commonwealth**: repealed, on 2 September 1996, by section 2 of the Patents Amendment Act 1996 (1996 No 139).

Section 2(1) **convention country**: replaced, on 14 October 1999, by section 3(2) of the Patents Amendment Act 1999 (1999 No 119).

Section 2(1) **court**: amended, on 1 April 1980, pursuant to section 12 of the Judicature Amendment Act 1979 (1979 No 124).

Section 2(1) **integrated circuit**: inserted, on 1 January 1995, by section 2 of the Patents Amendment Act 1994 (1994 No 122).

Section 2(1) **international application**: inserted, on 1 December 1992, by section 2 of the Patents Amendment Act 1992 (1992 No 81).

Section 2(1) **International Bureau**: inserted, on 1 December 1992, by section 2 of the Patents Amendment Act 1992 (1992 No 81).

Section 2(1) **international filing date**: inserted, on 1 December 1992, by section 2 of the Patents Amendment Act 1992 (1992 No 81).

Section 2(1) **IPONZ**: inserted, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 2(1) **journal**: replaced, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 2(1) **Minister**: replaced, on 1 December 1988, by section 4(1) of the Trade and Industry Act Repeal Act 1988 (1988 No 156).

Section 2(1) **Patent Cooperation Treaty**: inserted, on 1 December 1992, by section 2 of the Patents Amendment Act 1992 (1992 No 81).

Section 2(1) **receiving Office**: inserted, on 1 December 1992, by section 2 of the Patents Amendment Act 1992 (1992 No 81).

Section 2(1) **Treaty application**: inserted, on 1 December 1992, by section 2 of the Patents Amendment Act 1992 (1992 No 81).

Section 2(1) **Treaty regulations**: inserted, on 1 December 1992, by section 2 of the Patents Amendment Act 1992 (1992 No 81).

Section 2(3): inserted, on 14 October 1999, by section 3(3) of the Patents Amendment Act 1999 (1999 No 119).

**2A Act preserved for patent attorney provisions**

- (1) This Act continues to govern patent attorneys and their registration.
- (2) The Patents Act 2013 governs patents and patent applications (but *see* subpart 6 of Part 5 of that Act as to the continued application of repealed provisions of this Act for transitional purposes).
- (3) This section is intended only as a guide to the general scheme and effect of these Acts.

Section 2A: inserted, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

**3 Commissioner of Patents**

*[Repealed]*

Section 3: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**4 Assistant Commissioners of Patents and other officers**

*[Repealed]*

Section 4: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**5 Patent Office**

*[Repealed]*

Section 5: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**5A Closing of Patent Office at short notice**

*[Repealed]*

Section 5A: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**6 Officers and employees of Patent Office not to acquire interest in any patent or prepare specifications**

*[Repealed]*

Section 6: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Application, investigation, opposition, etc*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**7 Persons entitled to make application**

*[Repealed]*

Section 7: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**8 Application**

*[Repealed]*

Section 8: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**9 Complete and provisional specifications**

*[Repealed]*

Section 9: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**10 Contents of specification**

*[Repealed]*

Section 10: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**11 Priority date of claims of complete specification**

*[Repealed]*

Section 11: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**12 Examination of application**

*[Repealed]*

Section 12: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**13 Search for anticipation by previous publication**

*[Repealed]*

Section 13: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**14 Search for anticipation by prior claim**

*[Repealed]*

Section 14: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**15 Commissioner may require information as to corresponding applications overseas**

*[Repealed]*

Section 15: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**16 Reference in case of potential infringement**

*[Repealed]*

Section 16: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**17 Refusal of application in certain cases**

*[Repealed]*

Section 17: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**18 Supplementary provisions as to examination, etc**

*[Repealed]*

Section 18: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**19 Time for putting application in order for acceptance**

*[Repealed]*

Section 19: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**20 Acceptance and publication of complete specification**

*[Repealed]*

Section 20: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**21 Opposition to grant of patent**

*[Repealed]*

Section 21: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**22 Refusal of patent without opposition**

*[Repealed]*

Section 22: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**23 Mention of inventor as such in patent**

*[Repealed]*

Section 23: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**24 Substitution of applicants, etc**

*[Repealed]*

Section 24: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**25 Provisions for secrecy of certain inventions**

*[Repealed]*

Section 25: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26 Inventions relating to atomic energy**

*[Repealed]*

Section 26: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Treaty application*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26A Treaty application deemed to be application accompanied by complete specification**

*[Repealed]*

Section 26A: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26B Description, claims, and drawings**

*[Repealed]*

Section 26B: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26C International filing date**

*[Repealed]*

Section 26C: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26D Commissioner to provide international filing date**

*[Repealed]*

Section 26D: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26E Amendments to documents forming part of complete specification**

*[Repealed]*

Section 26E: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26F Treaty application void**

*[Repealed]*

Section 26F: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26G Requirements for examination of Treaty application**

*[Repealed]*

Section 26G: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**26H Publication of Treaty applications**

*[Repealed]*

Section 26H: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Grant, effect, and term of patent*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**27 Grant and sealing of patent**

*[Repealed]*

Section 27: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**28 Amendment of patent granted to deceased applicant***[Repealed]*

Section 28: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**29 Extent, effect, and form of patent***[Repealed]*

Section 29: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**30 Date and term of patent***[Repealed]*

Section 30: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**31 Extension on ground of inadequate remuneration***[Repealed]*

Section 31: repealed, on 1 January 1995, by section 5 of the Patents Amendment Act 1994 (1994 No 122).

**32 Extension on ground of war loss***[Repealed]*

Section 32: repealed, on 1 January 1995, by section 5 of the Patents Amendment Act 1994 (1994 No 122).

**33 Extension on ground of war loss of licensee***[Repealed]*

Section 33: repealed, on 1 January 1995, by section 5 of the Patents Amendment Act 1994 (1994 No 122).

**34 Patents of addition***[Repealed]*

Section 34: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Restoration of lapsed patents and patent applications**[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**35 Restoration of lapsed patents***[Repealed]*

Section 35: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**36 Restoration of applications where patent not sealed***[Repealed]*

Section 36: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**37 Restoration of application where complete specification not accepted**

*[Repealed]*

Section 37: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Amendment of specifications*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**38 Amendment of specification with leave of Commissioner**

*[Repealed]*

Section 38: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**39 Amendment of specification with leave of court**

*[Repealed]*

Section 39: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**40 Supplementary provisions as to amendment of specification**

*[Repealed]*

Section 40: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Revocation and surrender of patents*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**41 Revocation of patent by court**

*[Repealed]*

Section 41: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**42 Revocation of patent by Commissioner**

*[Repealed]*

Section 42: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**43 Surrender of patent**

*[Repealed]*

Section 43: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Voluntary endorsement of patent*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**44 Endorsement of patent “licences of right”**

*[Repealed]*

Section 44: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**45 Cancellation of endorsement under section 44**

*[Repealed]*

Section 45: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Compulsory licences, etc*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**46 Compulsory licence**

*[Repealed]*

Section 46: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**47 Provisions as to licences under section 46**

*[Repealed]*

Section 47: repealed, on 1 January 1995, by section 8 of the Patents Amendment Act 1994 (1994 No 122).

**48 Exercise of powers on applications under section 46**

*[Repealed]*

Section 48: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**49 Endorsement, etc, on application of Crown**

*[Repealed]*

Section 49: repealed, on 1 January 1995, by section 10(1) of the Patents Amendment Act 1994 (1994 No 122).

**50 Revocation of patent**

*[Repealed]*

Section 50: repealed, on 1 January 1995, by section 10(1) of the Patents Amendment Act 1994 (1994 No 122).

**51 Inventions relating to food or medicine, etc**

*[Repealed]*

Section 51: repealed, on 19 August 1992, by section 8(1) of the Patents Amendment Act 1992 (1992 No 81).

**52 Procedure on application under sections 46 to 50**

*[Repealed]*

Section 52: repealed, on 1 January 1995, by section 10(2) of the Patents Amendment Act 1994 (1994 No 122).

**53 Appeal and references to arbitrator**

*[Repealed]*

Section 53: repealed, on 1 January 1995, by section 10(2) of the Patents Amendment Act 1994 (1994 No 122).

**54 Supplementary provisions**

*[Repealed]*

Section 54: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Use of patented inventions for services of the Crown*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**55 Use of patented inventions for services of the Crown**

*[Repealed]*

Section 55: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**56 Rights of third parties in respect of Crown use**

*[Repealed]*

Section 56: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**57 Reference of disputes as to Crown use**

*[Repealed]*

Section 57: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**58 Special provisions as to Crown use during emergency**

*[Repealed]*

Section 58: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**58A Nature and scope of rights under section 55**

*[Repealed]*

Section 58A: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**58B Duty to inform owner**

*[Repealed]*

Section 58B: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**58C Patentee entitled to remuneration**

*[Repealed]*

Section 58C: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Anticipation, etc**[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**59 Previous publication***[Repealed]*

Section 59: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**60 Previous communication, display, or working***[Repealed]*

Section 60: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**61 Use and publication after provisional specification or foreign application***[Repealed]*

Section 61: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**62 Priority date in case of obtaining***[Repealed]*

Section 62: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Miscellaneous provisions as to rights in inventions**[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**63 Co-ownership of patents***[Repealed]*

Section 63: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**64 Power of Commissioner to give directions to co-owners***[Repealed]*

Section 64: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**65 Disputes as to inventions made by employees***[Repealed]*

Section 65: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**66 Avoidance of certain restrictive conditions***[Repealed]*

Section 66: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**67 Determination of certain contracts***[Repealed]*

Section 67: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Proceedings for infringement, etc*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**68 Restrictions on recovery of damages for infringement**

*[Repealed]*

Section 68: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**68A Burden of proof for infringement of process patent**

*[Repealed]*

Section 68A: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**68B Regulatory review exception**

*[Repealed]*

Section 68B: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**69 Order for account in action for infringement**

*[Repealed]*

Section 69: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**70 Counterclaim for revocation in action for infringement**

*[Repealed]*

Section 70: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**71 Relief for infringement of partially valid specification**

*[Repealed]*

Section 71: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**72 Proceedings for infringement by exclusive licensee**

*[Repealed]*

Section 72: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**73 Certificate of contested validity of specification**

*[Repealed]*

Section 73: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**74 Remedy for groundless threats of infringement proceedings**

*[Repealed]*

Section 74: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**75 Power of court to make declaration as to non-infringement**

*[Repealed]*

Section 75: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**76 Attorney-General may appear in patent proceedings**

*[Repealed]*

Section 76: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*International agreements, etc*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**77 Orders in Council as to convention countries**

*[Repealed]*

Section 77: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**78 Supplementary provisions as to convention applications**

*[Repealed]*

Section 78: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**79 Special provisions as to vessels, aircraft, and land vehicles**

*[Repealed]*

Section 79: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**80 Extension of time for certain convention applications**

*[Repealed]*

Section 80: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**81 Protection of inventions communicated under international agreements**

*[Repealed]*

Section 81: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**82 Regulations under section 80 or section 81**

*[Repealed]*

Section 82: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Register of patents, etc***83 Register of patents**

*[Repealed]*

Section 83: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**84 Registration of assignments, etc**

*[Repealed]*

Section 84: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**85 Limitation of proceedings**

*[Repealed]*

Section 85: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**85A Application of Personal Property Securities Act 1999**

*[Repealed]*

Section 85A: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**86 Commissioner may dispense with production of probate or letters of administration in certain cases**

*[Repealed]*

Section 86: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**87 Rectification of register of patents by court**

*[Repealed]*

Section 87: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**88 Correction of errors**

*[Repealed]*

Section 88: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**89 Evidence of entries, documents, etc**

- (1) A certificate purporting to be signed by the Commissioner certifying that any entry which he is authorised by or under this Act to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence of the matters so certified.
- (2) A copy of any entry in any register or of any document kept by IPONZ, or an extract from that register or document, purporting to be certified by the Commissioner, shall be admitted in evidence without further proof and without production of the original.
- (3) Where by this Act or otherwise by law the Commissioner is directed, authorised, or empowered to do, exercise, or perform any act, power, function, or duty, any notification in the journal of the doing, exercise, or performance of any such act, power, function, or duty shall be prima facie evidence that it was lawfully done, exercised, or performed.

Compare: 1921–22 No 18 ss 130, 131; 1946 No 32 s 6(3); Patents Act 1949 s 77 (UK)

Section 89(1): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 89(2): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 89(3): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

## **90 Requests for information as to patent or patent application**

*[Repealed]*

Section 90: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **91 Restriction upon publication of specifications, etc**

*[Repealed]*

Section 91: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **92 Loss or destruction of patent**

*[Repealed]*

Section 92: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **93 Commissioner may grant extension of time**

*[Repealed]*

Section 93: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **93A Additional provisions for extending time limits**

*[Repealed]*

Section 93A: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

### *Proceedings before Commissioner*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **94 Exercise of discretionary powers of Commissioner**

*[Repealed]*

Section 94: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **95 Costs and security for costs**

*[Repealed]*

Section 95: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **96 Evidence before Commissioner**

*[Repealed]*

Section 96: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Appeals*

*[Repealed]*

Heading: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**97 Appeals to High Court**

*[Repealed]*

Section 97: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**98 Appeals to Court of Appeal**

*[Repealed]*

Section 98: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**99 Costs of Commissioner in proceedings before court**

*[Repealed]*

Section 99: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

*Patent attorneys*

**100 Registration of patent attorneys**

- (1) There shall be kept at IPONZ a register of patent attorneys.
- (2) The Commissioner may register as a patent attorney any person who,—
  - (a) is a British subject or a citizen of the Republic of Ireland; and
  - (b) is not less than 21 years of age; and
  - (c) has passed in all subjects of the prescribed examination; and
  - (d) if so required by regulations made under this Act, has been employed for the period specified in the regulations in the manner specified in the regulations; and
  - (e) possesses such other qualifications as may be prescribed.
- (3) Regulations made under this Act may provide for the appointment of a person or persons to conduct the examinations referred to in subsection (2).
- (4) Every person who was registered as a patent agent under the Patents, Designs, and Trade Marks Act 1921–22 immediately before the commencement of this Act shall be deemed to be registered as a patent attorney under this Act.

Compare: 1921–22 No 18 s 135

Section 100(1): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

**101 Powers of patent attorneys**

- (1) A patent attorney—

- (a) shall be entitled to prepare all documents, transact all business, and conduct all proceedings for the purposes of the Patents Act 2013 and this Act; and
  - (b) shall have such other rights and privileges as may be prescribed.
- (2) Nothing in this section shall authorise a patent attorney to transact business or conduct proceedings in a court.
  - (3) A person who is registered under section 100 as a patent attorney is not guilty of an offence against section 32 or section 33 or section 35 of the Lawyers and Conveyancers Act 2006 by reason only of exercising any of the powers conferred on patent attorneys by this section.

Compare: Patents Act 1949 s 88(5) (UK)

Section 101(1)(a): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 101(3): replaced, on 1 August 2008, by section 348 of the Lawyers and Conveyancers Act 2006 (2006 No 1).

### **102 Cancellation of registration of patent attorneys**

- (1) The court, on application made by the Commissioner or by the New Zealand Institute of Patent Attorneys Incorporated with the leave in writing of the Attorney-General, may order the removal from the register of patent attorneys of the name of any patent attorney or the suspension from practice before IPONZ of any patent attorney who—
  - (a) is convicted of a crime involving dishonesty within the meaning of section 2 of the Crimes Act 1961; or
  - (b) has been guilty of misconduct in his professional capacity and by reason thereof is not a fit and proper person to practise as a patent attorney; or
  - (c) has otherwise been guilty of grave impropriety or infamous conduct and by reason thereof is not a fit and proper person to practise as a patent attorney.
- (2) The Commissioner and the New Zealand Institute of Patent Attorneys Incorporated shall be entitled to appear and be heard on any such application.
- (3) No person whose name has been removed from the register of patent attorneys under this section shall be again entered thereon except by direction of the court.

Section 102(1): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 102(1)(a): amended, on 1 January 1962, by section 411(1) of the Crimes Act 1961 (1961 No 43).

### **103 Restrictions on practice as patent attorney**

- (1) No person either alone or in partnership shall carry on business, practise, act, describe himself or hold himself out, or permit himself to be described or held

out, as a patent attorney or patent agent unless he is registered as a patent attorney, or, as the case may be, unless he and all his partners are so registered.

- (2) No company shall carry on business, practise, act, describe itself or hold itself out, or permit itself to be described or held out, as a patent attorney or patent agent:

provided that this subsection shall not apply in the case of any company which was immediately before the commencement of this Act carrying on business as a patent attorney during any period or periods while a manager or director of the company is registered as a patent attorney.

- (3) For the purposes of this section a person who or a company which undertakes for gain in New Zealand—

- (a) to apply for or obtain patents in New Zealand or elsewhere; or
- (b) to prepare specifications or other documents for the purposes of the Patents Act 2013, this Act, or the patent law of any country; or
- (c) to give advice other than of a scientific or technical nature as to the validity of patents or their infringement—

shall be deemed to carry on business as a patent attorney.

- (4) Any person who or company which fails to comply with or acts in contravention of the provisions of this section commits an offence, and shall be liable on conviction to a fine not exceeding \$200.
- (5) Nothing in this section shall be construed as prohibiting barristers or solicitors of the High Court of New Zealand from giving professional advice or taking such part in proceedings under the Patents Act 2013 or this Act as has heretofore been taken by them.
- (6) Nothing in this section shall prevent the personal representative of a deceased patent attorney from carrying on the business or practice of the deceased patent attorney for a period not exceeding 3 years from the date of the death of the patent attorney, or for such further period (if any) as the court may allow, if the personal representative is himself registered as a patent attorney or employs a person who is registered as a patent attorney to manage the business or practice.

Compare: 1921–22 No 18 s 135

Section 103(3)(b): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 103(4): amended, on 1 July 2013, by section 413 of the Criminal Procedure Act 2011 (2011 No 81).

Section 103(5): amended, on 13 September 2014, by section 249 of the Patents Act 2013 (2013 No 68).

Section 103(5): amended, on 1 April 1980, pursuant to section 12 of the Judicature Amendment Act 1979 (1979 No 124).

**104 Recovery of patent attorney's charges**

- (1) No patent attorney shall commence or maintain any action for the recovery of any fees, charges, or disbursements paid or incurred or made by him for any business done by him as a patent attorney until the expiration of 7 days after a bill of the fees, charges, and disbursements, signed by him (or, in the case of a partnership, by any of the partners with the name of the partnership), or enclosed in or accompanied by a letter signed in like manner referring to the bill, has been delivered to the party chargeable.
- (2) The delivery may be effected either by personal delivery to the party chargeable or by leaving the bill or letter for him at his place of business, or dwelling-house, or last known place of abode, or by forwarding it to him by post in a registered letter addressed to him as aforesaid. Where it is forwarded by post as aforesaid, it shall be deemed to have been delivered at the time at which the letter would have been delivered in the ordinary course of post.

Compare: 1921–22 No 18 s 137

*Offences***105 Falsification of register, etc**

- (1) Every person who makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, commits an offence, and shall be liable on conviction to imprisonment for any term not exceeding 2 years.
- (2) Despite anything to the contrary in section 25 of the Criminal Procedure Act 2011, a charging document may be filed at any time in respect of an offence against subsection (1).

Compare: 1921–22 No 18 s 143; Patents Act 1949 s 90 (UK)

Section 105(1): amended, on 1 July 2013, by section 413 of the Criminal Procedure Act 2011 (2011 No 81).

Section 105(2): inserted, on 1 July 2013, by section 413 of the Criminal Procedure Act 2011 (2011 No 81).

**106 Unauthorised claim of patent rights**

*[Repealed]*

Section 106: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**107 Protection of Royal Arms, etc**

*[Repealed]*

Section 107: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

### **108 Offences by companies**

Where an offence against section 25, section 26, section 103, or section 105 is committed by a body corporate, every person who at the time of the commission of the offence is a director, general manager, secretary, or other similar officer of the body corporate, or is purporting to act in any such capacity, shall be deemed to be guilty of that offence unless he proves that the offence was committed without his consent or connivance and that he exercised all such diligence to prevent the commission of the offence as he ought to have exercised having regard to the nature of his functions in that capacity and to all the circumstances.

Compare: Patents Act 1949 s 93 (UK)

### **109 Certain offences may be dealt with summarily**

*[Repealed]*

Section 109: repealed, on 1 April 1958, by section 214(1) of the Summary Proceedings Act 1957 (1957 No 87).

### *Miscellaneous*

### **110 Service of notices, etc, by post**

- (1) Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made, or filed by sending it by post in a letter addressed to the person concerned at his usual or last known address.
- (2) Where any notice is sent by the Commissioner to any person by post as aforesaid the notice shall be deemed to have been given at the time when the letter containing it would have been delivered in the ordinary course of post.

Compare: 1921–22 No 18 s 132; Patents Act 1949 s 97 (UK)

### **111 Declaration by person under disability**

*[Repealed]*

Section 111: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

### **112 Journal, indexes, etc**

*[Repealed]*

Section 112: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

### **113 Rules of court**

*[Repealed]*

Section 113: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**114 Regulations**

- (1) Subject to the provisions of this Act, the Governor-General may from time to time, by Order in Council, make all such regulations as may in his opinion be necessary or expedient for giving effect to the provisions of this Act and for the due administration thereof.
- (2) Without limiting the general power conferred by subsection (1), it is hereby declared that regulations may be made under this section for all or any of the following purposes:
  - (a) for regulating the business of the Patent Office in relation to patents:
  - (b) for regulating all matters by this Act placed under the direction or control of the Commissioner:
  - (c) for prescribing the form and manner of execution of applications for patents and of any specifications, drawings, or other documents which may be filed at the Patent Office, and for requiring copies to be furnished of any such documents:
  - (d) for regulating the procedure to be followed in connection with any application or request to the Commissioner or in connection with any proceeding before the Commissioner and for authorising the rectification of irregularities of procedure:
  - (e) for regulating the keeping of the register of patent attorneys:
  - (f) for regulating the registration of patent attorneys, and for prescribing the terms and conditions of their registration:
  - (g) for regulating the procedure for removing the names of patent attorneys from the register of patent attorneys and for suspending patent attorneys from practice before the Patent Office:
  - (h) prescribing classes of persons whom the Commissioner may refuse to recognise as agents in respect of proceedings under this Act:
  - (i) for authorising the preparation, publication, sale, and exchange of copies of specifications, drawings, and other documents in the Patent Office and of indexes to and abridgments of them:
  - (j) for prescribing the mode of advertising any matter which by this Act is required to be advertised:
  - (k) for prescribing anything authorised or required by this Act to be prescribed by regulations:
  - (l) for the carrying out, or giving effect to, New Zealand's obligations under the Patent Cooperation Treaty.

**(3) *[Repealed]***

Compare: 1921–22 No 18, s 138; Patents Act 1949 s 94 (UK)

Section 114(2)(l): inserted, on 1 December 1992, by section 9 of the Patents Amendment Act 1992 (1992 No 81).

Section 114(3): repealed, on 19 December 1989, by section 11 of the Regulations (Disallowance) Act 1989 (1989 No 143).

## **115 Fees**

- (1) Subject to the provisions of this Act, there shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters relating to patents arising under this Act, such fees as may be from time to time prescribed by regulations made under this Act, and all such fees shall be paid into a Departmental Bank Account.
- (2) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by the regulations made under this Act, may be refunded by the Commissioner, and all moneys so refunded shall be paid out of public money without further appropriation than this Act.
- (3) Fees in respect of international applications may, in accordance with New Zealand's obligations under the Patent Cooperation Treaty, be collected by the Commissioner on behalf of—
  - (a) the International Bureau; or
  - (b) any international search authority that has been approved, for the purposes of this subsection, by the Minister as an appropriate authority on whose behalf the Commissioner may collect such fees.

Compare: 1921–22 No 18 s 117; Patents Act 1949 s 99 (UK)

Section 115(1): amended (with effect on 1 July 1989), on 26 July 1989, by section 86(1) of the Public Finance Act 1989 (1989 No 44).

Section 115(2): amended (with effect on 1 July 1989), on 26 July 1989, by section 86(1) of the Public Finance Act 1989 (1989 No 44).

Section 115(3): inserted, on 1 December 1992, by section 10 of the Patents Amendment Act 1992 (1992 No 81).

## **116 Annual report of Commissioner**

*[Repealed]*

Section 116: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **117 Saving for Royal prerogative, etc**

*[Repealed]*

Section 117: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## **118 Application of Act to Tokelau**

*[Repealed]*

Section 118: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**119 Repeals and savings***[Repealed]*

Section 119: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**Schedule 1  
Enactments repealed***[Repealed]*

s 119(1)

Schedule 1: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**Schedule 2  
Regulations revoked***[Repealed]*

s 119(2)

Schedule 2: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

**Schedule 3  
Transitional provisions***[Repealed]*

s 119(3)(b)

Schedule 3: repealed, on 13 September 2014, by section 247(1) of the Patents Act 2013 (2013 No 68).

## Patents Amendment Act 1992

Public Act	1992 No 81
Date of assent	18 August 1992
Commencement	see section 1

### **1 Short Title and commencement**

- (1) This Act may be cited as the Patents Amendment Act 1992, and shall be read together with and deemed part of the Patents Act 1953 (hereinafter referred to as “the principal Act”).
- (2) Except as provided in subsection (3), this Act shall come into force on 1 December 1992.
- (3) Sections 3, 8, and 11 shall come into force on the day after the date on which this Act receives the Royal assent.

## Schedule 1

### Patent Cooperation Treaty

s 2

**Done at Washington on June 19, 1970, amended on October 2, 1979, and modified on February 3, 1984**

The Contracting States,

Desiring to make a contribution to the progress of science and technology,

Desiring to perfect the legal protection of inventions,

Desiring to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries,

Desiring to facilitate and accelerate access by the public to the technical information contained in documents describing new inventions,

Desiring to foster and accelerate the economic development of developing countries through the adoption of measures designed to increase the efficiency of their legal systems, whether national or regional, instituted for the protection of inventions by providing easily accessible information on the availability of technological solutions applicable to their special needs and by facilitating access to the ever expanding volume of modern technology,

Convinced that cooperation among nations will greatly facilitate the attainment of these aims,

Have concluded the present Treaty.

#### Introduction Provisions

##### Article 1—Establishment of a Union

- (1) The States party to this Treaty (hereinafter called “the Contracting States”) constitute a Union for cooperation in the filing, searching, and examination, of applications for the protection of inventions, and for rendering special technical services. The Union shall be known as the International Patent Cooperation Union.
- (2) No provision of this Treaty shall be interpreted as diminishing the rights under the Paris Convention for the Protection of Industrial Property of any national or resident of any country party to that Convention.

##### Article 2—Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

- (i) “application” means an application for the protection of an invention; references to an “application” shall be construed as references to applications for patents for inventions, inventors’ certificates, utility certificates, utility models,

- patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition;
- (ii) references to a "patent" shall be construed as references to patents for inventions, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, and utility certificates of addition;
  - (iii) "national patent" means a patent granted by a national authority;
  - (iv) "regional patent" means a patent granted by a national or an intergovernmental authority having the power to grant patents effective in more than one State;
  - (v) "regional application" means an application for a regional patent;
  - (vi) references to a "national application" shall be construed as references to applications for national patents and regional patents, other than applications filed under this Treaty;
  - (vii) "international application" means an application filed under this Treaty;
  - (viii) references to an "application" shall be construed as references to international applications and national applications;
  - (ix) references to a "patent" shall be construed as references to national patents and regional patents;
  - (x) references to "national law" shall be construed as references to the national law of a Contracting State or, where a regional application or a regional patent is involved, to the treaty providing for the filing of regional applications or the granting of regional patents;
  - (xi) "priority date," for the purposes of computing time limits, means:
    - (a) where the international application contains a priority claim under Article 8, the filing date of the application whose priority is so claimed;
    - (b) where the international application consists several priority claims under Article 8, the filing date of the earliest application whose priority is so claimed;
    - (c) where the international application does not contain any priority claim under Article 8, the international filing date of such application;
  - (xii) "national Office" means the government authority of a Contracting State entrusted with the granting of patents; references to a "national Office" shall be construed as referring also to any intergovernmental authority which several States have entrusted with the task of granting regional patents, provided that at least one of those States is a Contracting State, and provided that the said States have authorized that authority to assume the obligations and exercise the powers which this Treaty and the Regulations provide for in respect of national Offices;
  - (xiii) "designated Office" means the national Office of or acting for the State designated by the applicant under Chapter I of this Treaty;

- (xiv) “elected Office” means the national Office of or acting for the State elected by the applicant under Chapter II of this Treaty;
- (xv) “receiving Office” means the national Office or the intergovernmental organization with which the international application has been filed;
- (xvi) “Union” means the International Patent Cooperation Union;
- (xvii) “Assembly” means the Assembly of the Union;
- (xviii) “Organization” means the World Intellectual Property Organization;
- (xix) “International Bureau” means the International Bureau of the Organization and, as long as it subsists, the United International Bureaux for the Protection of Intellectual Property (BIRPI);
- (xx) “Director General” means the Director General of the Organization and, as long as BIRPI subsists, the Director of BIRPI.

## Chapter I

### International Application and International Search

#### Article 3—The International Application

- (1) Applications for the protection of inventions in any of the Contracting States may be filed as international applications under this Treaty.
- (2) An international application shall contain, as specified in this Treaty and the Regulations, a request, a description, one or more claims, one or more drawings (where required), and an abstract.
- (3) The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought.
- (4) The international application shall:
  - (i) be in a prescribed language;
  - (ii) comply with the prescribed physical requirements;
  - (iii) comply with the prescribed requirement of unity of invention;
  - (iv) be subject to the payment of the prescribed fees.

