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Statutory Rules 1991 No. 1

71/

Patents Regulations

I, THE GOVERNOR-GENERAL of the Commonwealth of Australia,
acting with the advice of the Federal Executive Council and under section
4 of the *Acts Interpretation Act 1901*, make the following Regulations
under the *Patents Act 1990*.

Dated 18 April 1991.

BILL HAYDEN

Governor-General

By His Excellency's Command,

John N. Button

Minister of State for Industry, Technology and Commerce

CHAPTER 1—INTRODUCTORY

Citation

1.1 These Regulations may be cited as the Patents Regulations.

Commencement

1.2 These Regulations commence on 30 April 1991.

Interpretation

1.3 (1) In these Regulations, unless the contrary intention appears:

“abstract” means abstract of a complete specification;

“acceptance” means:

- (a) in relation to a patent request and complete specification relating to an application for a standard patent—acceptance of the patent request and complete specification under section 49 of the Act (“acceptance of patent request: standard patent”); and
- (b) in relation to a patent request and complete specification relating to an application for a petty patent—acceptance of the patent request and complete specification under section 50 of the Act (“consideration and acceptance of patent request: petty patent”);

“basic documents” means documents filed in a Convention country in respect of a basic application;

“certificate of verification” means a statement:

- (a) that a document to which the statement relates is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement; and
- (b) that is dated and signed;

“former attorneys Regulations” means the Patent Attorneys Regulations in force immediately before the commencing day under the 1952 Act;

“former patents Regulations” means the Patents Regulations in force immediately before the commencing day under the 1952 Act;

“International Bureau” means the International Bureau of the World Intellectual Property Organization and, as long as it subsists, the United International Bureaux for the Protection of Intellectual Property (BIRPI);

“patent attorney” means:

- (a) a person:
 - (i) who is, immediately before the commencement of these Regulations, registered as a patent attorney under the former attorneys Regulations; and
 - (ii) whose registration has not ceased under these Regulations; or
- (b) a person who is registered as a patent attorney under these Regulations;

“the Act” means the *Patents Act 1990*;

“the Tribunal” means the Administrative Appeals Tribunal.

(2) A reference in these Regulations to:
(a) the giving of a notice or other document; or
(b) the making of a request or an application;
to the Commissioner or the Patent Office includes a reference to the filing of the document.

(3) A reference in these Regulations to a document that is open to public inspection is a reference to a document that may be inspected by the public at the Patent Office.

(4) Unless the contrary intention appears, if a document is given to a person by the Commissioner or the Patent Office, the document is taken to have been given to the person on the day on which the document is dated by the Commissioner or the Office.

English text of Treaties

1.4 (1) The English text of the Budapest Treaty as in force for Australia on the commencing day is the text set out in Schedule 1.

(2) The English text of the PCT as in force for Australia on the commencing day is the text set out in Schedule 2.

Prescribed periods: deposit requirements

1.5 (1) For the purposes of paragraph 6 (c) of the Act ("deposit requirements"), the prescribed period is from the filing date of the application to which the specification relates to:

- (a) if the Commissioner makes a declaration under subsection 42 (1) of the Act ("micro-organisms ceasing to be reasonably available") in relation to the specification—to the end of the period of 3 months from the date taken to be the date of filing of the specification under paragraph 42 (2) (b) of the Act; and
- (b) in any other case:
 - (i) the end of the day immediately before the day on which the application becomes open to public inspection; or
 - (ii) immediately before acceptance;whichever happens first.

(2) If a matter mentioned in paragraph 6 (c) of the Act has been included in the specification, the applicant or patentee is taken to consent to a micro-organism being obtained:

- (a) after the period prescribed in subregulation (1) in respect of the specification to which the application relates; and
- (b) from the prescribed depositary institution with which the micro-organism is deposited;

by a person to whom the Commissioner has granted the certification under regulation 3.25 ("request for Commissioner's certificate authorising release of sample of a micro-organism") in respect of the deposit.

Disclosure

1.6 (1) For the purposes of section 8 of the Act ("disclosure in basic applications"), the prescribed period is from the date of making the application relating to the basic application to the end of the day immediately before acceptance.

(2) A matter that was claimed or disclosed in a disclaimer or acknowledgement of prior art in a basic application or in a specification or other document filed in respect of, and at the same time as, the basic application is not taken to have been disclosed.

Verification of translations of international applications

1.7 For the purposes of subsection 10 (2) of the Act ("certain international applications to be taken to have been given an international filing date"), the translation of an international application that was not filed in the receiving Office in English must have with it a related certificate of verification.

CHAPTER 2—PATENT RIGHTS, OWNERSHIP AND VALIDITY

Applications by co-owners for directions

2.1 (1) An application under section 17 of the Act ("directions to co-owners") must be in the approved form.

- (2) A person making an application under that section must:
 - (a) file with the application a notice stating the facts on which the application is based; and

- (b) serve a copy of the application and notice on the other patentee or patentees.

Publication or use: prescribed circumstances and periods

2.2 (1) In this regulation:

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force for Australia on the commencing day;

“recognised exhibition” means:

- (a) an official or officially recognised international exhibition within the meaning of Article 11 of the Paris Convention or Article 1 of the Convention relating to International Exhibitions done at Paris on 22 November 1928, as in force for Australia on the commencing day; or
- (b) an international exhibition recognised by the Commissioner by a notice published in the *Official Journal* before the beginning of the exhibition.

(2) For the purposes of section 24 of the Act (“validity not affected by certain publication or use”), the following circumstances are prescribed:

- (a) the showing or use of the invention at a recognised exhibition;
- (b) the publication of the invention during a recognised exhibition at which the invention was shown or used;
- (c) the publication of the invention in a paper written by the inventor and:
 - (i) read before a learned society; or
 - (ii) published with the inventor's consent by or on behalf of a learned society; or
- (d) the working in public of the invention within the period of 12 months before the priority date of a claim for the invention:
 - (i) for the purposes of reasonable trial; and
 - (ii) if, because of the nature of the invention, it is reasonably necessary for the working to be in public.

(3) Paragraphs 2 (a) and (b) are prescribed circumstances only if:

- (a) at the time the application is made for a patent for the invention, the applicant has filed a notice stating that the invention has been exhibited; and

- (b) before the complete specification in respect of that application is open to public inspection, the applicant has filed a statement issued by the authority responsible for the exhibition in which:
 - (i) the invention and the exhibition are identified; and
 - (ii) the date of the opening of the exhibition is given; and
 - (iii) where the first disclosure of the invention during the exhibition did not take place on that date—the date of that disclosure.

Prescribed period: publication or use affecting validity

2.3 (1) For the purposes of section 24 of the Act (“validity not affected by certain publication or use”), the prescribed period is:

- (a) in the case of a circumstance mentioned in paragraph 2.2 (2) (a) or (b) (“publication or use: prescribed circumstances and periods”):
 - (i) if the application claims priority from a basic application made within 6 months of the date of the first showing or use of the invention at a recognised exhibition—12 months from the making of the basic application; and
 - (ii) in any other case—6 months after the first showing or use of the invention at the exhibition; and
- (b) in the case of the circumstance mentioned in paragraph 2.2 (2) (c):
 - (i) if the application claims priority from a basic application made within 6 months of the date of the first reading or publication referred to in that paragraph—12 months from the making of the basic application; and
 - (ii) in any other case—6 months after the first reading or publication; and
- (c) in the case of the circumstance mentioned in paragraph 2.2 (2) (d)—12 months from the start of the first public working of the invention referred to in that paragraph.

(2) For the purposes of paragraph 24 (1) (b) of the Act, the prescribed period is 12 months from the day when the information referred to in that paragraph became publicly available.

Prescribed period: patents of addition

2.4 For the purposes of section 25 of the Act ("validity: patents of addition"), the prescribed period is from the priority date of the claim of the specification of the main invention, being the claim:

- (a) defining that main invention; or
- (b) if there are 2 or more claims defining the main invention—that has the earlier or earliest priority date;

to the end of the day that is the priority date of the relevant claim of the specification of the patent of addition or of the application for a patent of addition.

Prescribed period: assertion that invention is not patentable

2.5 For the purposes of subsection 27 (1) of the Act ("notice of matters affecting validity of standard patents"), the prescribed period is from the day when the complete specification filed in relation to an application for a standard patent becomes open to public inspection to immediately before acceptance.

Prescribed period: notification of assertion of invalidity of petty patent

2.6 For the purposes of subsection 28 (1) of the Act ("notice of matters affecting validity of petty patents"), the prescribed period is 11 months from the day on which the petty patent is granted under subsection 62 (1) ("grant and publication of petty patent").

Documents to accompany notice of assertions of invalidity

2.7 Notice of an assertion under subsection 27 (1) ("notice of matters affecting validity of standard patents") or 28 (1) ("notice of matters affecting validity of petty patents") of the Act must, where the assertion is based on a document, have with it:

- (a) if the document is not available in the Patent Office—a copy of the document; and
- (b) if the document is not in English—a translation of the document into English and a related certificate of verification; and
- (c) evidence of the date and place of publication of the document.

CHAPTER 3—FROM APPLICATION TO ACCEPTANCE**PART 1—INVENTIONS GENERALLY****Prescribed documents: patent applications**

3.1 (1) For the purposes of subsection 29 (1) of the Act (“application for patent”), an abstract, and a copy of the abstract are required to be filed with a patent request made in relation to a complete application.

(2) For the purposes of subsection 29 (1) of the Act, if a complete application is made, the following documents are required to be filed before acceptance:

- (a) a notice by the applicant stating the entitlement of the nominated person to the grant of the patent; and
- (b) if the applicant claims priority from another application—a notice by the applicant stating the entitlement of the nominated person to claim that priority;
- (c) if a micro-organism is deposited with a prescribed depository institution:
 - (i) if the deposit is an original deposit within the meaning of Rule 7.3 of the Budapest Treaty or a new deposit within the meaning of Rule 7.4 of that Treaty—a copy of a receipt issued by the institution under Rule 7 of the Treaty; and
 - (ii) if samples of the micro-organism were transferred to that institution under Rule 5.1 (a) (i) of the Treaty—a copy of a receipt issued by the institution under Rule 7 of the Treaty; and
 - (iii) if a receipt referred to in subparagraph (i) or (ii) is not in English—a translation of the receipt into English and a related certificate of verification; and
- (d) if the application relies on section 6 of the Act (“deposit requirements”)—a notice by the applicant stating the entitlement of the nominated person to rely on the deposit for the purposes of the Act; and

- (e) if the application is an application to which subsection 34 (2) of the Act (“applications by eligible persons arising out of court proceedings”) applies—a copy of the court order declaring the applicant to be an eligible person in relation to the invention so far as claimed in a claim of the specification; and
- (f) if the application is an application to which subsection 36 (3) of the Act (“other applications by eligible persons”) applies—a copy of the declaration of the Commissioner that the applicant is an eligible person in relation to the invention as disclosed in the specification; and
- (g) if the request is for a patent of addition and is made by a person authorised by the applicant or patentee—a statement authorising the person that is signed by the applicant or patentee.

(3) For the purposes of subsection 29 (1) of the Act, if a PCT application claims the priority from a basic application:

- (a) a copy of the relevant basic documents; and
- (b) if those basic documents are not in English—translations of the documents into English and related certificates of verification;

must be filed before acceptance.

Note: The text of the Budapest Treaty is set out in Schedule 1.

Specifications

3.2 (1) A provisional specification must be in the approved form.

(2) A complete specification must:

- (a) be in the approved form; and
- (b) comply substantially with the requirements of Schedule 3; and
- (c) have with it a copy of the specification:
 - (i) marked on the first page as a true copy; and
 - (ii) if the specification includes drawings—marked on the reverse side of each sheet of drawings as a true copy; and

(3) If a complete specification is not in accordance with the Act or these Regulations, the Commissioner may:

- (a) treat the complete application to which the specification relates as not having been filed; and
- (b) return that specification to the applicant with:
 - (i) a written statement of the reasons for the return; and
 - (ii) any other document filed in respect of the application.

(4) If the Commissioner treats a complete specification as having been filed, he or she may, within 1 month from the date of filing of the specification, direct the applicant to do such as are necessary to ensure that the specification complies with those requirements.

(5) The complete application to which the complete specification relates lapses if an applicant to whom a direction has been given does not comply with the direction within:

- (a) 3 months after the day on which that direction was given or the specification becomes open to public inspection, whichever happens later; or
- (b) if:
 - (i) the direction is given to assist the Commissioner in relation to subregulation 3.4 (1) ("substitute abstracts") in deciding whether a filed abstract is in accordance with these Regulations; and
 - (ii) the Commissioner has specified in the direction a period of not less than 1 month within which the applicant must comply with the direction;the period referred to in subparagraph (ii).

(6) If an application lapses under subregulation (5), the Commissioner must:

- (a) advertise that fact in the *Official Journal*; and
- (b) advise the applicant of the lapse.

Abstracts

3.3 (1) An abstract must consist of:

- (a) a summary of the disclosure as contained in the description, the claims and any drawings, being a summary:
 - (i) that indicates the technical field to which the invention pertains; and
 - (ii) that is drafted in a way that 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; and
- (b) if applicable, any chemical formula that, among all the formulas contained in the specification, best characterises the invention; and
 - (c) if applicable, the number of any drawing that the applicant recommends should accompany the abstract.

(2) An abstract must be as concise as the disclosure permits, preferably 50 to 150 words.

(3) An abstract must not contain statements on the alleged merits or value of the claimed invention or on its speculative application.

(4) Each main technical feature mentioned in the abstract and illustrated by a drawing in the specification must be followed by a reference sign placed between parentheses.

(5) An abstract must be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art, especially by assisting in the formulation of an opinion on whether there is a need to consult the specification itself for those purposes.

Substitute abstracts

3.4 (1) If a filed abstract is not in accordance with these Regulations, the Commissioner may prepare a draft of a new abstract in substitution for the filed abstract.

(2) A copy of the draft of a new abstract must be given to the applicant who may give the Commissioner written comments on the draft within 1 month of the draft being given to him or her.

(3) The Commissioner must take the comments into account in the final preparation of the new abstract.

(4) If the Commissioner prepares a new abstract, the new abstract is taken to be the abstract of the specification to which it relates.

(5) If an abstract is not filed with a complete specification within 1 month from the date of filing of the specification, the Commissioner may direct the applicant to file an abstract within 1 month from the day on which the direction was given.

(6) If an abstract is not filed within 1 month from the day on which the direction was given, the application lapses.

(7) If an application lapses under subregulation (6), the Commissioner must:

- (a) advertise that fact in the *Official Journal*; and
- (b) advise the applicant of the lapse.

(8) An abstract is not taken into account in construing the nature of the invention that is the subject of the specification to which the abstract relates.

Filing date

3.5 (1) For the purposes of section 30 of the Act ("filing date"), the filing date of a patent application is the date on which a patent request in relation to the application that is accompanied by a specification is filed.

(2) The Patent Office and each sub-office of the Patent Office may provide facilities for the filing of documents when the Office or sub-office is not open to the public for business.

(3) A document filed under subregulation (2) is taken to have been filed on the day on which the Office or sub-office was last open for business before the document was filed.

Requests to make determinations between applicants

3.6 (1) For the purposes of section 32 of the Act ("disputes between applicants etc."), a request must be in the approved form.

(2) A party making a request must serve a copy of that request on each other interested party as soon as practicable after the request is made.

(3) The Commissioner must publish a notice of the request in the *Official Journal*.

(4) If a party wishes to be heard by the Commissioner, the party must notify the Commissioner accordingly within 2 months of the publication of the notice.

(5) If, as a result of a request, the Commissioner determines under section 32 of the Act to change the name of a nominated person, notice of the determination must be published in the *Official Journal*.

Form of certain applications

3.7 For the purposes of paragraphs 35 (1) (b) (“applications by eligible persons following revocation by Commissioner”) and 36 (1) (b) (“other applications by eligible persons”) of the Act, an application must:

- (a) be in the approved form; and
- (b) have with it a notice by the applicant stating the grounds on which the application is made.

Applications to be made before certain decisions and declarations

3.8 An application under section 29 of the Act (“application for patent”) of the kind described in:

- (a) section 33 (“applications by opponents etc.”); or
- (b) section 34 (“applications by eligible persons arising out of court proceedings”); or
- (c) section 35 (“applications by eligible persons following revocation by Commissioner”); or
- (d) section 36 (“other applications by eligible persons”); of the Act must be made within 3 months from the date of:
- (e) if paragraph (a) applies—the decision of the Commissioner under subsection 33 (1) or (2) of the Act; or
- (f) if paragraph (b) applies—the declaration of a court under subsection 34 (1) of the Act; or
- (g) if paragraph (c) or (d) applies—the declaration of the Commissioner under subsection 35 (1) or 36 (1) of the Act, respectively.

Prescribed period: treatment of complete application as provisional

3.9 For the purposes of subsection 37 (1) of the Act (“complete application may be treated as provisional”), the period of 12 months from the filing date of the complete application is prescribed.

Prescribed period: making of complete applications

3.10 For the purposes of section 38 of the Act (“time for making complete application”), the period of 12 months from the filing date of the provisional application is prescribed.

Making divisional applications

3.11 (1) For the purposes of subsections 39 (1) and (2) of the Act (“divisional applications”), a divisional application must be made under section 29 of the Act (“application for patent”).

(2) A divisional application for a patent under subsection 39 (1) of the Act must be made before the date of the grant of a patent on the first-mentioned application in that subsection.

(3) A divisional application for a patent under subsection 39 (2) of the Act must be made before the end of 3 months after the date of the grant of the petty patent first mentioned in that subsection.

Priority dates generally

3.12 (1) Subject to regulations 3.13 (“priority dates: certain persons and applications”) and 3.14 (“priority dates: certain amended claims”) and subregulation (2), the priority date of a claim of a specification is the earliest of the following dates:

- (a) the date of filing of the specification;
- (b) if the claim is fairly based on matter disclosed in 1 or more relevant applications—the date of making the relevant application in which the matter was first disclosed;
- (c) if:
 - (i) the specification is a complete specification filed in respect of a divisional application; and
 - (ii) the claim is fairly based on matter disclosed in the specification referred to in paragraph 39 (1) (a) or subsection 39 (2) of the Act (“divisional applications”);

the date that would have been the priority date of the claim if it had been included in the last-mentioned specification.

(2) In paragraph (1) (b), “**relevant application**” means:

- (a) a provisional application that is associated with a complete application in accordance with section 38 of the Act (“time for making complete application”); or
- (b) if the application is a Convention application, a basic application, a specification or another document filed in respect of, and at the same time as, a basic application that is related to the Convention application; or

- (c) if the application is a PCT application that claims priority under Article 8 of the PCT of an earlier application that is:
 - (i) an application made in Australia not more than 12 months before the international filing date of the PCT application; or
 - (ii) a basic application that is:
 - (A) the first application made in a Convention country in respect of the invention; and
 - (B) made not more than 12 months before the international filing date of the PCT application; or
 - (iii) a basic application made after a basic application referred to in subparagraph (ii);
 - that earlier application; or
 - (d) a specification filed in relation to:
 - (i) a basic application referred to in paragraph (b); or
 - (ii) the earlier application referred to in paragraph (c);
- after the making of the application.

(3) For the purposes of paragraph (1) (c) (ii), a claim is not fairly based on the specification referred to in paragraph 39 (1) (a) or subsection 39 (2) of the Act if, in order to comply with paragraph 40 (2) (a) of the Act ("specifications"), the deposit requirements must be satisfied and on the date of making the divisional application:

- (a) the requirement specified in paragraph 6 (a) of the Act ("deposit requirements") is not satisfied; or
 - (b) the period prescribed in subregulation 1.5 (1) ("prescribed periods: deposit requirements") has ended and the requirements of paragraph 6 (c) of the Act are not satisfied;
- in relation to the specification referred to in paragraph 39 (1) (a) or subsection 39 (2) of the Act.

(4) If a PCT application claims priority from a basic application, a specification or other document filed in respect of, and at the same time as, a basic application, section 96 of the Act ("withdrawn, abandoned or refused applications") is taken to apply to the PCT application as if it were a Convention application.

Note: The text of the PCT is set out in Schedule 2.

Priority dates: certain persons and applications

3.13 If, under subsection 36 (1) of the Act ("other applications by eligible persons"):

- (a) the Commissioner declares a person to be an eligible person; and
 - (b) the person makes a complete application under section 29 of the Act ("application for patent");
- the priority date of a claim of the specification in respect of that application, being a claim that is fairly based on matter disclosed in the specification referred to in paragraph 36 (1) (b) of the Act and referred to in the declaration is:
- (c) if that specification is a complete specification—the priority date of the claim or the date that would have been the priority date of the claim if the claim had been a claim of the specification; and
 - (d) if that specification is a provisional specification—the date of filing of the specification.

Priority dates: certain amended claims

3.14 If subsection 114 (1) of the Act ("priority date of certain amended claims") applies to a claim of a specification, the priority date of the claim is:

- (a) in the case of an amendment to which subsection 89 (4) or (5) of the Act ("modified application of Act") applies—the date on which the amendment is taken to have been made under that subsection; and
- (b) in any other case—the date of filing of the statement of proposed amendments that resulted in the disclosure referred to in subsection 114 (1) of the Act.

Prescribed period and form of request for examination

3.15 (1) For the purposes of subsection 44 (1) of the Act ("request for examination"), the period of 5 years from the filing date of the complete application is prescribed.

(2) For the purposes of subsection 44 (1) of the Act, a request for an examination of a patent request and complete specification must be in the approved form.

Prescribed grounds and period for examination

3.16 (1) For the purposes of subsection 44 (2) of the Act ("request for examination"), the following grounds are prescribed:

- (a) that the Commissioner reasonably considers it expedient to give the direction having regard to the progress made in the examination of applications filed before the filing date of the application concerned;
- (b) that the Commissioner reasonably considers it to be in the public interest to give the direction;
- (c) that the Commissioner reasonably considers it expedient to give the direction, having regard to the examination of another application for a standard patent or the consideration of an application for a petty patent.

(2) For the purposes of subsection 44 (2) of the Act, the prescribed period is 6 months from the day on which the direction was given.

(3) A direction must be given in writing and state the grounds on which it is given.

Requirement for Commissioner to direct or expedite examination

3.17 (1) For the purposes of subsection 44 (3) of the Act ("request for examination"), a person may, in the approved form, request the Commissioner to direct an applicant for a standard patent to ask for an examination of the patent request and complete specification under subsection 44 (2) of the Act.

(2) If an applicant has asked for an examination of the patent request and complete specification to be expedited, the Commissioner may do so if he or she is reasonably satisfied that:

- (a) it is in the public interest; or
- (b) there are special circumstances that make it desirable.

Report of Commissioner: examination

3.18 (1) In reporting for the purposes of paragraph 45 (1) (b) ("examination") or 48 (1) (a) ("modified examination") of the Act, the Commissioner must not have regard to information made publicly available only through the doing of an act anywhere in the patent area.

(2) For the purposes of paragraph 45 (1) (c) or 48 (1) (b) of the Act, the following matters are prescribed:

- (a) whether, to the best of the knowledge of the Commissioner, the request and specification comply with the following provisions of the Act:
 - (i) section 15 (“who may be granted a patent?”);
 - (ii) section 29 (“application for patent”);
 - (iii) section 38 (“time for making complete application”);
 - (iv) section 39 (“divisional applications”);
 - (v) section 81 (“grant of patent of addition”);
 - (vi) section 94 (“Convention applicants may make Convention applications”);
 - (vii) section 95 (“manner of making Convention applications”);
- (b) whether, to the best of the knowledge of the Commissioner, the request and specification comply with paragraph 3.1 (2) (c), (e) or (h) (“prescribed documents: patent applications”) or regulation 3.11 (“making divisional applications”);
- (c) whether acceptance of the request and specification should be refused under section 51 of the Act (“application or grant may be refused in certain cases”);
- (d) whether the invention is not a patentable invention because of subsection 18 (2) of the Act (“patentable inventions”);
- (e) whether a patent cannot be granted on the application because of subsection 64 (2) of the Act (“grant: multiple applications”);
- (f) whether the applicant is entitled to ask that any action be taken, or that he or she be allowed to take any action, because of subsection 89 (3) of the Act (“modified application of Act”).

(3) For the purposes of paragraph 48 (1) (b) of the Act, the following matters are prescribed:

- (a) in the case of an invention to which section 6 of the Act (“deposit requirements”) applies—whether, to the best of the knowledge of the Commissioner, the requirements of that section 6 of the Act are satisfied;
- (b) whether the specification under modified examination is the same as the copy of the specification (in this regulation called “**foreign specification**”) filed under subregulation 3.20 (6) (“requests for deferment of examination or modified examination”), apart from:
 - (i) matters of form; or

- (ii) the omission of a claim that is made in the foreign specification; or
- (iii) an amendment of a claim that is consequential on an omission referred to in subparagraph (ii); or
- (iv) an obvious mistake in the foreign specification; or
- (v) if the micro-organism deposited in respect of the foreign specification is the same micro-organism as that deposited in respect of the specification, a difference relating to matter referred to in paragraph 6 (c) of the Act that is necessary for the application to comply with the deposit requirements.

(4) For the purposes of examination, if a notice has been filed under subsection 27 (1) of the Act ("notice of matters affecting validity of standard patents"), the Commissioner must consider a matter stated in the notice that addresses a claim that an invention does not comply with paragraph 18 (1) (b) of the Act.

Conduct of examination

3.19 (1) If the Commissioner reasonably believes that there are lawful grounds of objection to the patent request or complete specification, he or she must state the grounds of objection in reporting on an examination.

(2) The applicant may contest the objection in writing or ask for leave to amend the patent request or complete specification in accordance with Chapter 10 ("amendments").

(3) If the applicant asks for leave to amend a patent request or complete specification in response to, or in anticipation of, a report under section 45 ("examination") or section 48 ("modified examination") of the Act, the Commissioner must examine the request and specification and report as if each proposed amendment had been made.

(4) If the applicant contests the objection, the Commissioner must examine the request and specification and take note of the matters raised by the applicant.

Requests for deferment of examination or modified examination

3.20 (1) In this regulation:

“prescribed foreign country” means a country prescribed in regulation 3.21 (“prescribed foreign countries: requests for deferment of examination and modified examination”).

(2) For the purposes of paragraph 46 (1) (b) (“request for deferment of examination”) of the Act, the following applications are prescribed:

- (a) a basic application in relation to the complete application;
- (b) an application for a patent that claims the priority of the complete application or a provisional application associated with the complete application under section 38 of the Act (“time for making complete application”);
- (c) an application for a patent made in a prescribed foreign country that claims the priority of the application that is a basic application in relation to that complete application.

(3) For the purposes of paragraph 47 (1) (b) of the Act (“request for modified examination”), an application prescribed for the purposes of paragraph 46 (1) (b) of the Act in relation to which a patent in English has been granted in a prescribed foreign country is prescribed.

(4) For the purposes of paragraph 46 (1) (d) of the Act, the prescribed ground is that the Commissioner reasonably considers it expedient to give the direction, having regard to the progress made in the examination of applications filed before the filing date of the application concerned.

(5) For the purposes of subsection 46 (2) and subsection 47 (1) of the Act, a request for each action must be in the approved form.

(6) The applicant must file a copy of the specification relating to the patent referred to in paragraph 47 (1) (b) of the Act that is:

- (a) certified by the official chief or head of the Patent Office of the prescribed foreign country by which the patent was granted; or
- (b) otherwise verified to the reasonable satisfaction of the Commissioner;

before acceptance, unless the applicant makes a request under subsection 47 (2) of the Act.

Prescribed foreign countries: requests for deferment of examination and modified examination

3.21 For the purposes of paragraphs 46 (1) (b) ("request for deferment of examination") and 47 (1) (b) of the Act ("request for modified examination"), the following countries are prescribed:

- (a) a country that is a signatory to the the treaty done at Munich on 5 October 1973 entitled the Convention on the Grant of European Patents, as in force from time to time;
- (b) Canada;
- (c) New Zealand (excluding the Cook Islands, Niue and Tokelau);
- (d) United States of America (including all territories and possessions and the Commonwealth of Puerto Rico).

Consideration of petty patent application

3.22 (1) In considering the complete application for a petty patent under subsection 50 (1) of the Act ("consideration and acceptance of patent request: petty patent"), the Commissioner must:

- (a) not have regard to information made publicly available only through the doing of an act anywhere in the patent area; and
- (b) have regard to:
 - (i) the matters prescribed in paragraphs 3.18 (2) (a) to (f) (inclusive) ("report of Commissioner: examination"); and
 - (ii) whether the abstract is finally completed; and
 - (iii) whether, to the best of the knowledge of the Commissioner, the invention, so far as claimed in any claim, satisfies paragraphs 18 (1) (a) and (b) of the Act ("patentable inventions"); and
 - (iv) whether the specification complies with section 40 of the Act ("specifications").

(2) If the applicant asks for leave to amend a patent request or complete specification in response to, or in anticipation of, a notice under paragraph 50 (2) (a) of the Act, the Commissioner must consider the request and specification as if each proposed amendment had been made.

(3) If the applicant contests the objection, the Commissioner must consider the request and specification and take note of the matters raised by the applicant.

PART 2—INVENTIONS THAT ARE MICRO-ORGANISMS

Documents in accepted applications and patents involving micro-organisms

3.23 (1) Where a micro-organism is deposited with a prescribed depositary institution for the purposes of section 41 of the Act ("specifications: micro-organisms"), the following documents must be filed in relation to an application that has been accepted under section 49 ("acceptance of patent request: standard patent") or 50 ("consideration and acceptance of patent request: petty patent") of the Act or a patent in respect of the micro-organism:

- (a) if the deposit is an original deposit within the meaning of Rule 7.3 of the Budapest Treaty or a new deposit within the meaning of Rule 7.4 of that Treaty—a copy of a receipt issued by the institution under Rule 7 of the Treaty;
- (b) if samples of the micro-organism were transferred to that institution under Rule 5.1 (a) (i) of the Treaty—a copy of a receipt issued by the institution under Rule 7 of the Treaty;
- (c) if a receipt referred to in paragraph (a) or (b) is not in English—a translation of the receipt into English and a related certificate of verification.

(2) The documents referred to in subregulation (1) must be filed within 3 months from the date of receipt of the micro-organism by the prescribed depositary institution.

Note: The text of the Budapest Treaty is set out in Schedule 1.

Commissioner may request samples and viability statement

3.24 (1) If, in relation to a patent application or patent in respect of a micro-organism, the micro-organism is deposited with a prescribed depositary institution, the Commissioner:

- (a) on the order of a court in Australia, must; or
- (b) on his or her own motion or on application in writing by another person, may;

for the purposes of proceedings before the Commissioner or any other legal proceedings in Australia:

- (c) make to that institution a request referred to in Rule 11.1 of the Budapest Treaty for a sample of that micro-organism; and
- (d) in relation to that micro-organism, make the declaration referred to in that Rule.

(2) Before making a request, the Commissioner must give the applicant or patentee concerned, and any other person who apparently has

an interest in the request, an opportunity to be heard, unless the request is made on the order of a court.

(3) If the Commissioner decides to make, or to refuse to make, a request, he or she must inform the applicant or patentee concerned, and any other person who apparently has an interest in the request, of the decision, and of the reasons for the decision, by notice in writing as soon as practicable after the decision.

(4) The Commissioner may make a request referred to in Rule 10.2 (a) (iii) of the Budapest Treaty for a statement concerning the viability of a micro-organism if a sample of the micro-organism has been given to the Commissioner in accordance with a request under subregulation (1).

Note: The text of the Budapest Treaty is set out in Schedule 1.

Request for Commissioner's certificate authorising release of sample of a micro-organism

3.25 (1) If a micro-organism is deposited with a prescribed depositary institution, a person may, in the approved form, request the Commissioner to grant the certification referred to in Rule 11.3 (a) of the Budapest Treaty in respect of the deposit.

(2) As soon as practicable after receiving a request, the Commissioner must decide whether to:

- (a) comply with the request; or
- (b) impose such conditions as are reasonable, including a condition that the person give security for damages for any breach of the undertaking referred to in paragraph (4) (c) given by:
 - (i) the person; or
 - (ii) another person who has been nominated as a skilled addressee; or
- (c) refuse that request.

(3) The applicant for the patent may, at any time before the specification relating to the application is open for public inspection, notify the Commissioner that a sample of the deposited micro-organism is only to be provided before:

- (a) the patent is granted on that application; or
- (b) the application has lapsed or been withdrawn or refused;

to a person who is:

- (c) a skilled addressee without an interest in the invention; and
- (d) nominated by the person who made the request.

