



Treaty Series No. 32 (2006)

# Amendments to the Regulations under the Patent Cooperation Treaty (PCT)

Adopted by the Assembly of the International Patent Cooperation Union  
(PCT Union) at its thirty-fourth (15<sup>th</sup> ordinary) session on October 5,  
2005, with effect from April 1, 2006

Geneva, 5 October 2005

[The Amendments entered into force on 1 April 2006]

*Presented to Parliament  
by the Secretary of State for Foreign and Commonwealth Affairs  
by Command of Her Majesty  
December 2006*

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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) Cm 7340. Previous amendments were published as: Treaty Series No.44 (1985) Cm 9604, Treaty Series No.20 (1993) Cm 2179, Treaty Series No.40 (1994) Cm 2647, Treaty Series No.40 (1996) Cm 3236, Treaty Series No.14 (2001) Cm 5047, Treaty Series No.27 (2001) Cm 5140 and Treaty Series No.1 (2004) Cm 6100.

<sup>2</sup> The Rules as amended:

- (a) shall enter into force on April 1, 2006, and shall apply to international applications whose international filing date is on or after April 1, 2006;
- (b) shall not apply to international applications whose international filing date is before April 1, 2006, provided that:
  - (i) Rules 13*bis*.4, 47.1, 48.1 and 48.2 as amended shall apply to international applications whose international filing date is before April 1, 2006, and which are published under Article 21 on or after April 1, 2006;
  - (ii) Rules 26*bis*.2 and 91.1 as amended shall apply to international applications whose international filing date is before April 1, 2006 and whose communication under Article 20 is on or after April 1, 2006;
  - (iii) Rules 86.1 and 86.2 as amended shall apply to issues of the Gazette published on or after April 1, 2006, regardless of the international filing dates of the international applications to which those issues relate;
  - (iv) Rules 87.1 and 87.2 as amended shall apply to the communication of international applications, the Gazette and other publications on or after April 1, 2006, regardless, where applicable, of the international filing dates of the international applications concerned.

## AMENDMENTS<sup>1</sup>

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

4.1 to 4.8 [No change]

#### *4.9 Designation of States; Kinds of Protection; National and Regional Patents*

(a) [No change]

(b) Notwithstanding paragraph (a)(i), if, on October 5, 2005, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request in which the priority of an earlier national application filed in that State is claimed may contain an indication that the designation of that State is not made, provided that the designated Office notifies the International Bureau by January 5, 2006, that this paragraph shall apply in respect of designations of that State and that the notification is still in force on the international filing date. The information received shall be promptly published by the International Bureau in the Gazette.

4.10 to 4.18 [No change]

### **Rule 13bis Inventions Relating to Biological Material**

13bis.1 to 13bis.3 [No change]

#### *13bis.4 References: Time Limit for Furnishing Indications*

(a) to (c) [No change]

(d) The International Bureau shall notify the applicant of the date on which it received any indication furnished under paragraph (a), and:

(i) if the indication was received before the technical preparations for international publication have been completed, publish the indication

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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.

furnished under paragraph (a), and an indication of the date of receipt, together with the international application;

(ii) [No change]

13bis.5 to 13bis.7 [No change]

**Rule 26bis**  
**Correction or Addition of Priority Claim**

26bis.1 [No change]

*26bis.2 Invitation to Correct Defects in Priority Claims*

(a) and (b) [No change]

(c) Where the receiving Office or the International Bureau has made a declaration under paragraph (b), the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning the priority claim which was considered not to have been made. A copy of that request shall be included in the communication under Article 20 where the international application is not published by virtue of Article 64(3).

**Rule 47**  
**Communication to Designated Offices**

*47.1 Procedure*

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

(a-ter) [Deleted]

(b) to (e) [No change]

47.2 to 47.4 [No change]

**Rule 48**  
**International Publication**

48.1 *Form and Means*

The form in which and the means by which international applications are published shall be governed by the Administrative Instructions.

48.2 *Contents*

- (a) The publication of the international application 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);
  - (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) the indications in relation to deposited biological material furnished under Rule 13*bis* separately from the description, together with an indication of the date on which the International Bureau received such indications;
  - (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, 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) to (e) [No change]
- (f) If the claims have been amended under Article 19, the publication of the international application shall contain the full text of the claims both as filed and

as amended. 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, the front page shall contain an indication to the effect that that report was not available and that the international search report (when it becomes available) will be separately published together with a revised front page.
- (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 front page shall refer to that fact and indicate that, should the claims be amended under Article 19, then, promptly after receipt by the International Bureau of such amendments within the time limit under Rule 46.1, the full text of the claims as amended will be published together with a revised front page. 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) [Deleted]

### 48.3 *Languages of Publication*

- (a) If the international application is filed in Arabic, Chinese, English, French, German, Japanese, Russian or Spanish ("languages of publication"), that application shall be published in the language in which it was filed.

(b) and (c) [No change]

48.4 to 48.6 [No change]

## **Rule 86 The Gazette**

### 86.1 *Contents*

The Gazette referred to in Article 55(4) shall contain:

- (i) for each published international application, the data specified by the Administrative Instructions taken from the front page of the publication of the international application, 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) [No change]

86.2 *Languages; Form and Means of Publication; Timing*

- (a) The Gazette shall be published in English and French at the same time. The translations shall be ensured by the International Bureau in English and French.
- (b) [No change]
- (c) The form in which and the means by which the Gazette is published shall be governed by the Administrative Instructions.
- (d) The International Bureau shall ensure that, for each published international application, the information referred to in Rule 86.1(i) is published in the Gazette on, or as soon as possible after, the date of publication of the international application.

86.3 to 86.6 [No change]

**Rule 87**  
**Communication of Publications**

87.1 *Communication of Publications on Request*

The International Bureau shall communicate, free of charge, every published international application, the Gazette and any other publication of general interest published by the International Bureau in connection with the Treaty or these Regulations, to International Searching Authorities, International Preliminary Examining Authorities and national Offices upon request by the Authority or Office concerned. Further details concerning the form in which and the means by which publications are communicated shall be governed by the Administrative Instructions.



87.2 [Deleted]

**Rule 91**  
**Obvious Errors in Documents**

91.1 *Rectification*

(a) to (e) [No change]

- (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 (*g-bis*), (*g-ter*) or (*g-quater*) 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 the international application is not published by virtue of Article 64(3).

(g) to (*g-quater*) [No change]



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