

ELECTRONIC PROCESSING OF INTERNATIONAL APPLICATIONS

1. This non-paper contains revised draft amendments to Rules concerning electronic processing of international applications.
2. The changes compared to document PCT/WG/18/8 are **highlighted**. The differences are:
 - (a) The proposed amendment to Rule 4.1(a)(iv) and the consequential amendments to Rules 4.1(c) and 4.6 are withdrawn – as a matter of fact, the provision of inventor information in the request form is already optional, but the International Bureau will look further into the question of how the Rules and receiving Offices should encourage applicants to provide this information.
 - (b) It is proposed to maintain the words “In order to allow rapid communication with the applicant” in Rule 4.4(c) – in practice, the email address will be used in most cases by the International Bureau routinely to send secure links (as well as email attachments for applicants choosing to continue to receive these), but it remains a valid statement of reasoning, irrespective of the use to which the information is put.
 - (c) It is proposed to include the same words into Rule 92*bis*.1(a) as were proposed for Rule 92*bis*.1(c), clarifying the person to whom correspondence is addressed. Modifications to the Receiving Office Guidelines might also be considered to provide further clarification of special cases.
 - (d) Rule 92*bis*.1(c) has a reference added to Rule 93.1, introducing a final backstop to the date by which changes can be made. The International Bureau notes that this time (10 years) might risk suggesting that changing the address at a very late date might be useful to applicants, when in fact it can only be relevant while leftovers of international phase processing remain – however, it is difficult to identify a better cutoff date, noting that by its nature, this provision relates to exceptional cases where the processing has not gone as expected.
3. No changes are made to the proposals concerning mandatory provision of email address and telephone number, nor to the proposals concerning exclusion of personal data from public access. In these respects it is noted that:
 - (a) A telephone number is important information to the International Bureau in order to provide good customer service in urgent cases (including where sending of email fails). Neither email addresses nor telephone numbers should be difficult for an applicant to provide.
 - (b) It would not be necessary for receiving Offices and International Authorities to use email addresses and telephone numbers to contact applicants simply because their provision is mandatory. It remains up to each Office to decide the most appropriate means for contacting their applicants, provided that use of the system remains sufficiently accessible.

(c) While it would be desirable in theory to specify provisions concerning exclusion of personal data from public access more strictly within the Rule, to do so would involve a much longer timescale to deliver the first benefits to applicants and several years again to be able to deliver further improvements. Providing an arrangement where an Administrative Instruction can allow for hiding of the most important measure as soon as Offices are able to update stylesheets will allow for a first step, with the ability to open the way to further improvements when appropriate technical standards can be approved and implemented.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

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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) [No change] 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) indications relating to an earlier search as provided in Rules 4.12(i) and 12bis.1(b) and (d),
- (iii) a reference to a parent application or parent patent,
- (iv) an indication of the applicant's choice of competent International Searching Authority.

(c) The request may contain:

(i) [No change] 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 prepare and 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,

- (iii) declarations as provided in Rule 4.17,
- (iv) a statement as provided in Rule 4.18,

[Rule 4.1(c), continued]

- (v) a request for restoration of the right of priority,
 - (vi) a statement as provided in Rule 4.12(ii).
- (d) The request shall be signed.

4.2 and 4.3 *[No change]*

4.4 *Names and Addresses*

(a) [No change] 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) [No change] 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 communication, of the applicant or, where applicable, the agent or the common representative. an email address and telephone number shall be provided for at least one person to whom correspondence is to be addressed, being the agent, if appointed, or otherwise the applicant or common representative.**

[COMMENT: It does not appear to be necessary to retain a reference to facsimile numbers and corresponding data in paragraph (c). Rule 4.19 provides a basis for including fields for such data in the request form as optional matter, but facsimile communication is no longer recommended and if email address and telephone number are mandatory, there is no need to recommend any other communication details.]

(d) [No change] 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 *[No change]*

4.6 *The Inventor*

(a) **[No change]** Where Rule 4.1(a)(iv) 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) 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 to 4.19 *[No change]*

Rule 45bis
Supplementary International Searches

45bis.1 Supplementary Search Request

(a) [No change]

(b) A request under paragraph (a) (“supplementary search request”) shall be submitted to the International Bureau and shall indicate:

(i) the name and address of the applicant and of the agent (if any), the title of the invention, the international filing date and the international application number; [Rule 4.4 shall apply mutatis mutandis](#);

(ii) the International Searching Authority that is requested to carry out the supplementary international search (“Authority specified for supplementary search”); and

(iii) where the international application was filed in a language which is not accepted by that Authority, whether any translation furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search.

(c) to (e) [No change]

45bis.2 to 45bis.9 [No change]

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.

provided that following the changes, an email address and telephone number remain available for at least one person to whom correspondence is to be addressed, being the agent, applicant or common representative, as applicable.

(b) ~~The~~ Subject to paragraph (c), the International Bureau shall not record the requested change if the request for recording is received by it after the expiration of 30 months from the priority date.