(4) The Commissioner must comply with a request in respect of a patent application or patent:

- (a) if the specification relating to that application or patent is open to public inspection; and
- (b) unless the Commissioner is reasonably satisfied that the nominated person is not entitled to rely on the deposit for the purposes of the Act; and
- (c) if the person making the request or the person nominated as a skilled addressee has undertaken to use that micro-organism only for experimental purposes or in relation to:

- (i) opposition proceedings under Chapter 5 of the Act ("opposition") in relation to the grant of a standard patent on that application; or

- (ii) a notice under section 28 of the Act ("notice of matters affecting validity of petty patents") in relation to the petty patent; or

- (iii) relevant proceedings in relation to the patent;

and not to make that micro-organism, or a culture derived from that micro-organism, available to another person; and

- (d) unless the Commissioner is reasonably satisfied that the undertaking given by the person making the request or the person nominated as a skilled addressee was not given in good faith; and

(e) if:

- (i) the Commissioner has been notified under subregulation (3); and

- (ii) the patent referred to in that subregulation has not been granted; and

- (iii) the application referred to in that subregulation has not lapsed or been withdrawn or refused; and

- (iv) the Commissioner is reasonably satisfied that the person nominated as a skilled addressee is a skilled addressee without an interest in the invention; and

(f) if:

- (i) the request is in respect of a patent; and

- (ii) the person making that request is a person to whom the patentee has granted a licence under section 133 of the Act ("compulsory licences"); and

- (iii) the Commissioner is reasonably satisfied that the licence provides that the person making the request has a right to obtain a sample of that micro-organism; and
- (g) if:
 - (i) the request is in respect of a patent; and
 - (ii) the person making that request is a person who may exploit the invention under section 163 of the Act ("exploitation of inventions by Crown"); and
 - (iii) the Commissioner is reasonably satisfied that the terms for the exploitation of the invention provide that the person making the request has a right to obtain a sample of that micro-organism.

(5) Before making a decision under subregulation (2), the Commissioner must give the person making the request, the applicant or patentee concerned and any other person who apparently has an interest in the request, an opportunity to be heard.

(6) If the Commissioner makes a decision under subregulation (2), he or she must inform the person who made the request, the applicant or patentee concerned and any other person who apparently has an interest in the request, of the decision, and the reasons for the decision, by notice in writing given as soon as practicable after the date of the decision.

Note: The text of the Budapest Treaty is set out in Schedule 1.

Breach of undertakings given in respect of micro-organisms

3.26 (1) Where the micro-organism is deposited with a prescribed depositary institution, proceedings for breach of an undertaking referred to in paragraph 3.25 (4) (c) ("request for Commissioner's certificate authorising release of sample of a micro-organism") may be instituted in a prescribed court by a person who is:

- (a) if a patent has not been granted on that patent application---the applicant; or
- (b) if:
 - (i) a patent has been granted on that patent application; or
 - (ii) the deposit is effected in relation to a patent; the patentee of, or an exclusive licensee under, that patent.

(2) In proceedings by an exclusive licensee, the patentee must be a party to the proceedings.

(3) A patentee joined as a defendant in the proceedings by an exclusive licensee is not liable for costs unless the patentee enters an appearance and takes part in the proceedings.

(4) It is a defence in proceedings for breach of the undertaking given in respect of a micro-organism to which a specification filed in respect of a patent application or patent relates, that when the matters complained of took place the specification did not comply with the requirements referred to in paragraph 6 (c) or (d) of the Act ("deposit requirements").

(5) A defendant may not plead a defence referred to in subregulation (4) unless:

- (a) the defendant, before becoming a defendant in the proceedings, notified the Commissioner under paragraph 3.29 (1) ("notification that a deposit requirement has ceased to be satisfied") of the deposit requirement that has ceased to be satisfied; and
- (b) the applicant for the patent or the patentee fails to take the steps referred to in paragraph 41 (4) (b) of the Act ("specifications: micro-organisms") within the appropriate period prescribed by subregulation 3.30 (1) ("prescribed period: deposit requirements taken to be satisfied") for the purposes of that paragraph.

Procedure in proceedings for breach of an undertaking

3.27 In proceedings referred to in subregulation 3.26 (1) ("breach of undertakings given in respect of micro-organisms") for breach of an undertaking:

- (a) the plaintiff must deliver particulars of the breaches complained of:
 - (i) with the statement of claim or declaration; or
 - (ii) by order of the court, at a later time; and
- (b) the defendant must deliver particulars of any objections on which the defendant relies:
 - (i) with the statement of defence or plea; or
 - (ii) by order of the court, at a later time.

Relief in proceedings for breach of undertakings

3.28 (1) In proceedings referred to in subregulation 3.26 (1) (“breach of undertakings given in respect of micro-organisms”), the court may:

- (a) make an order for inspection; and
- (b) impose terms and give directions with respect to the inspection.

(2) In proceedings referred to in subregulation 3.26 (1), the court may grant such relief as it thinks fit, including:

- (a) an injunction on such terms as it thinks fit; or
- (b) an order for damages; or
- (c) an order for an account of profits; or
- (d) an order with respect to any security given under paragraph 3.25 (2) (b) (“request for Commissioner’s certificate authorising release of sample of a micro-organism”); or
- (e) an order on such terms as it thinks fit to deliver to such person as it thinks fit the micro-organism or any substance or thing derived directly or indirectly from that micro-organism as a result of the breach of the undertaking, including:
 - (i) any products made by using that micro-organism; and
 - (ii) any other micro-organisms derived from that micro-organism; and
 - (iii) any products made by using those other micro-organisms.

Notification that a deposit requirement has ceased to be satisfied

3.29 (1) If a deposit requirement ceases to be satisfied in relation to a micro-organism to which a specification filed in respect of a patent application or patent relates, a person other than the applicant or patentee may, after the specification has become open to public inspection, notify the Commissioner in the approved form of the requirement referred to in paragraph 6 (c) or (d) of the Act (“deposit requirements”) that has ceased to be satisfied.

(2) As soon as practicable after receiving a notice under subregulation (1), the Commissioner must give a copy of the notice to the applicant or patentee.

(3) If the Commissioner learns, otherwise than by a notice referred to in subregulation (1), of facts that may establish that a requirement referred to in that subregulation has ceased to be satisfied, the Commissioner must cause a notice setting out those facts to be given to the applicant or patentee.

(4) As soon as practicable after the Commissioner receives a notice under subregulation (1) or gives a notice under subregulation (3), a notice of the receipt or giving of that notification must be published in the *Official Journal*.

(5) The terms of a notice under subregulation (1) or (3) need not be published, but the notice must be open to public inspection.

(6) The applicant or patentee may file a written reply setting out the facts relied upon to establish that the requirement referred to in subregulation (1) is satisfied.

(7) If a reply filed under subregulation (6) is in answer to a notification under subregulation (1) by a person, the Commissioner must, as soon as practicable after receiving the reply, give a copy of the reply to that person.

(8) As soon as practicable after a reply is filed under subregulation (6), a notice of the filing must be published in the *Official Journal*.

(9) The terms of a reply filed under subregulation (6) need not be published, but the reply must be open to public inspection.

Prescribed period: deposit requirements taken to be satisfied

3.30 For the purposes of paragraph 41 (4) (b) of the Act ("specifications: micro-organisms"), if, in relation to a patent application or patent relating to a micro-organism:

- (a) that micro-organism is deposited with a prescribed depository institution; and
- (b) a requirement referred to in paragraph 6 (c) or (d) of the Act ("deposit requirements") ceases to be satisfied in relation to the micro-organism;

the prescribed period is from the day when the requirement ceases to be so satisfied to the end of:

- (c) where the step referred to in paragraph 41 (4) (b) of the Act is the making of a new deposit of a sample of the micro-organism:
 - (i) if the Commissioner has given under subregulation 3.29 (2) ("notification that a deposit requirement has ceased to be satisfied") the applicant or patentee a

- copy of a notice of that requirement—the period of 3 months after the copy was given; or
- (ii) if the Commissioner has given under subregulation 3.29 (3) to the applicant or patentee a notice of the requirement—the period of 3 months after the notice was given; or
 - (iii) if under Article 4 (1) of the Budapest Treaty the authority has notified the depositor of its inability to furnish samples of the micro-organism and the Commissioner has not, before the notification, given to the applicant or patentee under subregulation 3.29 (2) or (3) a copy of the notice, or the notice, as the case may be, of the requirement—the period of 3 months after the depositor received that notification under Article 4 (1) (d) of the Treaty; or
 - (iv) in any other case—the day when that new deposit is so made; or
- (d) where the step referred to in paragraph 41 (4) (b) of the Act is an amendment of the specification in respect of that patent application or patent—the date of the allowance of the amendment, unless:
- (i) the Commissioner has given the applicant or patentee a copy of a notice under subregulation 3.29 (2) or a notice under subregulation 3.29 (3); and the applicant or patentee has not asked for leave to amend the specification within the period of 3 months after the copy or the notice was given; or
 - (ii) the authority has notified the depositor under Article 4 (1) of the Budapest Treaty of its inability to furnish samples of the micro-organism and:
 - (A) the Commissioner has not, before the notification, given to the applicant or patentee under subregulation 3.29 (2) or (3) the notice, or a copy of the notice, as the case may be, of the requirement; and
 - (B) the applicant or patentee has not asked for leave to amend the specification within the period of 3 months after the depositor received the notification under Article 4 (1) (d) of the Treaty.

Note: The text of the Budapest Treaty is set out in Schedule 1.

Application for declaration that deposit requirements are not satisfied

3.31 (1) An application under section 42 of the Act ("micro-organisms ceasing to be reasonably available") for a declaration that a specification does not comply with section 40 of the Act ("specifications") unless the deposit requirements are satisfied in relation to a micro-organism, must:

- (a) be made in the approved form to a prescribed court or the Commissioner; and
- (b) be lodged at the court or filed.

(2) A person who applies for a declaration under section 42 of the Act must give a copy of the application:

- (a) to the applicant or patentee; and
- (b) to such other person as the court or Commissioner directs.

(3) If the Commissioner on his or her own motion proposes to declare under section 42 of the Act that the specification in respect of a patent application or patent does not comply with the requirements of section 40 of the Act unless the deposit requirements are satisfied in relation to a micro-organism, he or she must give to the applicant or patentee a statement of the facts relied upon to justify the making of that declaration.

(4) A person to whom:

- (a) a copy of an application under subregulation (2); or
- (b) a statement under subregulation (3);

has been given:

- (c) may, within 3 months, give to the court to which the application is made or to the Commissioner a reply to that application or statement; and
- (d) must give a copy of the reply to the applicant or patentee and to such other persons as the court or the Commissioner directs.

(5) As soon as practicable after:

- (a) a copy of a declaration by a court under subsection 42 (1) of the Act is given to the Commissioner under subsection 42 (6) of the Act; or
- (b) the making of a decision of the Commissioner under subsection 42 (1) of the Act;

notice of the making of the declaration or decision must be published in the *Official Journal*.

(6) The terms of a declaration or decision referred to in subregulation (5) need not be published, but the declaration or decision must be open to public inspection.

CHAPTER 4—PUBLICATION**Prescribed information: applicants and applications**

4.1 For the purposes of section 53 of the Act (“publication of certain information about applicants etc.”), the following information is prescribed:

- (a) the number allocated to the application by the Commissioner;
- (b) the name of the applicant;
- (c) in the case of a complete application—the name of the nominated person;
- (d) the title, or an abbreviated title, of the invention;
- (e) the date on which the application was filed;
- (f) in the case of a complete application, other than a PCT application—particulars of priority documents.

Notice that specification is open to public inspection

4.2 (1) A request under subsection 54 (1) of the Act (“notice of publication”) must be in the approved form.

(2) For the purposes of subsection 54 (1) of the Act, the Commissioner must publish the notice as soon as practicable after:

- (a) being asked by the applicant to publish the notice; and
- (b) the relevant abstract is finally completed; and
- (c) if a direction has been given under subregulation 3.2 (4) (“specifications”)—the direction has been complied with.

(3) For the purposes of paragraph 54 (3) (b) of the Act, the prescribed period is from the day of filing of the specification to the end of 18 months after:

- (a) that day; or
- (b) the date of making the earliest relevant application referred to in regulation 3.12 (“priority dates generally”);

whichever is earlier.

Prescribed documents: public inspection

4.3 For the purposes of subsection 55 (1) of the Act (“documents open to public inspection”), the following documents, including those documents as amended, are prescribed:

- (a) the patent request;

- (b) any document filed, including a specification, in relation to any provisional application associated with the complete application;
- (c) any basic document that has been filed and, if the document is not in English, a translation of the document into English and a related certificate of verification;
- (d) any documents filed under section 6 (“deposit requirements”), section 41 (“specifications: micro-organisms”) or section 42 (“micro-organisms ceasing to be reasonably available”) of the Act;
- (e) a notice and a statement filed under subregulation 2.2 (3) (“publication or use: prescribed circumstances and periods”);
- (f) a document prescribed in subregulation 3.1 (1) (“prescribed documents: patent applications”).

CHAPTER 5—OPPOSITION

Application of this Chapter

5.1 This Chapter applies if a notice of opposition has been filed for the purposes of:

- (a) the following sections of the Act:
 - (i) section 59 (“opposition to grant of standard patent”);
 - (ii) section 74 (“opposition to extension”);
 - (iii) subsection 104 (4) (“amendments by applicants and patentees”), unless the request for leave to amend is made under regulation 9.5 (“completion of re-examination”) or is in response to a direction of the Commissioner under section 107 (“amendments directed by Commissioner: patent applications”) or 108 (“amendments directed by Commissioner: extensions of term of petty patents”);
 - (iv) subsection 223 (6) (“extensions of time”); or
- (b) subregulation 22.21 (4) (“protection or compensation of certain persons”) or 10.7 (4) (“amendment of documents by Commissioner”).

Interpretation

5.2 In this Chapter:

“applicant” means a person who has filed an application or request in respect of which another person has filed a notice of opposition;

“opponent” means a person who has filed a notice of opposition;

“party” means applicant or opponent.

Filing of opposition

5.3 (1) The Minister or other person who intends to oppose the grant of a patent under section 59 of the Act ("opposition to grant of standard patent") must file a notice of opposition in the approved form within 3 months of publication in the *Official Journal* of the notice of acceptance under section 49 of the Act ("acceptance of patent request: standard patent").

(2) The Minister, the Secretary to the Department of Community Services and Health or an interested person who intends to oppose the grant of an extension of the term of a patent under section 74 of the Act ("opposition to extension") must file a notice of opposition in the approved form within 3 months of the publication in the *Official Journal* of a notice under section 73 of the Act ("advertisement of application for extension").

(3) The Minister or other person who intends to oppose allowing an amendment under subsection 104 (4) of the Act ("amendments by applicants and patentees") must file a notice of opposition in the approved form within 3 months of publication in the *Official Journal* of a notice referred to in subregulation 10.5 (2) ("Commissioner to grant leave to amend") or 10.7 (3) ("correction of Register or patent").

(4) A person must not oppose the allowance of a proposed amendment of a complete specification, except on the grounds that the amendment is not allowable under section 102 of the Act ("what amendments are not allowable?").

(5) A person who intends to oppose the grant of an application for an extension of time under subsection 223 (6) of the Act ("extensions of time") must file a notice of opposition in the approved form within 1 month of the advertisement of the application in the *Official Journal*.

(6) A person:

(a) on whom a copy of an application for a licence in accordance with subregulation 22.21 (3) ("protection or compensation of certain persons") has been served; and

(b) who intends to oppose the grant of the licence;

must file a notice of opposition to the grant of the licence in the approved form within 1 month from the day on which the copy was served on him or her.

(7) As soon as practicable after a notice of opposition is filed, the opponent must serve a copy of the notice on the applicant.

Filing of statement

5.4 (1) An opponent must:

- (a) within 1 month of filing the notice of opposition serve on the applicant a copy of a statement that sets out:
 - (i) the grounds of opposition; and
 - (ii) the particulars relating to each ground; and
- (b) as soon as practicable after the copy of the statement has been served on the applicant, file the statement.

(2) If a notice of opposition is filed for the purposes of section 74 of the Act ("opposition to extension"), the statement and the copy of the statement must each have with it evidence in support of the opposition (if any) and a copy of that evidence.

Dismissal of opposition

5.5 (1) An applicant may:

- (a) within 1 month of being served with a copy of a statement by an opponent under subregulation 5.4 (1) ("filing of statement"); or
- (b) if the complete specification in relation to an opposed application is re-examined under subsection 97 (1) of the Act ("re-examination of complete specifications")—within 1 month from the day when the re-examination is completed under regulation 9.5 ("completion of re-examination");

request the Commissioner in the approved form to dismiss the opposition.

(2) As soon as practicable after a request is made, the Commissioner must inform the opponent of the request having been made.

(3) The Commissioner may dismiss the opposition whether or not the applicant has requested dismissal of the opposition.

Determination of opposition

5.6 (1) If the complete specification in relation to an opposed application is re-examined under subsection 97 (1) of the Act ("re-examination of complete specifications"), the opponent may, within 1 month from the day when the re-examination is completed under

regulation 9.5 (“completion of re-examination”), request the Commissioner in the approved form to determine the opposition.

(2) As soon as practicable after a request is made, the Commissioner must inform the applicant of the request having been made.

(3) The Commissioner may determine the opposition whether or not the opponent has requested determination of the opposition.

Opponent to serve copy of substitute statement

5.7 If the specification in relation to the opposed application is re-examined under subsection 97 (1) of the Act (“re-examination of complete specifications”):

- (a) the opponent may, within 1 month from the day when the re-examination is completed under regulation 9.5 (“completion of re-examination”), serve on the applicant a copy of a statement in substitution for the statement to which subregulation 5.4 (1) (“filing of statement”) relates; and
- (b) if a copy of a substituted statement is served on the applicant, the opponent must, as soon as practicable after the copy of the statement has been so served, file that statement.

Time for giving of evidence

5.8 (1) Subject to subregulation (5), if an opponent intends to rely on evidence in support of the opposition, the opponent must:

- (a) serve on the applicant a copy of any evidence in support of the opposition within:
 - (i) 3 months of serving the applicant with:
 - (A) a copy of the statement referred to in subregulation 5.4 (1) (“filing of statement”); or
 - (B) if a substitute statement has been served on the applicant under regulation 5.7 (“opponent to serve copy of substitute statement”)—a copy of that statement;
 - (ii) if the Commissioner has re-examined the complete specification in relation to the opposed application under subsection 97 (1) of the Act (“re-examination of complete specifications”)—3 months from the day when re-examination is completed under regulation 9.5 (“completion of re-examination”); or

- (iii) if dismissal of the opposition has been requested under subregulation 5.5 (1) ("dismissal of opposition")—3 months of a decision of the Commissioner not to dismiss the opposition; or
 - (iv) if determination of the opposition has been requested under subregulation 5.6 (1) ("determination of opposition")—3 months of a decision of the Commissioner not to determine the opposition;
- whichever happens last; and
- (b) file the evidence in support of the opposition as soon as practicable after the copy of the evidence has been served on the applicant.
- (2) Subject to subregulation (3), if an applicant intends to rely on evidence in answer to the evidence in support of the opposition, the applicant must:
- (a) serve on the opponent a copy of any evidence in answer to the evidence in support of the opposition referred to in paragraph (1) (a) within 3 months after the end of the period prescribed in that paragraph; and
 - (b) file the evidence in answer as soon as practicable after the copy of the evidence has been served on the opponent.
- (3) If an opponent has not served on an applicant a copy of evidence in support of the opposition and the applicant intends to rely on evidence in answer to the opposition, the applicant must:
- (a) serve on the opponent a copy of any evidence in answer to the opposition within 3 months of the end of the period prescribed in paragraph (1) (a); and
 - (b) file the evidence in answer as soon as practicable after the copy of the evidence has been served on the opponent.
- (4) Subject to subregulation (5), if an opponent intends to rely on evidence in reply to the evidence referred to in paragraph (2) (a) or (3) (a), the opponent must:
- (a) within 1 month of being served by the applicant with a copy of the evidence under paragraph (2) (a) or (3) (a), serve on the applicant a copy of:
 - (i) the evidence in reply; and
 - (ii) any notice of intention to file evidence in reply; and
 - (b) if the applicant has been served with a copy of a notice of intention to file evidence in reply, serve the applicant with a

- copy of the evidence within 3 months of being served with a copy of the evidence under paragraph (2) (a) or (3) (a); and
- (c) file the evidence in reply and any notice of intention as soon as practicable after the copy of the evidence in reply or notice has been served on the applicant.

(5) Subregulations (1) and (4) do not apply if a notice of opposition has been filed under section 74 of the Act (“opposition to extension”).

Amendment of statement

5.9 (1) The Commissioner, on the written request of an opponent and subject to such terms as the Commissioner may specify:

- (a) if the Commissioner reasonably believes that an amendment of a statement referred to in subregulation 5.4 (1) (“filing of statement”) corrects an error or omission by the opponent or by his or her agent—may amend the grounds of opposition set out in the statement; or
- (b) if the Commissioner reasonably believes that an amendment of the grounds set out in a statement referred to in subregulation 5.4 (1) results from an amendment of a patent request or complete specification—must amend those grounds; or
- (c) must amend particulars relating to a ground referred to in subregulation 5.4 (1).

(2) The Commissioner must not allow an amendment requested under subregulation (1), if:

- (a) an application for dismissal of opposition is being considered; or
- (b) an application for determination of opposition is being considered; or
- (c) in the case of opposition under section 59 of the Act (“opposition to grant of standard patent”)—a specification relating to the opposed application is being re-examined; or
- (d) he or she does not reasonably believe that the applicant has been notified of the proposed amendment; or
- (e) he or she reasonably believes that a person will be unduly prejudiced by the amendment.

(3) The Commissioner must give the parties an opportunity to make representations concerning the proposed amendment.

(4) If the Commissioner allows an amendment, he or she must give the applicant a copy of the statement as amended.

Conduct of proceedings to which this Chapter applies

5.10 (1) The Commissioner may, on his or her own motion or on the application of a party:

- (a) give a direction that is not inconsistent with the Act or these Regulations for the conduct of proceedings to which this Chapter applies; or
- (b) determine that a period prescribed in this Chapter is to be extended by such further period as the Commissioner reasonably allows.

(2) The Commissioner may:

- (a) on the application of a party in the approved form; and
- (b) on such reasonable terms (if any) as the Commissioner specifies;

extend the time within which the party may take a step prescribed in this Chapter, not being a step that is taken under regulation 5.3 ("filing of opposition").

(3) If section 107 of the Act ("amendments directed by Commissioner: patent applications") applies to an opposed application, the time within which a party may take a step prescribed in this Chapter is extended by a period that is equal to the period from the day when the applicant is given an opportunity to be heard that is referred to in subsection 107 (2) of the Act to the end of the day when the decision is made under 107 (4) of the Act whether or not the amendment is allowed.

(4) The Commissioner may:

- (a) on the application of a party; and
- (b) on such reasonable terms (if any) as the Commissioner may specify;

permit the party to serve further evidence on the other party.

(5) The Commissioner must not give a direction under subregulation (1) or grant an application under subregulation (2) or (4) unless the Commissioner:

- (a) if he or she proposes to grant an application by a party—is reasonably satisfied that the other party has been notified of the application; and

- (b) if he or she proposes to act on his or her own motion—ensures that the parties are notified of the proposed action; and
- (c) in either case:
 - (i) gives the parties a reasonable opportunity to make representations concerning the application or proposed action; and
 - (ii) is reasonably satisfied that a direction, an extension of time or the serving of further evidence is appropriate in all the circumstances.

Commissioner may inform himself or herself

5.11 (1) The Commissioner may inform himself or herself of a fact by reference to a document available in the Patent Office.

(2) If the Commissioner proposes to refer to a document under subregulation (1), he or she must:

- (a) notify the parties accordingly; and
- (b) give the parties a copy of, or access to, the document; and
- (c) give the parties an opportunity to give evidence or make representations with respect to the fact or document.

(3) In subregulation (2), “document” does not include a document filed under regulation 5.4 (“filing of statement”), 5.8 (“time for giving of evidence”) or further evidence referred to in subregulation 5.10 (4) (“conduct of proceedings to which this Chapter applies”).

Hearing of opposition

5.12 The Commissioner must if he or she receives a request by a party to hold a hearing, or may, on his or her own motion:

- (a) give a notice of a hearing into the opposition; and
- (b) hold the hearing;

if the relevant periods prescribed in regulation 5.8 (“time for giving of evidence”) have ended, unless:

- (c) the opposition has been dismissed or determined; or
- (d) the notice has been withdrawn.

Representations to Commissioner

5.13 A representation referred to in subregulation 5.9 (3) (“amendment of statement”), subparagraph 5.10 (5) (c) (i) (“conduct of

proceedings to which this Chapter applies”) or paragraph 5.11 (2) (c) (“Commissioner may inform himself or herself”) may be made to the Commissioner in writing or by telephone.

Commissioner not required to hold hearing

5.14 If the Commissioner reasonably believes that no party wishes to be heard in a matter arising under regulation 5.12 (“hearing of opposition”) or 5.13 (“representations to Commissioner”), the Commissioner is not required to hold a hearing.

Withdrawal of opposition

5.15 An opponent may at any time withdraw opposition by:

- (a) filing a written notice of withdrawal that is signed by him or her; and
- (b) serving a copy of the notice on the applicant.

CHAPTER 6—GRANT AND TERM OF PATENTS

Publication of notice of grant of standard patent

6.1 If a standard patent is granted under section 61 of the Act (“grant of standard patent”), the Commissioner must publish a notice that the patent has been granted in the *Official Journal*.

Prescribed period: grant of standard patent

6.2 (1) For the purposes of subsection 61 (2) of the Act (“grant of standard patent”), the prescribed period is from 3 months after publication under paragraph 49 (5) (b) of the Act (“acceptance of patent request: standard patent”) of the notice of the acceptance of the request and complete specification to:

- (a) 6 months after that publication; or
- (b) such later day as:
 - (i) in the case of proceedings before a court or the Tribunal—the court or Tribunal directs; or
 - (ii) in any other case—the Commissioner reasonably directs;

being satisfied that the grant of the patent should be postponed.

(2) A person may request the Commissioner in the approved form to give a direction referred to in subparagraph (1) (b) (ii).

Date of patent

6.3 For the purposes of paragraph 65 (b) of the Act ("date of patent"), the date of a patent is as follows:

- (a) in the case of a patent granted under subsection 33 (1) of the Act ("applications by opponents etc.")—the date of filing of the complete specification in respect of the application of which the grant of a standard patent is opposed;
- (b) in the case of a petty patent granted under subsection 33 (2) of the Act—the date of the patent referred to in paragraph 33 (2) (b) of the Act;
- (c) in the case of a patent granted under subsection 34 (2) of the Act ("applications by eligible persons arising out of court proceedings")—the date of the patent referred to in subsection 34 (1) of the Act;
- (d) in the case of a patent granted under section 35 of the Act ("applications by eligible persons following revocation by Commissioner")—the date of the revoked patent;
- (e) in the case of a patent granted as a result of a declaration under section 36 of the Act ("other applications by eligible persons"), if the declaration is made in respect of:
 - (i) a complete application—the date that would have been the date of the patent if the patent had been granted on that application; or
 - (ii) a provisional application:
 - (A) the date 12 months after the date of filing of the provisional specification in respect of that application; or
 - (B) the date of filing of the complete application referred to in subsection 36 (3) of the Act;whichever is earlier;
- (f) in the case of a patent granted on a divisional application—the date of filing of the complete specification in which the invention that is the subject of the application was first disclosed.

Form of application for sealing of duplicate of patent

6.4 An application for the sealing of a duplicate of a patent under section 66 of the Act ("sealing of duplicate of patent") must be in the approved form.

Application for extension of term of petty patent

6.5 (1) For the purposes of subsection 69 (1) of the Act ("extension of term of petty patent"), an application for an extension of the term of a petty patent must:

- (a) be in the approved form; and
- (b) be made within 11 months of the date of sealing of the patent.

(2) If a patentee applies for an extension of the term of a petty patent, the Commissioner must publish in the *Official Journal* a notice stating that the application has been made.

Deciding an application for extension of term of petty patent

6.6 (1) For the purposes of subsection 69 (2) of the Act ("extension of term of petty patent"), in deciding an application for an extension of the term of a petty patent, the Commissioner must consider:

- (a) any notice under subsection 28 (1) of the Act ("notice of matters affecting validity of petty patents") in relation to the petty patent; and
- (b) any matter of which the Commissioner has informed the patentee under subsection 28 (3) of the Act.

(2) If the Commissioner is satisfied that a ground mentioned in subsection 28 (1) of the Act is made out, the Commissioner may refuse to grant an extension of the term of the petty patent.

(3) If the Commissioner is satisfied that no ground mentioned in subsection 28 (1) of the Act is made out, the Commissioner must grant the extension of the term of the petty patent.

Prescribed period: lapse of applications for extension of term

6.7 (1) For the purposes of section 71 of the Act ("application for extension to lapse in certain circumstances"), the prescribed period is

1 month, or such longer period as the Commissioner reasonably allows, from the date of:

- (a) the making of the application mentioned in that section; or
- (b) the giving to the patentee of the certificate mentioned in paragraph (a) of that section;

whichever happens later.

(2) If an application has lapsed because of that section, the Commissioner must publish in the *Official Journal* a notice to that effect.

CHAPTER 7—PATENTS OF ADDITION

Form of application for grant of patent of addition etc.

7.1 (1) For the purposes of paragraph 81 (1) (c) of the Act (“grant of patent of addition”), an application for a further patent must be made under section 29 of the Act (“application for patent”).

(2) The Commissioner must not grant a patent of addition under subsection 81 (1) of the Act unless the date that would be the date of the patent if that patent of addition were granted is the same as, or later than, the date of the patent for the main invention.

Form of application for revocation of patent and grant of patent of addition instead

7.2 An application under section 82 of the Act (“revocation of patent and grant of patent of addition instead”) must be in the approved form.

CHAPTER 8—PCT APPLICATIONS AND CONVENTION APPLICATIONS

PART 1—PCT APPLICATIONS

International applications taken to be applications under the Act

8.1 (1) In this regulation:
“**priority date**”, in relation to an international application, has the same meaning as in the PCT.

(2) Where:

- (a) the receiving Office has declared that an international application that specifies Australia as a designated State

- under Article 4 (1) (ii) of the PCT is taken to be withdrawn;
or
- (b) the International Bureau has made a finding under Article 12 (3) of the PCT;
- the application is taken to be a PCT application as if a declaration or finding had not been made, if:
- (c) the applicant has made a request referred to in Article 25 (1) (a) of the PCT within the time limit specified in Rule 51.1 of the PCT; and
- (d) the Commissioner has received within the time limit specified in Rule 51.3 of the PCT:
- (i) fees prescribed for the purposes of paragraph 89 (3) (b) (“modified application of Act”); and
 - (ii) if the application is not in English—a translation of the application into English and a related certificate of verification; and
- (e) the Commissioner reasonably believes that:
- (i) the declaration was the result of an error or omission on the part of the receiving Office; or
 - (ii) the finding was the result of an error or omission on the part of the International Bureau.
- (3) For the purposes of subsection 89 (1) of the Act:
- (a) the requirements of subsection 29 (4) of the Act (“application for patent”); and
 - (b) subregulation 3.1 (1) (“prescribed documents: patent applications”) and regulation 3.2 (“specifications”);
- are prescribed.
- (4) The applicant must meet the requirements of subsection 89 (3) of the Act within the period of:
- (a) if the application is an application in respect of which Australia has been elected under Chapter II of the PCT within the period specified in Article 39 of the PCT—31 months from the priority date of that application; or
 - (b) in any other case—21 months from the priority date of that application.

Note: The text of the PCT is set out in Schedule 2.

Prescribed documents: PCT application

8.2 (1) In this regulation:

“PCT application” includes an amendment under Article 19 or 34 of the PCT.

(2) For the purposes of paragraph 89 (3) (a) of the Act (“modified application of Act”), if:

- (a) a PCT application is not filed in English; and
- (b) the PCT application has been published in English under Article 21 of the PCT; and
- (c) a translation of the application into English has not been filed before the date of publication under Article 21 of the PCT;

the publication under Article 21 of the PCT is taken to be the translation referred to in paragraph 89 (3) (a) of the Act and to have been verified in accordance with these Regulations.

(3) For the purposes of paragraph 89 (3) (b) of the Act, each of the following documents is prescribed:

- (a) a document setting out an address for service of documents in Australia;
- (b) if a PCT application has not been published under Article 21 of the PCT—a copy of the application;
- (c) if a PCT application is not filed in English and has not been published in English under Article 21 of the PCT—a translation of the application into English together with a related certificate of verification.

(4) The Commissioner must not, in relation to a PCT application that is treated as an application under the Act for:

- (a) a standard patent—give a direction under section 44 of the Act (“request for examination”); or
- (b) a petty patent—act under section 50 of the Act (“consideration and acceptance of patent request: petty patent”);

unless the applicant has complied with the requirements of subsection 89 (3) of the Act.

(5) In a PCT application, the applicant is taken to be the nominated person in respect of the application.

Note: The text of the PCT is set out in Schedule 2.

Modification of Act to apply to PCT applications

8.3 (1) For the purposes of paragraph 228 (2) (t) of the Act (“regulations”), the Act is modified in accordance with this regulation.

(2) Section 141 (“withdrawal of applications”):

Omit the section, substitute:

Withdrawal of applications

“141. (1) Subject to subsection (2), a patent application is to be treated as having been withdrawn if, and only if, the applicant files a written notice of withdrawal signed by the applicant.

