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PRINCIPALES LOIS ET REGLEMENTATIONS CONSACREES A LA PROPRIETE INTELLECTUELLE NOTIFIEES AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD

Nouvelle-Zélande

Brevets (y compris la protection des variétés végétales)

Le présent document contient le texte des lois et réglementations ci-après¹, notifiées par la Nouvelle-Zélande au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/NZL/1):

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¹Anglais seulement.

REPRINTED ACT

[WITH AMENDMENTS INCORPORATED]

PATENTS

REPRINTED AS ON 1 AUGUST 1982

NOTES: 1. Except where otherwise indicated, all references to money in decimal currency in square brackets were substituted for references to money in the former currency by s. 7 of the Decimal Currency Act 1964.

2. Except where otherwise indicated, all references to the High Court in square brackets were substituted for references to the Supreme Court by s. 12 of the Judicature Amendment Act 1979.

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THE PATENTS ACT 1953

1953, No. 64

An Act to consolidate and amend certain enactments relating to patents
[26 November 1953]

1. Short Title and commencement—(1) This Act may be cited as the Patents Act 1953.

(2) This Act shall come into force on a day to be appointed for the commencement thereof by the Governor-General by Proclamation.

This Act came into force on 1 January 1955; see the Patents Act Commencement Order 1954 (S.R. 1954/220).

2. Interpretation—(1) In this Act, unless the context otherwise requires,—

“Applicant” includes a person in whose favour a direction has been given under section 24 of this Act and the personal representative of a deceased applicant:

“Article” includes any substance or material, and any plant, machinery, or apparatus, whether affixed to land or not:

“Assignee” includes the personal representative of a deceased assignee; and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person:

“Commissioner” means the Commissioner of Patents:

- “Commonwealth” means the British Commonwealth of Nations; and includes every territory for whose international relations the Government of any country of the Commonwealth is responsible:
- “Convention application” has the meaning assigned to it by subsection (4) of section 7 of this Act:
- “Convention country” means a country in respect of which there is for the time being in force an Order in Council made under section 77 of this Act declaring it to be a convention country:
- “Court” means the [High Court]:
- “Date of filing”, in relation to any document filed under this Act, means the date on which the document is filed or, where it is deemed by virtue of any provision of this Act or of regulations made thereunder to have been filed on any different date, means the date on which it is deemed to be filed:
- “Exclusive licence” means a licence from a patentee which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention; and “exclusive licensee” shall be construed accordingly:
- “Government Department” means any Department or instrument of the Executive Government of New Zealand:
- “Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies and any new method or process of testing applicable to the improvement or control of manufacture; and includes an alleged invention:
- “Journal” means the *Patent Office Journal* published under subsection (1) of section 112 of this Act:
- “Minister” means the Minister of Justice:
- “Patent” means letters patent for an invention:
- “Patent of addition” means a patent granted in accordance with section 34 of this Act:
- “Patent Attorney” means a person carrying on for gain in New Zealand the business of acting as agent for other persons for the purpose of applying for or obtaining patents in New Zealand or elsewhere:
- “Patentee”, in relation to any patent, means the person or persons for the time being entered on the register of patents as grantee or proprietor of the patent:

“Prescribed” means prescribed by this Act or by regulations made under this Act:

“Priority date” has the meaning assigned to it by section 11 of this Act:

“Published”, except in relation to a complete specification, means made available to the public; and without prejudice to the generality of the foregoing provision a document shall be deemed for the purposes of this Act to be published—

(a) If it can be inspected as of right at any place in New Zealand by members of the public whether upon payment of a fee or otherwise; or

(b) If it can be inspected in a library of a Government Department or of any institution or public authority and the library is one which is open generally to members of the public who are interested in matters to which the document relates and is a library in which members of the public in search of information related to the subject of the document would ordinarily seek and do in fact seek the information:

“The Statute of Monopolies” means the Act of the 21st year of the reign of King James the First, chapter 3, intituled “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”.

(2) For the purposes of subsection (3) of section 7 of this Act, so far as it relates to a convention application, and for the purposes of section 81 of this Act, the expression “personal representative”, in relation to a deceased person, includes the legal representative of the deceased appointed in any country outside New Zealand.

Cf. Patents Act 1949, s. 101 (U.K.); 1921–22, No. 18, s. 2

3. Commissioner of Patents—(1) There may from time to time be appointed under the [State Services Act 1962] some fit person to be the Commissioner of Patents.

(2) The person who at the commencement of this Act holds the office of Commissioner of Patents, Designs, and Trade Marks under the Patents, Designs, and Trade Marks Act 1921–22 shall be deemed to have been appointed as Commissioner of Patents under this Act.

Cf. 1921–22, No. 18, s. 113

In subs. (1) the State Services Act 1962, being the corresponding enactment in force at the date of this reprint, has been substituted for the repealed Public Service Act 1912.

4. Assistant Commissioners of Patents and other officers—(1) There may from time to time be appointed under the [State Services Act 1962]—

(a) One or more fit persons to be Assistant Commissioners of Patents:

(b) Such other officers and employees as may be necessary for carrying out the provisions of this Act.

(2) Every Assistant Commissioner of Patents so appointed, while he remains in office, shall have and may exercise, subject to the control and direction of the Commissioner, all the powers, duties, and functions of the Commissioner, and all references in this or any other Act to the Commissioner shall, so far as may be necessary for the purpose of giving effect to the provisions of this section, be deemed to include a reference to every Assistant Commissioner of Patents.

(3) The person who at the commencement of this Act holds the office of Deputy Commissioner of Patents, Designs, and Trade Marks under the Patents, Designs, and Trade Marks Act 1921–22 shall be deemed to have been appointed an Assistant Commissioner of Patents under this Act.

Cf. 1921–22, No. 18, ss. 114, 115.

In subs. (1) the State Services Act 1962, being the corresponding enactment in force at the date of this reprint, has been substituted for the repealed Public Service Act 1912.

5. Patent Office—(1) The Minister may from time to time, by notice in the *Journal*, appoint a place to be the Patent Office. The place at the commencement of this Act used as the Patent Office shall be deemed to have been appointed to be the Patent Office under this Act.

[(2) The Commissioner, from time to time by notice in the *Journal*, may fix the hours during which the Patent Office shall be open for the transaction of public business under this Act, and may declare the Patent Office closed for the transaction of public business on any day.]

(3) Where the time prescribed for doing any act or taking any proceeding expires on a day on which the Patent Office is not open and by reason thereof the act or proceeding cannot be done or taken on that day, the act or proceeding shall be deemed to be in time if done or taken on the next day on which the Patent Office is open.

(4) There shall be a seal of the Patent Office and impressions thereof shall be judicially noticed.

Cf. Patents Act 1949, s. 98 (U.K.); 1921–22, No. 18, ss. 113, 116, 133

Subs. (2) was substituted for the original subs. (2) by s. 2 (1) of the Patents Amendment Act 1976.

[5A. Closing of Patent Office at short notice—

(1) Notwithstanding subsection (2) of section 5 of this Act, where, because of an emergency or other temporary circumstances, the Commissioner is satisfied that it is or will be necessary or desirable to close the Patent Office on any day and it is not practicable to give notice of the closure in the *Journal* as required by that subsection, the Commissioner may, without giving that notice, declare the Patent Office closed for the transaction of public business on that day in accordance with the provisions of this section.

(2) In every case where the Commissioner proposes to declare or has declared the Patent Office closed under subsection (1) of this section he shall, if practicable, display a public notice of that fact in or on the building in which the Patent Office is situated.

(3) As soon as practicable thereafter the Commissioner shall also cause a copy of the public notice, or (if no such notice was displayed) a notice of the exercise of his powers under this section, to be published in the *Journal*.]

This section was inserted by s. 2 (2) of the Patents Amendment Act 1976.

6. Officers and employees of Patent Office not to acquire interest in any patent or prepare specifications—

(1) Every officer and employee of the Patent Office shall be incapable, during the period for which he holds his appointment and for one year thereafter, of applying in New Zealand for a patent or of acquiring directly or indirectly, except under a will or on an intestacy, any right or interest in any patent granted or to be granted in New Zealand.

(2) Every officer and employee of the Patent Office commits an offence, and shall be liable on summary conviction to a fine not exceeding [\$100], if, during the period for which he holds his appointment and for one year thereafter, he applies in any country other than New Zealand for a patent or acquires directly or indirectly, except under a will or on an intestacy, any right or interest in any patent granted or to be granted in any country other than New Zealand.

(3) Every officer and employee of the Patent Office commits an offence, and shall be liable on summary conviction to a fine not exceeding [\$40], if, outside the scope of his official duties, he drafts or prepares a specification or drawing or any part of a specification or drawing or makes a search of the records of the Patent Office for the use or information of any applicant or intending applicant for a patent under this Act.

(4) Nothing in subsections (1) and (2) of this section shall prevent any former officer or employee of the Patent Office who is practising as a solicitor or patent attorney from lawfully carrying out, within the period of one year specified in those subsections, any function that is merely incidental to that practice.

Cf. 1947, No. 37, s. 4

Application, Investigation, Opposition, etc.

7. Persons entitled to make application—(1) An application for a patent for an invention may be made by any of the following persons, that is to say:

(a) By any person claiming to be the true and first inventor of the invention:

(b) By any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application,—

and may be made by that person either alone or jointly with any other person.

(2) Without prejudice to the foregoing provisions of this section, an application for a patent for an invention in respect of which protection has been applied for in a convention country may be made by the person by whom the application for protection was made or by the assignee of that person; and for the purposes of this Act the filing in any convention country of a complete specification after the filing of a provisional specification or provisional specifications in respect of any such application shall be deemed to be an application for protection in that country:

Provided that no application shall be made by virtue of this subsection after the expiration of 12 months from the date of the application for protection in a convention country or, where more than one such application for protection has been made, from the date of the first application.

(3) An application for a patent may be made under subsection (1) or subsection (2) of this section by the personal representative or the assignee of the personal representative of any deceased person who, immediately before his death was entitled to make such an application.

(4) An application for a patent made by virtue of subsection (2) of this section is in this Act referred to as a convention application.

Cf. Patents Act 1949, s. 1 (U.K.); 1921–22, No. 18, ss. 3, 48

As to the meaning of the term “personal representative” in subs. (3), see s. 2 (2).

8. Application—(1) Every application for a patent shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner.

(2) Every application (other than a convention application) shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor; and where the person so claiming is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes him to be the true and first inventor.

(3) Every convention application shall specify the date on which and the convention country in which the application for protection, or the first such application, was made, and shall state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or any person from whom he derives title.

(4) Where applications for protection have been made in one or more convention countries in respect of 2 or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to the provisions of section 10 of this Act, be made in respect of those inventions at any time within 12 months from the date of the earliest of the said applications for protection:

Provided that the fee payable on the making of any such application shall be the same as if separate applications had been made in respect of each of the said inventions; and the requirements of subsection (3) of this section shall in the case of any such application apply separately to the applications for protection in respect of each of the said inventions.

Cf. Patents Act 1949, s. 2 (U.K.); 1921–22, No. 18, s. 3

9. Complete and provisional specifications—(1) Every application for a patent (other than a convention application) shall be accompanied by either a complete specification or a provisional specification; and every convention application shall be accompanied by a complete specification.

(2) Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within 12 months from the date of filing of the application, and if the complete specification is not so filed the application shall be deemed to be abandoned:

Provided that the complete specification may be filed at any time after 12 months but within 15 months from the date aforesaid if a request to that effect is made to the

Commissioner and the prescribed fee paid on or before the date on which the specification is filed.

(3) Where 2 or more applications accompanied by provisional specifications have been filed in respect of inventions which are cognate or of which one is a modification of another, a single complete specification may, subject to the provisions of this section and of section 10 of this Act, be filed in pursuance of those applications, or, if more than one complete specification has been filed, may with the leave of the Commissioner be proceeded with in respect of those applications.

(4) Where an application for a patent (not being a convention application) is accompanied by a specification purporting to be a complete specification, the Commissioner may, if the applicant so requests at any time before the acceptance of the specification, direct that it shall be treated for the purposes of this Act as a provisional specification, and proceed with the application accordingly.

(5) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under subsection (4) of this section as a provisional specification, the Commissioner may, if the applicant so requests at any time before the acceptance of the complete specification, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

Cf. Patents Act 1949, s. 3 (U.K.); 1921–22, No. 18, ss. 4, 7, 18; 1939, No. 26, s. 73

10. Contents of specification—(1) Every specification, whether complete or provisional, shall describe the invention, and shall begin with a title indicating the subject to which the invention relates.

(2) Subject to any regulations made under this Act, drawings may, and shall if the Commissioner so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Commissioner otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) Every complete specification—

(a) Shall particularly describe the invention and the method by which it is to be performed; and

- (b) Shall disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and
- (c) Shall end with a claim or claims defining the scope of the invention claimed.

(4) The claim or claims of a complete specification must relate to a single invention, must be clear and succinct, and must be fairly based on the matter disclosed in the specification.

(5) Regulations made under this Act may require that in such cases as may be prescribed by the regulations a declaration as to the inventorship of the invention, in such form as may be so prescribed, shall be furnished with the complete specification or within such period as may be so prescribed after the filing of that specification.

(6) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification, or filed with a convention application, may include claims in respect of developments of or additions to the invention which was described in the provisional specification or, as the case may be, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 7 of this Act to make a separate application for a patent.

(7) Where a complete specification claims a new substance, the claim shall be construed as not extending to that substance when found in nature.

Cf. Patents Act 1949, s. 4 (U.K.); 1921–22, No. 18, ss. 3, 4

11. Priority date of claims of complete specification—

(1) Every claim of a complete specification shall have effect from the date prescribed by this section in relation to that claim (in this Act referred to as the priority date); and a patent shall not be invalidated by reason only of the publication or use of the invention, so far as claimed in any claim of the complete specification, on or after the priority date of that claim, or by the grant of another patent upon a specification claiming the same invention in a claim of the same or later priority date.

(2) Where the complete specification is filed in pursuance of a single application accompanied by a provisional specification or by a specification which is treated by virtue of a direction under subsection (4) of section 9 of this Act as a

provisional specification, and the claim is fairly based on the matter disclosed in that specification, the priority date of that claim shall be the date of filing of the application.

(3) Where the complete specification is filed or proceeded with in pursuance of 2 or more applications accompanied by such specifications as are mentioned in subsection (2) of this section, and the claim is fairly based on the matter disclosed in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that specification.

(4) Where the complete specification is filed in pursuance of a convention application and the claim is fairly based on the matter disclosed in the application for protection in a convention country or, where the convention application is founded upon more than one such application for protection, in one of those applications, the priority date of that claim shall be the date of the relevant application for protection.

(5) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for this provision, have 2 or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.

(6) In any case to which subsections (2) to (5) of this section do not apply, the priority date of a claim shall be the date of filing of the complete specification.

Cf. Patents Act 1949, s. 5 (U.K.); 1921–22, No. 18, s. 8

12. Examination of application—(1) When the complete specification has been filed in respect of an application for a patent, the application and specification or specifications shall be referred by the Commissioner to an examiner.

(2) If the examiner reports that the application or any specification filed in pursuance thereof does not comply with the requirements of this Act or of any regulations made thereunder, or that there is lawful ground of objection to the grant of a patent in pursuance of the application, the Commissioner may either—

- (a) Refuse to proceed with the application; or
- (b) Require the application or any such specification as aforesaid to be amended before he proceeds with the application.

(3) At any time after an application has been filed under this Act and before acceptance of the complete specification, the Commissioner may, at the request of the applicant and upon payment of the prescribed fee, direct that the

application shall be post-dated to such date as may be specified in the request:

Provided that—

- (a) No application shall be post-dated under this subsection to a date later than 6 months from the date on which it was actually made or would, but for this subsection, be deemed to have been made; and
 - (b) A convention application shall not be post-dated under this subsection to a date later than the last date on which, under the foregoing provisions of this Act, the application could have been made.
- (4) Where an application or specification filed under this Act is amended before acceptance of the complete specification, the Commissioner may direct that the application or specification shall be post-dated to the date on which the amendment is first filed.
- (5) Regulations made under this Act may make provision for securing that where, at any time after an application or specification has been filed under this Act and before acceptance of the complete specification a fresh application or specification is filed in respect of any part of the subject-matter of the first-mentioned application or specification, the Commissioner may on request direct that the fresh application or specification shall be antedated to a date not earlier than the date of filing of the first-mentioned application or specification.
- (6) An appeal to the Court shall lie from any decision of the Commissioner under subsection (2) or subsection (4) of this section.

Cf. Patents Act 1949, s. 6 (U.K.); 1921–22, No. 18, s. 5

13. Search for anticipation by previous publication—

(1) Subject to the provisions of section 12 of this Act, the examiner to whom an application for a patent is referred under this Act shall make investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been published before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in New Zealand and dated within 50 years next before that date.

(2) The examiner shall, in addition, make such investigation as the Commissioner may direct for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been published in

New Zealand before the date of filing of the applicant's complete specification in any other document (not being a document of any class described in subsection (1) of section 59 of this Act).

(3) If it appears to the commissioner that the invention, so far as claimed in any claim of the complete specification, has been published as aforesaid, he may refuse to accept the specification unless the applicant either—

(a) Shows to the satisfaction of the Commissioner that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or

(b) Amends his complete specification to the satisfaction of the Commissioner.

(4) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 7 (U.K.); 1921–22, No. 18, s. 10

14. Search for anticipation by prior claim—(1) In addition to the investigation required by section 13 of this Act, the examiner shall make investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed—

(a) In pursuance of an application for a patent made in New Zealand and dated before that date; or

(b) In pursuance of a convention application founded upon an application for protection made in a convention country before that date.

(2) If it appears to the Commissioner that the said invention is claimed in a claim of any such other specification as aforesaid, he may, subject to the provisions of this section, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed either—

(a) The applicant shows to the satisfaction of the Commissioner that the priority date of his claim is not later than the priority date of the claim of the said other specification; or

(b) The complete specification is amended to the satisfaction of the Commissioner.

(3) If in consequence of the investigation under section 13 of this Act or otherwise it appears to the Commissioner—

(a) That the invention, so far as claimed in any claim of the applicant's complete specification, has been claimed in any such specification as is mentioned in subsection (1) of that section; and

(b) That the other specification was published on or after the priority date of the applicant's claim,—

then, unless it has been shown to the satisfaction of the Commissioner under that section that the priority date of the applicant's claim is not later than the priority date of claim of that other specification, the provisions of subsection (2) of this section shall apply as they apply in relation to a specification published on or after the date of filing of the applicant's complete specification.

(4) The powers of the Commissioner under this section to direct the insertion of a reference to another specification may be exercised either before or after a patent has been granted for the invention claimed in that other specification, but any directions given before the grant of such a patent shall be of no effect unless and until such a patent is granted.