#### Article 4—The Request

- (1) The request shall contain:
  - (i) a petition to the effect that the international application be processed according to this Treaty;
  - (ii) the designation of the Contracting State or States in which protection for the invention is desired on the basis of the international application (“designated States”); if for any designated State a regional patent is available and the applicant wishes to obtain a regional patent rather than

- a national patent, the request shall so indicate; if, under a treaty concerning a regional patent, the applicant cannot limit his application to certain of the States party to that treaty, designation of one of those States and the indication of the wish to obtain the regional patent shall be treated as designation of all the States party to that treaty; if, under the national law of the designated State, the designation of that State has the effect of an application for a regional patent, the designation of the said State shall be treated as an indication of the wish to obtain the regional patent;
- (iii) the name of and other prescribed data concerning the applicant and the agent (if any);
  - (iv) the title of the invention;
  - (v) the name of and other prescribed data concerning the inventor where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application. Otherwise, the said indications may be furnished either in the request or in separate notices addressed to each designated Office whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application.
- (2) Every designation shall be subject to the payment of the prescribed fee within the prescribed time limit.
  - (3) Unless the applicant asks for any of the other kinds of protection referred to in Article 43, designation shall mean that the desired protection consists of the grant of a patent by or for the designated State. For the purposes of this paragraph, Article 2(ii) shall not apply.
  - (4) Failure to indicate in the request the name and other prescribed data concerning the inventor shall have no consequence in any designated State whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application. Failure to furnish the said indications in a separate notice shall have no consequence in any designated State whose national law does not require the furnishing of the said indications.

### Article 5—The Description

The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

### Article 6—The Claims

The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description.

### Article 7—The Drawings

- (1) Subject to the provisions of paragraph (2)(ii), drawings shall be required when they are necessary for the understanding of the invention.
- (2) Where, without being necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings:
  - (i) the applicant may include such drawings in the international application when filed,
  - (ii) any designated Office may require that the applicant file such drawings with it within the prescribed time limit.

### Article 8—Claiming Priority

- (1) The international application may contain a declaration, as prescribed in the Regulations, 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.
- (2)(a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.
- (b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

### Article 9—The Applicant

- (1) Any resident or national of a Contracting State may file an international application.
- (2) The Assembly may decide to allow the residents and the nationals of any country party to the Paris Convention for the Protection of Industrial Property which is not party to this Treaty to file international applications.
- (3) The concepts of residence and nationality, and the application of those concepts in cases where there are several applicants or where the applicants are not the same for all the designated States, are defined in the Regulations.

### Article 10—The Receiving Office

The international application shall be filed with the prescribed receiving Office, which will check and process it as provided in this Treaty and the Regulations.

### Article 11—Filing Date and Effects of the International Application

- (1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:
  - (i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,
  - (ii) the international application is in the prescribed language,
  - (iii) the international application contains at least the following elements:
    - (a) an indication that it is intended as an international application,
    - (b) the designation of at least one Contracting State,
    - (c) the name of the applicant, as prescribed,
    - (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.
- (2)(a) If the receiving Office finds that the international application did not, at the time of receipt, fulfil the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.
- (b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.
- (3) Subject to article 64(4), any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.
- (4) Any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property.

### Article 12—Transmittal of the International Application to the International Bureau and the International Searching Authority

- (1) One copy of the international application shall be kept by the receiving Office (“home copy”), one copy (“record copy”) shall be transmitted to the International Bureau, and another copy (“search copy”) shall be transmitted to the competent International Searching Authority referred to in Article 16, as provided in the Regulations.
- (2) The record copy shall be considered the true copy of the international application.

- (3) The international application shall be considered withdrawn if the record copy has not been received by the International Bureau within the prescribed time limit.

### Article 13—Availability of Copy of the International Application to Designated Offices

- (1) Any designated Office may ask the International Bureau to transmit to it a copy of the international application prior to the communication provided for in Article 20, and the International Bureau shall transmit such copy to the designated Office as soon as possible after the expiration of one year from the priority date.
- (2)(a) The applicant may, at any time, transmit a copy of his international application to any designated Office.
- (b) The applicant may, at any time, ask the International Bureau to transmit a copy of his international application to any designated Office, and the International Bureau shall transmit such copy to the designated Office as soon as possible.
- (c) Any national Office may notify the International Bureau that it does not wish to receive copies as provided for in subparagraph (b), in which case that subparagraph shall not be applicable in respect of that Office.

### Article 14—Certain Defects in the International Application

- (1)(a) The receiving Office shall check whether the international application contains any of the following defects, that is to say:
  - (i) it is not signed as provided in the Regulations;
  - (ii) it does not contain the prescribed indications concerning the applicant;
  - (iii) it does not contain a title;
  - (iv) it does not contain an abstract;
  - (v) it does not comply to the extent provided in the Regulations with the prescribed physical requirements.
- (b) If the receiving Office finds any of the said defects, it shall invite the applicant to correct the international application within the prescribed time limit, failing which that application shall be considered withdrawn and the receiving Office shall so declare.
- (2) If the international application refers to drawings which, in fact, are not included in that application, the receiving Office shall notify the applicant accordingly and he may furnish them within the prescribed time limit and, if he does, the international filing date shall be the date on which the drawings are received by the receiving Office. Otherwise, any reference to the said drawings shall be considered non-existent.
- (3)(a) If the receiving Office finds that, within the prescribed time limits, the fees prescribed under Article 3(4)(iv) have not been paid, or no fee prescribed under

Article 4(2) has been paid in respect of any of the designated States, the international application shall be considered withdrawn and the receiving Office shall so declare.

- (b) If the receiving Office finds that the fee prescribed under Article 4(2) has been paid in respect of one or more (but less than all) designated States within the prescribed time limit, the designation of those States in respect of which it has not been paid within the prescribed time limit shall be considered withdrawn and the receiving Office shall so declare.
- (4) If, after having accorded an international filing date to the international application, the receiving Office finds, within the prescribed time limit, that any of the requirements listed in items (i) to (iii) of Article 11(1) was not complied with at that date, the said application shall be considered withdrawn and the receiving Office shall so declare.

#### Article 15—The International Search

- (1) Each international application shall be the subject of international search.
- (2) The objective of the international search is to discover relevant prior art.
- (3) International search shall be made on the basis of the claims, with due regard to the description and the drawings (if any).
- (4) The International Searching Authority referred to in Article 16 shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations.
- (5)(a) If the national law of the Contracting State so permits, the applicant who files a national application within the national Office of or acting for such State may, subject to the conditions provided for in such law, request that a search similar to an international search (“international-type search”) be carried out on such application.
- (b) If the national law of the Contracting State so permits, the national Office of or acting for such State may subject any national application filed with it to an international-type search.
- (c) The international-type search shall be carried out by the International Searching Authority referred to in Article 16 which would be competent for an international search if the national application were an international application and were filed with the Office referred to in subparagraphs (a) and (b). If the national application is in a language which the International Searching Authority considers it is not equipped to handle, the international-type search shall be carried out on a translation prepared by the applicant in a language prescribed for international applications and which the International Searching Authority has undertaken to accept for international applications. The national application and the translation, when required, shall be presented in the form prescribed for international applications.

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### Article 16—The International Searching Authority

- (1) International search shall be carried out by an International Searching Authority, which may be either a national Office or an intergovernmental organization, such as the International Patent Institute, whose tasks include the establishing of documentary search reports on prior art with respect to inventions which are the subject of applications.
- (2) If, pending the establishment of a single International Searching Authority, there are several International Searching Authorities, each receiving Office shall, in accordance with the provisions of the applicable agreement referred to in paragraph (3)(b), specify the International Searching Authority or Authorities competent for the searching of international applications filed with such Office.
- (3)(a) International Searching Authorities shall be appointed by the Assembly. Any national Office and any intergovernmental organization satisfying the requirements referred to in subparagraph (c) may be appointed as International Searching Authority.
- (b) Appointment shall be conditional on the consent of the national Office or intergovernmental organization to be appointed and the conclusion of an agreement, subject to approval by the Assembly, between such Office or organization and the International Bureau. The agreement shall specify the rights and obligations of the parties, in particular, the formal undertaking by the said Office or organization to apply and observe all the common rules of international search.
- (c) The Regulations prescribe the minimum requirements, particularly as to manpower and documentation, which any Office or organization must satisfy before it can be appointed and must continue to satisfy while it remains appointed.
- (d) Appointment shall be for a fixed period of time and may be extended for further periods.
- (e) Before the Assembly makes a decision on the appointment of any national Office or intergovernmental organization, or on the extension of its appointment, or before it allows any such appointment to lapse, the Assembly shall hear the interested Office or organization and seek the advice of the Committee for Technical Cooperation referred to in Article 56 once that Committee has been established.

### Article 17—Procedure before the International Searching Authority

- (1) Procedure before the International Searching Authority shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.
- (2)(a) If the International Searching Authority considers

- (i) that the international application relates to a subject matter which the International Searching Authority is not required, under the Regulations, to search, and in the particular case decides not to search, or
- (ii) that the description, the claims, or the drawings, fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out,

the said Authority shall so declare and shall notify the applicant and the International Bureau that no international search report will be established.

- (b) If any of the situations referred to in subparagraph (a) is found to exist in connection with certain claims only, the international search report shall so indicate in respect of such claims, whereas, for the other claims, the said report shall be established as provided in Article 18.
- (3)(a) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant to pay additional fees. The International Searching Authority shall establish the international search report on those parts of the international application which relate to the invention first mentioned in the claims (“main invention”) and, provided the required additional fees have been paid within the prescribed time limit, on those parts of the international application which relate to inventions in respect of which the said fees were paid.
- (b) The national law of any designated State may provide that, where the national Office of that State finds the invitation, referred to in subparagraph (a), of the International Searching Authority justified and where the applicant has not paid all additional fees, those parts of the international application which consequently have not been searched shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to the national Office of that State.

#### Article 18—The International Search Report

- (1) The international search report shall be established within the prescribed time limit and in the prescribed form.
- (2) The international search report shall, as soon as it has been established, be transmitted by the International Searching Authority to the applicant and the International Bureau.
- (3) The international search report or the declaration referred to in Article 17(2)(a) shall be translated as provided in the Regulations. The translations shall be prepared by or under the responsibility of the International Bureau.

#### Article 19—Amendment of the Claims before the International Bureau

- (1) The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by

filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

- (2) The amendments shall not go beyond the disclosure in the international application as filed.
- (3) If the national law of any designated State permits amendments to go beyond the said disclosure, failure to comply with paragraph (2) shall have no consequence in that State.

#### Article 20—Communication to Designated Offices

- (1)(a) The international application, together with the international search report (including any indication referred to in Article 17(2)(b)) or the declaration referred to in Article 17(2)(a), shall be communicated to each designated Office, as provided in the Regulations, unless the designated Office waives such requirement in its entirety or in part.
- (b) The communication shall include the translation (as prescribed) of the said report or declaration.
- (2) If the claims have been amended by virtue of Article 19(1), the communication shall either contain the full text of the claims both as filed and as amended or shall contain the full text of the claims as filed and specify the amendments, and shall include the statement, if any, referred to in Article 19(1).
- (3) At the request of the designated Office or the applicant, the International Searching Authority shall send to the said Office or the applicant, respectively, copies of the documents cited in the international search report, as provided in the Regulations.

#### Article 21—International Publication

- (1) The International Bureau shall publish international applications.
- (2)(a) Subject to the exceptions provided for in subparagraph (b) and in Article 64(3), the international publication of the international application shall be effected promptly after the expiration of 18 months from the priority date of that application.
- (b) The applicant may ask the International Bureau to publish his international application any time before the expiration of the time limit referred to in subparagraph (a). The International Bureau shall proceed accordingly, as provided in the Regulations.
- (3) The international search report or the declaration referred to in Article 17(2)(a) shall be published as prescribed in the Regulations.
- (4) The language and form of the international publication and other details are governed by the Regulations.

- (5) There shall be no international publication if the international application is withdrawn or is considered withdrawn before the technical preparations for publication have been completed.
- (6) If the international application contains expressions or drawings which, in the opinion of the International Bureau, are contrary to morality or public order, or if, in its opinion, the international application contains disparaging statements as defined in the Regulations, it may omit such expressions, drawings, and statements, from its publications, indicating the place and number of words or drawings omitted, and furnishing, upon request, individual copies of the passages omitted.

#### Article 22—Copy, Translation, and Fee, to Designated Offices

- (1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 20 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 20 months from the priority date.
- (2) Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).
- (3) Any national law may, for performing the acts referred to in paragraphs (1) or (2), fix time limits which expire later than the time limit provided for in those paragraphs.

#### Article 23—Delaying of National Procedure

- (1) No designated Office shall process or examine the international application prior to the expiration of the applicable time limit under Article 22.
- (2) Notwithstanding the provisions of paragraph (1), any designated Office may, on the express request of the applicant, process or examine the international application at any time.

#### Article 24—Possible Loss of Effect in Designated States

- (1) Subject, in case (ii) below, to the provisions of Article 25, the effect of the international application provided for in Article 11(3) shall cease in any designated State with the same consequences as the withdrawal of any national application in that State:

- (i) if the applicant withdraws his international application or the designation of that State;
  - (ii) if the international application is considered withdrawn by virtue of Articles 12(3), 14(1)(b), 14(3)(a), or 14(4), or if the designation of that State is considered withdrawn by virtue of Article 14(3)(b);
  - (iii) if the applicant fails to perform the acts referred to in Article 22 within the applicable time limit.
- (2) Notwithstanding the provisions of paragraph (1), any designated Office may maintain the effect provided for in Article 11(3) even where such effect is not required to be maintained by virtue of Article 25(2).

#### Article 25—Review by Designated Offices

- (1)(a) Where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn, or where the International Bureau has made a finding under Article 12(3), the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to any of the designated Offices named by the applicant.
- (b) Where the receiving Office has declared that the designation of any given State is considered withdrawn, the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to the national Office of such State.
- (c) The request under subparagraphs (a) or (b) shall be presented within the prescribed time limit.
- (2)(a) Subject to the provisions of subparagraph (b), each designated Office shall, provided that the national fee (if any) has been paid and the appropriate translation (as prescribed) has been furnished within the prescribed time limit, decide whether the refusal, declaration, or finding, referred to in paragraph (1) was justified under the provisions of this Treaty and the Regulations, and, if it finds that the refusal or declaration was the result of an error or omission on the part of the receiving Office or that the finding was the result of an error or omission on the part of the International Bureau, it shall, as far as effects in the State of the designated Office are concerned, treat the international application as if such error or omission had not occurred.
- (b) Where the record copy has reached the International Bureau after the expiration of the time limit prescribed under Article 12(3) on account of any error or omission on the part of the applicant, the provisions of subparagraph (a) shall apply only under the circumstances referred to in Article 48(2).

#### Article 26—Opportunity to Correct before Designated Offices

No designated Office shall reject an international application on the grounds of non-compliance with the requirements of this Treaty and the Regulations without first giv-

ing the applicant the opportunity to correct the said application to the extent and according to the procedure provided by the national law for the same or comparable situations in respect of national applications.

### Article 27—National Requirements

- (1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.
- (2) The provisions of paragraph (1) neither affect the application of the provisions of Article 7(2) nor preclude any national law from requiring, once the processing of the international application has started in the designated Office, the furnishing:
  - (i) when the applicant is a legal entity, of the name of an officer entitled to represent such legal entity,
  - (ii) of documents not part of the international application but which constitute proof of allegations or statements made in that application, including the confirmation of the international application by the signature of the applicant when that application, as filed, was signed by his representative or agent.
- (3) Where the applicant, for the purposes of any designated State, is not qualified according to the national law of that State to file a national application because he is not the inventor, the international application may be rejected by the designated Office.
- (4) Where the national law provides, in respect of the form or contents of national applications, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for by this Treaty and the Regulations in respect of international applications, the national Office, the courts and any other competent organs of or acting for the designated State may apply the former requirements, instead of the latter requirements, to international applications, except where the applicant insists that the requirements provided for by this Treaty and the Regulations be applied to his international application.
- (5) Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.
- (6) The national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.

- (7) Any receiving Office or, once the processing of the international application has started in the designated Office, that Office may apply the national law as far as it relates to any requirement that the applicant be represented by an agent having the right to represent applicants before the said Office and/or that the applicant have an address in the designated State for the purpose of receiving notifications.
- (8) Nothing in this Treaty and the Regulations is intended to be construed as limiting the freedom of any Contracting State to apply measures deemed necessary for the preservation of its national security or to limit, for the protection of the general economic interests of that State, the right of its own residents or nationals to file international applications.

#### Article 28—Amendment of the Claims, the Description, and the Drawings, before Designated Offices

- (1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each designated Office within the prescribed time limit. No designated Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired except with the express consent of the applicant.
- (2) The amendments shall not go beyond the disclosure in the international application as filed unless the national law of the designated State permits them to go beyond the said disclosure.
- (3) The amendments shall be in accordance with the national law of the designated State in all respects not provided for in this Treaty and the Regulations.
- (4) Where the designated Office requires a translation of the international application, the amendments shall be in the language of the translation.

#### Article 29—Effects of the International Publication

- (1) As far as the protection of any rights of the applicant in a designated State is concerned, the effects, in that State, of the international publication of an international application shall, subject to the provisions of paragraphs (2) to (4), be the same as those which the national law of the designated State provides for the compulsory national publication of unexamined national applications as such.
- (2) If the language in which the international publication has been effected is different from the language in which publications under the national law are effected in the designated State, the said national law may provide that the effects provided for in paragraph (1) shall be applicable only from such time as:
  - (i) a translation into the latter language has been published as provided by the national law, or

- (ii) a translation into the latter language has been made available to the public, by laying open for public inspection as provided by the national law, or
  - (iii) a translation into the latter language has been transmitted by the applicant to the actual or prospective unauthorized user of the invention claimed in the international application, or
  - (iv) both the acts described in (i) and (iii), or both the acts described in (ii) and (iii), have taken place.
- (3) The national law of any designated State may provide that, where the international publication has been effected, on the request of the applicant, before the expiration of 18 months from the priority date, the effects provided for in paragraph (1) shall be applicable only from the expiration of 18 months from the priority date.
- (4) The national law of any designated State may provide that the effects provided for in paragraph (1) shall be applicable only from the date on which a copy of the international application as published under Article 21 has been received in the national Office of or acting for such State. The said Office shall publish the date of receipt in its gazette as soon as possible.

#### Article 30—Confidential Nature of the International Application

- (1)(a) Subject to the provisions of subparagraph (b), the International Bureau and the International Searching Authorities shall not allow access by any person or authority to the international application before the international publication of that application, unless requested or authorized by the applicant.
- (b) The provisions of subparagraph (a) shall not apply to any transmittal to the competent International Searching Authority, to transmittals provided for under Article 13, and to communications provided for under Article 20.
- (2)(a) No national Office shall allow access to the international application by third parties, unless requested or authorized by the applicant, before the earliest of the following dates:
- (i) date of the international publication of the international application,
  - (ii) date of the receipt of the communication of the international application under Article 20,
  - (iii) date of the receipt of a copy of the international application under Article 22.
- (b) The provisions of subparagraph (a) shall not prevent any national Office from informing third parties that it has been designated, or from publishing that fact. Such information or publication may, however, contain only the following data: identification of the receiving Office, name of the applicant, international filing date, international application number, and title of the invention.

- (c) The provisions of subparagraph (a) shall not prevent any designated Office from allowing access to the international application for the purposes of the judicial authorities.
- (3) The provisions of paragraph (2)(a) shall apply to any receiving Office except as far as transmittals provided for under Article 12(1) are concerned.
- (4) For the purposes of this Article, the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication, provided, however, that no national Office shall generally publish an international application or its translation before the international publication or, if international publication has not taken place by the expiration of 20 months from the priority date, before the expiration of 20 months from the said priority date.

## **Chapter II**

### **International Preliminary Examination**

#### Article 31—Demand for International Preliminary Examination

- (1) On the demand of the applicant, his international application shall be the subject of an international preliminary examination as provided in the following provisions and the Regulations.
- (2)(a) Any applicant who is a resident or national, as defined in the Regulations, of a Contracting State bound by Chapter II, and whose international application has been filed with the receiving Office of or acting for such State, may make a demand for international preliminary examination.
- (b) The Assembly may decide to allow persons entitled to file international applications to make a demand for international preliminary examination even if they are residents or nationals of a State not party to this Treaty or not bound by Chapter II.
- (3) The demand for international preliminary examination shall be made separately from the international application. The demand shall contain the prescribed particulars and shall be in the prescribed language and form.
- (4)(a) The demand shall indicate the Contracting State or States in which the applicant intends to use the results of the international preliminary examination (“elected States”). Additional Contracting States may be elected later. Election may relate only to Contracting States already designated under Article 4.
- (b) Applicants referred to in paragraph (2)(a) may elect any Contracting State bound by Chapter II. Applicants referred to in paragraph (2)(b) may elect only such Contracting States bound by Chapter II as have declared that they are prepared to be elected by such applicants.
- (5) The demand shall be subject to the payment of the prescribed fees within the prescribed time limit.

- (6)(a) The demand shall be submitted to the competent International Preliminary Examining Authority referred to in Article 32.
- (b) Any later election shall be submitted to the International Bureau.
- (7) Each elected Office shall be notified of its election.

#### Article 32—The International Preliminary Examining Authority

- (1) International preliminary examination shall be carried out by the International Preliminary Examining Authority.
- (2) In the case of demands referred to in Article 31(2)(a), the receiving Office, and, in the case of demands referred to in Article 31(2)(b), the Assembly, shall, in accordance with the applicable agreement between the interested International Preliminary Examining Authority or Authorities and the International Bureau, specify the International Preliminary Examining Authority or Authorities competent for the preliminary examination.
- (3) The provisions of Article 16(3) shall apply, *murtatis mutandis*, in respect of International Preliminary Examining Authorities.

#### Article 33—The International Preliminary Examination

- (1) The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable.
- (2) For the purposes of the international preliminary examination, a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations.
- (3) For the purposes of the international preliminary examination, a claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art.
- (4) For the purposes of the international preliminary examination, a claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. “Industry” shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.
- (5) The criteria described above merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria for the purpose of deciding whether, in that State, the claimed invention is patentable or not.
- (6) The international preliminary examination shall take into consideration all the documents cited in the international search report. It may take into consideration any additional documents considered to be relevant in the particular case.

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### Article 34—Procedure before the International Preliminary Examining Authority

- (1) Procedure before the International Preliminary Examining Authority shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.
- (2)(a) The applicant shall have a right to communicate orally and in writing with the International Preliminary Examining Authority.
- (b) The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.
- (c) The applicant shall receive at least one written opinion from the International Preliminary Examining Authority unless such Authority considers that all of the following conditions are fulfilled:
  - (i) the invention satisfies the criteria set forth in Article 33(1),
  - (ii) the international application complies with the requirements of this Treaty and the Regulations in so far as checked by that Authority,
  - (iii) no observations are intended to be made under Article 35(2), last sentence.
- (d) The applicant may respond to the written opinion.
- (3)(a) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it may invite the applicant, at his option, to restrict the claims so as to comply with the requirement or to pay additional fees.
- (b) The national law of any elected State may provide that, where the applicant chooses to restrict the claims under subparagraph (a), those parts of the international application which, as a consequence of the restriction, are not to be the subject of international preliminary examination shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to the national Office of that State.
- (c) If the applicant does not comply with the invitation referred to in subparagraph (a) within the prescribed time limit, the International Preliminary Examining Authority shall establish an international preliminary examination report on those parts of the international application which relate to what appears to be the main invention and shall indicate the relevant facts in the said report. The national law of any elected State may provide that, where its national Office finds the invitation of the International Preliminary Examining Authority justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to that Office.

- (4)(a) If the International Preliminary Examining Authority considers—
- (i) that the international application relates to a subject matter on which the International Preliminary Examining Authority is not required, under the Regulations, to carry out an international preliminary examination, and in the particular case decides not to carry out such examination, or
  - (ii) that 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,
- the said Authority shall not go into the questions referred to in Article 33(1) and shall inform the applicant of this opinion and the reasons therefor.
- (b) If any of the situations referred to in subparagraph (a) is found to exist in, or in connection with, certain claims only, the provisions of that subparagraph shall apply only to the said claims.

#### Article 35—The International Preliminary Examination Report

- (1) The international preliminary examination report shall be established within the prescribed time limit and in the prescribed form.
- (2) 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 shall state, subject to the provisions of paragraph (3), in relation to each claim, whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined for the purposes of the international preliminary examination in Article 33(1) to (4). The statement shall be accompanied by the citation of the documents believed to support the stated conclusion with such explanations as the circumstances of the case may require. The statement shall also be accompanied by such other observations as the Regulations provide for.
- (3)(a) If, at the time of establishing the international preliminary examination report, the International Preliminary Examining Authority considers that any of the situations referred to in Article 34(4)(a) exists, that report shall state this opinion and the reasons therefor. It shall not contain any statement as provided in paragraph (2).
- (b) If a situation under Article 34(4)(b) is found to exist, the international preliminary examination report shall, in relation to the claims in question, contain the statement as provided in subparagraph (a), whereas, in relation to the other claims, it shall contain the statement as provided in paragraph (2).

### Article 36—Transmittal, Translation, and Communication, of the International Preliminary Examination Report

- (1) The international preliminary examination report, together with the prescribed annexes, shall be transmitted to the applicant and to the International Bureau.
- (2)(a) The international preliminary examination report and its annexes shall be translated into the prescribed languages.
- (b) Any translation of the said report shall be prepared by or under the responsibility of the International Bureau, whereas any translation of the said annexes shall be prepared by the applicant.
- (3)(a) The international preliminary examination report, together with its translation (as prescribed) and its annexes (in the original language), shall be communicated by the International Bureau to each elected Office.
- (b) The prescribed translation of the annexes shall be transmitted within the prescribed time limit by the applicant to the elected Offices.
- (4) The provisions of Article 20(3) shall apply, *mutatis mutandis*, to copies of any document which is cited in the international preliminary examination report and which was not cited in the international search report.

### Article 37—Withdrawal of Demand or Election

- (1) The applicant may withdraw any or all elections.
- (2) If the election of all elected States is withdrawn, the demand shall be considered withdrawn.
- (3)(a) Any withdrawal shall be notified to the International Bureau.
- (b) The elected Offices concerned and the International Preliminary Examining Authority concerned shall be notified accordingly by the International Bureau.
- (4)(a) Subject to the provisions of subparagraph (b), withdrawal of the demand or of the election of a Contracting State shall, unless the national law of that State provides otherwise, be considered to be withdrawal of the international application as far as that State is concerned.
- (b) Withdrawal of the demand or of the election shall not be considered to be withdrawal of the international application if such withdrawal is effected prior to the expiration of the applicable time limit under Article 22; however, any Contracting State may provide in its national law that the aforesaid shall apply only if its national Office has received, within the said time limit, a copy of the international application, together with a translation (as prescribed), and the national fee.

### Article 38—Confidential Nature of the International Preliminary Examination

- (1) Neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4) to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.
- (2) Subject to the provisions of paragraph (1) and Articles 36(1) and (3) and 37(3)(b), neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, give information on the issuance or non-issuance of an international preliminary examination report and on the withdrawal or nonwithdrawal of the demand or of any election.

### Article 39—Copy, Translation, and Fee, to Elected Offices

- (1)(a) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30 months from the priority date.
- (b) Any national law may, for performing the acts referred to in subparagraph (a), fix time limits which expire later than the time limit provided for in that subparagraph.
- (2) The effect provided for in Article 11(3) shall cease in the elected State with the same consequences as the withdrawal of any national application in that State if the applicant fails to perform the acts referred to in paragraph (1)(a) within the time limit applicable under paragraph (1)(a) or (b).
- (3) Any elected Office may maintain the effect provided for in Article 11(3) even where the applicant does not comply with the requirements provided for in paragraph (1)(a) or (b).

### Article 40—Delaying of National Examination and Other Processing

- (1) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 23 shall not apply to such State and the national Office of or acting for that State shall not proceed, subject to the provisions of paragraph (2), to the examination and other processing of the international application prior to the expiration of the applicable time limit under Article 39.

- (2) Notwithstanding the provisions of paragraph (1), any elected Office may, on the express request of the applicant, proceed to the examination and other processing of the international application at any time.

#### Article 41—Amendment of the Claims, the Description, and the Drawings, before Elected Offices

- (1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each elected Office within the prescribed time limit. No elected Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired, except with the express consent of the applicant.
- (2) The amendments shall not go beyond the disclosure in the international application as filed, unless the national law of the elected State permits them to go beyond the said disclosure.
- (3) The amendments shall be in accordance with the national law of the elected State in all respects not provided for in this Treaty and the Regulations.
- (4) Where an elected Office requires a translation of the international application, the amendments shall be in the language of the translation.

#### Article 42—Results of National Examination in Elected Offices

No elected Office receiving the international preliminary examination report may require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same international application in any other elected Office.

### Chapter III Common Provisions

#### Article 43—Seeking Certain Kinds of Protection

In respect of any designated or elected State whose law provides for the grant of inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, or utility certificates of addition, the applicant may indicate, as prescribed in the Regulations, that his international application is for the grant, as far as that State is concerned, of an inventor's certificate, a utility certificate, or a utility model, rather than a patent, or that it is for the grant of a patent or certificate of addition, an inventor's certificate of addition, or a utility certificate of addition, and the ensuing effect shall be governed by the applicant's choice. For the purposes of this Article and any Rule thereunder, Article 2(ii) shall not apply.

#### Article 44—Seeking Two Kinds of Protection

In respect of any designated or elected State whose law permits an application, while being for the grant of a patent or one of the other kinds of protection referred to in

Article 43, to be also for the grant of another of the said kinds of protection, the applicant may indicate, as prescribed in the Regulations, the two kinds of protection he is seeking, and the ensuing effect shall be governed by the applicant's indications. For the purposes of this Article, Article 2(ii) shall not apply.

#### Article 45—Regional Patent Treaties

- (1) Any treaty providing for the grant of regional patents (“regional patent treaty”), and giving to all persons who, according to Article 9, are entitled to file international applications the right to file applications for such patents, may provide that international applications designating or electing a State party to both the regional patent treaty and the present Treaty may be filed as applications for such patents.
- (2) The national law of the said designated or elected State may provide that any designation or election of such State in the international application shall have the effect of an indication of the wish to obtain a regional patent under the regional patent treaty.

#### Article 46—Incorrect Translation of the International Application

If, because of an incorrect translation of the international application, the scope of any patent granted on that application exceeds the scope of the international application in its original language, the competent authorities of the Contracting State concerned may accordingly and retroactively limit the scope of the patent, and declare it null and void to the extent that its scope has exceeded the scope of the international application in its original language.

#### Article 47—Time Limits

- (1) The details for computing time limits referred to in this Treaty are governed by the Regulations.
- (2)(a) All time limits fixed in Chapters I and II of this Treaty may, outside any revision under Article 60, be modified by a decision of the Contracting States.
- (b) Such decisions shall be made in the Assembly or through voting by correspondence and must be unanimous.
- (c) The details of the procedure are governed by the Regulations.