“(2) A PCT application is to be treated as having been withdrawn if Article 11 (3) of the PCT ceases to have effect in Australia in relation to the application under Article 24 (1) (i) of the PCT.”.

(3) Subsection 142 (2) (“lapsing of applications”):

Add at the end:

“;or (f) Article 11 (3) of the PCT ceases to have effect in Australia in relation to the application under Article 24 (1) (ii) or (iii) or Article 39 (2) of the PCT”.

(4) Section 223 (“extensions of time”):

After subsection (1) insert:

“(1A) If, because of an error or omission by the receiving Office or the International Bureau, a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Commissioner must extend the time for doing the act.”.

Note: The text of the PCT is set out in Schedule 2.

Form of request and prescribed documents: PCT applications

8.4 (1) A request under subsection 92 (1) of the Act (“notice of publication”) must be in the approved form.

(2) For the purposes of subsection 92 (4) of the Act, the following documents are prescribed:

- (a) the documents specified in paragraphs 4.3 (c), (d) and (e) (“prescribed documents: public inspection”);
- (b) any International Search Report or Preliminary Examination Report made under the PCT and filed;
- (c) if the PCT application claims priority under Article 8 of the PCT of a provisional or complete application—a document

referred to in regulation 4.3, and a specification, in respect of that application.

Note: The text of the PCT is set out in Schedule 2.

PART 2—CONVENTION APPLICATIONS

Convention countries

8.5 (1) Each of the countries specified in Schedule 4 is declared to be a Convention country for the purposes of the definition of "Convention country" in the Act.

(2) For the purposes of section 94 of the Act ("Convention applicants may make Convention applications"), the period of 12 months from the day on which a basic application is first made in a Convention country in respect of the invention is prescribed.

Particulars required for Convention application

8.6 (1) For the purposes of paragraph 95 (2) (a) of the Act ("manner of making Convention application"), the following particulars are prescribed:

- (a) the name of the applicant;
- (b) the country in which the application was made;
- (c) the number allocated to the application by the official chief or head of the Patent Office of the Convention country in which the application was made;
- (d) the date on which the application was made;
- (e) if the application is not the first made in a Convention country in respect of the invention—the particulars specified in paragraphs (a) to (d) (inclusive) in respect of that first made application.

(2) For the purposes of subsection 95 (3) of the Act, the following documents are prescribed:

- (a) a copy of the specification relating to the basic application that is certified by the official chief or head of the Patent Office of the Convention country in which the basic application was made;
- (b) if that specification is not in English—a translation of the specification into English and a related certificate of verification.

(3) For the purposes of subsection 95 (3) of the Act, the period from the day on which the application is made to immediately before acceptance is prescribed.

Form of request in relation to withdrawn, abandoned or refused applications

8.7 A request under section 96 of the Act ("withdrawn, abandoned or refused applications") must be in the approved form.

CHAPTER 9—RE-EXAMINATION

Commissioner may re-examine complete specification when grant opposed

9.1 (1) The Commissioner may, within 1 month of the filing of a statement under subregulation 5.4 (1) ("filing of statement"), decide to re-examine under subsection 97 (1) of the Act ("re-examination of complete specifications") a complete specification in respect of the application in respect of which the grant of a patent is opposed.

(2) The Commissioner must notify an applicant and an opponent under Chapter 5 ("opposition") of his or her decision to re-examine a complete specification under subsection 97 (1) of the Act.

Request for re-examination of complete specification

9.2 (1) For the purposes of subsection 97 (2) of the Act ("re-examination of complete specifications"), a request for re-examination of a complete specification must be in the approved form.

(2) A request must:

- (a) identify the documents on which an assertion is based that the invention, so far as claimed in any claim and when compared with the prior art base as it existed immediately before the priority date of that claim:
 - (i) is not novel; and
 - (ii) does not involve an inventive step; and
- (b) state the relevance of each of those documents.

(3) The request must have with it:

- (a) if the document is not available in the Patent Office—a copy of the document; and

- (b) if the document is not in English—a translation of the document into English and a related certificate of verification; and
- (c) evidence of the date and place of publication of the document.

(4) If the request does not:

- (a) identify the documents on which the assertion is based; and
- (b) state the relevance of each document; and
- (c) have with it the documents referred to in subregulation (3);

the Commissioner may not re-examine the complete specification.

(5) A person who has made a request may, by filing a notice in writing, amend or withdraw the request before the Commissioner reports under section 98 of the Act (“report on re-examination”).

(6) If the person who made the request is not the patentee, the Commissioner must notify the patentee of his or her decision to re-examine the complete specification.

(7) A patentee or another person who has requested re-examination of the complete specification under subsection 97 (2) of the Act must give notice to the Commissioner of any relevant proceedings in relation to the patent of which he or she is aware.

Copy of report on re-examination

9.3 (1) If a person who asked for the re-examination is not the patentee, a copy of the report under section 98 of the Act (“report on re-examination”) must be given to the person by the Commissioner.

(2) The Commissioner must give an opponent under Chapter 5 of the Act (“opposition”) a copy of the report in respect of a complete specification in relation to the application in respect of which the grant of a patent is opposed.

Prescribed period: statement disputing report by Commissioner

9.4. (1) For the purposes of subsection 99 (1) of the Act (“statement by applicant or patentee”), the period of 2 months after the day on which the Commissioner reports under section 98 of the Act (“report on re-examination”) is prescribed.

(2) The Commissioner must give a copy of a statement filed under subsection 99 (1) of the Act to:

- (a) an opponent under Chapter 5 of the Act ("opposition") in respect of the re-examined complete specification in relation to the application in respect of which the grant of a patent is opposed; and
- (b) if the person who asked for the re-examination is not the patentee—that person.

Completion of re-examination

9.5 If the Commissioner makes an adverse report on a re-examination under subsection 97 (1) or (2) of the Act ("re-examination of complete specifications") and:

- (a) a statement is filed under section 99 of the Act ("statement by applicant or patentee") and:
 - (i) the Commissioner gives the applicant an opportunity to be heard that is referred to in subsection 107 (2) of the Act ("amendments directed by Commissioner: patent applications") within 3 months from the day when the Commissioner reports under section 98 of the Act ("report on re-examination"); or
 - (ii) the applicant or patentee asks for leave to amend the complete specification to remove any lawful grounds of objection specified in a report on re-examination within 3 months from the day referred to in subparagraph (i);

the re-examination is completed when the decision is made whether or not the amendment is allowed; or

- (b) a statement is filed under section 99 of the Act and subparagraphs (a) (i) and (ii) do not apply—the re-examination is completed 2 months from the day when the Commissioner reports under section 98 of the Act; or
- (c) a statement is not filed under section 99 of the Act and:
 - (i) the Commissioner gives the applicant an opportunity to be heard that is referred to in subsection 107 (2) of the Act within 2 months from the day when the Commissioner reports under section 98 of the Act; or
 - (ii) the applicant or patentee asks for leave to amend the complete specification to remove any lawful grounds of objection specified in a report on re-examination within 2 months from the day when the Commissioner reports under section 98 of the Act;

the re-examination is completed when the decision is made whether or not the amendment is allowed; or

- (d) a statement is not filed under section 99 of the Act and subparagraphs (c) (i) and (ii) do not apply—the re-examination is completed 2 months from the day when the Commissioner reports under section 98 of the Act.

CHAPTER 10—AMENDMENTS

Form of amendments

10.1 (1) For the purposes of subsection 104 (1) of the Act (“amendments by applicants and patentees”), an applicant or a patentee may ask the Commissioner for leave to amend a patent request or complete specification or another filed document by filing a request for leave to amend in the approved form together with a statement of proposed amendments.

(2) If:

- (a) a proposed amendment is to be made by means of substituting 1 page or document for another page or document; or
- (b) the Commissioner requires the applicant or patentee to make a proposed amendment by that means;

the applicant or patentee must file:

- (c) 2 copies of each page or document that is to be substituted for a page of the request or document; and
- (d) 3 copies of each page that is to be substituted for a page of the complete specification; and
- (e) on 1 of the copies, an indication of the nature and location of the proposed amendments.

(3) The Commissioner may require an applicant or a patentee to file, within 3 months of being asked to do so, a statement of the reasons for the request being made and any evidence in support of the request.

(4) The Commissioner may, before granting leave to amend, require a patentee to file within 1 month of being asked to do so, a statement that, to the best of his or her knowledge, relevant proceedings are not pending in relation to the patent.

(5) For the purposes of this Chapter, a statement of proposed amendments may be amended by filing a statement of proposed

amendments of the first-mentioned statement before allowance of those amendments.

Commissioner to consider and deal with requests for leave to amend

10.2 (1) For the purposes of subsection 104 (2) of the Act (“amendments by applicants and patentees”), the Commissioner must report on whether:

- (a) the request for leave to amend and the statement of proposed amendments do not comply with regulation 10.1 (“form of amendments”) and Schedule 3; and
- (b) any proposed amendment of a complete specification is not allowable under section 102 of the Act (“what amendments are not allowable?”); and
- (c) the proposed amendments are not allowable under regulation 10.3 (“amendments not allowable”) or, if made, would not otherwise be allowable under the Act or these Regulations.

(2) The Commissioner must give a copy of each report made under subregulation (1) to the applicant or patentee.

(3) The applicant or patentee may contest in writing the report or file a statement of proposed amendments of the statement referred to in paragraph (1) (a).

(4) If a statement of proposed amendments referred to in subregulation (3) is filed, the Commissioner must report under subregulation (1) as if the proposed amendments had been made.

(5) If, under subregulation (3), the applicant or patentee contests the report, the Commissioner must report under subregulation (1) and take notice of the matters raised by the applicant or patentee.

(6) If:

- (a) the grant of a standard patent is opposed under section 59 of the Act (“opposition to grant of standard patent”); or
- (b) a person has given the Commissioner a notice under section 28 of the Act (“notice of matters affecting validity of petty patents”) and the Commissioner has not decided the application under section 69 of the Act (“extension of term of petty patent”);

and the applicant or patentee has requested leave to amend the patent request or complete specification concerned, the Commissioner must:

- (c) give a copy of the request for leave to amend and the statement of proposed amendments to the opponent or person referred to in paragraph (b) as soon as practicable after the request for leave to amend has been filed; and
- (d) invite that opponent or person to comment on the request and statement.

(7) The opponent or person may file comments within 2 months of being given the copy of the request for leave to amend and the statement under paragraph (6) (c).

(8) If:

- (a) a person has, under subregulation 3.25 (1) ("request for Commissioner's certificate authorising release of sample of a micro-organism"), requested the Commissioner to grant the certification referred to in that subregulation; and
- (b) the Commissioner has not made a decision under subregulation 3.25 (2); and
- (c) the applicant or patentee has filed a request for leave to amend the complete specification in respect of a matter mentioned in paragraph 6 (c) of the Act ("deposit requirements");

the Commissioner must, as soon as practicable after the request for leave to amend has been filed, give a copy of that request and the statement of proposed amendments to the person referred to in paragraph (a).

(9) If a request for leave to amend a complete specification in respect of a micro-organism is made for the purpose of including in the specification a matter in respect of which a notice has been filed by a person under subregulation 3.29 (1) ("notification that a deposit requirement has ceased to be satisfied"), the Commissioner must, as soon as practicable after the request for leave to amend has been filed, give the person a copy of the request and the statement of proposed amendments.

Amendments not allowable

10.3 (1) A proposed amendment of a provisional specification is not allowable if it would materially alter the meaning or scope of the specification.

(2) A proposed amendment of a complete specification is not allowable if:

- (a) it is in respect of a matter mentioned in paragraph 6 (c) of the Act (“deposit requirements”); and
- (b) after the amendment were made the specification would not include each of the matters specified in that paragraph.

(3) A proposed amendment of a patent request is not allowable if:

- (a) the patent request has been accepted under section 49 (“acceptance of patent request: standard patent”) or 50 (“consideration and acceptance of patent request: petty patent”) of the Act; and
- (b) it would convert the patent application from:
 - (i) an application for a standard patent to an application for a petty patent; or
 - (ii) an application for a petty patent to an application for a standard patent.

(4) The Commissioner must not allow a proposed amendment of a complete specification if he or she has:

- (a) under subregulation 10.2 (8) or (9) (“Commissioner to consider and deal with requests for leave to amend”) given a person a copy of the request for leave to amend and the statement of proposed amendments; and
- (b) not given the person a reasonable opportunity to be heard.

Commissioner to refuse request for leave to amend

10.4 The Commissioner must refuse the request for leave to amend, if:

- (a) he or she reasonably believes that a proposed amendment is not allowable, other than for the reasons mentioned in subregulation 10.3 (4) (“amendments not allowable”); or
- (b) the applicant or patentee has not complied with a request of the Commissioner under subregulation 10.1 (3) (“form of amendments”); or
- (c) in the case of a proposed amendment of a complete specification relating to a patent—the patentee has not complied with a request of the Commissioner under subregulation 10.1 (4).

Commissioner to grant leave to amend

10.5 (1) The Commissioner must grant leave to amend a patent request, complete specification or another filed document, if:

- (a) a report under subregulation 10.2 (“Commissioner to consider and deal with requests for leave to amend”) is not an adverse report; and
- (b) in the case of proposed amendments of a patent request or complete specification made in anticipation of, or response to, a report relating to an examination or a notice relating to a consideration of a complete application for a petty patent under section 50 of the Act (“consideration and acceptance of patent request: petty patent”)—the Commissioner reasonably believes that the amendments would remove all lawful grounds of objection to the patent request or specification.

(2) If the Commissioner grants leave to amend, he or she must publish a notice of that fact in the *Official Journal*, where:

- (a) the patent request and complete specification to which the leave to amend relates have been accepted under section 49 (“acceptance of patent request: standard patent”) or 50 of the Act; and
- (b) the proposed amendments are in respect of:
 - (i) the complete specification; or
 - (ii) the patent request or another filed document and the proposed amendments would materially alter the meaning or scope of the request or document.

(3) The Minister or another person may oppose allowance of an amendment if a notice is published under subregulation (2).

(4) For the purposes of paragraph (2) (b), if:

- (a) a request for leave to amend is filed before a patent is granted on an application under section 61 (“grant of standard patent”) or 62 (“grant and publication of petty patent”) of the Act; and
- (b) the proposed amendments relate to the name or address of an applicant for the patent;

the proposed amendments are not taken to materially alter the meaning or scope of the patent request or other filed document.

Allowance of amendments

10.6 (1) If, under subregulation 10.5 (1) (“Commissioner to grant leave to amend”), the Commissioner grants leave to amend a patent request

or complete specification and the request or specification has not been accepted under section 49 ("acceptance of patent request: standard patent") or 50 ("consideration and acceptance of patent request: petty patent") of the Act, he or she must, subject to any conditions, allow the amendments forthwith.

(2) If the Commissioner grants leave to amend a patent request or complete specification to which paragraph 10.5 (1) (b) applies and:

- (a) the proposed amendments do not relate to a matter mentioned in section 5 of the Act ("associated applications"); or
- (b) the proposed amendments of the complete specification would include matters mentioned in paragraph 6 (c) of the Act ("deposit requirements");

the Commissioner must allow the amendments immediately before acceptance.

(3) Subject to subregulation (4), if under subregulation 10.5 (1):

- (a) the Commissioner grants leave to amend a patent request or complete specification; and
- (b) publishes a notice of that fact under subregulation 10.5 (2);

the Commissioner must allow the proposed amendments:

- (c) where a person has not opposed allowance of the amendments; or
- (d) subject to the terms of any decision of a prescribed court, the Tribunal or the Commissioner in respect of the opposition.

(4) If the Commissioner requires the patentee to file a statement that, to the best of the knowledge of the patentee, relevant proceedings are not pending, the patentee must file the statement within 1 month.

Correction of Register or patent

10.7 (1) The Commissioner may, on a request being made in the approved form, amend:

- (a) an entry in the Register for the purposes of:
 - (i) correcting a clerical error or an obvious mistake; or
 - (ii) if a name or an address entered in the Register has been changed—changing the name or address; or
- (b) a patent for the purposes of correcting a clerical error or an obvious mistake.

(2) The Commissioner may, if he or she proposes to amend a patent or an entry in the Register, give notice to a person whose name is entered in the Register as having an interest in the patent.

(3) If a proposed amendment would materially alter the meaning or scope of an entry in the Register or a patent, the Commissioner must publish in the *Official Journal* a notice of the request to amend the entry or the patent.

(4) If a notice is published, a person may oppose the making of the amendment.

(5) If the Commissioner publishes a notice of the request to amend, he or she must amend the patent or the entry in the Register:

- (a) where a person has not opposed allowance of the amendments; or
- (b) subject to the terms of any decision of a prescribed court, the Tribunal or the Commissioner in respect of the opposition.

(6) The Commissioner may, of his or her own motion, amend a patent or an entry in the Register to correct a clerical error or an obvious mistake.

Prescribed decisions: appeal to Federal Court

10.8 For the purposes of subsection 104 (7) of the Act ("amendments by applicants and patentees"), a prescribed decision is a decision to grant leave to amend a patent request or complete specification to which paragraph 10.5(1)(b) applies ("Commissioner to grant leave to amend").

Pending proceedings: amendments relating to micro-organisms

10.9 The Commissioner must not amend a complete specification relating to a patent if the amendment would include matters mentioned in paragraph 6 (c) of the Act ("deposit requirements") while relevant proceedings are pending.

Prescribed period: filing of court order

10.10 For the purposes of subsection 105 (5) of the Act ("amendments directed by court"), the period of 14 days from the date of the order of the court is prescribed.

Form of direction by Commissioner: patents

10.11 A direction of the Commissioner under subsection 106 (1) of the Act (“amendments directed by Commissioner: patents”):

- (a) must be in writing; and
- (b) must state the grounds on which he or she is satisfied that the patent relating to the direction is invalid; and
- (c) must specify the time within which the patentee must file a relevant statement of proposed amendments.

Form of direction by Commissioner: applications

10.12 A direction of the Commissioner under subsection 107 (1) of the Act (“amendments directed by Commissioner: patent applications”):

- (a) must be in writing; and
- (b) must state the grounds on which he or she is satisfied that there are lawful grounds of objection to the patent request or complete specification; and
- (c) must specify the time within which the applicant must file a relevant statement of proposed amendments.

Form of direction by Commissioner: extension of petty patent term

10.13 A direction of the Commissioner under subsection 108 (1) of the Act (“amendments directed by Commissioner: extensions of term of petty patents”):

- (a) must be in writing; and
- (b) must state the grounds on which he or she is satisfied that the petty patent relating to the direction is invalid; and
- (c) must specify the time within which the patentee must file a relevant statement of proposed amendments.

Form of request: claim under assignment or agreement

10.14 A request under subsection 113 (1) of the Act (“persons claiming under assignment or agreement”) for a direction of the Commissioner must be in the approved form.

CHAPTER 11—INFRINGEMENT

Infringement exemptions: prescribed foreign countries

11.1 For the purposes of the definitions of “foreign aircraft”, “foreign land vehicle” and “foreign vessel” in the Act, each of the foreign countries specified in Part 1 in Schedule 4 is prescribed.

CHAPTER 12—COMPULSORY LICENCES AND REVOCATION OF PATENTS

Lodgment of applications for compulsory licences

12.1 (1) For the purposes of subsection 133 (1) of the Act (“compulsory licences”), the period of 3 years after the date of sealing of the patent to which the application relates is prescribed.

(2) An applicant must lodge with the Registrar of the prescribed court to which the application is made:

- (a) a copy of the application that includes:
 - (i) the name and address of the applicant; and
 - (ii) the address for service in relation to the application; and
 - (iii) the identity of the patent; and
 - (iv) facts supporting the assertion that the reasonable requirements of the public with respect to the patented invention have not been satisfied; and
- (b) a declaration by the applicant to the effect that the facts in the statement are true to the best of the knowledge of the applicant.

(3) The applicant must:

- (a) serve a copy of the application and declaration on the patentee and any other person who claims an interest in the patent as soon as practicable after lodgment; and
- (b) lodge with the Registrar notice of the date when, and the place where, he or she complied with paragraph (a).

Prescribed period: revocation of standard patent

12.2 (1) For the purposes of subsection 134 (1) of the Act (“revocation of standard patent after grant of compulsory licence”), the period of 2 years after the date of the grant of the first compulsory licence in respect of a standard patent is prescribed.

(2) A prescribed court may, as a preliminary issue, hear and determine the question of the right of the person concerned to apply for revocation of a patent in respect of which a compulsory licence has been ordered.

Form of notice: offer to surrender patent

12.3 (1) A notice under subsection 137 (1) of the Act (“revocation on surrender of patent”) must be in the approved form.

(2) Notice of an offer to surrender under subsection 137 (2) of the Act must be published in the *Official Journal*.

(3) An interested person must, not later than 1 month after the publication, give the Commissioner notice of his or her wish to be heard under subsection 137 (3) of the Act.

(4) The Commissioner may, as a preliminary issue, hear and determine the question of the right of the person concerned to be heard.

Applications to revoke patents

12.4 (1) An applicant to a prescribed court for an order to revoke a patent under subsection 138 (1) of the Act (“revocation of patents in other circumstances”) must include in:

- (a) the pleading; or
- (b) another document disputing the validity of the patent; particulars of the grounds on which he or she relies.

(2) If 1 of those grounds is that the invention is not a patentable invention because of information about the invention in a document or through the doing of an act, the particulars must specify:

- (a) in the case of a document— the time when, and the place where, the document is alleged to have become publicly available; and
- (b) in the case of an act:
 - (i) the name of the person alleged to have done the act; and
 - (ii) the period in which, and the place where, the act is alleged to have been done publicly; and
 - (iii) a description that is sufficient to identify the act; and
 - (iv) if the act relates to apparatus or machinery—whether the apparatus or machinery exists and, if so, where it can be inspected.

(3) Except by leave of the court:

- (a) evidence is not admissible to prove a ground of invalidity that has not been disclosed in the particulars in relation to that ground; and

- (b) evidence as to apparatus or machinery that exists at the date of lodgment of the particulars is not admissible unless it is proved that the party relying on the evidence:
 - (i) if the apparatus or machinery is in his or her possession—has offered the opportunity to inspect it; or
 - (ii) in any other case—has used reasonable endeavours to obtain its inspection;to, or by, each other party to the hearing of the application.
- (4) The court may:
 - (a) extend the time for giving particulars; and
 - (b) allow the amendment of particulars.

CHAPTER 13—WITHDRAWAL AND LAPSING OF APPLICATIONS AND CEASING OF PATENTS

Publication of notice of withdrawal of application

13.1 The Commissioner must publish notice in the *Official Journal* of the withdrawal of a patent application under section 141 of the Act (“withdrawal of applications”).

Prescribed period: request for examination of applications

13.2 The period of 9 months from the date on which the request for deferment of the examination was filed is prescribed for the purposes of paragraph 142 (2) (c) of the Act (“lapsing of applications”).

Prescribed period: continuation fees

13.3 (1) Subject to this regulation, for the purposes of paragraph 142 (2) (d) of the Act (“lapsing of applications”), the period of 12 months ending at the end of an anniversary of the date (being an anniversary specified in column 2 of item 8 of Part 2 in Schedule 7) that would be the date of the patent if a patent were granted on the application is prescribed for the payment of a continuation fee.

(2) In the case of an application to which section 33 (“applications by opponents etc.”), 34 (“applications by eligible persons arising out of court proceedings”), 35 (“applications by eligible persons following revocation by Commissioner”), 36 (“other applications by eligible persons”) or 39 (“divisional applications”) of the Act applies, a

continuation fee that is payable before 12 months after the date of filing of the application is taken to have been paid.

(3) If a continuation fee is not paid in the period referred to in subregulation (1), but is paid within 6 months after the anniversary concerned, the prescribed period is extended to the day on which the fee is paid.

Prescribed period: acceptance of request and specification

13.4 The period prescribed for the purposes of paragraph 142 (2) (e) of the Act ("lapsing of applications") is:

- (a) whichever is the later of:
 - (i) if examination is requested under subsection 47 (2) of the Act ("request for modified examination") after the Commissioner first reported under section 48 of the Act ("modified examination")—the period of 12 months from the date of the first report on the examination under section 45 of the Act ("examination"); or
 - (ii) the period of 21 months from the date of the first report under section 48 of the Act; or
- (b) if paragraph (a) does not apply—the period of 21 months from the date of the first report under section 45 of the Act; or
- (c) if:
 - (i) if the Commissioner has reported that the patent request or complete specification relates to an invention that, so far as claimed, is not novel in view of information of the kind described in subparagraph (b) (ii) of the definition of "prior art base" in the Act—the period of 3 months from the date of publication of the specification containing that information or its lapsing, refusal or withdrawal, whichever is the earlier; or
 - (ii) the patent request and complete specification relate to an application to which subsection 36 (3) of the Act ("other applications by eligible persons") applies—the period 3 months from the date of the declaration of the Commissioner under subsection 36 (1) of the Act; or
 - (iii) in the case of an appeal to a prescribed court or an application for review to the Tribunal in relation to

the patent request or complete specification—the period of 3 months from the day when the appeal or application is withdrawn or finally dealt with or determined, or such further period as the court or Tribunal allows; or

- (iv) in the case of an application for a patent of addition, if an appeal to a prescribed court or an application for review to the Tribunal in respect of the application for a patent for the main invention has been instituted—the period of 3 months from the day when the appeal or application is withdrawn or finally dealt with or determined, or such further period as the court or Tribunal allows;

whichever ends later.

If applications lapse

13.5 If a complete application lapses under section 142 (“lapsing of applications”), the Commissioner must advertise that fact in the *Official Journal*.

Time for payment of renewal fee for standard patent

13.6 (1) For the purposes of paragraph 143 (a) of the Act (“ceasing of patents”), subject to subregulation (2), the period of 12 months ending at the end of an anniversary of the date of the patent (being an anniversary specified in column 2 of item 8 or 9 of Part 2 in Schedule 7) is prescribed for the payment of renewal fee.

(2) If a continuation fee is paid in respect of an anniversary, the renewal fee in respect of that anniversary is taken to have been paid.

(3) Subject to subregulation (4), if a renewal fee is not paid in the period referred to in subregulation (1), but is paid within 6 months after the anniversary concerned, the prescribed period is extended to the day on which the fee is paid.

(4) If:

- (a) an extension of the term of a patent is applied for under subsection 70 (1) of the Act (“application for extension of term of patent relating to a pharmaceutical substance”); and
- (b) a renewal fee in respect of 1 or more anniversaries of the date of the patent (being an anniversary specified in column 2 of

- item 8 or 9 of Part 2 in Schedule 7) is payable before an extension is granted under subsection 75 (2) or (4) of the Act (“determination of application for extension”); and
- (c) the fee is paid within 6 months of the day when the extension is granted;
- the prescribed period is extended to the day on which the fee is paid.

(5) The Commissioner must publish notice in the *Official Journal* of a patent that ceases under section 143 of the Act.

CHAPTER 15—SPECIAL PROVISIONS RELATING TO ASSOCIATED TECHNOLOGY

Time for restoration of application for patent

15.1 A request under subsection 150 (1) of the Act (“restoration of lapsed application”) must be filed within 3 months after the revocation under section 149 of the Act (“revocation of direction”) of a direction in respect of the application to which the request relates.

Requirements for reinstatement of international applications

15.2 (1) For the purposes of paragraph 151 (4) (c) of the Act (“reinstatement of application as an international application”), the period of 3 months after the revocation of a direction under section 149 of the Act (“revocation of direction”) is prescribed.

(2) For the purposes of paragraph 151 (4) (d) of the Act, the patent request, the specification to which the request relates and such other documents as are prescribed for the purposes of subsection 29 (1) of the Act (“application for patent”) are prescribed.

(3) For the purposes of paragraph 151 (4) (d) of the Act, the fee that would have been payable if the application had been filed under section 29 of the Act is prescribed.

Prescribed period: order relating to a standard patent

15.3 For the purposes of subsection 153 (3) of the Act (“effect of order”), the period of 1 month from the revocation of the order under subsection 152 (3) of the Act (“notice of prohibitions or restrictions on publication”) that relates to the application.

CHAPTER 17—THE CROWN

Prescribed period: order relating to a standard patent

17.1 For the purposes of subsection 174 (2) of the Act (“effect of prohibition orders”), the period of 1 month from the revocation of an order under subsection 173 (1) of the Act (“prohibition of publication of information about inventions”) that relates to the application is prescribed.

Prescribed period, document and fee: filing of international applications

17.2 (1) For the purposes of paragraph 176 (c) of the Act (“international applications treated as applications under this Act”), the period of 3 months from the date on which an international application is considered to be withdrawn under Article 12 of the PCT is prescribed.

(2) For the purposes of paragraph 176 (d) of the Act, the patent request, the specification relating to the request and such other documents as are prescribed for the purposes of subsection 29 (1) of the Act (“application for patent”) are prescribed.

(3) For the purposes of paragraph 176 (d) of the Act, the fee that would have been payable if the application had been filed under section 29 of the Act is prescribed.

Note: The text of the PCT is set out in Schedule 2.

CHAPTER 19—THE REGISTER AND OFFICIAL DOCUMENTS

Particulars to be registered

19.1 (1) For the purposes of section 187 of the Act (“registration of particulars of patents etc.”), the following particulars are prescribed, that is, particulars of:

- (a) an entitlement as mortgagee, licensee or otherwise to an interest in a patent;
- (b) a transfer of an entitlement to a patent or licence, or to a share in a patent or licence;
- (c) an extension of the term of a patent;
- (d) a restoration of a standard patent;

- (e) an order of a court a copy of which is filed under subsection 105 (5) of the Act (“amendments directed by court”);
- (f) an order of a prescribed court that has been served on the Commissioner under section 140 of the Act (“Commissioner to be given copies of orders”);
- (g) an order of a prescribed court made on appeal in relation to a patent, being an order of which an office copy has been served on the Commissioner;
- (h) a decision of the Commissioner to revoke a patent under Chapter 9 of the Act (“re-examination”);
- (i) the acquisition of a patent by the Commonwealth under Part 3 (“acquisitions by and assignments to the Crown”) of Chapter 17 (“the Crown”) of the Act;
- (j) the cessation of a patent.

(2) A request for registration of particulars referred to in paragraph (1) (a) or (b) must be in the approved form and have with it proof to the reasonable satisfaction of the Commissioner of the entitlement of the person making the request.

Request for information from Commissioner

19.2 (1) A request made to the Commissioner under paragraph 194 (c) of the Act (“information obtainable from the Commissioner”) must be in the approved form.

(2) A request under Article 15 (5) of the PCT for an international-type search to be carried out must be made by the applicant referred to in that Article within 3 months of the making of the application referred to in the Article.

Note: The text of the PCT is set out in Schedule 2.

CHAPTER 20—PATENT ATTORNEYS

PART 1—INTRODUCTORY

Interpretation

20.1 In this Chapter, unless the contrary intention appears:
“**Board**” means the Patent Attorneys Professional Standards Board established by subregulation 20.32 (1) ;

“candidate” means a person who proposes or proposed to sit, or has sat, for an examination;

“Disciplinary Tribunal” means the Patent Attorneys Disciplinary Tribunal established by regulation 20.41;

“examination” means an examination held under regulation 20.6;

“former attorney” means a patent attorney whose registration has been suspended or cancelled under Part 4 (“discipline”);

“Institute” means the Institute of Patent Attorneys of Australia incorporated under the law of Victoria;

“member” means a member of the Board other than the Commissioner;

“Register of Patent Attorneys” means the register kept under section 198 of the Act (“registration of patent attorneys”);

“unprofessional conduct” means conduct on the part of a patent attorney whereby he or she can be regarded as committing a gross failure to comply with the standards that, in the circumstances, it is reasonable to require the patent attorney to observe;

“unqualified”, in relation to a particular time, means lacking a qualification required for registration at that time by these Regulations or the former attorneys Regulations;

“unsatisfactory conduct” means not having attained or sustained a professional standard that is consistent with the standard of practice of patent attorneys.

How to make an application

20.2 (1) An application under this Chapter, other than an application under regulation 20.4 (“procedure for registration”) or 20.19 (“restoration of patent attorney’s name to the Register”), may be made by sending it to the Patent Office addressed to the Secretary to the Board.

(2) An application under regulation 20.4 or 20.19 may be made by sending it to the Patent Office addressed to the Commissioner and marked for the attention of the Secretary to the Board.

PART 2—OBTAINING REGISTRATION FOR THE FIRST TIME

Division 1—Generally

Requirements for registration

20.3 For the purposes of subsection 198 (2) of the Act (“registration of patent attorneys”):

- (a) the prescribed subjects that a person must have passed are those specified in column 2 of Schedule 5; and
- (b) the prescribed qualifications that a person must have are that the person:
 - (i) is of good fame and character; and
 - (ii) has satisfied the Board that he or she has been awarded, or is entitled to be awarded, a qualification referred to in column 2 of Schedule 6; and
- (c) the prescribed employment is employment as a technical assistant in the conduct of the practice of a patent attorney in matters arising under the Act or the 1952 Act; and
- (d) the prescribed period of that employment is:
 - (i) 1 continuous period of not less than 1 year; or
 - (ii) periods within a continuous period of 2 years that total not less than 1 year.