(5) An Appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949 s. 8 (U.K.); 1921–22, No. 18, s. 10

15. Commissioner may require information as to corresponding applications overseas—For the purposes of the investigation required under this Act an applicant, if so required by the Commissioner shall,—

(a) State whether a corresponding or substantially corresponding application has been filed in any of the following countries, namely,—

(i) The United Kingdom, Canada, Australia, or the United States of America; or

(ii) Any other country for the time being declared by Order in Council to be a country to which this paragraph applies:

(b) With respect to any such application in any such country, furnish (so far as it is reasonably available to the applicant) the following information:

(i) The number and filing date of the application; and

(ii) Particulars sufficient to identify the prior art cited against the application; and

(iii) The number allotted to the patent when granted on the application and the form of the claims allowed; and

(iv) Particulars of any other application or patent with which the corresponding application is or has been involved in opposition, conflict, interference, or similar proceedings.

16. Reference in case of potential infringement—

(1) If, in consequence of the investigations required by the foregoing provisions of this Act or of proceedings under section 21 or section 42 of this Act, it appears to the Commissioner that an invention in respect of which application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public unless within such time as may be prescribed either—

(a) The applicant shows to the satisfaction of the Commissioner that there are reasonable grounds for contesting the validity of the said claim of the other patent; or

(b) The complete specification is amended to the satisfaction of the Commissioner.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under the foregoing subsection—

(a) That other patent is revoked or otherwise ceases to be in force; or

(b) The specification of that other patent is amended by the deletion of the relevant claim; or

(c) It is found, in proceedings before the court or the Commissioner, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention,—

the Commissioner may, on the application of the applicant, delete the reference to that other patent.

(3) An appeal to the Court shall lie from any decision or direction of the Commissioner under this section.

Cf. Patents Act 1949, s. 9 (U.K.)

17. Refusal of application in certain cases—(1) If it appears to the Commissioner in the case of any application for a patent—

- (a) That it is frivolous on the ground that it claims as an invention anything obviously contrary to well established natural laws; or
- (b) That the use of the invention in respect of which the application is made would be contrary to law or morality; or
- (c) That it claims as an invention a substance capable of being used as food or medicine which is a mixture of known ingredients possessing only the aggregate of the known properties of the ingredients, or that it claims as an invention a process producing such a substance by mere admixture,—

he may refuse the application.

(2) If it appears to the Commissioner that any invention in respect of which an application for a patent is made might be used in any manner contrary to law, he may refuse the application unless the specification is amended by the insertion of such a disclaimer in respect of that use of the invention, or such other reference to the illegality thereof, as the Commissioner thinks fit.

(3) An appeal to the court shall lie from any decision of the Commissioner under this section.

Cf. *Patents Act 1949*, s. 10 (U.K.); 1939, No. 26, s. 71

18. Supplementary provisions as to examination, etc.—(1) The powers of the Commissioner under section 14 or section 16 of this Act may be exercised either before or after the complete specification has been accepted or a patent granted to the applicant and references in those sections to the applicant shall accordingly be construed as including references to the patentee.

(2) Where a complete specification is amended under the foregoing provisions of this Act before it has been accepted, the amended specification shall be examined and investigated in like manner as the original specification.

(3) The examination and investigations required by the foregoing provisions of this Act shall not be deemed to warrant the validity of any patent, and no liability shall be incurred by the Patent Office or any officer thereof by reason of or in connection with any such examination or investigation or any report or other proceedings consequent thereon.

Cf. *Patents Act 1949*, s. 11 (U.K.); 1921–22, No. 18, s. 10

19. Time for putting application in order for acceptance—(1) An application for a patent shall be void unless within 15 months from the date of filing of the complete specification, or within such longer period as may be allowed under the following provisions of this section, the applicant has complied with all requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application.

(2) The period allowed by subsection (1) of this section shall be extended to such period, not exceeding 18 months from the date of filing of the complete specification, as may be specified in a notice given by the applicant to the Commissioner, if the notice is given and the prescribed fee paid before the expiration of the period so specified.

(3) If at the expiration of the period allowed under the foregoing provisions of this section an appeal to the Court is pending under any of the provisions of this Act in respect of the application (or, in the case of an application for a patent of addition, either in respect of that application or in respect of the application for the patent for the main invention) or the time within which such an appeal could be brought in accordance with the rules of Court (apart from any future extension of time thereunder) has not expired, then—

(a) Where such an appeal is pending or is brought within the time aforesaid or before the expiration of any extension of that time granted (in the case of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, the said period shall be extended until such date as the Court may determine:

(b) Where no such appeal is pending or is so brought, the said period shall continue until the end of the time aforesaid, or, if any extension of that time is granted as aforesaid, until the expiration of the extension or last extension so granted.

Cf. Patents Act 1949, s. 12 (U.K.); No. 26, s. 72

As to the extension of the period specified in subs. (1), see also s. 93.

20. Acceptance and publication of complete specification—(1) Subject to the provisions of section 19 of this Act, the complete specification filed in pursuance of an application for a patent may be accepted by the Commissioner at any time after the applicant has complied with the requirements

mentioned in subsection (1) of that section, and if not so accepted within the period allowed under that section for compliance with those requirements, shall be accepted as soon as may be thereafter:

Provided that the applicant may give notice to the Commissioner requesting him to postpone acceptance until such date, not being later than 18 months from the date of filing of the complete specification, as may be specified in the notice; and if such notice is given and, where the notice requests a postponement to a date later than 15 months from the date aforesaid, the prescribed fee is paid, the Commissioner may postpone acceptance accordingly.

(2) On the acceptance of a complete specification the Commissioner shall give notice to the applicant, and shall advertise in the *Journal* the fact that the specification has been accepted, and thereupon the application and the specification or specifications filed in pursuance thereof shall be open to public inspection.

(3) Any reference in this Act to the date of the publication of a complete specification shall be construed as a reference to the date of issue of the *Journal* containing the advertisement as aforesaid.

(4) After the date of the publication of a complete specification and until the sealing of a patent in respect thereof, the applicant shall have the like privileges and rights as if a patent for the invention has been sealed on the date of the publication of the complete specification:

Provided that an applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed.

Cf. Patents Act 1949, s. 13 (U.K.); 1921–22, No. 18, ss. 11, 12; 1946, No. 32, s. 5

21. Opposition to grant of patent—(1) At any time within the period prescribed by subsection (2) of this section any person interested may give notice to the Commissioner of opposition to the grant of the patent on any of the following grounds:

(a) That the applicant for the patent, or the person described in the application as the true and first inventor, obtained the invention or any part thereof from him, or from a person of whom he is the personal representative:

- (b) That the invention, so far as claimed in any claim of the complete specification, has been published in New Zealand before the priority **date** of the claim—
- (i) In any specification filed in pursuance of an application for a patent made in New Zealand and dated within 50 years next before the date of filing of the applicant's complete specification:
- (ii) In any other document (not being a document of any class described in subsection (1) of section 59 of this Act):
- (c) That the invention, so far as claimed in any claim of the complete specification is claimed in any claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in New Zealand, being a claim of which the priority date is earlier than that of the applicant's claim:
- (d) That the invention, so far as claimed in any claim of the complete specification, was used in New Zealand before the priority date of that claim:
- (e) That the invention, so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step having regard to matter published as mentioned in paragraph (b) of this subsection, or having regard to what was used in New Zealand before the priority date of the applicant's claim:
- (f) That the subject of any claim of the complete specification is not an invention within the meaning of this Act:
- (g) That the complete specification does not sufficiently and fairly describe the invention or the method by which it is to be performed:
- (h) That, in the case of a convention application, the application was not made within 12 months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title:
- (i) That, in the case of an application to which an order under section 37 of this Act applies, the failure of the applicant to comply with the requirements imposed on him by or under this Act within the period prescribed by section 19 of this Act and every extension of that period granted under that section or under section 93 of this Act was not unintentional:

(j) That in the case of an application to which an order under section 37 of this Act applies, there was undue delay in applying for the order:

[(k) That, in the case of an application under section 93A of this Act, an extension of time granted by the Commissioner was unwarranted,—]

but on no other ground.

(2) Every such notice shall be given within 3 months from the date of the publication of the complete specification under this Act:

Provided that on application made to him in that behalf within the said 3 months the Commissioner may extend the prescribed period to 4 months.

(3) Where any such notice is given, the Commissioner shall give notice of the opposition to the applicant, and shall give to the applicant and the opponent an opportunity to be heard before he decides on the case.

(4) The grant of a patent shall not be refused on the ground specified in paragraph (c) of subsection (1) of this section if no patent has been granted in pursuance of the application mentioned in that paragraph; and for the purposes of paragraph (d) or paragraph (e) of the said subsection (1) no account shall be taken of any secret use.

(5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 14 (U.K.); 1939, No. 26, s. 57

In subs. (1), para. (k) was inserted by s. 3 of the Patents Amendment Act 1972.

22. Refusal of patent without opposition—(1) If at any time after the acceptance of the complete specification filed in pursuance of an application for a patent and before the grant of a patent thereon it comes to the notice of the Commissioner, otherwise than in consequence of proceedings in opposition to the grant under section 21 of this Act, that the invention, so far as claimed in any claim of the complete specification, has been published in New Zealand before the priority date of the claim—

(a) In any specification filed in pursuance of an application for a patent made in New Zealand and dated within 50 years next before the date of filing of the applicant's complete specification; or

(b) In any other document (not being a document of any class described in subsection (1) of section 59 of this Act),—

the Commissioner may refuse to grant the patent unless

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within such time as may be prescribed the complete specification is amended to his satisfaction.

(2) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 15 (U.K.)

23. Mention of inventor as such in patent—(1) If the Commissioner is satisfied, upon a request or claim made in accordance with the provisions of this section,—

(a) That the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and

(b) That the application for the patent is a direct consequence of his being the inventor,—

the Commissioner shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application, in the complete specification, and in the register of patents:

Provided that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.

(2) For the purposes of this section the actual deviser of an invention or a part of an invention shall be deemed to be the inventor, notwithstanding that any other person is for any of the other purposes of this Act treated as the true and first inventor; and no person shall be deemed to be the inventor of an invention or a part of an invention by reason only that it was imported by him into New Zealand.

(3) A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.

(4) If any person (other than a person in respect of whom a request in relation to the application in question has been made under subsection (3) of this section) desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.

(5) A request or claim under the foregoing provisions of this section must be made not later than 2 months after the date of the publication of the complete specification, or within such further period (not exceeding one month) as the Commissioner may, on an application made to him in that

behalf before the expiration of the said period of 2 months and subject to payment of the prescribed fee, allow.

(6) No request or claim under the foregoing provisions of this section shall be entertained if it appears to the Commissioner that the request or claim is based upon facts which, if proved in the case of an opposition under the provisions of paragraph (a) of subsection (1) of section 21 of this Act by the person in respect of or by whom the request or claim is made, would have entitled him to relief under that section.

(7) Subject to the provisions of subsection (6) of this section, where a claim is made under subsection (4) of this section, the Commissioner shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Commissioner may consider to be interested; and before deciding upon any request or claim made under subsection (3) or subsection (4) of this section, the Commissioner shall, if required, hear the person in respect of or by whom the request or claim is made, and, in the case of a claim under the said subsection (4) any person to whom notice of the claim has been given as aforesaid.

(8) Where any person has been mentioned as inventor in pursuance of this section, any other person who alleges that he ought not have been so mentioned may at any time apply to the Commissioner for a certificate to that effect, and the Commissioner may, after hearing (if required) any person whom he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.

(9) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 16 (U.K.); 1939, No. 26, s. 58

24. Substitution of applicants, etc.—(1) If the Commissioner is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement made by the applicant or one of the applicants for the patent, or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Commissioner may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimant and the applicant or the other joint applicant or applicants, according as the case may require.

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of 2 or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless either—

(a) The invention is identified therein by reference to the number of the application for the patent; or

(b) There is produced to the Commissioner an acknowledgment by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or

(c) The rights of the claimant in respect of the invention have been finally established by a decision of any Court or by a determination of the Commissioner under the following provisions of this Act.

(4) Where one of 2 or more joint applicants for a patent dies at any time before the patent has been granted, the Commissioner may, upon a request in that behalf made by the survivor or survivors, and with the consent of the personal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.

(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Commissioner may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, according as the case may require. In any such case the Commissioner may authorise the application to proceed in the name of one or more of the parties.

(6) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 17 (U.K.)

25. Provisions for secrecy of certain inventions—

(1) Where, either before or after the commencement of this Act, an application for a patent has been made in respect of an invention, and it appears to the Commissioner that the invention is one of a class notified to him by the Minister of

Defence as relevant for defence purposes, or is in the opinion of the Commissioner likely to be valuable for defence purposes, he may give directions for prohibiting or restricting the publication of information with respect to the invention, or the communication of such information to any person or class of persons specified in the directions; and while such directions are in force the application may, subject to the directions, proceed up to the acceptance of the complete specification, but the acceptance shall not be advertised nor the specification published, and no patent shall be granted in pursuance of the application.

(2) Where the Commissioner gives any such directions as aforesaid, he shall give notice of the application and of the directions to the Minister of Defence, and thereupon the following provisions shall have effect, that is to say:

- (a) The Minister of Defence shall, upon receipt of the notice, consider whether the publication of the invention would be prejudicial to the defence of New Zealand, and unless a notice under paragraph (c) of this subsection has previously been given by the Minister of Defence to the Commissioner, shall reconsider that question before the expiration of 9 months from the date of filing of the application for the patent and at least once in every subsequent year:
- (b) For the purpose aforesaid, the Minister of Defence may, at any time after the complete specification has been accepted or, with the consent of the applicant, at any time before the complete specification has been accepted, inspect the application and any documents furnished to the Commissioner in connection therewith:
- (c) If upon consideration of the invention at any time it appears to the Minister of Defence that the publication of the invention would not, or would no longer, be prejudicial to the defence of New Zealand, the Minister of Defence shall give notice to the Commissioner to that effect:
- (d) On receipt of any such notice the Commissioner shall revoke the directions and may, subject to such conditions, if any, as he thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired.

(3) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under this section or under section 26 of this Act is accepted during the continuance in force of the directions, then—

- (a) If any use of the invention is made during the continuance in force of the directions by or on behalf of or to the order of a Government Department, the provisions of sections 55 to 58 of this Act shall apply in relation to that use as if the patent had been granted for the invention; and
- (b) If it appears to the Minister of Defence that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Minister of Finance may make to him such payment (if any) by way of compensation as appears to him to be reasonable, having regard to the novelty and utility of the invention and the purpose for which it is designed, and to any other relevant circumstances.

(4) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section or under section 26 of this Act, no renewal fees shall be payable in respect of any period during which those directions were in force.

(5) No person resident in New Zealand shall, except under the authority of a written permit granted by or on behalf of the Commissioner, make or cause to be made any application outside New Zealand for the grant of a patent for an invention unless—

- (a) An application for a patent for the same invention or substantially the same invention has been made in New Zealand not less than 6 weeks before the application outside New Zealand; and
- (b) Either no directions have been given under subsection (1) of this section or under section 26 of this Act in relation to the application in New Zealand, or all such directions have been revoked:

Provided that this subsection shall not apply in relation to an invention for which an application for protection has first been filed in a country outside New Zealand by a person resident outside New Zealand.

(6) If any person fails to comply with any direction given under this section or makes or causes to be made an application for the grant of a patent in contravention of this

section, he shall be guilty of an offence and shall be liable on conviction on indictment to imprisonment for a term not exceeding 2 years or to a fine not exceeding [\$1,000], or to both such imprisonment and such fine.

Cf. Patents Act 1949, s. 18 (U.K.); 1921–22, No. 18, s. 33

As to the summary jurisdiction of a District Court Judge under this section, see s. 6 of the Summary Proceedings Act 1957.

26. Inventions relating to atomic energy—(1) Where an application has been made to the Commissioner for the grant of a patent, and it appears to the Commissioner that the invention which is the subject-matter of the application relates to the production or use of energy derived from the atomic nucleus or research into matters connected therewith he shall serve a notice in writing on the Minister of Defence to that effect, and may, notwithstanding anything in this Act or any other Act, omit or delay the doing of anything which he would otherwise be required to do in relation to the application, and give directions for prohibiting or restricting the publication of information with respect to the subject-matter of the application or the communication of that information to particular persons or classes of persons; and any person who contravenes any such direction commits an offence against this section.

(2) Where the Minister of Defence is notified as aforesaid, he shall forthwith consider whether the invention which is the subject-matter of the application in question is of importance for purposes of defence, and may inspect all documents and information furnished to the Commissioner in connection with the application, and if he is satisfied either then or subsequently that the invention is not of importance for purposes of defence he shall serve a notice in writing on the Commissioner to that effect, and thereupon the Commissioner shall cease to exercise his powers under subsection (1) of this section in relation to that application and shall forthwith revoke any directions given under those powers in relation thereto.

(3) Where any notice is given by or to the Commissioner under the foregoing provisions of this section in relation to any application, he shall serve a copy of the notice on the applicant.

(4) Where, on an application to the Commissioner for the grant of a patent, a notice has been served under subsection (1) of this section and 6 months have elapsed from the date of the service of that notice without the service of a notice under

subsection (2) of this section in relation to that application, any person who has, before the date of the application, incurred expense or done work in connection with the discovery or development of the invention concerned shall be entitled to be paid such compensation in respect of that expense or work as the Minister of Defence may, with the approval of the Minister of Finance, determine, and the compensation shall not in any case be less than the amount of the expense reasonably so incurred, and the amount of that expense shall, in default of agreement between the Minister of Defence and that person, be settled by arbitration:

Provided that, if a notice is subsequently served by the Minister of Defence under subsection (2) of this section in relation to the application, there shall be recoverable by the Minister of Defence as a debt due to the Crown such part of the compensation paid to any person under this subsection in connection with the invention concerned as may be reasonable, having regard to the length of the period during which powers were exercised under subsection (1) of this section in relation to the application and all the other circumstances of the case; and the amount to be so recovered shall, in default of agreement between the Minister of Defence and the said person, be settled by arbitration.

(5) Where the Commissioner in the exercise of powers under subsection (1) of this section omits or delays the doing of anything or gives directions for prohibiting or restricting the publication or communication of information, he may, subject to such conditions, if any, as he thinks fit to impose, extend the time limit by or under this Act for doing any act where he is satisfied that an extension ought to be granted by reason of the exercise of the powers aforesaid.

(6) The right of a person to apply for, or obtain, a patent in respect of an invention shall not be prejudiced by reason only of the fact that the invention has previously been communicated to the Minister of Defence under this section, and a patent in respect of an invention shall not be held to be invalid by reason only that the invention has been communicated as aforesaid.

(7) The power of a Government Department and persons authorised by a Government Department under section 55 of this Act shall include power to make, use, exercise, or vend an invention for such purposes relating to the production or use of atomic energy or research into matters connected therewith as the Minister of Defence thinks necessary or expedient, and any reference in that section or in sections 56 and 57 of this

Act to the services of the Crown shall be construed as including a reference to those purposes.

(8) Every person who commits an offence against this section shall be liable on conviction on indictment to imprisonment for a term not exceeding 2 years or to a fine not exceeding [\$1,000], or to both such imprisonment and such fine.

Cf. Patents Act 1949, s. 106 (3) (U.K.); 1947, No. 37, s. 6

As to the summary jurisdiction of a District Court Judge under this section, see s. 6 of the Summary Proceedings Act 1957.