#### Article 48—Delay in Meeting Certain Time Limits

- (1) Where any time limit fixed in this Treaty or the Regulations is not met because of interruption in the mail service or unavoidable loss or delay in the mail, the time limit shall be deemed to be met in the cases and subject to the proof and other conditions prescribed in the Regulations.
- (2)(a) Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit.

- (b) Any Contracting State may, as far as that State is concerned, excuse, for reasons other than those referred to in subparagraph (a), any delay in meeting any time limit.

#### Article 49—Right to Practice before International Authorities

Any attorney, patent agent, or other person, having the right to practice before the national Office with which the international application was filed, shall be entitled to practice before the International Bureau and the competent International Searching Authority and competent International Preliminary Examining Authority in respect of that application.

### Chapter IV Technical Services

#### Article 50—Patent Information Services

- (1) The International Bureau may furnish services by providing technical and any other pertinent information available to it on the basis of published documents, primarily patents and published applications (referred to in this Article as “the information services”).
- (2) The International Bureau may provide these information services either directly or through one or more International Searching Authorities or other national or international specialized institutions, with which the International Bureau may reach agreement.
- (3) The information services shall be operated in a way particularly facilitating the acquisition by Contracting States which are developing countries of technical knowledge and technology, including available published know-how.
- (4) The information services shall be available to Governments of Contracting States and their nationals and residents. The Assembly may decide to make these services available also to others.
- (5)(a) Any service to Governments of Contracting States shall be furnished at cost, provided that, when the Government is that of a Contracting State which is a developing country, the service shall be furnished below cost if the difference can be covered from profit made on services furnished to others than Governments of Contracting States or from the sources referred to in Article 51(4).
- (b) The cost referred to in subparagraph (a) is to be understood as cost over and above costs normally incident to the performance of the services of a national Office or the obligations of an International Searching Authority.
- (6) The details concerning the implementation of the provisions of this Article shall be governed by decisions of the Assembly and, within the limits to be fixed by the Assembly, such working groups as the Assembly may set up for that purpose.

- (7) The Assembly shall, when it considers it necessary, recommend methods of providing financing supplementary to those referred to in paragraph (5).

#### Article 51—Technical Assistance

- (1) The Assembly shall establish a Committee for Technical Assistance (referred to in this Article as “the Committee”).
- (2)(a) The members of the Committee shall be elected among the Contracting States, with due regard to the representation of developing countries.
- (b) The Director General shall, on his own initiative or at the request of the Committee, invite representatives of intergovernmental organizations concerned with technical assistance to developing countries to participate in the work of the Committee.
- (3)(a) The task of the Committee shall be to organize and supervise technical assistance for Contracting States which are developing countries in developing their patent systems individually or on a regional basis.
- (b) The technical assistance shall comprise, among other things, the training of specialists, the loaning of experts, and the supply of equipment both for demonstration and for operational purposes.
- (4) The International Bureau shall seek to enter into agreements, on the one hand, with international financing organizations and intergovernmental organizations, particularly the United Nations, the agencies of the United Nations, and the Specialized Agencies connected with the United Nations concerned with technical assistance, and, on the other hand, with the Governments of the States receiving the technical assistance, for the financing of projects pursuant to this Article.
- (5) The details concerning the implementation of the provisions of this Article shall be governed by decisions of the Assembly and, within the limits to be fixed by the Assembly, such working groups as the Assembly may set up for that purpose.

#### Article 52—Relations with Other Provisions of the Treaty

Nothing in this Chapter shall affect the financial provisions contained in any other Chapter of this Treaty. Such provisions are not applicable to the present Chapter or to its implementation.

### Chapter V Administrative Provisions

#### Article 53—Assembly

- (1)(a) The Assembly shall, subject to Article 57(8), consist of the Contracting States.

- (b) The Government of each Contracting State shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
- (2)(a) The Assembly shall:
- (i) deal with all matters concerning the maintenance and development of the union and the implementation of this Treaty;
  - (ii) perform such tasks as are specifically assigned to it under other provisions of this Treaty;
  - (iii) give directions to the International Bureau concerning the preparation for revision conferences;
  - (iv) review and approve the reports and activities of the Director General concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;
  - (v) review and approve the reports and activities of the Executive Committee established under paragraph (9), and give instructions to such Committee;
  - (vi) determine the program and adopt the triennial<sup>1</sup> budget of the Union, and approve its final accounts;
  - (vii) adopt the financial regulations of the Union;
  - (viii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union;
  - (ix) determine which States other than Contracting States and, subject to the provisions of paragraph (8), which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;
  - (x) take any other appropriate action designed to further the objectives of the Union and perform such other functions as are appropriate under this Treaty.
- (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.
- (3) A delegate may represent, and vote in the name of, one State only.
- (4) Each Contracting State shall have one vote.
- (5)(a) One-half of the Contracting States shall constitute a quorum.
- (b) In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall

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<sup>1</sup> *Editor's Note:* Since 1980, the budget of the Union is biennial.

take effect only if the quorum and the required majority are attained through voting by correspondence as provided in the Regulations.

- (6)(a) Subject to the provisions of Articles 47(2)(b), 58(2)(b), 58(3) and 61(2)(b), the decisions of the Assembly shall require two-thirds of the votes cast.
- (b) Abstentions shall not be considered as votes.
- (7) In connection with matters of exclusive interest to States bound by Chapter II, any reference to Contracting States in paragraphs (4), (5), and (6), shall be considered as applying only to States bound by Chapter II.
- (8) Any intergovernmental organization appointed as International Searching or Preliminary Examining Authority shall be admitted as observer to the Assembly.
- (9) When the number of Contracting States exceeds forty, the Assembly shall establish an Executive Committee. Any reference to the Executive Committee in this Treaty and the Regulations shall be construed as references to such Committee once it has been established.
- (10) Until the Executive Committee has been established, the Assembly shall approve, within the limits of the program and triennial budget, the annual programs and budgets prepared by the Director General.<sup>2</sup>
- (11)(a) The Assembly shall meet in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.
- (b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of the Executive Committee, or at the request of one-fourth of the Contracting States.
- (12) The Assembly shall adopt its own rules of procedure.

#### Article 54—Executive Committee

- (1) When the Assembly has established an Executive Committee, that Committee shall be subject to the provisions set forth hereinafter.
- (2)(a) The Executive Committee shall, subject to Article 57(8), consist of States elected by the Assembly from among States members of the Assembly.
- (b) The Government of each State member of the Executive Committee shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
- (3) The number of States members of the Executive Committee shall correspond to one-fourth of the number of States members of the Assembly. In establishing

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<sup>2</sup> *Editor's Note:* Since 1980, the program and budget of the Union are biennial.

- the number of seats to be filled, remainders after division by four shall be disregarded.
- (4) In electing the members of the Executive Committee, the Assembly shall have due regard to an equitable geographical distribution.
- (5)(a) Each member of the Executive Committee shall serve from the close of the session of the Assembly which elected it to the close of the next ordinary session of the Assembly.
- (b) Members of the Executive Committee may be re-elected but only up to a maximum of two-thirds of such members.
- (c) The Assembly shall establish the details of the rules governing the election and possible re-election of the members of the Executive Committee.
- (6)(a) The Executive Committee shall:
- (i) prepare the draft agenda of the Assembly;
  - (ii) submit proposals to the Assembly in respect of the draft program and biennial budget of the Union prepared by the Director General;
  - (iii) *[deleted]*
  - (iv) submit, with appropriate comments, to the Assembly the periodical reports of the Director General and the yearly audit reports on the accounts;
  - (v) take all necessary measures to ensure the execution of the program of the Union by the Director General, in accordance with the decisions of the Assembly and having regard to circumstances arising between two ordinary sessions of the Assembly;
  - (vi) perform such other functions as are allocated to it under this Treaty.
- (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Executive Committee shall make its decisions after having heard the advice of the Coordination Committee of the Organization.
- (7)(a) The Executive Committee shall meet once a year in ordinary session upon convocation by the Director General, preferably during the same period and at the same place as the Coordination Committee of the Organization.
- (b) The Executive Committee shall meet in extraordinary session upon convocation by the Director General, either on his own initiative or at the request of its Chairman or one-fourth of its members.
- (8)(a) Each State member of the Executive Committee shall have one vote.
- (b) One-half of the members of the Executive Committee shall constitute a quorum.
- (c) Decisions shall be made by a simple majority of the votes cast.
- (d) Abstentions shall not be considered as votes.
- (e) A delegate may represent, and vote in the name of, one State only.

- (9) Contracting States not members of the Executive Committee shall be admitted to its meetings as observers, as well as any intergovernmental organization appointed as International Searching or Preliminary Examining Authority.
- (10) The Executive Committee shall adopt its own rules of procedure.

#### Article 55—International Bureau

- (1) Administrative tasks concerning the Union shall be performed by the International Bureau.
- (2) The International Bureau shall provide the secretariat of the various organs of the Union.
- (3) The Director General shall be the chief executive of the Union and shall represent the Union.
- (4) The International Bureau shall publish a Gazette and other publications provided for by the Regulations or required by the Assembly.
- (5) The Regulations shall specify the services that national Offices shall perform in order to assist the International Bureau and the International Searching and Preliminary Examining Authorities in carrying out their tasks under this Treaty.
- (6) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the Executive Committee and any other committee or working group established under this Treaty or the Regulations. The Director General, or a staff member designated by him, shall be *ex officio* secretary of these bodies.
- (7)(a) The International Bureau shall, in accordance with the directions of the Assembly and in cooperation with the Executive Committee, make the preparations for the revision conferences.
- (b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for revision conferences.
- (c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at revision conferences.
- (8) The International Bureau shall carry out any other tasks assigned to it.

#### Article 56—Committee for Technical Cooperation

- (1) The Assembly shall establish a Committee for Technical Cooperation (referred to in this Article as “the Committee”).
- (2)(a) The Assembly shall determine the composition of the Committee and appoint its members, with due regard to an equitable representation of developing countries.
- (b) The International Searching and Preliminary Examining Authorities shall be *ex officio* members of the Committee. In the case where such an Authority is the

- national Office of a Contracting State, that State shall not be additionally represented on the Committee.
- (c) If the number of Contracting States so allows, the total number of members of the Committee shall be more than double the number of *ex officio* members.
  - (d) The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested organizations to participate in discussions of interest to them.
- (3) The aim of the Committee shall be to contribute, by advice and recommendations:
- (i) to the constant improvement of the services provided for under this Treaty,
  - (ii) to the securing, so long as there are several International Searching Authorities and several International Preliminary Examining Authorities, of the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their reports, and
  - (iii) on the initiative of the Assembly or the Executive Committee, to the solution of the technical problems specifically involved in the establishment of a single International Searching Authority.
- (4) Any Contracting State and any interested international organization may approach the Committee in writing on questions which fall within the competence of the Committee.
- (5) The Committee may address its advice and recommendations to the Director General or, through him, to the Assembly, the Executive Committee, all or some of the International Searching and Preliminary Examining Authorities, and all or some of the receiving Offices.
- (6)(a) In any case, the Director General shall transmit to the Executive Committee the texts of all the advice and recommendations of the Committee. He may comment on such texts.
- (b) The Executive Committee may express its views on any advice, recommendation, or other activity of the Committee, and may invite the Committee to study and report on questions falling within its competence. The Executive Committee may submit to the Assembly, with appropriate comments, the advice, recommendations and report of the Committee.
- (7) Until the Executive Committee has been established, references in paragraph (6) to the Executive Committee shall be construed as references to the Assembly.
- (8) The details of the procedure of the Committee shall be governed by the decisions of the Assembly.

### Article 57—Finances

- (1)(a) The Union shall have a budget.
- (b) The budget of the Union shall include the income and expenses proper to the Union and its contribution to the budget of expenses common to the Unions administered by the Organization.
- (c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.
- (2) The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.
- (3) Subject to the provisions of paragraph (5), the budget of the Union shall be financed from the following sources:
  - (i) fees and charges due for services rendered by the International Bureau in relation to the Union;
  - (ii) sale of, or royalties on, the publications of the International Bureau concerning the Union;
  - (iii) gifts, bequests, and subventions;
  - (iv) rents, interests, and other miscellaneous income.
- (4) The amounts of fees and charges due to the International Bureau and the prices of its publications shall be so fixed that they should, under normal circumstances, be sufficient to cover all the expenses of the International Bureau connected with the administration of this Treaty.
- (5)(a) Should any financial year close with a deficit, the Contracting States shall, subject to the provisions of subparagraphs (b) and (c), pay contributions to cover such deficit.
- (b) The amount of the contribution of each Contracting State shall be decided by the Assembly with due regard to the number of international applications which has emanated from each of them in the relevant year.
- (c) If other means of provisionally covering any deficit or any part thereof are secured, the Assembly may decide that such deficit be carried forward and that the Contracting States should not be asked to pay contributions.
- (d) If the financial situation of the Union so permits, the Assembly may decide that any contributions paid under subparagraph (a) be reimbursed to the Contracting States which have paid them.
- (e) A Contracting State which has not paid, within two years of the due date as established by the Assembly, its contribution under subparagraph (b) may not exercise its right to vote in any of the organs of the Union. However, any organ of the Union may allow such a State to continue to exercise its right to vote in that

organ so long as it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

- (6) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.
- (7)(a) The Union shall have a working capital fund which shall be constituted by a single payment made by each Contracting State. If the fund becomes insufficient, the Assembly shall arrange to increase it. If part of the fund is no longer needed, it shall be reimbursed.
- (b) The amount of the initial payment of each Contracting State to the said fund or of its participation in the increase thereof shall be decided by the Assembly on the basis of principles similar to those provided for under paragraph (5)(b).
- (c) The terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.
- (d) Any reimbursement shall be proportionate to the amounts paid by each Contracting State, taking into account the dates at which they were paid.
- (8)(a) In the headquarters agreement concluded with the State on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such State shall grant advances. The amount of these advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such State and the Organization. As long as it remains under the obligation to grant advances, such State shall have an *ex officio* seat in the Assembly and on the Executive Committee.
- (b) The State referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.
- (9) The auditing of the accounts shall be effected by one or more of the Contracting States or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

#### Article 58—Regulations

- (1) The Regulations annexed to this Treaty provide Rules:
  - (i) concerning matters in respect of which this Treaty expressly refers to the Regulations or expressly provides that they are or shall be prescribed,
  - (ii) concerning any administrative requirements, matters, or procedures,
  - (iii) concerning any details useful in the implementation of the provisions of this Treaty.
- (2)(a) The Assembly may amend the Regulations.

- (b) Subject to the provisions of paragraph (3), amendments shall require three-fourths of the votes cast.
- (3)(a) The Regulations specify the Rules which may be amended
  - (i) only by unanimous consent, or
  - (ii) only if none of the Contracting States whose national Office acts as an International Searching or Preliminary Examining Authority dissents, and, where such Authority is an intergovernmental organization, if the Contracting State member of that organization authorized for that purpose by the other member States within the competent body of such organization does not dissent.
- (b) Exclusion, for the future, of any such Rules from the applicable requirement shall require the fulfillment of the conditions referred to in subparagraph (a)(i) or (a)(ii), respectively.
- (c) Inclusion, for the future, of any Rule in one or the other of the requirements referred to in subparagraph (a) shall require unanimous consent.
- (4) The Regulations provide for the establishment, under the control of the Assembly, of Administrative Instructions by the Director General.
- (5) In the case of conflict between the provisions of the Treaty and those of the Regulations, the provisions of the Treaty shall prevail.

## **Chapter VI**

### **Disputes**

#### Article 59—Disputes

Subject to Article 64(5), any dispute between two or more Contracting States concerning the interpretation or application of this Treaty or the Regulations, not settled by negotiation, may, by any one of the States concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the States concerned agree on some other method of settlement. The Contracting State bringing the dispute before the Court shall inform the International Bureau; the International Bureau shall bring the matter to the attention of the other Contracting States.

## **Chapter VII**

### **Revision and Amendment**

#### Article 60—Revision of the Treaty

- (1) This Treaty may be revised from time to time by a special conference of the Contracting States.
- (2) The convocation of any revision conference shall be decided by the Assembly.

- (3) Any intergovernmental organization appointed as International Searching or Preliminary Examining Authority shall be admitted as observer to any revision conference.
- (4) Articles 53(5), (9) and (11), 54, 55(4) to (8), 56, and 57, may be amended either by a revision conference or according to the provisions of Article 61.

#### Article 61—Amendment of Certain Provisions of the Treaty

- (1)(a) Proposals for the amendment of Articles 53(5), (9) and (11), 54, 55(4) to (8), 56, and 57, may be initiated by any State member of the Assembly, by the Executive Committee, or by the Director General.
- (b) Such proposals shall be communicated by the Director General to the Contracting States at least six months in advance of their consideration by the Assembly.
- (2)(a) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly.
- (b) Adoption shall require three-fourths of the votes cast.
- (3)(a) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the States members of the Assembly at the time it adopted the amendment.
- (b) Any amendment to the said Articles thus accepted shall bind all the States which are members of the Assembly at the time the amendment enters into force, provided that any amendment increasing the financial obligations of the Contracting States shall bind only those States which have notified their acceptance of such amendment.
- (c) Any amendment accepted in accordance with the provisions of subparagraph (a) shall bind all States which become members of the Assembly after the date on which the amendment entered into force in accordance with the provisions of subparagraph (a).

### Chapter VIII Final Provisions

#### Article 62—Becoming Party to the Treaty

- (1) Any State member of the International Union for the Protection of Industrial Property may become party to this Treaty by:
  - (i) signature followed by the deposit of an instrument of ratification, or
  - (ii) deposit of an instrument of accession.
- (2) Instruments of ratification or accession shall be deposited with the Director General.

- (3) The provisions of Article 24 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property shall apply to this Treaty.
- (4) Paragraph (3) shall in no way be understood as implying the recognition or tacit acceptance by a Contracting State of the factual situation concerning a territory to which this Treaty is made applicable by another Contracting State by virtue of the said paragraph.

#### Article 63—Entry into Force of the Treaty

- (1)(a) Subject to the provisions of paragraph (3), this Treaty shall enter into force three months after eight States have deposited their instruments of ratification of accession, provided that at least four of those States each fulfill any of the following conditions:
  - (i) the number of applications filed in the State has exceeded 40,000 according to the most recent annual statistics published by the International Bureau,
  - (ii) the nationals or residents of the State have filed at least 1,000 applications in one foreign country according to the most recent annual statistics published by the International Bureau,
  - (iii) the national Office of the State has received at least 10,000 applications from nationals or residents of foreign countries according to the most recent annual statistics published by the International Bureau.
- (b) For the purposes of this paragraph, the term “applications” does not include applications for utility models.
- (2) Subject to the provisions of paragraph (3), any State which does not become party to this Treaty upon entry into force under paragraph (1) shall become bound by this Treaty three months after the date on which such State has deposited its instrument of ratification or accession.
- (3) The provisions of Chapter II and the corresponding provisions of the Regulations annexed to this Treaty shall become applicable, however, only on the date on which three States each of which fulfill at least one of the three requirements specified in paragraph (1) have become party to this Treaty without declaring, as provided in Article 64(1), that they do not intend to be bound by the provisions of Chapter II. That date shall not, however, be prior to that of the initial entry into force under paragraph (1).

#### Article 64—Reservations

- (1)(a) Any State may declare that it shall not be bound by the provisions of Chapter II.
- (b) States making a declaration under subparagraph (a) shall not be bound by the provisions of Chapter II and the corresponding provisions of the Regulations.

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- (2)(a) Any State not having made a declaration under paragraph (1)(a) may declare that:
- (i) it shall not be bound by the provisions of Article 39(1) with respect to the furnishing of a copy of the international application and a translation thereof (as prescribed),
  - (ii) the obligation to delay national processing, as provided for under Article 40, shall not prevent publication, by or through its national Office, of the international application or a translation thereof, it being understood, however, that it is not exempted from the limitations provided for in Articles 30 and 38.
- (b) States making such a declaration shall be bound accordingly.
- (3)(a) Any State may declare that, as far as it is concerned, international publication of international applications is not required.
- (b) Where, at the expiration of 18 months from the priority date, the international application contains the designation only of such State as have made declarations under subparagraph (a), the international application shall not be published by virtue of Article 21(2).
- (c) Where the provisions of subparagraph (b) apply, the international application shall nevertheless be published by the International Bureau:
- (i) at the request of the applicant, as provided in the Regulations,
  - (ii) when a national application or a patent based on the international application is published by or on behalf of the national Office of any designated State having made a declaration under subparagraph (a), promptly after such publication but not before the expiration of 18 months from the priority date.
- (4)(a) Any State whose national law provides for prior art effect of its patents as from a date before publication, but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State, may declare that the filing outside that State of an international application designating that State is not equated to an actual filing in that State for prior art purposes.
- (b) Any State making a declaration under subparagraph (a) shall to that extent not be bound by the provisions of Article 11(3).
- (c) Any State making a declaration under subparagraph (a) shall, at the same time, state in writing the date from which, and the conditions under which, the prior art effect of any international application designating that State becomes effective in that State. This statement may be modified at any time by notification addressed to the Director General.
- (5) Each State may declare that it does not consider itself bound by Article 59. With regard to any dispute between any Contracting State having made such a

declaration and any other Contracting State, the provisions of Article 59 shall not apply.

- (6)(a) Any declaration made under this Article shall be made in writing. It may be made at the time of signing this Treaty, at the time of depositing the instrument of ratification or accession, or, except in the case referred to in paragraph (5), at any later time by notification addressed to the Director General. In the case of the said notification, the declaration shall take effect six months after the day on which the Director General has received the notification, and shall not affect international applications filed prior to the expiration of the said six-month period.
- (b) Any declaration made under this Article may be withdrawn at any time by notification addressed to the Director General. Such withdrawal shall take effect three months after the day on which the Director General has received the notification and, in the case of the withdrawal of a declaration made under paragraph (3), shall not affect international applications filed prior the expiration of the said three-month period.
- (7) No reservations to this Treaty other than the reservations under paragraphs (1) to (5) are permitted.

#### Article 65—Gradual Application

- (1) If the agreement with any International Searching or Preliminary Examining Authority provides, transitionally, for limits on the number or kind of international applications that such Authority undertakes to process, the Assembly shall adopt the measures necessary for the gradual application of this Treaty and the Regulations in respect of given categories of international applications. This provision shall also apply to requests for an international-type search under Article 15(5).
- (2) The Assembly shall fix the dates from which, subject to the provision of paragraph (1), international applications may be filed and demands for international preliminary examination may be submitted. Such dates shall not be later than six months after this Treaty has entered into force according to the provisions of Article 63(1), or after Chapter II has become applicable under Article 63(3), respectively.

#### Article 66—Denunciation

- (1) Any Contracting State may denounce this Treaty by notification addressed to the Director General.
- (2) Denunciation shall take effect six months after receipt of the said notification by the Director General. It shall not affect the effects of the international application in the denouncing State if the international application was filed, and, where the denouncing State has been elected, the election was made, prior to the expiration of the said six-month period.

### Article 67—Signature and Languages

- (1)(a) This Treaty shall be signed in a single original in the English and French languages, both texts being equally authentic.
- (b) Official texts shall be established by the Director General, after consultation with the interested Governments, in the German, Japanese, Portuguese, Russian and Spanish languages, and such other languages as the Assembly may designate.
- (2) This Treaty shall remain open for signature at Washington until December 31, 1970.

### Article 68—Depositary Functions

- (1) The original of this Treaty, when no longer open for signature, shall be deposited with the Director General.
- (2) The Director General shall transmit two copies, certified by him, of this Treaty and the Regulations annexed hereto to the Governments of all States party to the Paris Convention for the Protection of Industrial Property and, on request, to the Government of any other State.
- (3) The Director General shall register this Treaty with the Secretariat of the United Nations.
- (4) The Director General shall transmit two copies, certified by him, of any amendment to this Treaty and the Regulations to the Governments of all Contracting States and, on request, to the Government of any other State.

### Article 69—Notifications

The Director General shall notify the Governments of all States party to the Paris Convention for the Protection of Industrial Property of:

- (i) signatures under Article 62,
- (ii) deposits of instruments of ratification or accession under Article 62,
- (iii) the date of entry into force of this Treaty and the date from which Chapter II is applicable in accordance with Article 63(3),
- (iv) any declarations made under Article 64(1) to (5),
- (v) withdrawals of any declarations made under Article 64(6)(b),
- (vi) denunciations received under Article 66, and
- (vii) any declarations made under Article 31(4).

**Schedule 2**  
**Regulations under the Patent Cooperation Treaty (as in force from  
1 July 1992)**

s 2

**Part A**  
**Introductory Rules**

Rule 1—Abbreviated Expressions

**1.1 Meaning of Abbreviated Expressions**

- (a) In these Regulations, the word “Treaty” means the Patent Cooperation Treaty.
- (b) In these Regulations, the words “Chapter” and “Article” refer to the specified Chapter or Article of the Treaty.

Rule 2—Interpretation of Certain Words

**2.1 “Applicant”**

Whenever the word “applicant” is used, it shall be construed as meaning also the agent or other representative of the applicant, except where the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used, such as, in particular, where the provision refers to the residence or nationality of the applicant.

**2.2 “Agent”**

Whenever the word “agent” is used, it shall be construed as meaning an agent appointed under Rule 90.1, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used.

**2.2bis “Common Representative”**

Whenever the expression “common representative” is used, it shall be construed as meaning an applicant appointed as, or considered to be, the common representative under Rule 90.2.

**2.3 “Signature”**

Whenever the word “signature” is used, it shall be understood that, if the national law applied by the Receiving Office or the competent International Searching or Preliminary Examining Authority require the use of a seal instead of a signature, the word, for the purposes of that Office or Authority, shall mean seal.

## **Part B**

### **Rules Concerning Chapter I of the Treaty**

#### **Rule 3—The Request (Form)**

##### **3.1 Form of Request**

The request shall be made on a printed form or be presented as a computer print-out.

##### **3.2 Availability of Forms**

Copies of the printed form shall be furnished free of charge to the applicants by the receiving Office, or, if the receiving Office so desires, by the International Bureau.

##### **3.3 Check List**

- (a) The request shall contain a list indicating:
- (i) the total number of sheets constituting the international application and the number of the sheets of each element of the international application (request, description, claims, drawings, abstract);
  - (ii) whether or not the international application as filed is accompanied by a power of attorney (i.e., a document appointing an agent or a common representative), a copy of a general power of attorney, a priority document, a document relating to the payment of fees, and any other document (to be specified in the check list);
  - (iii) the number of that figure of the drawings which the applicant suggest should accompany the abstract when the abstract is published; in exceptional cases, the applicant may suggest more than one figure.
- (b) The list shall be completed by the applicant, failing which the receiving Office shall make the necessary indications, except that the number referred to in paragraph (a)(iii) shall not be indicated by the receiving Office.

##### **3.4 Particulars**

Subject to Rule 3.3, particulars of the printed request form and of a request presented as a computer print-out shall be prescribed by the Administrative Instructions.

#### **Rule 4—The Request (Contents)**

##### **4.1 Mandatory and Optional Contents; Signature**

- (a) The request shall contain:
- (i) a petition,
  - (ii) the title of the invention,
  - (iii) indications concerning the applicant and the agent, if there is an agent,
  - (iv) the designation of States,

- (v) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.
- (b) The request shall, where applicable, contain:
  - (i) a priority claim,
  - (ii) a reference to any earlier international, international-type or other search,
  - (iii) choices of certain kinds of protection,
  - (iv) an indication that the applicant wishes to obtain a regional patent,
  - (v) a reference to a parent application or parent patent.
- (c) The request may contain:
  - (i) indications concerning the inventor where the national law of none of the designated States requires that the name of the inventor be furnished at the time of filing a national application,
  - (ii) a request to the receiving Office to transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office.
- (d) The request shall be signed.

#### **4.2 The Petition**

The petition shall be to the following effect and shall preferably be worded as follows: “The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.”

#### **4.3 Title of the Invention**

The title of the invention shall be short (preferably from two to seven words when in English or translated into English) and precise.

#### **4.4 Names and Addresses**

- (a) Names of natural persons shall be indicated by the person’s family name and given name(s), the family name being indicated before the given name(s).
- (b) Names of legal entities shall be indicated by their full, official designations.
- (c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. In order to allow rapid communication with the applicant, it is recommended to indicate any teleprinter address, telephone and facsimile machine numbers, or corresponding data for other like means of com-

munication, of the applicant or, where applicable, the agent or the common representative.

- (d) For each applicant, inventor, or agent, only one address may be indicated, except that, if no agent has been appointed to represent the applicant, or all of them if more than one, the applicant or, if there is more than one applicant, the common representative, may indicate, in addition to any other address given in the request, an address to which notifications shall be sent.

#### **4.5 The Applicant**

- (a) The request shall indicate the name, address, nationality and residence of the applicant or, if there are several applicants, of each of them.
- (b) The applicant's nationality shall be indicated by the name of the State of which he is a national.
- (c) The applicant's residence shall be indicated by the name of the State of which he is a resident.
- (d) The request may, for different designated States, indicate different applicants. In such a case, the request shall indicate the applicant or applicants for each designated State or group of designated States.

#### **4.6 The Inventor**

- (a) Where Rule 4.1(a)(v) applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them.
- (b) If the applicant is the inventor, the request, in lieu of the indication under paragraph (a), shall contain a statement to that effect.
- (c) The request may, for different designated States, indicate different persons as inventors where, in this respect, the requirements of the national laws of the designated States are not the same. In such a case, the request shall contain a separate statement for each designated State or group of States in which a particular person, or the same person, is to be considered the inventor, or in which particular persons, or the same persons, are to be considered the inventors.

#### **4.7 The Agent**

If agents are designated, the request shall so indicate, and shall state their names and addresses.

#### **4.8 Common Representative**

If a common representative is designated, the request shall so indicate.

#### **4.9 Designation of States**

- (a) Contracting States shall be designated in the request:
  - (i) in the case of designations for the purpose of obtaining national patents, by an indication of each State concerned;

- (ii) in the case of designations for the purpose of obtaining a regional patent, by an indication that a regional patent is desired either for all Contracting States which are party to the regional patent treaty concerned or only for such Contracting States as are specified.
- (b) The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:
  - (i) at least one Contracting State is designated under paragraph (a), and
  - (ii) the request also contains a statement that any designation made under this paragraph is subject to confirmation as provided in paragraph (c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.
- (c) The confirmation of any designation made under paragraph (b) shall be effected by
  - (i) filing with the receiving Office a written notice containing an indication as referred to in paragraph (a)(i) or (ii), and
  - (ii) paying to the receiving Office the designation fee and the confirmation fee referred to in Rule 15.5within the time limit under paragraph (b)(ii).