Procedure for registration

20.4 A person may apply for registration as a patent attorney in the approved form together with:

- (a) evidence that the person is an Australian citizen; and
- (b) evidence of the person's age; and
- (c) a certificate issued to the person under regulation 20.16 ("certificate of completion of examinable subjects and of academic qualifications"); and
- (d) evidence that the person has been employed as required by regulation 20.3 ("requirements for registration"); and
- (e) certificates in the approved form by 3 persons to whom the person has been known for not less than 12 months immediately before the certificates are given that the applicant is of good fame and character.

Certificate of registration

20.5 When the Commissioner registers a person as a patent attorney the Commissioner must give to the person a certificate of registration in the approved form.

Division 2—Prescribed subjects and academic qualifications**Examination to be conducted**

20.6 (1) The Board is to hold an examination in the subjects specified in Schedule 5.

(2) The Board may appoint examiners for the purposes of the examinations and give them instructions about the setting and marking of papers.

(3) Examiners appointed under this regulation are entitled to be paid the fees that the Minister determines in writing.

Time for holding examinations

20.7 (1) An examination must be held in October, November or December each year.

(2) The Board must arrange to publish in the *Official Journal* adequate notice of:

- (a)** the time of each examination and the place where it is to be held; and
- (b)** the deadline for applications for admission to sit for each examination.

(3) Subregulations (1) and (2) do not apply to a supplementary examination under regulation 20.12 (“supplementary examination”).

Particulars of subjects

20.8 From time to time the Board must arrange to publish in the *Official Journal* particulars of:

- (a)** the scope of the subjects specified in column 2 of Schedule 5; and
- (b)** the books it recommends to candidates.

Admission to sit for an examination

20.9 (1) An application by a person to sit for an examination must be in the approved form.

(2) A person is not eligible to sit for an examination in a subject mentioned in item 5, 6, 7 or 8 in Schedule 5 unless the person has passed,

or been exempted from having to pass, the subjects mentioned in items 1, 2, 3 and 4 in that Schedule.

Notification of results

20.10 As soon as practicable after an examination, the Board must give to each candidate who sat for the examination his or her results in the examination.

Reasons for failure

20.11 The Board may give a report of the reasons for the failure to a candidate who failed an examination if the candidate applies to the Board for a report of the reasons for that failure in the approved form within 1 month of being informed of the failure .

Supplementary examination

20.12 (1) An application by a person to sit for a supplementary examination must be in the approved form.

(2) The Board may let a candidate sit for a supplementary examination if the candidate:

- (a) failed an examination and applies to the Board to sit for the supplementary examination within 1 month of being told of the failure; or
- (b) did not sit for the examination because of illness or another reason that the Board reasonably considers sufficient and he or she applies to the Board to sit for the supplementary examination within 1 month of the examination.

Exemption from examination

20.13 (1) The Board may exempt a person from having to pass an examination.

- (2)** The Board must not give an exemption to a person unless:
 - (a) the person makes an application in the approved form; and
 - (b) the Board is satisfied that the person has passed, at a satisfactory level, an examination in a subject covering the same, or a similar, field of knowledge.

(3) If the Board exempts a person, it must give to the person a certificate of exemption in the approved form.

Approval of courses and examinations

20.14 (1) The Board may approve a course mentioned in item 1 or 2 of Schedule 6.

- (2) In approving a course, the Board must:
- (a) have regard to the syllabus for the course; and
 - (b) in the case of a course mentioned in item 2 of Schedule 6—reasonably believe that the standard of the course is at least equal to the standard of a degree, diploma or postgraduate diploma of an Australian tertiary educational institution in a branch of engineering or science.

(3) The Board may approve an examination mentioned in item 3 of Schedule 6.

(4) In approving an examination referred to in subregulation (3), the Board must have regard to the syllabus for any course undertaken by a person preparing for the examination.

(5) For the purposes of item 3 of Schedule 6, the Board may approve a professional institution.

Certificate of academic qualifications

20.15 The Board must give to a person a certificate that the person has a qualification specified in Schedule 6 if:

- (a) the person makes an application in the approved form; and
- (b) the application has with it evidence that the person has that qualification; and
- (c) the Board is reasonably satisfied that the person has the qualification.

Certificate of completion of examinable subjects and of academic qualifications

20.16 The Board must give to a person a certificate in the approved form that the person:

- (a) has passed or is exempt under regulation 20.13 (“exemption from examination”) the subjects specified in Schedule 5; and
- (b) has a qualification specified in Schedule 6;

if:

- (c) the person applies in the approved form for the certificate; and
- (d) the application has with it a copy of each of the certificates referred to in regulations 20.13 and 20.15 ("certificate of academic qualifications").

Division 3—Rights of Patent Attorneys

Lien

20.17 A patent attorney has the same right of lien over documents and property of a client as a solicitor.

PART 3—RENEWAL OF REGISTRATION: PAYMENT OF ANNUAL FEE

Annual registration fee

20.18 (1) An annual registration fee is payable by a patent attorney on 1 July in each year.

(2) The Commissioner must give to each patent attorney no later than 1 June in each year notice of the fee that is payable.

(3) If a patent attorney does not pay the fee within 14 days after it is payable, the Commissioner must:

- (a) remove the name of the attorney from the Register of Patent Attorneys; and
- (b) notify the attorney of that removal.

Restoration of patent attorney's name to the Register

20.19 The Commissioner may restore a person's name to the Register of Patent Attorneys if:

- (a) the person pays the fee referred to in regulation 20.18 ("annual registration fee"); and
- (b) applies in the approved form;

within 6 weeks after the end of the period mentioned in subregulation 20.18 (3) ("annual registration fee") or such further period as the Commissioner reasonably allows.

PART 4—DISCIPLINE

*Division 1—Complaints, decisions of the Disciplinary Tribunal and consequential action***Complaints**

20.20 (1) The Institute or a person who alleges that his or her interests are affected by the unprofessional conduct of a patent attorney may make a written complaint to the Board about that conduct.

(2) The Institute or a person may complain in writing to the Board:

- (a) that a patent attorney was unqualified at the time of his or her registration; or
- (b) that the patent attorney obtained his or her registration by fraud.

(3) A complaint must:

- (a) state the name of the patent attorney complained about and the address of the attorney, if known to the complainant; and
- (b) state the nature of the complaint; and
- (c) state the name and address of the complainant; and
- (d) be signed by the complainant; and
- (e) have with it a statutory declaration stating the facts on which the complainant relies to support the complaint.

(4) If the complaint is made by the Institute, the statutory declaration must be made by an officer of the Institute.

(5) The Board must give to the patent attorney a copy of the complaint and statutory declaration and ask the attorney to give to the Board a written statement replying to the complaint.

(6) The statement must be given to the Board within the period specified by the Board, being a period of not less than 21 days from the day on which the patent attorney was asked to give a statement.

(7) The Board may request the Commissioner, the complainant or the patent attorney to give it further information not less than 21 days after the day on which the request was given.

(8) The period of 21 days for giving further information may be extended by the Board before or after that period.

Authorisation to bring proceedings against a patent attorney

20.21 (1) A person may not bring proceedings against a patent attorney before the Disciplinary Tribunal unless the person is authorised under this regulation.

(2) The Board must give written authority to a complainant to bring proceedings against a patent attorney:

- (a) charging the attorney with unsatisfactory conduct or unprofessional conduct; or
- (b) charging that the attorney was unqualified at the time of his or her registration or obtained his or her registration by fraud; if it appears to the Board, after considering the complaint and any reply and any further information given under regulation 20.20 ("complaints"), that the attorney may be guilty of conduct of that kind or may have been unqualified, as the case may be.

(3) If the Board authorises a complainant to bring proceedings, it must inform the complainant that he or she may ask the Board to bring those proceedings on the complainant's behalf.

(4) If a person authorised to bring proceedings:

- (a) informs the Board that he or she wants the Board to bring the proceedings—the Board must bring the proceedings on behalf of the complainant; or
- (b) does not bring the proceedings within 21 days after the day on which the authority is sent to him or her—the Board may bring the proceedings on its own behalf.

(5) If a person has begun proceedings but fails to continue them, the Board may continue the proceedings on its own behalf.

(6) If the Board authorises proceedings against a patent attorney, the Board must:

- (a) give the Disciplinary Tribunal copies of the complaint and all other documents it holds that relate to the complaint; and
- (b) notify the attorney, in writing, of that authorisation.

(7) If the Board, after considering a complaint and any reply and any further information given under regulation 20.20, decides not to authorise proceedings against a patent attorney, it must give written notice of its decision to the complainant and the attorney.

Bringing of proceedings

20.22 (1) Proceedings against a patent attorney arising from a complaint are to be brought before the Disciplinary Tribunal by lodging with that Tribunal:

- (a) a copy of the complaint; and
- (b) if the proceedings are to be brought by the complainant—a copy of the authorisation of the Board to bring proceedings.

(2) If proceedings are brought against a patent attorney, the Disciplinary Tribunal must fix a time and place for the hearing and notify:

- (a) if the proceedings have been brought by a complainant—the complainant; and
- (b) the attorney; and
- (c) the Board;

of that time and place.

(3) The time of hearing must not be less than 21 days after the day on which the patent attorney is told of the time and place.

Decision of Disciplinary Tribunal

20.23 (1) If the Disciplinary Tribunal has heard a charge of:

- (a) unsatisfactory conduct against a patent attorney—that Tribunal may find the attorney guilty of unprofessional conduct; or
- (b) unprofessional conduct against a patent attorney—that Tribunal may find the attorney guilty of unsatisfactory conduct.

(2) If the Disciplinary Tribunal finds a patent attorney guilty of unsatisfactory conduct or unprofessional conduct, that Tribunal may:

- (a) reprimand the attorney; or
- (b) suspend the attorney's registration for not more than 12 months; or
- (c) where the attorney is guilty of unprofessional conduct—cancel his or her registration.

(3) In deciding what to do about a patent attorney under subregulation (2), the Disciplinary Tribunal may take into account the findings about the conduct of the attorney in any other proceedings:

- (a) brought before that Tribunal; or
- (b) brought before the Patent Attorneys Disciplinary Tribunal under the former attorneys Regulations.

(4) If the Disciplinary Tribunal has heard a charge against a patent attorney that the attorney was unqualified at the time of his or her registration and finds the charge proved, that Tribunal may:

- (a) if the attorney has, since that time, obtained that qualification or the qualification is no longer required for registration—reprimand the attorney; or
- (b) in any other case—cancel his or her registration.

(5) If the Disciplinary Tribunal finds that a patent attorney obtained his or her registration by fraud, that Tribunal must cancel the registration of the attorney.

(6) If the Disciplinary Tribunal reprimands a patent attorney or suspends or cancels the attorney's registration, that Tribunal must give a written notice of finding of the Tribunal against the attorney that sets out particulars of the reprimand, suspension or cancellation to:

- (a) if the proceedings were brought by a complainant—the complainant; and
- (b) the attorney; and
- (c) the Board; and
- (d) the Commissioner.

(7) If the registration of a patent attorney is suspended the Commissioner must note the suspension and its duration in the Register of Patent Attorneys.

(8) If the registration of a patent attorney is cancelled the Commissioner must remove the name of the attorney from the Register of Patent Attorneys.

(9) If the Disciplinary Tribunal does not find a charge proved, that Tribunal must notify the patent attorney concerned, the complainant and the Board accordingly.

Publication of decision

20.24 If directed by the Disciplinary Tribunal, the Commissioner must publish in the *Official Journal* a copy of a notice under subregulation 20.23 (6) ("decision of Disciplinary Tribunal") or an extract of that notice.

Completion of outstanding business

20.25 (1) The Disciplinary Tribunal may appoint a patent attorney who has consented to carry on the practice of a former patent attorney:

- (a) if the registration of the former attorney has been suspended—for the period of the suspension or, if a shorter period is specified in the appointment, for that shorter period; or
- (b) if the name of the former attorney has been removed from the Register of Patent Attorneys under subregulation 20.23 (8) (“decision of Disciplinary Tribunal”)—until all outstanding matters are disposed of or, if a shorter period is specified in the appointment, for that shorter period.

(2) This regulation does not allow a patent attorney to act as a patent attorney on behalf of a person without the consent of the person.

(3) A patent attorney appointed to carry on the practice of a former attorney may give a written notice requiring the former attorney to make available to the attorney so appointed:

- (a) any information about the practice that he or she may reasonably require; or
- (b) any books, accounts or other documents concerning the practice that he or she may reasonably require; or
- (c) any moneys held by the former attorney:
 - (i) on behalf of a client; or
 - (ii) that have been paid by a client in respect of services not yet performed for the client.

(4) A former attorney who has been given a notice under subregulation (3) must not, without reasonable excuse, fail or refuse to comply with a requirement in the notice.

Penalty: \$500.

Division 2—Procedure etc. relating to the Disciplinary Tribunal**Procedure of Disciplinary Tribunal**

20.26 (1) Subject to this Part, the Disciplinary Tribunal may determine its procedure.

(2) Proceedings before the Disciplinary Tribunal are to be conducted quickly and informally while allowing for proper consideration of the matter before that Tribunal.

(3) The Disciplinary Tribunal is not bound by the rules of evidence but may be informed on any matter in the manner it chooses.

(4) The Disciplinary Tribunal may take evidence on oath and, for that purpose, may administer an oath.

Hearings to be public except in special circumstances

20.27 (1) Subject to subregulation (2), a hearing before the Disciplinary Tribunal is to be in public.

(2) If the Disciplinary Tribunal is reasonably satisfied that it is desirable to do so in the public interest or because of the confidential nature of any evidence or matter, that Tribunal may:

- (a) direct that a hearing, or a part of a hearing, is to take place in private and give directions as to the persons who may be present; and
- (b) give directions restricting or prohibiting the publication or disclosure:
 - (i) of evidence given before the Tribunal, whether in public or in private; or
 - (ii) of any matters contained in documents lodged with the Tribunal or received in evidence by it; or
 - (iii) of any finding or decision of the Tribunal.

(3) A person must not contravene a direction under this regulation that is applicable to him or to her.

Penalty: \$500.

Representation before Disciplinary Tribunal

20.28 (1) At the hearing of proceedings before the Disciplinary Tribunal, a party to the proceedings may appear in person or be represented by a legal practitioner.

(2) The Disciplinary Tribunal may allow a person to be represented by a person who is not a legal practitioner.

(3) A party to proceedings before the Disciplinary Tribunal, or his or her representative, may request that Tribunal to summon witnesses.

Summoning of witnesses

20.29 (1) For the purposes of the hearing of a charge against a patent attorney before the Disciplinary Tribunal, that Tribunal may, by writing signed by the person constituting the Tribunal:

- (a) summon any person, other than the attorney, to appear before the Tribunal to give evidence about the charge and to produce any documents mentioned in the summons; or
- (b) summon the attorney to appear before the Tribunal:
 - (i) to produce any documents mentioned in the summons; and
 - (ii) to give evidence to identify those documents.

(2) A patent attorney summoned under this regulation must appear in person.

Offences by persons appearing before Disciplinary Tribunal

20.30 (1) A person summoned to appear before the Disciplinary Tribunal must not, without reasonable excuse:

- (a) fail to appear as required by the summons; or
- (b) fail to produce documents or articles as required by the summons; or
- (c) fail to appear and report to that Tribunal from day to day, unless excused by the Tribunal.

Penalty: \$1,000.

(2) A person appearing as a witness before the Disciplinary Tribunal, not being a patent attorney to whom subregulation (3) applies, must not, after being paid expenses and allowances determined by that Tribunal in accordance with Part 2 in Schedule 8, without reasonable excuse:

- (a) refuse or fail to be sworn or to make an affirmation; or
- (b) refuse or fail to answer a question relevant to the evidence that he or she was summoned to give.

Penalty: \$1,000.

(3) A patent attorney against whom proceedings have been instituted who is summoned to appear at a hearing before the Disciplinary

Tribunal in respect of those proceedings must not, without reasonable excuse:

- (a) refuse or fail to be sworn or to make an affirmation; or
- (b) refuse or fail to answer a question relevant to the evidence that he or she was summoned to give.

Penalty: \$1,000.

(4) It is a reasonable excuse for a person referred to in subregulation (2) or (3) to refuse or fail to answer a question or to produce a document or article, if the answer to the question, or the document or article, may tend to prove that he or she has committed an offence against a law of the Commonwealth or of a State or Territory.

Protection of person constituting Disciplinary Tribunal, witnesses, etc.

20.31 (1) A person:

- (a) constituting or acting as the Disciplinary Tribunal; or
- (b) appointed under subregulation 20.45 (2) ("disclosure of interest");

has, in the exercise of the powers and the performance of the functions of that Tribunal under this Part, the same protection and immunity as a Justice of the High Court.

(2) A member of the Board has, in considering complaints under this Part and authorizing the institution of proceedings before the Disciplinary Tribunal, the same protection and immunity as a Justice of the High Court.

(3) A legal practitioner or other person appearing before the Disciplinary Tribunal has the same protection and immunity as a barrister has in appearing for a party in proceedings in the High Court.

(4) Subject to this Part, a person summoned to attend or appearing before the Disciplinary Tribunal as a witness has the same protection, and is, in addition to the penalties provided by this Part, subject to the same liabilities, as a witness in proceedings in the High Court.

PART 5—ADMINISTRATION

*Division 1—The Patent Attorneys Professional Standards Board***Establishment of Board**

20.32 (1) The Patent Attorneys Professional Standards Board is established.

- (2) The Board is constituted by:
 - (a) the Commissioner; and
 - (b) 2 members who are patent attorneys elected by patent attorneys in accordance with directions published under subregulation 20.33 (1) (“election of Board members”); and
 - (c) no fewer than 2 members appointed by the Minister.
- (3) The Commissioner is the Chairperson of the Board.

Election of Board members

20.33 (1) An election of members of the Board or a replacement member of the Board must be held in the manner that the Minister directs by notice published in the *Official Journal*.

(2) As soon as practicable after the result of an election is known, the Minister is to declare the result by notice published in the *Official Journal*.

Term of office of Board members

20.34 (1) An elected member holds office for 3 years commencing on publication of the notice under subregulation 20.33 (2) (“election of Board members”) of the member’s election.

(2) An appointed member holds office for a period of not more than 3 years that is specified in the instrument of appointment.

(3) A member of the Board is eligible for re-election.

(4) A person who turns 65 may not be elected or appointed as a member and a person may not be elected or appointed as a member for a period that extends beyond the date on which he or she turns 65.

(5) In subregulation (4), “elected” includes re-elected.

Resignation and removal from office as Board member

20.35 (1) A member may resign in writing given to the Minister.

(2) The Minister may remove a member from office for inefficiency, misbehaviour or incapacity.

(3) If a member:

- (a) becomes bankrupt, applies to take the benefit of a law for the relief of bankrupt or insolvent debtors, compounds with his or her creditors or makes an assignment of his or her remuneration for their benefit; or
- (b) is convicted in Australia of an offence punishable by imprisonment for 12 months or longer; or
- (c) is absent without leave granted by the Chairperson from 3 consecutive meetings of the Board; or
- (d) in the case of an elected member—ceases to be a registered patent attorney;

the Minister is to remove the member from office.

Replacement of elected Board members failing to serve their full term

20.36 (1) If an elected member ceases to hold office more than 6 months before the end of the period that applies to him or her under subregulation 20.34 (1) (“term of office of Board members”), another patent attorney must be elected in accordance with directions given under subregulation 20.33 (1) (“election of Board members”) to replace that member.

(2) A patent attorney elected to replace an elected member is a member until the end of the period that applied to that member under subregulation 20.34 (1) unless the replacement member ceases to hold office sooner.

(3) If an elected member (in this subregulation called “**the original member**”) is replaced by a person who ceases to hold office more than 6 months before the end of the period that applied to the original member under subregulation 20.34 (1), another patent attorney must be elected in accordance with directions under subregulation 20.33 (1) to replace that person.

Meetings of Board

20.37 (1) The Board must hold as many meetings as are necessary for the performance of its functions.

(2) The Commissioner may, at any time, by notice in writing to the members, call a meeting of the Board at the time and place specified in the notice.

Member presiding at meetings of Board

20.38 (1) The Commissioner must preside at all meetings of the Board at which he or she is present.

(2) In the absence of the Commissioner from a meeting, the members present must appoint 1 of themselves to preside.

(3) The Commissioner or a member who presides at a meeting has a deliberative vote and, in the event of an equality of votes, also has a casting vote.

Quorum for meetings of Board

20.39 At a meeting of the Board:

(a) the Commissioner and 3 members; or

(b) in the absence of the Commissioner—4 members;

constitute a quorum.

Secretary to Board

20.40 (1) The Minister may in writing appoint an employee to be the Secretary to the Board.

(2) The Secretary to the Board must record minutes of the business transacted at meetings of the Board and perform the other duties directed by the Board.

(3) The Secretary to the Board may resign in writing given to the Minister.

Division 2—The Patent Attorneys Disciplinary Tribunal**Establishment of Disciplinary Tribunal**

20.41 The Patent Attorneys Disciplinary Tribunal is established.

Disciplinary Tribunal: substantive appointments

20.42 (1) The Minister may in writing appoint a person to constitute the Disciplinary Tribunal.

(2) A copy of the instrument of appointment must be published in the *Official Journal*.

(3) A person so appointed holds the office for the period specified in the instrument.

(4) A person so appointed may resign in writing given to the Minister.

(5) The Minister may remove a person so appointed from office for inefficiency, misbehaviour or incapacity.

(6) If a person so appointed:

- (a) becomes bankrupt, applies to take the benefit of a law for the relief of bankrupt or insolvent debtors, compounds with his or her creditors or makes an assignment of his or her remuneration for their benefit; or
- (b) is convicted in Australia of an offence punishable by imprisonment for 12 months or longer; or
- (c) fails, without reasonable excuse, to disclose a conflict of interest in accordance with regulation 20.45 (“disclosure of interest”);

the Minister is to remove the person from office.

Disciplinary Tribunal: acting appointments

20.43 (1) The Minister may in writing appoint a person to act as the Disciplinary Tribunal:

- (a) during a vacancy in the office, whether or not an appointment has been previously made to the office; or
- (b) during any period, or during all periods, when the holder of the office is, or is expected to be, absent from duty or from

Australia or is, for any reason, unable to perform the functions of the office;
but a person appointed to act during a vacancy must not continue to act for more than 12 months.

(2) A copy of the instrument of appointment must be published in the *Official Journal*.

(3) The Minister:

- (a) may terminate the appointment at any time; and
- (b) is to terminate the appointment if the person appointed fails, without reasonable excuse, to disclose a conflict of interest in accordance with regulation 20.45 “(disclosure of interest”).

(4) Anything done by or in relation to a person purporting to act under the appointment is not invalid only because:

- (a) the need for the appointment had not arisen;
- (b) there was a defect or irregularity in connection with the appointment;
- (c) the appointment had ceased to have effect; or
- (d) the need to act had not arisen or had ceased.

Qualifications for holding, or acting as, Disciplinary Tribunal

20.44 A person is not qualified to be appointed under subregulation 20.42 (1) (“Disciplinary Tribunal: substantive appointments”), 20.43 (1) (“Disciplinary Tribunal: acting appointments”) or 20.45 (2) (“disclosure of interest”) unless he or she is enrolled, and has for not fewer than 7 years been enrolled, as a legal practitioner.

Disclosure of interest

20.45 (1) If a person constituting or acting as the Disciplinary Tribunal has or acquires an interest that could conflict with the proper performance of his or her functions in relation to proceedings he or she is to hear, the person:

- (a) must tell the parties to the proceedings about the interest; and
- (b) must not perform those functions without the consent of the parties.

(2) If such a person is unable to perform his or her functions because of a conflict of interest, the Minister may in writing appoint

another person to be the Disciplinary Tribunal for the purpose of conducting or completing those proceedings.

(3) A copy of the instrument of appointment must be published in the *Official Journal*.

(4) A person so appointed may exercise all the powers and must perform all of the functions of the Disciplinary Tribunal in relation to those proceedings.

CHAPTER 21—ADMINISTRATION

Patent Office and sub-offices

21.1 The hours of business of the Patent Office and each sub-office of the Patent Office are from 10 a.m. to 4 p.m. on each day other than:

- (a) a Saturday or a Sunday; or
- (b) a public holiday:
 - (i) where the Office or sub-office is located; or
 - (ii) for the purposes of the Australian Public Service in that place.

CHAPTER 22—MISCELLANEOUS

PART 1—FEES AND COSTS

Division 1—Fees

Fees generally

22.1 (1) A fee must be paid at the Patent Office or a sub-office of the Patent Office in such a manner as the Commissioner reasonably directs.

(2) If the Commissioner has directed that a complete application is to be treated as a provisional application, the amount by which the fee payable on the filing of a complete application exceeds the fee payable on the filing of a provisional application must be credited towards the payment of the fee payable on the next filing of a complete application associated with the provisional application by the applicant concerned.

(3) For the purposes of subsection 227 (5) of the Act ("fees"), the Commissioner must give notice of the failure to pay the fee to the person or his or her patent attorney in writing within 7 days after the filing of the document, or the doing of the act, for which the fee is payable.

General fees

22.2 (1) For the purposes of subsection 227 (1) of the Act ("fees"), there is payable to the Commissioner in respect of a matter specified in column 2 of an item of Part 1 or 2 in Schedule 7 a fee of the amount specified in column 3 of that item.

(2) In order to ascertain the amount of a fee payable under item 29 of Part 2 in Schedule 7, the period from the day on which a notice of opposition to the grant of an application for an extension of time is filed to the end of:

- (a) if an application is made to the Tribunal for a review of a decision of the Commissioner—the day when the application is withdrawn or finally dealt with or determined; or
- (b) in any other case—21 days after the end of the day on which the Commissioner decides the application;

must not be taken into account.

(3) For the purposes of paragraph 89 (3) (b) of the Act ("modified application of Act"):

- (a) if a PCT application is treated as an application:
 - (i) for a petty patent—the amount of the fee specified in item 2 of Part 2 in Schedule 7; or
 - (ii) for a standard patent—the amounts of the fees specified in item 3 of that Part;
- is, or are, payable in respect of the application; and
- (b) the fees specified in item 2 or 3 of Part 2 in Schedule 7 is not payable in respect of a PCT application.

(4) Item 22 of Part 2 in Schedule 7 does not apply to a request for correction that is made only because of an error or omission on the part of an employee.

General fees for international applications**22.3 (1) If:**

- (a) for the purposes of the PCT, the Commissioner or the Patent Office is:
 - (i) a receiving Office; or
 - (ii) an International Searching Authority; or
 - (iii) an International Preliminary Examining Authority;and
- (b) the Commissioner or the Patent Office is empowered by the PCT to charge a fee, other than a fee for the benefit of the International Bureau;

for the purposes of subsection 227 (1) of the Act ("fees"), the amount of the fee payable to the Commissioner in respect of a matter specified in column 2 of an item of Part 3 in Schedule 7 is the amount specified in column 3 of that item.

(2) The fees specified in items 1 and 2 of Part 3 in Schedule 7 are payable to the Commissioner within 1 month of filing an international application.

(3) The fee specified in item 4 of Part 3 in Schedule 7 is payable to the Commissioner on filing a demand for a preliminary examination under Article 31 of the PCT.

Note: The text of the PCT is set out in Schedule 2.

Fees for international applications payable for the benefit of the International Bureau

22.4 (1) If, for the purposes of the PCT, the Commissioner or the Patent Office is:

- (a) a receiving Office; or
- (b) an International Searching Authority; or
- (c) an International Preliminary Examining Authority;

in relation to an international application, the amount of the fee payable to the Commissioner in accordance with the PCT in respect of a matter specified in column 2 of an item of Part 4 in Schedule 7 is the amount specified in column 3 of that item.

(2) The Commissioner must, in accordance with the PCT, determine the currency in which a fee payable under this regulation is payable and the exchange rate between Swiss currency and the currency so determined.

(3) The Commissioner must give notice of a determination in the *Official Journal*.

(4) A determination has effect on the date specified in the determination for that purpose or on the date of notification of the determination in the *Official Journal*, whichever is later.

Note: The text of the PCT is set out in Schedule 2.

PCT Fund

22.5 Money paid as a fee to the Commissioner under subregulation 22.4 (1) ("fees for international applications payable for the benefit of the International Bureau"):

- (a) must be paid into the Trust Fund kept under section 60 of the *Audit Act 1901* ("Trust Fund"); and
- (b) may be expended from the Fund for the purposes of the PCT, including the making of refunds and the remission of fees to the International Bureau.

Note: The text of the PCT is set out in Schedule 2.

Exemption from fees

22.6 (1). The Commissioner may exempt a person from the payment of the whole or any part of a fee if the Commissioner is reasonably satisfied that the action is justified, having regard to all the circumstances.

(2) If acceptance of a patent request and complete specification has been delayed because of an error or omission on the part of an employee, the period that is, in the reasonable opinion of the Commissioner, equal to the period of delay that resulted from the error or omission is not, for the purposes of ascertaining the amount of a fee, to be taken into account.

Refund of certain fees

22.7 (1) Subject to subregulation (2), if:

- (a) a complete application for a standard patent has been filed; and
- (b) the application is withdrawn before the specification becomes open to public inspection;

so much of the fee paid on the filing of the application as the Commissioner reasonably thinks fit may, on written application made to him or her, be refunded.

(2) If the PCT requires a fee paid to the Commissioner to be refunded in whole or in part, that fee or that part of the fee must be refunded.

(3) If:

(a) a search fee or a preliminary examination fee is payable to an International Searching Authority or an International Preliminary Examining Authority; and

(b) the PCT provides for the refund of the fee in whole or in part; and

(c) that fee has been paid to the Commissioner;

he or she must determine in accordance with the PCT to what extent that fee is to be refunded to the applicant and the fee must be refunded accordingly.

Note: The text of the PCT is set out in Schedule 2.

Division 2—Costs

Costs

22.8 (1) The Commissioner must not award costs, other than costs specified in Schedule 8, unless each party to the proceedings has had the reasonable opportunity to make a submission on the matter of the award of those costs.

(2) The Commissioner may award an amount:

(a) for costs in respect of a matter specified in column 2 of an item of Part 1 in Schedule 8; or

(b) in respect of the expenses or allowances of a person in relation to proceedings to which this Division applies.

(3) An amount referred to in subregulation (2) must be taxed, allowed and certified, by an employee appointed by the Commissioner for that purpose, in accordance with:

(a) the amount specified in column 3 of that item; or

(b) Part 2 in Schedule 8;

as the case may be.

- (4) A taxation is subject to review by the Commissioner.

PART 2—OTHER MATTERS

Death of applicant or nominated person

22.9 The legal representative of a deceased applicant, nominated person or patentee who wishes:

- (a) in accordance with subsection 215 (1) of the Act (“death of applicant or nominated person”) to proceed with the application; or
- (b) in accordance with subsection 215 (2) of the Act to have the patent granted to him or her; or
- (c) in accordance with subsection 215 (3) of the Act to have the patent amended by substituting for the name of the patentee the name of the person to whom the patent should have been granted;

must file the approved form and such other documents as the Commissioner reasonably considers necessary to support the request.

Address for service

22.10 (1) If provision is made in an approved form to state an address for service, the person completing the form must state an address in Australia at which a document under the Act or these Regulations may be given to him or her personally or to the person specified in the form as his or her representative.

(2) A person may file notice of a change of his or her address for service.

(3) If a notice of opposition is filed under regulation 5.3 (“filing of opposition”), a person who has filed notice under subregulation (2) must serve a copy of the notice on each person interested in the opposition proceedings.

(4) If a person serves a document on a person other than the Commissioner, the first-mentioned person must, as soon as practicable after serving the document on the other person, file a notice of the service in the approved form together with a copy of the document served.

Extension of time

22.11 (1) For the purposes of subsection 223 (2) of the Act (“extensions of time”), an application for an extension of time must be in the approved form and have with it a declaration setting out the grounds on which the application is made.

(2) Notice of the grant of an extension of time must be published in the *Official Journal*.

(3) For the purposes of the definition of “relevant act” in subsection 223 (11) of the Act, each of the following actions is prescribed:

- (a) an action or step prescribed in Chapter 5 (“opposition”), not being an action or step taken under regulation 5.3 (“filing of opposition”);
- (b) paying a fee in a period that is extended because of subregulation 13.3 (3) (“prescribed period: continuation fees”) or subregulation 13.6 (4) (“time for payment of renewal fee for standard patent”).

Evidence

22.12 (1) If evidence is given in writing to the Commissioner or to the Patent Attorneys Disciplinary Tribunal for the purposes of the Act or these Regulations, the evidence must be in the form of a declaration.

(2) The Commissioner may:

- (a) require a person who has made a declaration to appear before him or her to give evidence orally on oath in substitution for, or addition to, the evidence contained in the declaration; and
- (b) allow the person to be cross-examined on the declaration.