Grant, Effect, and Term of Patent

27. Grant and sealing of patent—(1) Subject to the provisions of this Act with respect to opposition, and to any other power of the Commissioner to refuse the grant, a patent sealed with the seal of the Patent Office shall, if the prescribed request is made within the time allowed under this section, be granted to the applicant or applicants within that time or as soon as may be thereafter; and the date on which the patent is sealed shall be entered in the register of patents.

(2) Subject to the following provisions of this Act with respect to patents of addition, a request under this section for the sealing of a patent shall be made not later than the expiration of 4 months from the date of the publication of the complete specification:

Provided that—

(a) Where at the expiration of the said 4 months any proceeding in relation to the application for the patent is pending in any Court or before the Commissioner, the request may be made within the prescribed period after the final determination of that proceeding:

(b) Where the applicant or one of the applicants have died before the expiration of the time within which under the provisions of this subsection the request could otherwise be made, the said request may be made at any time within 12 months after the date of the death or at such later time as the Commissioner may allow.

(3) The period within which under subsection (2) of this section a request for the sealing of a patent may be made may from time to time be extended by the Commissioner to such longer period as may be specified in an application made to him in that behalf, if the application is made and the prescribed fee paid within that longer period:

Provided that the first-mentioned period shall not be extended under this subsection by more than 6 months or such shorter period as may be prescribed.

(4) Where in any case the longest period for making a request for the sealing of a patent allowable in that case by or under the foregoing provisions of this section has been allowed, and it is proved to the satisfaction of the Commissioner that hardship would arise in connection with the prosecution by an applicant of an application for a patent in any country outside New Zealand unless that period is extended, that period may be extended from time to time to such longer period as appears to the Commissioner to be necessary in order to prevent that hardship arising if an application in that behalf is made to him, and the prescribed fee is paid, within the first-mentioned period, or in the case of a second or subsequent application under this subsection, within the period to which that period was extended on the last preceding application thereunder.

(5) For the purposes of this section a proceeding shall be deemed to be pending so long as the time for any appeal therein (apart from any future extension of that time) has not expired, and a proceeding shall be deemed to be finally determined when the time for an appeal therein (apart from any such extension) has expired without the appeal being brought.

Cf. Patents Act 1949, s. 19 (U.K.); 1939, No. 26, s. 59

28. Amendment of patent granted to deceased applicant—Where, at any time after a patent has been sealed in pursuance of an application under this Act, the Commissioner is satisfied that the person to whom the patent was granted had died, or (in the case of a body corporate) had ceased to exist, before the patent was sealed, he may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted; and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

Cf. Patents Act 1949, s. 20 (U.K.)

29. Extent, effect, and form of patent—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the . . . Seal of New Zealand, and shall have effect throughout New Zealand:

Provided that a patent may be assigned for any place in or part of New Zealand as effectually as if it were granted so as to extend to that place or part only.

(2) Subject to the provisions of this Act and of subsection (3) of section 7 of the Crown Proceedings Act 1950, a patent shall have the same effect against the Crown as it has against a subject.

(3) A patent shall be in such form as may be prescribed.

(4) A patent shall be granted for one invention only; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

Cf. Patents Act 1949, s. 21 (U.K.); 1921–22, No. 18, s. 16

In subs. (1) the word “Public” was omitted by s. 8 of the Seal of New Zealand Act 1977.

30. Date and term of patent—(1) Every patent shall be dated with the date of filing of the complete specification:

Provided that no proceeding shall be taken in respect of an infringement committed before the date of the publication of the complete specification.

(2) The date of every patent shall be entered in the register of patents.

(3) Except as otherwise expressly provided by this Act, the term of every patent shall be 16 years from the date of the patent.

(4) A patent shall cease to have effect, notwithstanding anything therein or in this Act, on the expiration of the period prescribed for the payment of any renewal fee if that fee is not paid within the prescribed period or within that period as extended under this section:

Provided that, where the period prescribed for the payment of a renewal fee expires before the date 4 months after the date of the sealing of the patent, the period for payment of the renewal fee shall be extended to the date 4 months after the date of the sealing of the patent.

(5) The period prescribed for the payment of any renewal fee (including any extension of the period under subsection (4) of this section) shall be extended to such period, not being more than 3 months longer than the prescribed period, as may be specified in a request made to the Commissioner if the request is made and the renewal fee and the prescribed additional fee are paid before the expiration of the period so specified.

Cf. Patents Act 1949, s. 22 (U.K.); 1921–22, No. 18, ss. 15, 19; 1939, No. 26, s. 60

31. Extension on ground of inadequate remuneration—(1) If upon application made by a patentee in accordance with this section the Court or Commissioner is

satisfied that the patentee has not been adequately remunerated by the patent, the Court or Commissioner may by order extend the term of the patent, subject to such restrictions, conditions, and provisions, if any, as may be specified in the order, for such period (not exceeding 5 years or, in an exceptional case, 10 years) as may be so specified; and any such order may be made notwithstanding that the term of the patent has previously expired.

(2) An application for an order under this section may be made at the option of the applicant to the Court or to the Commissioner; but if the Commissioner considers that an application made to him raises issues of a kind which would be more fittingly decided by the Court, he may if he thinks fit refer the application for decision by the Court.

(3) An application made under this section shall be made not more than 12 nor less than 6 months before the expiration of the term of the patent or at such later time (not being later than the expiration of the said term) as the Court or Commissioner may allow.

(4) Where an application under this section is made to the Court it shall thereafter be advertised in such manner as may be prescribed by rules of Court; and where an application under this section is made to the Commissioner it shall be made in such a manner as may be prescribed by regulations made under this Act and shall thereafter be advertised in such manner as may be so prescribed.

(5) Any person desiring to oppose the making of an order under this section, or to claim the inclusion therein of any restrictions or conditions or provisions, may give notice of opposition to the Court or, as the case may be, the Commissioner,—

(a) In the case of an application to the Court, within such period as may be prescribed by rules of Court; and

(b) In the case of an application to the Commissioner, within such period as may be prescribed by regulations made under this Act.

(6) On the hearing of any application under this section the applicant and any person by whom notice of opposition has been duly given shall be made parties to the proceedings; and in the case of an application to the Court, the Commissioner shall be entitled to appear and be heard, and shall appear if so directed by the Court.

(7) In considering any application under this section the Court or Commissioner shall have regard to the nature and merits of the invention in relation to the public, to the profits

made by the patentee as such, and to all the circumstances of the case.

(8) Not more than one order shall be made under this section in respect of the same patent, but an order may be made under this section in respect of a patent in respect of which one or more orders have been made under section 32 of this Act.

(9) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 23 (U.K.); 1921–22, No. 18, s. 20; 1943, No. 6, s. 2

As to appeals to the Court of Appeal, see ss. 97 (4) (b) and 98 (c).

32. Extension on ground of war loss—(1) If upon application made by a patentee in accordance with this section the Court or the Commissioner is satisfied that the patentee as such has suffered loss or damage (including loss of opportunity of dealing in or developing the invention) by reason of hostilities between Her Majesty in respect of the Government of New Zealand and any foreign State, the Court or Commissioner may by order extend the term of the patent, subject to such restrictions, conditions, and provisions, if any, as may be specified in the order, for such period (not exceeding 10 years) as may be so specified; and any such order may be made notwithstanding that the term of the patent has previously expired.

(2) An application for an order under this section may be made at the option of the applicant to the Court or to the Commissioner; but if the Commissioner considers that an application made to him raises issues of a kind which would be more fittingly decided by the Court, he may if he thinks fit refer the application for decision by the Court.

(3) An application under this section shall be made not more than 12 nor less than 6 months before the expiration of the term of the patent or at such later time as the Court or Commissioner may allow:

Provided that the Court or Commissioner shall not allow an application to be made later than the expiration of the said term unless satisfied that the applicant has been prevented from making the application before the expiration of that term by being on active service or by other circumstances arising by reason of any such hostilities as aforesaid.

(4) Where an application under this section is made to the Court, it shall thereafter be advertised in such manner as may be prescribed by rules of Court; and where an application

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under this section is made to the Commissioner, it shall thereafter be advertised in such manner as may be prescribed by regulations made under this Act.

(5) Any person desiring to oppose the making of an order under this section, or to claim the inclusion therein of any restrictions, conditions, or provisions, may give notice of opposition to the Court or, as the case may be, the Commissioner,—

(a) In the case of an application to the Court, within such period as may be prescribed by rules of Court; and

(b) In the case of an application to the Commissioner, within such period as may be prescribed by regulations made under this Act.

(6) On the hearing of any application under this section the applicant and any person by whom notice of opposition has been duly given shall be made parties to the proceedings; and in the case of an application to the Court, the Commissioner shall be entitled to appear and be heard, and shall appear if so directed by the Court.

(7) Two or more orders may be made under this section in respect of the same patent, and an order may be made under this section in respect of a patent in respect of which an order has been made under section 31 of this Act; but the aggregate term of any extensions granted in pursuance of orders made under this section shall not exceed 10 years.

(8) No order shall be made under this section on the application of—

(a) A person who is a subject of such a foreign State as is mentioned in subsection (1) of this section; or

(b) A company the business of which is managed or controlled by such persons or is carried on wholly or mainly for the benefit of or on behalf of such persons, notwithstanding that the company may be registered within the Commonwealth or the Republic of Ireland,—

and for the purpose of this section no account shall be taken of any loss or damage suffered by any person during any period during which he was such a subject as aforesaid, or by any company during any period during which its business was managed or controlled or carried on as aforesaid.

(9) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 24 (U.K.); 1943, No. 6, s. 3; 1946, No. 32, s. 2

As to appeals to the Court of Appeal, see ss. 97 (4) (b) and 98 (c)

33. Extension on ground of war loss of licensee—

Subject to the provisions of section 32 of this Act, an order for the extension of the term of a patent may be made under that section on the application of a person registered under section 84 of this Act as holding a licence from the patentee giving to the licensee, or to the licensee and persons authorised by him, to the exclusion of all other persons, permission to make, use, exercise, and vend the invention, if the Court or Commissioner is satisfied that the licensee as such has suffered any such loss or damage as is mentioned in subsection (1) of section 32 of this Act.

Cf. Patents Act 1949, s. 25 (U.K.)

34. Patents of addition—(1) Subject to the provisions of this section, where application is made for a patent in respect of any improvement in or modification of an invention (in this Act referred to as the main invention) and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Commissioner may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions of this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Commissioner may, if the patentee so requests, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the complete specification was the same as or later than the date of filing of the complete specification in respect of the main invention.

(4) A patent of addition shall not be sealed before the sealing of the patent for the main invention; and if the period within which, but for this provision, a request for the sealing of a patent of addition could be made under section 27 of this Act expires before the period within which a request for the sealing of the patent for the main invention may be so made, the request for the sealing of the patent of addition may be made at any time within the last-mentioned period.

(5) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as is unexpired, and shall remain in force during that term or

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until the previous cesser of the patent for the main invention and no longer:

Provided that—

(a) If the term of the patent for the main invention is extended under the foregoing provisions of this Act, the term of the patent of addition may also be extended accordingly; and

(b) If the patent for the main invention is revoked under this Act, the Court or Commissioner, as the case may be, may order that the patent of addition shall become an independent patent for the remainder of the term of the patent for the main invention, and thereupon the patent shall continue in force as an independent patent accordingly.

(6) No renewal fees shall be repayable in respect of a patent of addition; but, if any such patent becomes an independent patent by virtue of an order under subsection (5) of this section, the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

(7) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of—

(a) The main invention described in the complete specification relating thereto; or

(b) Any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition,—

and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(8) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 26 (U.K.); 1921–22, No. 18, s. 21

Restoration of Lapsed Patents and Patent Applications

35. Restoration of lapsed patents—(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under section 30 of this Act, and the

Commissioner is satisfied upon application that the failure was unintentional and that no undue delay has occurred in the making or prosecution of the application, he shall by order restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.

(2) An application under this section may be made by the person who was the patentee or by his personal representative; and where the patent was held by 2 or more persons jointly, the application may, with the leave of the Commissioner, be made by one or more of them without joining the others.

(3) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to pay the renewal fee; and the Commissioner may require from the applicant such further evidence as he may think necessary.

(4) If after hearing the applicant (if the applicant so requires or the Commissioner thinks fit) the Commissioner is satisfied that a *prima facie* case has been made out for an order under this section, he shall advertise the application in the *Journal*; and within the prescribed period any person may give notice to the Commissioner of opposition thereto on either or both of the following grounds, that is to say,—

(a) That the failure to pay the renewal fee was not unintentional; or

(b) That there has been undue delay in the making of the application.

(5) If notice of opposition is given within the period aforesaid, the Commissioner shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(6) If no notice of opposition is given within the period aforesaid or if, in the case of opposition, the decision of the Commissioner is in favour of the applicant, the Commissioner shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, make the order in accordance with the application.

(7) An order under this section for the restoration of a patent—

(a) May be made subject to such conditions as the Commissioner thinks fit, including in particular a condition requiring the registration in the register of

patents of any matter in respect of which the provisions of this Act as to entries in that register have not been complied with; and

- (b) Shall contain or be subject to such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the patented invention between the date when the patent ceased to have effect and the date of the application under this section,—

and if any condition of an order under this section is not complied with by the patentee, the Commissioner may, after giving to the patentee an opportunity to be heard, revoke the order and give such directions consequential on the revocation as he thinks fit.

(8) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 27 (U.K.); 1921–22, No. 18, s. 22

36. Restoration of applications where patent not sealed—(1) Where a patent has not been sealed by reason only that the prescribed request was not made within the time allowed for that purpose by or under section 27 of this Act, then if the Commissioner is satisfied, upon application made by the applicant for the patent, that the failure to make the request was unintentional and that no undue delay has occurred in making the application he may order the patent to be sealed notwithstanding that the prescribed request was not made as aforesaid.

(2) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to make the prescribed request; and the Commissioner may require from the applicant such further evidence as he may think necessary.

(3) If the Commissioner (after hearing the applicant, if the applicant so requires or the Commissioner thinks fit) is satisfied that a *prima facie* case has been made out for an order under this section, he shall advertise the application in the *Journal*; and within the prescribed period any person may give notice to the Commissioner of opposition thereto on the ground that the failure to make the prescribed request was not unintentional or that undue delay has occurred in making the application.

(4) If notice of opposition is given within the period aforesaid, the Commissioner shall notify the applicant and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(5) If no notice of opposition is given within the period aforesaid, or if in the case of opposition the decision of the Commissioner is in favour of the applicant, the Commissioner shall, upon payment of the fee prescribed in respect of the making of the request for sealing and of such additional fee as may be prescribed, make the order in accordance with the application.

(6) An order under this section for the sealing of a patent shall contain or be subject to such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the invention between the date when the time allowed by or under section 27 of this Act for making the prescribed request expired and the date of the application under this section.

(7) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 28 (U.K.); 1921–22, No. 18, s. 22

37. Restoration of application where complete specification not accepted—(1) Where an applicant has not complied with all the requirements imposed on him by or under this Act within the period prescribed by section 19 of this Act, or within any extension of the period granted by the Commissioner under that section or under section 93 of this Act, and the application has accordingly become void, the applicant may apply to the Commissioner in the prescribed manner for an order restoring the application and extending the period for complying with the requirements imposed on the applicant by or under this Act to such date as may be specified in that behalf in the order.

(2) Every such application shall contain a statement of the circumstances which led to the failure of the applicant to comply with the requirements imposed on him by or under this Act.

(3) If it appears from that statement that any omission on the part of the applicant was unintentional and that no undue delay has occurred in the making of the application, the Commissioner shall advertise the application and within such period as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where any such notice is given the Commissioner shall notify the applicant thereof.

(5) After the expiration of the prescribed period the Commissioner shall hear the case, and issue an order which shall either—

(a) Restore the application and extend the period for complying with the requirements imposed on the applicant by or under this Act to a period to be specified in that behalf in the order; or

(b) Dismiss the application.

(6) An order under this section shall contain or be subject to such provisions as may be prescribed for the protection of persons who may have availed themselves of the invention the subject of the application for a patent between the date when the period prescribed by section 19 of this Act, and every extension of that period granted under that section or under section 93 of this Act, for complying with all the requirements imposed on the applicant by or under this Act expired and the date of the application under this section.

(7) An appeal to the Court shall lie from the decision of the Commissioner under this section.

Cf. 1924, No. 40, s. 4

Amendment of Specifications

38. Amendment of specification with leave of Commissioner—(1) Subject to the provisions of section 40 of this Act, the Commissioner may, upon application made under this section by a patentee, or by an applicant for a patent at any time after the acceptance of the complete specification, allow the complete specification to be amended subject to such conditions, if any, as the Commissioner thinks fit:

Provided that the Commissioner shall not allow a specification to be amended under this section upon an application made while any action before the Court for infringement of the patent or any proceeding before the Court for the revocation of the patent is pending.

(2) Every application for leave to amend a specification under this section shall state the nature of the proposed amendment and shall give full particulars of the reasons for which the application is made.

(3) Any application for leave to amend a specification under this section, and the nature of the proposed amendment, shall be advertised in the prescribed manner:

Provided that where the application is made before the publication of the complete specification, the Commissioner

may, if he thinks fit, dispense with advertisement under this subsection or direct that advertisement shall be postponed until the complete specification is published.

(4) Within the prescribed period after the advertisement of an application under this section, any person may give notice to the Commissioner of opposition thereto; and where such a notice is given within the period aforesaid, the Commissioner shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

(6) This section shall not apply in relation to any amendment of a specification effected in proceedings in opposition to the grant of a patent or on a reference to the Commissioner of a dispute as to the infringement or validity of a claim, or effected in pursuance of any provision of this Act authorising the Commissioner to direct a reference to another specification or patent to be inserted, or to refuse to grant a patent, or to revoke a patent, unless the specification is amended to his satisfaction.

Cf. Patents Act 1949, s. 29 (U.K.); 1921–22, No. 18, s. 23

39. Amendment of specification with leave of Court—

(1) In any action for infringement of a patent or any proceeding before the Court for the revocation of a patent, the Court may, subject to the provisions of section 40 of this Act, by order allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisements, or otherwise, as the Court may think fit; and if in any such proceedings for revocation the Court decides that the patent is invalid, the Court may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the Court, the applicant shall give notice of the application to the Commissioner, and the Commissioner shall be entitled to appear and be heard, and shall appear if so directed by the Court.

Cf. Patents Act 1949, s. 30 (U.K.); 1921–22, No. 18, s. 24

40. Supplementary provisions as to amendment of specification—(1) After the acceptance of a complete specification, no amendment thereof shall be effected except

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by way of disclaimer, correction, or explanation, and no amendment thereof shall be allowed, except for the purpose of correcting an obvious mistake, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved by the Commissioner or the Court, the right of the patentee or applicant to make the amendment shall not be called in question except on the ground of fraud; and the amendment shall in all Courts and for all purposes be deemed to form part of the specification:

Provided that in construing the specification as amended reference may be made to the specification as originally published.

(3) Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved as aforesaid, the fact that the specification has been amended shall be advertised in the *Journal*.