#### **4.10 Priority Claim**

- (a) The declaration referred to in Article 8(1) shall be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:
  - (i) when the earlier application is not a regional or an international application, the country in which it was filed; when the earlier application is a regional or an international application, the country or countries for which it was filed,
  - (ii) the date on which it was filed,
  - (iii) the number under which it was filed, and
  - (iv) when the earlier application is a regional or an international application, the national Office or intergovernmental organization with which it was filed.
- (b) If the request does not indicate both
  - (i) when the earlier application is not a regional or an international application, the country in which such earlier application was filed; when the earlier application is a regional or an international application, at least one country for which such earlier application was filed, and
  - (ii) the date on which the earlier application was filed,

the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made. However, where, resulting from an obvious error, the indication of the said country or the said date is missing or is erroneous, the receiving Office may, at the request of the applicant, make the necessary correction. The error shall be considered as an obvious error whenever the correction is obvious from a comparison with the earlier application. Where the error consists of the omission of the indication of the said date, the correction can only be made before the transmittal of the record copy to the International Bureau. In the case of any other error relating to the indication of the said date or in the case of any error relating to the indication of the said country, the correction can only be made before the expiration of the time limit under Rule 17.1(a) computed on the basis of the correct priority date.

- (c) If the application number of the earlier application is not indicated in the request but is furnished by the applicant to the International Bureau or to the receiving Office prior to the expiration of the 16th month from the priority date, it shall be considered by all designated States to have been furnished in time.
- (d) If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated. If the applicant fails to act accordingly within one month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled *ex officio*.
- (e) Where the priorities of several earlier applications are claimed, the provisions of paragraphs (a) to (d) shall apply to each of them.

#### 4.11 Reference to Earlier Search

If an international or international-type search has been requested on an application under Article 15(5) or if the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application, the request shall contain a reference to that fact. Such reference shall either identify the application (or its translation, as the case may be) in respect of which the earlier search was made by indicating country, date and number, or the said search by indicating, where applicable, date and number of the request for such search.

#### 4.12 Choice of Certain Kinds of Protection

- (a) If the applicant wishes his international application to be treated, in any designated State, as an application not for a patent but for the grant of any of the other kinds of protection specified in Article 43, he shall so indicate in the request. For the purposes of this paragraph, Article 2(ii) shall not apply.

- (b) In the case provided for in Article 44, the applicant shall indicate the two kinds of protection sought, or, if one of two kinds of protection is primarily sought, he shall indicate which kind is sought primarily and which kind is sought subsidiarily.

#### **4.13 Identification of Parent Application or Parent Grant**

If the applicant wishes his international application to be treated, in any designated State, as an application for a patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, he shall identify the parent application or the parent patent, parent inventor's certificate, or parent utility certificate to which the patent or certificate of addition, inventor's certificate of addition, or utility certificate of addition, if granted, relates. For the purposes of this paragraph Article 2(ii) shall not apply.

#### **4.14 Continuation or Continuation-in-Part**

If the applicant wishes his international application to be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application, he shall so indicate in the request and shall identify the parent application involved.

#### **4.15 Signature**

- (a) Subject to paragraph (b), the request shall be signed by the applicant or, if there is more than one applicant, by all of them.
- (b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.

#### **4.16 Transliteration or Translation of Certain Words**

- (a) Where any name or address is written in characters other than those of the Latin alphabet, the same shall also be indicated in characters of the Latin alphabet either as a mere transliteration or through translation into English. The applicant shall decide which words will be merely transliterated and which words will be so translated.
- (b) The name of any country written in characters other than those of the Latin alphabet shall also be indicated in English.

#### **4.17 Additional Matter**

- (a) The request shall contain no matter other than that specified in Rules 4.1 to 4.16, provided that the Administrative Instructions may permit, but cannot

make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

- (b) If the request contains matter other than that specified in Rules 4.1 to 4.16 or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

## Rule 5—The Description

### 5.1 Manner of the Description

- (a) The description shall first state the title of the invention as appearing in the request and shall:
- (i) specify the technical field to which the invention relates;
  - (ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such art;
  - (iii) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;
  - (iv) briefly describe the figures in the drawings, if any;
  - (v) set forth at least the best mode contemplated by the applicant for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; where the national law of the designated State does not require the description of the best mode but is satisfied with the description of any mode (whether it is the best contemplated or not), failure to describe the best mode contemplated shall have no effect in that State;
  - (vi) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry and the way in which it can be made and used, or, if it can only be used, the way in which it can be used; the term “industry” is to be understood in its broadest sense as in the Paris Convention for the Protection of Industrial Property.
- (b) The manner and order specified in paragraph (a) shall be followed except when, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more economic presentation.
- (c) Subject to the provisions of paragraph (b), each of the parts referred to in paragraph (a) shall preferably be preceded by an appropriate heading as suggested in the Administrative Instructions.

## **5.2 Nucleotide and/or Amino Acid Sequence Disclosure**

Where the international application contains disclosure of a nucleotide and/or amino acid sequence, the description shall contain a listing of the sequence complying with the standard prescribed by the Administrative Instructions.

## **Rule 6—The Claims**

### **6.1 Number and Numbering of Claims**

- (a) The number of the claims shall be reasonable in consideration of the nature of the invention claimed.
- (b) If there are several claims, they shall be numbered consecutively in Arabic numerals.
- (c) The method of numbering in the case of the amendment of claims shall be governed by the Administrative Instructions.

### **6.2 References to Other Parts of the International Application**

- (a) Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings. In particular, they shall not rely on such references as: “as described in part ... of the description,” or “as illustrated in figure ... of the drawings.”
- (b) Where the international application contains drawings, the technical features mentioned in the claims shall preferably be followed by the reference signs relating to such features. When used, the reference signs shall preferably be placed between parentheses. If inclusion of reference signs does not particularly facilitate quicker understanding of a claim, it should not be made. Reference signs may be removed by a designated Office for the purposes of publication by such Office.

### **6.3 Manner of Claiming**

- (a) The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.
- (b) Whenever appropriate, claims shall contain:
  - (i) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art,
  - (ii) a characterizing portion—preceded by the words “characterized in that,” “characterized by,” “wherein the improvement comprises,” or any other words to the same effect—stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect.
- (c) Where the national law of the designated State does not require the manner of claiming provided for in paragraph (b), failure to use that manner of claiming

shall have no effect in that State provided the manner of claiming actually used satisfies the national law of that State.

#### **6.4 Dependent Claims**

- (a) Any claim which includes all the features of one or more other claims (claim in dependent form, hereinafter referred to as “dependent claim”) shall do so by a reference, if possible at the beginning, to the other claim or claims and shall then state the additional features claimed. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such claims in the alternative only. Multiple dependent claims shall not serve as a basis for any other multiple dependent claim. Where the national law of the national Office acting as International Searching Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the preceding two sentences, failure to use that manner of claiming may result in an indication under Article 17(2)(b) in the international search report. Failure to use the said manner of claiming shall have no effect in a designated State if the manner of claiming actually used satisfies the national law of that State.
- (b) Any dependent claim shall be construed as including all the limitations contained in the claim to which it refers or, if the dependent claim is a multiple dependent claim, all the limitations contained in the particular claim in relation to which it is considered.
- (c) All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most practical way possible.

#### **6.5 Utility Models**

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 6.1 to 6.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.

### **Rule 7—The Drawings**

#### **7.1 Flow Sheets and Diagrams**

Flow sheets and diagrams are considered drawings.

#### **7.2 Time Limit**

The time limit referred to in Article 7(2)(ii) shall be reasonable under the circumstances of the case and shall, in no case, be shorter than two months from the date of the

written invitation requiring the filing of drawings or additional drawings under the said provision.

## Rule 8—The Abstract

### 8.1 Contents and Form of the Abstract

- (a) The abstract shall consist of the following:
  - (i) a summary of the disclosure as contained in the description, the claims, and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention;
  - (ii) where applicable, the chemical formula which, among all the formulae contained in the international application, best characterizes the invention.
- (b) The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English).
- (c) The abstract shall not contain statements on the alleged merits or value of the claimed invention or on its speculative application.
- (d) Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application shall be followed by a reference sign, placed between parentheses.

### 8.2 Figure

- (a) If the applicant fails to make the indication referred to in Rule 3.3(a)(iii), or if the International Searching Authority finds that a figure or figures other than that figure or those figures suggested by the applicant would, among all the figures of all the drawings, better characterize the invention, it shall, subject to paragraph (b), indicate the figure or figures which should accompany the abstract when the latter is published by the International Bureau. In such case, the abstract shall be accompanied by the figure or figures so indicated by the International Searching Authority. Otherwise, the abstract shall, subject to paragraph (b), be accompanied by the figure or figures suggested by the applicant.
- (b) If the International Searching Authority finds that none of the figures of the drawings is useful for the understanding of the abstract, it shall notify the International Bureau accordingly. In such case, the abstract, when published by the International Bureau, shall not be accompanied by any figure of the drawings even where the applicant has made a suggestion under Rule 3.3(a)(iii).

### 8.3 Guiding Principles in Drafting

The abstract shall be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art, especially by assisting the scientist, engineer

or researcher in formulating an opinion on whether there is a need for consulting the international application itself.

## Rule 9—Expressions, Etc., Not to Be Used

### 9.1 Definition

The international application shall not contain:

- (i) expressions or drawings contrary to morality;
- (ii) expressions or drawings contrary to public order;
- (iii) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person (mere comparisons with the prior art shall not be considered disparaging *per se*);
- (iv) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

### 9.2 Noting of Lack of Compliance

The receiving Office and the International Searching Authority may note lack of compliance with the prescriptions of Rule 9.1 and may suggest to the applicant that he voluntarily correct his international application accordingly. If the lack of compliance was noted by the receiving Office, that Office shall inform the competent International Searching Authority and the International Bureau; if the lack of compliance was noted by the International Searching Authority, that Authority shall inform the receiving Office and the International Bureau.

### 9.3 Reference to Article 21(6)

“Disparaging statements,” referred to in Article 21(6), shall have the meaning as defined in Rule 9.1(iii).

## Rule 10—Terminology and Signs

### 10.1 Terminology and Signs

- (a) Units of weights and measures shall be expressed in terms of the metric system, or also expressed in such terms if first expressed in terms of a different system.
- (b) Temperatures shall be expressed in degrees Celsius, or also expressed in degrees Celsius, if first expressed in a different manner.
- (c) *[Deleted]*
- (d) For indications of heat, energy, light, sound, and magnetism, as well as for mathematical formulae and electrical units, the rules of international practice shall be observed; for chemical formulae, the symbols, atomic weights, and molecular formulae, in general use, shall be employed.

- (e) In general, only such technical terms, signs and symbols should be used as are generally accepted in the art.
- (f) When the international application or its translation is in English or Japanese, the beginning of any decimal fraction shall be marked by a period, whereas, when the international application or its translation is in a language other than English or Japanese, it shall be marked by a comma.

## **10.2 Consistency**

The terminology and the signs shall be consistent throughout the international application.

### **Rule 11—Physical Requirements of the International Application**

#### **11.1 Number of Copies**

- (a) Subject to the provisions of paragraph (b), the international application and each of the documents referred to in the check list (Rule 3.3(a)(ii)) shall be filed in one copy.
- (b) Any receiving Office may require that the international application and any of the documents referred to in the check list (Rule 3.3(a)(ii)), except the receipt for the fees paid or the check for the payment of the fees, be filed in two or three copies. In that case, the receiving Office shall be responsible for verifying the identity of the second and the third copies with the record copy.

#### **11.2 Fitness for Reproduction**

- (a) All elements of the international application (i.e., the request, the description, the claims, the drawings, and the abstract) shall be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset, and microfilming, in any number of copies.
- (b) All sheets shall be free from creases and cracks; they shall not be folded.
- (c) Only one side of each sheet shall be used.
- (d) Subject to Rule 11.10(d) and Rule 11.13(j), each sheet shall be used in an upright position (i.e., the short sides at the top and bottom).

#### **11.3 Material to Be Used**

All elements of the international applications shall be on paper which shall be flexible, strong, white, smooth, non-shiny, and durable.

#### **11.4 Separate Sheets, Etc.**

- (a) Each element (request, description, claims, drawings, abstract) of the international application shall commence on a new sheet.
- (b) All sheets of the international application shall be so connected that they can be easily turned when consulted, and easily separated and joined again if they have been separated for reproduction purposes.

### 11.5 Size of Sheets

The size of the sheets shall be A4(29.7 cm × 21 cm). However, any receiving Office may accept international applications on sheets of other sizes provided that the record copy, as transmitted to the International Bureau, and, if the competent International Searching Authority so desires, the search copy, shall be of A4 size.

### 11.6 Margins

- (a) The minimum margins of the sheets containing the description, the claims, and the abstract, shall be as follows:
- top: 2 cm
  - left side: 2.5 cm
  - right side: 2 cm
  - bottom: 2 cm
- (b) The recommended maximum, for the margins provided for in paragraph (a), is as follows:
- top: 4 cm
  - left side: 4 cm
  - right side: 3 cm
  - bottom: 3 cm
- (c) On sheets containing drawings, the surface usable shall not exceed 26.2 cm × 17.0 cm. The sheets shall not contain frames around the usable or used surface. The minimum margins shall be as follows:
- top: 2.5 cm
  - left side: 2.5 cm
  - right side: 1.5 cm
  - bottom: 1.0 cm
- (d) The margins referred to in paragraphs (a) to (c) apply to A4-size sheets, so that, even if the receiving Office accepts other sizes, the A4-size record copy and, when so required, the A4-size search copy shall leave the aforesaid margins.
- (e) Subject to paragraph (f) and to Rule 11.8(b), the margins of the international application, when submitted, must be completely blank.
- (f) The top margin may contain in the left-hand corner an indication of the applicant's file reference, provided that the reference appears within 1.5 cm from the top of the sheet. The number of characters in the applicant's file reference shall not exceed the maximum fixed by the Administrative Instructions.

### 11.7 Numbering of Sheets

- (a) All the sheets contained in the international application shall be numbered in consecutive Arabic numerals.

- (b) The numbers shall be centred at the top or bottom of the sheet, but shall not be placed in the margin.

#### **11.8 Numbering of Lines**

- (a) It is strongly recommended to number every fifth line of each sheet of the description, and of each sheet of claims.
- (b) The numbers should appear in the right half of the left margin.

#### **11.9 Writing of Text Matter**

- (a) The request, the description, the claims and the abstract shall be typed or printed.
- (b) Only graphic symbols and characters, chemical or mathematical formulae, and certain characters in the Japanese language may, when necessary, be written by hand or drawn.
- (c) The typing shall be 1½-spaced.
- (d) All text matter shall be in characters the capital letters of which are not less than 0.21 cm high, and shall be in a dark, indelible color, satisfying the requirements specified in Rule 11.2.
- (e) As far as the spacing of the typing and the size of the characters are concerned, paragraphs (c) and (d) shall not apply to texts in the Japanese language.

#### **11.10 Drawings, Formulae, and Tables, in Text Matter**

- (a) The request, the description, the claims and the abstract shall not contain drawings.
- (b) The description, the claims and the abstract may contain chemical or mathematical formulae.
- (c) The description and the abstract may contain tables; any claim may contain tables only if the subject matter of the claim makes the use of tables desirable.
- (d) Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position thereon; sheets on which tables or chemical or mathematical formulae are presented sideways shall be so presented that the tops of the tables or formulae are at the left side of the sheet.

#### **11.11 Words in Drawings**

- (a) The drawings shall 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 catchwords indispensable for understanding.
- (b) Any words used shall be so placed that, if translated, they may be pasted over without interfering with any lines of the drawings.

**11.12 Alterations, Etc.**

Each sheet shall be reasonably free from erasures and shall be free from alterations, overwritings, and interlineations. Non-compliance with this Rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

**11.13 Special Requirements for Drawings**

- (a) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colorings.
- (b) Cross-sections shall be indicated by oblique hatching which should not impede the clear reading of the reference signs and leading lines.
- (c) The scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty.
- (d) When, in exceptional cases, the scale is given on a drawing, it shall be represented graphically.
- (e) All numbers, letters and reference lines, appearing on the drawings, shall be simple and clear. Brackets, circles or inverted commas shall not be used in association with numbers and letters.
- (f) All lines in the drawings shall, ordinarily, be drawn with the aid of drafting instruments.
- (g) Each element of each figure shall be in proper 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.
- (h) The height of the numbers and letters shall not be less than 0.32 cm. For the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used.
- (i) The same sheet of drawings may contain several figures. Where figures on two or more sheets form in effect a single complete figure, the figures on the several sheets shall be so arranged that the complete figure can be assembled without concealing any part of any of the figures appearing on the various sheets.
- (j) The different figures shall be arranged on a sheet or sheets without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet.
- (k) The different figures shall be numbered in arabic numerals consecutively and independently of the numbering of the sheets.
- (l) Reference signs not mentioned in the description shall not appear in the drawings, and vice versa.
- (m) The same features, when denoted by reference signs, shall, throughout the international application, be denoted by the same signs.

- (n) If the drawings contain a large number of reference signs, it is strongly recommended to attach a separate sheet listing all reference signs and the features denoted by them.

#### **11.14 Later Documents**

Rules 10, and 11.1 to 11.13, also apply to any document — for example, corrected pages, amended claims — submitted after the filing of the international application.

### **Rule 12—Language of the International Application**

#### **12.1 Admitted Languages**

- (a) Any international application shall be filed in the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Searching Authority competent for the international searching of that application, provided that, if the agreement specifies several languages, the receiving Office may prescribe among the specified languages that language in which or those languages in one of which the international application must be filed.
- (b) Notwithstanding paragraph (a), the request, any text matter of the drawings, and the abstract need not be in the same language as other elements of the international application, provided that:
  - (i) the request is in a language admitted under paragraph (a) or in the language in which the international application is to be published;
  - (ii) the text matter of the drawings is in the language in which the international application is to be published;
  - (iii) the abstract is in the language in which the international application is to be published.
- (c) Subject to paragraph (d), where the official language of the receiving Office is one of the languages referred to in Rule 48.3(a) but is a language not specified in the agreement referred to in paragraph (a), the international application may be filed in the said official language. If the international application is filed in the said official language, the search copy transmitted to the International Searching Authority under Rule 23.1 shall be accompanied by a translation into the language, or one of the languages, specified in the agreement referred to in paragraph (a); such translation shall be prepared under the responsibility of the receiving Office.
- (d) Paragraph (c) shall apply only where the International Searching Authority has declared, in a notification addressed to the International Bureau, that it accepts to search international applications on the basis of the translation referred to in paragraph (c).

## **12.2 Language of Changes in the International Application**

Any changes in the international application, such as amendments and corrections, shall, subject to Rules 46.3 and 66.9, be in the same language as the said application.

## **Rule 13—Unity of Invention**

### **13.1 Requirement**

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”).

### **13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled**

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

### **13.3 Determination of Unity of Invention Not Affected by Manner of Claiming**

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

### **13.4 Dependent Claims**

Subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

### **13.5 Utility Models**

Any designated State in which the grant of a utility model is sought on the basis of an international application may, instead of Rules 13.1 to 13.4, apply in respect of the matters regulated in those Rules the provisions of its national law concerning utility models once the processing of the international application has started in that State, provided that the applicant shall be allowed at least two months from the expiration of the time limit applicable under Article 22 to adapt his application to the requirements of the said provisions of the national law.

## Rule 13bis—Microbiological Inventions

### **13bis.1 Definition**

For the purposes of this Rule, “reference to a deposited microorganism” means particulars given in an international application with respect to the deposit of a microorganism with a depositary institution or to the microorganism so deposited.

### **13bis.2 References (General)**

Any reference to a deposited microorganism shall be made in accordance with this Rule and, if so made, shall be considered as satisfying the requirements of the national law of each designated State.

### **13bis.3 References: Contents; Failure to Include Reference or Indication**

- (a) A reference to a deposited microorganism shall indicate,
- (i) the name and address of the depositary institution with which the deposit was made;
  - (ii) the date of deposit of the microorganism with that institution;
  - (iii) the accession number given to the deposit by that institution; and
  - (iv) any additional matter of which the International Bureau has been notified pursuant to Rule 13bis.7(a)(i), provided that the requirement to indicate that matter was published in the Gazette in accordance with Rule 13bis.7(c) at least two months before the filing of the international application.
- (b) Failure to include a reference to a deposited microorganism or failure to include, in a reference to a deposited microorganism, an indication in accordance with paragraph (a), shall have no consequence in any designated State whose national law does not require such reference or such indication in a national application.

### **13bis.4 References: Time of Furnishing Indications**

If any of the indications referred to in Rule 13bis.3(a) is not included in a reference to a deposited microorganism in the international application as filed but is furnished by the applicant to the International Bureau within 16 months after the priority date, the indication shall be considered by any designated Office to have been furnished in time unless its national law requires the indication to be furnished at an earlier time in the case of a national application and the International Bureau has been notified of such requirement pursuant to Rule 13bis.7(a)(ii), provided that the International Bureau has published such requirement in the Gazette in accordance with Rule 13bis.7(c) at least two months before the filing of the international application. In the event that the applicant makes a request for early publication under Article 21(2)(b), however, any designated Office may consider any indication not furnished by the time such request is made as not having been furnished in time. Irrespective of whether the applicable time limit under the preceding sentences has been observed, the Inter-

national Bureau shall notify the applicant and the designated Offices of the date on which it has received any indication not included in the international application as filed. The International Bureau shall indicate that date in the international publication of the international application if the indication has been furnished to it before the completion of technical preparations for international publication.

**13bis.5 References and Indications for the Purposes of One or More Designated States: Different Deposits for Different Designated States; Deposits with Depository Institutions Other Than Those Notified**

- (a) A reference to a deposited microorganism shall be considered to be made for the purposes of all designated States, unless it is expressly made for the purposes of certain of the designated States only; the same applies to the indications included in the reference.
- (b) References to different deposits of the microorganism may be made for different designated States.
- (c) Any designated Office shall be entitled to disregard a deposit made with a depository institution other than one notified by it under Rule 13bis.7(b).

**13bis.6 Furnishing of Samples**

- (a) Where the international application contains a reference to a deposited microorganism, the applicant shall, upon the request of the International Searching Authority or the International Preliminary Examining Authority, authorize and assure the furnishing of a sample of that microorganism by the depository institution to the said Authority, provided that the said Authority has notified the International Bureau that it may require the furnishing of samples and that such samples will be used solely for the purposes of international search or international preliminary examination, as the case may be, and such notification has been published in the Gazette.
- (b) Pursuant to Articles 23 and 40, no furnishing of samples of the deposited microorganism to which a reference is made in an international application shall, except with the authorization of the applicant, take place before the expiration of the applicable time limits after which national processing may start under the said Articles. However, where the applicant performs the acts referred to in Articles 22 or 39 after international publication but before the expiration of the said time limits, the furnishing of samples of the deposited microorganism may take place, once the said acts have been performed. Notwithstanding the previous provision, the furnishing of samples of the deposited microorganism may take place under the national law applicable for any designated Office as soon as, under that law, the international publication has the effects of the compulsory national publication of an unexamined national application.

**13bis.7 National Requirements: Notification and Publication**

- (a) Any national Office may notify the International Bureau of any requirement of the national law,

- (i) that any matter specified in the notification, in addition to those referred to in Rule 13*bis*.3(a)(i), (ii) and (iii), is required to be included in a reference to a deposited microorganism in a national application;
- (ii) that one or more of the indications referred to in Rule 13*bis*.3(a) are required to be included in a national application as filed or are required to be furnished at a time specified in the notification which is earlier than 16 months after the priority date.
- (b) Each national Office shall notify the International Bureau of the depositary institutions with which the national law permits deposits of microorganisms to be made for the purposes of patent procedure before that Office or, if the national law does not provide for or permit such deposits, of that fact.
- (c) The International Bureau shall promptly publish in the Gazette requirements notified to it under paragraph (a) and information notified to it under paragraph (b).

### Rule 13ter—Nucleotide and/or Amino Acid Sequence Listings

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

- (a) If the International Searching Authority finds that a nucleotide and/or amino acid sequence listing does not comply with the standard prescribed in the Administrative Instructions under Rule 5.2, and/or is not in a machine readable form provided for in those Instructions, it may invite the applicant, within a time limit fixed in the invitation, as the case may be:
  - (i) to furnish to it a listing of the sequence complying with the prescribed standard, and/or
  - (ii) to furnish to it a listing of the sequence in a machine readable form provided for in the Administrative Instructions or, if that Authority is prepared to transcribe the sequence listing into such a form, to pay for the cost of such transcription.
- (b) Any sequence listing furnished under paragraph (a) shall be accompanied by a statement to the effect that the listing does not include matter which goes beyond the disclosure in the international application as filed.
- (c) If the applicant does not comply with the invitation within the time limit fixed in the invitation, the International Searching Authority shall not be required to search the international application to the extent that such non-compliance has the result that a meaningful search cannot be carried out.
- (d) If the International Searching Authority chooses, under paragraph (a)(ii), to transcribe the sequence listing into a machine readable form, it shall send a copy of such transcription in machine readable form to the applicant.
- (e) The International Searching Authority shall, upon request, make available to the International Preliminary Examining Authority a copy of any sequence listing furnished to it, or as transcribed by it, under paragraph (a).

- (f) A sequence listing furnished to the International Searching Authority, or as transcribed by it, under paragraph (a) shall not form part of the international application.

### **13ter.2 Sequence Listing for Designated Office**

- (a) Once the processing of the international application has started before a designated Office, that Office may require the applicant to furnish to it a copy of any sequence listing furnished to the International Searching Authority, or as transcribed by that Authority, under Rule 13ter.1(a).
- (b) If a designated Office finds that a nucleotide and/or amino acid sequence listing does not comply with the standard prescribed in the Administrative Instructions under Rule 5.2, and/or is not in a machine readable form provided for in those Instructions, and/or no listing of the sequence was furnished to the International Searching Authority, or transcribed by that Authority, under Rule 13ter.1(a), that Office may require the applicant;
- (i) to furnish to it a listing of the sequence complying with the prescribed standard, and/or
- (ii) to furnish to it a listing of the sequence in a machine readable form provided for in the Administrative Instructions or, if that Office is prepared to transcribe the sequence listing into such a form, to pay for the cost of such transcription.

## **Rule 14—The Transmittal Fee**

### **14.1 The Transmittal Fee**

- (a) Any receiving Office may require that the applicant pay a fee to it, for its own benefit, for receiving the international application, transmitting copies to the International Bureau and the component International Searching Authority, and performing all the other tasks which it must perform in connection with the international application in its capacity of receiving Office (“transmittal fee”).
- (b) The amount and the due date of the transmittal fee, if any, shall be fixed by the receiving Office.

## **Rule 15—The International Fee**

### **15.1 Basic Fee and Designation Fee**

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

- (i) a “basic fee,” and
- (ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a) by the applicant in the international application, ex-

cept that, where Article 44 applies in respect of a designation, only one designation fee shall be due for that designation.

### **15.2 Amounts**

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

### **15.3 Mode of Payment**

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

### **15.4 Time of Payment**

- (a) The basic fee shall be paid within one month from the date of receipt of the international application.
- (b) The designation fee shall be paid:
  - (i) where the international application does not contain a priority claim under Article 8, within one year from the date of receipt of the international application,
  - (ii) where the international application contains a priority claim under Article 8, within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date.

- (c) Where the basic fee or the designation fee is paid later than the date on which the international application was received and where the amount of that fee is, in the currency in which it is payable, higher on the date of payment (“the higher amount”) than it was on the date on which the international application was received (“the lower amount”),
- (i) the lower amount shall be due if the fee is paid within one month from the date of receipt of the international application,
  - (ii) the higher amount shall be due if the fee is paid later than one month from the date of receipt of the international application.

### **15.5 Fees Under Rule 4.9(c)**

- (a) Notwithstanding Rule 15.4(b), the confirmation under Rule 4.9(c) of any designations made under Rule 4.9(b) shall be subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office), as set out in the Schedule of Fees.
- (b) Where moneys paid by the applicant within the time limit under Rule 4.9(b)(ii) are not sufficient to cover the fees due under paragraph (a), the receiving Office shall allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.

### **15.6 Refund**

The receiving Office shall refund the international fee to the applicant:

- (i) if the determination under Article 11(1) is negative, or
- (ii) if, before the transmittal of the record copy to the International Bureau, the international application is withdrawn or considered withdrawn.

## **Rule 16—The Search Fee**

### **16.1 Right to Ask for a Fee**

- (a) Each International Searching Authority may require that the applicant pay a fee (“search fee”) for its own benefit for carrying out the international search and for performing all other tasks entrusted to International Searching Authorities by the Treaty and these Regulations.
- (b) The search fee shall be collected by the receiving Office. The said fee shall be payable in the currency or currencies prescribed by that Office (“the receiving Office currency”), it being understood that, if any receiving Office currency is not that, or one of those, in which the International Searching Authority has fixed the said fee (“the fixed currency or currencies”), it shall, when transferred by the receiving Office to the International Searching Authority, be freely convertible into the currency of the State in which the International Searching Authority has its headquarters (“the headquarters currency”). The amount of the

search fee in any receiving Office currency, other than the fixed currency or currencies, shall be established by the Director General after consultation with that Office. The amounts so established shall be the equivalents, in round figures, of the amount established by the International Searching Authority in the headquarters currency. They shall be published in the Gazette.

- (c) Where the amount of the search fee in the headquarters currency is changed, the corresponding amounts in the receiving Office currencies, other than the fixed currency or currencies, shall be applied from the same date as the changed amount in the headquarters currency.
- (d) Where the exchange rate between the headquarters currency and any receiving Office currency, other than the fixed currency or currencies, becomes different from the exchange rate last applied, the Director General shall establish the new amount in the said receiving Office currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that any interested receiving Office and the Director General may agree on a date falling during the said two-month period in which case the said amount shall become applicable for that Office from that date.
- (e) Where, in respect of the payment of the search fee in a receiving Office currency, other than the fixed currency or currencies, the amount actually received by the International Searching Authority in the headquarters currency is less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.
- (f) As to the time of payment of the search fee, the provisions of Rule 15.4 relating to the basic fee shall apply.