Declarations

22.13 (1) In this regulation:
“**diplomatic or consular officer**” means a person who holds or performs the duties of any of the following offices of the Commonwealth in a country other than Australia:

- (a) ambassador;
- (b) high commissioner;
- (c) minister;
- (d) charge d'affaires;

- (e) counsellor or second or third secretary at an embassy, high commission or other post;
- (f) consul-general;
- (g) consul;
- (h) vice-consul.

(2) A declaration required by the Act or these Regulations to be given to the Commissioner must:

- (a) be headed with the title of the matter in respect of which the declaration is made; and
- (b) be expressed in the first person; and
- (c) state the description and actual place of business or residential address and occupation of the declarant; and
- (d) be divided into paragraphs, each of which must be numbered consecutively and, as far as practicable, be confined to 1 subject; and
- (e) show the name and address of the person making the declaration and, if appropriate, the name of the person on whose behalf it is made.

(3) A declaration may be made before:

- (a) a magistrate; or
- (b) a justice of the peace; or
- (c) a commissioner for affidavits; or
- (d) a commissioner for declarations; or
- (e) a notary public; or
- (f) a person before whom a statutory declaration may be made under the law of the State, Territory or foreign country where the declaration is made; or
- (g) a diplomatic or consular officer.

(4) The name and title of the person before whom the declaration is made and the date when and the place where it was made must be stated in the declaration.

Directions not otherwise prescribed

22.14 If the Commissioner reasonably believes that it is necessary for the proper prosecution or completion of proceedings for a person to perform an act, file a document or produce evidence that is not provided for by the Act or these Regulations, the Commissioner may give notice to the person requiring him or her to perform the act, file the document or produce the evidence, specified in the notice.

Documents to be in English**22.15 (1)** Subject to subregulation (2):

- (a) an abstract or approved form or a specification; and
- (b) another filed document, other than a document that has been translated into English and has with it a related certificate of verification;

must be in English.

(2) If, for the purposes of the PCT, the Commissioner or the Patent Office is:

- (a) a receiving Office; or
- (b) an International Searching Authority; or
- (c) an International Preliminary Examining Authority;

subject to the PCT, an international application or a demand for an international preliminary examination under Article 31 of the PCT must be filed in English.

Note: The text of the PCT is set out in Schedule 2.

Documents other than specifications and abstracts**22.16 (1)** In this regulation:

“document” does not include a specification or an abstract.

(2) If a document received at the Patent Office does not substantially comply with Schedule 3 or is not in accordance with whichever approved form is applicable, the Commissioner may treat the document:

- (a) as not having been filed and return it to the person from whom it was received with a statement indicating how the document or form does not so comply or accord; or
- (b) as having been filed, but direct the person from whom it was received to do such things as are necessary to ensure that the document will so comply or accord.

(3) If the Commissioner returns a document under paragraph (2) (a), he or she must return with the document any other document filed with it.

(4) If the Commissioner gives a direction under paragraph (2) (b) and the person to whom the direction was given does not comply with that direction within 3 months from the day when it was given, the Commissioner must treat the document as not having been filed.

(5) Chapter 10 (“amendments”) does not apply to a document to which this regulation applies.

Incapacity of certain persons

22.17 (1) In this regulation:

“**mental dysfunction**” means a disturbance or defect, to a severely disabling degree, of perceptual interpretation, comprehension, reasoning, learning, judgment, memory, motivation, or emotion.

(2) If a person is incapable of doing anything required or permitted by the Act or these Regulations to be done because of infancy or of mental dysfunction or physical disability or disease, a court may, on the application of a person acting on behalf of the incapable person or of another person interested in the doing of the thing:

(a) do that thing; or

(b) appoint a person to do the thing;

in the name, and on behalf, of the incapable person.

(3) A thing done in the name of, and on behalf of, an incapable person is taken to have been done by that person as if the person had not been incapable when the thing was done.

Destruction of documents

22.18 (1) The Commissioner may order the destruction of documents relating to applications filed not less than 25 years before the date of the order.

(2) Subregulation (1) does not authorise the destruction of:

(a) the Register; or

(b) documents relating to patents in force; or

(c) documents considered by the Commissioner, or the Director-General of the Australian Archives, to be of legal or historical interest.

Copies of certain documents to be supplied

22.19 A copy of a document that:

(a) affects the ownership of a patent or licence; and

(b) has been witnessed;

must be filed by a person who seeks to have the Commissioner consider the document for the purposes of the Act or these Regulations.

International applications and the Patent Office

22.20 If, for the purposes of the PCT, the Patent Office is:

- (a) a receiving Office; or
- (b) an International Searching Authority; or
- (c) an International Preliminary Examining Authority;

the Commissioner and the Patent Office may perform the functions under the PCT of a receiving Office, an International Searching Authority or an International Preliminary Examining Authority, as the case requires, in relation to an international application.

Note: The text of the PCT is set out in Schedule 2.

Protection or compensation of certain persons

22.21 (1) The following provisions of this regulation are prescribed for the purposes of subsections 41 (4) ("specifications: micro-organisms"), 150 (4) ("restoration of lapsed application") and 223 (9) ("extensions of time") of the Act.

(2) Persons who availed themselves of or exploited, or took definite steps by contract or otherwise to avail themselves of or exploit, inventions:

- (a) in the case of inventions to which subsection 41 (4) of the Act applies—in the period mentioned in paragraph 41 (4) (c) of the Act; and
- (b) in the case of inventions to which subsection 150 (4) of the Act applies—after the lapse of the applications and before the day on which their restoration was notified in the *Official Journal*; and
- (c) in the case of inventions to which subsection 223 (9) of the Act applies—within the period of time extended under that subsection;

may apply, in the approved form, to the Commissioner for the grant of licences to exploit the inventions.

(3) An applicant for a licence must serve a copy of the application on a person whose application or patent:

- (a) was so restored; or
- (b) is referred to in subsection 41 (4) of the Act ;

and to such other persons as the Commissioner reasonably directs.

(4) A person on whom a copy of an application has been served may oppose the grant of the licence.

(5) The Commissioner, if reasonably satisfied that the application should be granted, must grant a licence to the applicant on such terms as the Commissioner thinks reasonable.

Exercise by Commissioner of certain powers

22.22 (1) The Commissioner must, before exercising a discretionary power under the Act or these Regulations adversely to a person, give the person at least 10 days notice of the time when, and the place where, that person may be heard in relation to the exercise of the power.

- (2) The Commissioner may exercise that power, if the person:
- (a) informs the Commissioner that he or she does not wish to be heard; or
 - (b) does not attend the hearing; or
 - (c) being an applicant or patentee, requests the Commissioner to exercise the power of the Commissioner without the applicant or patentee being heard.

- (3) A request:
- (a) must be in the approved form; and
 - (b) may be accompanied by written submissions.

(4) The Commissioner must, after hearing the person, notify him or her of the decision.

Hearings

22.23 (1) the Commissioner must give notice of the date, time and place of a hearing before him or her to each party to the hearing at least 10 days before the day when the hearing is to begin.

(2) The Commissioner may adjourn a hearing from time to time or from place to place by notifying the parties to the hearing accordingly.

- (3) The Commissioner may hold a hearing:
- (a) at which the parties appear before him or her in person; or
 - (b) in which a party participates by telephone or such other means of telecommunication as the Commissioner reasonably allows.

(4) If a party to a hearing does not intend to appear at the hearing, the party may make a submission in writing to the Commissioner

before the hearing begins to which the Commissioner must have regard in reaching his or her decision on the matter being heard as if:

- (a) the party were present or otherwise participating in the hearing; and
- (b) the matter of the submission were presented by the party in the presence of the Commissioner.

(5) The Commissioner must, after hearing the person, notify him or her of the decision.

Practice and procedure other than for opposition proceedings

22.24 (1) Subject to these Regulations:

- (a) if the Act or these Regulations authorise the Commissioner to hear and decide an application or matter that is not an opposition; or
- (b) in a matter being decided on the motion of the Commissioner; the practice and procedure to be followed for the purposes of enabling the application or matter to be decided is to be determined by him or her.

(2) A person to be heard at a hearing may apply to the Commissioner in respect of the practice and procedure in relation to the hearing to be determined by the Commissioner.

Requirements cannot be complied with for reasonable cause

22.25 If, under these Regulations, a person is required to:

- (a) sign a document, make a declaration or file or give the Commissioner a document or evidence; and
- (b) the Commissioner is reasonably satisfied that the person cannot comply with the requirement;

the Commissioner may, subject to such conditions as he or she reasonably directs, dispense with the requirement.

Review of decisions

22.26 (1) In this regulation:
“**decision**” has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

(2) Application may be made to the Tribunal for review of a decision of:

- (a) the Commissioner under the following provisions:
 - (i) paragraph 3.24 (1) (b) (“Commissioner may request samples and viability statement”);
 - (ii) subregulation 3.25 (2) (“request for Commissioner’s certificate authorising release of sample of a micro-organism”);
 - (iii) subregulation 5.5 (3) (“dismissal of opposition”);
 - (iv) subregulation 5.6 (3) (“determination of opposition”);
 - (v) subparagraph 6.2 (1) (b) (ii) (“prescribed period: grant of standard patent”);
 - (vi) subregulation 22.21 (5) (“protection or compensation of certain persons”); or
- (b) the Patent Attorneys Professional Standards Board under subregulation 20.21 (7) (“authorisation to bring proceedings against a patent attorney”); or
- (c) the Patent Attorneys Disciplinary Tribunal under subregulation 20.23 (2), (4) or (5) (“decision of Disciplinary Tribunal”).

(3) If the Commissioner gives a person affected by a decision referred to in subregulation (2) written notice of the making of the decision, the notice must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Tribunal for review of that decision by or on behalf of the person whose interests are affected by it.

(4) Failure to comply with subregulation (3) in relation to a decision does not affect the validity of the decision.

(5) If the Tribunal reviews a decision of the Commissioner under subsection 224 (1) of the Act (“review of decisions”) and the decision is not affirmed, the Commissioner must publish a notice of the decision of the Tribunal in the *Official Journal*.

CHAPTER 23—TRANSITIONAL AND SAVINGS PROVISIONS**Saving: prohibition orders**

23.1 Subsection 4 (2) of the 1952 Act continues in force.

Delegation: certain matters referred to in this Chapter

23.2 Section 11 of the 1952 Act continues on and after the commencing day in respect of the exercise by the Commissioner of his or her powers and functions in relation to the operation of:

- (a) subsection 234 (3) of the Act ("applications under 1952 Act"); or
- (b) a following provision of this Chapter.

Opposition to grant: practice and procedure

23.3 (1) Division 1 of Part XIV and regulations 82 and 83A of the former patents Regulations continue to apply in relation to opposition to the grant of a standard patent on an application:

- (a) to which subsection 234 (3) of the Act ("applications under 1952 Act") refers; and
- (b) acceptance of which has been advertised under the 1952 Act.

(2) Chapter 5 of these Regulations ("opposition") does not apply to opposition to an application to which subregulation (1) applies.

Certain opposition: practice and procedure

23.4 (1) If, before the commencing day:

- (a) a matter is advertised in the *Official Journal*; or
- (b) a document is served on a person;

to enable opposition proceedings to be taken, other than in relation to the grant of a standard patent:

- (c) the following provisions of the 1952 Act continue to apply:
 - (i) sections 82, 83, 84 and 85;
 - (ii) subsections 106 (5) and (6); and
- (d) the following provisions of the former patents Regulations continue to apply:
 - (i) regulations 36, 39B, 39C, 39D, 48, 49, 50, 51, 52, 82, 83A and 92;
 - (ii) Divisions 1 and 2 of Part XIV.

- (2) If provisions specified in subregulation (1) continue to apply:
- (a) sections 74 ("opposition to extension"), 104 ("amendments by applicants and patentees") and 223 ("extensions of time") of the Act; and
 - (b) Chapter 5 ("opposition") and regulations 22.21 ("protection or compensation of certain persons"), 22.22 ("exercise by Commissioner of certain powers") and 22.23 ("hearings") of these Regulations;

do not apply to the opposition referred to in that subregulation.

Fees payable for certain matters relating to opposition

23.5 The fee payable in respect of opposition proceedings of the kind mentioned in regulation 23.3 ("opposition to grant: practice and procedure") or 23.4 ("certain opposition: practice and procedure") is the fee that would have been payable if these Regulations applied to those proceedings.

Certain delegations: opposition

23.6 The delegation of a person who, before the commencing day, was:

- (a) the delegate of the Commissioner under the 1952 Act; and
- (b) exercising the powers of the Commissioner in relation to a matter to which regulation 23.3 ("opposition to grant: practice and procedure") or 23.4 ("certain opposition: practice and procedure") applies;

continues in relation to the matter.

Certain undertakings

23.7 If an undertaking referred to in paragraph 3.25 (4) (c) ("request for Commissioner's certificate authorising release of sample of a micro-organism") is given in respect of an application lodged under the 1952 Act, the reference to Chapter 5 of the Act ("opposition") in subparagraph 3.25 (4) (c) (i) includes a reference to Part V of the 1952 Act.

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Restoration of lapsed applications or ceased patents

23.8 (1) If, before the commencing day:

- (a) an application lapses under:
 - (i) section 47C or 47D of the 1952 Act; or
 - (ii) subregulation 7B (4) or (5) of the former patents Regulations; or
- (b) a patent ceases because of failure to pay a prescribed fee within the prescribed time;

and an application is made for the restoration of the lapsed application or ceased patent, as the case may be, under:

- (c) subsection 47E (2) or 97 (1) of the 1952 Act; or
 - (d) subregulation 7B (6) of the former patents Regulations;
- section 47E, subsection 97 (2) or (3) or section 98 of the 1952 Act or the prescribed provisions of the former patents Regulations, as the case requires, continues to apply in relation to that lapsed application or ceased patent and the corresponding provisions of the Act and these Regulations do not so apply.

(2) There is payable to the Commissioner in respect of a lapsed application or ceased patent to which subregulation (1) applies a fee of the amount specified in column 3 of item 8 of Part 1 in Schedule 2 to the former patents Regulations.

(3) In subregulation (1), "**prescribed regulations**" means:

- (a) regulations 16D, 16E, 16F, 41, 42, 43, 44, 82, 83A, 92; or
- (b) Division 1 of Part XIV.

Certain continuation and renewal fees

23.9 (1) If, before the commencing day:

- (a) the second year after lodgment of a complete specification ends; and
- (b) the continuation fee prescribed in respect of that year in relation to the specification is payable but has not been paid;

item 8 of Part 2 in Schedule 7 is taken to include a fee of \$75 in respect of the second anniversary.

(2) If, before the commencing day:

- (a) the second year of a patent ends; and
- (b) the renewal fee prescribed in respect of that year in relation to the patent is payable but has not been paid;

item 8 of Part 2 in Schedule 7 is taken to include a fee of \$75 in respect of the second anniversary.

Fee taken to have been paid**23.10 If:**

- (a) in respect of the lodging of an application for an extension of time, a fee specified in item 27 of Part 1 in Schedule 2 to the former patents Regulations is paid in respect of a period referred to in section 54 (1B) of the 1952 Act; and
- (b) the application has not been accepted before the commencing day; and
- (c) the applicant is required to pay the fee specified in item 32 of Part 2 in Schedule 7 to these Regulations in relation to the application;

the fee under item 32 is taken to have been paid in respect of the period referred to in paragraph (a).

Supply of product referred to in section 117 of the Act**23.11 (1) If:**

- (a) a product to which section 117 of the Act ("infringement by supply of products") applies is supplied by a person to another person before the commencing day; and
- (b) the supply would not have infringed a patent under the 1952 Act before the commencing day; and
- (c) the first-mentioned person supplies the product to another person after the commencing day;

section 117 of the Act does not apply to the supply referred to in paragraph (c).

(2) In subregulation (1), a reference to the first-mentioned person includes:

- (a) on the death of the person—the legal personal representative of the estate of the person who has died; or
- (b) if the person becomes bankrupt—the person who becomes, under the *Bankruptcy Act 1966*, the trustee in bankruptcy of the estate of the first-mentioned person; or
- (c) if a body corporate is being wound up—the person appointed to be the liquidator of the body corporate; or
- (d) if the person agrees to dispose of a business relating to the supply of the product—the person who acquires that business.

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Certain withdrawn, abandoned or refused applications

23.12 (1) On and after the commencing day, section 142AA of the 1952 Act continues to apply to an application referred to in subsection 234 (2) of the Act ("applications under 1952 Act").

(2) Section 96 of the Act ("withdrawn, abandoned or refused applications") does not apply to an application to which subregulation (1) applies.

Certain certificates of validity

23.13 If:

- (a) a court certifies under section 169 of the 1952 Act in relation to the validity of a patent or of a claim; and
- (b) the validity of the patent or claim is disputed on or after the commencing day;

the certificate referred to in paragraph (a) is taken to have been issued under subsection 19 (1) of the Act ("certificate of validity").

Certain action under the 1952 Act

23.14 If:

- (a) a provision of the Act requires an act to be done under that or another particular provision of the Act; and
- (b) the act was done under a corresponding provision of the 1952 Act;

that act is taken to have been done under the provision of this Act referred to in paragraph (a).

Amendment of petty patents

23.15 The complete specification of a petty patent granted under section 62A of the 1952 Act cannot be amended under the Act so as to include more than 1 claim.

Certain applications under 1952 Act: time for acceptance

23.16 (1) This regulation applies to an invention referred to in paragraph 45 (1) (b) ("examination") or 48 (1) (a) ("modified examination") of the Act that is, so far as claimed in any claim, the subject of:

- (a) a claim of the complete specification in relation to an application for a standard patent referred to in subparagraph 48 (3) (a) (i) of the 1952 Act; or
- (b) the claim of the complete specification in relation to an application for a petty patent referred to in subparagraph 48 (3) (a) (ii) of the 1952 Act;

the priority date of which is earlier than the priority date of the first-mentioned claim.

(2) If, under paragraph 45 (1) (b) or 48 (1) (a) of the Act, the Commissioner reports that the first-mentioned claim in subregulation (1) is a claim the priority date of which is later than the priority date of the claim referred to in paragraph (1) (a) or (b), he or she may defer acceptance of the application and complete specification until the end of 3 months after:

- (a) the date on which a patent was sealed on the application referred to in paragraph (1) (a) or (b); or
- (b) the date on which that application lapsed or was withdrawn or refused.

PCT applications to which subsection 89 (5) of the Act does not apply

23.17 Subsection 89 (5) of the Act ("modified application of Act") does not apply to an application:

- (a) to which subsection 234 (2) of the Act ("applications under 1952 Act") applies; and
- (b) that is a PCT application in respect of which Australia has been elected under Chapter II of the PCT within the period specified in Article 39 of the PCT; and
- (c) in respect of which a filed Preliminary Examination Report made under the PCT reports that an amendment to the application goes beyond the disclosure in the relevant international application that has been filed.

Note: The text of the PCT is set out in Schedule 2.

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Certain priority dates: saving**23.18** In the case of a claim of a specification:

- (a) relating to a further application for a standard patent or for a petty patent under section 51 of the 1952 Act in respect of an invention disclosed in a provisional specification under that Act; or
- (b) to which subsections 45 (2), (3), (3A) and (4A) of the 1952 Act apply; or
- (c) to which subsection 191 (8) of the *Statute Law (Miscellaneous Amendments) Act (No. 1) 1982* applies;

the priority date is determined under section 45 of the 1952 Act or subsection 191 (8) of the *Statute Law (Miscellaneous Amendments) Act (No. 1) 1982*, as the case requires.

Appointment of certain examiners

23.19 A person appointed under subregulation 16 (1) of the former attorneys Regulations as an examiner is taken to have been appointed under subregulation paragraph 20.6 (2) of these Regulations ("examination to be conducted") as an examiner.

Patent attorneys: continued application of certain provisions**23.20** (1) In this regulation:

"prescribed person", in relation to a person who has, before the commencing day:

- (a) passed the examination in a subject specified in subregulation 10 (2) of the former attorneys Regulations—that person; or
- (b) been issued with a certificate of under regulation 20A or 22 of the former attorneys Regulations—that person; or
- (c) met the requirements of regulation 21 of the former attorneys Regulations—that person.

(2) Despite the repeal of the former attorneys Regulations, regulation 18 of the Patent Attorneys Regulations (Amendment), being Statutory Rules 1989 No. 25, continues to apply to persons referred to in that regulation.

(3) Regulation 15 of the former attorneys Regulations continues to apply to a person who is a prescribed person as if the reference to having passed the examination in a subject included a reference to being exempted under subregulation 10A (1) of those Regulations from having to pass the examination in that subject.

(4) Regulations 20A and 22 of the former attorneys Regulations continue to apply to a prescribed person as if the reference to a certificate in those regulations were a reference to the certificates referred to in regulation 20.15 and 20.16.

(5) If a prescribed person was employed continuously on or after 1 May 1989 and before the commencing day for not less than 1 year, or for periods within a continuous period of 2 years together that total not less than 1 year, by a patent attorney as a technical assistant in the conduct of the practice of a patent attorney, the prescribed person is taken to have been employed for the prescribed period of employment for the purposes of paragraph 20.3 (d) ("requirements for registration") of these Regulations.

Patent Attorneys Professional Standards Board: continuation of appointments

23.21 (1) A person elected under paragraph 5 (1) (b) of the former attorneys Regulations as a member of the Patent Attorneys Professional Standards Board established under those Regulations is taken to have been elected under paragraph 20.32 (2) (b) of these Regulations ("establishment of Board") as a member of the Patent Attorneys Professional Standards Board established under these Regulations.

(2) A person appointed under paragraph 5 (1) (c) of the former attorneys Regulations as a member of the Patent Attorneys Professional Standards Board established under those Regulations is taken to have been appointed under paragraph 20.32 (2) (c) of these Regulations as a member of the Patent Attorneys Professional Standards Board established under these Regulations.

(3) A member referred to in subregulation (1) or (2) holds office as a member of the Patent Attorneys Professional Standards Board under these Regulations for the period that is, immediately before the commencing day, the remainder of the period of his or her office as a member of the Patent Attorneys Professional Standards Board under the former attorneys Regulations.

Secretary to Patent Attorneys Professional Standards Board: continuation of appointment

23.22 The person appointed to be the Secretary to the Patent Attorneys Professional Standards Board under subregulation 9 (1) of the

former attorneys Regulations is taken to have been appointed to be the Secretary to the Patent Attorneys Professional Standards Board under subregulation 20.40 (1) of these Regulations ("Secretary to Board").

Patent Attorneys Disciplinary Tribunal: continuation

23.23 The person constituting the Patent Attorneys Disciplinary Tribunal under subregulation 26 (1) of the former attorneys Regulations is taken to constitute the Patent Attorneys Disciplinary Tribunal under subregulation 20.42 (1) of these Regulations ("Disciplinary Tribunal: substantive appointments").

Matters begun under the former attorneys Regulations not finally dealt with before the commencing day

23.24 These Regulations apply on and after the commencing day to a matter that was not finally dealt with before that day under the former attorneys Regulations as if the matter had started under a corresponding provision of these Regulations.

Fees

23.25 (1) In this regulation:

"continuation fee" means a continuation fee for the purposes of section 47D of the 1952 Act;

"renewal fee" means a renewal fee for the purposes of of subsection 68 (2) of that Act.

(2) Subregulation 22.2 (1) ("general fees") does not apply in respect of:

- (a) a continuation fee in respect of a year; or
- (b) a renewal fee in respect of a year of a patent;

that ends on or after the commencing day, if the fee became payable, and was paid, before that day.

(3) If an application for a standard patent was accepted under section 52 or 52D of the 1952 Act before the commencing day, the fee payable for the sealing of that patent is the fee that was applicable to the sealing of the patent immediately before that day.

- (4) In the case of a PCT application, if:
- (a) a continuation fee in respect of an anniversary that occurs within the period of 9 months immediately preceding the commencing day; and
 - (b) the continuation fee is not paid in the period referred to in subregulation (1) but is paid within 9 months after the anniversary concerned;

the prescribed period referred to in subregulation 13.3 (1) ("prescribed period: continuation fees") is extended to the day on which the fee is paid.

Certain actions and proceedings

23.26 (1) The 1952 Act applies to an action or proceeding made or started under that Act and not finally dealt with or determined before the commencing day:

- (a) in which the validity of a patent is disputed; or
- (b) concerning infringement of a patent.

(2) The 1952 Act applies to an action or proceeding in which the validity of a patent granted under the *Patents Act 1990* on an application made under the 1952 Act is disputed.

SCHEDULE 1

Subregulation 1.4 (1)

Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

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Regulations under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

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SCHEDULE 1—continued

**BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE
DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT
PROCEDURE**

Done at Budapest on April 28, 1977, and amended on September 26, 1980

INTRODUCTORY PROVISIONS

Article 1

Establishment of a Union

The States party to this Treaty (hereinafter called "the Contracting States") constitute a Union for the international recognition of the deposit of microorganisms for the purposes of patent procedure.

Article 2

Definitions

For the purposes of this Treaty and the Regulations:

- (i) 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;
- (ii) "deposit of a microorganism" means, according to the context in which these words appear, the following acts effected in accordance with this Treaty and the Regulations: the transmittal of a microorganism to an international depositary authority, which receives and accepts it, or the storage of such a microorganism by the international depositary authority, or both the said transmittal and the said storage;
- (iii) "patent procedure" means any administrative or judicial procedure relating to a patent application or a patent;
- (iv) "publication for the purposes of patent procedure" means the official publication, or the official laying open for public inspection, of a patent application or a patent;
- (v) "intergovernmental industrial property organization" means an organization that has filed a declaration under Article 9 (1);
- (vi) "industrial property office" means an authority of a Contracting State or an intergovernmental industrial property organization competent for the grant of patents;
- (vii) "depositary institution" means an institution which provides for the receipt, acceptance and storage of microorganisms and the furnishing of samples thereof;
- (viii) "international depositary authority" means a depositary institution which has acquired the status of international depositary authority as provided in Article 7;
- (ix) "depositor" means the natural person or legal entity transmitting a microorganism to an international depositary authority, which receives and accepts it, and any successor in title of the said natural person or legal entity;
- (x) "Union" means the Union referred to in Article 1;
- (xi) "Assembly" means the Assembly referred to in Article 10;
- (xii) "Organization" means the World Intellectual Property Organization;
- (xiii) "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);
- (xiv) "Director General" means the Director General of the Organization;
- (xv) "Regulations" means the Regulations referred to in Article 12.

SCHEDULE 1—continued

CHAPTER I

SUBSTANTIVE PROVISIONS

Article 3

Recognition and Effect of the Deposit of Microorganisms

(1) (a) Contracting States which allow or require the deposit of microorganisms for the purposes of patent procedure shall recognise, for such purposes, the deposit of a microorganism with any international depositary authority. Such recognition shall include the recognition of the fact and date of the deposit as indicated by the international depositary authority as well as the recognition of the fact that what is furnished as a sample is a sample of the deposited microorganism.

(b) Any Contracting State may require a copy of the receipt of the deposit referred to in subparagraph (a), issued by the international depositary authority.

(2) As far as matters regulated in this Treaty and the Regulations are concerned, no Contracting State may require compliance with requirements different from or additional to those which are provided in this Treaty and the Regulations.

Article 4

New Deposit

(1) (a) Where the international depositary authority cannot furnish samples of the deposited microorganism for any reason, in particular,

(i) where such microorganism is no longer viable, or

(ii) where the furnishing of samples would require that they be sent abroad and the sending or the receipt of the samples abroad is prevented by export or import restrictions,

that authority shall, promptly after having noted its inability to furnish samples, notify the depositor of such inability, indicating the cause thereof, and the depositor, subject to paragraph (2) and as provided in this paragraph, shall have the right to make a new deposit of the microorganism which was originally deposited.

(b) The new deposit shall be made with the international depositary authority with which the original deposit was made, provided that:

(i) it shall be made with another international depositary authority where the institution with which the original deposit was made has ceased to have the status of international depositary authority, either entirely or in respect of the kind of microorganism to which the deposited microorganism belongs, or where the international depositary authority with which the original deposit was made discontinues, temporarily or definitively, the performance of its functions in respect of deposited microorganisms;

(ii) it may be made with another international depositary authority in the case referred to in subparagraph (a) (ii).

(c) Any new deposit shall be accompanied by a statement signed by the depositor alleging that the newly deposited microorganism is the same as that originally deposited. If the allegation of the depositor is contested, the burden of proof shall be governed by the applicable law.

(d) Subject to subparagraphs (a) to (c) and (e), the new deposit shall be treated as if it had been made on the date on which the original deposit was made where all the preceding statements concerning the viability of the originally deposited microorganism indicated that the microorganism was viable and where the new deposit was made within three months after the date on which the depositor received the notification referred to in subparagraph (a).

(e) Where subparagraph (b) (i) applies and the depositor does not receive the notification referred to in subparagraph (a) within six months after the date on which the termination, limitation or discontinuance referred to in subparagraph (b) (i) was published by the International Bureau, the three-month time limit

SCHEDULE 1—continued

referred to in subparagraph (d) shall be counted from the date of the said publication.

(2) The right referred to in paragraph (1) (a) shall not exist where the deposited microorganism has been transferred to another international depositary authority as long as that authority is in a position to furnish samples of such microorganism.

Article 5

Export and Import Restrictions

Each Contracting State recognises that it is highly desirable that, if and to the extent to which the export from or import into its territory of certain kinds of microorganisms is restricted, such restriction should apply to microorganisms deposited, or destined for deposit, under this Treaty only where the restriction is necessary in view of national security or the dangers for health or the environment.

Article 6

Status of International Depositary Authority

(1) In order to qualify for the status of international depositary authority, any depositary institution must be located on the territory of a Contracting State and must benefit from assurances furnished by that State to the effect that the said institution complies and will continue to comply with the requirements specified in paragraph (2). The said assurances may be furnished also by an intergovernmental industrial property organization; in that case, the depositary institution must be located on the territory of a State member of the said organization.

(2) The depositary institution must, in its capacity of international depositary authority:

- (i) have a continuous existence;
- (ii) have the necessary staff and facilities, as prescribed in the Regulations, to perform its scientific and administrative tasks under this Treaty;
- (iii) be impartial and objective;
- (iv) be available, for the purposes of deposit, to any depositor under the same conditions;
- (v) accept for deposit any or certain kinds of microorganisms, examine their viability and store them, as prescribed in the Regulations;
- (vi) issue a receipt to the depositor, and any required viability statement, as prescribed in the Regulations;
- (vii) comply, in respect of the deposited microorganisms, with the requirement of secrecy, as prescribed in the Regulations;
- (viii) furnish samples of any deposited microorganism under the conditions and in conformity with the procedure prescribed in the Regulations.

(3) The Regulations shall provide the measures to be taken:

- (i) where an international depositary authority discontinues, temporarily or definitively, the performance of its functions in respect of deposited microorganisms or refuses to accept any of the kinds of microorganisms which it should accept under the assurances furnished;
- (ii) in case of the termination or limitation of the status of international depositary authority of an international depositary authority.

Article 7

Acquisition of the Status of International Depositary Authority

(1) (a) A depositary institution shall acquire the status of international depositary authority by virtue of a written communication addressed to the Director General by the Contracting State on the territory of which the depositary institution is located and including a declaration of assurances to the effect that the said

SCHEDULE 1—continued

institution complies and will continue to comply with the requirements specified in Article 6(2). The said status may be acquired also by virtue of a written communication addressed to the Director General by an intergovernmental industrial property organisation and including the said declaration.

(b) The communication shall also contain information on the depositary institution as provided in the Regulations and may indicate the date on which the status of international depositary authority should take effect.

(2) (a) If the Director General finds that the communication includes the required declaration and that all the required information has been received, the communication shall be promptly published by the International Bureau.

(b) The status of international depositary authority shall be acquired as from the date of publication of the communication or, where a date has been indicated under paragraph (1) (b) and such date is later than the date of publication of the communication, as from such date.

(3) The details of the procedure under paragraphs (1) and (2) are provided in the Regulations.

Article 8

Termination and Limitation of the Status of International Depositary Authority

(1) (a) Any Contracting State or any intergovernmental industrial property organization may request the Assembly to terminate, or to limit to certain kinds of microorganisms, any authority's status of international depositary authority on the ground that the requirements specified in Article 6 have not been or are no longer complied with. However, such a request may not be made by a Contracting State or intergovernmental industrial property organization in respect of an international depositary authority for which it has made the declaration referred to in Article 7 (1) (a).

(b) Before making the request under subparagraph (a), the Contracting State or the intergovernmental industrial property organization shall, through the intermediary of the Director General, notify the reasons for the proposed request to the Contracting State or the intergovernmental industrial property organization which has made the communication referred to in Article 7 (1) so that that State or organisation may, within six months from the date of the said notification, take appropriate action to obviate the need for making the proposed request.

(c) Where the Assembly finds that the request is well founded, it shall decide to terminate, or to limit to certain kinds of microorganisms, the status of international depositary authority of the authority referred to in subparagraph (a). The decision of the Assembly shall require that a majority of two-thirds of the votes cast be in favour of the request.

(2) (a) The Contracting State or intergovernmental industrial property organization having made the declaration referred to in Article 7 (1) (a) may, by a communication addressed to the Director General, withdraw its declaration either entirely or in respect only of certain kinds of microorganisms and in any event shall do so when and to the extent that its assurances are no longer applicable.