Cf. Patents Act 1949, s. 31 (U.K.); 1921–22, No. 18, ss. 23 (6), 24 (1)

Revocation and Surrender of Patents

41. Revocation of patent by Court—(1) Subject to the provisions of this Act, a patent may, on the application of any person interested, be revoked by the Court on any of the following grounds, that is to say,—

- (a) That the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in New Zealand;
- (b) That the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;
- (c) That the patent was obtained in contravention of the rights of the person who makes the application to the Court or any person under or through whom he claims;
- (d) That the subject of any claim of the complete specification is not an invention within the meaning of this Act:

- (e) That the invention, so far as claimed in any claim of the complete specification, is not new having regard to what was known or used before the priority date of the claim in New Zealand:
- (f) That the invention, so far as claimed in any claim of the complete specification, is obvious and does not involve any inventive step having regard to what was known or used before the priority date of the claim in New Zealand:
- (g) That the invention, so far as claimed in any claim of the complete specification, is not useful:
- (h) That the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, or does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection:
- (i) That the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification:
- (j) That the patent was obtained on a false suggestion or representation:
- (k) That the primary or intended use or exercise of the invention is contrary to law:
- (l) That the invention, so far as claimed in any claim of the complete specification, was secretly used in New Zealand, otherwise than as mentioned in subsection (2) of this section, before the priority date of that claim:
- (m) That the patent has been granted contrary to law.

(2) For the purposes of paragraph (l) of subsection (1) of this section, no account shall be taken of any use of the invention—

- (a) For the purpose of reasonable trial or experiment only;
- or
- (b) By a Government Department or any person authorised by a Government Department, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to a Government Department or person authorised as aforesaid; or
- (c) By any other person, in consequence of the applicant for the patent or any person from whom he derives title

having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title,—

and for the purposes of paragraph (e) or paragraph (f) of the said subsection (1) no account shall be taken of any secret use.

(3) Without prejudice to the provisions of subsection (1) of this section, a patent may be revoked by the Court,—

(a) On the application of a Government Department, if the Court is satisfied that the patentee has without reasonable cause failed to comply with a request of the Department to make, use, or exercise the patented invention for the services of the Crown upon reasonable terms; or

(b) On the application, with the written consent of the Attorney-General, of any person not otherwise entitled to apply under this section.

(4) Every ground on which a patent may be revoked shall be available as a ground of defence in any proceeding for the infringement of the patent.

Cf. Patents Act 1949, s. 32 (U.K.); 1921–22, No. 18, s. 27; 1939, No. 26, s. 61

42. Revocation of patent by Commissioner—(1) At any time within 12 months after the sealing of a patent, any person interested who did not oppose the grant of the patent may apply to the Commissioner for an order revoking the patent on any one or more of the grounds upon which the grant of the patent could have been opposed:

Provided that when an action for infringement, or proceedings for the revocation, of a patent are pending in any Court, an application to the Commissioner under this section shall not be made except with the leave of the Court.

(2) Where an application is made under this section, the Commissioner shall notify the patentee and shall give to the applicant and the patentee an opportunity to be heard before deciding the case.

(3) If on an application under this section the Commissioner is satisfied that any of the grounds aforesaid are established, he may by order direct that the patent shall be revoked either unconditionally or unless within such time as may be specified in the order the complete specification is amended to his satisfaction:

Provided that the Commissioner shall not make an order

for the unconditional revocation of a patent under this section unless the circumstances are such as would have justified him in refusing to grant the patent in proceedings under section 21 of this Act.

(4) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 33 (U.K.); 1921–22, No. 18, s. 28; 1939, No. 26, s. 62

As to appeals to the Court of Appeal, see ss. 97 (4) (a) and 98 (a).

43. Surrender of patent—(1) A patentee may at any time by notice given to the Commissioner offer to surrender his patent.

(2) Where such an offer is made, the Commissioner shall advertise the offer in the prescribed manner; and within the prescribed period after such advertisement any person interested may give notice to the Commissioner of opposition to the surrender.

(3) Where any such notice of opposition is duly given, the Commissioner shall notify the patentee.

(4) If the Commissioner (after hearing the patentee and any opponent, if desirous of being heard) is satisfied that the patent may properly be surrendered, he may accept the offer and by order revoke the patent.

(5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 34 (U.K.); 1921–22, No. 18, s. 28 (3)

Voluntary Endorsement of Patent

44. Endorsement of patent “licences of right”—(1) At any time after the sealing of a patent the patentee may apply to the Commissioner for the patent to be endorsed with the words “licences of right”; and where such an application is made, the Commissioner shall notify the application to any person entered on the register as entitled to an interest in the patent, and if satisfied, after giving any such person an opportunity to be heard, that the patentee is not precluded by contract from granting licences under the patent, cause the patent to be endorsed accordingly.

(2) Where a patent is endorsed under this section—

(a) Any person shall, at any time thereafter, be entitled as of right to a licence under the patent upon such terms as may, in default of agreement, be settled by the Commissioner on the application of the patentee or the person requiring the licence:

- (b) The Commissioner may, on the application of the holder of any licence granted under the patent before the endorsement, order the licence to be exchanged for a licence to be granted by virtue of the endorsement upon terms to be settled as aforesaid:
- (c) If in proceedings for infringement of the patent (otherwise than by the importation of goods) the defendant undertakes to take a licence upon terms to be settled by the Commissioner as aforesaid, no injunction shall be granted against him, and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence had been granted before the earliest infringement:
- (d) The renewal fees payable in respect of the patent after the date of the endorsement shall be one-half of the renewal fees which would be payable if the patent were not so endorsed.

(3) The licensee under any licence granted by virtue of the endorsement of a patent under this section shall (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent; and if the patentee refuses or neglects to do so within 2 months after being so called upon, the licensee may institute proceedings for the infringement in his own name as if he were patentee, making the patentee a defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) An application for the endorsement of a patent under this section shall contain a statement (to be verified in such manner as may be prescribed) that the patentee is not precluded by contract from granting licences under the patent; and the Commissioner may require from the applicant such further evidence as he may think necessary.

(5) An application made under this section for the endorsement of a patent of addition shall be treated as an application for the endorsement of the patent for the main invention also, and an application made under this section for the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the

endorsement of the patent of addition also; and where a patent of addition is granted in respect of a patent already endorsed under this section, the patent of addition shall also be so endorsed.

(6) All endorsements of patents under this section shall be entered in the register of patents and shall be published in the *Journal* and in such other manner as the Commissioner thinks desirable for bringing the endorsement to the notice of manufacturers.

(7) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 35 (U.K.); 1921–22, No. 18, s. 26

45. Cancellation of endorsement under section 44—

(1) At any time after a patent has been endorsed under section 44 of this Act, the patentee may apply to the Commissioner for cancellation of the endorsement; and where such an application is made and the balance paid of all renewal fees which would have been payable if the patent has not been endorsed, the Commissioner may, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application, cancel the endorsement accordingly.

(2) Within the prescribed period after a patent has been endorsed as aforesaid, any person who claims that the patentee is, and was at the time of the endorsement, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the Commissioner for cancellation of the endorsement.

(3) Where the Commissioner is satisfied, on application made under subsection (2) of this section, that the patentee is and was precluded as aforesaid, he shall cancel the endorsement; and thereupon the patentee shall be liable to pay, within such period as may be prescribed, a sum equal to the balance of all renewal fees which would have been payable if the patent had not been endorsed, and if that sum is not paid within that period the patent shall cease to have effect at the expiration of that period.

(4) Where the endorsement of a patent is cancelled under this section, the rights and liabilities of the patentee shall thereafter be the same as if the endorsement had not been made.

(5) The Commissioner shall advertise in the prescribed manner any application made to him under this section; and within the prescribed period after such advertisement,—

(a) In the case of an application under subsection (1) of this section, any person interested; and

(b) In the case of an application under subsection (2) of this section, the patentee,—

may give notice to the Commissioner of opposition to the cancellation.

(6) Where any such notice of opposition is given, the Commissioner shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

(7) An application under this section for the cancellation of the endorsement of a patent of addition shall be treated as an application for the cancellation of the endorsement of the patent for the main invention also, and an application made under this section for the cancellation of the endorsement of a patent in respect of which a patent of addition is in force shall be treated as an application for the cancellation of the endorsement of the patent of addition also.

(8) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 36 (U.K.); 1921–22, No. 18, s. 26 (5)

Compulsory Licences, etc.

46. Compulsory endorsement—(1) At any time after the expiration of 3 years from the date of the sealing of a patent, any person interested may apply to the Commissioner upon any one or more of the grounds specified in subsection (2) of this section for a licence under the patent or for the endorsement of the patent with the words “licences of right”.

(2) The grounds upon which application may be made for an order under this section are as follows, that is to say:

(a) That the patented invention, being capable of being commercially worked in New Zealand, is not being commercially worked therein or is not being so worked to the fullest extent that is reasonably practicable:

(b) That a demand for the patented article in New Zealand is not being met on reasonable terms:

(c) That the commercial working of the invention in New Zealand is being prevented or hindered by the importation of the patented article:

(d) That by reason of the refusal of the patentee to grant a licence or licences on reasonable terms—

(i) A market for the export of the patented article manufactured in New Zealand is not being supplied; or

(ii) The working or efficient working in New Zealand of any other patented invention which makes a substantial contribution to the art is prevented or hindered; or

(iii) The establishment or development of commercial or industrial activities in New Zealand is unfairly prejudiced:

(e) That by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire, or use of the patented article or process, the manufacture, use, or sale of materials not protected by the patent, or the establishment or development of commercial or industrial activities in New Zealand is unfairly prejudiced.

(3) Subject as hereinafter provided, the Commissioner may, if satisfied that any of the grounds aforesaid are established, make an order in accordance with the application; and where the order is for the grant of a licence, it may require the licence to be granted upon such terms as the Commissioner thinks fit:

Provided that—

(a) Where the application is made on the ground that the patented invention is not being commercially worked in New Zealand or is not being worked to the fullest extent that is reasonably practicable, and it appears to the Commissioner that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable it to be so worked, he may by order adjourn the application for such period as will in his opinion give sufficient time for the invention to be so worked:

(b) An order shall not be made under this section for the endorsement of a patent on the ground that a market for the export of the patented article is not being supplied, and any licence granted under this section on that ground shall contain such provisions as appear to the Commissioner to be expedient for restricting the countries in which the patented article may be sold or used by the licensee:

(c) No order shall be made under this section in respect of a patent on the ground that the working or efficient working in New Zealand of another patented invention is prevented or hindered unless the Commissioner is satisfied that the patentee in respect of that other invention is able and willing to grant to the patentee and his licensees a licence in respect of that other invention on reasonable terms.

(4) An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent; and no person shall be estopped from alleging any of the matters specified in subsection (2) of this section by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted such a licence.

(5) In this section the expression "patented article" includes any article made by a patented process.

Cf. Patents Act 1949, s. 37 (U.K.); 1921–22, No. 18, s. 29; 1939, No. 26, s. 63 (d)

47. Provisions as to licences under section 46—

(1) Where the Commissioner is satisfied, on application made under section 46 of this Act, that the manufacture, use, or sale of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire, or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 46 of this Act is made by a person who is the holder of a licence under the patent, the Commissioner may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where on an application under section 46 of this Act the Commissioner orders the grant of a licence, he may direct that the licence shall operate—

(a) To deprive the patentee of any right which he may have as patentee to make, use, exercise, or vend the invention or to grant licences under the patent:

(b) To revoke all existing licences in respect of the invention.

(4) Subsection (3) of section 44 of this Act shall apply to any licence granted in pursuance of an order under section 46 of this Act as it applies to a licence granted by virtue of the said section 44.

Cf. Patents Act 1949, s. 38 (U.K.); 1939, No. 26, s. 63 (e)

48. Exercise of powers on applications under section 46—(1) The powers of the Commissioner upon an application under section 46 of this Act shall be exercised with a view to securing the following general purposes, that is to say:

- (a) That inventions which can be worked on a commercial scale in New Zealand and which should in the public interest be so worked shall be worked therein without undue delay and to the fullest extent that is reasonably practicable;
- (b) That the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration, having regard to the nature of the invention;
- (c) That the interests of any person for the time being working or developing an invention in New Zealand under the protection of a patent shall not be unfairly prejudiced.

(2) Subject to subsection (1) of this section, the Commissioner shall, in determining whether to make an order in pursuance of any such application, take account of the following matters, that is to say:

- (a) The nature of the invention, the time which has elapsed since the sealing of the patent, and the measures already taken by the patentee or any licensee to make full use of the invention; and
- (b) The ability of any person to whom a licence would be granted under the order to work the invention to the public advantage; and
- (c) The risk to be undertaken by that person in providing capital and working the invention if the application is granted,—

but shall not be required to take account of matters subsequent to the making of the application.

Cf. Patents Act 1949, s. 39 (U.K.); 1921–22, No. 18, s. 29 (1), (4)

49. Endorsement, etc., on application of Crown—

(1) At any time after the expiration of 3 years from the date of the sealing of a patent, any Government Department may

apply to the Commissioner upon any one or more of the grounds specified in section 46 of this Act for the endorsement of the patent with the words "licences of right" or for the grant to the Government Department or to any person specified in the application of a licence under the patent; and the Commissioner may, if satisfied that any of those grounds are established, make an order in accordance with the application.

(2) Subsections (3) and (5) of section 46 of this Act and sections 47 and 48 of this Act shall, so far as applicable, apply in relation to an application and an order under subsection (1) of this section as they apply in relation to an application and an order under the said section 46.

(3) A licence granted under this section may permit the licensee to import the patented article.

Cf. Patents Act 1949, s. 40 (U.K.)

50. Revocation of patent—(1) Where an order for the grant of a licence under a patent has been made in pursuance of an application under section 46 of this Act, any person interested may, at any time after the expiration of 2 years from the date of that order, apply to the Commissioner for the revocation of the patent upon any of the grounds specified in subsection (2) of the said section 46; and if upon any such application the Commissioner is satisfied—

(a) That any of the said grounds are established; and

(b) That the purposes for which an order may be made in pursuance of an application under the said section 46 could not be achieved by the making of any such order as is authorised to be made in pursuance of such an application,—

he may order the patent to be revoked.

(2) An order for the revocation of a patent under this section may be made so as to take effect either unconditionally or in the event of failure to comply, within such reasonable period as may be specified in the order, with such conditions as may be imposed by the order with a view to achieving the purposes aforesaid; and the Commissioner may, on reasonable cause shown in any case, by subsequent order extend any period so specified.

Cf. Patents Act 1949, s. 42 (U.K.); 1921–22, No. 18, s. 29; 1939, No. 26, s. 63 (f)

51. Inventions relating to food or medicine, etc.—

(1) Without prejudice to the foregoing provisions of this Act, where a patent is in force in respect of—

- (a) A substance capable of being used as food or medicine or in the production of food or medicine; or
- (b) A process for producing such a substance as aforesaid; or
- (c) Any invention capable of being used as or as part of a surgical or curative device,—

the Commissioner shall, on application made to him by any person interested, order the grant to the applicant of a licence under the patent on such terms as he thinks fit, unless it appears to him that there are good reasons for refusing the application.

(2) In settling the terms of licences under this section the Commissioner shall endeavour to secure that food, medicines, and surgical and curative devices shall be available to the public at the lowest prices consistent with the patentees' deriving a reasonable advantage from their patent rights.

(3) A licence granted under this section shall entitle the licensee to make, use, exercise, and vend the invention as a food or medicine, or for the purposes of the production of food or medicine or as part of a surgical or curative device, but for no other purposes.

(4) A licence granted under this section may permit the licensee to import the patented article.

Cf. Patents Act 1949, s. 41 (U.K.); 1921–22, No. 18, s. 44 (2); 1939, No. 26, s. 67

52. Procedure on application under sections 46 to 51—(1) Every application under sections 46 to 51 of this Act shall specify the nature of the order sought by the applicant and shall contain a statement (to be verified in such manner as may be prescribed) setting out the nature of the applicant's interest (if any) and the facts upon which the application is based.

(2) Where the Commissioner is satisfied, upon consideration of any such application, that a *prima facie* case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other persons appearing from the register of patents to be interested in the patent in respect of which the application is made, and shall advertise the application in the *Journal*.

(3) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Commissioner may on

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application (made either before or after the expiration of the prescribed time) allow, give to the Commissioner notice of opposition.

(4) Any such notice of opposition shall contain a statement (to be verified in such manner as may be prescribed) setting out the grounds on which the application is opposed.

(5) Where any such notice of opposition is duly given, the Commissioner shall notify the applicant, and shall, subject to the provisions of section 53 of this Act with respect to arbitration, give to the applicant and the opponent an opportunity to be heard before deciding the case.

Cf. Patents Act 1949, s. 43 (U.K.); 1921–22, No. 18, s. 29; 1939, No. 26, s. 63

53. Appeal and references to arbitrator—(1) An appeal to the Court shall lie from any order made by the Commissioner in pursuance of an application under sections 46 to 51 of this Act.

(2) On any appeal under this section the Attorney-General or such other counsel as he may appoint shall be entitled to appear and be heard.

(3) Where any such application is opposed in accordance with section 52 of this Act and either—

(a) The parties consent; or

(b) The proceedings require a prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the Commissioner conveniently be made before him,—

the Commissioner may at any time order the whole proceedings, or any question or issue of fact arising therein, to be referred to an arbitrator agreed on by the parties, or, in default of agreement, appointed by the Commissioner.

(4) Where the whole proceedings are referred as aforesaid, section 11 of the Arbitration Amendment Act 1938 (which relates to the statement of cases by arbitrators) shall not apply to the arbitration; but unless the parties otherwise agree before the award of the arbitrator is made, an appeal shall lie from the award to the Court.

(5) Where a question or issue of fact is referred as aforesaid, the arbitrator shall report his findings to the Commissioner.

Cf. Patents Act 1949, s. 44 (U.K.); 1921–22, No. 18, s. 29 (12)

As to appeals to the Court of Appeal, see ss. 97 (4) (a) and 98 (a).

54. Supplementary provisions—(1) Any order under this Act for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the patentee and all other necessary parties, granting a licence in accordance with the order.

(2) An order may be made on an application under sections 46 to 49 of this Act for the endorsement of a patent with the words “licences of right” notwithstanding any contract which would have precluded the endorsement of the patent on the application of the patentee under section 44 of this Act; and any such order shall for all purposes have the same effect as an endorsement made in pursuance of an application under the said section 44.

(3) No order shall be made in pursuance of any application under sections 46 to 50 of this Act which would be at variance with any treaty, convention, arrangement, or engagement applying to New Zealand and any convention country.

Cf. Patents Act 1949, s. 45 (U.K.); 1921–22, No. 18, s. 30

Use of Patented Inventions for Services of the Crown

55. Use of patented inventions for services of the Crown—(1) Notwithstanding anything in this Act, any Government Department, and any person authorised in writing by a Government Department, may make, use, and exercise any patented invention for the services of the Crown in accordance with the following provisions of this section.

(2) If and so far as the invention has before the priority date of the relevant claim of the complete specification been duly recorded by or tried by or on behalf of a Government Department otherwise than in consequence of the communication thereof directly or indirectly by the patentee or any person from whom he derives title, any use of the invention by virtue of this section may be made free of any royalty or other payment to the patentee.