### **16.2 Refund**

The receiving Office shall refund the search fee to the applicant:

- (i) if the determination under Article 11(1) is negative, or
- (ii) if, before the transmittal of the search copy to the International Searching Authority, the international application is withdrawn or considered withdrawn.

### **16.3 Partial Refund**

Where the international application claims the priority of an earlier international application which has been the subject of an international search by the same International Searching Authority, that Authority shall refund the search fee paid in connection with the later international application to the extent and under the conditions provided for in the agreement under Article 16(3)(b), if the international search report on the later international application could wholly or partly be based on the results of the international search effected on the earlier international application.

## Rule 16bis—Extension of Time Limits for Payment of Fees

### **16bis.1 Invitation by the Receiving Office**

- (a) Where, by the time they are due under Rule 14.1(b), Rule 15.4(a) and Rule 16.1(f), the receiving Office finds that in respect of an international application no fees were paid to it by the applicant, or that the amount paid to it by the applicant is less than what is necessary to cover the transmittal fee, the basic fee and search fee, the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within one month from the date of the invitation.
- (b) Where, by the time they are due under Rule 15.4(b), the receiving Office finds that in respect of an international application the payment made by the applicant is insufficient to cover the designation fees necessary to cover all the designations under Rule 4.9(a), the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within one month from the date of the invitation.
- (c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) or (b) and the applicant has not, within one month from the date of the invitation, paid in full the amount due, including, where applicable, the late payment fee under Rule 16bis.2, the receiving Office shall:
  - (i) allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.
  - (ii) make the applicable declaration under Article 14(3), and
  - (iii) proceed as provided in Rule 29.

### **16bis.2 Late Payment Fee**

- (a) The payment of fees in response to an invitation under Rule 16bis.1(a) or (b) may be subjected by the receiving Office to the payment to it of a late payment fee. The amount of that fee shall be:
  - (i) 50% of the amount of unpaid fees which is specified in the invitation, or,
  - (ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.
- (b) The amount of the late payment fee shall not, however, exceed the amount of the basic fee.

## Rule 17—The Priority Document

### **17.1 Obligation to Submit Copy of Earlier National Application**

- (a) Where the priority of an earlier national application is claimed under Article 8 in the international application, a copy of the said national application, certified

by the authority with which it was filed (“the priority document”), shall, unless already filed with the receiving Office together with the international application, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date or, in the case referred to in Article 23(2), not later than at the time the processing or examination is requested.

- (b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to transmit the priority document to the International Bureau. Such request shall be made not later than the expiration of the applicable time limit referred to under paragraph (a) and may be subjected by the receiving Office to the payment of a fee.
- (c) If the requirements of neither of the two preceding paragraphs are complied with, any designated State may disregard the priority claim.

#### **17.2 Availability of Copies**

- (a) The International Bureau shall, at the specific request of the designated Office, promptly but not before the expiration of the time limit fixed in Rule 17.1(a), furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy, except where it requires the furnishing of a copy of the priority document together with a certified translation thereof. The applicant shall not be required to furnish a certified translation to the designated Office before the expiration of the applicable time limit under Article 22.
- (b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application.
- (c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:
  - (i) the international application was withdrawn,
  - (ii) the relevant priority claim was withdrawn or was considered, under Rule 4.10(b), not to have been made, or
  - (iii) the relevant declaration under Article 8(1) was cancelled under Rule 4.10(d).
- (d) Paragraphs (a) to (c) shall apply also to any earlier international application whose priority is claimed in the subsequent international application.

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## Rule 18—The Applicant

### 18.1 Residence

- (a) Subject to the provisions of paragraph (b), the question whether an applicant is a resident of the Contracting State of which he claims to be a resident shall depend on the national law of that State and shall be decided by the receiving Office.
- (b) In any case, possession of a real and effective industrial or commercial establishment in a Contracting State shall be considered residence in that State.

### 18.2 Nationality

- (a) Subject to the provisions of paragraph (b), the question whether an applicant is a national of the Contracting State of which he claims to be a national shall depend on the national law of that State and shall be decided by the receiving Office.
- (b) In any case, a legal entity constituted according to the national law of a Contracting State shall be considered a national of that State.

### 18.3 Two or More Applicants

If there are two or more applicants, the right to file an international application shall exist if at least one of them is entitled to file an international application according to Article 9.

### 18.4 Information on Requirements Under National Law as to Applicants

- (a) *[Deleted]*
- (b) *[Deleted]*
- (c) The International Bureau shall, from time to time, publish information on the various national laws in respect of the question who is qualified (inventor, successor in title of the inventor, owner of the invention, or other) to file a national application and shall accompany such information by a warning that the effect of the international application in any designated State may depend on whether the person designated in the international application as applicant for the purposes of that State is a person who, under the national law of that State, is qualified to file a national application.

## Rule 19—The Competent Receiving Office

### 19.1 Where to File

- (a) Subject to the provisions of paragraph (b), the international application shall be filed, at the option of the applicant, with the national Office of or acting for the Contracting State of which the applicant is a resident or with the national Office of or acting for the Contracting State of which the applicant is a national.

- (b) Any Contracting State may agree with another Contracting State or any inter-governmental organization that the national Office of the latter State or the intergovernmental organization shall, for all or some purposes, act instead of the national Office of the former State as receiving Office for applicants who are residents or nationals of that former State. Notwithstanding such agreement, the national Office of the former State shall be considered the competent receiving Office for the purposes of Article 15(5).
- (c) In connection with any decision made under Article 9(2), the Assembly shall appoint the national Office or the intergovernmental organization which will act as receiving Office for applications of residents or nationals of States specified by the Assembly. Such appointment shall require the previous consent of the said national Office or intergovernmental organization.

### **19.2 Two or More Applicants**

If there are two or more applicants, the requirements of Rule 19.1 shall be considered to be met if the national Office with which the international application is filed is the national Office of or acting for a Contracting State of which at least one of the applicants is a resident or national.

### **19.3 Publication of Fact of Delegation of Duties of Receiving Office**

- (a) Any agreement referred to in Rule 19.1(b) shall be promptly notified to the International Bureau by the Contracting State which delegates the duties of the receiving Office to the national Office of or acting for another Contracting State or an intergovernmental organization.
- (b) The International Bureau shall, promptly upon receipt, publish the notification in the Gazette.

## **Rule 20—Receipt of the International Application**

### **20.1 Date and Number**

- (a) Upon receipt of papers purporting to be an international application, the receiving Office shall indelibly mark the date of actual receipt on the request of each copy received and the international application number on each sheet of each copy received.
- (b) The place on each sheet where the date or number shall be marked, and other details, shall be specified in the Administrative Instructions.

### **20.2 Receipt on Different Days**

- (a) In cases where all the sheets pertaining to the same purported international application are not received on the same day by the receiving Office, that Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the papers completing the international application were received, provided that

- (i) where no invitation under Article 11(2)(a) to correct was sent to the applicant, the said papers are received within 30 days from the date on which sheets were first received;
  - (ii) where an invitation under Article 11(2)(a) to correct was sent to the applicant, the said papers are received within the applicable time limit under Rule 20.6;
  - (iii) in the case of Article 14(2), the missing drawings are received within 30 days from the date on which the incomplete papers were filed;
  - (iv) the absence or later receipt of any sheet containing the abstract or part thereof shall not, in itself, require any correction of the date marked on the request.
- (b) Any sheet received on a date later than the date on which sheets were first received shall be marked by the receiving Office with the date on which it was received.

### **20.3 Corrected International Application**

In the case referred to in Article 11(2)(b), the receiving Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the last required correction was received.

### **20.4 Determination under Article 11(1)**

- (a) Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers comply with the requirements of Article 11(1).
- (b) For the purposes of Article 11(1)(iii)(c), it shall be sufficient to indicate the name of the applicant in a way which allows his identity to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.
- (c) For the purposes of Article 11(1)(ii), it shall be sufficient that the elements referred to in Article 11(1)(iii)(d) and (e) be in a language admitted under Rule 12.1(a) or (c).
- (d) If, on July 12, 1991, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

### **20.5 Positive Determination**

- (a) If the determination under Article 11(1) is positive, the receiving Office shall stamp on the request the name of the receiving Office and the words "PCT

International Application,” or “Demande internationale PCT.” If the official language of the receiving Office is neither English nor French, the words “International Application” or “Demande internationale” may be accompanied by a translation of these words in the official language of the receiving Office.

- (b) The copy whose request has been so stamped shall be the record copy of the international application.
- (c) The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

#### **20.6 Invitation to Correct**

- (a) The invitation to correct under Article 11(2) shall specify the requirement provided for under Article 11(1) which, in the opinion of the receiving Office, has not been fulfilled.
- (b) The receiving Office shall promptly mail the invitation to the applicant and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction. The time limit shall not be less than 10 days, and shall not exceed one month, from the date of the invitation. If such time limit expires after the expiration of one year from the filing date of any application whose priority is claimed, the receiving Office may call this circumstance to the attention of the applicant.

#### **20.7 Negative Determination**

If the receiving Office does not, within the prescribed time limit, receive a reply to its invitation to correct, or if the correction offered by the applicant still does not fulfill the requirements provided for under Article 11(1), it shall:

- (i) promptly notify the applicant that his application is not and will not be treated as an international application and shall indicate the reasons therefor,
- (ii) notify the International Bureau that the number it has marked on the papers will not be used as an international application number,
- (iii) keep the papers constituting the purported international application and any correspondence relating thereto as provided in Rule 93.1, and
- (iv) send a copy of the said papers to the International Bureau where, pursuant to a request by the applicant under Article 25(1), the International Bureau needs such a copy and specially asks for it.

#### **20.8 Error by the Receiving Office**

If the receiving Office later discovers, or on the basis of the applicant’s reply realizes, that it has erred in issuing an invitation to correct since the requirements provided for

under Article 11(1) were fulfilled when the papers were received, it shall proceed as provided in Rule 20.5.

### **20.9 Certified Copy for the Applicant**

Against payment of a fee, the receiving Office shall furnish to the applicant, on request, certified copies of the international application as filed and of any corrections thereto.

## **Rule 21—Preparation of Copies**

### **21.1 Responsibility of the Receiving Office**

- (a) Where the international application is required to be filed in one copy, the receiving Office shall be responsible for preparing the home copy and the search copy required under Article 12(1).
- (b) Where the international application is required to be filed in two copies, the receiving Office shall be responsible for preparing the home copy.
- (c) If the international application is filed in less than the number of copies required under Rule 11.1(b), the receiving Office shall be responsible for the prompt preparation of the number of copies required, and shall have the right to fix a fee for performing that task and to collect such fee from the applicant.

## **Rule 22—Transmittal of the Record Copy**

### **22.1 Procedure**

- (a) If the determination under Article 11(1) is positive, and unless prescriptions concerning national security prevent the international application from being treated as such, the receiving Office shall transmit the record copy to the International Bureau. Such transmittal shall be effected promptly after receipt of the international application or, if a check to preserve national security must be performed, as soon as the necessary clearance has been obtained. In any case, the receiving Office shall transmit the record copy in time for it to reach the International Bureau by the expiration of the 13th month from the priority date. If the transmittal is effected by mail, the receiving Office shall mail the record copy not later than five days prior to the expiration of the 13th month from the priority date.
- (b) If the International Bureau has received a copy of the notification under Rule 20.5(c) but is not, by the expiration of 13 months from the priority date, in possession of the record copy, it shall remind the receiving Office that it should transmit the record copy to the International Bureau promptly.
- (c) If the International Bureau has received a copy of the notification under Rule 20.5(c) but is not, by the expiration of 14 months from the priority date, in possession of the record copy, it shall notify the applicant and the receiving Office accordingly.

- (d) After the expiration of 14 months from the priority date, the applicant may request the receiving Office to certify a copy of his international application as being identical with the international application as filed and may transmit such certified copy to the International Bureau.
- (e) Any certification under paragraph (d) shall be free of charge and may be refused only on any of the following grounds:
  - (i) the copy which the receiving Office has been requested to certify is not identical with the international application as filed;
  - (ii) prescriptions concerning national security prevent the international application from being treated as such;
  - (iii) the receiving Office has already transmitted the record copy to the International Bureau and that Bureau has informed the receiving Office that it has received the record copy.
- (f) Unless the International Bureau has received the record copy, or until it receives the record copy, the copy certified under paragraph (e) and received by the International Bureau shall be considered to be the record copy.
- (g) If, by the expiration of the time limit applicable under Article 22, the applicant has performed the acts referred to in that Article but the designated Office has not been informed by the International Bureau of the receipt of the record copy, the designated Office shall inform the International Bureau. If the International Bureau is not in possession of the record copy, it shall promptly notify the applicant and the receiving Office unless it has already notified them under paragraph (c).

## **22.2** *[Deleted]*

## **22.3 Time Limit under Article 12(3)**

The time limit referred to in Article 12(3) shall be three months from the date of the notification sent by the International Bureau to the applicant under Rule 22.1(c) or (g).

## **Rule 23—Transmittal of the Search Copy**

### **23.1 Procedure**

- (a) The search copy shall be transmitted by the receiving Office to the International Searching Authority at the latest on the same day as the record copy is transmitted to the International Bureau unless no search fee has been paid. In the latter case, it shall be transmitted promptly after payment of the search fee.
- (b) *[Deleted]*

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**Rule 24—Receipt of the Record Copy by the International Bureau****24.1 [Deleted]****24.2 Notification of Receipt of the Record Copy**

- (a) The International Bureau shall promptly notify:
- (i) the applicant,
  - (ii) the receiving Office, and
  - (iii) the International Searching Authority (unless it has informed the International Bureau that it wishes not to be so notified),
- of the fact and the date of receipt of the record copy. The notification shall identify the international application by its number, the international filing date and the name of the applicant, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the States designated under Rule 4.9(a) and, where applicable, of those States whose designations have been confirmed under Rule 4.9(c).
- (b) Each designated Office which has informed the International Bureau that it wishes to receive the notification under paragraph (a) prior to the communication under Rule 47.1 shall be so notified by the International Bureau:
- (i) if the designation concerned was made under Rule 4.9(a), promptly after the receipt of the record copy;
  - (ii) if the designation concerned was made under Rule 4.9(b), promptly after the International Bureau has been informed by the receiving Office of the confirmation of that designation.
- (c) If the record copy is received after the expiration of the time limit fixed in Rule 22.3, the International Bureau shall promptly notify the applicant, the receiving Office, and the International Searching Authority, accordingly.

**Rule 25—Receipt of the Search Copy by the International Searching Authority****25.1 Notification of Receipt of the Search Copy**

The International Searching Authority shall promptly notify the International Bureau, the applicant, and — unless the International Searching Authority is the same as the receiving Office — the receiving Office, of the fact and the date of receipt of the search copy.

## Rule 26—Checking by, and Correcting before, the Receiving Office of Certain Elements of the International Application

### 26.1 Time Limit for Check

- (a) The receiving Office shall issue the invitation to correct provided for in Article 14(1)(b) as soon as possible, preferably within one month from the receipt of the international application.
- (b) If the receiving Office issues an invitation to correct the defect referred to in Article 14(1)(a)(iii) or (iv) (missing title or missing abstract), it shall notify the International Searching Authority accordingly.

### 26.2 Time Limit for Correction

The time limit referred to in Article 14(1)(b) shall be reasonable under the circumstances and shall be fixed in each case by the receiving Office. It shall not be less than one month from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

### 26.3 Checking of Physical Requirements under Article 14(1)(a)(v)

The physical requirements referred to in Rule 11 shall be checked only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

### 26.3bis Invitation to Correct Defects under Article 14(1)(b)

The receiving Office shall not be required to issue the invitation to correct a defect under Article 14(1)(a)(v) where the physical requirements referred to in Rule 11 are complied with to the extent necessary for the purpose of reasonably uniform international publication.

### 26.3ter Invitation to Correct Defects under Article 3(4)(i)

- (a) Where any element of the international application, other than those referred to in Article 11(1)(iii)(d) and (e), does not comply with Rule 12.1, the receiving Office shall invite the applicant to file the required correction. Rules 26.1(a), 26.2, 26.5 and 29.1 shall apply *mutatis mutandis*.
- (b) If, on July 12, 1991, paragraph (a) is not compatible with the national law applied by the receiving Office, paragraph (a) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

### 26.4 Procedure

- (a) Any correction offered to the receiving Office may be stated in a letter addressed to that Office if the correction is of such a nature that it can be transfer-

red from the letter to the record copy without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred; otherwise, the applicant shall be required to submit a replacement sheet embodying the correction and the letter accompanying the replacement sheet shall draw attention to the differences between the replaced sheet and the replacement sheet.

(b) to (d) *[Deleted]*

### **26.5 Decision of the Receiving Office**

(a) The receiving Office shall decide whether the applicant has submitted the correction within the time limit under Rule 26.2 and, if the correction has been submitted within that time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

(b) *[Deleted]*

### **26.6 Missing Drawings**

(a) If, as provided in Article 14(2), the international application refers to drawings which in fact are not included in that application, the receiving Office shall so indicate in the said application.

(b) The date on which the applicant receives the notification provided for in Article 14(2) shall have no effect on the time limit fixed under Rule 20.2(a)(iii).

## **Rule 27—Lack of Payment of Fees**

### **27.1 Fees**

(a) For the purposes of Article 14(3)(a), “fees prescribed under Article 3(4)(iv)” means: the transmittal fee (Rule 14), the basic fee part of the international fee (Rule 15.1(i)), the search fee (Rule 16), and, where required, the late payment fee (Rule 16*bis*.2).

(b) For the purposes of Article 14(3)(a) and (b), “the fee prescribed under Article 4(2)” means the designation fee part of the international fee (Rule 15.1(ii)) and, where required, the late payment fee (Rule 16*bis*.2).

## **Rule 28—Defects Noted by the International Bureau**

### **28.1 Note on Certain Defects**

(a) If, in the opinion of the International Bureau, the international application contains any of the defects referred to in Article 14(1)(a)(i), (ii) or (v), the International Bureau shall bring such defects to the attention of the receiving Office.

- (b) The receiving Office shall, unless it disagrees with the said opinion, proceed as provided in Article 14(1)(b) and Rule 26.

### Rule 29—International Applications or Designations Considered Withdrawn under Article 14(1), (3) or (4)

#### 29.1 Finding by Receiving Office

- (a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), that the international application is considered withdrawn:
- (i) the receiving Office shall transmit the record copy (unless already transmitted), and any correction offered by the applicant, to the International Bureau;
  - (ii) the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration, and the International Bureau shall in turn notify each designated Office which has already been notified of its designation;
  - (iii) the receiving Office shall not transmit the search copy as provided in Rule 23, or, if such copy has already been transmitted, it shall notify the International Search Authority of the said declaration;
  - (iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy.
- (b) If the receiving Office declares under Article 14(3)(b) (failure to pay the prescribed designation fee under Rule 27.1(b)) that the designation of any given State is considered withdrawn, the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration. The International Bureau shall in turn notify each designated Office which has already been notified of its designation.

#### 29.2 *[Deleted]*

#### 29.3 Calling Certain Facts to the Attention of the Receiving Office

If the International Bureau or the International Searching Authority considers that the receiving Office should make a finding under Article 14(4), it shall call the relevant facts to the attention of the receiving Office.

#### 29.4 Notification of Intent to Make Declaration under Article 14(4)

Before the receiving Office issues any declaration under Article 14(4), it shall notify the applicant of its intent to issue such declaration and the reasons therefor. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within one month from the notification.

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## Rule 30—Time Limit under Article 14(4)

### 30.1 Time Limit

The time limit referred to in Article 14(4) shall be four months from the international filing date.

## Rule 31—Copies Required under Article 13

### 31.1 Request for Copies

- (a) Requests under Article 13(1) may relate to all, some kinds of, or individual international applications in which the national Office making the request is designated. Requests for all or some kinds of such international applications must be renewed for each year by means of a notification addressed by that Office before November 30 of the preceding year to the International Bureau.
- (b) Requests under Article 13(2)(b) shall be subject to the payment of a fee covering the cost of preparing and mailing the copy.

### 31.2 Preparation of Copies

The preparation of copies required under Article 13 shall be the responsibility of the International Bureau.

## Rule 32

*[Deleted]*

## Rule 32bis

*[Deleted]*

## Rule 33—Relevant Prior Art for the International Search

### 33.1 Relevant Prior Art for the International Search

- (a) For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.
- (b) When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making avail-

able to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

- (c) Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report.

### **33.2 Fields to Be Covered by the International Search**

- (a) The international search shall cover all those technical fields, and shall be carried out on the basis of all those search files, which may contain material pertinent to the invention.
- (b) Consequently, not only shall the art in which the invention is classifiable be searched but also analogous arts regardless of where classified.
- (c) The question what arts are, in any given case, to be regarded as analogous shall be considered in the light of what appears to be the necessary essential function or use of the invention and not only the specific functions expressly indicated in the international application.
- (d) The international search shall embrace all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features, even though, in its specifics, the invention as described in the international application is different.

### **33.3 Orientation of the International Search**

- (a) International search shall be made on the basis of the claims, with due regard to the description and the drawings (if any) and with particular emphasis on the inventive concept towards which the claims are directed.
- (b) In so far as possible and reasonable, the international search shall cover the entire subject matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended.

## **Rule 34—Minimum Documentation**

### **34.1 Definition**

- (a) The definitions contained in Article 2(i) and (ii) shall not apply for the purposes of this Rule.
- (b) The documentation referred to in Article 15(4) (“minimum documentation”) shall consist of:
  - (i) the “national patent documents” as specified in paragraph (c),

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- (ii) the published international (PCT) applications, the published regional applications for patents and inventors' certificates, and the published regional patents and inventors' certificates,
  - (iii) such other published items of non-patent literature as the International Searching Authorities shall agree upon and which shall be published in a list by the International Bureau when agreed upon for the first time and whenever changed.
- (c) Subject to paragraphs (d) and (e), the "national patent documents" shall be the following:
- (i) the patents issued in and after 1920 by France, the former *Reichspatentamt* of Germany, Japan, the Soviet Union, Switzerland (in French and German languages only), the United Kingdom, and the United States of America,
  - (ii) the patents issued by the Federal Republic of Germany,
  - (iii) the patent applications, if any, published in and after 1920 in the countries referred to in items (i) and (ii),
  - (iv) the inventors' certificates issued by the Soviet Union,
  - (v) the utility certificates issued by, and the published applications for utility certificates of, France,
  - (vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority.
- (d) Where an application is republished once (for example, an *Offenlegungsschrift* as an *Auslegeschrift*) or more than once, no International Searching Authority shall be obliged to keep all versions in its documentation; consequently, each such Authority shall be entitled not to keep more than one version. Furthermore, where an application is granted and is issued in the form of a patent or a utility certificate (France), no International Searching Authority shall be obliged to keep both the application and the patent or utility certificate (France) in its documentation; consequently, each such Authority shall be entitled to keep either the application only or the patent or utility certificate (France) only.
- (e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan and the Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in tech-

nical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

- (f) For the purposes of this Rule, applications which have only been laid open for public inspection are not considered published applications.

### Rule 35—The Competent International Searching Authority

#### **35.1 When Only One International Searching Authority is Competent**

Each receiving Office shall, in accordance with the terms of the applicable agreement referred to in Article 16(3)(b), inform the International Bureau which International Searching Authority is competent for the searching of the international applications filed with it, and the International Bureau shall promptly publish such information.

#### **35.2 When Several International Searching Authorities Are Competent**

- (a) Any receiving Office may, in accordance with the terms of the applicable agreement referred to in Article 16(3)(b), specify several International Searching Authorities:
- (i) by declaring all of them competent for any international application filed with it, and leaving the choice to the applicant, or
  - (ii) by declaring one or more competent for certain kinds of international applications filed with it, and declaring one or more others competent for other kinds of international applications filed with it, provided that, for those kinds of international applications for which several International Searching Authorities are declared to be competent, the choice shall be left to the applicant.
- (b) Any receiving Office availing itself of the faculty provided in paragraph (a) shall promptly inform the International Bureau, and the International Bureau shall promptly publish such information.

### Rule 36—Minimum Requirements for International Searching Authorities

#### **36.1 Definition of Minimum Requirements**

The minimum requirements referred to in Article 16(3)(c) shall be the following:

- (i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches;
- (ii) that Office or organisation must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media;

- (iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

### Rule 37—Missing or Defective Title

#### **37.1 Lack of Title**

If the international application does not contain a title and the receiving Office has notified the International Searching Authority that it has invited the applicant to correct such defect, the International Searching Authority shall proceed with the international search unless and until it receives notification that the said application is considered withdrawn.

#### **37.2 Establishment of Title**

If the international application does not contain a title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish a title, or if the said Authority finds that the title does not comply with Rule 4.3, it shall itself establish a title.

### Rule 38—Missing or Defective Abstract

#### **38.1 Lack of Abstract**

If the international application does not contain an abstract and the receiving Office has notified the International Searching Authority that it has invited the applicant to correct such defect, the International Searching Authority shall proceed with the international search unless and until it receives notification that the said application is considered withdrawn.

#### **38.2 Establishment of Abstract**

- (a) If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract (in the language in which the international application is published).
- (b) The applicant may, within one month from the date of mailing of the international search report, submit comments on the abstract established by the International Searching Authority. Where that Authority amends the abstract established by it, it shall notify the amendment to the International Bureau.

## Rule 39—Subject Matter under Article 17(2)(a)(i)

### 39.1 Definition

No International Searching Authority shall be required to search an international application if, and to the extent to which, its subject matter is any of the following:

- (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 of treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
- (v) mere presentations of information,
- (vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.

## Rule 40—Lack of Unity of Invention (International Search)

### 40.1 Invitation to Pay

The invitation to pay additional fees provided for in Article 17(3)(a) shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention and shall indicate the amount to be paid.

### 40.2 Additional Fees

- (a) The amount of the additional fee due for searching under Article 17(3)(a) shall be determined by the competent International Searching Authority.
- (b) The additional fee due for searching under Article 17(3)(a) shall be payable direct to the International Searching Authority.
- (c) 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 amount of the required additional fee is excessive. Such protest shall be examined by a three-member board or other special instance of the International Searching Authority or any competent higher authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

- (d) The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person who made the decision which is the subject of the protest.
- (e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the three-member board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified.

### **40.3 Time Limit**

The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant’s address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.

## **Rule 41—Earlier Search Other Than International Search**

### **41.1 Obligation to Use Results; Refund of Fee**

If reference has been made in the request, in the form provided for in Rule 4.11, to an international-type search carried out under the conditions set out in Article 15(5) or to a search other than an international or international-type search, the International Searching Authority shall, to the extent possible, use the results of the said search in establishing the international search report on the international application. The International Searching Authority shall refund the search fee, to the extent and under the conditions provided for in the agreement under Article 16(3)(b) or in a communication addressed to and published in the Gazette by the International Bureau, if the international search report could wholly or partly be based on the results of the said search.

## **Rule 42—Time Limit for International Search**

### **42.1 Time Limit for International Search**

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later.

## Rule 43—The International Search Report

### 43.1 Identifications

The international search report shall identify the International Searching Authority which established it by indicating the name of such Authority, and the international application by indicating the international application number, the name of the applicant, and the international filing date.

### 43.2 Dates

The international search report shall be dated and shall indicate the date on which the international search was actually completed. It shall also indicate the filing date of any earlier application whose priority is claimed or, if the priority of more than one earlier application is claimed, the filing date of the earliest among them.

### 43.3 Classification

- (a) The international search report shall contain the classification of the subject matter at least according to the International Patent Classification.
- (b) Such classification shall be effected by the International Searching Authority.

### 43.4 Language

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is published.

### 43.5 Citations

- (a) The international search report shall contain the citations of the documents considered to be relevant.
- (b) The method of identifying any cited document shall be regulated by the Administrative Instructions.
- (c) Citations of particular relevance shall be specially indicated.
- (d) Citations which are not relevant to all the claims shall be cited in relation to the claim or claims to which they are relevant.
- (e) If only certain passages of the cited document are relevant or particularly relevant, they shall be identified, for example, by indicating the page, the column, or the lines, where the passage appears. If the entire document is relevant but some passages are of particular relevance, such passages shall be identified unless such identification is not practicable.

### 43.6 Fields Searched

- (a) The international search report shall list the classification identification of the fields searched. If that identification is effected on the basis of a classification other than the International Patent Classification, the International Searching Authority shall publish the classification used.

- (b) If the international search extended to patents, inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, utility certificates of addition, or published applications for any of those kinds of protection, of States, periods, or languages, not included in the minimum documentation as defined in Rule 34, the international search report shall, when practicable, identify the kinds of documents, the States, the periods, and the languages to which it extended. For the purposes of this paragraph, Article 2(ii) shall not apply.
- (c) If the international search was based on, or was extended to, any electronic data base, the international search report may indicate the name of the data base and, where considered useful to others and practicable, the search terms used.

#### **43.7 Remarks Concerning Unity of Invention**

If the applicant paid additional fees for the international search, the international search report shall so indicate. Furthermore, where the international search was made on the main invention only or on less than all the inventions (Article 17(3)(a)), the international search report shall indicate what parts of the international application were and what parts were not searched.

#### **43.8 Authorised Officer**

The international search report shall indicate the name of the officer of the International Searching Authority responsible for that report.

#### **43.9 Additional Matter**

The international search report shall contain no matter other than that specified in Rules 33.1(b) and (c), 43.1 to 43.3, 43.5 to 43.8, and 44.2(a), and the indication referred to in Article 17(2)(b), provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. The international search report shall not contain, and the Administrative Instructions shall not permit the inclusion of, any expressions of opinion, reasoning, arguments, or explanations.

#### **43.10 Form**

The physical requirements as to the form of the international search report shall be prescribed by the Administrative Instructions.

### **Rule 44—Transmittal of the International Search Report, Etc.**

#### **44.1 Copies of Report or Declaration**

The International Searching Authority shall, on the same day, transmit one copy of the international search report or the declaration referred to in Article 17(2)(a) to the International Bureau and one copy to the applicant.