(b) Such a communication shall, from the date provided for in the Regulations, entail, where it relates to the entire declaration, the termination of the status of international depositary authority or, where it relates only to certain kinds of microorganisms, a corresponding limitation of such status.

(3) The details of the procedure under paragraphs (1) and (2) are provided in the Regulations.

Article 9

Intergovernmental Industrial Property Organizations

(1) (a) Any intergovernmental organization to which several States have entrusted the task of granting regional patents and of which all the member States are members of the International (Paris) Union for the Protection of Industrial Property

SCHEDULE 1—continued

may file with the Director General a declaration that it accepts the obligation of recognition provided for in Article 3 (1) (a), the obligation concerning the requirements referred to in Article 3 (2) and all the effects of the provisions of this Treaty and the Regulations applicable to intergovernmental industrial property organizations. If filed before the entry into force of this Treaty according to Article 16 (1), the declaration referred to in the preceding sentence shall become effective on the date of the said entry into force. If filed after such entry into force, the said declaration shall become effective three months after its filing unless a later date has been indicated in the declaration. In the latter case, the declaration shall take effect on the date thus indicated.

(b) The said organization shall have the right provided for in Article 3 (1) (b).

(2) Where any provision of this Treaty or of the Regulations affecting intergovernmental industrial property organizations is revised or amended, any intergovernmental industrial property organization may withdraw its declaration referred to in paragraph (1) by notification addressed to the Director General. The withdrawal shall take effect:

- (i) where the notification has been received before the date on which the revision or amendment enters into force, on that date;
- (ii) where the notification has been received after the date referred to in (i), on the date indicated in the notification or, in the absence of such indication, three months after the date on which the notification was received.

(3) In addition to the case referred to in paragraph (2), any intergovernmental industrial property organization may withdraw its declaration referred to in paragraph (1) (a) by notification addressed to the Director General. The withdrawal shall take effect two years after the date on which the Director General has received the notification. No notification of withdrawal under this paragraph shall be receivable during a period of five years from the date on which the declaration took effect.

(4) The withdrawal referred to in paragraph (2) or (3) by an intergovernmental industrial property organization whose communication under Article 7 (1) has led to the acquisition of the status of international depositary authority by a depositary institution shall entail the termination of such status one year after the date on which the Director General has received the notification of withdrawal.

(5) Any declaration referred to in paragraph (1) (a), notification of withdrawal referred to in paragraph (2) or (3), assurances furnished under Article 6 (1), second sentence, and included in a declaration made in accordance with Article 7 (1) (a), request made under Article 8 (1) and communication of withdrawal referred to in Article 8 (2) shall require the express previous approval of the supreme governing organ of the intergovernmental industrial property organization whose members are all the States members of the said organization and in which decisions are made by the official representatives of the governments of such States.

CHAPTER II

ADMINISTRATIVE PROVISIONS

Article 10

Assembly

- (1) (a) The Assembly shall consist of the Contracting States.
- (b) Each Contracting State shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
- (c) Each intergovernmental industrial property organization shall be represented by special observers in the meetings of the Assembly and any committee and working group established by the Assembly.
- (d) Any State not member of the Union which is a member of the Organization or of the International (Paris) Union for the Protection of Industrial

SCHEDULE 1—continued

Property and any intergovernmental organization specialised in the field of patents other than an intergovernmental industrial property organization as defined in Article 2 (v) may be represented by observers in the meetings of the Assembly and, if the Assembly so decides, in the meetings of any committee or working group established by the Assembly.

- (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) exercise such rights and perform such tasks as are specially conferred upon it or assigned to it under this Treaty;
 - (iii) give directions to the Director General concerning the preparations 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) establish such committees and working groups as it deems appropriate to facilitate the work of the Union;
 - (vi) determine, subject to paragraph (1)(d), which States other than Contracting States, which intergovernmental organizations other than intergovernmental industrial property organizations as defined in Article 2 (v) and which international non-governmental organizations shall be admitted to its meetings as observers and to what extent international depositary authorities shall be admitted to its meetings as observers;
 - (vii) take any other appropriate action designed to further the objectives of the Union;
 - (viii) 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 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 Articles 8 (1) (c), 12 (4) and 14 (2) (b), the decisions of the Assembly shall require a majority of the votes cast.
 - (b) Abstentions shall not be considered as votes.
- (7) (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General, preferably 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, either on his own initiative or at the request of one-fourth of the Contracting States.
- (8) The Assembly shall adopt its own rules of procedure.

SCHEDULE 1—continued

Article 11

International Bureau

- (1) The International Bureau shall:
 - (i) perform the administrative tasks concerning the Union, in particular such tasks as are specifically assigned to it under this Treaty and the Regulations or by the Assembly;
 - (ii) provide the secretariat of revision conferences, of the Assembly, of committees and working groups established by the Assembly, and of any other meeting convened by the Director General and dealing with matters of concern to the Union.
- (2) The Director General shall be the chief executive of the Union and shall represent the Union.
- (3) The Director General shall convene all meetings dealing with matters of concern to the Union.
- (4)(a) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly, and any other meeting convened by the Director General and dealing with matters of concern to the Union.
 - (b) The Director General, or a staff member designated by him, shall be ex officio secretary of the Assembly, and of the committees, working groups and other meetings referred to in subparagraph (a).
- (5)(a) The Director General shall, in accordance with the directions of the Assembly, make the preparations for revision conferences.
 - (b) The Director General may consult with intergovernmental and international non-governmental organizations concerning the 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.
 - (d) The Director General, or a staff member designated by him, shall be ex officio secretary of any revision conference.

Article 12

Regulations

- (1) The Regulations provide rules concerning:
 - (i) matters in respect of which this Treaty expressly refers to the Regulations or expressly provides that they are or shall be prescribed;
 - (ii) any administrative requirements, matters or procedures;
 - (iii) any details useful in the implementation of this Treaty.
- (2) The Regulations adopted at the same time as this Treaty are annexed to this Treaty.
- (3) The Assembly may amend the Regulations.
- (4)(a) Subject to subparagraph (b), adoption of any amendment of the Regulations shall require two-thirds of the votes cast.
 - (b) Adoption of any amendment concerning the furnishing of samples of deposited microorganisms by the international depositary authorities shall require that no Contracting State vote against the proposed amendment.
- (5) In the case of conflict between the provisions of this Treaty and those of the Regulations, the provisions of this Treaty shall prevail.

SCHEDULE 1—continued

CHAPTER III

REVISION AND AMENDMENT

Article 13

Revision of the Treaty

- (1) This Treaty may be revised from time to time by conferences of the Contracting States.
- (2) The convocation of any revision conference shall be decided by the Assembly.
- (3) Articles 10 and 11 may be amended either by a revision conference or according to Article 14.

Article 14

Amendment of Certain Provisions of the Treaty

- (1) (a) Proposals under this Article for the amendment of Articles 10 and 11 may be initiated by any Contracting State 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 of any amendment to Article 10 shall require four-fifths of the votes cast; adoption of any amendment to Article 11 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 Contracting States members of the Assembly at the time the Assembly adopted the amendment.
 - (b) Any amendment to the said Articles thus accepted shall bind all the Contracting States which were Contracting States at the time the amendment was adopted by the Assembly, provided that any amendment creating financial obligations for the said Contracting States or increasing such obligations shall bind only those Contracting States which have notified their acceptance of such amendment.
 - (c) Any amendment which has been accepted and which has entered into force in accordance with subparagraph (a) shall bind all States which become Contracting States after the date on which the amendment was adopted by the Assembly.

CHAPTER IV

FINAL PROVISIONS

Article 15

Becoming Party to the Treaty

- (1) Any State member of the International (Paris) 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.

SCHEDULE 1—continued

Article 16

Entry Into Force of the Treaty

- (1) This Treaty shall enter into force, with respect to the first five States which have deposited their instruments of ratification or accession, three months after the date on which the fifth instrument of ratification or accession has been deposited.
- (2) This Treaty shall enter into force with respect to any other State three months after the date on which that State has deposited its instrument of ratification or accession unless a later date has been indicated in the instrument of ratification or accession. In the latter case, this Treaty shall enter into force with respect to that State on the date thus indicated.

Article 17

Denunciation of the Treaty

- (1) Any Contracting State may denounce this Treaty by notification addressed to the Director General.
- (2) Denunciation shall take effect two years after the day on which the Director General has received the notification.
- (3) The right of denunciation provided for in paragraph (1) shall not be exercised by any Contracting State before the expiration of five years from the date on which it becomes party to this Treaty.
- (4) The denunciation of this Treaty by a Contracting State that has made a declaration referred to in Article 7 (1) (a) with respect to a depositary institution which thus acquired the status of international depositary authority shall entail the termination of such status one year after the day on which the Director General received the notification referred to in paragraph (1).

Article 18

Signature and Languages of the Treaty

- (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 of this Treaty shall be established by the Director General, after consultation with the interested Governments and within two months from the date of signature of this Treaty, in the other languages in which the Convention Establishing the World Intellectual Property Organization was signed.
(c) Official texts of this Treaty shall be established by the Director General, after consultation with the interested Governments, in the Arabic, German, Italian, Japanese and Portuguese languages, and such other languages as the Assembly may designate.
- (2) This Treaty shall remain open for signature at Budapest until December 31, 1977.

Article 19

Deposit of the Treaty; Transmittal of Copies; Registration of the Treaty

- (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 to the Governments of all the States referred to in Article 15 (1), to the intergovernmental organizations that may file a declaration under Article 9 (1) (a) 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.

SCHEDULE 1—continued

(4) The Director General shall transmit two copies, certified by him, of any amendment to this Treaty and to the Regulations to all Contracting States, to all intergovernmental industrial property organizations and, on request, to the Government of any other State and to any other intergovernmental organization that may file a declaration under Article 9 (1) (a).

Article 20

Notifications

The Director General shall notify the Contracting States, the intergovernmental industrial property organizations and those States not members of the Union which are members of the International (Paris) Union for the Protection of Industrial Property of:

- (i) signatures under Article 18;
- (ii) deposits of instruments of ratification or accession under Article 15 (2);
- (iii) declarations filed under Article 9 (1) (a) and notifications of withdrawal under Article 9 (2) or (3);
- (iv) the date of entry into force of this Treaty under Article 16 (1);
- (v) the communications under Articles 7 and 8 and the decisions under Article 8;
- (vi) acceptance of amendments to this Treaty under Article 14 (3);
- (vii) any amendment of the Regulations;
- (viii) the dates on which amendments to the Treaty or the Regulations enter into force;
- (ix) denunciations received under Article 17.

REGULATIONS UNDER THE BUDAPEST TREATY ON THE
INTERNATIONAL RECOGNITION OF THE
DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF
PATENT PROCEDURE

Adopted on April 28, 1977 and amended on January 20, 1981

Rule 1

Abbreviated Expressions and Interpretation of the Word "Signature"

1.1 "Treaty"

In these Regulations, the word "Treaty" means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

1.2 "Article"

In these Regulations, the word "Article" refers to the specified Article of the Treaty.

1.3 "Signature"

In these Regulations, whenever the word "signature" is used, it shall be understood that, where the law of the State on the territory of which an international depositary authority is located requires the use of a seal instead of a signature, the said word shall mean "seal" for the purposes of that authority.

SCHEDULE 1—continued

Rule 2

International Depositary Authorities

2.1 *Legal Status*

Any international depositary authority may be a government agency, including any public institution attached to a public administration other than the central government, or a private entity.

2.2 *Staff and Facilities*

The requirements referred to in Article 6 (2) (ii) shall include in particular the following:

- (i) the staff and facilities of any international depositary authority must enable the said authority to store the deposited microorganisms in a manner which ensures that they are kept viable and uncontaminated;
- (ii) any international depositary authority must, for the storage of microorganisms, provide for sufficient safety measures to minimize the risk of losing microorganisms deposited with it.

2.3 *Furnishing of Samples*

The requirements referred to in Article 6 (2) (viii) shall include in particular the requirement that any international depositary authority must furnish samples of deposited microorganisms in an expeditious and proper manner.

Rule 3

Acquisition of the Status of International Depositary Authority

3.1 *Communication*

(a) The communication referred to in Article 7 (1) shall be addressed to the Director General, in the case of a Contracting State, through diplomatic channels or, in the case of an intergovernmental industrial property organisation, by its chief executive officer.

(b) The communication shall:

- (i) indicate the name and address of the depositary institution to which the communication relates;
- (ii) contain detailed information as to the said institution's capacity to comply with the requirements specified in Article 6 (2), including information on its legal status, scientific standing, staff and facilities;
- (iii) where the said depositary institution intends to accept for deposit only certain kinds of microorganisms, specify such kinds;
- (iv) indicate the amount of any fees that the said institution will, upon acquiring the status of international depositary authority, charge for storage, viability statements and furnishing of samples of microorganisms;
- (v) indicate the official language or languages of the said institution;
- (vi) where applicable, indicate the date referred to in Article 7 (1) (b).

3.2 *Processing of the Communication*

If the communication complies with Article 7 (1) and Rule 3.1, it shall be promptly notified by the Director General to all Contracting States and intergovernmental industrial property organizations and shall be promptly published by the International Bureau.

3.3 *Extension of the List of Kinds of Microorganisms Accepted*

The Contracting State or intergovernmental industrial property organization having made the communication referred to in Article 7 (1) may, at any time thereafter, notify the Director General that its assurances are extended to specified kinds of microorganisms to which, so far, the assurances have not extended. In such a case,

SCHEDULE 1—continued

and as far as the additional kinds of microorganisms are concerned. Article 7 and Rules 3.1 and 3.2 shall apply, *mutatis mutandis*.

Rule 4

*Termination or Limitation of the Status of International Depositary Authority*4.1 *Request; Processing of Request*

(a) The request referred to in Article 8 (1) (a) shall be addressed to the Director General as provided in Rule 3.1 (a).

(b) The request shall:

- (i) indicate the name and address of the international depositary authority concerned;
- (ii) where it relates only to certain kinds of microorganisms, specify such kinds;
- (iii) indicate in detail the facts on which it is based.

(c) If the request complies with paragraphs (a) and (b), it shall be promptly notified by the Director General to all Contracting States and intergovernmental industrial property organizations.

(d) Subject to paragraph (e), the Assembly shall consider the request not earlier than six and not later than eight months from the notification of the request.

(e) Where, in the opinion of the Director General, respect of the time limit provided for in paragraph (d) could endanger the interests of actual or potential depositors, he may convene the Assembly for a date earlier than the date of the expiration of the six-month period provided for in paragraph (d).

(f) If the Assembly decides to terminate, or to limit to certain kinds of microorganisms, the status of international depositary authority, the said decision shall become effective three months after the date on which it was made.

4.2 *Communication; Effective Date; Processing of Communication*

(a) The communication referred to in Article 8 (2) (a) shall be addressed to the Director General as provided in Rule 3.1 (a).

(b) The communication shall:

- (i) indicate the name and address of the international depositary authority concerned;
- (ii) where it relates only to certain kinds of microorganisms, specify such kinds;
- (iii) where the Contracting State or intergovernmental industrial property organization making the communication desires that the effects provided for in Article 8 (2) (b) take place on a date later than at the expiration of three months from the date of the communication, indicate that later date.

(c) Where paragraph (b) (iii) applies, the effects provided for in Article 8 (2) (b) shall take place on the date indicated under that paragraph in the communication; otherwise, they shall take place at the expiration of three months from the date of the communication.

(d) The Director General shall promptly notify all Contracting States and intergovernmental industrial property organisations of any communication received under Article 8 (2) and of its effective date under paragraph (c). A corresponding notice shall be promptly published by the International Bureau.

4.3 *Consequences for Deposits*

In the case of a termination or limitation of the status of international depositary authority under Articles 8 (1), 8 (2), 9 (4) or 17 (4), Rule 5.1 shall apply, *mutatis mutandis*.

SCHEDULE 1—continued

Rule 5

Defaults by the International Depositary Authority

5.1 Discontinuance of Performance of Functions in Respect of Deposited Microorganisms

(a) If any international depositary authority temporarily or definitively discontinues the performance of any of the tasks it should perform under the Treaty and these Regulations in relation to any microorganisms deposited with it, the Contracting State or intergovernmental industrial property organization which, in respect of that authority, has furnished the assurances under Article 6 (1) shall:

- (i) ensure, to the fullest extent possible, that samples of all such microorganisms are transferred promptly and without deterioration or contamination from the said authority ("the defaulting authority") to another international depositary authority ("the substitute authority");
- (ii) ensure, to the fullest extent possible, that all mail or other communications addressed to the defaulting authority, and all files and other relevant information in the possession of that authority, in respect of the said microorganisms are promptly transferred to the substitute authority;
- (iii) ensure, to the fullest extent possible, that the defaulting authority promptly notifies all depositors affected of the discontinuance of the performance of its functions and the transfers effected;
- (iv) promptly notify the Director General of the fact and the extent of the discontinuance in question and of the measures which have been taken by the said Contracting State or intergovernmental industrial property organization under (i) to (iii).

(b) The Director General shall promptly notify the Contracting States and the intergovernmental industrial property organizations as well as the industrial property offices of the notification received under paragraph (a) (iv); the notification of the Director General and the notification received by him shall be promptly published by the International Bureau.

(c) Under the applicable patent procedure it may be required that the depositor shall, promptly after receiving the receipt referred to in Rule 7.5, notify to any industrial property office with which a patent application was filed with reference to the original deposit the new accession number given to the deposit by the substitute authority.

(d) The substitute authority shall retain in an appropriate form the accession number given by the defaulting authority, together with the new accession number.

(e) In addition to any transfer effected under paragraph (a) (i), the defaulting authority shall, upon request by the depositor, transfer, as far as possible, a sample of any microorganism deposited with it together with copies of all mail or other communications and copies of all files and other relevant information referred to in paragraph (a) (ii) to any international depositary authority indicated by the depositor other than the substitute authority, provided that the depositor pays any expenses to the defaulting authority resulting from the said transfer. The depositor shall pay the fee for the storage of the said sample to the international depositary authority indicated by him.

(f) On the request of any depositor affected, the defaulting authority shall retain, as far as possible, samples of the microorganisms deposited with it.

5.2 Refusal to Accept Certain Kinds of Microorganisms

(a) If any international depositary authority refuses to accept for deposit any of the kinds of microorganisms which it should accept under the assurances furnished, the Contracting State or intergovernmental industrial property organization which, in respect of that authority, has made the declaration referred to in Article 7 (1) (a) shall promptly notify the Director General of the relevant facts and the measures which have been taken.

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SCHEDULE 1—continued

(b) The Director General shall promptly notify the other Contracting States and intergovernmental industrial property organizations of the notification received under paragraph (a); the notification of the Director General and the notification received by him shall be promptly published by the International Bureau.

Rule 6

Making the Original Deposit or New Deposit

6.1 Original Deposit

(a) The microorganism transmitted by the depositor to the international depositary authority shall, except where Rule 6.2 applies, be accompanied by a written statement bearing the signature of the depositor and containing:

- (i) an indication that the deposit is made under the Treaty and an undertaking not to withdraw it for the period specified in Rule 9.1;
- (ii) the name and address of the depositor;
- (iii) details of the conditions necessary for the cultivation of the microorganism, for its storage and for testing its viability and also, where a mixture of microorganisms is deposited, descriptions of the components of the mixture and at least one of the methods permitting the checking of their presence;
- (iv) an identification reference (number, symbols, etc.) given by the depositor to the microorganism;
- (v) an indication of the properties of the microorganism which are or may be dangerous to health or the environment, or an indication that the depositor is not aware of such properties.

(b) It is strongly recommended that the written statement referred to in paragraph (a) should contain the scientific description and/or proposed taxonomic designation of the deposited microorganism.

6.2 New Deposit

(a) Subject to paragraph (b), in the case of a new deposit made under Article 4, the microorganism transmitted by the depositor to the international depositary authority shall be accompanied by a copy of the receipt of the previous deposit, a copy of the most recent statement concerning the viability of the microorganism which was the subject of the previous deposit indicating that the microorganism is viable and a written statement bearing the signature of the depositor and containing:

- (i) the indications referred to in Rule 6.1 (a) (i) to (v);
- (ii) a declaration stating the reason relevant under Article 4 (1) (a) for making the new deposit, a statement alleging that the microorganism which is the subject of the new deposit is the same as that which was the subject of the previous deposit, and an indication of the date on which the depositor received the notification referred to in Article 4 (1) (a) or, as the case may be, the date of the publication referred to in Article 4 (1) (e);
- (iii) where a scientific description and/or proposed taxonomic designation was/were indicated in connection with the previous deposit, the most recent scientific description and/or proposed taxonomic designation as communicated to the international depositary authority with which the previous deposit was made.

(b) Where the new deposit is made with the international depositary authority with which the previous deposit was made, paragraph (a) (i) shall not apply.

(c) for the purposes of paragraphs (a) and (b) and of Rule 7.4, "previous deposit" means:

- (i) where the new deposit has been preceded by one or more other new deposits: the most recent of those other new deposits;

SCHEDULE 1—continued

- (ii) where the new deposit has not been preceded by one or more other new deposits: the original deposit.

6.3 *Requirements of the International Depositary Authority*

- (a) Any international depositary authority may require:
 - (i) that the microorganism be deposited in the form and quantity necessary for the purposes of the Treaty and these Regulations;
 - (ii) that a form established by such authority and duly completed by the depositor for the purposes of the administrative procedures of such authority be furnished;
 - (iii) that the written statement referred to in Rule 6.1 (a) or 6.2 (a) be drafted in the language, or in any of the languages, specified by such authority, it being understood that such specification must at least include the official language or languages indicated under Rule 3.1 (b) (v);
 - (iv) that the fee for storage referred to in Rule 12.1 (a) (i) be paid; and
 - (v) that, to the extent permitted by the applicable law, the depositor enter into a contract with such authority defining the liabilities of the depositor and the said authority.
- (b) (No change)

6.4 *Acceptance Procedure*

- (a) The international depositary authority shall refuse to accept the microorganism and shall immediately notify the depositor in writing of such refusal and of the reasons therefor:
 - (i) where the microorganism is not of a kind of microorganism to which the assurances furnished under Rule 3.1 (b) (iii) or 3.3 extend;
 - (ii) where the properties of the microorganism are so exceptional that the international depositary authority is technically not in a position to perform the tasks in relation to it that it must perform under the Treaty and these Regulations;
 - (iii) where the deposit is received in a condition which clearly indicates that the microorganism is missing or which precludes for scientific reasons the acceptance of the microorganism.
- (b) Subject to paragraph (a), the international depositary authority shall accept the microorganism when all the requirements of Rule 6.1 (a) or 6.2 (a) and Rule 6.3 (a) are complied with. If any of those requirements are not complied with, the international depositary authority shall immediately notify the depositor in writing of that fact and invite him to comply with those requirements.
- (c) When the microorganism has been accepted as an original or new deposit, the date of that original or new deposit, as the case may be, shall be the date on which the microorganism was received by the international depositary authority.
- (d) The international depositary authority shall, on the request of the depositor and provided that all the requirements referred to in paragraph (b) are complied with, consider a microorganism, deposited before the acquisition by such authority of the status of international depositary authority, to have been received, for the purposes of the Treaty, on the date on which such status was acquired.

Rule 7

Receipt

7.1 *Issuance of Receipt*

The international depositary authority shall issue to the depositor, in respect of each deposit of microorganism effected with it or transferred to it, a receipt in attestation of the fact that it has received and accepted the microorganism.

SCHEDULE 1—continued

7.2 Form; Languages; Signature

- (a) Any receipt referred to in Rule 7.1 shall be established on a form called an "international form," a model of which shall be established by the Director General in those languages which the Assembly shall designate.
- (b) Any words or letters filled in in the receipt in characters other than those of the Latin alphabet shall also appear therein transliterated in characters of the Latin alphabet.
- (c) The receipt shall bear the signature of the person or persons having the power to represent the international depositary authority or that of any other official of that authority duly authorised by the said person or persons.

7.3 Contents in the Case of the Original Deposit

Any receipt referred to in Rule 7.1 and issued in the case of an original deposit shall indicate that it is issued by the depositary institution in its capacity of international depositary authority under the Treaty and shall contain at least the following indications:

- (i) the name and address of the international depositary authority;
- (ii) the name and address of the depositor;
- (iii) the date of the original deposit as defined in Rule 6.4 (c);
- (iv) the identification reference (number, symbols, etc.) given by the depositor to the microorganism;
- (v) the accession number given by the international depositary authority to the deposit;
- (vi) where the written statement referred to in Rule 6.1 (a) contains the scientific description and/or proposed taxonomic designation of the microorganism, a reference to that fact.

7.4 Contents in the Case of the New Deposit

Any receipt referred to in Rule 7.1 and issued in the case of a new deposit effected under Article 4 shall be accompanied by a copy of the receipt of the previous deposit (within the meaning of Rule 6.2 (c)) and a copy of the most recent statement concerning the viability of the microorganism which was the subject of the previous deposit (within the meaning of Rule 6.2 (c)) indicating that the microorganism is viable, and shall at least contain:

- (i) the name and address of the international depositary authority;
- (ii) the name and address of the depositor;
- (iii) the date of the new deposit as defined in Rule 6.4 (c);
- (iv) the identification reference (number, symbols, etc.) given by the depositor to the microorganism;
- (v) the accession number given by the international depositary authority to the new deposit;
- (vi) an indication of the relevant reason and the relevant date as stated by the depositor in accordance with Rule 6.2 (a) (ii);
- (vii) where Rule 6.2 (a) (iii) applies, a reference to the fact that a scientific description and/or a proposed taxonomic designation has/have been indicated by the depositor;
- (viii) the accession number given to the previous deposit (within the meaning of Rule 6.2 (c)).

7.5 Receipt in the Case of Transfer

The international depositary authority to which samples of microorganisms are transferred under Rule 5.1 (a) (i) shall issue to the depositor, in respect of each deposit in relation with which a sample is transferred, a receipt indicating that it

SCHEDULE 1—continued

is issued by the depositary institution in its capacity of international depositary authority under the Treaty and containing at least:

- (i) the name and address of the international depositary authority;
- (ii) the name and address of the depositor;
- (iii) the date on which the transferred sample was received by the international depositary authority (date of the transfer);
- (iv) the identification reference (number, symbols, etc.) given by the depositor to the microorganism;
- (v) the accession number given by the international depositary authority;
- (vi) the name and address of the international depositary authority from which the transfer was effected;
- (vii) the accession number given by the international depositary authority from which the transfer was effected;
- (viii) where the written statement referred to in Rule 6.1 (a) or 6.2 (a) contained the scientific description and/or proposed taxonomic designation of the microorganism, or where such scientific description and/or proposed taxonomic designation was/were indicated or amended under Rule 8.1 at a later date, a reference to that fact.

7.6 *Communication of the Scientific Description and/or Proposed Taxonomic Designation*

On request of any party entitled to receive a sample of the deposited microorganism under Rules 11.1, 11.2 or 11.3, the international depositary authority shall communicate to such party the most recent scientific description and/or proposed taxonomic designation referred to in Rules 6.1 (b), 6.2 (a) (iii) or 8.1 (b) (iii).

Rule 8

Later Indication or Amendment of the Scientific Description and/or Proposed Taxonomic Designation

8.1 *Communication*

(a) Where, in connection with the deposit of a microorganism, the scientific description and/or taxonomic designation of the microorganism was/were not indicated, the depositor may later indicate or, where already indicated, may amend such description and/or designation.

(b) Any such later indication or amendment shall be made in a written communication, bearing the signature of the depositor, addressed to the international depositary authority and containing:

- (i) the name and address of the depositor;
- (ii) the accession number given by the said authority;
- (iii) the scientific description and/or proposed taxonomic designation of the microorganism;
- (iv) in the case of an amendment, the last preceding scientific description and/or proposed taxonomic designation.

8.2 *Attestation*

The international depositary authority shall, on the request of the depositor having made the communication referred to in Rule 8.1, deliver to him an attestation showing the data referred to in Rule 8.1 (b) (i) to (iv) and the date of receipt of such communication.

SCHEDULE 1—continued

Rule 9

*Storage of Microorganisms*9.1 *Duration of the Storage*

Any microorganism deposited with an international depositary authority shall be stored by such authority, with all the care necessary to keep it viable and uncontaminated, for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism was received by the said authority and, in any case, for a period of at least 30 years after the date of the deposit.

9.2 *Secrecy*

No international depositary authority shall give information to anyone whether a microorganism has been deposited with it under the Treaty. Furthermore, it shall not give any information to anyone concerning any microorganism deposited with it under the Treaty except to an authority, natural person or legal entity which is entitled to obtain a sample of the said microorganism under Rule 11 and subject to the same conditions as provided in that Rule.

Rule 10

*Viability Test and Statement*10.1 *Obligation to Test*

The international depositary authority shall test the viability of each microorganism deposited with it:

- (i) promptly after any deposit referred to in Rule 6 or any transfer referred to in Rule 5.1;
- (ii) at reasonable intervals, depending on the kind of microorganism and its possible storage conditions, or at any time, if necessary for technical reasons;
- (iii) at any time, on the request of the depositor.

10.2 *Viability Statement*

(a) The international depositary authority shall issue a statement concerning the viability of the deposited microorganism:

- (i) to the depositor, promptly after any deposit referred to in Rule 6 or any transfer referred to in Rule 5.1;
- (ii) to the depositor, on his request, at any time after the deposit or transfer;
- (iii) to any industrial property office, other authority, natural person or legal entity, other than the depositor, to whom or to which samples of the deposited microorganism were furnished in conformity with Rule 11, on his or its request, together with or at any time after such furnishing of samples.

(b) The viability statement shall indicate whether the microorganism is or is no longer viable and shall contain:

- (i) the name and address of the international depositary authority issuing it;
- (ii) the name and address of the depositor;
- (iii) the date referred to in Rule 7.3 (iii) or, where a new deposit or a transfer has been made, the most recent of the dates referred to in Rules 7.4 (iii) and 7.5 (iii);
- (iv) the accession number given by the said authority;
- (v) the date of the test to which it refers;
- (vi) information on the conditions under which the viability test has been performed, provided that the said information has been requested by the

SCHEDULE 1—continued

party to which the viability statement is issued and that the results of the test were negative.

(c) In the cases of paragraph (a) (ii) and (iii), the viability statement shall refer to the most recent viability test.

(d) As to form, languages and signature, Rule 7.2 shall apply, *mutatis mutandis*, to the viability statement.

(e) In the case of paragraph (a) (i) or where the request is made by an industrial property office, the issuance of the viability statement shall be free of charge. Any fee payable under Rule 12.1 (a) (iii) in respect of any other viability statement shall be chargeable to the party requesting the statement and shall be paid before or at the time of making the request.

Rule 11

Furnishing of Samples

11.1 *Furnishing of Samples to Interested Industrial Property Offices*

Any international depositary authority shall furnish a sample of any deposited microorganism to the industrial property office of any Contracting State or of any intergovernmental industrial property organization, on the request of such office, provided that the request shall be accompanied by a declaration to the effect that:

- (i) an application referring to the deposit of that microorganism has been filed with that office for the grant of a patent and that the subject matter of that application involves the said microorganism or the use thereof;
- (ii) such application is pending before that office or has led to the grant of a patent;
- (iii) the sample is needed for the purposes of a patent procedure having effect in the said Contracting State or in the said organization or its member States;
- (iv) the said sample and any information accompanying or resulting from it will be used only for the purposes of the said patent procedure.

11.2 *Furnishing of Samples to or with the Authorisation of the Depositor*

Any international depositary authority shall furnish a sample of any deposited microorganism:

- (i) to the depositor, on his request;
- (ii) to any authority, natural person or legal entity (hereinafter referred to as "the authorised party"), on the request of such party, provided that the request is accompanied by a declaration of the depositor authorising the requested furnishing of a sample.

11.3 *Furnishing of Samples to Parties Legally Entitled*

(a) Any international depositary authority shall furnish a sample of any deposited microorganism to any authority, natural person or legal entity (hereinafter referred to as "the certified party"), on the request of such party, provided that the request is made on a form whose contents are fixed by the Assembly and that on the said form the industrial property office certifies:

- (i) that an application referring to the deposit of that microorganism has been filed with that office for the grant of a patent and that the subject matter of that application involves the said microorganism or the use thereof;
- (ii) that, except where the second phrase of (iii) applies, publication for the purposes of patent procedure has been effected by that office;
- (iii) *either* that the certified party has a right to a sample of the microorganism under the law governing patent procedure before that office and, where the said law makes the said right dependent on the fulfilment of certain conditions, that that office is satisfied that such conditions have actually

SCHEDULE 1—continued

been fulfilled *or* that the certified party has affixed his signature on a form before that office and that, as a consequence of the signature of the said form, the conditions for furnishing a sample to the certified party are deemed to be fulfilled in accordance with the law governing patent procedure before that office, where the certified party has the said right under the said law prior to publication for the purposes of patent procedure by the said office and such publication has not yet been effected, the certification shall expressly state so and shall indicate, by citing it in the customary manner, the applicable provision of the said law, including any court decision.