(3) If and so far as the invention has not been so recorded or tried as aforesaid, any use of the invention made by virtue of this section at any time after the acceptance of the complete specification in respect of the patent, or in consequence of any such communication as aforesaid, shall be made upon such terms as may be agreed upon, either before or after the use, between the Government Department and the patentee with the approval of the Minister of Finance, or as may in default of agreement be determined by the Court on a reference under section 57 of this Act.

(4) The authority of a Government Department in respect of an invention may be given under this section either before or after the patent is granted and either before or after the acts in respect of which the authority is given are done, and may be given to any person whether or not he is authorised directly or indirectly by the patentee to make, use, exercise, or vend the invention.

(5) Where any use of an invention is made by or with the authority of a Government Department under this section, then, unless it appears to the Department that it would be contrary to the public interest so to do, the Department shall notify the patentee as soon as practicable after the use is begun, and furnish him with such information as to the extent of the use as he may from time to time require.

(6) For the purposes of this section and section 56 of this Act, any use of an invention for the supply to the Government of any country outside New Zealand, in pursuance of any agreement or arrangement between Her Majesty's Government in New Zealand and the Government of that country, of articles required for the defence of that country shall be deemed to be a use of the invention for the services of the Crown; and the power of a Government Department or a person authorised by a Government Department under this section to make, use, and exercise an invention shall include power—

- (a) To sell such articles to the Government of any country in pursuance of any such agreement or arrangement as aforesaid; and
- (b) To sell to any person any articles made in the exercise of the powers conferred by this section which are no longer required for the purpose for which they were made.

(7) Where the Governor-General, by Order in Council, declares that the use of any patented invention by any person or by any class of persons engaged in a particular industry is necessary or desirable to enable full benefit to be derived by the members of the public in New Zealand of any enterprise or undertaking in which the Crown or any Government Department has a complete or almost complete monopoly, any such use of the invention or inventions shall for the purposes of this section and sections 56 and 57 of this Act be deemed to be a use for the services of the Crown, and the power of a Government Department or a person authorised by a Government Department under this section to make, use, and exercise an invention shall include power to sell to

any person any articles made in the exercise of the powers conferred by this section.

(8) The purchaser of any articles sold in the exercise of powers conferred by this section, and any person claiming through him, shall have power to deal with them in the same manner as if the patent were held on behalf of Her Majesty.

Cf. Patents Act 1949, s. 46 (U.K.); 1921–22, No. 18, s. 32; 1943, No. 6, s. 4

Section 4 (6) of the Hospitals Act 1957 provides that for the purposes of ss. 55–58 of this Act the services of a Hospital Board shall be deemed to be the services of the Crown.

As to the extension of the powers in this section in respect of pharmaceutical requirements, see s. 100A of the Social Security Act 1964.

56. Rights of third parties in respect of Crown use—

(1) In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the services of the Crown—

(a) By a Government Department or a person authorised by a Government Department under section 55 of this Act; or

(b) By the patentee or applicant for the patent to the order of a Government Department,—

the provisions of any licence, assignment, or agreement made, whether before or after the commencement of this Act, between the patentee or applicant for the patent, or any person who derives title from him or from whom he derives title, and any person other than a Government Department shall be of no effect so far as those provisions restrict or regulate the use of the invention, or any model, document, or information, relating thereto, or provide for making of payments in respect of any such use, or calculated by reference thereto; and the reproduction or publication of any model or document in connection with the said use shall not be deemed to be an infringement of any copyright subsisting in the model or document.

(2) Where any exclusive licence granted otherwise than for royalties or other benefits determined by reference to the use of the invention is in force under the patent, then,—

(a) In relation to any use of the invention which, but for the provisions of this section and section 55 of this Act, would constitute an infringement of the rights of the licensee, subsection (3) of section 55 of this Act shall have the effect as if for reference to the patentee there was substituted a reference to the licensee; and

(b) In relation to any use of the invention by the licensee by virtue of an authority given under section 55 of this Act, that section shall have effect as if the said subsection (3) were omitted.

(3) Subject to the provisions of subsection (2) of this section, where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention, then,—

(a) In relation to any use of the invention by virtue of section 55 of this Act, subsection (3) of that section shall have effect as if the reference to the patentee included a reference to the assignor, and any sum payable by virtue of that subsection shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the Court on a reference under section 57 of this Act; and

(b) In relation to any use of the invention made for the services of the Crown by the patentee to the order of a Government Department, subsection (3) of section 55 of this Act shall have effect as if that use were made by virtue of an authority given under that section.

(4) Where, under subsection (3) of section 55 of this Act, payments are required to be made by a Government Department to a patentee in respect of any use of an invention, any person, being the holder of an exclusive licence under the patent (not being such a licence as is mentioned in subsection (2) of this section) authorising him to make that use of the invention, shall be entitled to recover from the patentee such part (if any) of those payments as may be agreed upon between that person and the patentee, or as may in default of agreement be determined by the Court under section 57 of this Act to be just, having regard to any expenditure incurred by that person—

(a) In developing the said invention; or

(b) In making payments to the patentee, other than royalties or other payments, determined by reference to the use of the invention, in consideration of the licence,—

and if, at any time before the amount of any such payment has been agreed upon between the Government Department and the patentee, that person gives notice in writing of his

interest to the Department, any agreement as to the amount of that payment shall be of no effect unless it is made with his consent.

Cf. Patents Act 1949, s. 47 (U.K.); 1921–22, No. 18, s. 32 (1); 1943, No. 6, s. 4

See the notes to s. 55 above.

57. Reference of disputes as to Crown use—(1) Any dispute as to the exercise by a Government Department or a person authorised by a Government Department of the powers conferred by section 55 of this Act, or as to terms for the use of an invention for the services of the Crown thereunder, or as to the right of any person to receive any part of a payment made in pursuance of subsection (3) of that section, may be referred to the Court by either party to the dispute in such manner as may be prescribed by rules of Court.

(2) In any proceedings under this section to which a Government Department is a party, the Department may,—

(a) If the patentee is a party to the proceedings, apply for revocation of the patent upon any ground upon which a patent may be revoked under section 41 of this Act;

(b) In any case, put in issue the validity of the patent without applying for its revocation.

(3) If in such proceedings as aforesaid any question arises whether an invention has been recorded or tried as mentioned in section 55 of this Act, and the disclosure of any document recording the invention, or of any evidence of the trial thereof, would in the opinion of the Department be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed upon.

(4) In determining under this section any dispute between a Government Department and any person as to terms for the use of an invention for the services of the Crown, the Court shall have regard to any benefit or compensation which that person or any person from whom he derives title may have received, or may be entitled to receive, directly or indirectly from any Government Department in respect of the invention in question.

(5) In any proceedings under this section the Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to a special or official

referee or an arbitrator on such terms as the Court may direct; and references to the Court in the foregoing provisions of this section shall be construed accordingly.

Cf. Patents Act 1949, s. 48 (U.K.); 1921–22, No. 18, s. 32 (2); 1943, No. 6, s. 4 (3)

See the notes to s. 55 above.

58. Special provisions as to Crown use during emergency—(1) During any period of emergency within the meaning of this section, the powers exercisable in relation to an invention by a Government Department, or a person authorised by a Government Department under section 55 of this Act, shall include power to make, use, exercise, and vend the invention for any purpose which appears to the Department necessary or expedient—

- (a) For the efficient prosecution of any war in which Her Majesty may be engaged; or
- (b) For the maintenance of supplies and services essential to the life of the community; or
- (c) For securing a sufficiency of supplies and services essential to the well-being of the community; or
- (d) For promoting the productivity of industry, commerce, and agriculture; or
- (e) For fostering and directing exports and reducing imports, or imports of any classes, from all or any countries and for redressing the balance of trade; or
- (f) Generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or
- (g) For assisting the relief of suffering and the restoration and distribution of essential supplies and services in any part of the Commonwealth or of the Republic of Ireland or in any foreign countries that are in grave distress as a result of war; or
- (h) For providing or securing supplies and services required for the defence of any part of the Commonwealth, or for the maintenance or restoration of peace and security in any part of the world, or for any measures arising out of a breach or apprehended breach of peace in any part of the world; or
- (i) For preventing supplies or services being disposed of in a manner prejudicial to the defence of any part of

the Commonwealth or to peace and security in any part of the world or to any such measures as aforesaid,—

and any reference in that section or in section 56 or section 57 of this Act to the services of the Crown shall be construed as including a reference to the purposes aforesaid.

(2) In this section the expression “period of emergency” means any period beginning on such date as may be declared by Order in Council to be the commencement, and ending on such date as may be so declared to be the termination, of a period of emergency for the purposes of this section.

(3) Every Order in Council made under this section shall be laid before Parliament within 28 days after the date of the making thereof if Parliament is then in session, and, if not, shall be laid before Parliament within 28 days after the date of the commencement of the next ensuing session.

Cf. Patents Act 1949, s. 49 (U.K.); 1943, No. 6, s. 4

S. 4 (6) of the Hospitals Act 1957 provides that for the purposes of ss. 55–58 of this Act the services of a Hospital Board shall be deemed to be the services of the Crown.

Anticipation, etc.

59. Previous publication—(1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in New Zealand—

- (a) In a specification filed in pursuance of an application for a patent made in New Zealand and dated more than 50 years before the date of filing of the first mentioned specification; or
- (b) In a specification describing the invention for the purposes of an application for protection in any country outside New Zealand made more than 50 years before that date; or
- (c) In any abridgment of or extract from any such specification published under the authority of the Commissioner or of the Government of any country outside New Zealand.

(2) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority date of the relevant claim of the specification, if the patentee or applicant for the patent proves—

- (a) That the matter published was obtained from him or (where he himself is not the true and first inventor)

from any person from whom he derives title, and was published without his consent or the consent of any such person; and

- (b) Where the patentee or applicant for the patent or any person from whom he derives title learned of the publication before the date of the application for the patent or (in the case of a convention application) before the date of the application for protection in a convention country, that the application or the application in a convention country, as the case may be, was made as soon as reasonably practicable thereafter:

Provided that this subsection shall not apply if the invention was before the priority date of the claim commercially worked in New Zealand, otherwise than for the purpose of reasonable trial, either by the patentee or applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title.

(3) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention, made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of the invention by that applicant.

(4) Notwithstanding anything in this Act, the Commissioner shall not refuse to accept a complete specification or to grant a patent, and a patent shall not be revoked or invalidated, by reason only of any circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

Cf. Patents Act 1949, s. 50 (U.K.); 1921–22, No. 18, s. 46

60. Previous communication, display, or working—

(1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to a Government Department or to any person authorised by a Government

Department to investigate the invention or its merits, or of anything done, in consequence of such a communication, for the purpose of the investigation.

(2) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of—

- (a) The display of the invention with the consent of the true and first inventor at an international or industrial exhibition declared as such by the Governor-General by notice in the *Gazette* (whether the exhibition is held in New Zealand or elsewhere) . . . , or the use thereof with the consent of the true and first inventor for the purposes of such an exhibition in the place where it is held; or
- (b) The publication of any description of the invention in consequence of the display or use of the invention at any such exhibition as aforesaid; or
- (c) The use of the invention, after it has been displayed or used at any such exhibition as aforesaid and during the period of the exhibition, by any person without the consent of the true and first inventor; or
- (d) The description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society,—

if the application for the patent is made by the true and first inventor or a person deriving title from him not later than 6 months after the opening of the exhibition or the reading or publication of the paper, as the case may be.

(3) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that, at any time within one year before the priority date of the relevant claim of the specification, the invention was publicly worked in New Zealand—

- (a) By the patentee or applicant for the patent or any person from whom he derives title; or
- (b) By any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title,—

if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

(4) Notwithstanding anything in this Act, the Commissioner shall not refuse to accept a complete specification or to grant a patent, and a patent shall not be revoked or

invalidated, by reason only of any circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

Cf. Patents Act 1949, s. 51 (U.K.); 1921–22, No. 18, ss. 33 (5), 50

In subs. (2) (a) words were omitted by s. 5 (3) of the Shop Trading Hours Amendment Act 1980.

61. Use and publication after provisional specification or foreign application—(1) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or by a specification treated by virtue of a direction under subsection (4) of section 9 of this Act as a provisional specification, then, notwithstanding anything in this Act, the Commissioner shall not refuse to grant the patent, and the patent shall not be revoked or invalidated by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used or published at any time after the date of filing of that specification.

(2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything in this Act, the Commissioner shall not refuse to grant the patent, and the patent shall not be revoked or invalidated by reason only that any matter disclosed in any application for protection in a convention country upon which the convention application is founded was used or published at any time after the date of that application for protection.

Cf. Patents Act 1949, s. 52 (U.K.); 1939, No. 26, ss. 55 (6), 56

62. Priority date in case of obtaining—Where an application is made for a patent for an invention which has been claimed in a complete specification filed in pursuance of any other such application, then, if—

- (a) The Commissioner has refused to grant a patent in pursuance of that other application on the ground specified in paragraph (a) of subsection (1) of section 21 of this Act; or
- (b) A patent granted in pursuance of that other application has been revoked by the Court or the Commissioner on the ground specified in paragraph (a) of subsection (1) of section 21 or paragraph (c) of subsection (1) of section 41 of this Act; or

- (c) The complete specification filed in pursuance of the said other application has, in proceedings under section 21 or section 42 of this Act, been amended by the exclusion of the claim relating to the said invention in consequence of a finding by the Commissioner that the invention was obtained by the applicant or patentee from any other person,—

the Commissioner may direct that the first-mentioned application and any specification filed in pursuance thereof shall be deemed, for the purposes of the provisions of this Act relating to the priority date of claims of complete specifications, to have been filed on the date on which the corresponding document was or was deemed to have been filed in the proceedings upon the said other application.

Cf. Patents Act 1949, s. 53 (U.K.); 1921–22, No. 18, s. 17

Miscellaneous Provisions as to Rights in Inventions

63. Co-ownership of patents—(1) Where after the commencement of this Act a patent is granted to 2 or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions of this section and section 64 of this Act, where 2 or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to make, use, exercise, and vend the patented invention for his own benefit without accounting to the other or others.

(3) Subject to the provisions of section 64 of this Act, and to any agreement for the time being in force, a licence under a patent shall not be granted, and a share in a patent shall not be assigned, except with the consent of all persons, other than licensor or assignor, who are registered as grantee or proprietor of the patent.

(4) Where an article is sold by one of 2 or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with it in the same manner as if the article has been sold by a sole patentee.

(5) Subject to the provisions of this section, the rules of law applicable to the ownership and devolution of personal property, generally shall apply in relation to patents as they apply in relation to other choses in action; and nothing in subsection (1) or subsection (2) of this section shall affect the

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mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

Cf. Patents Act 1949, s. 54 (U.K.); 1921–22, No. 18, s. 42; 1939, No. 26, s. 66

64. Power of Commissioner to give directions to co-owners—(1) Where 2 or more persons are registered as grantee or proprietor of a patent, the Commissioner may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent, or the exercise of any right under section 63 of this Act in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of the patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within 14 days after being requested in writing so to do by any of the other persons so registered, the Commissioner may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving directions in pursuance of an application under this section, the Commissioner shall give an opportunity to be heard,—

(a) In the case of an application under subsection (1) of this section, to the other person or persons registered as grantee or proprietor of the patent:

(b) In the case of an application under subsection (2) of this section, to the person in default.

(4) An appeal to the Court shall lie from any decision or direction of the Commissioner under this section.

(5) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

Cf. Patents Act 1949, s. 55 (U.K.); 1921–22, No. 18, s. 42; 1939, No. 26, s. 66

As to appeals to the Court of Appeal, see ss. 97 (4) (a) and 98 (b).

65. Disputes as to inventions made by employees—

(1) Where a dispute arises between an employer and a person who is or was at the material time his employee as to the

rights of the parties in respect of an invention made by the employee either alone or jointly with other employees or in respect of any patent granted or to be granted in respect thereof, the Commissioner may, upon application made to him in the prescribed manner by either of the parties and after giving to each of them an opportunity to be heard, determine the matter in dispute, and may make such orders for giving effect to his decision as he considers expedient:

Provided that if it appears to the Commissioner upon any application under this section that the matter in dispute involves questions which would more properly be determined by the Court, he may decline to deal therewith.

(2) In proceedings before the Court between an employer and a person who is or was at the material time his employee, or upon application made to the Commissioner under subsection (1) of this section, the Court or Commissioner may, unless satisfied that one or other of the parties is entitled, to the exclusion of the other, to the benefit of an invention made by the employee, by order provide for the apportionment between them of the benefit of the invention, and of any patent granted or to be granted in respect thereof, in such manner as the Court or Commissioner considers just.

(3) A decision of the Commissioner under this section shall have the same effect as between the parties and persons claiming under them as a decision of the Court.

(4) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 56 (U.K.)

66. Avoidance of certain restrictive conditions—

(1) Subject to the provisions of this section, any condition of a contract for the sale or lease of a patented article or of an article made by a patented process or for licence to use or work a patented article or process, or relating to any such sale, lease, or licence, shall be void in so far as it purports—

- (a) To require the purchaser, lessee, or licensee to acquire from the vendor, lessor, or licensor, or his nominees, or prohibit him from acquiring from any specified person, or from acquiring except from the vendor, lessor, or licensor, or his nominees, any articles other than the patented article or an article made by the patented process:
- (b) To prohibit the purchaser, lessee, or licensee from using articles (whether patented or not) which are not supplied by, or any patented process which does not

belong to, the vendor, lessor, or licensor, or his nominees, or to restrict the right of the purchaser, lessee, or licensee to use any such articles or process.

(2) In proceedings against any person for infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff and containing a condition void by virtue of this section.

(3) A condition of a contract shall not be void by virtue of this section if—

(a) At the time of the making of the contract the vendor, lessor, or licensor was willing to sell or lease the article, or grant a licence to use or work the article or process, as the case may be, to the purchaser, lessee, or licensee, on reasonable terms specified in the contract and without any such condition as is mentioned in subsection (1) of this section; and

(b) The purchaser, lessee, or licensee is entitled under the contract to relieve himself of his liability to observe the condition upon giving to the other party 3 months' notice in writing and subject to payment to him of such compensation (being, in the case of a purchase a lump sum, and in the case of a lease or licence a rent or royalty for the residue of the term of the contract) as may be determined by an arbitrator appointed by the Minister.

(4) If in any proceeding it is alleged that any condition of a contract is void by virtue of this section, it shall lie on the vendor, lessor, or licensor to prove the matters set out in paragraph (a) of subsection (3) of this section.

(5) A condition of a contract shall not be void by virtue of this section by reason only that it prohibits any person from selling goods other than those supplied by a specified person, or, in the case of a contract for the lease of or licence to use a patented article, that it reserves to the lessor or licensor or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

Cf. Patents Act 1949, s. 57 (U.K.); 1921–22, No. 18, s. 43

67. Determination of certain contracts—(1) Any contract for the sale or lease of a patented article or for licence to manufacture, use, or work a patented article or process, or relating to any such sale, lease, or licence, whether made before or after the commencement of this Act, may at any

time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or in any other contract, be determined by either party on giving 3 months' notice in writing to the other party.