#### **44.2 Title or Abstract**

- (a) The international search report shall either state that the International Searching Authority approves the title and the abstract as submitted by the applicant or be accompanied by the text of the title and/or abstract as established by the International Searching Authority under Rules 37 and 38.
- (b) *[Deleted]*
- (c) *[Deleted]*

#### **44.3 Copies of Cited Documents**

- (a) The request referred to in Article 20(3) may be presented any time during seven years from the international filing date of the international application to which the international search report relates.
- (b) The International Searching Authority may require that the party (applicant or designated Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be provided for in the agreements referred to in Article 16(3)(b) between the International Searching Authorities and the International Bureau.
- (c) *[Deleted]*
- (d) Any International Searching Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

### **Rule 45—Translation of the International Search Report**

#### **45.1 Languages**

International search reports and declarations referred to in Article 17(2)(a) shall, when not in English, be translated into English.

### **Rule 46—Amendment of Claims before the International Bureau**

#### **46.1 Time Limit**

The time limit referred to in Article 19 shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later, provided that any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

#### **46.2 Where to File**

Amendments made under Article 19 shall be filed directly with the International Bureau.

### 46.3 Language of Amendments

If the international application has been filed in a language other than the language in which it is published, any amendment made under Article 19 shall be in the language of publication.

### 46.4 Statement

- (a) The statement referred to in Article 19(1) shall be in the language in which the international application is published and shall not exceed 500 words if in the English language or if translated into that language. The statement shall be identified as such by a heading, preferably by using the words “Statement under Article 19(1)” or their equivalent in the language of the statement.
- (b) The statement shall contain no disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

### 46.5 Form of Amendments

- (a) The applicant shall be required to submit a replacement sheet for every sheet of the claims which, on account of an amendment or amendments under Article 19, differs from the sheet originally filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.
- (b) and (c) *[Deleted]*

## Rule 47—Communication to Designated Offices

### 47.1 Procedure

- (a) The communication provided for in Article 20 shall be effected by the International Bureau.
- (*abis*) The International Bureau shall notify each designated Office, at the time of the communication provided for in Article 20, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document. Such notification shall also be sent to any designated Office which has waived the communication provided for in Article 20, unless such Office has also waived the notification of its designation.
- (b) Such communication shall be effected promptly after the international publication of the international application and, in any event, by the end of the 19th month after the priority date. Any amendment received by the International Bureau within the time limit under Rule 46.1 which was not included in the communication shall be communicated promptly to the designated Offices by the International Bureau, and the latter shall notify the applicant accordingly.

- (c) The International Bureau shall send a notice to the applicant indicating the designated Offices to which the communication has been effected and the date of such communication. Such notice shall be sent on the same day as the communication. Each designated Office shall be informed, separately from the communication, about the sending and the date of mailing of the notice. The notice shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place on the date specified in the notice.
- (d) Each designated Office shall, when it so requires, receive the international search reports and the declarations referred to in Article 17(2)(a) also in the translation referred to in Rule 45.1.
- (e) Where any designated Office has waived the requirement provided under Article 20, the copies of the documents which otherwise would have been sent to that Office shall, at the request of that Office or the applicant, be sent to the applicant at the time of the notice referred to in paragraph (c).

#### **47.2 Copies**

- (a) The copies required for communication shall be prepared by the International Bureau.
- (b) They shall be on sheets of A4 size.
- (c) Except to the extent that any designated Office notifies the International Bureau otherwise, copies of the pamphlet under Rule 48 may be used for the purposes of the communication of the international application under Article 20.

#### **47.3 Languages**

The international application communicated under Article 20 shall be in the language in which it is published provided that if that language is different from the language in which it was filed it shall, on the request of the designated Office, be communicated in either or both of these languages.

#### **47.4 Express Request under Article 23(2)**

Where the applicant makes an express request to a designated Office under Article 23(2) before the communication provided for in Article 20 has taken place, the International Bureau shall, upon request of the applicant or the designated Office, promptly effect that communication to that Office.

### **Rule 48—International Publication**

#### **48.1 Form**

- (a) The international application shall be published in the form of a pamphlet.
- (b) The particulars regarding the form of the pamphlet and the method of reproduction shall be governed by the Administrative Instructions.

## 48.2 Contents

- (a) The pamphlet shall contain:
- (i) a standardized front page,
  - (ii) the description,
  - (iii) the claims,
  - (iv) the drawings, if any,
  - (v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a); the publication of the international search report in the pamphlet shall, however, not be required to include the part of the international search report which contains only matter referred to in Rule 43 already appearing on the front page of the pamphlet,
  - (vi) any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4,
  - (vii) any request for rectification referred to in the third sentence of Rule 91.1(f),
  - (viii) any indications in relation to a deposited microorganism furnished under Rule 13*bis* separately from the description, together with an indication of the date on which the International Bureau received such indications.
- (b) Subject to paragraph (c), the front page shall include:
- (i) data taken from the request sheet and such other data as are prescribed by the Administrative Instructions,
  - (ii) a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies,
  - (iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first.
- (c) Where a declaration under Article 17(2)(a) has issued, the front page shall conspicuously refer to that fact and need include neither a drawing nor an abstract.
- (d) The figure or figures referred to in paragraph (b)(ii) shall be selected as provided in Rule 8.2. Reproduction of such figure or figures on the front page may be in a reduced form.
- (e) If there is not enough room on the front page for the totality of the abstract referred to in paragraph (b)(iii), the said abstract shall appear on the back of the front page. The same shall apply to the translation of the abstract when such translation is required to be published under Rule 48.3(c).
- (f) If the claims have been amended under Article 19, the publication shall contain either the full text of the claims both as filed and as amended or the full text of the claims as filed and specify the amendments. Any statement referred to in Article 19(1) shall be included as well, unless the International Bureau finds

that the statement does not comply with the provisions of Rule 46.4. The date of receipt of the amended claims by the International Bureau shall be indicated.

- (g) If, at the time of the completion of the technical preparations for international publication, the international search report is not yet available (for example, because of publication on the request of the applicant as provided in Articles 21(2)(b) and 64(3)(c)(i), the pamphlet shall contain, in place of the international search report, an indication to the effect that that report was not available and that either the pamphlet (then also including the international search report) will be republished or the international search report (when it becomes available) will be separately published.
- (h) If, at the time of the completion of the technical preparations for international publication, the time limit for amending the claims under Article 19 has not expired, the pamphlet shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after such amendments, either the pamphlet (containing the claims as amended) will be republished or a statement reflecting all the amendments will be published. In the latter case, at least the front page and the claims shall be republished and, if a statement under Article 19(1) has been filed, that statement shall be published as well, unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4.
- (i) The Administrative Instructions shall determine the cases in which the various alternatives referred to in paragraphs (g) and (h) shall apply. Such determination shall depend on the volume and complexity of the amendments and/or the volume of the international application and the cost factors.

### **48.3 Languages**

- (a) If the international application is filed in English, French, German, Japanese, Russian or Spanish, that application shall be published in the language in which it was filed.
- (b) If the international application is filed in a language other than English, French, German, Japanese, Russian or Spanish, that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the

correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the essence of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

- (c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

#### **48.4 Earlier Publication on the Applicant's Request**

- (a) Where the applicant asks for publication under Articles 21(2)(b) and 64(3)(c)(i) and the international search report, or the declaration referred to in Article 17(2)(a), is not yet available for publication together with the international application, the International Bureau shall collect a special publication fee whose amount shall be fixed in the Administrative Instructions.
- (b) Publication under Articles 21(2)(b) and 64(3)(c)(i) shall be effected by the International Bureau promptly after the applicant has asked for it and, where a special fee is due under paragraph (a), after receipt of such fee.

#### **48.5 Notification of National Publication**

Where the publication of the international application by the International Bureau is governed by Article 64(3)(c)(ii), the national Office concerned shall, promptly after effecting the national publication referred to in the said provision, notify the International Bureau of the fact of such national publication.

#### **48.6 Announcing of Certain Facts**

- (a) If any notification under Rule 29.1(a)(ii) reaches the International Bureau at a time later than that at which it was able to prevent the international publication of the international application, the International Bureau shall promptly publish a notice in the Gazette reproducing the essence of such notification.
- (b) *[Deleted]*
- (c) If the international application, the designation of any designated State or the priority claim is withdrawn under Rule 90*bis* after the technical preparations for international publication have been completed, notice of the withdrawal shall be published in the Gazette.

## Rule 49—Copy, Translation and Fee under Article 22

### 49.1 Notification

- (a) Any Contracting State requiring the furnishing of a translation or the payment of a national fee, or both, under Article 22, shall notify the International Bureau of:
  - (i) the languages from which and the language into which it requires translation,
  - (ii) the amount of the national fee.
- (*abis*) Any Contracting State not requiring the furnishing, under Article 22, by the applicant of a copy of the international application (even though the communication of the copy of the international application by the International Bureau under Rule 47 has not taken place by the expiration of the time limit applicable under Article 22) shall notify the International Bureau accordingly.
- (*ater*) Any Contracting State which, pursuant to Article 24(2), maintains, if it is a designated State, the effect provided for in Article 11(3) even though a copy of the international application is not furnished by the applicant by the expiration of the time limit applicable under Article 22 shall notify the International Bureau accordingly.
- (b) Any notification received by the International Bureau under paragraphs (a), (*abis*) or (*ater*) shall be promptly published by the International Bureau in the Gazette.
- (c) If the requirements under paragraph (a) change later, such changes shall be notified by the Contracting State to the International Bureau and that Bureau shall promptly publish the notification in the Gazette. If the change means that translation is required into a language which, before the change, was not required, such change shall be effective only with respect to international applications filed later than two months after the publication of the notification in the Gazette. Otherwise, the effective date of any change shall be determined by the Contracting State.

### 49.2 Languages

The language into which translation may be required must be an official language of the designated Office. If there are several of such languages, no translation may be required if the international application is in one of them. If there are several official languages and a translation must be furnished, the applicant may choose any of those languages. Notwithstanding the foregoing provisions of this paragraph, if there are several official languages but the national law prescribes the use of one such language for foreigners, a translation into that language may be required.

**49.3 Statements under Article 19; Indications under Rule 13bis.4**

For the purposes of Article 22 and the present Rule, any statement made under Article 19(1) and any indication furnished under Rule 13bis.4 shall, subject to Rule 49.5(c) and (h), be considered part of the international application.

**49.4 Use of National Form**

No applicant shall be required to use a national form when performing the acts referred to in Article 22.

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

- (a) For the purposes of Article 22, the translation of the international application shall contain the description, the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b), (*cbis*) and (e),
  - (i) contain the request,
  - (ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended, and
  - (iii) be accompanied by a copy of the drawings.
- (b) Any designated Office requiring the furnishing of a translation of the request shall furnish copies of the request form in the language of the translation free of charge to the applicants. The form and contents of the request form in the language of the translation shall not be different from those of the request under Rules 3 and 4; in particular, the request form in the language of the translation shall not ask for any information that is not in the request as filed. The use of the request form in the language of the translation shall be optional.
- (c) Where the applicant did not furnish a translation of any statement made under Article 19(1), the designated Office may disregard such statement.
- (*cbis*) Where the applicant furnishes, to a designated Office which requires under paragraph (a)(ii) a translation of both the claims as filed and the claims as amended, only one of the required two translations, the designated Office may disregard the claims of which a translation has not been furnished or invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the designated Office chooses to invite the applicant to furnish the missing translation and the latter is not furnished within the time limit fixed in the invitation, the designated Office may disregard those claims of which a translation has not been furnished or consider the international application withdrawn.
- (d) If any drawing contains text matter, the translation of that text matter shall be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew.

- (e) Any designated Office requiring under paragraph (a) the furnishing of a copy of the drawings shall, where the applicant failed to furnish such copy within the time limit applicable under Article 22, invite the applicant to furnish such copy within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.
- (f) The expression “Fig.” does not require translation into any language.
- (g) Where any copy of the drawings or any drawing executed anew which has been furnished under paragraph (d) or (e) does not comply with the physical requirements referred to in Rule 11, the designated Office may invite the applicant to correct the defect within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.
- (h) Where the applicant did not furnish a translation of the abstract or of any indication furnished under Rule 13*bis*.4, the designated Office shall invite the applicant to furnish such translation, if it deems it to be necessary, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.
- (i) Information on any requirement and practice of designated Offices under the second sentence of paragraph (a) shall be published by the International Bureau in the Gazette.
- (j) No designated Office shall require that the translation of the international application comply with physical requirements other than those prescribed for the international application as filed.
- (k) Where a title has been established by the International Searching Authority pursuant to Rule 37.2, the translation shall contain the title as established by that Authority.
- (l) If, on July 12, 1991, paragraph (*cbis*) or paragraph (k) is not compatible with the national law applied by the designated Office, the paragraph concerned shall not apply to that designated Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

### Rule 50—Faculty under Article 22(3)

#### 50.1 Exercise of Faculty

- (a) Any Contracting State allowing a time limit expiring later than the time limits provided for in Article 22(1) or (2) shall notify the International Bureau of the time limits so fixed.
- (b) Any notification received by the International Bureau under paragraph (a) shall be promptly published by the International Bureau in the Gazette
- (c) Notifications concerning the shortening of the previously fixed time limit shall be effective in relation to international applications filed after the expiration of

three months computed from the date on which the notification was published by the International Bureau.

- (d) Notifications concerning the lengthening of the previously fixed time limit shall become effective upon publication by the International Bureau in the Gazette in respect of international applications pending at the time or filed after the date of such publication, or, if the Contracting State effecting the notification fixes some later date, as from the latter date.

## Rule 51—Review by Designated Offices

### 51.1 Time Limit for Presenting the Request to Send Copies

The time limit referred to in Article 25(1)(c) shall be two months computed from the date of the notification sent to the applicant under Rules 20.7(i), 24.2(c), 29.1(a)(ii), or 29.1(b).

### 51.2 Copy of the Notice

Where the applicant, after having received a negative determination under Article 11(1), requests the International Bureau, under Article 25(1), to send copies of the file of the purported international application to any of the named Offices he has attempted to designate, he shall attach to his request a copy of the notice referred to in Rule 20.7(i).

### 51.3 Time Limit for Paying National Fee and Furnishing Translation

The time limit referred to in Article 25(2)(a) shall expire at the same time as the time limit prescribed in Rule 51.1.

## Rule 51bis—Certain National Requirements Allowed under Article 27(1), (2), (6) and (7)

### 51bis.1 Certain National Requirements Allowed

- (a) The documents referred to in Article 27(2)(ii), or the evidence referred to in Article 27(6), which the applicant may be required to furnish under the national law applicable by the designated Office include, in particular:
- (i) any document relating to the identity of the inventor,
  - (ii) any document relating to any transfer or assignment of the right to the application,
  - (iii) any document containing an oath or declaration by the inventor alleging his inventorship,
  - (iv) any document containing a declaration by the applicant designating the inventor or alleging the right to the application,
  - (v) any document containing any proof of the right of the applicant to claim priority where he is different from the applicant having filed the earlier application the priority of which is claimed,

- (vi) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.
- (b) The national law applicable by the designated Office may, in accordance with Article 27(7), require that
  - (i) the applicant be represented by an agent having the right to represent applicants before that Office and/or have an address in the designated State for the purpose of receiving notifications,
  - (ii) the agent, if any, representing the applicant be duly appointed by the applicant.
- (c) The national law applicable by the designated Office may, in accordance with Article 27(1), require that the international application, the translation thereof or any document relating thereto be furnished in more than one copy.
- (d) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the translation of the international application furnished by the applicant under Article 22 be verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful.

#### **51bis.2 Opportunity to Comply with National Requirements**

- (a) Where any of the requirements referred to in Rule 51bis.1, or any other requirement of the national law applicable by the designated Office which that Office may apply under Article 27(1), (2), (6) or (7), is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.
- (b) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the applicant, upon invitation by the designated Office, furnish a certification of the translation of the international application by a public authority or a sworn translator, if the designated Office deems such certification to be necessary under the circumstances, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation.

### **Rule 52—Amendment of the Claims, the Description, and the Drawings, before Designated Offices**

#### **52.1 Time Limit**

- (a) In any designated State in which processing or examination starts without special request, the applicant shall, if he so wishes, exercise the right under Article 28 within one month from the fulfillment of the requirements under Article 22, provided that, if the communication under Rule 47.1 has not been effected by the expiration of the time limit applicable under Article 22, he shall exercise

the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any other time if so permitted by the national law of the said State.

- (b) In any designated State in which the national law provides that examination starts only on special request, the time limit within or the time at which the applicant may exercise the right under Article 28 shall be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under paragraph (a).

## **Part C**

### **Rules Concerning Chapter II of the Treaty**

#### **Rule 53—The Demand**

##### **53.1 Form**

- (a) The demand shall be made on a printed form or be presented as a computer print-out. The particulars of the printed form and of a demand presented as a computer print-out shall be prescribed by the Administrative Instructions.
- (b) Copies of printed demand forms shall be furnished free of charge by the receiving Office or by the International Preliminary Examining Authority.

##### **53.2 Contents**

- (a) The demand shall contain:
- (i) a petition,
  - (ii) indications concerning the applicant and the agent if there is an agent,
  - (iii) indications concerning the international application to which it relates,
  - (iv) election of States,
  - (v) where applicable, a statement concerning amendments.
- (b) The demand shall be signed.

##### **53.3 The Petition**

The petition shall be to the following effect and shall preferably be worded as follows: “Demand under Article 31 of the Patent Cooperation Treaty: The undersigned requests that the international application specified below be the subject of international preliminary examination according to the Patent Cooperation Treaty.”

##### **53.4 The Applicant**

As to the indications concerning the applicant, Rules 4.4 and 4.16 shall apply, and Rule 4.5 shall apply *mutatis mutandis*. Only applicants for the elected States are required to be indicated in the demand.

### **53.5 Agent or Common Representative**

If an agent or common representative is designated, the demand shall so indicate. Rules 4.4 and 4.16 shall apply, and Rule 4.7 shall apply *mutatis mutandis*.

### **53.6 Identification of the International Application**

The international application shall be identified by the name and address of the applicant, the title of the invention, the international filing date (if known to the applicant) and the international application number or, where such number is not known to the applicant, the name of the receiving Office with which the international application was filed.

### **53.7 Election of States**

- (a) The demand shall indicate at least one Contracting State from among those States which are designated and are bound by Chapter II of the Treaty (“eligible States”), as an elected State.
- (b) Election of Contracting States in the demand shall be made:
  - (i) by an indication that all eligible States are elected, or,
  - (ii) in the case of States which have been designated for the purpose of obtaining national patents, by an indication of those eligible States that are elected, and, in the case of States which have been designated for the purpose of obtaining a regional patent, by an indication of the regional patent concerned together with either an indication that all eligible States party to the regional patent treaty concerned are elected or an indication of those among the said States that are elected.

### **53.8 Signature**

- (a) Subject to paragraph (b), the demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.
- (b) Where two or more applicants file a demand which elects a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the demand or could not be found or reached after diligent effort, the demand need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and
  - (i) a statement is furnished explaining, to the satisfaction of the International Preliminary Examining Authority, the lack of signature of the applicant concerned, or
  - (ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with.

**53.9 Statement Concerning Amendments**

- (a) If amendments under Article 19 have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments
  - (i) to be taken into account, in which case a copy of the amendments shall preferably be submitted with the demand, or
  - (ii) to be considered as reversed by an amendment under Article 34.
- (b) If no amendments under Article 19 have been made and the time limit for filing such amendments has not expired, the statement may indicate that the applicant wishes the start of the international preliminary examination to be postponed in accordance with Rule 69.1(d).
- (c) If any amendments under Article 34 are submitted with the demand, the statement shall so indicate.

**Rule 54—The Applicant Entitled to Make a Demand****54.1 Residence and Nationality**

The residence or nationality of the applicant shall, for the purposes of Article 31(2), be determined according to Rules 18.1 and 18.2.

**54.2 Two or More Applicants**

If there are two or more applicants, the right to make a demand under Article 31(2) shall exist if at least one of the applicants making the demand is

- (i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II, or
- (ii) a person entitled to make a demand under Article 31(2)(b) and the international application has been filed as provided in the decision of the Assembly.

**54.3 [Deleted]****54.4 Applicant Not Entitled to Make a Demand**

- (a) If the applicant does not have the right to make a demand or, in the case of two or more applicants, if none of them has the right to make a demand under Rule 54.2, the demand shall be considered not to have been submitted.
- (b) *[Deleted]*

**Rule 55—Languages (International Preliminary Examination)****55.1 The Demand**

The demand shall be in the language of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication.

## Rule 56—Later Elections

### 56.1 Elections Submitted Later Than the Demand

- (a) The election of States subsequent to the submission of the demand (“later election”) shall be effected by a notice submitted to the International Bureau. The notice shall identify the international application and the demand, and shall include an indication as referred to in Rule 53.7(b)(ii).
- (b) Subject to paragraph (c), the notice referred to in paragraph (a) shall be signed by the applicant for the elected States concerned or, if there is more than one applicant for those States, by all of them.
- (c) Where two or more applicants file a notice effecting a later election of a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the notice or could not be found or reached after diligent effort, the notice need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and
  - (i) a statement is furnished explaining, to the satisfaction of the International Bureau, the lack of signature of the applicant concerned, or
  - (ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or did not sign the demand but the requirements of Rule 53.8(b) were complied with.
- (d) An applicant for a State elected by a later election need not have been indicated as an applicant in the demand.
- (e) If a notice effecting a later election is submitted after the expiration of 19 months from the priority date, the International Bureau shall notify the applicant that the election does not have the effect provided for under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in respect of the elected Office concerned within the time limit applicable under Article 22.
- (f) If, notwithstanding paragraph (a), a notice effecting a later election is submitted by the applicant to the International Preliminary Examining Authority rather than the International Bureau, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

### 56.2 Identification of the International Application

The international application shall be identified as provided in Rule 53.6.

**56.3 Identification of the Demand**

The demand shall be identified by the date on which it was submitted and by the name of the International Preliminary Examining Authority to which it was submitted.

**56.4 Form of Later Elections**

The notice effecting the later election shall preferably be worded as follows: “In relation to the international application filed with ... on ... under No. ... by ... (applicant) (and the demand for international preliminary examination submitted on ... to ...), the undersigned elects the following additional State(s) under Article 31 of the Patent Cooperation Treaty: ...”

**56.5 Language of Later Elections**

The later election shall be in the language of the demand.

**Rule 57—The Handling Fee****57.1 Requirement to Pay**

- (a) Each demand for international preliminary examination shall be subject to the payment of a fee for the benefit of the International Bureau (“handling fee”) to be collected by the International Preliminary Examining Authority to which the demand is submitted.
- (b) *[Deleted]*

**57.2 Amount**

- (a) The amount of the handling fee is as set out in the Schedule of Fees.
- (b) *[Deleted]*
- (c) The amount of the handling fee shall be established, for each International Preliminary Examining Authority which, under Rule 57.3(c), prescribes the payment of the handling fee in a currency or currencies other than Swiss currency, by the Director General after consultation with that Authority and in the currency or currencies prescribed by that Authority (“prescribed currency”). The amount in each prescribed currency shall be the equivalent, in round figures, of the amount of the handling fee in Swiss currency set out in the Schedule of Fees. The amounts in the prescribed currencies shall be published in the Gazette.
- (d) Where the amount of the handling fee set out in the Schedule of Fees is changed, the corresponding amounts in the prescribed currencies shall be applied from the same date as the amount set out in the amended Schedule of Fees.
- (e) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new amount in the prescribed currency according to direc-

tives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that the interested International Preliminary Examining Authority and the Director General may agree on a date falling during the said two-month period in which case the said amount shall become applicable for that Authority from that date.

### **57.3 Time and Mode of Payment**

- (a) The handling fee shall be due at the time the demand is submitted.
- (b) *[Deleted]*
- (c) The handling fee shall be payable in the currency or currencies prescribed by the International Preliminary Examining Authority to which the demand is submitted, it being understood that, when transferred by that Authority to the International Bureau, it shall be freely convertible into Swiss currency.

### **57.4 Failure to Pay**

- (a) Where the handling fee is not paid as required, the International Preliminary Examining Authority shall invite the applicant to pay the fee within one month from the date of the invitation.
- (b) If the applicant complies with the invitation within the one-month time limit, the handling fee shall be considered as if it had been paid on the due date.
- (c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.

### **57.5 *[Deleted]***

### **57.6 Refund**

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

- (i) if the demand is withdrawn before the demand has been sent by that Authority to the International Bureau, or
- (ii) if the demand is considered, under Rule 54.4(a), not to have been submitted.

## **Rule 58—The Preliminary Examination Fee**

### **58.1 Right to Ask for a Fee**

- (a) Each International Preliminary Examining Authority may require that the applicant pay a fee (“preliminary examination fee”) for its own benefit for carrying out the international preliminary examination and for performing all other tasks entrusted to International Preliminary Examining Authorities under the Treaty and these Regulations.
- (b) The amount and the due date of the preliminary examination fee, if any, shall be fixed by the International Preliminary Examining Authority, provided that the said due date shall not be earlier than the due date of the handling fee.

- (c) The preliminary examination fee shall be payable directly to the International Preliminary Examining Authority. Where that Authority is a national Office, it shall be payable in the currency prescribed by that Office, and where the Authority is an intergovernmental organization, it shall be payable in the currency of the State in which the intergovernmental organization is located or in any other currency which is freely convertible into the currency of the said State.

### **58.2 Failure to Pay**

- (a) Where the preliminary examination fee fixed by the International Preliminary Examining Authority under Rule 58.1(b) is not paid as required under that Rule, the International Preliminary Examining Authority shall invite the applicant to pay the fee or the missing part thereof within one month from the date of the invitation.
- (b) If the applicant complies with the invitation within the prescribed time limit, the preliminary examination fee will be considered as if it had been paid on the due date.
- (c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.

### **58.3 Refund**

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

## **Rule 59—The Competent International Preliminary Examining Authority**

### **59.1 Demands under Article 31(2)(a)**

For demands made under Article 31(2)(a), each receiving Office of or acting for a Contracting State bound by the provisions of Chapter II shall, in accordance with the terms of the applicable agreement referred to in Article 32(2) and (3), inform the International Bureau which International Preliminary Examining Authority is or which International Preliminary Examining Authorities are competent for the international preliminary examination of international applications filed with it. The International Bureau shall promptly publish such information. Where several International Preliminary Examining Authorities are competent, the provisions of Rule 35.2 shall apply *mutatis mutandis*.

### **59.2 Demands under Article 31(2)(b)**

As to demands made under Article 31(2)(b), the Assembly, in specifying the International Preliminary Examining Authority competent for international applications filed with a national Office which is an International Preliminary Examining Authority

ty, shall give preference to that Authority; if the national Office is not an International Preliminary Examining Authority, the Assembly shall give preference to the International Preliminary Examining Authority recommended by that Office.

## Rule 60—Certain Defects in the Demand or Elections

### 60.1 Defects in the Demand

- (a) If the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to 53.8 and 55, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.
- (b) If the applicant complies with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted contained at least one election and permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.
- (c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had not been submitted.
- (d) Where, after the expiration of the time limit under paragraph (a), a signature required under Rule 53.8 or a prescribed indication is lacking in respect of an applicant for a certain elected State, the election of that State shall be considered as if it had not been made.
- (e) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in paragraphs (a) to (d).
- (f) If the demand does not contain a statement concerning amendments, the International Preliminary Examining Authority shall proceed as provided for in Rules 66.1 and 69.1(a) or (b).
- (g) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall invite the applicant to submit the amendments within a time limit fixed in the invitation and shall proceed as provided for in Rule 69.1(e).

### 60.2 Defects in Later Elections

- (a) If the notice effecting a later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the de-

fects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Bureau at any time before a decision is taken.

- (b) If the applicant complies with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had been received on the actual filing date, provided that the notice as submitted contained at least one election and permitted the international application to be identified; otherwise, the notice shall be considered as if it had been received on the date on which the International Bureau receives the correction.
- (c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had not been submitted.
- (d) Where, in respect of an applicant for a certain elected State, the signature required under Rule 56.1(b) and (c) or the name or address is lacking after the expiration of the time limit under paragraph (a), the later election of that State shall be considered as if it had not been made.

## Rule 61—Notification of the Demand and Elections

### 61.1 Notification to the International Bureau and the Applicant

- (a) The International Preliminary Examining Authority shall indicate on the demand the date of receipt or, where applicable, the date referred to in Rule 60.1(b). The International Preliminary Examining Authority shall promptly send the demand to the International Bureau, and shall prepare and keep a copy in its file.
- (b) The International Preliminary Examining Authority shall promptly inform the applicant in writing of the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 57.4(c), 58.2(c), or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 60.1(d) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.
- (c) The International Bureau shall promptly notify the applicant of the receipt, and the date of receipt, of any notice effecting a later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b). Where the notice has been considered under Rule 60.2(c) as if it had not been submitted or where a later election has been considered under Rule 60.2(d) as if it had not been made, the International Bureau shall notify the applicant accordingly.

### 61.2 Notification to the Elected Offices

- (a) The notification provided for in Article 31(7) shall be effected by the International Bureau.

- (b) The notification shall indicate the number and filing date of the international application, the name of the applicant, the filing date of the application whose priority is claimed (where priority is claimed), the date of receipt by the International Preliminary Examining Authority of the demand, and—in the case of a later election—the date of receipt of the notice effecting the later election. The latter date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b).
- (c) The notification shall be sent to the elected Office together with the communication provided for in Article 20. Elections effected after such communication shall be notified promptly after they have been made.
- (d) Where the applicant makes an express request to an elected Office under Article 40(2) before the communication provided for in Article 20 has taken place, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect that communication to that Office.

### **61.3 Information for the Applicant**

The International Bureau shall inform the applicant in writing of the notification referred to in Rule 61.2 and of the elected Offices notified under Article 31(7).

### **61.4 Publication in the Gazette**

Where a demand has been filed prior to the expiration of the 19th month from the priority date, the International Bureau shall publish a notice of that fact in the Gazette promptly after the filing of the demand, but not before the international publication of the international application. The notice shall indicate all designated States bound by Chapter II which have not been elected.

## **Rule 62—Copy of Amendments Under Article 19 for the International Preliminary Examining Authority**

### **62.1 Amendments Made before the Demand is Filed**

Upon receipt of a demand from the International Preliminary Examining Authority, the International Bureau shall promptly transmit a copy of any amendments under Article 19 to that Authority, unless that Authority has indicated that it has already received such a copy.

