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TRADE AND  
COMMERCE



Treaty Series No. 27 (2001)

# Amendments

to the

# Regulations under the Patent Cooperation Treaty (PCT)

adopted by the Assembly of the International Patent  
Cooperation Union (PCT Union) at its Twenty-eighth  
(16th Extraordinary) Session on March 17, 2000, with  
effect March 1, 2001

[The Amendments entered into force on 1 March 2001]

*Presented to Parliament  
by the Secretary of State for Foreign and Commonwealth Affairs  
by Command of Her Majesty  
May 2001*

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**AMENDMENTS TO THE REGULATIONS UNDER THE  
PATENT COOPERATION TREATY (PCT)<sup>1</sup>**

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<sup>1</sup> Treaty Series No. 78 (1978) Cmnd 7340.  
Previous amendments were published as:  
Treaty Series No. 44 (1985) Cmnd 9604,  
Treaty Series No. 20 (1993) Cm 2179,  
Treaty Series No. 40 (1994) Cm 2647,  
Treaty Series No. 40 (1996) Cm 3236 and  
Treaty Series No. 14 (2001) Cm 5047.

<sup>2</sup> The Rules as amended will apply, as explained in and subject to the following items, to international applications irrespective of when they are filed (that is, whether they are filed before, on or after 1 March 2001):  
(i) the provisions providing for certain declarations under new Rule 4.17, and the related provisions of new or amended Rules 4.1(c)(iii), 4.5(e), 4.6(a), 4.7(b), 4.18, 26ter, 47.1(a-ter), 48.2(a)(x) and (b)(iv), and 51bis.2, will not apply, subject to items (ii) and (iii), to international applications filed before 1 March 2001;  
(ii) new Rule 26ter will apply to international applications filed before 1 March 2001, to the extent that it will permit the applicant to add a declaration to the request, and new Rule 4.17 and the related provisions mentioned in item (i) will apply in respect of such an added declaration;  
(iii) amended Rule 51bis.2 will apply to international applications filed before 1 March 2001, which enter the national phase on or after 1 March 2001, in respect of which indications concerning the inventor are included in the request or a declaration is added to the request under Rule 26ter or submitted directly to the designated Office.

## AMENDMENTS<sup>1</sup>

### Rule 4

#### The Request (Contents)

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

(a) and (b) [No change]

(c) The request may contain:

(i) [No Change]

(ii) a request to the receiving Office to prepare and transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office of intergovernmental authority which is the receiving Office,

(iii) declarations as provided in Rule 4.17

(d) [No change]

4.2 to 4.4 [No change]

##### 4.5 *The Applicant*

(a) to (d) [No change]

(e) Where the applicant is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the applicant is so registered.

##### 4.6 *The Inventor*

(a) Where Rule 4.1(a)(v) or (c)(i) applies, the request shall indicate the name and address of the inventor or, if there are several inventors, of each of them.

(b) and (c) [No change]

##### 4.7 *The Agent*

(a) If an agent is appointed, the request shall so indicate, and shall state the agent's name and address.

(b) Where the agent is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the agent is so registered.

##### 4.8 *Common Representative*

If a common representative is appointed, the request shall so indicate

4.9 to 4.16 [No change]

##### 4.17 *Declarations Relating to National Requirements Referred to in Rule 51bis.1(a)(i) to (v)*

The request may, for the purposes of the national law applicable in one or more designated States, contain one or more of the following declarations, worded as prescribed by the Administrative Instructions:

(i) a declaration as to the identity of the inventor, as referred to in Rule 51bis.1(a)(i);

(ii) a declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent, as referred to in Rule 51bis.1(a)(ii);

(iii) a declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application, as referred to in Rule 51bis.1(a)(iii);

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

- (iv) a declaration of inventorship, as referred to in Rule 51*bis*.1(a)(iv), which shall be signed as prescribed by the Administrative Instructions;
- (v) a declaration as to non-prejudicial disclosures or exceptions to lack of novelty, as referred to in Rule 51*bis*.1(a)(v).

#### 4.18 *Additional Matter*

- (a) The request shall contain no matter other than that specified in Rules 4.1 to 4.17, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.
- (b) If the request contains matter other than that specified in Rules 4.1 to 4.17 or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

### **Rule 26*ter***

#### **Correction or Addition of Declarations Under Rule 4.17**

##### *26ter.1 Correction or Addition of Declarations*

The applicant may correct or add to the request any declaration referred to in Rule 4.17 by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

##### *26ter.2 Processing of Declarations*

- (a) Where the receiving Office or the International Bureau finds that any declaration referred to in Rule 4.17 is not worded as required or, in the case of the declaration of inventorship referred to in Rule 4.17(iv), is not signed as required, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within a time limit of 16 months from the priority date.
- (b) Where the International Bureau receives any declaration or correction under Rule 26*ter*.1 after the expiration of the time limit under Rule 26*ter*.1, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions.