(2) The provisions of this section shall be without prejudice to any right of determining a contract exercisable apart from this section.

Cf. Patents Act 1949, s. 58 (U.K.); 1921–22, No. 18, s. 43 (3)

Proceedings for Infringement, etc.

68. Restrictions on recovery of damages for infringement—(1) In proceedings for the infringement of a patent, damages or account of profits shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the patent existed; and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the application to an article of the word “patent”, “patented”, or any word or words expressing or implying that a patent has been obtained for the article, unless the word or words are accompanied by the words “New Zealand” or the letters “N.Z.” and by the number of the patent.

(2) In any proceeding for infringement of a patent the Court may, if it thinks fit, refuse to award any damages in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.

(3) Where an amendment of a specification by way of disclaimer, correction, or explanation has been allowed under this Act after the publication of the specification, no damages shall be awarded in any proceeding in respect of the use of the invention before the date of the decision allowing the amendment, unless the Court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

(4) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of a patent.

Cf. Patents Act 1949, s. 59 (U.K.); 1921–22, No. 18, ss. 25, 38

69. Order for account in action for infringement—In an action for infringement of a patent the plaintiff shall be entitled, at his option, to an account of profits instead of damages.

Cf. Patents Act 1949, s. 60 (U.K.); 1921–22, No. 18, s. 39

70. Counterclaim for revocation in action for infringement—A defendant in an action for infringement of a patent may, without obtaining the consent of the Attorney-General under paragraph (b) of subsection (3) of section 41 of this Act, apply in accordance with rules of Court by way of counterclaim in the action for revocation of the patent.

Cf. Patents Act 1949, s. 61 (U.K.); 1921–22, No. 18, s. 36; 1939, No. 26, s. 64 (1)

71. Relief for infringement of partially valid specification—(1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the Court may grant relief in respect of any valid claim which is infringed:

Provided that the Court shall not grant relief by way of damages, or account of profits, or costs except in the circumstances mentioned in subsection (2) of this section.

(2) Where the patent is dated before the 1st day of January 1940, or the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the Court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the Court as to costs and as to the date from which damages should be reckoned.

(3) As a condition of relief under subsection (1) or subsection (2) of this section the Court may direct that the specification shall be amended to its satisfaction upon an application made for that purpose under section 39 of this Act, and such an application may be made accordingly whether or not all other issues in the proceedings have been determined.

(4) In relation to a patent which is dated before the 1st day of January 1940, the provisions of this section shall have effect notwithstanding anything in subsection (3) of section 68 of this Act.

Cf. Patents Act 1949, s. 62 (U.K.); 1939, No. 26, s. 64 (2), (3)

72. Proceedings for infringement by exclusive licensee—(1) Subject to the provisions of this section and of section 85 of this Act, the holder of an exclusive licence under a patent shall have the like right as the patentee to take proceedings in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or granting any other relief in any such proceedings, the Court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(2) In any proceedings taken by the holder of an exclusive licence by virtue of this section, the patentee shall, unless he is joined as plaintiff in the proceedings, be added as defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he defends the proceedings.

Cf. Patents Act 1949, s. 63 (U.K.)

73. Certificate of contested validity of specification—(1) If in any proceedings before the Court the validity of any claim of a specification is contested, and that claim is found by the Court to be valid, the Court may certify that the validity of that claim was contested in those proceedings.

(2) Where any such certificate has been granted, then, if in any subsequent proceedings before the Court for infringement of the patent or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent, that party shall, unless the Court otherwise directs, be entitled to his costs as between solicitor and client so far as concerns the claim in respect of which the certificate was granted:

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

Cf. Patents Act 1949, s. 64 (U.K.); 1921–22, No. 18, s. 40

74. Remedy for groundless threats of infringement proceedings—(1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) by circulars, advertisements, or otherwise threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby may bring action against him for any such relief as is mentioned in subsection (2) of this section.

(2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say:

- (a) A declaration to the effect that the threats are unjustifiable; and
- (b) An injunction against the continuance of the threats; and
- (c) Such damages, if any, as he has sustained thereby.

(3) For the avoidance of doubt it is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

(4) It is hereby declared that a notice given under section 85 of this Act does not constitute a threat of proceedings within the meaning of this section.

Cf. Patents Act 1949, s. 65 (U.K.); 1939, No. 26, s. 65

75. Power of Court to make declaration as to non-infringement—(1) A declaration that the use by any person of any process, or the making or use or sale by any person of any article, does not or would not constitute an infringement of a claim of a patent may be made by the Court in proceedings between that person and the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or licensee, if it is shown—

- (a) That the plaintiff has applied in writing to the patentee or licensee for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the process or article in question; and
- (b) That the plaintiff has undertaken to pay a reasonable sum for expenses of the patentee or licensee in obtaining advice in respect of the declaration sought; and
- (c) That the patentee or licensee has refused or neglected to give such an acknowledgment.

(2) The costs of all parties in proceedings for a declaration brought by virtue of this section shall be in the discretion of the Court.

(3) The validity of a claim of the specification of a patent shall not be called in question in proceedings for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid.

(4) Proceedings for a declaration may be brought by virtue of this section at any time after the date of the publication of the complete specification in pursuance of an application for a patent, and references in this section to the patentee shall be construed accordingly.

Cf. Patents Act 1949, s. 66 (U.K.)

76. Attorney-General may appear in patent proceedings—(1) The Attorney-General, if in his opinion the public interest is or may be involved, may do all or any of the following things:

- (a) Institute proceedings to test the validity of any patent:
- (b) Join the plaintiff in an action brought under section 74 of this Act:
- (c) Apply for the revocation of a patent:
- (d) Appear and be heard in any proceedings before the Court or the Commissioner for the grant, extension, amendment, or revocation of a patent, or where the validity of a patent is in question, or for a licence under a patent, or for the endorsement of a patent with the words “licences of right”, or for a declaration of non-infringement, and take any steps which he considers desirable as if he were a party to the proceedings:
- (e) Intervene in and take over the control and conduct of any proceedings in which he may appear and be heard as aforesaid on behalf and with the consent of a party thereto.

(2) In any proceedings before the Court or the Commissioner (other than proceedings under section 16 of this Act) any party who intends to question the validity of a patent shall give notice of that intention to the Solicitor-General at least 21 days before the hearing, and shall supply the Solicitor-General with a copy of such papers filed in the proceedings by himself and by any other party as the Solicitor-General requires.

(3) In any proceedings in which the Attorney-General appears in accordance with this section, costs may be awarded either to or against the Attorney-General.

Cf. 1947, No. 37, s. 3

*International Agreements, etc.***77. Orders in Council as to convention countries—**

(1) The Governor-General may, with a view to the fulfilment of a treaty, convention, arrangement, or engagement, by Order in Council, declare that any country specified in the Order is a convention country for the purposes of this Act:

Provided that a declaration may be made as aforesaid for the purposes either of all or some only of the provisions of this Act, and a country in the case of which a declaration made for the purposes of some only of the provisions of this Act is in force shall be deemed to be a convention country for the purposes of those provisions only.

(2) For the purposes of subsection (1) of this section, every territory for whose international relations another country is responsible shall be deemed to be a country in the case of which a declaration may be made under that subsection.

Cf. Patents Act 1949, s. 68 (U.K.); 1939, No. 26, s. 54

See the Patents Designs, and Trade Marks Convention Order 1968 (S.R. 1968/207).

78. Supplementary provisions as to convention applications—(1) Where a person has applied for protection for an invention by an application which,—

(a) In accordance with the terms of a treaty subsisting between any 2 or more convention countries, is equivalent to an application duly made in any one of those convention countries; or

(b) In accordance with the law of any convention country, is equivalent to an application duly made in that convention country,—

he shall be deemed for the purposes of this Act to have applied in that convention country.

(2) For the purpose of this Act, matter shall be deemed to have been disclosed in an application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or in documents submitted by the applicant for protection in support of and at the same time as that application; but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the Patent Office with the convention application or within such period as may be prescribed after the filing of that application.

Cf. Patents Act 1949, s. 69 (U.K.); 1939, No. 26, s. 55

(4), (8)

79. Special provisions as to vessels, aircraft, and land vehicles—Where a vessel or aircraft registered in a convention country, or a land vehicle owned by a person ordinarily resident in such a country, comes into New Zealand (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention—

- (a) In the body of the vessel or in the machinery, tackle, apparatus, or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or
 - (b) In the construction or working of the aircraft or land vehicle or of the accessories thereof,—
- as the case may be.

Cf. Patents Act 1949, s. 70 (U.K.); 1939, No. 26, s. 68

See the Patents, Designs, and Trade Marks Convention Order 1968 (S.R. 1968/207).

80. Extension of time for certain convention applications—(1) If the Governor-General is satisfied that provision substantially equivalent to the provision to be made by or under this section has been or will be made under the law of any convention country, he may, by Order in Council, make regulations empowering the Commissioner to extend the time for making application under subsection (2) of section 7 of this Act for a patent for an invention in respect of which protection has been applied for in that country in any case where the period specified in the proviso to that subsection expires during a period prescribed by the regulations.

(2) Regulations made under this section—

- (a) May, where any agreement or arrangement has been made between Her Majesty's Government in New Zealand and the Government of the convention country for the supply or mutual exchange of information or articles, provide, either generally or in any class of case specified in the regulations, that an extension of time shall not be granted under this section unless the invention has been communicated in accordance with the agreement or arrangement:
- (b) May, either generally or in any class of case specified in the regulations, fix the maximum extension which may be granted under this section and provide for reducing the term of any patent granted on an application made by virtue of this section, and

- (notwithstanding anything in section 115 of this Act) vary the time for the payment of renewal fees in respect of such a patent and the amount of such fees:
- (c) May prescribe or allow any special procedure in connection with applications made by virtue of this section:
 - (d) May empower the Commissioner to extend, in relation to an application made by virtue of this section, the time limited by or under the foregoing provisions of this Act for doing any act, subject to such conditions, if any, as may be imposed by or under the regulations:
 - (e) May provide for securing that the rights conferred by a patent granted on an application made by virtue of this section shall be subject to such restrictions or conditions as may be specified by or under the regulations and in particular to restrictions and conditions for the protection of persons (including persons acting on behalf of Her Majesty) who, otherwise than as the result of a communication made in accordance with such an agreement or arrangement as is mentioned in paragraph (a) of this subsection, and before the date of the application in question or such later date as may be allowed by the regulations, may have made, used, exercised, or vended the invention or may have applied for a patent in respect thereof.

Cf. Patents Act 1949, s. 71 (U.K.); 1943, No. 6, s. 5; 1946, No. 32, s. 3

81. Protection of inventions communicated under international agreements—(1) Subject to the provisions of this section, the Governor-General may, by Order in Council, make regulations for securing that, where an invention has been communicated in accordance with an agreement or arrangement made between Her Majesty's Government in New Zealand and the Government of any other country for the supply or mutual exchange of information or articles,—

- (a) An application for a patent made by the person from whom the invention was communicated or his personal representative or assignee shall not be prejudiced, and a patent granted on such an application shall not be invalidated, by reason only that the invention has been communicated as aforesaid or that in consequence thereof—

(i) The invention has been published, made, used, exercised, or vended; or

(ii) An application for a patent has been made by any other person, or a patent has been granted on such an application:

(b) Any application for a patent made in consequence of such a communication as aforesaid may be refused and any patent granted on such an application may be revoked.

(2) Regulations made under subsection (1) of this section may provide that the publication, making, use, exercise, or vending of an invention, or the making of any application for a patent in respect thereof, shall, in such circumstances and subject to such conditions or exceptions as may be prescribed by the regulations, be presumed to have been in consequence of such a communication as is mentioned in that subsection.

(3) The powers of the Governor-General under this section, so far as they are exercisable for the benefit of persons from whom inventions have been communicated to Her Majesty's Government in New Zealand by the Government of any other country, shall only be exercised if and to the extent that the Governor-General is satisfied that substantially equivalent provisions has been or will be made under the law of that country for the benefit of persons for whom inventions have been communicated by Her Majesty's Government in New Zealand to the Government of that country.

(4) References in subsection (3) of this section to the communication of an invention to or by Her Majesty's Government in New Zealand or the Government of any other country shall be construed as including references to the communication of the invention by or to any person authorised in that behalf by the Government in question.

Cf. Patents Act 1949, s. 72 (U.K.); 1946, No. 32, s. 4

As to the meaning of the term "personal representative", see s. 2 (2).

82. Regulations under section 80 or section 81—Any regulations made under section 80 or section 81 of this Act, and any order made, direction given, or other action taken under the regulations by the Commissioner, may be made, given, or taken so as to have effect as respects things done or omitted to be done on or after such date, whether before or after the commencement of the regulations or of this Act, as may be specified in the regulations.

Cf. Patents Act 1949, s. 95 (2) (U.K.); 1943, No. 6, s. 7

Register of Patents, etc.

83. Register of patents—(1) There shall be kept at the Patent Office a register of patents, in which there shall be entered particulars of patents in force, of assignments and transmissions of patents and of licences under patents, and notice of all matters which are required by or under this Act to be entered in the register and of such other matters affecting the validity or proprietorship of patents as the Commissioner thinks fit.

(2) Subject to the provisions of this Act and to regulations made thereunder, on payment of the prescribed fee the register of patents shall, at all convenient times, be open to inspection by the public; and certified copies, sealed with the seal of the Patent Office, of any entry in the register shall be given to any person requiring them.

(3) The register of patents shall be prima facie evidence of any matters required or authorised by or under this Act to be entered therein.

(4) No notice of any trust, whether expressed, implied, or constructive, shall be entered in the register of patents, and the Commissioner shall not be affected by any such notice.

Cf. Patents Act 1949, s. 73 (U.K.); 1921–22, No. 18, ss. 31, 118, 119

84. Registration of assignments, etc.—(1) Where any person becomes entitled by assignment, transmission, or operation of law to a patent or to a share in a patent, or becomes entitled as mortgagee, licensee, or otherwise to any other interest in a patent, he shall apply to the Commissioner in the prescribed manner for the registration of his title as proprietor or co-proprietor, or, as the case may be, of notice of his interest, in the register of patents.

(2) Without prejudice to the provisions of subsection (1) of this section, an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent, or becoming entitled by virtue of a mortgage, licence, or other instrument to any other interest in a patent, may be made in the prescribed manner by the assignor, mortgagor, licensor, or other party to that instrument, as the case may be.

(3) Where application is made under this section for the registration of the title of any person, the Commissioner shall, upon proof of title to his satisfaction,—

(a) Where that person is entitled to a patent or a share in a patent, register him in the register of patents as

proprietor or co-proprietor of the patent, and enter in that register particulars of the instrument or event by which he derives title; or

- (b) Where that person is entitled to any other interest in the patent, enter in that register and on any patent produced to the Commissioner notice of his interest.

(4) Subject to the provisions of this Act relating to co-ownership of patents, and subject also to any rights vested in any other person of which notice is entered in the register of patents, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with the patent, and to give effectual receipts for any consideration for any such assignment, licence, or dealing:

Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other personal property.

(5) Regulations made under this Act may require the supply to the Commissioner for filing at the Patent Office of copies of such deeds, licences, and other documents as may be prescribed.

Cf. Patents Act 1949, s. 74 (U.K.); 1921–22, No. 18, s. 122

85. Limitation of proceedings—(1) Except where the Court (on application in that behalf) in any case otherwise authorises, no person shall bring any proceedings (other than criminal proceedings) in respect of any interest to which he may be entitled as owner, mortgagee, licensee, or otherwise in a patent unless—

- (a) In the case of an interest which is not registered under this Act at the time of the commencement of the proceedings and which is capable of being so registered,—

(i) He has by notice in writing given to the proposed defendant at least one month before the date of the commencement of the proceedings advised his intention to bring the proceedings and furnished an address for service in New Zealand; and

(ii) No notice under subsection (2) of this section requiring him to register the interest under this Act has been given to him within one month after he gave notice under subparagraph (i) of this paragraph; or

(b) In the case of an interest which is registered under this Act, the interest was so registered,—

(i) Before the right to commence proceedings was barred under this section; and

(ii) At least one month before the date of the commencement of the proceedings; or

(c) In the case of any other interest, he has, by notice in writing given to the proposed defendant at least one month before the date of the commencement of the proceedings, advised his intention to bring the proceedings.

(2) Where any person makes any claim, or threatens to bring or gives notice of his intention to bring any proceedings (other than criminal proceedings), against any other person in respect of any interest as owner, mortgagee, licensee, or otherwise in a patent, being an interest which is not registered under this Act and which is capable of being so registered, that other person may, at any time within one month thereafter by notice in writing given to the maker of the claim or threat or the giver of the notice of intention to bring the proceedings, require him to register under this Act the interest in respect of which the claim or threat is made or the notice of intention to bring the proceedings is given, and if he fails to do so within 6 months after the giving of the notice under this subsection he shall not thereafter be entitled to bring any proceedings in respect of the claim or interest against the person who has given the notice to register.

(3) Nothing in this section shall enable any person to bring any proceedings which are barred under the Limitation Act 1950, and nothing in section 33 of that Act shall exclude the operation of that Act in any case where proceedings may be barred under this section.

86. Commissioner may dispense with production of probate or letters of administration in certain cases—

(1) For the purposes of this section, unless the context otherwise requires,—

“Deceased proprietor” means a registered proprietor of any patent who has died, whether before or after the commencement of this Act; and includes any applicant for a patent who has died before it is granted, whether before or after the commencement of this Act; and also includes an inventor of any invention who has died before or after the commencement of this Act without making an application for a patent for the invention:

“Qualified person”, in relation to any deceased proprietor, means a person who satisfies the Commissioner—

(a) That he has obtained or is entitled to obtain probate of the will of the deceased proprietor or letters of administration in his estate in the place where the deceased proprietor was domiciled at his death, or that he is the personal representative of the deceased proprietor in that place:

(b) That probate of the will of the deceased proprietor or letters of administration in his estate have not been granted or resealed in New Zealand:

(c) That the Commissioner of Inland Revenue is satisfied that no [estate duty] will be payable in New Zealand in the estate of the deceased proprietor:

(d) That the interests of the creditors of the deceased proprietor, and of all persons beneficially interested under his will or on his intestacy, will be adequately safeguarded if the Commissioner of Patents registers the qualified person as the proprietor of the patent.

(2) Upon application in the prescribed manner and payment of the prescribed fees, the Commissioner in his discretion and without requiring the production of probate or letters of administration may;—

(a) Where the registered proprietor of any patent has died before or after the commencement of this Act, register any qualified person as the proprietor of the patent:

(b) Where an applicant for any patent has died before the grant of the patent (whether before or after the commencement of this Act), allow any qualified person to complete the application and may register that person as the proprietor of the patent, or may accept the consent of that person for the purposes of section 24 of this Act as if that person were the personal representative of the deceased applicant:

(c) Allow an application under section 9 of this Act to be made by and may grant a patent to any qualified person as if he were the personal representative of the deceased inventor.

(3) Every qualified person who is registered under this section as the proprietor of a patent shall hold it subject to all existing interests and equities affecting it.