### **62.2 Amendments Made after the Demand is Filed**

- (a) If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority. In any case, the International Bureau shall promptly transmit a copy of such amendments to that Authority.
- (b) *[Deleted]*

## Rule 63—Minimum Requirements for International Preliminary Examining Authorities

### 63.1 Definition of Minimum Requirements

The minimum requirements referred to in Article 32(3) shall be the following:

- (i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out examinations;
- (ii) that Office or organization must have at its ready disposal at least the minimum documentation referred to in Rule 34, properly arranged for examination purposes;
- (iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

## Rule 64—Prior Art for International Preliminary Examination

### 64.1 Prior Art

- (a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) shall be considered prior art provided that such making available occurred prior to the relevant date.
- (b) For the purposes of paragraph (a), the relevant date will be:
  - (i) subject to item (ii), the international filing date of the international application under international preliminary examination;
  - (ii) where the international application under international preliminary examination validly claims the priority of an earlier application, the filing date of such earlier application.

### 64.2 Non-Written Disclosures

In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means (“non-written disclosure”) before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the non-written disclosure shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.

### **64.3 Certain Published Documents**

In cases where any application or any patent which would constitute prior art for the purposes of Article 33(2) and (3) had it been published prior to the relevant date referred to in Rule 64.1 was published on a date which is the same as, or later than, the relevant date but was filed earlier than the relevant date or claimed the priority of an earlier application which had been filed prior to the relevant date, such published application or patent shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such application or patent in the manner provided for in Rule 70.10.

## **Rule 65—Inventive Step or Non-Obviousness**

### **65.1 Approach to Prior Art**

For the purposes of Article 33(3), the international preliminary examination shall take into consideration the relation of any particular claim to the prior art as a whole. It shall take into consideration the claim's relation not only to individual documents or parts thereof taken separately but also its relation to combinations of such documents or parts of documents, where such combinations are obvious to a person skilled in the art.

### **65.2 Relevant Date**

For the purposes of Article 33(3), the relevant date for the consideration of inventive step (non-obviousness) is the date prescribed in Rule 64.1.

## **Rule 66—Procedure before the International Preliminary Examining Authority**

### **66.1 Basis of the International Preliminary Examination**

- (a) Subject to paragraphs (b) to (d), the international preliminary examination shall be based on the international application as filed.
- (b) The applicant may submit amendments under Article 34 at the time of filing the demand or, subject to Rule 66.4*bis* until the international preliminary examination report is established.
- (c) Any amendments under Article 19 made before the demand was filed shall be taken into account for the purposes of the international preliminary examination unless superseded, or considered as reversed, by an amendment under Article 34.
- (d) Any amendments under Article 19 made after the demand was filed and any amendments under Article 34 submitted to the International Preliminary Examining Authority shall, subject to Rule 66.4*bis* be taken into account for the purposes of the international preliminary examination.

- (e) Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

#### **66.2 First Written Opinion of the International Preliminary Examining Authority**

- (a) If the International Preliminary Examining Authority
  - (i) considers that any of the situations referred to in Article 34(4) exists,
  - (ii) considers that the international preliminary examination report should be negative in respect of any of the claims because the invention claimed therein does not appear to be novel, does not appear to involve an inventive step (does not appear to be non-obvious), or does not appear to be industrially applicable,
  - (iii) notices that there is some defect in the form or contents of the international application under the Treaty or these Regulations,
  - (iv) considers that any amendment goes beyond the disclosure in the international application as filed,
  - (v) wishes to accompany the international preliminary examination report by observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description,
  - (vi) considers that a claim relates to an invention in respect of which no international search report has been established and has decided not to carry out the international preliminary examination in respect of that claim, or
  - (vii) considers that a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out,

the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

- (b) The notification shall fully state the reasons for the opinion of the International Preliminary Examining Authority.
- (c) The notification shall invite the applicant to submit a written reply together, where appropriate, with amendments.
- (d) The notification shall fix a time limit for the reply. The time limit shall be reasonable under the circumstances. It shall normally be two months after the

date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. It shall not be more than three months after the said date but may be extended if the applicant so requests before its expiration.

### **66.3 Formal Response to the International Preliminary Examining Authority**

- (a) The applicant may respond to the invitation referred to in Rule 66.2(c) of the International Preliminary Examining Authority by making amendments or — if he disagrees with the opinion of that Authority — by submitting arguments, as the case may be, or do both.
- (b) Any response shall be submitted directly to the International Preliminary Examining Authority.

### **66.4 Additional Opportunity for Submitting Amendments or Arguments**

- (a) If the International Preliminary Examining Authority wishes to issue one or more additional written opinions, it may do so, and Rules 66.2 and 66.3 shall apply.
- (b) On the request of the applicant, the International Preliminary Examining Authority may give him one or more additional opportunities to submit amendments or arguments.

### **66.4bis Consideration of Amendments and Arguments**

Amendments or arguments need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received after that Authority has begun to draw up that opinion or report.

### **66.5 Amendment**

Any change, other than the rectification of obvious errors, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

### **66.6 Informal Communications with the Applicant**

The International Preliminary Examining Authority may, at any time, communicate informally, over the telephone, in writing, or through personal interviews, with the applicant. The said Authority shall, at its discretion, decide whether it wishes to grant more than one personal interview if so requested by the applicant, or whether it wishes to reply to any informal written communication from the applicant.

### **66.7 Priority Document**

- (a) If the International Preliminary Examining Authority needs a copy of the application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is

not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1, the international preliminary examination report may be established as if the priority had not been claimed.

- (b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

### **66.8 Form of Amendments**

- (a) The applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. Where the amendment consists in the deletion of passages or in minor alterations or additions, it may be made on a copy of the relevant sheet of the international application, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.
- (b) *[Deleted]*

### **66.9 Language of Amendments**

If the international application has been filed in a language other than the language in which it is published, any amendment, as well as any letter referred to in Rule 66.8(a), shall be submitted in the language of publication.

## **Rule 67—Subject Matter under Article 34(4)(a)(i)**

### **67.1 Definition**

No International Preliminary Examining Authority shall be required to carry out an international preliminary examination on an international application if, and to the extent to which, its subject matter is any of the following:

- (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 presentations of information,
- (vi) computer programs to the extent that the International Preliminary Examining Authority is not equipped to carry out an international preliminary examination concerning such programs.

### Rule 68—Lack of Unity of Invention (International Preliminary Examination)

#### **68.1 No Invitation to Restrict or Pay**

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses not to invite the applicant to restrict the claims or to pay additional fees, it shall proceed with the international preliminary examination, subject to Article 34(4)(b) and Rule 66.1(e) in respect of the entire international application, but shall indicate, in any written opinion and in the international preliminary examination report, that it considers that the requirement of unity of invention is not fulfilled and it shall specify the reasons therefor.

#### **68.2 Invitation to Restrict or Pay**

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, it shall specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement, and shall specify the amount of the additional fees and the reasons for which the international application is not considered as complying with the requirement of unity of invention. It shall, at the same time, fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

#### **68.3 Additional Fees**

- (a) The amount of the additional fee due for international preliminary examination under Article 34(3)(a) shall be determined by the competent International Preliminary Examining Authority.
- (b) The additional fee due for international preliminary examination under Article 34(3)(a) shall be payable direct to the International Preliminary Examining Authority.
- (c) Any applicant may pay the additional 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 amount of the required additional fee is excessive. Such protest shall be examined by a three-member board or other special instance of the International Preliminary Examining Au-

thority, or any competent higher authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the elected Offices as an annex to the international preliminary examination report.

- (d) The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person who made the decision which is the subject of the protest.
- (e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the three-member board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified.

#### **68.4 Procedure in the Case of Insufficient Restriction of the Claims**

If the applicant restricts the claims but not sufficiently to comply with the requirement of unity of invention, the International Preliminary Examining Authority shall proceed as provided in Article 34(3)(c).

#### **68.5 Main Invention**

In case of doubt which invention is the main invention for the purposes of Article 34(3)(c), the invention first mentioned in the claims shall be considered the main invention.

### **Rule 69—Start of and Time Limit for International Preliminary Examination**

#### **69.1 Start of International Preliminary Examination**

- (a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession both of the demand and of either the international search report or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established.
- (b) If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organisation as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes and subject to paragraph (d), start at the same time as the international search.

- (c) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned.
- (d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before
  - (i) it has received a copy of any amendments made under Article 19,
  - (ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19, or
  - (iii) the expiration of 20 months from the priority date, whichever occurs first.
- (e) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.

## **69.2 Time Limit for International Preliminary Examination**

The time limit for establishing the international preliminary examination report shall be:

- (i) 28 months from the priority date if the demand was filed prior to the expiration of 19 months from the priority date;
- (ii) nine months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.

### **Rule 70—The International Preliminary Examination Report**

#### **70.1 Definition**

For the purposes of this Rule, “report” shall mean international preliminary examination report.

#### **70.2 Basis of the Report**

- (a) If the claims have been amended, the report shall issue on the claims as amended.
- (b) If, pursuant to Rule 66.7(a) or (b), the report is established as if the priority had not been claimed, the report shall so indicate.
- (c) If the International Preliminary Examining Authority considers that any amendment goes beyond the disclosure in the international application as filed,

the report shall be established as if such amendment had not been made, and the report shall so indicate. It shall also indicate the reasons why it considers that the amendment goes beyond the said disclosure.

- (d) Where claims relate to inventions in respect of which no international search report has been established and have therefore not been the subject of international preliminary examination, the international preliminary examination report shall so indicate.

### **70.3 Identifications**

The report shall identify the International Preliminary Examining Authority which established it by indicating the name of such Authority, and the international application by indicating the international application number, the name of the applicant, and the international filing date.

### **70.4 Dates**

The report shall indicate:

- (i) the date on which the demand was submitted, and
- (ii) the date of the report; that date shall be the date on which the report is completed.

### **70.5 Classification**

- (a) The report shall repeat the classification given under Rule 43.3 if the International Preliminary Examining Authority agrees with such classification.
- (b) Otherwise, the International Preliminary Examining Authority shall indicate in the report the classification, at least according to the International Patent Classification, which it considers correct.

### **70.6 Statement under Article 35(2)**

- (a) The statement referred to in Article 35(2) shall consist of the words “YES” or “NO,” or their equivalent in the language of the report, or some appropriate sign provided for in the Administrative Instructions, and shall be accompanied by the citations, explanations and observations, if any, referred to in the last sentence of Article 35(2).
- (b) If any of the three criteria referred to in Article 35(2) (that is, novelty, inventive step (non-obviousness), industrial applicability) is not satisfied, the statement shall be negative. If, in such a case, any of the criteria, taken separately, is satisfied, the report shall specify the criterion or criteria so satisfied.

### **70.7 Citations under Article 35(2)**

- (a) The report shall cite the documents considered to be relevant for supporting the statements made under Article 35(2).
- (b) The provisions of Rule 43.5(b) and (e) shall apply also to the report.

### **70.8 Explanations under Article 35(2)**

The Administrative Instructions shall contain guidelines for cases in which the explanations referred to in Article 35(2) should or should not be given and the form of such explanations. Such guidelines shall be based on the following principles:

- (i) explanations shall be given whenever the statement in relation to any claim is negative;
- (ii) explanations shall be given whenever the statement is positive unless the reason for citing any document is easy to imagine on the basis of consultation of the cited document;
- (iii) generally, explanations shall be given if the case provided for in the last sentence of Rule 70.6(b) obtains.

### **70.9 Non-Written Disclosures**

Any non-written disclosure referred to in the report by virtue of Rule 64.2 shall be mentioned by indicating its kind, the date on which the written disclosure referring to the non-written disclosure was made available to the public, and the date on which the non-written disclosure occurred in public

### **70.10 Certain Published Documents**

Any published application or any patent referred to in the report by virtue of Rule 64.3 shall be mentioned as such and shall be accompanied by an indication of its date of publication, of its filing date, and its claimed priority date (if any). In respect of the priority date of any such document, the report may indicate that, in the opinion of the International Preliminary Examining Authority, such date has not been validly claimed.

### **70.11 Mention of Amendments**

If, before the International Preliminary Examining Authority, amendments have been made, this fact shall be indicated in the report. Where any amendment has resulted in the cancellation of an entire sheet, this fact shall also be specified in the report.

### **70.12 Mention of Certain Defects and Other Matters**

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

- (i) the international application contains any of the defects referred to in Rule 66.2(a)(iii), it shall include this opinion and the reasons therefor in the report;
- (ii) the international application calls for any of the observations referred to in Rule 66.2(a)(v), it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;
- (iii) any of the situations referred to in Article 34(4) exists, it shall state this opinion and the reasons therefore in the report;

- (iv) a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, it shall so state in the report.

#### **70.13 Remarks Concerning Unity of Invention**

If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under Article 34(3), the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (Article 34(3)(a)), or on the main invention only (Article 34(3)(c)), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination. The report shall contain the indications provided for in Rule 68.1, where the International Preliminary Examining Authority chose not to invite the applicant to restrict the claims or to pay additional fees.

#### **70.14 Authorised Officer**

The report shall indicate the name of the officer of the International Preliminary Examining Authority responsible for that report.

#### **70.15 Form**

The physical requirements as to the form of the report shall be prescribed by the Administrative Instructions.

#### **70.16 Annexes of the Report**

Each replacement sheet under Rule 66.8(a) and each replacement sheet containing amendments under Article 19 shall, unless superseded by later replacement sheets, be annexed to the report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8(a) shall not be annexed.

#### **70.17 Languages of the Report and the Annexes**

- (a) The report and any annex shall be in the language in which the international application to which they relate is published.
- (b) *[Deleted]*

### **Rule 71—Transmittal of the International Preliminary Examination Report**

#### **71.1 Recipients**

The International Preliminary Examining Authority shall, on the same day, transmit one copy of the international preliminary examination report and its annexes, if any, to the International Bureau, and one copy to the applicant.

## **71.2 Copies of Cited Documents**

- (a) The request under Article 36(4) may be presented any time during seven years from the international filing date of the international application to which the report relates.
- (b) The International Preliminary Examining Authority may require that the party (applicant or elected Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be provided for in the agreements referred to in Article 32(2) between the International Preliminary Examining Authorities and the International Bureau.
- (c) *[Deleted]*
- (d) Any International Preliminary Examining Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

## **Rule 72—Translation of the International Preliminary Examination Report**

### **72.1 Languages**

- (a) Any elected State may require that the international preliminary examination report, established in any language other than the official language, or one of the official languages, of its national Office, be translated into English.
- (b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

### **72.2 Copy of Translation for the Applicant**

The International Bureau shall transmit a copy of the translation referred to in Rule 72.1(a) of the international preliminary examination report to the applicant at the same time as it communicates such translation to the interested elected Office or Offices.

### **72.3 Observations on the Translation**

The applicant may make written observations on what, in his opinion, are errors of translation in the translation of the international preliminary examination report and shall send a copy of any such observations to each of the interested elected Offices and a copy to the International Bureau.

## **Rule 73—Communication of the International Preliminary Examination Report**

### **73.1 Preparation of Copies**

The International Bureau shall prepare the copies of the documents to be communicated under Article 36(3)(a).

**73.2 Time Limit for Communication**

The communication provided for in Article 36(3)(a) shall be effected as promptly as possible but not earlier than the communication under Article 20.

**Rule 74—Translations of Annexes of the International Preliminary Examination Report and Transmittal Thereof****74.1 Content of Translation and Time Limit for Transmittal Thereof**

Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), transmit a translation of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report. The same time limit shall apply where the furnishing of a translation of the international application to the elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22.

**Rule 75**

*[Deleted]*

**Rule 76—Copy, Translation and Fee under Article 39(1); Translation of Priority Document**

**76.1, 76.2 and 76.3** *[Deleted]*

**76.4 Time Limit for Translation of Priority Document**

The applicant shall not be required to furnish to any elected Office a certified translation of the priority document before the expiration of the applicable time limit under Article 39.

**76.5 Application of Rules 22.1(g), 49 and 51bis**

Rules 22.1(g), 49 and 51bis shall apply, provided that:

- (i) any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;
- (ii) any reference in the said Rules to Article 22 or Article 24(2) shall be construed as a reference to Article 39(1) or Article 39(3), respectively;
- (iii) the words “international applications filed” in Rule 49.1(c) shall be replaced by the words “a demand submitted”;
- (iv) for the purposes of Article 39(1), where an international preliminary examination report has been established, a translation of any amendment under Article 19 shall only be required if that amendment is annexed to that report.

### **76.6 Transitional Provision**

If, on July 12, 1991, Rule 76.5(iv) is not compatible with the national law applied by the elected Office in respect of claims amended under Article 19, Rule 76.5(iv) shall not apply in that respect to that elected Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

### **Rule 77—Faculty under Article 39(1)(b)**

#### **77.1 Exercise of Faculty**

- (a) Any Contracting State allowing a time limit expiring later than the time limit provided for in Article 39(1)(a) shall notify the International Bureau of the time limit so fixed.
- (b) Any notification received by the International Bureau under paragraph (a) shall be promptly published by the International Bureau in the Gazette.
- (c) Notifications concerning the shortening of the previously fixed time limit shall be effective in relation to demands submitted after the expiration of three months computed from the date on which the notification was published by the International Bureau.
- (d) Notifications concerning the lengthening of the previously fixed time limit shall become effective upon publication by the International Bureau in the Gazette in respect of demands pending at the time or submitted after the date of such publication, or, if the Contracting State effecting the notification fixes some later date, as from the latter date.

### **Rule 78—Amendment of the Claims, the Description, and the Drawings, before Elected Offices**

#### **78.1 Time Limit Where Election Is Effected prior to Expiration of 19 Months from Priority Date**

- (a) Where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, the applicant shall, if he so wishes, exercise the right under Article 41 to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfilment of the requirements under Article 39(1)(a), provided that, if the transmittal of the international preliminary examination report under Article 36(1) has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than four months after such expiration date. In either case, the applicant may exercise the said right at any other time if so permitted by the national law of the said State.
- (b) In any elected State in which the national law provides that examination starts only on special request, the national law may provide that the time limit within

or the time at which the applicant may exercise the right under Article 41 shall, where the election of any Contracting State is effected prior to the expiration of the 19th month from the priority date, be the same as that provided by the national law for the filing of amendments in the case of the examination, on special request, of national applications, provided that such time limit shall not expire prior to, or such time shall not come before, the expiration of the time limit applicable under paragraph (a).

### **78.2 Time Limit Where Election Is Effected after Expiration of 19 Months from Priority Date**

Where the election of any Contracting State has been effected after the expiration of the 19th month from the priority date and the applicant wishes to make amendments under Article 41, the time limit for making amendments under Article 28 shall apply.

### **78.3 Utility Models**

The provisions of Rules 6.5 and 13.5 shall apply, *mutatis mutandis*, before elected Offices. If the election was made before the expiration of the 19th month from the priority date, the reference to the time limit applicable under Article 22 is replaced by a reference to the time limit applicable under Article 39.

## **Part D Rules Concerning Chapter III of the Treaty**

### **Rule 79—Calendar**

#### **79.1 Expressing Dates**

Applicants, national Offices, receiving Offices, International Searching and Preliminary Examining Authorities, and the International Bureau, shall, for the purposes of the Treaty and the Regulations, express any date in terms of the Christian era and the Gregorian calendar, or, if they use other eras and calendars, they shall also express any date in terms of the Christian era and the Gregorian calendar.

### **Rule 80—Computation of Time Limits**

#### **80.1 Periods Expressed in Years**

When a period is expressed as one year or a certain number of years, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

### **80.2 Periods Expressed in Months**

When a period is expressed as one month or a certain number of months, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

### **80.3 Periods Expressed in Days**

When a period is expressed as a certain number of days, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire on the day on which the last day of the count has been reached.

### **80.4 Local Dates**

- (a) The date which is taken into consideration as the starting date of the computation of any period shall be the date which prevails in the locality at the time when the relevant event occurred.
- (b) The date on which any period expires shall be the date which prevails in the locality in which the required document must be filed or the required fee must be paid.

### **80.5 Expiration on a Non-Working Day**

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day on which such Office or organization is not open to the public for the purposes of the transaction of official business, or on which ordinary mail is not delivered in the locality in which such Office or organization is situated, the period shall expire on the next subsequent day on which neither of the said two circumstances exists.

### **80.6 Date of Documents**

- (a) Where a period starts on the day of the date of a document or letter emanating from a national Office or intergovernmental organization, any interested party may prove that the said document or letter was mailed on a day later than the date it bears, in which case the date of actual mailing shall, for the purposes of computing the period, be considered to be the date on which the period starts. Irrespective of the date on which such a document or letter was mailed, if the applicant offers to the national Office or intergovernmental organization evidence which satisfies the national Office or intergovernmental organization that the document or letter was received more than seven days after the date it bears, the national Office or intergovernmental organization shall treat the period starting from the date of the document or letter as expiring later by an additional number of days which is equal to the number of days which the document or letter was received later than seven days after the date it bears.
- (b) *[Deleted]*

**80.7 End of Working Day**

- (a) A period expiring on a given day shall expire at the moment the national Office or intergovernmental organization with which the document must be filed or to which the fee must be paid closes for business on that day.
- (b) Any Office or organization may depart from the provisions of paragraph (a) up to midnight on the relevant day.

**Rule 81—Modification of Time Limits Fixed in the Treaty****81.1 Proposal**

- (a) Any Contracting State or the Director General may propose a modification under Article 47(2).
- (b) Proposals made by a Contracting State shall be presented to the Director General.

**81.2 Decision by the Assembly**

- (a) When the proposal is made to the Assembly, its text shall be sent by the Director General to all Contracting States at least two months in advance of that session of the Assembly whose agenda includes the proposal.
- (b) During the discussion of the proposal in the Assembly, the proposal may be amended or consequential amendments proposed.
- (c) The proposal shall be considered adopted if none of the Contracting States present at the time of voting votes against the proposal.

**81.3 Voting by Correspondence**

- (a) When voting by correspondence is chosen, the proposal shall be included in a written communication from the Director General to the Contracting States, inviting them to express their vote in writing.
- (b) The invitation shall fix the time limit within which the reply containing the vote expressed in writing must reach the International Bureau. That time limit shall not be less than three months from the date of the invitation.
- (c) Replies must be either positive or negative. Proposals for amendments or mere observations shall not be regarded as votes.
- (d) The proposal shall be considered adopted if none of the Contracting States opposes the amendment and if at least one-half of the Contracting States express either approval or indifference or abstention.

**Rule 82—Irregularities in the Mail Service****82.1 Delay or Loss in Mail**

- (a) Any interested party may offer evidence that he has mailed the document or letter five days prior to the expiration of the time limit. Except in cases where

surface mail normally arrives at its destination within two days of mailing, or where no airmail service is available, such evidence may be offered only if the mailing was by airmail. In any case, evidence may be offered only if the mailing was by mail registered by the postal authorities.

- (b) If the mailing, in accordance with paragraph (a), of a document or letter is proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, or, if the document or letter is lost in the mail, substitution for it of a new copy shall be permitted, provided that the interested party proves to the satisfaction of the said Office or organization that the document or letter offered in substitution is identical with the document or letter lost.
- (c) In the cases provided for in paragraph (b), evidence of mailing within the prescribed time limit, and, where the document or letter was lost, the substitute document or letter as well as the evidence concerning its identity with the document or letter lost shall be submitted within one month after the date on which the interested party noticed—or with due diligence should have noticed—the delay or the loss, and in no case later than six months after the expiration of the time limit applicable in the given case.
- (d) Any national Office or intergovernmental organization which has notified the International Bureau that it will do so shall, where a delivery service other than the postal authorities is used to mail a document or letter, apply the provisions of paragraphs (a) to (c) as if the delivery service was a postal authority. In such a case, the last sentence of paragraph (a) shall not apply but evidence may be offered only if details of the mailing were recorded by the delivery service at the time of mailing. The notification may contain an indication that it applies only to mailings using specified delivery services or delivery services which satisfy specified criteria. The International Bureau shall publish the information so notified in the Gazette.
- (e) Any national Office or intergovernmental organization may proceed under paragraph (d):
  - (i) even if, where applicable, the delivery service used was not one of those specified, or did not satisfy the criteria specified, in the relevant notification under paragraph (d), or
  - (ii) even if that Office or organization has not sent to the International Bureau a notification under paragraph (d).

## **82.2 Interruption in the Mail Service**

- (a) Any interested party may offer evidence that on any of the 10 days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.

- (b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, provided that the interested party proves to the satisfaction of the said Office or organization that he effected the mailing within five days after the mail service was resumed. The provisions of Rule 82.1(c) shall apply *mutatis mutandis*.

### Rule 82bis—Excuse by the Designated or Elected State of Delays in Meeting Certain Time Limits

#### **82bis.1 Meaning of “Time Limit” in Article 48(2)**

The reference to “any time limit” in Article 48(2) shall be construed as comprising a reference:

- (i) to any time limit fixed in the Treaty or these Regulations;
- (ii) to any time limit fixed by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau or applicable by the receiving Office under its national law;
- (iii) to any time limit fixed by, or in the national law applicable by, the designated or elected Office, for the performance of any act by the applicant before that Office.

#### **82bis.2 Reinstatement of Rights and Other Provisions to Which Article 48(2) Applies**

The provisions of the national law which is referred to in Article 48(2) concerning the excusing, by the designated or elected State, of any delay in meeting any time limit are those provisions which provide for reinstatement of rights, restoration, *restitutio in integrum* or further processing in spite of non-compliance with a time limit, and any other provision providing for the extension of time limits or for excusing delays in meeting time limits.

### Rule 82ter—Rectification of Errors Made by the Receiving Office or by the International Bureau

#### **82ter.1 Errors Concerning the International Filing Date and the Priority Claim**

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the declaration made under Article 8(1) has been erroneously cancelled or corrected by the receiving Office or the International Bureau, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the declaration under Article 8(1) had not been cancelled or corrected, as the case may be.

## Rule 83—Right to Practice before International Authorities

### 83.1 Proof of Right

The International Bureau, the competent International Searching Authority, and the competent International Preliminary Examining Authority, may require the production of proof of the right to practice referred to in Article 49.

### 83.2 Information

- (a) The national Office or the intergovernmental organization which the interested person is alleged to have a right to practice before shall, upon request, inform the International Bureau, the competent International Searching Authority, or the competent International Preliminary Examining Authority, whether such person has the right to practice before it.
- (b) Such information shall be binding upon the International Bureau, the International Searching Authority, or the International Preliminary Examining Authority, as the case may be.

## Part E

### Rules Concerning Chapter V of the Treaty

#### Rule 84—Expenses of Delegations

##### 84.1 Expenses Borne by Governments

The expenses of each Delegation participating in any organ established by or under the Treaty shall be borne by the Government which has appointed it.

#### Rule 85—Absence of Quorum in the Assembly

##### 85.1 Voting by Correspondence

In the case provided for in Article 53(5)(b), the International Bureau shall communicate the decisions of the Assembly (other than those concerning the Assembly's own procedure) to the Contracting States which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of that period, the number of Contracting States having thus expressed their vote or abstention attains the number of Contracting States which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

#### Rule 86—The Gazette

##### 86.1 Contents

The Gazette referred to in Article 55(4) shall contain:

- (i) for each published international application, data specified by the Administrative Instructions taken from the front page of the pamphlet published under Rule 48, the drawing (if any) appearing on the said front page, and the abstract,
- (ii) the schedule of all fees payable to the receiving Offices, the International Bureau, and the International Searching and Preliminary Examining Authorities,
- (iii) notices the publication of which is required under the Treaty or these Regulations,
- (iv) information, if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned,
- (v) any other useful information prescribed by the Administrative Instructions, provided access to such information is not prohibited under the Treaty or these Regulations.

#### **86.2 Languages**

- (a) The Gazette shall be published in an English-language edition and a French-language edition. It shall also be published in editions in any other language, provided the cost of publication is assured through sales or subventions.
- (b) The Assembly may order the publication of the Gazette in languages other than those referred to in paragraph (a).

#### **86.3 Frequency**

The frequency of publication of the Gazette shall be determined by the Director General.

#### **86.4 Sale**

The subscription and other sale prices of the Gazette shall be determined by the Director General.

#### **86.5 Title**

The title of the Gazette shall be determined by the Director General.

#### **86.6 Further Details**

Further details concerning the Gazette may be provided for in the Administrative Instructions.

### **Rule 87—Copies of Publications**

#### **87.1 International Searching and Preliminary Examining Authorities**

Any International Searching or Preliminary Examining Authority shall have the right to receive, free of charge, two copies of every published international application, of

the Gazette, and of any other publication of general interest published by the International Bureau in connection with the Treaty or these Regulations.

### **87.2 National Offices**

- (a) Any national Office shall have the right to receive, free of charge, one copy of every published international application, of the Gazette, and of any other publication of general interest published by the International Bureau in connection with the Treaty or these Regulations.
- (b) The publications referred to in paragraph (a) shall be sent on special request. If any publication is available in more than one language, the request shall specify the language or languages in which it is desired.

## **Rule 88—Amendment of the Regulations**

### **88.1 Requirement of Unanimity**

Amendment of the following provisions of these Regulations shall require that no State having the right to vote in the Assembly vote against the proposed amendment:

- (i) Rule 14.1 (Transmittal Fee),
- (ii) *[Deleted]*
- (iii) Rule 22.3 (Time Limit under Article 12(3)),
- (iv) Rule 33 (Relevant Prior Art for International Search),
- (v) Rule 64 (Prior Art for International Preliminary Examination),
- (vi) Rule 81 (Modification of Time Limits Fixed in the Treaty),
- (vii) the present paragraph (i.e., Rule 88.1).

### **88.2 *[Deleted]***

### **88.3 Requirement of Absence of Opposition by Certain States**

Amendment of the following provisions of these Regulations shall require that no State referred to in Article 58(3)(a)(ii) and having the right to vote in the Assembly vote against the proposed amendment:

- (i) Rule 34 (Minimum Documentation),
- (ii) Rule 39 (Subject Matter under Article 17(2)(a)(i)),
- (iii) Rule 67 (Subject Matter under Article 34(4)(a)(i)),
- (iv) the present paragraph (i.e., Rule 88.3).

### **88.4 Procedure**

Any proposal for amending a provision referred to in Rules 88.1 or 88.3 shall, if the proposal is to be decided upon in the Assembly, be communicated to all Contracting States at least two months prior to the opening of that session of the Assembly which is called upon to make a decision on the proposal.

