

the written opinion of the ISA will become the written opinion of the IPEA. If a Demand is not timely filed, the written opinion of the ISA will form the basis for the issuance, by the International Bureau (IB) on behalf of the ISA, of an "International Preliminary Report on Patentability (chapter I of the Patent Cooperation Treaty)" ("IPRP"), which will be communicated to all designated Offices and made available for public inspection after the expiration of 30 months from the priority date.

This revised system will result in a slight increase in the workload on the ISA, but should result in a substantial decrease in the workload on the IPEA. In addition, smaller Offices will benefit by the availability of an international preliminary report on patentability equivalent to the chapter II international preliminary examination report (*i.e.*, the IPRP) even if no Demand has been filed.

Under the revised system, the time limit for filing a Demand for international preliminary examination has changed. Specifically, the Demand must be filed within the later of: (1) Three months from issuance of the international search report and the written opinion of the ISA (or, if a search cannot be made, of the declaration under Article 17.2(a)); or (2) 22 months from the priority date. *See* PCT rule 54*bis*.1(a). Any Demand made after the expiration of this time limit will be considered as if it had not been submitted. *See* PCT rule 54*bis*.1(b). Any arguments or amendments in response to the written opinion of the ISA must be submitted within the time limit for filing the Demand to ensure consideration by the IPEA. It is noted that applicants may still desire to file the Demand prior to the expiration of 19 months of the priority date in order to delay entry into the national stage for those few remaining Contracting States that have taken a reservation to the 30-month time limit in Article 22(1).

As in current PCT chapter II procedures, the IPEA will still establish an international preliminary examination report, though the report will now bear the title "International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty)." This report will be established within the applicable time limit under PCT rule 69 (usually within 28 months from the priority date).

Under the revised system, payment of the international preliminary examination fee and handling fee is not required until the later of one month from the filing of the Demand or 22 months from the priority date. *See* PCT rules 57.3(a) and 58.1(b). However,

where the IPEA and the ISA are the same and the IPEA wishes to start examination at the same time as the international search, the IPEA may require that the examination and handling fees be paid within one month of an invitation by the IPEA to pay such fees. *See* PCT rule 57.3(c).

*Automatic Indication of All Designations Possible under the PCT; Relaxed Signature and other Filing Requirements; Simplified Fee System:* Under the amendments to the Regulations of the PCT, upon filing an international application, applicant will obtain automatic and all-inclusive coverage of all designations available under the PCT, including all kinds of protection as well as both national and regional patent protection. *See* PCT rule 4.9. Similarly, the mere filing of a Demand will constitute the election of all designated States. *See* PCT rule 53.7. Thus, applicants need not, at the time of filing the international application, specifically designate individual Contracting States, or choose certain kinds of protection or indicate expressly whether national or regional protection is sought. Such matters will be resolved in the national phase.

This automatic and all-inclusive designation system overcomes a current pitfall for applicants who have inadvertently omitted specific designations upon filing the international application and such designations were not, or could not be, timely confirmed under PCT rule 4.9(c). For example, if the original international application papers did not contain at least one designation, an international filing date could not be accorded as of the initial receipt date of the application papers. *See* PCT Article 11(1)(iii)(b). Furthermore, even in those applications containing at least one designation, PCT rule 4.9(b) required that any additional States and/or additional kinds of protection be confirmed by the submission of a written notice, accompanied by payment of the appropriate confirmation fee, within a relatively short time period (*i.e.*, 15 months from the priority date). This time period was frequently overlooked by applicants. Under the new system of automatic designations/elections, the current procedures for precautionary designations and later elections become unnecessary and have been eliminated from the PCT Rules. This will reduce the workload on the PCT Receiving Office (RO) and IPEA by eliminating processing of precautionary designations and later elections, as well as petitions relating to omitted designations.

As a further benefit of the automatic designation system is the simplification of the PCT fee system. Under the current PCT fee structure, both a "basic" fee and a "designation" fee are required. Moreover, these fees are due at different times in different amounts depending on when they are paid. Under the new system, these fees have been eliminated in favor of a single international filing fee (comprised of two fee components, a first fee component for up to 30 sheets of paper and a second fee component for sheets of paper in excess of 30) due at one time.

As a consequence of the automatic designation system, applicant/inventors will have to be named in the international application. To alleviate hardships with regard to obtaining signatures of all the applicants named on the Request, PCT rule 26 has been amended to provide that, for purposes of Article 14(a)(i), the international application will be considered as signed in accordance with the PCT Regulations if the Request has been signed by at least one applicant. *See* PCT rule 26.2*bis*(a). In addition, if there is more than one applicant, PCT rule 26.2*bis*(b) provides that, for purposes of PCT Article 14(1)(a)(ii), it is sufficient that the identifying information (*i.e.*, address, residence and nationality) be provided for only one applicant who is entitled under PCT rule 19.1 to file the international application with the RO. This means that for purposes of filing an international application with the United States Receiving Office (RO/US) as the competent RO, this information must be provided with respect to at least one applicant who is a citizen or resident of the United States. Notwithstanding the amendments to PCT rule 26, a designated/elected Office may still require applicants to furnish, during the national stage, confirmation of the international application by the signature of any applicant who has not signed the Request and any missing identifying information. *See* PCT rule 51*bis*.1(a).

PCT rule 90.4 has been revised to permit the RO, ISA, or IPEA to waive the requirement for a power of attorney, except in instances of applicant initiated withdrawals under PCT rule 90*bis*.

### Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, part 1, is proposed to be amended as follows:

*Section 1.14:* Section 1.14(i)(1)(ii) is proposed to be amended to exclude members of the public from obtaining a copy of the written opinion of the United States International Searching