(4) Nothing in [section 70 or in section 73 of the Administration Act 1969] shall be deemed to restrict the operation of this section.

Cf. 1947, No. 37, s. 5

In subs. (1) the reference to estate duty was substituted for a reference to death duty by s. 89 (7) of the Estate and Gift Duties Act 1955, in relation to the estates of persons dying after the commencement of that Act.

In subs. (4), ss. 70 and 73 of the Administration Act 1969, being the corresponding enactments in force at the date of this reprint, have been substituted for ss. 49 and 52 of the repealed Administration Act 1952.

S. 67 of the Administration Act 1969 provides that nothing in that Act is to affect the operation of this section.

87. Rectification of register of patents by Court—

(1) The Court may, on the application of any person aggrieved, order the register of patents to be rectified by the making of any entry therein or the variation or deletion of any entry therein.

(2) In proceedings under this section the Court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register of patents.

(3) Notice of any application to the Court under this section shall be given in the prescribed manner to the Commissioner, who shall be entitled to appear and be heard on the application, and shall appear if so directed by the Court.

(4) Any order made by the Court under this section shall direct that notice of the order shall be served on the Commissioner in the prescribed manner; and the Commissioner shall, on the receipt of the notice, rectify the register of patents accordingly.

Cf. Patents Act 1949, s. 75 (U.K.); 1921–22, No. 18, ss. 123, 141

88. Correction of errors—(1) Where a mistake exists in the register of patents, in any patent, or in any other document issued under this Act, by reason of an error or omission on the part of the Patent Office, the Commissioner may, in accordance with the provisions of this section, correct the mistake, and for that purpose may require the production of the patent or other document.

(2) Where the Commissioner proposes to make any such correction as aforesaid, he shall give notice of the proposal to the persons who appear to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(3) Where a mistake exists in the register of patents, in any patent or application for patent or any document filed in pursuance of such an application, or in proceedings in connection with any patent, by reason of an error or an omission on the part of the patentee or of the applicant for the patent or of any other person concerned, a correction may be made in accordance with the provisions of this section upon a request in writing by any person interested and payment of the prescribed fee. If it appears to the Commissioner that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons likely to be affected thereby, he shall require notice of the nature of the proposed correction to be advertised in the prescribed manner.

(4) Within the prescribed time after any such advertisement as aforesaid, any person interested may give notice to the Commissioner of opposition to the request, and where any such notice of opposition is given the Commissioner shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(5) An appeal to the Court shall lie from any decision of the Commissioner under this section.

Cf. Patents Act 1949, s. 76 (U.K.); 1921–22, No. 18, s. 121; 1946, No. 32, s. 7

89. Evidence of entries, documents, etc.—(1) A certificate sealed with the seal of the Patent Office and purporting to be signed by the Commissioner certifying that any entry which he is authorised by or under this Act to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence of the matters so certified.

(2) A copy of any entry in any register or of any document kept in the Patent Office or of any patent, or an extract from any such register or document, sealed with the seal of the Patent Office, and purporting to be certified by the Commissioner, shall be admitted in evidence without further proof and without production of the original.

(3) Where by this Act or otherwise by law the Commissioner is directed, authorised, or empowered to do, exercise, or perform any act, power, function, or duty, any notification in the *Journal* of the doing, exercise, or

performance of any such act, power, function or duty shall be prima facie evidence that it was lawfully done, exercised, or performed.

Cf. Patents Act 1949, s. 77 (U.K.); 1921–22, No. 18, ss. 130, 131; 1946, No. 32, s. 6 (3)

90. Requests for information as to patent or patent application—The Commissioner shall, on request made to him in the prescribed manner by any person and on payment of the prescribed fee, furnish the person making the request with such information relating to any patent or application for a patent as may be specified in the request, being information in respect of any such matters as may be prescribed.

Cf. Patents Act 1949, s. 78 (U.K.)

91. Restriction upon publication of specifications, etc.—(1) An application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Commissioner or be open to public inspection at any time before the date advertised in the *Journal* in pursuance of subsection (2) of section 20 of this Act:

Provided that nothing in this subsection shall preclude the Commissioner from publishing the date and number of an application and such details of the application and invention as are required to be given in the application form.

(2) The reports of examiners made under this Act shall not be open to public inspection or be published by the Commissioner; and such reports shall not be liable to production or inspection in any legal proceeding unless the Court or officer having power to order discovery in the proceeding certifies that the production or inspection is desirable in the interests of justice, and ought to be allowed:

Provided that the Commissioner may, on application made in the prescribed manner by any person, disclose the result of any search made under section 13 or section 14 of this Act or any information furnished under subparagraph (i) of paragraph (b) of section 15 of this Act in respect of any application for a patent where the complete specification has been published.

Cf. Patents Act 1949, s. 79 (U.K.); 1921–22, No. 18, ss. 11, 120; 1946, No. 32, s. 5

92. Loss or destruction of patent—Where the Commissioner is satisfied that a patent has been lost or destroyed or cannot be produced, he may at any time, on application made to him in the prescribed manner and on payment of the prescribed fee, cause a further patent to be sealed.

Cf. Patents Act 1949, s. 80 (U.K.); 1921–22, No. 18, s. 49

93. Commissioner may grant extension of time—

(1) Where by this Act anything is required to be done within a prescribed time, and by reason of delay in the Patent Office the thing is not so done, the Commissioner may extend the time for the doing of the thing.

(2) Where, having regard to the procedure specified and the information required under sections 12 to 16 of this Act or any regulations under those sections, the Commissioner is satisfied that the circumstances warrant an extension or extensions of the period specified in subsection (1) of section 19 of this Act, the Commissioner may extend the period prescribed therein for complying with any requirement imposed on the applicant by or under this Act; and the said subsection shall then be read as if the period so extended had been substituted for the period of 15 months therein mentioned.

(3) Where an extension of period has been allowed under subsection (2) of this section, the period so allowed shall be extended by the Commissioner to such further period not exceeding 3 months, as may be specified in a notice given by the applicant to the Commissioner, if the notice is given and the prescribed fee is paid before the expiration of the further period so specified.

(4) No fees shall be payable in respect of any extension of time granted under subsection (1) or subsection (2) of this section.

(5) The powers conferred on the Commissioner by this section may be exercised notwithstanding that in any case the time limited may have expired.

Cf. 1921–22, No. 18, s. 125

[93A. Additional provisions for extending time limits—(1) The Commissioner may extend—

- (a) The time prescribed in subsection (2) of section 7 of this Act for the filing of a convention application; or
- (b) The time prescribed in subsection (2) of section 9 of this Act for the filing of a complete specification—

on such terms (if any) as he thinks fit where he is satisfied that the circumstances warrant the extension.

(2) Where by this Act any thing is required to be done within a prescribed time, and by reason of failure of or delay in the delivery of mail by any postal official or postal carrier that thing is not done within such time, the Commissioner may extend the time for the doing of the thing on such terms (if any) as he thinks fit.

(3) Notwithstanding subsection (1) or subsection (2) of this section, the Commissioner shall refuse to grant an extension of time under that subsection if in his opinion—

- (a) The applicant or his agent has not allowed a reasonable margin of time for the delivery to the Patent Office, by post or otherwise, of any documents relating to the matter in respect of which the application for the extension of time is made; or
- (b) The applicant or his agent has in any other way failed to act with due diligence and prudence in respect of such manner; or
- (c) There has been undue delay in bringing the application for the extension of time or in prosecuting the application.

(4) Every extension of time granted under this section shall be advertised in the *Journal* in the prescribed manner.

(5) Where an application is made for an extension of time under this section by an agent on behalf of any applicant, the Commissioner may require as a condition of granting the application that written confirmation that the application is authorised shall be signed or executed by the applicant and lodged with the Commissioner within such time as the Commissioner specifies.

(6) Any extension of time under this section, and any requirement given or other action taken by the Commissioner under this section, may be granted, given, or taken so as to have effect in respect of things done or omitted to be done before the commencement of this section, as long as the application for the extension of time has been made before acceptance of the complete specification of the application for a patent in respect of which the application under this section has been made.

(7) The Governor-General may from time to time, by Order in Council, make regulations for all or any of the following purposes:

- (a) For the protection of persons who at any time in good faith have begun to avail themselves of any

invention that is the subject-matter of a matter in respect of which any application under this section is made:

- (b) Prescribing the evidence that the Commissioner may accept in support of applications under this section:
- (c) Prescribing the manner of advertising in the *Journal* extensions of time granted under this section:
- (d) Prescribing the grounds of opposition to applications under this section:
- (e) Regulating the procedure to be followed in relation to applications under this section and opposition to such applications:
- (f) Prescribing the fees to be paid in respect of applications under this section.]

This section was inserted by s. 2 of the Patents Amendment Act 1972.

Proceedings Before Commissioner

94. Exercise of discretionary powers of Commissioner—Without prejudice to any provisions of this Act requiring the Commissioner to hear any party to proceedings thereunder, or to give to any such party an opportunity to be heard, the Commissioner shall give to any applicant for a patent, or for amendment of a specification, an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Commissioner by or under this Act.

Cf. Patents Act 1949, s. 81 (U.K.); 1921–22, No. 18, s. 124

95. Costs and security for costs—(1) The Commissioner may, in any proceedings before him under this Act, by order award to any party such costs as he may consider reasonable, and direct how and by what parties they are to be paid; and any such order may be entered as a judgment of the court and with the leave of the Court may be enforced accordingly.

(2) If any party by whom notice of any opposition is given under this Act or by whom application is made to the Commissioner for the revocation of a patent or for the grant of a licence under a patent or for the determination of a dispute as to an invention under section 65 of this Act, or by whom notice of appeal is given from any decision of the Commissioner under this Act, neither resides nor carries on business in New Zealand, the Commissioner, or in the case of appeal, the Court, may require him to give security for the

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costs of the proceedings or appeal, and in default of such security being given may treat the opposition, application, or appeal as abandoned.

Cf. Patents Act 1949, s. 82 (U.K.); 1921–22, No. 18 ss. 45, 127

96. Evidence before Commissioner—(1) Subject to regulations made under this Act the evidence to be given in any proceedings before the Commissioner under this Act may be given by affidavit or statutory declaration; but the Commissioner may if he thinks fit in any particular case take oral evidence instead of or in addition to such evidence as aforesaid, and may allow any witness to be cross-examined on his affidavit or declaration. Any such statutory declaration may, in the event of an appeal under this Act, be used before the Court instead of evidence by affidavit, and when so used shall have all the incidents and consequences of evidence by affidavit.

(2) In any proceedings under this Act before the Commissioner, he may administer oaths to any witness, and may in the prescribed manner require the attendance of any witness and discovery and production of documents.

(3) Any evidence given on oath before the Commissioner shall be deemed to be given in a judicial proceeding for the purposes of [sections 108 and 109 of the Crimes Act 1961].

(4) [Section 111 of the Crimes Act 1961] shall apply to every affidavit and statutory declaration made for the purposes of this Act.

(5) The Governor-General may from time to time, by Order in Council, make regulations—

- (a) Prescribing the manner in which statutory declarations in respect of proceedings under this Act may be made and subscribed:
- (b) Prescribing the manner in which witnesses may be required to attend and to give evidence in any proceedings before the Commissioner:
- (c) Making provision for the payment of the expenses of witnesses:
- (d) Imposing fines not exceeding [\$40] for failure or refusal of any person so to attend and give evidence.

Cf. Patents Act 1949, s. 83 (U.K.); 1921–22, No. 18, s. 129

In subs. (3), ss. 108 and 109, and in subs. (4), s. 111 of the Crimes Act 1961, being the corresponding enactments in force at the date of this reprint, have been substituted for ss. 130 and 131, and s. 133 of the repealed Crimes Act 1908.

As to the application of this section to the Commissioner of Designs, see s. 39 (2) of the Designs Act 1953.

Appeals

97. Appeals to High Court—(1) Every appeal under this Act against a decision of the Commissioner shall be to the [High Court].

(2) Notice of every such appeal shall be filed in the Court . . . within 28 days after the day on which the decision appealed against was given.

(3) In any such appeal the Court shall have and may exercise the same discretionary powers as are conferred upon the Commissioner.

(4) Subject to the provisions of section 98 of this Act, the decision of the Court shall be final—

(a) On any appeal against a decision of the Commissioner:

(b) On any application under section 31 or section 32 of this Act.

Cf. 1921–22, No. 18, s. 140

In subs. (2) the words “and served upon the Commissioner” were omitted by s. 3 of the Patents Amendment Act 1976.

98. Appeals to Court of Appeal—An appeal shall lie to the Court of Appeal—

(a) From any decision of the Court on an appeal under section 42 or section 50 of this Act, where the effect of the decision is the revocation of a patent:

(b) From any decision of the Court under section 64 of this Act:

(c) With the leave of the [High Court] or of the Court of Appeal, from any decision of the [High Court] on any appeal against a decision of the Commissioner or on application under section 31 or section 32 of this Act.

Cf. Patents Act 1949, s. 87 (U.K.)

99. Costs of Commissioner in proceedings before Court—In all proceedings before the Court under this Act the costs of the Commissioner shall be in the discretion of the Court.

Cf. 1921–22, No. 18, s. 142

Patent Attorneys

100. Registration of patent attorneys—(1) There shall be kept at the Patent Office a register of patent attorneys.

(2) The Commissioner may register as a patent attorney any person who,—

- (a) Is a British subject or a citizen of the Republic of Ireland; and
- (b) Is not less than 21 years of age; and
- (c) Has passed all the subjects of the prescribed examination; and
- (d) If so required by regulations made under this Act, has been employed for the period specified in the regulations in the manner specified in the regulations; and
- (e) Possesses such other qualifications as may be prescribed.

(3) Regulations made under this Act may provide for the appointment of a person or persons to conduct the examinations referred to in subsection (2) of this section.

(4) Every person who was registered as a patent agent under the Patent, Designs, and Trade Marks Act 1921–22 immediately before the commencement of this Act shall be deemed to be registered as a patent attorney under this Act.

Cf 1921–22, No. 18, s. 135

101. Powers of patent attorneys—(1) A patent attorney—

- (a) Shall be entitled to prepare all documents, transact all business, and conduct all proceedings for the purposes of this Act; and
- (b) Shall have such other rights and privileges as may be prescribed.

(2) Nothing in this section shall authorise a patent attorney to transact business or conduct proceedings in a Court.

(3) A patent attorney shall not be guilty of an offence against [section 18 of the Law Practitioners Act 1955] by reason only of the preparation by him of any document for use in proceedings under this Act before the Commissioner.

Cf. Patents Act 1949, s. 88 (5) (U.K.)

In subs. (3), s. 18 of the Law Practitioners Act 1955, being the corresponding enactment in force at the date of this reprint, has been substituted for s. 40 of the repealed Law Practitioners Act 1931.

102. Cancellation of registration of patent attorneys—

(1) The Court, on application made by the Commissioner or by the New Zealand Institute of Patent Attorneys Incorporated with the leave in writing of the Attorney-General, may order the removal from the register of patent attorneys of the name of any patent attorney or the suspension from practice before the Patent Office of any patent attorney who—

- (a) Is convicted of a crime involving dishonesty [within the meaning of section 2 of the Crimes Act 1961]; or
- (b) Has been guilty of misconduct in his professional capacity and by reason thereof is not a fit and proper person to practise as a patent attorney; or
- (c) Has otherwise been guilty of grave impropriety or infamous conduct and by reason thereof is not a fit and proper person to practise as a patent attorney.

(2) The Commissioner and the New Zealand Institute of Patent Attorneys Incorporated shall be entitled to appear and be heard on any such application.

(3) No person whose name has been removed from the register of patent attorneys under this section shall be again entered thereon except by direction of the Court.

In subs. (1) (a) the words in square brackets were substituted for the words "as defined by section 237 of the Crimes Act 1908" by s. 411 (1) of the Crimes Act 1961.

103. Restrictions on practice as patent attorney—

(1) No person either alone or in partnership shall carry on business, practise, act, describe himself or hold himself out, or permit himself to be described or held out, as a patent attorney or patent agent unless he is registered as a patent attorney, or, as the case may be, unless he and all his partners are so registered.

(2) No company shall carry on business, practise, act, describe itself or hold itself out, or permit itself to be described or held out, as a patent attorney or patent agent:

Provided that this subsection shall not apply in the case of any company which was immediately before the commencement of this Act carrying on business as a patent attorney during any period or periods while a manager or director of the company is registered as a patent attorney.

(3) For the purposes of this section a person who or a company which undertakes for gain in New Zealand—

- (a) To apply for or obtain patents in New Zealand or elsewhere; or
- (b) To prepare specifications or other documents for the purposes of this Act or of the patent law of any country; or
- (c) To give advice other than of a scientific or technical nature as to the validity of patents or their infringement—

shall be deemed to carry on business as a patent attorney.

(4) Any person who or company which fails to comply with or acts in contravention of the provisions of this section

commits an offence, and shall be liable on summary conviction to a fine not exceeding [S200].

(5) Nothing in this section shall be construed as prohibiting barristers or solicitors of the [High Court] of New Zealand from giving professional advice or taking such part in proceedings under this Act as has heretofore been taken by them.

(6) Nothing in this section shall prevent the personal representative of a deceased patent attorney from carrying on the business or practice of the deceased patent attorney for a period not exceeding 3 years from the date of the death of the patent attorney, or for such further period (if any) as the Court may allow, if the personal representative is himself registered as a patent attorney or employs a person who is registered as a patent attorney to manage the business or practice.

Cf. 1921–22, No. 18, s. 135

104. Recovery of patent attorney's charges—(1) No patent attorney shall commence or maintain any action for the recovery of any fees, charges, or disbursements paid or incurred or made by him for any business done by him as a patent attorney until the expiration of 7 days after a bill of the fees, charges and disbursements, signed by him (or, in the case of a partnership, by any of the partners with the name of the partnership), or enclosed in or accompanied by a letter signed in like manner referring to the bill, has been delivered to the party chargeable.

(2) The delivery may be effected either by personal delivery to the party chargeable or by leaving the bill or letter for him at his place of business, or dwellinghouse, or last known place of abode, or by forwarding it to him by post in a registered letter addressed to him as aforesaid. Where it is forwarded by post as aforesaid, it shall be deemed to have been delivered at the time at which the letter would have been delivered in the ordinary course of post.

Cf. 1921–22, No. 18, s. 137

Offences

105. Falsification of register, etc.—Every person who makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing,

knowing the entry or writing to be false, commits an offence, and shall be liable on conviction on indictment to imprisonment for any term not exceeding 2 years.

Cf. Patents Act 1949, s. 90 (U.K.); 1921–22, No. 18, s. 143

As to the summary jurisdiction of a District Court Judge under this section, see s. 6 of the Summary Proceedings Act 1957.

106. Unauthorised claim of patent rights—(1) Every person who falsely represents that he or another person is the patentee of an invention or that he or another person has applied for a patent for an invention commits an offence and shall be liable on summary conviction to a fine not exceeding **[\$200]**.

(2) Every person who falsely represents that an article sold by him is patented in New Zealand or is the subject of an application for a patent in New Zealand commits an offence and shall be liable on summary conviction to a fine not exceeding **[\$100]**.