(c) The International Bureau shall, at any time prior to the expiration of the time limit referred to in Rule 93.1, record a change to the person, address and/or communication details of the person to whom correspondence is to be addressed, being the agent, applicant or common representative, as applicable.

Rule 94
Access to Files

94.1 *Access to the File Held by the International Bureau*

(a) At the request of the applicant or any person authorized by the applicant, the International Bureau shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 and ~~paragraphs (d) to (g)~~ [Rule 94.4](#), furnish copies of any document contained in its file. The furnishing of copies may be subject to reimbursement of the cost of the service.

(c) The International Bureau shall, if so requested by an elected Office, but not before the international preliminary examination report has been established, furnish on behalf of that Office copies under paragraph (b) of any document transmitted to it under Rule 71.1(a) or (b) by the International Preliminary Examining Authority. The International Bureau shall promptly publish details of any such request in the Gazette.

~~(d) The International Bureau shall not provide access to any information contained in its file which has been omitted from publication under Rule 48.2(l) and to any document contained in its file relating to a request under that Rule.~~

~~(e) Upon a reasoned request by the applicant, the International Bureau shall not provide access to any information contained in its file and to any document contained in its file relating to such a request, if it finds that:~~

~~(i) this information does not obviously serve the purpose of informing the public about the international application;~~

~~(ii) public access to such information would clearly prejudice the personal or economic interests of any person; and~~

~~(iii) there is no prevailing public interest to have access to that information.~~

~~Rule 26.4 shall apply mutatis mutandis as to the manner in which the applicant shall present the information which is the subject of a request made under this paragraph.~~

[Rule 94.1, continued]

~~(f) Where the International Bureau has omitted information from public access in accordance with paragraphs (d) or (e), and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly.~~

~~(g) The International Bureau shall not provide access to any document contained in its file which was prepared solely for internal use by the International Bureau.~~

94.1 bis Access to the File Held by the Receiving Office

(a) [No change] At the request of the applicant or any person authorized by the applicant, the receiving Office may provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) [No change] The receiving Office may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The receiving Office shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(l) or from public access in accordance with Rule ~~94.1(d) or (e)~~ [94.4\(a\) or \(b\)](#).

94.1 ter Access to the File Held by the International Searching Authority

(a) [No change] At the request of the applicant or any person authorized by the applicant, the International Searching Authority may provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) [No change] The International Searching Authority may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

[Rule 94.1ter, continued]

(c) The International Searching Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(l) or from public access in accordance with Rule ~~94.1(d) or (e)~~ [94.4\(a\) or \(b\)](#).

(d) [No change] Paragraphs (a) to (c) shall apply *mutatis mutandis* to the Authority specified for supplementary search.

94.2 *Access to the File Held by the International Preliminary Examining Authority*

(a) [No change] At the request of the applicant or any person authorized by the applicant, the International Preliminary Examining Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) [No change] At the request of any elected Office, but not before the establishment of the international preliminary examination report and subject to paragraph (c), the International Preliminary Examining Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The International Preliminary Examining Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(l) or from public access in accordance with Rule ~~94.1(d) or (e)~~ [94.4\(a\) or \(b\)](#).

94.2bis and 94.3 *[No change]*

[94.4 *Exceptions to Access to File*](#)

[\(a\) *\[Moved from Rule 94.1\(d\)\] The International Bureau shall not provide access to any information contained in its file which has been omitted from publication under Rule 48.2\(l\) and to any document contained in its file relating to a request under that Rule.*](#)

[\(b\) *\[Moved from Rule 94.1\(e\)\] Upon a reasoned request by the applicant, the International Bureau shall not provide access to any information contained in its file and to any document contained in its file relating to such a request, if it finds that:*](#)

[\(i\) *this information does not obviously serve the purpose of informing the public about the international application;*](#)

(ii) public access to such information would clearly prejudice the personal or economic interests of any person; and

(iii) there is no prevailing public interest to have access to that information.

Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the applicant shall present the information which is the subject of a request made under this paragraph.

(c) [Moved from Rule 94.1(f) with consequential changes to paragraph references] Where the International Bureau has omitted information from public access in accordance with paragraphs (a) or (b), and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly.

(d) [Moved from Rule 94.1(g)] The International Bureau shall not provide access to any document contained in its file which was prepared solely for internal use by the International Bureau.

(e) The Administrative Instructions may provide for measures to exclude from public access references to the following personal data, provided that said data shall be made available to the receiving Office, International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority, and designated and elected Offices:

(i) the email address, telephone number, or corresponding data for other like means of communication, of any applicant, inventor or agent; and

[COMMENT: The reference to the inventor does not appear strictly to be needed at present since none of the current forms or declarations contain spaces for email addresses, telephone or fax numbers to be provided. Nevertheless, it is proposed to list inventors as well as applicants and agents in this rule to emphasize that this is a sensitive type of personal data that should be protected if future modifications to the Administrative Instructions resulted in the possibility of such data being provided.]

(ii) the postal address of any applicant, inventor or agent provided that means of contact shall be publicly available for at least one agent or, if none, applicant.

[End]