(b) In respect of patents granted and published by any industrial property office, such office may from time to time communicate to any international depositary authority lists of the accession numbers given by that authority to the deposits of the microorganisms referred to in the said patents. The international depositary authority shall, on the request of any authority, natural person or legal entity (hereinafter referred to as "the requesting party"), furnish to it a sample of any microorganism where the accession number has been so communicated. In respect of deposited microorganisms whose accession numbers have been so communicated, the said office shall not be required to provide the certification referred to in Rule 11.3 (a).

11.4 *Common Rules*

(a) Any request, declaration, certification or communication referred to in Rules 11.1, 11.2 and 11.3 shall be

- (i) in English, French, Russian or Spanish where it is addressed to an international depositary authority whose official language is or whose official languages include English, French, Russian or Spanish, respectively, provided that, where it must be in Russian or Spanish, it may be instead filed in English or French and, if it is so filed, the International Bureau shall, on the request of the interested party referred to in the said Rules or the international depositary authority, establish, promptly and free of charge, a certified translation into Russian or Spanish;
- (ii) in all other cases, it shall be in English or French, provided that it may be, instead, in the official language or one of the official languages of the international depositary authority.

(b) Notwithstanding paragraph (a), where the request referred to in Rule 11.1 is made by an industrial property office whose official language is Russian or Spanish, the said request may be in Russian or Spanish, respectively, and the International Bureau shall establish, promptly and free of charge, a certified translation into English or French, on the request of that office or the international depositary authority which received the said request.

(c) Any request, declaration, certification or communication referred to in Rules 11.1, 11.2 and 11.3 shall be in writing, shall bear a signature and shall be dated.

(d) Any request, declaration or certification referred to in Rules 11.1, 11.2 and 11.3 (a) shall contain the following indications:

- (i) the name and address of the industrial property office making the request, of the authorised party or of the certified party, as the case may be;
- (ii) the accession number given to the deposit;
- (iii) in the case of Rule 11.1, the date and number of the application or patent referring to the deposit;
- (iv) in the case of Rule 11.3 (a), the indications referred to in (iii) and the name and address of the industrial property office which has made the certification referred to in the said Rule.

(e) Any request referred to in Rule 11.3 (b) shall contain the following indications:

- (i) the name and address of the requesting party;

SCHEDULE 1—continued

- (ii) the accession number given to the deposit.
- (f) The container in which the sample furnished is placed shall be marked by the international depositary authority with the accession number given to the deposit and shall be accompanied by a copy of the receipt referred to in Rule 7, an indication of any properties of the microorganism which are or may be dangerous to health or the environment and, upon request, an indication of the conditions which the international depositary authority employs for the cultivation and storage of the microorganism.
- (g) The international depositary authority having furnished a sample to any interested party other than the depositor shall promptly notify the depositor in writing of that fact, as well as of the date on which the said sample was furnished and of the name and address of the industrial property office, of the authorised party, of the certified party or of the requesting party, to whom or to which the sample was furnished. The said notification shall be accompanied by a copy of the pertinent request, of any declarations submitted under Rules 11.1 or 11.2 (ii) in connection with the said request, and of any forms or requests bearing the signature of the requesting party in accordance with Rule 11.3.
- (h) The furnishing of samples referred to in Rule 11.1 shall be free of charge. Where the furnishing of samples is made under Rule 11.2 or 11.3, any fee payable under Rule 12.1 (a) (iv) shall be chargeable to the depositor, to the authorised party, to the certified party or to the requesting party, as the case may be, and shall be paid before or at the time of making the said request.

11.5 *Changes in Rules 11.1 and 11.3 when Applying to International Applications*

Where an application was filed as an international application under the Patent Cooperation Treaty, the reference to the filing of the application with the industrial property office in Rules 11.1 (i) and 11.3 (a) (i) shall be considered a reference to the designation, in the international application, of the Contracting State for which the industrial property office is the "designated Office" within the meaning of that Treaty, and the certification of publication which is required by Rule 11.3 (a) (ii) shall, at the option of the industrial property office, be either a certification of international publication under the said Treaty or a certification of publication by the industrial property office.

Rule 12

Fees

12.1 *Kinds and Amounts*

- (a) Any international depositary authority may, with respect to the procedure under the Treaty and these Regulations, charge a fee:
 - (i) for storage;
 - (ii) for the attestation referred to in Rule 8.2;
 - (iii) subject to Rule 10.2 (e), first sentence, for the issuance of viability statements;
 - (iv) subject to Rule 11.4 (h), first sentence, for the furnishing of samples;
 - (v) for the communication of information under Rule 7.6.
- (b) The fee for storage shall be for the whole duration of the storage of the microorganism as provided in Rule 9.1.
- (c) The amount of any fee shall not vary on account of the nationality or residence of the depositor or on account of the nationality or residence of the authority, natural person or legal entity requesting the issuance of a viability statement or furnishing of samples.

SCHEDULE 1—continued

12.2 *Change in the Amounts*

(a) Any change in the amount of the fees charged by any international depositary authority shall be notified to the Director General by the Contracting State or intergovernmental industrial property organization which made the declaration referred to in Article 7(1) in respect of that authority. The notification may, subject to paragraph (c), contain an indication of the date from which the new fees will apply.

(b) The Director General shall promptly notify all Contracting States and intergovernmental industrial property organizations of any notification received under paragraph (a) and of its effective date under paragraph (c); the notification of the Director General and the notification received by him shall be promptly published by the International Bureau.

(c) Any new fees shall apply as of the date indicated under paragraph (a), provided that, where the change consists of an increase in the amounts of the fees or where no date is so indicated, the new fees shall apply as from the thirtieth day following the publication of the change by the International Bureau.

Rule 12^{bis}*Computation of Time Limits*12^{bis}. 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.

12^{bis}. 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.

12^{bis}. 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.

Rule 13

*Publication by the International Bureau*13.1 *Form of Publication*

Any publication by the International Bureau referred to in the Treaty or these Regulations shall be made in the monthly periodical of the International Bureau referred to in the Paris Convention for the Protection of Industrial Property.

13.2 *Contents*

(a) At least in the first issue of each year of the said periodical, an up-to-date list of the international depositary authorities shall be published, indicating in respect of each such authority the kinds of microorganisms that may be deposited with it and the amount of the fees charged by it.

SCHEDULE 1—continued

(b) Full information on any of the following facts shall be published once, in the first issue of the said periodical published after the occurrence of the fact:

- (i) any acquisition, termination or limitation of the status of international depositary authority, and the measures taken in connection with that termination or limitation;
- (ii) any extension referred to in Rule 3.3;
- (iii) any discontinuance of the functions of an international depositary authority, any refusal to accept certain kinds of microorganisms, and the measures taken in connection with such discontinuance or refusal;
- (iv) any change in the fees charged by an international depositary authority;
- (v) any requirements communicated in accordance with Rule 6.3 (b) and any amendments thereof.

Rule 14

Expenses of Delegations

14.1 Coverage of Expenses

The expenses of each delegation participating in any session of the Assembly and in any committee, working group or other meeting dealing with matters of concern to the Union shall be borne by the State or organisation which has appointed it.

Rule 15

Absence of Quorum in the Assembly

15.1 Voting by Correspondence

- (a) In the case provided for in Article 10 (5) (b), the Director General shall communicate any decision of the Assembly (other than decisions relating to the Assembly's own procedure) to the Contracting States which were not represented when the decision was made and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication.
 - (b) If, at the expiration of the said 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 when the decision was made, that decision shall take effect provided that at the same time the required majority still obtains.
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SCHEDULE 2

Subregulation 1.4 (2)

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Schedule of Fees

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PATENT COOPERATION TREATY

Done at Washington 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.

Introductory 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;

SCHEDULE 2—continued

(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 contains 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.

SCHEDULE 2—continued

(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.

SCHEDULE 2—continued

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.

SCHEDULE 2—continued

*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, fulfill 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.

SCHEDULE 2—continued

(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 endeavour 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.

SCHEDULE 2—continued

(5) (a) If the national law of the Contracting State so permits, the applicant who files a national application with 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.

*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.

SCHEDULE 2—continued

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

SCHEDULE 2—continued

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 requirements 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.

SCHEDULE 2—continued

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 that 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

SCHEDULE 2—continued

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 giving 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 favourable 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.

SCHEDULE 2—continued

(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

SCHEDULE 2—continued

(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.

SCHEDULE 2—continued

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, *mutatis 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.

SCHEDULE 2—continued

(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.

*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.

SCHEDULE 2—continued

(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.

SCHEDULE 2—continued

(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

SCHEDULE 2—continued

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 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.

SCHEDULE 2—continued

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.

SCHEDULE 2—continued

(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

SCHEDULE 2—continued

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;

SCHEDULE 2—continued

(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 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 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.

(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.

SCHEDULE 2—continued

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 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;

(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.

SCHEDULE 2—continued

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

SCHEDULE 2—continued

(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 interests the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of co-ordination 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 subparagraph (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.

SCHEDULE 2—continued

(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

SCHEDULE 2—continued

(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.

SCHEDULE 2—continued

(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 or 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.

SCHEDULE 2—continued

(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.

(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 States 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.

SCHEDULE 2—continued

(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 to 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.

SCHEDULE 2—continued

*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).

Regulations under the Patent Cooperation Treaty

Adopted on June 19, 1970, and amended on April 14, 1978, on October 3, 1978, on May 1, 1979, on June 16, 1980, on September 26, 1980, on July 3, 1981, on September 10, 1982, on October 4, 1983, on February 3, 1984, on September 28, 1984 and on October 1, 1985.

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.

SCHEDULE 2—continued

2.2 "Agent"

Whenever the word "agent" is used, it shall be construed as meaning any person who has the right to practice before international authorities as defined in Article 49 and, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used, also the common representative referred to in Rule 4.8.

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 requires 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 Printed Form

The request shall be made on a printed form.

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 printed form shall contain a list which, when filled in, will show:

(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 suggests should accompany the abstract when the abstract is published on the front page of the pamphlet and in the Gazette; in exceptional cases, the applicant may suggest more than one figure.

(b) The list shall be filled in by the applicant, failing which the receiving Office shall fill it in and make the necessary annotations, except that the number referred to in paragraph (a) (iii) shall not be filled in by the receiving Office.

3.4 Particulars

Subject to Rule 3.3, particulars of the printed form 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.

SCHEDULE 2—continued

- (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 and the names of the designated States for which he wishes to obtain such a 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. It is recommended to indicate any telegraphic and teleprinter address and telephone number of the agent or common representative or, in the absence of the designation of an agent or common representative in the request, of the applicant first named in the request.

(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.

SCHEDULE 2—continued

(c) The applicant's residence shall be indicated by the name of the State of which he is a resident.

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 *Representation of Several Applicants Not Having a Common Agent*

(a) If there is more than one applicant and the request does not refer to an agent representing all the applicants ("a common agent"), the request shall designate one of the applicants who is entitled to file an international application according to Article 9 as their common representative.

(b) If there is more than one applicant and the request does not refer to an agent representing all the applicants and it does not comply with the requirement of designating one of the applicants as provided in paragraph (a), the common representative shall be the applicant first named in the request who is entitled to file an international application with the receiving Office with which the international application was filed (Rule 19.1 (a)).

4.9 *Designation of States*

Contracting States shall be designated in the request by their names.

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 it was filed; when the earlier application is a regional or an international application, at least one country for which it was filed, and

(ii) the date on which it was filed, the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made except where, resulting from an obvious error, the indication of the said country or the said date is missing or is erroneous; whenever the identity or correct identity of

SCHEDULE 2—continued

the said country, or the said date or the correct date, may be established on the basis of the copy of the earlier application which reaches the receiving Office before it transmits the record copy to the International Bureau, the error shall be considered as an obvious error.

(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 1 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.

SCHEDULE 2—continued

4.15 *Signature*

The request shall be signed by the applicant.

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.

SCHEDULE 2—continued

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

SCHEDULE 2—continued

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 2 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 2 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.

SCHEDULE 2—continued

(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.

(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.

SCHEDULE 2—continued

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 application 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 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 x 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 request, 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

SCHEDULE 2—continued

(c) On sheets containing drawings, the surface usable shall not exceed 26.2 cm x 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) The margins of the international application, when submitted, must be completely blank.

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 placed at the top of the sheet, in the middle, but not 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 on the left side, to the right of the 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 catch words 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.

SCHEDULE 2—continued

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 authorized 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

SCHEDULE 2—continued

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) If the international application is filed in a language other than the language in which it is to be published, the request may, notwithstanding paragraph (a), be filed in the language of publication.

(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 *Claims of Different Categories*

Rule 13.1 shall be construed as permitting, in particular, one of the following three possibilities:

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

(ii) in addition to an independent claim for a given process, the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, the inclusion in the same international application of an independent claim for a process specially adapted for the manufacture of the product, and the inclusion in the same international application of an independent claim for an apparatus or means specifically designed for carrying out the process.

13.3 *Claims of One and the Same Category*

Subject to Rule 13.1, it shall be permitted to include in the same international application two or more independent claims of the same category (i.e., product, process, apparatus, or use) which cannot readily be covered by a single generic 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

SCHEDULE 2—continued

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 2 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 13^{bis}

Microbiological Inventions

13^{bis}.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.

13^{bis}.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.

13^{bis}.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 13^{bis}.7 (a) (i), provided that the requirement to indicate that matter was published in the Gazette in accordance with Rule 13^{bis}.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.

13^{bis}.4 *References: Time of Furnishing Indications*

If any of the indications referred to in Rule 13^{bis}.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 13^{bis}.7 (a) (ii), provided that the International Bureau has published such requirement in the Gazette in accordance with Rule 13^{bis}.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 International Bureau shall notify the applicant and the designated Offices of the date on which it has

SCHEDULE 2—continued

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.

13^{bis}.5 References and Indications for the Purposes of One or More Designated States; Different Deposits for Different Designated States; Deposits with Depositary 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 depositary institution other than one notified by it under Rule 13^{bis}.7 (b).

13^{bis}.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 depositary 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 from 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.

13^{bis}.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.

SCHEDULE 2—continued

(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 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 competent 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 by the applicant in the international application, except that, where Article 44 applies in respect of a designation, only one designation fee shall be due.

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.

SCHEDULE 2—continued

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.

(d) If, on February 3, 1984, paragraphs (a) and (b) are not compatible with the national law applied by the receiving Office and as long as they continue to be not compatible with that law, the basic fee shall be paid on the date of receipt of the international application and the designation fee shall be paid within one year from the priority date.

15.6 *Refund*

(a) The international fee shall be refunded to the applicant if the determination under Article 11 (1) is negative.

(b) In no other case shall the international fee be refunded.

*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

SCHEDULE 2—continued

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 search fee shall be refunded to the applicant if the determination under Article 11 (1) is negative.

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 16^{bis}

Advancing Fees by the International Bureau

16^{bis}.1 *Guarantee by the International Bureau*

(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 the search fee, the receiving Office shall charge the amount required to cover those fees, or the missing part thereof, to the International Bureau and shall consider the said amount as if it had been paid by the applicant at the due time.

(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, the receiving Office shall charge the amount required to cover those fees to the International Bureau and shall consider that amount as if it had been paid by the applicant at the due time.

(c) The International Bureau shall transfer from time to time to each receiving Office an amount which is expected to be necessary for covering any charges that the receiving Office has to make under paragraphs (a) and (b). The amount and the time of such transfers shall be determined by each receiving Office according to its own wish. The charging of any amount under paragraphs (a) and (b) shall not require any advance notice to, or any agreement by, the International Bureau.

SCHEDULE 2—continued

16^{bis}.2 *Obligations of the Applicant. Etc.*

(a) The International Bureau shall promptly notify the applicant of any amount by which it was charged under Rule 16^{bis}.1 (a) and (b) and shall invite him to pay to it, within one month from the date of the notification, the said amount augmented by a surcharge of 50%, provided that the surcharge will not be less, and will not be more, than the amounts indicated in the Schedule of Fees. The notification may refer to the charges made both under Rule 16^{bis}.1 (a) and (b) or, at the discretion of the International Bureau, there may be two separate notifications, one referring to charges made under Rule 16^{bis}.1 (a), the other referring to charges made under Rule 16^{bis}.1 (b).

(b) If the applicant fails to pay, within the said time limit, to the International Bureau the amount claimed, or pays less than what is needed to cover the transmittal fee, the basic fee, the search fee, one designation fee and the surcharge, the International Bureau shall notify the receiving Office accordingly and the receiving Office shall declare the international application withdrawn under Article 14 (3) (a) and the receiving Office and the International Bureau shall proceed as provided in Rule 29.

(c) If the applicant pays, within the said time limit, to the International Bureau an amount which is more than what is needed to cover the fees and surcharge referred to in paragraph (b) but less than what is needed to cover all the designations maintained, the International Bureau shall notify the receiving Office accordingly and the receiving Office shall apply the amount paid in excess of what is needed to cover the fees and surcharge referred to in paragraph (b) in an order which shall be established as follows:

(i) where the applicant indicates to which designation or designations the amount is to be applied, it shall be applied accordingly but, if the amount received is insufficient to cover the designations indicated, it shall be applied to as many designations as are covered by it in the order chosen by the applicant in indicating the designations;

(ii) to the extent that the applicant has not given the indications under item (i), the amount or the balance thereof shall be applied to the designations in the order in which they appear in the international application;

(iii) where the designation of a State is for the purposes of a regional patent and provided that the required designation fee is, under the preceding provisions, available for that designation, the designation of any further States for which the same regional patent is sought shall be considered as covered by that fee.

The receiving Office shall declare any designation not covered by the amount paid withdrawn under Article 14 (3) (b) and the receiving Office and the International Bureau shall proceed as provided in Rule 29.

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

SCHEDULE 2—continued

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) Paragraphs (a) and (b) shall apply also to any earlier international application whose priority is claimed in the subsequent international application.

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 Several Applicants: Same for All Designated States

If all the applicants are applicants for the purposes of all designated States, 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 Several Applicants: Different for Different Designated States

(a) The international application may indicate different applicants for the purposes of different designated States, provided that, in respect of each designated State, at least one of the applicants indicated for the purposes of that State is entitled to file an international application according to Article 9.

(b) If the condition referred to in paragraph (a) is not fulfilled in respect of any designated State, the designation of that State shall be considered not to have been made.

(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

SCHEDULE 2—continued

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 intergovernmental 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 Several Applicants

If there are several 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 in the space provided for that purpose in the request form of each copy received and one of the numbers assigned by the International Bureau to that Office 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;

SCHEDULE 2—continued

(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.

20.3^{bis} *Manner of Carrying Out Corrections*

The Administrative Instructions prescribe the manner in which corrections required under Article 11 (2) (a) shall be presented by the applicant and the manner in which they shall be entered in the file of the international application.

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.

20.5 *Positive Determination*

(a) If the determination under Article 11 (1) is positive, the receiving Office shall stamp in the space provided for that purpose in the request form 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 sheet 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 1 month, from the date of the invitation. If such time limit expires after the expiration of 1 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.

SCHEDULE 2—continued

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 5 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.

SCHEDULE 2—continued

(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).

22.3 Time Limit under Article 12 (3)

The time limit referred to in Article 12 (3) shall be 3 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.

(b) If the International Bureau has not received, within 10 days from the receipt of the record copy, information from the International Searching Authority that that Authority is in possession of the search copy, the International Bureau shall promptly transmit a copy of the international application to the International Searching Authority.

Rule 24

Receipt of the Record Copy by the International Bureau

24.2 Notification of Receipt of the Record Copy

(a) Subject to the provisions of paragraph (b), the International Bureau shall promptly notify the applicant, the receiving Office, the International Searching Authority, and all designated Offices, 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, the name of the applicant, and the name of the receiving Office, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain

SCHEDULE 2—continued

the list of the designated Offices which have been notified under this paragraph, and shall, in respect of each designated Office, indicate any applicable time limit under Article 22 (3).

(b) 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 1 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 1 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.

26.3^{bis} *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.

26.4 *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 transferred 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.

SCHEDULE 2—continued

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.

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)), and the search fee (Rule 16).

(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)).

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 the interested designated Offices;

(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 Searching Authority of the said declaration;

SCHEDULE 2—continued

(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 the interested national Office.

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 1 month from the notification.

Rule 30

Time Limit under Article 14 (4)

30.1 *Time Limit*

The time limit referred to in Article 14 (4) shall be 4 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

Withdrawal of the International Application or of Designations

32.1 *Withdrawals*

(a) The applicant may withdraw the international application prior to the expiration of 20 months from the priority date except as to any designated State in which national processing or examination has already started. He may withdraw the designation of any designated State prior to the date on which processing or examination may start in that State.

(b) Withdrawal of the designation of all designated States shall be treated as withdrawal of the international application.

(c) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau or to the receiving Office. In the case of Rule 4.8 (b), the notice shall require the signature of all the applicants.

(e) There shall be no international publication of the international application or of the designation, as the case may be, if the notice effecting withdrawal reaches

SCHEDULE 2—continued

the International Bureau before the technical preparations for publication have been completed.

Rule 32^{bis}

Withdrawal of the Priority Claim

32^{bis}.1 *Withdrawals*

(a) The applicant may withdraw the priority claim made in the international application under Article 8 (1) at any time before the international publication of the international application.

(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 them.

(c) Where the withdrawal of the priority claim, or, in the case of more than one such claim, the withdrawal of any of them, causes a change in the priority date of the international application, any time limit which is computed from the original priority date and which has not already expired shall be computed from the priority date resulting from that change. In the case of the time limit of 18 months 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 effecting withdrawal reaches the International Bureau during the period of 15 days preceding the expiration of that time limit.

(d) For any withdrawal under paragraph (a), the provisions of Rule 32.1 (c) shall apply *mutatis mutandis*.

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 available to the public of the written disclosure occurred on a date posterior to the international filing date.

(c) Any published application or any patent whose publication date is later 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.

SCHEDULE 2—continued

(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),
- (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 *Offenlegunschrift* 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

SCHEDULE 2—continued

(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 6 months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical 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 organization must have in its possession at least the minimum documentation referred to in Rule 34, properly arranged for search purposes;

(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.

SCHEDULE 2—continued

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 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). In the latter case, it shall invite the applicant to comment on the abstract established by it within 1 month from the date of the invitation.

(b) The definitive contents of the abstract shall be determined by the International Searching Authority.

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 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 Searching Authority is not equipped to search prior art concerning such programs.

SCHEDULE 2—continued

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.

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 3 months from the receipt of the search

SCHEDULE 2—continued

copy by the International Searching Authority, or 9 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, the name of the receiving Office, 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.

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.

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.

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 (Article 17 (3) (a)), the international search report shall indicate what parts of the international application were and what parts were not searched.

SCHEDULE 2—continued

43.8 *Signature*

The international search report shall be signed by an authorized officer of the International Searching Authority.

43.9 *No Other Matter*

The international search report shall contain no matter other than that enumerated in Rules 33.1 (b) and (c), 43.1, 2, 3, 5, 6, 7 and 8, and 44.2 (a) and (b), and the indication referred to in Article 17 (2) (b). In particular, it shall contain no 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) Subject to paragraphs (b) and (c), 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) If, at the time the international search is completed, the time limit allowed for the applicant to comment on any suggestion of the International Searching Authority in respect of the abstract has not expired, the international search report shall indicate that it is incomplete as far as the abstract is concerned.

(c) As soon as the time limit referred to in paragraph (b) has expired, the International Searching Authority shall notify the abstract approved or established by it to the International Bureau and to the applicant.

44.3 *Copies of Cited Documents*

(a) The request referred to in Article 20 (3) may be presented any time during 7 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) Any International Searching Authority not wishing to send copies direct to any designated Office shall send a copy to the International Bureau and the International Bureau shall then proceed as provided in paragraphs (a) and (b).

(d) Any International Searching Authority may perform the obligations referred to in (a) to (c) 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.

SCHEDULE 2—continued

Rule 46

*Amendment of Claims Before the International Bureau*46.1 *Time Limit*

The time limit referred to in Article 19 shall be 2 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.

46.3 *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.

Rule 47

*Communication to Designated Offices*47.1 *Procedure*

(a) The communication provided for in Article 20 shall be effected by the International Bureau.

(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.

SCHEDULE 2—continued

(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.

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).

(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.

SCHEDULE 2—continued

(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

SCHEDULE 2—continued

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.

(c) If the international application or the designation of any designated State is withdrawn under Rule 32.1, or if the priority claim is withdrawn under Rule 32^{bis}.1, after the technical preparations for international publication have been completed, this fact 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.

(a^{bis}) 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.

(a^{ter}) 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.

SCHEDULE 2—continued

(b) Any notification received by the International Bureau under *paragraphs (a), (a^{bis}) or (a^{ter})* 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 2 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 13^{bis}.4*

For the purposes of Article 22 and the present Rule, any statement made under Article 19 (1) and any indication furnished under Rule 13^{bis}.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) 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.

(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,

SCHEDULE 2—continued

(i) 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, or

(ii) disregard the said drawing if such invitation, on February 3, 1984, is not compatible with the national law applied by that Office and as long as it continues to be not compatible with that law.

(f) The expression "Fig." does not require translation into any language.

(g) Where any copy of the drawings or 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 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.

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 3 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 2 months computed from the date of the notification sent to the applicant under Rules 20.7 (i), 24.2 (b), 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*

SCHEDULE 2—continued

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 51^{bis}**Certain National Requirements Allowed under Article 27 (1), (2), (6) and (7)**51^{bis}.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.

51^{bis}.2 Opportunity to Comply with National Requirements

(a) Where any of the requirements referred to in Rule 51^{bis}.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.

(c) If, on February 3, 1984, paragraph (a) is, with respect to the requirements referred to in Rule 51^{bis}.1 (a) (iii) and (vi), (b) (i) and (d), not compatible with the national law applied by the designated Office and as long as it continues to be not

SCHEDULE 2—continued

compatible with that law, the applicant shall have no opportunity to comply with any of the requirements after the expiration of the time limit applicable under Article 22. Information on such national laws shall be published by the International Bureau in the Gazette.

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 4 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.

(b) Copies of printed forms shall be furnished free of charge by the receiving Offices to the applicants.

(c) The particulars of the forms shall be prescribed by the Administrative Instructions.

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.

(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*.

SCHEDULE 2—continued

53.5 *The Agent*

If an agent is designated, Rules 4.4, 4.7, and 4.16 shall apply, and Rule 4.8 shall apply *mutatis mutandis*.

53.6 *Identification of the International Application*

The international application shall be identified by the name of the receiving Office with which the international application was filed, the name and address of the applicant, the title of the invention, and, where the international filing date and the international application number are known to the applicant, that date and that number.

53.7 *Election of States*

The demand shall name, among the designated States, at least one Contracting State bound by Chapter II of the Treaty as elected State.

53.8 *Signature*

The demand shall be signed by the applicant.

*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 *Several Applicants: Same for All Elected States*

If all the applicants are applicants for the purposes of all elected States, the right to make a demand under Article 31 (2) shall exist if at least one of them is

(i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed as provided in Article 31 (2) (a), 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 *Several Applicants: Different for Different Elected States*

(a) For the purposes of different elected States, different applicants may be indicated, provided that, in respect of each elected State, at least one of the applicants indicated for the purposes of that State is

(i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed as provided in Article 31 (2) (a), 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.

54.4 *Applicant Not Entitled to Make a Demand or an Election*

(a) If the applicant does not have the right or, in the case of several applicants, if none of them has the right to make a demand under Article 31 (2), the demand shall be considered not to have been submitted.

(b) If the requirement under Rule 54.3 (a) is not fulfilled in respect of any elected State, the election of that State shall be considered not to have been made.

*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.

SCHEDULE 2—continued

Rule 56

Later Elections

56.1 Elections Submitted Later Than the Demand

The election of States not named in the demand shall be effected by a notice signed and submitted by the applicant, and shall identify the international application and the demand.

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 later election shall preferably be made on a printed form furnished free of charge to applicants. If it is not made on such a form, it 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) Where, because of a later election or elections, the international preliminary examination report must, in application of Article 36 (2), be translated by the International Bureau into one or more additional languages, a "supplement to the handling fee" shall be collected by the International Bureau.

57.2 Amounts of the Handling Fee and the Supplement to the Handling Fee

(a) The amount of the handling fee is as set out in the Schedule of Fees. The amount payable in any particular case shall be the amount as so set out, increased by as many times the same amount as the number of languages into which the international preliminary examination report must, in application of Article 36 (2), be translated by the International Bureau.

(b) The amount of the supplement to the handling fee is as set out in the Schedule of Fees. The amount payable in any particular case shall be the amount as so set out, multiplied by the number of additional languages referred to in Rule 57.1 (b).

(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.

SCHEDULE 2—continued

(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 directives 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) Any supplement to the handling fee shall be due at the time the later election is submitted.

(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.

(d) Any supplement to the handling fee shall be payable in Swiss currency.

57.4 Failure to Pay (Handling Fee)

(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 Failure to Pay (Supplement to the Handling Fee)

(a) Where the supplement to the handling fee is not paid as required, the International Bureau shall invite the applicant to pay the supplement within one month from the date of the invitation.

(b) If the applicant complies with the invitation within the one month time limit, the supplement to 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 later election shall be considered as if it had not been submitted.

57.6 Refund

In no case shall the handling fee, or the supplement to the handling fee, be refunded.

*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.

SCHEDULE 2—continued

(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 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 its national Office, or, in the case provided for in Rule 19.1 (b), with the national Office of another State or an intergovernmental organization acting for the former Office, and 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, 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 and 55, the International Preliminary Examining Authority shall invite the applicant to correct the defects within 1 month from the date of the invitation.

SCHEDULE 2—continued

(b) If the applicant complies with the invitation within the prescribed time limit, 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) 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.

(d) 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 (c).

60.2 *Defects in Later Elections*

(a) If the later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the defects within 1 month from the date of the invitation.

(b) If the applicant complies with the invitation within the prescribed time limit, the later election shall be considered as if it had been received on the actual filing date, provided that the later election as submitted contained at least one election and permitted the international application to be identified; otherwise, the later election shall be considered as if it had been received on the date on which the International Bureau receives the correction.

(c) If the applicant does not comply with the invitation within the prescribed time limit, the later election shall be considered as if it had not been submitted.

Rule 61

*Notification of the Demand and Elections*61.1 *Notifications to the International Bureau, the Applicant and the International Preliminary Examining Authority*

(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 files.

(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 54.4 (b) 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 International Preliminary Examining Authority and the applicant of the receipt, and the date of receipt, of any later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 60.2 (b). Where the later election has been considered under Rules 57.5 (c) or 60.2 (c) as if it had not been submitted, the International Bureau shall notify the applicant accordingly.

61.2 *Notifications 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 name of the receiving Office, 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 later elections—the date of receipt by the International Bureau of the later election.

SCHEDULE 2—continued

(c) The notification shall be sent to the elected Office promptly after the expiration of the 18th month from the priority date, or, if the international preliminary examination report is communicated earlier, then, at the same time as the communication of that report. Elections effected after such notification shall be notified promptly after they have been effected.

61.3 *Information for the Applicant*

The International Bureau shall inform the applicant in writing that it has effected the notification referred to in Rule 61.2. At the same time, it shall indicate to him, in respect of each elected State, any applicable time limit under Article 39 (1) (b).

Rule 62

Copy for the International Preliminary Examining Authority

62.2 *Amendments*

(a) Any amendment filed under Article 19 shall be promptly transmitted by the International Bureau to the International Preliminary Examining Authority. If, at the time of filing such amendments, a demand for international preliminary examination has already been submitted, the applicant shall, 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.

(b) If the time limit for filing amendments under Article 19 (see Rule 46.1) has expired without the applicant's having filed amendments under that Article, or if the applicant has declared that he does not wish to make amendments under that Article, the International Bureau shall notify the International Preliminary Examining Authority accordingly.

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.

SCHEDULE 2—continued

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 after 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, as such, after 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*

Before the international preliminary examination starts, the applicant may make amendments according to Article 34 (2) (b) and the international preliminary examination shall initially be directed to the claims, the description, and the drawings, as contained in the international application at the time the international preliminary examination starts.

66.2 *First Written Opinion of the International Preliminary Examining Authority*(a) *If the International Preliminary Examining Authority*

- (i) considers that the international application has any of the defects described in Article 34 (4),
- (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.

SCHEDULE 2—continued

- (iv) considers that any amendment goes beyond the disclosure in the international application as filed, or
- (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.

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 2 months after the date of notification. In no case shall it be shorter than 1 month after the said date. It shall be at least 2 months after the said date where the international search report is transmitted at the same time as the notification. In no case shall it be more than 3 months after the said date.

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.

66.5 *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.

SCHEDULE 2—continued

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 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 2 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 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.

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 establish the

SCHEDULE 2—continued

international preliminary examination report, subject to Article 34 (4) (b), in respect of the entire international application, but shall indicate, in the said report, that, in its opinion, the requirement of unity of invention is not fulfilled and shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention.

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 1 month, and it shall not be longer than 2 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 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 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.

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

Time Limit for International Preliminary Examination

69.1 *Time Limit for International Preliminary Examination*

(a) 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:

SCHEDULE 2—continued

(ii) 9 months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.