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## Rule 89—Administrative Instructions

### 89.1 Scope

- (a) The Administrative Instructions shall contain provisions:
  - (i) concerning matters in respect of which these Regulations expressly refer to such Instructions,
  - (ii) concerning any details in respect of the application of these Regulations.
- (b) The Administrative Instructions shall not be in conflict with the provisions of the Treaty, these Regulations, or any agreement concluded by the International Bureau with an International Searching Authority, or an International Preliminary Examining Authority.

### 89.2 Source

- (a) The Administrative Instructions shall be drawn up and promulgated by the Director General after consultation with the receiving Offices and the International Searching and Preliminary Examining Authorities.
- (b) They may be modified by the Director General after consultation with the Offices or Authorities which have a direct interest in the proposed modification.
- (c) The Assembly may invite the Director General to modify the Administrative Instructions, and the Director General shall proceed accordingly.

### 89.3 Publication and Entry into Force

- (a) The Administrative Instructions and any modification thereof shall be published in the Gazette.
- (b) Each publication shall specify the date on which the published provisions come into effect. The dates may be different for different provisions, provided that no provision may be declared effective prior to its publication in the Gazette.

## Part F

### Rules Concerning Several Chapters of the Treaty

#### Rule 90—Agents and Common Representatives

##### 90.1 Appointment as Agent

- (a) A person having the right to practice before the national Office with which the international application is filed may be appointed by the applicant as his agent to represent him before that Office acting as the receiving Office and before the International Bureau, the International Searching Authority and the International Preliminary Examining Authority.
- (b) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority may

be appointed by the applicant as his agent to represent him specifically before that Authority.

- (c) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Preliminary Examining Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.
- (d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:
  - (i) before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed;
  - (ii) specifically before the International Searching Authority or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority or International Preliminary Examining Authority, as the case may be.

## **90.2 Common Representative**

- (a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a "common agent") under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 may be appointed by the other applicants as their common representative.
- (b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office shall be considered to be the common representative of all the applicants.

## **90.3 Effects of Acts by or in Relation to Agents and Common Representatives**

- (a) Any act by or in relation to an agent shall have the effect of an act by or in relation to the applicant or applicants concerned.
- (b) If there are two or more agents representing the same applicant or applicants, any act by or in relation to any of those agents shall have the effect of an act by or in relation to the said applicant or applicants.
- (c) Subject to Rule 90*bis*.5(a), second sentence, any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

**90.4 Manner of Appointment of Agent or Common Representative**

- (a) The appointment of an agent shall be effected by the applicant signing the request, the demand or a separate power of attorney. Where there are two or more applicants, the appointment of a common agent or common representative shall be effected by each applicant signing, at his choice, the request, the demand or a separate power of attorney.
- (b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be submitted to the International Searching Authority or the International Preliminary Examining Authority, as the case may be.
- (c) If the separate power of attorney is not signed, or if the required separate power of attorney is missing, or if the indication of the name or address of the appointed person does not comply with Rule 4.4, the power of attorney shall be considered non-existent unless the defect is corrected.

**90.5 General Power of Attorney**

- (a) Appointment of an agent in relation to a particular international application may be effected by referring in the request, the demand or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a “general power of attorney”), provided that:
  - (i) the general power of attorney has been deposited in accordance with paragraph (b), and
  - (ii) a copy of it is attached to the request, the demand or the separate notice, as the case may be; that copy need not be signed.
- (b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be deposited with the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

**90.6 Revocation and Renunciation**

- (a) Any appointment of an agent or common representative may be revoked by the persons who made the appointment or by their successors in title, in which case any appointment of a sub-agent under Rule 90.1(d) by that agent shall also be considered as revoked. Any appointment of a sub-agent under Rule 90.1(d) may also be revoked by the applicant concerned.
- (b) The appointment of an agent under Rule 90.1(a) shall, unless otherwise indicated, have the effect of revoking any earlier appointment of an agent made under that Rule.

- (c) The appointment of a common representative shall, unless otherwise indicated, have the effect of revoking any earlier appointment of a common representative.
- (c) An agent or a common representative may renounce his appointment by a notification signed by him.
- (e) Rule 90.4(b) and (c) shall apply, *mutatis mutandis*, to a document containing a revocation or renunciation under this Rule.

### Rule 90bis—Withdrawals

#### **90bis.1 Withdrawal of the International Application**

- (a) The applicant may withdraw the international application at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, prior to the expiration of 30 months from the priority date.
- (b) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.
- (c) No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

#### **90bis.2 Withdrawal of Designations**

- (a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies in respect of that State, prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90bis.4.
- (b) Where a State has been designated for the purpose of obtaining both a national patent and a regional patent, withdrawal of the designation for designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.
- (c) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90bis.1
- (d) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.
- (e) No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bu-

reau before the technical preparations for international publication have been completed.

### **90bis.3 Withdrawal of Priority Claims**

- (a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, 30 months from the priority date.
- (b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one or more or all of the priority claims.
- (c) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.
- (d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change.
- (e) In the case of the time limit referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for international publication.

### **90bis.4 Withdrawal of the Demand or of Elections**

- (a) The applicant may withdraw the demand or any or all elections at any time prior to the expiration of 30 months from the priority date.
- (b) Withdrawal shall be effective upon receipt of a notice addressed by the applicant to the International Bureau.
- (c) If the notice of withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

### **90bis.5 Signature**

- (a) Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, subject to paragraph (b), be signed by the applicant. Where one of the applicants is considered to be the common representative under Rule 90.2(b), such notice shall, subject to paragraph (b), require the signature of all the applicants.

- (b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4 need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and
- (i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or
  - (ii) in the case of a notice of withdrawal referred to in Rule 90*bis*.1(b), 90*bis*.2(d), or 90*bis*.3(c), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or
  - (iii) in the case of a notice of withdrawal referred to in Rule 90*bis*.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with, or did not sign the later election concerned but the requirements of Rule 56.1(c) were complied with.

#### **90*bis*.6 Effect of Withdrawal**

- (a) Withdrawal under Rule 90*bis* of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2).
- (b) Where the international application is withdrawn under Rule 90*bis*.1, the international processing of the international application shall be discontinued.
- (c) Where the demand or all elections are withdrawn under Rule 90*bis*.4, the processing of the international application by the International Preliminary Examining Authority shall be discontinued.

#### **90*bis*.7 Faculty under Article 37(4)(b)**

- (a) Any Contracting State whose national law provides for what is described in the second part of Article 37(4)(b) shall notify the International Bureau in writing.
- (b) The notification referred to in paragraph (a) shall be promptly published by the International Bureau in the Gazette, and shall have effect in respect of international applications filed more than one month after the date of such publication.

### **Rule 91—Obvious Errors in Documents**

#### **91.1 Rectification**

- (a) Subject to paragraphs (b) to (*g* *quater*), obvious errors in the international application or other papers submitted by the applicant may be rectified.

- (b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.
- (c) Omissions of entire elements or sheets of the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.
- (d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be an obvious error may invite the applicant to present a request for rectification as provided in paragraphs (e) to (*gquater*). Rule 26.4(a) shall apply *mutatis mutandis* to the manner in which rectifications shall be requested.
- (e) No rectification shall be made except with the express authorization:
  - (i) of the receiving Office if the error is in the request,
  - (ii) of the International Searching Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority,
  - (iii) of the International Preliminary Examining Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority, and
  - (iv) of the International Bureau if the error is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.
- (f) Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor. The authority which authorizes a rectification shall promptly notify the International Bureau accordingly. Where the authorization of the rectification was refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (*gbis*), (*gter*) or (*gquater*) and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification together with the international application. A copy of the request for rectification shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).
- (g) The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (*gbis*), (*gter*) and (*gquater*), be effective:
  - (i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;

- (ii) where it is given by the International Preliminary Examining Authority, if it is given before the establishment of the international preliminary examination report;
  - (iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.
- (*g bis*) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.
- (*g ter*) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.
- (*g quater*) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.

## Rule 92—Correspondence

### 92.1 Need for Letter and for Signature

- (a) Any paper submitted by the applicant in the course of the international procedure provided for in the Treaty and these Regulations, other than the international application itself, shall, if not itself in the form of a letter, be accompanied by a letter identifying the international application to which it relates. The letter shall be signed by the applicant.
- (b) If the requirements provided for in paragraph (a) are not complied with, the applicant shall be informed as to the non-compliance and invited to remedy the omission within a time limit fixed in the invitation. The time limit so fixed shall be reasonable in the circumstances; even where the time limit so fixed expires later than the time limit applying to the furnishing of the paper (or even if the latter time limit has already expired), it shall not be less than 10 days and not more than one month from the mailing of the invitation. If the omission is remedied within the time limit fixed in the invitation, the omission shall be disregarded; otherwise, the applicant shall be informed that the paper has been disregarded.

- (c) Where non-compliance with the requirements provided for in paragraph (a) has been overlooked and the paper taken into account in the international procedure, the non-compliance shall be disregarded.

## **92.2 Languages**

- (a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. Where the international application has been translated under Rule 12.1(c), the language of such translation shall be used.
- (b) Any letter from the applicant to the International Searching Authority or the International Preliminary Examining Authority may be in a language other than that of the international application, provided the said Authority authorizes the use of such language.
- (c) *[Deleted]*
- (d) Any letter from the applicant to the International Bureau shall be in English or French.
- (e) Any letter of notification from the International Bureau to the applicant or to any national Office shall be in English or French.

## **92.3 Mailings by National Offices and Intergovernmental Organizations**

Any document or letter emanating from or transmitted by a national Office or an intergovernmental organization and constituting an event from the date of which any time limit under the Treaty or these Regulations commences to run shall be sent by air mail, provided that surface mail may be used instead of air mail in cases where surface mail normally arrives at its destination within two days from mailing or where air mail service is not available.

## **92.4 Use of Telegraph, Teleprinter, Facsimile Machine, Etc.**

- (a) A document making up the international application, and any later document or correspondence relating thereto, may, notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraph (h), be transmitted, to the extent feasible, by telegraph, teleprinter, facsimile machine or other like means of communication producing a printed or written document.
- (b) A signature appearing on a document transmitted by facsimile machine shall be recognized for the purposes of the Treaty and these Regulations as a proper signature.
- (c) Where the applicant has attempted to transmit a document by any of the means referred to in paragraph (a) but part or all of the received document is illegible or part of the document is not received, the document shall be treated as not having been received to the extent that the received document is illegible or

that the attempted transmission failed. The national Office or intergovernmental organization shall promptly notify the applicant accordingly.

- (d) Any national Office or intergovernmental organization may require that the original of any document transmitted by any of the means referred to in paragraph (a) and an accompanying letter identifying that earlier transmission be furnished within 14 days from the date of the transmission, provided that such requirement has been notified to the International Bureau and the International Bureau has published information thereon in the Gazette. The notification shall specify whether such requirement concerns all or only certain kinds of documents.
- (e) Where the applicant fails to furnish the original of a document as required under paragraph (d), the national Office or intergovernmental organization concerned may, depending on the kind of document transmitted and having regard to Rules 11 and 26.3,
  - (i) waive the requirement under paragraph (d), or
  - (ii) invite the applicant to furnish, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation, the original of the document transmitted,provided that, where the document transmitted contains defects, or shows that the original contains defects, in respect of which the national Office or intergovernmental organization may issue an invitation to correct, that Office or organization may issue such an invitation in addition to, or instead of, proceeding under item (i) or (ii).
- (f) Where the furnishing of the original of a document is not required under paragraph (d) but the national Office or intergovernmental organization considers it necessary to receive the original of the said document, it may issue an invitation as provided for under paragraph (e)(ii).
- (g) If the applicant fails to comply with an invitation under paragraph (e)(ii) or (f):
  - (i) where the document concerned is the international application, the latter shall be considered withdrawn and the receiving Office shall so declare;
  - (ii) where the document concerned is a document subsequent to the international application, the document shall be considered as not having been submitted.
- (h) No national Office or intergovernmental organization shall be obliged to receive any document submitted by a means referred to in paragraph (a) unless it has notified the International Bureau that it is prepared to receive such a document by that means and the International Bureau has published information thereon in the Gazette.

## Rule 92bis—Recording of Changes in Certain Indications in the Request or the Demand

### **92bis.1 Recording of Changes by the International Bureau**

- (a) The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request or demand:
  - (i) person, name, residence, nationality or address of the applicant,
  - (ii) person, name or address of the agent, the common representative or the inventor.
- (b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration:
  - (i) of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;
  - (ii) of the time limit referred to in Article 39(1)(a), where Article 39(1) is applicable with respect to at least one Contracting State.

## Rule 93—Keeping of Records and Files

### **93.1 The Receiving Office**

Each receiving Office shall keep the records relating to each international application or purported international application, including the home copy, for at least 10 years from the international filing date or, where no international filing date is accorded, from the date of receipt.

### **93.2 The International Bureau**

- (a) The International Bureau shall keep the file, including the record copy, of any international application for at least 30 years from the date of receipt of the record copy.
- (b) The basic records of the International Bureau shall be kept indefinitely.

### **93.3 The International Searching and Preliminary Examining Authorities**

Each International Searching Authority and each International Preliminary Examining Authority shall keep the file of each international application it receives for at least 10 years from the international filing date.

### **93.4 Reproductions**

For the purposes of this Rule, records, copies and files shall also mean photographic reproductions of records, copies, and files, whatever may be the form of such reproductions (microfilms or other).

## Rule 94—Furnishing of Copies by the International Bureau and the International Preliminary Examining Authority

### 94.1 Obligation To Furnish

At the request of the applicant or any person authorized by the applicant, the International Bureau and the International Preliminary Examining Authority shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in the file of the applicant's international application or purported international application.

## Rule 95—Availability of Translations

### 95.1 Furnishing of Copies of Translations

- (a) At the request of the International Bureau, any designated or elected Office shall provide it with a copy of the translation of the international application furnished by the applicant to that Office.
- (b) The International Bureau may, upon request and subject to reimbursement of the cost, furnish to any person copies of the translations received under paragraph (a).

## Rule 96—The Schedule of Fees

### 96.1 Schedule of Fees Annexed to Regulations

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

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	762 Swiss francs
(b) if the international application contains more than 30 sheets	762 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	185 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 10 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	185 Swiss francs per designation
3. Confirmation Fee: (Rule 15.5(a))	50% of the sum of the designation fees payable under item 2(b)
4. Handling Fee: (Rule 57.2(a))	233 Swiss francs.

## Patents Amendment Act 1994

Public Act	1994 No 122
Date of assent	9 December 1994
Commencement	see section 1(2)

### 1 Short Title and commencement

- (1) This Act may be cited as the Patents Amendment Act 1994, and shall be read together with and deemed part of the Patents Act 1953 (hereinafter referred to as “the principal Act”).
- (2) This Act shall come into force on a date to be appointed by the Governor-General by Order in Council; and 1 or more orders may be made bringing different provisions into force on different dates.

Section 1(2): this Act brought into force, on 1 January 1995, by the Patents Amendment Act Commencement Order 1994 (SR 1994/302).

### 17 Transitional provisions

- (1) Nothing in this Act applies to or affects—
  - (a) any proceedings for revocation of a patent commenced before the commencement of this Act;
  - (b) any proceedings for infringement of a patent commenced before the commencement of this Act;
  - (c) any existing licences or applications for licences of right under section 46 of the principal Act in existence or made before the commencement of this Act;
  - (d) any application for the extension of the term of a patent made before the commencement of this Act;
  - (e) any reference to the court under section 57 of the principal Act made before the commencement of this Act;
  - (f) subject to subsection (2), any application for a patent in respect of which a complete specification has been filed before the commencement of this Act,—

and any such proceedings, licences, applications, or references to the court shall continue as if this Act had not been enacted.

- (2) Where, in respect of an application for a patent, a complete specification has not been advertised under section 20(2) of the principal Act before the commencement of this Act, the application must be determined in accordance with the principal Act (as amended by this Act) if the applicant gives notice to the Commissioner in accordance with subsection (3) of this section, requesting that the application be determined in accordance with the principal Act (as so amended).

- (3) Any notice under subsection (2)—
- (a) must be in the prescribed form:
  - (b) must be accompanied by the prescribed fee:
  - (c) must be given on or before the date falling 6 months after the commencement of this Act, or on or before the date of grant of the patent, whichever occurs first.

**18 Term of existing patents**

- (1) Subject to subsections (2) and (3), the term of every patent that has not expired before the commencement of this Act shall, notwithstanding anything contained in the principal Act, be deemed to be 20 years from the date of the patent.
- (2) Nothing in subsection (1) applies to a patent the term of which has, before the commencement of this Act, been extended by the court or the Commissioner for a period exceeding 20 years from the date of the patent.
- (3) Nothing in subsection (1) applies to a patent the term of which is extended by the court or the Commissioner for a period exceeding 20 years from the date of the patent pursuant to an application for the extension of the term of the patent made before the commencement of this Act.

## Patents Act 2013

Public Act	2013 No 68
Date of assent	13 September 2013
Commencement	see section 2

### 1 Title

This Act is the Patents Act 2013.

### 2 Commencement

- (1) The following provisions of this Act come into force on the day after the date on which this Act receives the Royal assent:
  - (a) section 1 and this section:
  - (b) Part 1 (which contains the preliminary provisions):
  - (c) subpart 3 of Part 5 (which relates to the establishment and operation of the administrative bodies under this Act):
  - (d) subpart 5 of Part 5 (which contains the regulation-making powers):
  - (e) section 266(1) (which appoints the Commissioner and Assistant Commissioners of Patents under the Patents Act 1953 as the new Commissioner and Assistant Commissioners).
- (2) The rest of this Act comes into force on a date to be appointed by the Governor-General by Order in Council; and 1 or more orders may be made bringing different provisions into force on different dates.
- (3) To the extent that it is not previously brought into force under subsection (1) or (2), the rest of this Act comes into force on the first anniversary of the date on which this Act receives the Royal assent.

## Part 1

### Preliminary

#### *Purposes and overview*

### 3 Purposes

The purposes of this Act are to—

- (a) provide an efficient and effective patent system that—
  - (i) promotes innovation and economic growth while providing an appropriate balance between the interests of inventors and patent owners and the interests of society as a whole; and
  - (ii) complies with New Zealand's international obligations; and

- (b) ensure that a patent is granted for an invention only in appropriate circumstances by—
  - (i) establishing appropriate criteria for the granting of a patent; and
  - (ii) providing for procedures that allow the validity of a patent to be tested; and
- (c) provide greater certainty for patent owners and the users of patented inventions that patents will be valid after they are granted; and
- (d) address Māori concerns relating to the granting of patents for inventions derived from indigenous plants and animals or from Māori traditional knowledge; and
- (e) ensure that New Zealand’s patent legislation takes account of developments in the patent systems of other countries.

## Part 5

### Administrative and miscellaneous provisions

#### Subpart 6—Repeals, amendments, validation, and saving and transitional provisions

##### *Transitional provisions for patents and patent applications*

#### 253 Outline of transitional provisions for patents

- (1) The general scheme and effect of the transitional provisions for patents on and from the commencement of Part 3 of this Act (**commencement**) is as follows:
  - (a) this Act applies to patents granted under the Patents Act 1953 (but patents retain their existing key dates, term, and grounds for revocation);
  - (b) patent applications made under the Patents Act 1953 continue to be dealt with under that Act unless a complete specification is filed on or after commencement and, in this case, the complete specification may be filed only under this Act and this Act then applies to the patent application;
  - (c) Treaty applications—
    - (i) continue to be dealt with under the Patents Act 1953 if the applicant has fulfilled the applicant’s obligations under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty before commencement; and
    - (ii) must be dealt with under this Act if the applicant did not fulfil those obligations before that time;
  - (d) there are particular transitional provisions for post-dated applications and divisional applications.

- (2) This section is a guide only to the general scheme and effect of the transitional provisions for patents.

**254 Transitional provision for patents granted under Patents Act 1953**

- (1) This Act applies to a patent granted under the Patents Act 1953 as if it were granted under this Act.
- (2) However,—
- (a) the patent retains its original date of filing of the patent application, patent date (that is the date of filing of the complete specification), priority date or dates, date of the publication of the accepted complete specification, date that the patent was granted, and date that the next renewal fee was due under the Patents Act 1953; and
  - (b) the patent retains its existing term; and
  - (c) the next renewal fee (after this section comes into force) must be paid when due in accordance with the Patents Act 1953 but, after that due date, renewal fees become due in accordance with this Act; and
  - (d) on a re-examination of the patent application and the complete specification under section 95, the grounds that a person may specify in a request for re-examination, and that the Commissioner may consider and report on, are the grounds in section 41(1) of the Patents Act 1953 (rather than the grounds in section 114 of this Act); and
  - (e) the Commissioner or the court may revoke the patent under this Act only on the grounds set out in section 41(1) or (3) of the Patents Act 1953, and those grounds are available as grounds of defence in a proceeding for the infringement of the patent (rather than the grounds in section 114 of this Act); and
  - (f) section 146 of this Act does not apply; and
  - (g) in relation to any existing endorsement of the patent under section 44 of the Patents Act 1953,—
    - (i) the repeals in section 247 do not affect the endorsement; and
    - (ii) sections 44 and 45 of the Patents Act 1953 continue to apply to the patent for the purposes of the endorsement, as if sections 247 to 249 were not in force (and accordingly, renewal fees remain at one-half of the fees otherwise payable under this Act while the patent is so endorsed).

**255 Patent applications made under Patents Act 1953 continue under that Act**

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if sections 247 to 249 were not in force, for the purposes of—

- (a) a patent application made under that Act before the commencement of Part 3 of this Act:
  - (b) the bringing and completion of any application, request, notice, or other proceeding relating to that application (whether commenced before or after the commencement of Part 3 of this Act).
- (2) Any reference in any other enactment to a repealed provision of the Patents Act 1953 (or a revoked provision of any regulations made under it) continues to apply for the purposes of subsection (1) as if the reference had not been repealed or amended by this Act.
- (3) Section 254 applies to any patent granted under the Patents Act 1953 in respect of that application.
- (4) This section is subject to sections 256, 257, and 259.

**256 Patents Act 1953 ceases to apply to patent application if complete specification later filed**

- (1) Despite section 255,—
- (a) a complete specification may not be filed under the Patents Act 1953 on or after the commencement of Part 3 of this Act (unless section 258 applies to the complete specification); and
  - (b) the complete specification must instead comply with, and be filed under, this Act; and
  - (c) on and from the date on which the complete specification is filed, this Act applies in respect of the patent application (and any application, request, notice, or other proceeding relating to it) as if it were made under this Act (including as to the priority date).
- (2) Subsection (1) applies whether the complete specification is filed for one of the following reasons or any other reason:
- (a) only a provisional specification was filed before that commencement; or
  - (b) the original complete specification was directed (whether before or after that commencement) to be treated as a provisional specification under section 9(4) of the Patents Act 1953.
- (3) If a complete specification is provided for 2 or more patent applications that are cognate or of which one is a modification of another, this section applies to those 2 or more patent applications.

**257 This Act applies if patent application under Patents Act 1953 is post-dated**

If a patent application made under the Patents Act 1953 is post-dated to a date that is on or after the commencement of Part 3 of this Act, this Act applies to the patent application as if the patent application had been made under this Act.

**258 Patents Act 1953 applies to divisional applications dated before commencement**

- (1) This section applies to a fresh patent application that is made on or after the commencement of Part 3 of this Act (and any complete specification that is filed at the same time) if—
  - (a) the fresh patent application is made for any part of the subject matter of a patent application to which the Patents Act 1953 applies under section 255 or 259; and
  - (b) the fresh patent application is given a date before that commencement.
- (2) The fresh patent application must be treated as a patent application made under the Patents Act 1953 (and section 255 applies to it) and the complete specification must be treated as having been filed on the date given to the fresh patent application.

**259 Which Act applies to Treaty applications**

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if sections 247 to 249 were not in force, for the purposes of—
  - (a) a Treaty application if the applicant fulfilled the applicant's obligations under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty before the commencement of Part 3 of this Act;
  - (b) the bringing and completion of any application, request, notice, or other proceeding relating to that application (whether commenced before or after the commencement of Part 3 of this Act).
- (2) Any reference in any other enactment to a repealed provision of the Patents Act 1953 (or a revoked provision of any regulations made under it) continues to apply for the purposes of subsection (1) as if the reference had not been repealed or amended by this Act.
- (3) Section 254 applies to any patent granted under the Patents Act 1953 in respect of that application.
- (4) However, this Act applies to a Treaty application if the applicant did not fulfil those obligations before the commencement of Part 3.

*Transitional provisions for other applications, notices, and requests***260 Transitional provision for other applications, notices, or requests**

- (1) The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply, as if sections 247 to 249 were not in force, for the purposes of completing any application, notice, or request that was received by the Commissioner or the court, or completing any other proceeding commenced, before the commencement of Part 3 of this Act.

- (2) Subsection (1) does not apply to a patent application, or an application, notice, request, or other proceeding relating to a patent application, to which any of sections 255 to 259 apply.
- (3) If the Patents Act 1953 continues to apply to an application, notice, or request under this section, any reference in any other enactment to a repealed provision of the Patents Act 1953 (or a revoked provision of any regulations made under it) continues to apply for that purpose as if the reference had not been repealed or amended by this Act.

*Transitional provision for matters in force on commencement*

**261 Transitional provision for orders, directions, and other matters in effect on transition to new law**

- (1) Any order, direction, or other matter made under a repealed provision of the Patents Act 1953, and that is in effect immediately before its transition takes effect under subsection (3), continues to have effect as if it had been made under the provision of this Act—
  - (a) that, with or without modification, replaces, or that corresponds to, the provision of the Patents Act 1953 under which it was made; and
  - (b) under which it could be made.
- (2) The order, direction, or other matter may be amended or revoked as if it had been made under the provision of this Act that replaces, or that corresponds to, the provision of the Patents Act 1953 under which it was made.
- (3) The transition of an order, direction, or other matter takes effect for the purposes of this section on the later of the following:
  - (a) on the repeal of the provision under which the order, direction, or other matter is made; or
  - (b) if this Part provides, or regulations made under section 245 provide, that the order, direction, or other matter continues to apply after the repeal of the provision under which it is made, when it ceases to so continue to apply.

*Transitional provision for patents register*

**262 Transitional provision for patents register**

The register of patents kept under section 83 of the Patents Act 1953 continues to have effect as the patents register kept under section 194 of this Act.

*Transitional provisions for offences and infringements***263 Transitional provision for offences and infringements**

The Patents Act 1953 (and the regulations, orders, directions, and other matters made under it) continues to apply (as if sections 247 to 249 were not in force) for the purpose of—

- (a) investigating any offence or infringement committed before the commencement of this section:
- (b) commencing or completing any proceeding for any offence or infringement committed before the commencement of this section:
- (c) imposing a penalty or granting any relief or other remedy for any offence or infringement committed before the commencement of this section.

*Transitional provisions as to statutory references***264 Transitional provision as to statutory references to corresponding matters**

If provided by the regulations, a specified reference to this Act (or to a defined term or other matter in this Act) includes a reference to the Patents Act 1953 (or to a corresponding or replaced specified term or matter under the Patents Act 1953) (for example, the regulations may specify that the reference in section 8(2) to another patent application includes, for the purpose of determining the prior art base under that section, a patent application made under the Patents Act 1953).

**265 Transitional provision as to repealed references to Commissioner, journal, or Patent Office**

Any reference to the Commissioner, the Journal, or the Patent Office in a provision that is repealed or revoked but continues to apply to any matter under this subpart must be read as a reference to the Commissioner or journal under this Act or to IPONZ (as the case may be).

*Transitional provisions for Commissioner and Assistant Commissioners***266 Transitional appointment of Commissioner and Assistant Commissioners**

- (1) The persons holding office as the Commissioner and Assistant Commissioners under the Patents Act 1953 are treated as having been appointed as the Commissioner and Assistant Commissioners under this Act on the commencement of this subsection (and may hold both offices concurrently).
- (2) The persons holding office as the Commissioner and Assistant Commissioners under the Designs Act 1953 continue to hold those offices despite the repeal and substitution of sections 3 and 4 of that Act.

**267 Transitional power for Commissioner**

- (1) The Commissioner may, for the purpose of facilitating the transition from the Patents Act 1953 to this Act, do any of the following in connection with a patent application, other application, notice, or request originally made under the Patents Act 1953 and to which this Act now applies:
  - (a) exempt a person (on the terms and conditions (if any) that the Commissioner thinks fit) from any statutory requirement that applied or now applies to the application, notice, or request:
  - (b) give a person additional time to comply with a statutory requirement in respect of the application, notice, or request that previously did not apply.
- (2) In this section, **statutory requirement** means a requirement under the Patents Act 1953 or this Act, or under any regulations, orders, directions, or other matters made under either Act.
- (3) This section expires on close of the day that is 3 years after the commencement of this section.

## Reprints notes

### 1 *General*

This is a reprint of the Patents Act 1953 that incorporates all the amendments to that Act as at the date of the last amendment to it.

### 2 *Legal status*

Reprints are presumed to correctly state, as at the date of the reprint, the law enacted by the principal enactment and by any amendments to that enactment. Section 18 of the Legislation Act 2012 provides that this reprint, published in electronic form, has the status of an official version under section 17 of that Act. A printed version of the reprint produced directly from this official electronic version also has official status.

### 3 *Editorial and format changes*

Editorial and format changes to reprints are made using the powers under sections 24 to 26 of the Legislation Act 2012. See also <http://www.pco.parliament.govt.nz/editorial-conventions/>.

### 4 *Amendments incorporated in this reprint*

Patents (Trans-Tasman Patent Attorneys and Other Matters) Amendment Act 2016 (2016 No 89): section 7(1)

Patents Act 2013 (2013 No 68): sections 247(1), 249

Criminal Procedure Act 2011 (2011 No 81): section 413

Lawyers and Conveyancers Act 2006 (2006 No 1): section 348

Patents Amendment Act 1999 (1999 No 119)

Patents Amendment Act 1996 (1996 No 139)

Patents Amendment Act 1994 (1994 No 122)

Patents Amendment Act 1992 (1992 No 81)

Regulations (Disallowance) Act 1989 (1989 No 143): section 11

Public Finance Act 1989 (1989 No 44): section 86(1)

Trade and Industry Act Repeal Act 1988 (1988 No 156): section 4(1)

Judicature Amendment Act 1979 (1979 No 124): section 12

Crimes Act 1961 (1961 No 43): section 411(1)

Summary Proceedings Act 1957 (1957 No 87): section 214(1)

Patents Act Commencement Order 1954 (SR 1954/220)