### **Rule 47**

#### **Communication to Designated Offices**

##### *47.1 Procedure*

- (a) and (a-*bis*) [No change]

(a-*ter*) The Notification under paragraph (a-*bis*) shall include any declaration referred to in Rule 4.17(i) to (iv), and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1, provided that the designated Office has informed the International Bureau that the applicable national law requires the furnishing of documents or evidence relating to the matter to which the declaration relates.

- (b) to (e) [No change]

47.2 to 47.4 [No change].

## Rule 48

### International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (viii) [No change]

(ix) any information concerning a priority claim considered not to have been made under Rule 26*bis*.2(b), the publication of which is requested under Rule 26*bis*.2(c),

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1.

(b) Subject to paragraph (c), the front page shall include:

(i) and (ii) [No change]

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first,

(iv) an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under rule 26*ter*.1.

(c) to (i) [No change]

48.3 to 48.6 [No change]

## Rule 51*bis*

### Certain National Requirements Allowed Under Article 27

51*bis*.1 *Certain National Requirements Allowed*

(a) Subject to Rule 51*bis*.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) any document relating to the identity of the inventor,

(ii) any document relating to the applicant's entitlement to apply for or be granted a patent,

(iii) any document containing any proof of the applicant's entitlement to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed,

(iv) where the international application designates a State whose national law requires that national applications be filed by the inventor, any document containing an oath or declaration of inventorship,

(v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

(b) and (c) [No change]

(d) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the translation of the international application furnished by the applicant under Article 22 be:

(i) verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful;

(ii) certified by a public authority or sworn translator, but only where the designated Office may reasonably doubt the accuracy of the translation.

- (e) The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.
- (f) If, on March 17 2000, the proviso in paragraph (e) is not compatible with the national law applied by the designated Office, that proviso shall not apply in respect of that Office for as long as that proviso continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30 2000. The information received shall be promptly published by the International Bureau in the Gazette.

*51bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required*

- (a) Where the applicable national law does not require that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:
  - (i) relating to the identity of the inventor (Rule 51bis.1(a)(i)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is concerned in the request or is submitted directly to the designated Office;
  - (ii) relating to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rule 51bis.1(a)(ii)), if a declaration as to that matter, in accordance with Rule 4.17(ii), is contained in the request or is submitted directly to the designated Office;
  - (iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office.
- (b) Where the applicable national law requires that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:
  - (i) relating to the identity of the inventor (Rule 51bis.1.(a)(i))(other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request;
  - (ii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;
  - (iii) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.
- (c) If, on March 17 2000, paragraph (a) is not compatible, in relation to any item of that paragraph, with the national law applied by the designated Office, paragraph (a) shall not apply in respect of that Office in relation to that item for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30 2000. The information received shall be promptly published by the International Bureau in the Gazette.

*51bis.3 Opportunity to Comply with National Requirements*

- (a) Where any of the requirements referred to in Rule 51bis.1(a)(i) to (iv) and (c) to (e), or any other requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27(1) or (2), is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the designated Office shall invite the applicant to comply with the

requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for complying with national requirements in response to the invitation.

- (b) Where any requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27(6) or (7) is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.
- (c) If, on March 17 2000, paragraph (a) is not compatible with the national law applied by the designated Office in relation to the time limit referred to in that paragraph, the said paragraph shall not apply in respect of that Office in relation to that time limit for as long as the said paragraph continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30 2000. The information received shall be promptly published by the International Bureau in the Gazette.

### **Rule 53**

#### **The Demand**

53.1 to 53.4 [No change]

#### *53.5 Agent or Common Representative*

If an agent or common representative is appointed, the demand shall so indicate. Rules 4.4 and 4.16 shall apply, and Rule 4.7 shall apply *mutatis mutandis*.

53.6 to 53.9 [No change]

### **Rule 66**

#### **Procedure Before the International Preliminary Examining Authority**

66.1 to 66.6 [No change]

#### *66.7 Priority Document*

(a) [No change]

- (b) If the application whose priority is claimed in the international application is in a language other than the language or one of the languages of the International Preliminary Examining Authority, that Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish a translation in the said language or one of the said languages within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

66.8 and 66.9 [No change]