(b) International preliminary examination shall start upon receipt, by the International Preliminary Examining Authority:

(i) under Rule 62.2 (a), of the claims as amended under Article 19, or

(ii) under Rule 62.2 (b), of a notice from the International Bureau that no amendments under Article 19 have been filed within the prescribed time limit or that the applicant has declared that he does not wish to make such amendments, or

(iii) of a notice, after the international search report is in the possession of the International Preliminary Examining Authority, from the applicant expressing the wish that the international preliminary examination should start and be directed to the claims as specified in such notice, or

(iv) of a notice of the declaration by the International Searching Authority that no international search report will be established (Article 17 (2) (a)).

(c) If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes, start at the same time as the international search. In such a case, the international preliminary examination report shall be established, notwithstanding the provisions of paragraph (a), no later than 6 months after the expiration of the time limit allowed under Article 19 for amending the claims.

*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.

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, the name of the receiving Office, 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.

SCHEDULE 2—continued

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 (c) 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.

SCHEDULE 2—continued

70.12 *Mention of Certain Defects*

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.

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.

70.14 *Signature*

The report shall be signed by an authorized officer of the International Preliminary Examining Authority.

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*

If the claims, the description, or the drawings, were amended before the International Preliminary Examining Authority, each replacement sheet under Rule 66.8 (a) shall be annexed to the report. Replacement sheets superseded by later replacement sheets 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.

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 7 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) Any International Preliminary Examining Authority not wishing to send copies direct to any elected Office shall send a copy to the International Bureau

SCHEDULE 2—continued

and the International Bureau shall then proceed as provided in paragraphs (a) and (b).

(d) Any International Preliminary Examining Authority may perform the obligations referred to in (a) to (c) 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, French, German, Japanese, Russian, or Spanish.

(b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

72.2 Copies of Translations for the Applicant

The International Bureau shall transmit a copy of each translation 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.

Rule 74

Translations of Annexes of the International Preliminary Examination Report and Transmittal Thereof

74.1 Contents 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

Withdrawal of the Demand, or of Elections

75.1 Withdrawals

(a) Withdrawal of the demand or all the elections may be effected prior to the expiration of 30 months from the priority date except as to any elected State in which national processing or examination has already started. Withdrawal of the

SCHEDULE 2—continued

election of any elected State may be effected prior to the date on which examination and processing may start in that State.

(b) Withdrawal shall be effected by a signed notice from the applicant to the International Bureau. In the case of Rule 4.8 (b), the notice shall require the signature of all the applicants.

75.4 *Faculty under Article 37 (4) (b)*

(a) Any Contracting State wishing to take advantage of the faculty provided for in Article 37 (4) (b) shall notify the International Bureau in writing.

(b) The notification under 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 1 month after the publication date of the relevant issue of the Gazette.

Rule 76

Copy, Translation and Fee under Article 39 (1); Translation of Priority Document

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 51^{bis}*

Rules 22.1 (g), 49 and 51^{bis} 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 shall be construed as a reference to Article 39 (1);

(iii) the words "international applications filed" in Rule 49.1 (c) shall be replaced by the words "a demand submitted."

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 3 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,

SCHEDULE 2—continued

exercise the right under Article 41 after the transmittal of the international preliminary examination report under Article 36 (1) has been effected and before the time limit applicable under Article 39 expires, provided that, if the said transmittal has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than on 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 Article 39.

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.

SCHEDULE 2—continued

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 7 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 7 days after the date it bears.

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.

(c) The International Bureau shall be open for business until 6 p.m.

SCHEDULE 2—continued

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 2 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 3 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 5 days prior to the expiration of the time limit. Except in cases where surface mail normally arrives at its destination within 2 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 such mailing 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 1 month after the date on which the interested party noticed—or with due diligence should have noticed—the delay or loss, and in no case later than 6 months after the expiration of the time limit applicable in the given case.

SCHEDULE 2—continued

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 5 days after the mail service was resumed. The provisions of Rule 82.1 (c) shall apply *mutatis mutandis*.

Rule 82^{bis}*Excuse by the Designated or Elected State of Delays in Meeting Certain Time Limits*82^{bis}.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.

82^{bis}.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 82^{ter}*Rectification of Errors Made by the Receiving Office or by the International Bureau*82^{ter}.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.

SCHEDULE 2—continued

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 3 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.

SCHEDULE 2—continued

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*

(a) Subject to paragraph (b), the Gazette shall be published once a week.

(b) For a transitional period after the entry into force of the Treaty terminating upon a date fixed by the Assembly, the Gazette may be published at such times as the Director General considers appropriate having regard to the number of international applications and the amount of other material required to be published.

86.4 *Sale*

(a) Subject to paragraph (b), the subscription and other sale prices of the Gazette shall be fixed in the Administrative Instructions.

(b) For a transitional period after the entry into force of the Treaty terminating upon a date fixed by the Assembly, the Gazette may be distributed on such terms as the Director General considers appropriate having regard to the number of international applications and the amount of other material published therein.

86.5 *Title*

The title of the Gazette shall be "Gazette of International Patent Applications," and "Gazette des Demandes internationales de brevets," respectively.

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, which shall be made, in respect of each year, by November 30 of the preceding year. If any publication is available in more than one language, the request shall specify the language 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:

SCHEDULE 2—continued

- (i) Rule 14.1 (Transmittal Fee),
- (ii) Rule 22.2 (Transmittal of the Record Copy: Alternative Procedure),
- (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).

88.3 *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 2 months prior to the opening of that session of the Assembly which is called upon to make a decision on the proposal.

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.

SCHEDULE 2—continued

PART F

Rules Concerning Several Chapters of the Treaty

Rule 90

*Representation*90.1 *Definitions*

For the purposes of Rule 90.2 and Rule 90.3:

- (i) "agent" means any of the persons referred to in Article 49;
- (ii) "common representative" means the applicant referred to in Rule 4.8.

90.2 *Effects*

(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 having appointed the agent.

(b) 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.

(c) If there are several agents appointed by the same applicant or applicants, any act by or in relation to any of the several agents shall have the effect of an act by or in relation to the said applicant or applicants.

(d) The effects described in paragraphs (a), (b), and (c), shall apply to the processing of the international application before the receiving Office, the International Bureau, the International Searching Authority, and the International Preliminary Examining Authority.

90.3 *Appointment*

(a) Appointment of any agent, or of any common representative within the meaning of Rule 4.8 (a), shall be effected by each applicant, at his choice, either by signing the request in which the agent or common representative is designated or by a separate power of attorney (i.e., a document appointing an agent or a common representative).

(b) The power of attorney may be submitted to the receiving Office or the International Bureau. Whichever of the two is the recipient of the power of attorney submitted shall immediately notify the other and the interested International Searching Authority and the interested International Preliminary Examining Authority.

(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.

(d) A general power of attorney may be deposited with the receiving Office for purposes of the processing of the international application as defined in Rule 90.2 (d). Reference may be made in the request to such general power of attorney, provided that a copy thereof is attached to the request by the applicant.

90.4 *Revocation*

(a) Any appointment may be revoked by the persons who have made the appointment or their successors in title.

(b) Rule 90.3 shall apply, *mutatis mutandis*, to the document containing the revocation.

Rule 91

*Obvious Errors in Documents*91.1 *Rectification*

(a) Subject to paragraphs (b) to (g^{quarter}), 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

SCHEDULE 2—continued

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 (g^{quater}). 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 (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 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 (g^{bis}), (g^{ter}) and (g^{quater}), 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

SCHEDULE 2—continued

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 be 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 be not 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.

(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 authorized the use of such language.

(d) Any letter from the applicant to the International Bureau shall be in English or French.

(e) Any letter or 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 registered air mail, provided that surface mail may be used instead of air mail in cases where surface mail normally arrives at its destination within 2 days from mailing or where air mail service is not available.

SCHEDULE 2—continued

92.4 *Use of Telegraph, Teleprinter, Etc.*

(a) Notwithstanding the provisions of Rules 11.14 and 92.1 (a), but subject to paragraph (b), below, any document (including any drawing) subsequent to the international application may be sent by telegraph or teleprinter or other like means of communication producing a printed or written document. Any such document so sent shall be considered to have been submitted in a form complying with the requirements of the said Rules on the day on which it was communicated by the means mentioned above, provided that, within 14 days after being so communicated, its contents are furnished in that form, otherwise, the telegraphic, teleprinter or other communication shall be considered not to have been made.

(b) Each national Office or intergovernmental organization shall promptly notify the International Bureau of any means referred to in paragraph (a) by which it is prepared to receive documents referred to in that paragraph. The International Bureau shall publish the information so received in the Gazette as well as information concerning the means referred to in paragraph (a) by which the International Bureau is prepared to receive any such document. Paragraph (a) shall apply with respect to any national Office or intergovernmental organization only to the extent the said information has been so published with respect to it. The International Bureau shall publish, from time to time, in the Gazette, changes in the information previously published.

Rule 92^{bis}

Recording of Changes in Certain Indications in the Request or the Demand

92^{bis}.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.

SCHEDULE 2—continued

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.

SCHEDULE OF FEES

<i>Fees</i>	<i>Amounts</i>
1. <i>Basic Fee:</i> (Rule 15.2 (a))	
if the international application contains not more than 30 sheets	706 Swiss francs
if the international application contains more than 30 sheets	706 Swiss francs plus 14 Swiss francs for each sheet in excess of 30 sheets

SCHEDULE 2—continued

2. <i>Designation Fee:</i> (Rule 15.2 (a))	171 Swiss francs per designation for which the fees is due, with a maximum of 1,710 Swiss francs, any such designation in excess of 10 being free of charge
3. <i>Handling Fee:</i> (Rule 57.2 (a))	216 Swiss francs
4. <i>Supplement to the Handling Fee:</i> (Rule 57.2 (b))	216 Swiss francs
<i>Surcharges</i>	
5. Surcharge for late payment: (Rule 16 ^{bis} .2(a))	Minimum: 268 Swiss francs Maximum: 674 Swiss francs

SCHEDULE 3

Paragraphs 3.2 (2) (b) and 10.2 (1) (a)
and subregulation 22.16 (2)

FORMAL REQUIREMENTS FOR DOCUMENTS TO BE FILED**Terminology and signs**

1. In a document:
 - (a) units of description must be expressed in terms of the metric system or, if first expressed in other terms, must be expressed also in terms of that system; and
 - (b) temperatures must be expressed in degrees Celsius or, if first expressed in another manner, must be expressed also in degrees Celsius; and
 - (c) to indicate units of measurement, the rules of international practice must be observed; and
 - (d) in chemical formulas, the symbols, atomic weights and molecular formulas in general use must be employed; and
 - (e) other terms, signs and symbols that are generally accepted in the art to which the document principally relates must be employed; and
 - (f) if the document is expressed in English— the beginning of any decimal fraction must be marked by a period; and
 - (g) units, signs, symbols and other terms must be used consistently.

Fitness for reproduction

2. Each sheet comprising a document or part of a document:
 - (a) must be presented in a manner that allows any number of copies of the sheet to be reproduced directly by means of photography, an electrostatic or photo-offset process and microfilming; and
 - (b) must not be folded, creased or cracked; and
 - (c) subject to subclause 8 (4) (“ drawings, formulas and tables in textual matter”) and subclause 11 (14) (“ special requirements for drawings”), must be presented in a vertical format; and
 - (d) must be durable, flexible, smooth, strong, white and have a matt finish; and
 - (e) must be international sheet size A4.

SCHEDULE 3— *continued*

Separate sheets

3. (1) The patent request, the description of the invention, the claim or claims, any drawing, and an abstract, must each commence on a separate sheet.

(2) The sheets comprising a document must be connected so that they may be readily:

- (a) turned to be read; and
- (b) separated for the purposes of reproduction and then rejoined.

Margins

4. (1) Subject to subclause (2), each sheet of a specification, or an abstract, must have a margin that is not less than:

- (a) at the top— 2 cm; and
- (b) on the left— 2.5cm; and
- (c) on the right— 2 cm; and
- (d) at the bottom— 2 cm.

(2) A sheet of drawings:

- (a) must have a margin that is not less than:
 - (i) at the top— 2.5 cm; and
 - (ii) on the left— 2.5 cm; and
 - (iii) on the right— 1.5 cm; and
 - (iv) at the bottom— 1 cm; and
- (b) must not contain a frame surrounding the drawings.

Numeration

5. (1) The parts of a patent application referred to in this subclause must be presented in the following order:

- (a) patent request;
- (b) description of the invention;
- (c) claim or claims;
- (d) drawing or drawings;
- (e) abstract.

(2) Subject to subclause (3), the sheets of a specification must be numbered consecutively in arabic numerals beginning with “1” that are placed at the top, and in the middle, of the sheet, but not within the margins of the sheet.

SCHEDULE 3— *continued*

(3) The sheets of a specification that contain drawings must be numbered by means of sets of 2 arabic numerals separated by an oblique stroke, the first numeral in each set being the consecutive number of each sheet, beginning with the arabic number “1”, and the second being the total number of the sheets containing the drawings.

(4) If there is more than 1 claim referred to in a complete specification, the claims must be numbered consecutively in arabic numerals beginning with “1”.

Numbering of lines

6. Every fifth line on each sheet of the specification must be numbered:

- (a) in arabic numerals; and
- (b) on the left of the sheet to the right of the margin.

Writing of textual matter

7. (1) Subject to subclause (2), except with the consent of the Commissioner, a patent request, specification and any abstract relating to a patent application must be typewritten or printed.

(2) If necessary, symbols relating to graphic matter, or chemical or mathematical formulas, may be handwritten or drawn, as the case may be.

(3) The lines of text in a typewritten document must be 1 ½ spaced or double spaced.

(4) The text in a document must be presented in letters the capitals of which are not less than 0.21 cm high, in a dark colour and be indelible.

Drawings, formulas and tables in textual matter

8. (1) A patent request must not include a drawing.

- (2) The description of an invention or an abstract:
 - (a) must not include a drawing; and

SCHEDULE 3—*continued*

(b) may include chemical or mathematical formulas or tables.

(3) A claim:

- (a) must not include a drawing; and
- (b) may include chemical or mathematical formulas; and
- (c) if, in the reasonable opinion of the Commissioner, the subject matter of the claim makes the use of a table desirable— may include tables.

(4) A table or a chemical or mathematical formula may be presented in a horizontal format if it cannot be presented in a vertical format in a satisfactory manner.

(5) If a table or a chemical or mathematical formula is presented in a horizontal format, the top of the table or formula must be placed on the left side of the paper.

Words in drawings

9. A drawing must not include text, other than a word or words indispensable to the understanding of the drawing.

Alterations

10. (1) Subject to subclause (2), a document must be free from erasures, alterations, overwritings and interlineations.

(2) If, in the reasonable opinion of the Commissioner, failure to comply with subclause (1) would not:

(a) compromise the authenticity; or

(b) jeopardise the likelihood of clear reproduction;

of a document, the Commissioner may excuse it from compliance with subclause (1).

Special requirements for drawings

11. (1) A drawing must be executed in durable, black, dense, dark, uniformly thick and well-defined, lines and strokes without colouring.

(2) A cross-section must be indicated by oblique hatching that does not impede the clear reading of reference letters, numbers or signs and leading lines.

(3) The scale of a drawing and the distinctness of its execution must enable all the details to be distinguished without difficulty on a photographic reproduction of the drawing with a two-thirds linear reduction in size.

(4) If the scale of a drawing is given on the drawing, it must be represented graphically.

(5) A letter, number or reference line that is shown on a drawing must be presented simply and be clear.

(6) Brackets, braces, circles or inverted commas must not be used in association with letters or numbers.

(7) A line in a drawing must ordinarily be drawn with the aid of drafting instruments.

(8) A sheet of drawings may include more than 1 drawing.

SCHEDULE 3— *continued*

(9) Each element of a drawing must be shown in proper proportion to each other element of the drawing, other than where the use of a different proportion is indispensable for the clarity of the drawing.

(10) The height of a letter or a number in a drawing must not be less than 0.32 cm.

(11) For the lettering of a drawing, the Latin or, if customary, the Greek alphabet must be used.

(12) If drawings on 2 or more sheets of drawings form in effect a single drawing, the drawings must be so arranged that the single drawing can be assembled without concealing any part of the other drawings.

(13) Subject to subclause (14), if there is more than 1 drawing on a sheet of drawings, the drawings must be presented on the sheet of drawings in a vertical format and separate from each other.

(14) If the drawings on a sheet of drawings cannot be presented in a vertical format, they must be presented in a horizontal format with the tops of the drawings on the left of the sheet of drawings.

(15) The drawings must be numbered consecutively in arabic numerals beginning with "1".

(16) A reference sign that is not mentioned in the description of the invention must not be referred to in a drawing.

(17) A reference sign that is not mentioned in a drawing must not be referred to in the description.

(18) A feature of a drawing that is denoted by a reference sign must be so denoted consistently.

SCHEDULE 4Subregulation 8.5 (1)
and regulation 11.1**PRESCRIBED FOREIGN COUNTRIES****PART 1**

Algeria	Guinea-Bissau
Argentina	Haiti
Austria	Holy See
Bahamas	Hungary
Bangladesh	Iceland
Barbados	Indonesia
Belgium	Iran (Islamic Republic of)
Benin	Iraq
Brazil	Ireland
Bulgaria	Israel
Burkina Faso	Italy
Burundi	Japan
Cameroon	Jordan
Canada	Kenya
Central African Republic	Lebanon
Chad	Lesotho
China	Libyan Arab Jamahiriya
Congo	Liechtenstein
Côte d'Ivoire	Luxembourg
Cuba	Madagascar
Cyprus	Malawi
Czechoslovakia	Malaysia
Democratic People's Republic of Korea	Mali
Denmark (including Faroe Islands)	Malta
Dominican Republic	Mauritania
Egypt	Mauritius
Finland	Mexico
France (including all Overseas Departments and Territories)	Monaco
Gabon	Mongolia
Germany	Morocco
Ghana	Netherlands (including the Netherlands Antilles and Aruba)
Greece	New Zealand (excluding the Cook Islands, Niue and Tokelau)
Guinea	Niger

SCHEDULE 4— *continued*

Nigeria
Norway
Philippines
Poland
Portugal
Republic of Korea
Romania
Rwanda
San Marino
Senegal
South Africa
Soviet Union
Spain
Sri Lanka
Sudan
Suriname
Sweden
Switzerland
Syrian Arab Republic

Togo
Trinidad and Tobago
Tunisia
Turkey
Uganda
United Kingdom (including Hong
Kong and the Isle of Man)
United Republic of Tanzania
United States of America
(including all territories and
possessions, including the
Commonwealth of Puerto
Rico)
Uruguay
Viet Nam
Yugoslavia
Zaire
Zambia
Zimbabwe

PART 2

India

SCHEDULE 5Regulations 20.3, 20.6,
20.8, 20.9 and 20.16**PRESCRIBED SUBJECTS**

Column 1 Item	Column 2 Subject
1	Legal Process
2	Patent Law of Australia and the Practice of the Patent Office
3	Trade Marks Law of Australia and the Practice of the Trade Marks Office
4	Designs Law and Related Intellectual Property Laws of Australia and the Practice of the Designs Office
5	Preparation of Specifications
6	Interpretation and Criticism of Specifications
7	Patent, Trade Marks and Designs Law and Practice of Countries other than Australia
8	Patent Attorneys' Practice

SCHEDULE 6

Regulations 20.3, 20.14,
20.15 and 20.16

PRESCRIBED QUALIFICATIONS

Column 1 Item	Column 2 Qualification
1	A degree, diploma or post-graduate diploma of an Australian tertiary institution in a course approved under subregulation 20.14 (1) in a branch of engineering or science
2	An award of an overseas education institution in a course approved under subregulation 20.14 (1) in a branch of engineering or science
3	A pass in an examination in a branch of engineering or science approved under subregulation 20.14 (3) that qualifies for corporate membership of The Institution of Engineers, Australia, The Royal Australian Chemical Institute or another professional institution approved under subregulation 20.14 (5)

SCHEDULE 7

Regulations 22.2, 22.3 and 22.4

FEES**PART 1- PATENT ATTORNEYS**

Column 1 Item	Column 2 Matter	Column 3 Fee \$
1	On making an application for admission to sit for an examination- per subject	45
2	On making an application for grant of a supplementary examination- per subject	45
3	On making an application for a report of reasons for failure- per subject	40
4	On making an application for a certificate of the Board under regulation 20.16	40
5	On making an application for registration as a patent attorney	185
6	Annual registration fee payable by a patent attorney	295
7	On making an application under regulation 20.19	145

PART 2- GENERAL FEES

Column 1 Item	Column 2 Matter	Column 3 Fee
1	On filing a request for a patent accompanied by a provisional specification	\$75

SCHEDULE 7—continued

Column 1 Item	Column 2 Matter	Column 3 Fee
2	On filing a request for a petty patent accompanied by a complete specification	\$75
3	On filing a request for a standard patent accompanied by a complete specification	\$160
	plus:	
	(a) if the number of sheets comprising the specification, including any drawings contained in the specification, exceeds 10— for each sheet in excess of 10	\$8
	(b) if the number of claims exceeds 10— for each claim in excess of 10	\$8
4	On filing a request for an examination of a patent request and complete specification:	
	(a) if the request was not preceded by a direction of the Commissioner under subsection 44 (2) or 44 (4) of the Act:	
	(i) in the case of a request for an examination to be made in accordance with section 45 of the Act	\$370
	(ii) in the case of a request for a modified examination	\$315
	(b) if the request was preceded by a direction of the Commissioner under subsection 44 (2) or 44 (4) of the Act (whether or not the applicant had, before the request was made, requested deferment of the examination under section 46 of the Act):	

SCHEDULE 7—continued

Column 1 Item	Column 2 Matter	Column 3 Fee
	(i) in the case of the request for an examination to be made in accordance with section 45 of the Act	\$315
	(ii) in the case of a request for a modified examination	\$270
5	On filing a request under subsection 44 (3) of the Act requiring the Commissioner to direct an applicant to request examination	\$85
6	On filing a copy of the specification referred to in subregulation 3.20 (6):	
	(a) if filed between 1 month and 2 months after filing of the request for modified examination	\$50
	(b) if filed after 2 months after filing of the request for modified examination	\$155
7	On filing a request under subsection 97 (2) of the Act for re-examination of a complete specification	\$1000
8	Continuation fee for the purposes of paragraph 142 (2) (d) and renewal fee for the purposes of paragraph 143 (a) of the Act for:	
	(a) the third anniversary	\$110
	(b) the fourth anniversary	\$135
	(c) the fifth anniversary	\$160
	(d) the sixth anniversary	\$190
	(e) the seventh anniversary	\$220
	(f) the eighth anniversary	\$255
	(g) the ninth anniversary	\$290

SCHEDULE 7— continued

Column 1 Item	Column 2 Matter	Column 3 Fee
	(h) the tenth anniversary	\$330
	(i) the eleventh anniversary	\$370
	(j) the twelfth anniversary	\$410
	(k) the thirteenth anniversary	\$450
	(l) the fourteenth anniversary	\$500
	(m) the fifteenth anniversary	\$550
	plus:	\$50 for each
		month, or
	if paid within 6 months after the anniversary	part of a
		month, after
		the
		anniversary
		to when the
		fee is paid
9	Renewal fee for the purposes of paragraph 143 (a) of the Act if an extension of the term of a standard patent has been granted under subsection 75 (2) or (4) of the Act for:	
	(a) the sixteenth anniversary	\$600
	(b) the seventeenth anniversary	\$650
	(c) the eighteenth anniversary	\$700
	(d) the nineteenth anniversary	\$750
	plus:	
	if paid within 6 months after the anniversary	\$50 for each
		month, or
		part of a
		month, after
		the
		anniversary
		to when the
		fee is paid

SCHEDULE 7— continued

Column 1 Item	Column 2 Matter	Column 3 Fee
10	On filing a notice of opposition under regulation 5.3	\$85
11	On filing a request under subregulation 5.5 (1) for dismissal of opposition	\$50
12	On filing an application under subregulation 5.10 (2) for an extension of time, for each month, or part of a month, for which the application is made	\$50
13	On filing an application under subregulation 5.10 (4) to lodge further evidence in opposition proceedings	\$75
14	For sealing a standard patent under section 61 of the Act	\$250
15	On filing an application for the grant of an extension of the term of a petty patent under section 69 of the Act	\$50
16	For granting an extension of the term of a petty patent under section 69 of the Act	\$285
17	On filing an application under section 70 of the Act for the extension of the term of a patent relating to a pharmaceutical substance	\$325
18	For granting under section 75 of the Act an extension of term of a patent relating to a pharmaceutical substance	\$325
19	On filing an application under section 66 of the Act for a duplicate of a patent to be sealed	\$50

SCHEDULE 7—continued

Column 1 Item	Column 2 Matter	Column 3 Fee
20	On filing a request for leave to amend a complete specification under section 104 of the Act, before a request for examination has been filed or after the complete specification has been accepted	\$95
21	On filing a request for leave to amend:	
	(a) a patent request or another filed document under section 104 of the Act, not being a request for change of address or a request to which the fee under paragraph (b) applies, before a request for examination has been filed or after the patent request has been accepted	\$50
	(b) a patent request for a petty patent to make it a patent request for a standard patent	\$85
22	On filing:	
	(a) a request to amend a patent or an entry in the Register under subregulation 10.7 (1), other than:	\$50
	(i) a request for change of address, or	
	(ii) a request to which the fee under paragraph (b) applies	
	(b) simultaneously, 2 or more requests under subregulation 10.7 (1), each of which is to make the same amendment to the name entered in the Register	\$50, plus \$25 for each request after the first

SCHEDULE 7—continued

Column 1 Item	Column 2 Matter	Column 3 Fee
23	On filing a request under subregulation 19.1 (2) for registration of particulars referred to in paragraph 19.1 (1) (a) or (b):	
	(a) other than a request to which the fee under paragraph (b) applies	\$50
	(b) simultaneously, 2 or more requests under subregulation 19.1 (2), if the devolution of title or interest is the same in respect of all the patents to which the requests relate	\$50, plus \$25 for each request after the first
24	On filing a request under subsection 17 (1) or (2), section 46, subsection 49 (3), 54 (1), 82 (1), 92 (1) or 113 (1) or section 215 of the Act	\$50
25	On filing a document or documents referred to in subregulation 8.6 (2), 3 months after filing the application:	
	(a) before or at the time of filing a request for examination	\$50
	(b) after filing a request for examination	\$155
26	On filing any translation or translations referred to in paragraph 3.1 (3) (b), 3 months after complying with the requirements of subsection 89 (3) of the Act:	
	(a) before or at the time of filing a request for examination	\$50

SCHEDULE 7— continued

Column 1 Item	Column 2 Matter	Column 3 Fee
	(b) after filing a request for examination	\$155
27	On filing a request under subsection 150 (1) of the Act to restore a lapsed application	\$85
28	On filing an application under subsection 223 (2) of the Act for an extension of time on the ground specified in paragraph 223 (2) (a) of the Act:	
	(a) if the application is filed before the end of the time to be extended— for each month, or part of a month, for which the extension is granted	\$50
	(b) if the application is filed after the time to be extended	\$80, plus the amount payable under paragraph (a)
29	For granting an extension of time under subsection 223 (2) of the Act on the ground specified in paragraph 223 (2) (a) of the Act, if the extension is granted after the period for which the application is made— for each month, or part of a month, for which the time is extended	\$50, less any amount paid under paragraph (a) of item 28
30	On filing an application under subsection 223 (2) of the Act for an extension of time on the ground specified in paragraph 223 (2) (b) of the Act	\$50

SCHEDULE 7—continued

Column 1 Item	Column 2 Matter	Column 3 Fee
31	On filing a request for the exercise of discretionary power under regulation 22.22 or appearing at a hearing	\$80
32	On filing a response to the Commissioner's report under section 45 or 48 of the Act, if filed more than 12 months, but within 21 months, after the date of the first report on the examination— for each month, or part of a month, after the 12 months, other than a month in respect of which a fee was paid in relation to that examination	\$50
33	For supply of an uncertified copy of:	
	(a) a patent specification,	\$15
	(b) another document	\$10
34	For supply of a certificate by the Commissioner:	
	(a) for the first certificate	\$75
	(b) for each additional certificate that is the same, and supplied at the same time as, the first certificate	\$55
35	On filing a request for information under subregulation 19.2 (1), other than a request referred to in item 36 or 37— for each application, patent or document	\$50
36	On filing a request for a computer printout of information under subregulation 19.2 (1) about a patent or a patent application	\$10

SCHEDULE 7—continued

Column 1 Item	Column 2 Matter	Column 3 Fee
37	On filing a request under subregulation 19.2 (2) for information that requires an international-type search	\$530
38	On filing a request under section 58 of the Act for the result of a search made under section 45 or 48 of the Act	\$25
39	On filing a substitute page or pages in compliance with a direction under subregulation 3.2 (4):	
	(a) within 3 months after the day when the direction was given	\$30
	(b) after the time specified in paragraph (a) but before the application becomes open to public inspection	\$90
40	For filing an abstract after the day when a direction was given under subregulation 3.4 (5)	\$50
41	For taxing costs	\$45

PART 3— GENERAL FEES FOR INTERNATIONAL APPLICATIONS

Column 1 Item	Column 2 Matter	Column 3 Fee \$
1	Transmittal fee under Rule 14 of the PCT	50
2	Search fee under Rule 16 of the PCT	570

SCHEDULE 7—continued

Column 1 Item	Column 2 Matter	Column 3 Fee
3	Additional fee for search under Article 17 (3) (a) of the PCT	510
4	Preliminary examination fee under Rule 58 of the PCT	285
5	Additional fee for international preliminary examination under Article 34 (3) (a) of the PCT	285
6	For a copy of a document in accordance with Rules 44.3 (b) and 71.2 (b) of the PCT	15

Note: The text of the PCT is set out in Schedule 2.

**PART 4— FEES FOR INTERNATIONAL APPLICATIONS PAYABLE
FOR THE BENEFIT OF THE INTERNATIONAL BUREAU**

Column 1 Item	Column 2 Matter	Column 3 Fee
1	Basic fee under Rule 15.2 (a) of the PCT	
	(a) if the international application contains not more than 30 sheets	706 Swiss francs
	(b) if international application contains more than 30 sheets	706 Swiss francs, plus 14 Swiss francs for each sheet in excess of 30 sheets

SCHEDULE 7—continued

Column 1 Item	Column 2 Matter	Column 3 Fee
2	Designation fee under Rule 15.2 (a) of the PCT	171 swiss francs per designation for which the fee is due with a maximum of 1,710 Swiss francs, any such designation in excess of 10 being free of charge
3	Handling fee under Rule 57.2 (a) of the PCT	216 Swiss francs

Note: The text of the PCT is set out in Schedule 2.

SCHEDULE 8

Regulation 22.8

COSTS, EXPENSES AND ALLOWANCES**PART 1— COSTS**

Column 1 Item	Column 2 Matter	Column 3 Amount
1	Notice of opposition	\$165
2	Evidence in support	\$430
3	Receiving and perusing notice of opposition	\$80
4	Receiving and perusing evidence in support	\$185
5	Evidence in answer	\$430
6	Receiving and perusing evidence in answer	\$130
7	Evidence in reply	\$215
8	Receiving and perusing evidence in reply	\$80
9	Preparation of case for hearing	\$325
10	Attendance at hearing by patent attorney or solicitor without counsel	\$165 per hour or \$735 per day
11	Attendance at hearing by patent attorney or solicitor instructing counsel	\$130 per hour or \$590 per day
12	Counsel fees	\$215 per hour or \$970 per day

PART 2—EXPENSES AND ALLOWANCES

Division 1—Expenses

1. A person who paid a fee prescribed in these Regulations in respect of a matter relating to proceedings before the Commissioner or the Patent Attorneys Disciplinary Tribunal may be paid the amount of the fee.

2. A person attending proceedings before the Commissioner or the Patent Attorneys Disciplinary Tribunal must be paid a reasonable amount for allowances for:

- (a) transport between the usual place of residence of the person and the place that he or she attends for that purpose; and
 - (b) if he or she is required to be absent overnight from his or her usual place of residence—meals and accommodation;
- up to a daily maximum of \$370.

Division 2—Allowances

3. A person summoned to appear as a witness, because of his or her professional, scientific or other special skill or knowledge, before the Commissioner or the Patent Attorneys Disciplinary Tribunal must be paid:

- (a) if the person is remunerated in his or her occupation by wages, salary or fees—an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; and
- (b) in any other case—an amount of not less than \$81, or more than \$407, for each day on which he or she so attends.

SCHEDULE 8—continued

4. A person summoned to appear as a witness, other than a witness referred to in clause 3, before the Commissioner or the Patent Attorneys Disciplinary Tribunal must be paid:

- (a) if the person is remunerated in his or her occupation by wages, salary or fees— an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; and
- (b) in any other case— an amount of not less than \$46, or more than \$76, for each day on which he or she so attends.

NOTE

1. Notified in the *Commonwealth of Australia Gazette* on

1991.

26 April /