

## Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Part 1, is amended as follows:

*Section 1.14:* Sections 1.14(g)(1)(ii) and 1.14(g)(3) are amended to exclude members of the public from obtaining a copy of the written opinion of the United States International Searching Authority (ISA/US) until the expiration of thirty months from the priority date of the international application. Under PCT Rule 44*ter*.1 (as amended), the ISA is not permitted to allow access to the written opinion of the ISA before the expiration of thirty months from the priority date unless authorized by the applicant.

*Section 1.413:* Section 1.413(c) is amended to reflect the additional major function of the ISA/US of preparing and transmitting written opinions.

*Section 1.421:* Section 1.421(b) is amended to remove reference to § 1.425 (§ 1.425 is removed). Under PCT Rule 26.2*bis*(a) (as amended), the international application will be considered to satisfy the signature requirement for purposes of PCT Article 14(1)(a)(i) if the request is signed by at least one applicant (except that all of the applicants' signatures will still be required for withdrawals, *see* discussion of § 1.421(g)). Accordingly, the current requirement in § 1.425 that the failure of an inventor to sign the request in an international application designating the United States will only be excused where the inventor could not be found or reached after diligent effort or refused to sign the request will no longer be applicable. Section 1.421(b) is also amended to include the requirement of § 1.424 that joint inventors must jointly apply for an international application. Section 1.424 is removed (*see* discussion of § 1.424).

Section 1.421(c) is amended as a consequence of the change to PCT Rule 4.9, as the United States will always be designated upon filing of an international application.

Section 1.421(d) is amended to reflect the change to PCT Rule 90.4(d) permitting the RO to waive the requirement for a separate power of attorney.

Section 1.421(f) is amended to clarify that for purposes of requests under PCT Rule 92*bis* to effect a change in an indication concerning the applicant, agent or common representative, such requests may be required to be signed by all applicants.

Section 1.421(g) is amended to remove the text of PCT Rule 92*bis* as unnecessary and to clarify that for purposes of withdrawals under PCT

Rule 90*bis* of the international application, designations, priority claim, demand or elections, the request for withdrawal must be signed by all applicants. Furthermore, where the request for withdrawal is signed by an attorney, agent, or common representative, a power of attorney from the applicants appointing that attorney, agent or common representative will be required. This clarification is consistent with PCT Rule 90.4(e) (as amended), which prohibits the RO, ISA, IPEA, and IB from waiving the separate power of attorney requirement in cases of withdrawals under Rule 90*bis*. An exception to this signature requirement is made in cases where an inventor cannot be found or reached after diligent effort. *See* PCT Rule 90*bis*.5(b).

*Section 1.424:* This section is removed. The requirement in § 1.424 regarding the naming of joint inventors in international applications will be moved to § 1.421(b). The further requirement relating to signature requirements of joint inventors, including reference to § 1.425, will no longer be applicable (*see* discussion of § 1.421(b)).

*Section 1.425:* This section is removed (*see* discussion of § 1.421(b)).

*Section 1.431:* Section 1.431(b)(3) is amended to remove reference to § 1.424 (§ 1.424 is removed). Sections 1.431(c) and (d) are amended to reflect the new fee structure applicable to international applications under revised PCT Rule 15. Specifically, the international "basic fee" and "designation fee" have been combined into a single "international filing fee." In addition, the late payment fee provision of § 1.431(c)(1) is amended as a consequence of this new fee structure, consistent with amended PCT Rule 16*bis*.2.

*Section 1.432:* Section 1.432 is amended to reflect the change to PCT Rule 4.9, which provides that the filing of the request shall constitute: (1) The designation of all Contracting States that are bound by the PCT on the international filing date; (2) an indication that for those States for which PCT Articles 43 or 44 apply, the filing of the request constitutes an indication for the grant of every kind of protection which is available by way of the designation of that State; and (3) an indication that the international application is, for those States to which PCT Article 45(1) applies, for the grant of a regional patent and also, unless PCT Article 45(2) applies, a national patent. As a consequence of the "automatic" designation system provided under revised PCT Rule 4.9, the procedure under former PCT Rule 4.9(b) and (c) regarding confirmation of precautionary

designations has been eliminated from that rule, and therefore, is removed from § 1.432.

*Section 1.434:* Section 1.434(d) is amended to remove the requirement that international applications designating the United States must include the address and the signature of the inventor except as provided by §§ 1.421(d), 1.422, 1.423 and 1.425. Under PCT Rule 26.2*bis* (as amended), if there is more than one applicant, it is sufficient that the request is signed by only one of them, and that the address is provided with respect to one of the applicants who is entitled, in accordance with Rule 19.1, to file the international application with the RO. Section 1.434(d)(3) is also redesignated as new § 1.434(e) for clarity.

*Section 1.445:* Section 1.445(a)(1) is amended to increase the transmittal fee from \$240.00 to \$300.00. 35 U.S.C. 376(b) authorizes the Office to (*inter alia*) prescribe the transmittal fee, search fee, supplemental search fee, and preliminary examination fee for PCT international applications. This transmittal fee amount more accurately reflects the Office's actual average costs of processing international applications, and is also consistent with the filing fee for applications under 35 U.S.C. 111(a) proposed by the Office in the 21st Century Strategic Plan (information concerning the Office's 21st Century Strategic Plan is available on the Office's Internet Web site <http://www.uspto.gov>).

Section 1.445(a)(2)(i) is amended to reduce the search fee charged by the ISA/US where there is a corresponding prior U.S. application filed under 35 U.S.C. 111(a) from \$450 to \$300. Section 1.445(a)(2)(i) is also amended to clarify the conditions for obtaining benefit of the reduced search fee where there is such a prior corresponding application.

Pursuant to PCT Rule 42.1, the ISA/US has, in most cases, only three months to establish the International Search Report. In order for the ISA/US to be able to utilize the benefits of a search conducted in a prior corresponding application filed under 35 U.S.C. 111(a), the Office must be informed of the prior corresponding application in sufficient time and in such manner so as to permit the Office to utilize the search and examination conducted in the prior application. Accordingly, § 1.445(a)(2)(i) is amended to require applicants to timely furnish adequate identifying information of the prior U.S. application in order to qualify for the lower search fee. Specifically, applicant must identify the prior nonprovisional application by U.S. application number upon filing the