(3) For the purposes of this section—

(a) A person shall be deemed to represent that an article is patented in New Zealand if there is stamped, engraved, or impressed on, or otherwise applied to, the article the word “patent” or “patented”, the words “provisional patent”, or some other word or words expressing or implying that a patent for the article has been obtained in New Zealand; and

(b) A person shall be deemed to represent that an article is the subject of an application for a patent in New Zealand if there are stamped, engraved, or impressed on or otherwise applied to the article the words “patent applied for” or “patent pending” or some other word or words implying that an application for a patent for the article has been made in New Zealand:

Provided that it shall be sufficient defence to any prosecution under this subsection to show that the article was patented or was the subject of an application for a patent at the time when and in the country where the words were stamped, engraved, or impressed on or otherwise applied to it.

(4) Every person who uses on his place of business or on any document issued by him or otherwise the words “Patent Office”, or any other words suggesting that his place of

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business is or is officially connected with the Patent Office, commits an offence and shall be liable on summary conviction to a fine not exceeding **[\$100]**.

Cf. Patents Act 1949, s. 91 (U.K.); 1921–22, No. 18, s. 143

[107. Protection of Royal Arms, etc.]—The grant of a patent under this Act shall not in itself authorise the patentee to use or place on any patented article any representation specified in sections 12 to 15 of the Flags, Emblems, and Names Protection Act 1981.]

This section was substituted for the original s. 107 by s. 27 (1) of the Flags, Emblems, and Names Protection Act 1981.

108. Offences by companies—Where an offence against section 25, section 26, section 103, or section 105 of this Act is committed by a body corporate, every person who at the time of the commission of the offence is a director, general manager, secretary, or other similar officer of the body corporate, or is purporting to act in any such capacity, shall be deemed to be guilty of that offence unless he proves that the offence was committed without his consent or connivance and that he exercised all such diligence to prevent the commission of the offence as he ought to have exercised having regard to the nature of his functions in that capacity and to all the circumstances.

Cf. Patents Act 1949, s. 93 (U.K.)

109. *Repealed by s. 214 (1) of the Summary Proceedings Act 1957.*

Miscellaneous

110. Service of notices, etc., by post—(1) Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made, or filed by sending it by post in a letter addressed to the person concerned at his usual or last known address.

(2) Where any notice is sent by the Commissioner to any person by post as aforesaid the notice shall be deemed to have been given at the time when the letter containing it would have been delivered in the ordinary course of post.

Cf. Patents Act 1949, s. 97 (U.K.); 1921–22, No. 18, s. 132

111. Declaration by person under disability—(1) If any person is incapable of making any declaration, or doing anything required or permitted by or under this Act because he is not of full age and capacity, the guardian, committee, or statutory administrator (if any) of the person subject to the disability, or (if there is none) any person appointed by any Court possessing jurisdiction in respect of his property, may make that declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do that thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the Court for the purposes of this section upon the application of any person acting on behalf of the person subject to the disability, or of any other person interested in the making of the declaration or the doing of the thing.

Cf. 1921–22, No. 18, s. 134

112. Journal, indexes, etc.—(1) The Commissioner shall issue periodically a journal to be called the *Patent Office Journal*, and, subject to the provisions of subsection (1) of section 91 of this Act, shall publish therein all such particulars of applications for patents (whether filed before or after the commencement of this Act) as are prescribed by regulations made under this Act and all such other matters as are directed by this Act or otherwise by law to be published therein and such other matters and information as may appear to him to be useful or important to proprietors of patents registered or subsisting in New Zealand.

(2) The Commissioner may prepare and publish in such form as he deems expedient indexes, specifications, abridgments of specifications, catalogues, and other works relating to inventions and patents as he thinks fit.

(3) The Commissioner may maintain and revise from time to time a classification by subject-matter of specifications filed in New Zealand and open to public inspection and of such printed publications relating to patents published in New Zealand as may be necessary or useful for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patents are filed.

Cf. 1946, No. 32, s. 6

113. Rules of Court—(1) Rules regulating the practice and procedure of the Court in proceedings under this Act may be made in accordance with the provisions of section 3 of the

Judicature Amendment Act 1930. Subject thereto, such proceedings shall be taken in accordance with the practice and procedure of the Court in like cases.

(2) Any such rules may make provision for the appointment of scientific advisers to assist the Court in proceedings for infringement of patents and in proceedings under this Act and for regulating the functions and remuneration of those advisers.

(3) Any action for infringement of a patent shall be tried without a jury, unless the Court otherwise directs.

Cf. Patents Act 1949, s. 84 (U.K.); 1921–22, No. 18, s. 139

114. Regulations—(1) Subject to the provisions of this Act, the Governor-General may from time to time, by Order in Council, make all such regulations as may in his opinion be necessary or expedient for giving effect to the provisions of this Act and for the due administration thereof.

(2) Without limiting the general power conferred by subsection (1) of this section, it is hereby declared that regulations may be made under this section for all or any of the following purposes:

- (a) For regulating the business of the Patent Office in relation to patents:
- (b) For regulating all matters by this Act placed under the direction or control of the Commissioner:
- (c) For prescribing the form and manner of execution of applications for patents and of any specifications, drawings, or other documents which may be filed at the Patent Office, and for requiring copies to be furnished of any such documents:
- (d) For regulating the procedure to be followed in connection with any application or request to the Commissioner or in connection with any proceeding before the Commissioner and for authorising the rectification of irregularities of procedure:
- (e) For regulating the keeping of the register of patent attorneys:
- (f) For regulating the registration of patent attorneys, and for prescribing the terms and conditions of their registration:
- (g) For regulating the procedure for removing the names of patent attorneys from the register of patent attorneys and for suspending patent attorneys from practice before the Patent Office:

- (h) Prescribing classes of persons whom the Commissioner may refuse to recognise as agents in respect of proceedings under this Act:
- (i) For authorising the preparation, publication, sale, and exchange of copies of specifications, drawings, and other documents in the Patent Office and of indexes to and abridgments of them:
- (j) For prescribing the mode of advertising any matter which by this Act is required to be advertised:
- (k) For prescribing anything authorised or required by this Act to be prescribed by regulations.

(3) All regulations made under this Act shall be laid before Parliament within 28 days after the date of the making thereof if Parliament is then in session, and, if not, shall be laid before Parliament within 28 days after the date of the commencement of the next ensuing session.

Cf. Patents Act 1949, s. 94 (U.K.); 1921–22, No. 18, s. 138

In subs. (2) (h) the word “Commissioner” has been substituted for the word “Commission” in order to correct an obvious error.

115. Fees—(1) Subject to the provisions of this Act, there shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters relating to patents arising under this Act, such fees as may be from time to time prescribed by regulations made under this Act, and all such fees shall be paid into the Public Account to the credit of the [Consolidated Account].

(2) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by the regulations made under this Act, may be refunded by the commissioner, and all money so refunded shall be paid out of the [Consolidated Account] without further appropriation than this Act.

Cf. Patents Act 1949, s. 99 (U.K.); 1921–22, No. 18, s. 117

In subss. (1) and (2) the reference to the Consolidated Account was by s. 114 (6) of the Public Finance Act 1977 substituted for a reference to the Consolidated Revenue Account (as substituted by s. 4 (4) of the Public Revenues Amendment Act 1963 for a reference to the Consolidated Fund).

116. Annual report of Commissioner—(1) The Commissioner shall, during the month of April in every year, furnish to the Minister a report with respect to the operation of this Act, and every such report shall include an account of all fees, salaries, allowances, and other money received and paid under this Act during the previous year.

(2) A copy of the report shall be laid before Parliament within 28 days after the date on which it is furnished to the Minister if Parliament is then in session, and, if not, shall be laid before Parliament within 28 days after the date of the commencement of the next ensuing session.

Cf. Patents Act 1949, s. 100 (U.K.); 1921–22, No. 18, s. 128

As to the extension of the report to the operation of the Designs Act 1953, see s. 49 of that Act; and as to its extension to the operation of the Trade Marks Act 1953, see s. 83 of that Act.

117. Saving for Royal prerogative, etc.—(1) Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of letters patent or to the withholding of a grant thereof.

(2) Nothing in this Act shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use articles forfeited under the laws relating to Customs or excise.

Cf. Patents Act 1949, s. 102 (U.K.); 1921–22, No. 18, ss. 32 (4), 145

118. Application of Act to Tokelau—This Act shall be in force in [Tokelau].

The reference to Tokelau was substituted for a reference to the Tokelau Islands by s. 3 (8) of the Tokelau Amendment Act 1976. See s. 6 of the Tokelau Act 1948.

This Act is in force in Niue; see s. 698 of the Niue Act 1966.

This Act is in force in the Cook Islands; see s. 635 of the Cook Islands Act 1915.

119. Repeals and savings—(1) The enactments specified in the First Schedule to this Act are hereby repealed.

(2) The regulations specified in the Second Schedule to this Act are hereby revoked.

(3) Without limiting the provisions of the Acts Interpretation Act 1924, it is hereby declared that—

(a) The repeal or revocation of any provision by this Act shall not affect any document made or any thing whatsoever done under the provision so repealed or revoked or under any corresponding former provision, and every such document or thing, so far as it is subsisting or in force at the time of the repeal or revocation and could have been made or done under this Act, shall continue and have effect as if it had been made or done under the corresponding provision of this Act and as if that provision had been in force when the document was made or the thing was done:

- (b) The transitional provisions set out in the Third Schedule to this Act shall have effect for the purposes of the transition to the provisions of this Act from the law in force before the commencement of this Act.

Cf. Patents Act 1949, s. 106 (U.K.)

SCHEDULES

FIRST SCHEDULE

Section 119 (1)

ENACTMENTS REPEALED

- 1908, No. 140—The Patents, Designs, and Trade Marks Act 1908: The definition of the expression “true and first inventor” in section 2.
- 1921–22, No. 18—The Patents, Designs, and Trade Marks Act 1921–22: Part I; and Part IV in its application to patents. (1931 Reprint, Vol. VI, p. 656.)
- 1924, No. 40—The Patents, Designs, and Trade Marks Amendment Act 1924. (1931 Reprint, Vol. VI, p. 736.)
- 1929, No. 14—The Patents, Designs, and Trade Marks Amendment Act 1929. (1931 Reprint, Vol. VI, p. 738.)
- 1939, No. 26—The Patents, Designs, and Trade Marks Amendment Act 1939: Sections 53, 54, 55, and 71 in their application to patents; and sections 56 to 68 and 72 and 73.
- 1943, No. 6.—The Patents, Designs, and Trade Marks Amendment Act 1943: Sections 5 and 7 in their application to patents; and sections 2 to 4.
- 1946, No. 32—The Patents, Designs, and Trade Marks Amendment Act 1946: Sections 3, 4, 6, and 7 in their application to patents; and sections 2 and 5.
- 1947, No. 37—The Patents, Designs, and Trade Marks Amendment Act 1947: Section 5 in its application to patents; and sections 3, 4, and 6.
- 1947, No. 66—The Emergency Regulations Continuance Act 1947: So much of the Second Schedule as relates to the Patents, Designs, Trade Marks, and Copyright Emergency Regulations 1940 and Amendment No. 1 thereof.
- 1953, No. 54—The Stamp Duties Amendment Act 1953: So much of the Schedule as relates to the Patents, Designs, and Trade Marks Act 1921–22.
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Section 119 (2)

SECOND SCHEDULE**REGULATIONS REVOKED**

	Title				Serial Number
The Patents, Designs, Trade Marks, and Copyright Emergency Regulations 1940	1940/60
Amendment No. 1	1943/91
Amendment No. 2	1947/198
Amendment No. 3	1948/43
Amendment No. 4	1948/118

Section 119

(3) (b)

THIRD SCHEDULE**TRANSITIONAL PROVISIONS**

1. Subject to the provisions of this Schedule, any Order in Council, regulation, order, requirement, certificate, notice, decision, direction, authorisation, consent, application, request, or thing made, issued, given, or done under any enactment repealed by this Act shall, if in force at the commencement of this Act, and so far as it could have been made, issued, given, or done under this Act, continue in force and have effect as if made, issued, given, or done under the corresponding enactment of this Act.

2. Section 11 of this Act shall apply in relation to a complete specification filed before the commencement of this Act as it applies to a complete specification filed after the commencement of this Act:

Provided that for the purposes of the said section 11 a claim of any such specification filed after a provisional specification shall be deemed to be fairly based on the matter disclosed in the provisional specification unless the claim is for a further invention or an invention different from that contained in the provisional specification.

3. Notwithstanding anything in subsection (2) of section 9 of this Act, a complete specification shall not be filed in pursuance of an application which, by virtue of section 7 of the Patents, Designs, and Trade Marks Act 1921–22 was deemed to be abandoned at any time before the commencement of this Act.

4. Where a complete specification has been filed before the commencement of this Act but has not been accepted, then, in relation to matters arising before the acceptance or refusal of acceptance of the complete specification, the provisions of this Act shall not apply, but the provisions of the Patents, Designs, and Trade Marks Act 1921–22 shall continue to apply, notwithstanding the repeal thereof.

5. The provisions of sections 21 and 42 of this Act relating to the grounds on which the grant of a patent may be opposed or on which a patent may be revoked by the Commissioner shall not apply in any case where the complete specification was accepted before the commencement of this Act, but the provisions of the Patents, Designs, and Trade Marks Act 1921–22, relating to those matters shall continue to apply in any such case notwithstanding the repeal thereof.

6. The power of the Commissioner under section 22 of this Act to refuse the grant of a patent unless the complete specification is amended to his satisfaction shall not be exercisable in relation to any complete specification which was accepted before the commencement of this Act.

THIRD SCHEDULE—*continued*

7. The provisions of section 62 of this Act shall apply in relation to any application for a patent made before the commencement of this Act as they apply in relation to such an application made after the commencement of this Act.

8. Where, in relation to any invention, the time for giving notice to the Commissioner under section 50 of the Patents, Designs, and Trade Marks Act 1921–22 expired before the commencement of this Act and the notice was not given, subsections (2) and (4) of section 60 of this Act shall not apply in relation to that invention or any patent for that invention.

9. In relation to a complete specification which was accepted before the commencement of this Act, this Act shall have effect as if for the words “the date of the publication”, wherever those words occur, there were substituted the words “the date of the acceptance”.

10. Where a specification filed before the commencement of this Act has become open to public inspection, it shall continue to be open to public inspection notwithstanding anything in section 91 of this Act.

11. Where a specification which, before the commencement of this Act, has become open to public inspection under paragraph (a) of subsection (3) of section 144 of the Patents, Designs, and Trade Marks Act 1921–22, the proviso to subsection (7) of section 55 of the Patents, Designs, and Trade Marks Amendment Act 1939, or section 5 of the Patents, Designs, and Trade Marks Amendment Act 1946 has been amended before acceptance, nothing in subsection (2) of section 40 of this Act shall be construed as authorising reference to be made, in construing the specification, to the specification as it subsisted before acceptance.

12. Where 2 or more persons are registered as grantee or proprietor in respect of a patent which was granted or for which application was made before the commencement of this Act, the right of each of those persons to assign the whole or part of his interest in the patent shall not be restricted by reason only of the provisions of section 63 of this Act.

13. A condition of any contract in force immediately before the commencement of this Act shall not be invalidated by reason only of the provisions of section 66 of this Act.

14. Notwithstanding the repeal of section 44 of the Patents, Designs, and Trade Marks Act 1921–22, subsection (1A) of that section, as set out in section 67 of the Patents, Designs, and Trade Marks Act 1939, shall continue to apply in any case where the complete specification was filed before the commencement of this Act.

15. Subsections (1) and (3) of section 30 of this Act shall not apply to any patent granted before the commencement of this Act.

16. Subsection (1) of section 34 of this Act shall apply in relation to any application made before the commencement of this Act as it applies in relation to an application made after the commencement of this Act.

17. Section 35 of this Act shall have effect, in relation to a patent which has ceased to have effect before the commencement of this Act, as if for the reference to section 30 of this Act there were substituted a reference to section 19 of the Patents, Designs, and Trade Marks Act 1921–22.

18. Where the time allowed under section 59 of the Patents, Designs, and Trade Marks Amendment Act 1939 for the sealing of a patent has expired before the commencement of this Act and the patent has not been sealed, section 36 of this Act shall have effect in relation to the application

THIRD SCHEDULE—*continued*

for the patent as if for the reference to section 27 of this Act there were substituted a reference to section 59 of the Patents, Designs, and Trade Marks Amendment Act 1939.

19. Where the time allowed under section 72 of the Patents, Designs, and Trade Marks Amendment Act 1939 for the acceptance of a complete specification has expired before the commencement of this Act and the complete specification has not been accepted, section 37 of this Act shall have effect in relation to the application for the patent as if for every reference to section 19 or section 93 of this Act there were substituted a reference to section 72 of the Patents, Designs, and Trade Marks Amendment Act 1939.

20. In relation to any proceedings pending at the commencement of this Act the provisions of sections 39 and 71 of this Act shall not apply, but the provisions of section 24 of the Patents, Designs, and Trade Marks Act 1921–22 and of subsection (2) of section 64 of the Patents, Designs, and Trade Marks Amendment Act 1939 shall continue to apply notwithstanding the repeal of those enactments.

21. Section 72 of this Act shall not apply in relation to any infringement of a patent committed before the commencement of this Act.

22. Nothing in this Act shall affect the term of any patent granted before the commencement of this Act.

23. Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding enactment of this Act.

24. Where any application or proceeding under the regulations revoked by the Second Schedule to this Act has been filed or commenced before the commencement of this Act, or where any application or proceeding could (if those regulations remained in force) be filed or commenced after the commencement of this Act and be accorded a date before the commencement of this Act, the application or proceeding may be filed, commenced, continued, and completed as if the said regulations continued in force. Any patent granted before or after the commencement of this Act with an extension under regulation 8 of the Patents, Designs, Trade Marks, and Copyright Emergency Regulations 1940 shall be subject to the conditions which would be imposed by that regulation if it continued in force.

THE PATENTS AMENDMENT ACT 1972

1972, No. 91

An Act to amend the Patents Act 1953

[20 October 1972]

1. Short Title—This Act may be cited as the Patents Amendment Act 1972, and shall be read together with and deemed part of the Patents Act 1953 (hereinafter referred to as the principal Act).

2. *This section inserted s. 93A in the principal Act.*

3. *This section added para. (k) to s. 21 (1) of the principal Act.*

THE PATENTS AMENDMENT ACT 1976
1976, No. 112

An Act to amend the Patents Act 1953

[9 December 1976]

1. Short Title—This Act may be cited as the Patents Amendment Act 1976, and shall be read together with and deemed part of the Patents Act 1953 (hereinafter referred to as the principal Act).

2. (1) *This subsection substituted a new subsection for subs. (2) of s. 5 of the principal Act.*

(2) *This subsection inserted s. 5A in the principal Act.*

3. *This section amended s. 97 (2) of the principal Act.*

The Patents Act 1953 is administered in the Department of Justice.



ANALYSIS

Title	
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2. Interpretation	26D. Commissioner to provide international filing date
3. Persons entitled to make application	26E. Amendments to documents forming part of complete specification
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6. Time for putting application in order for acceptance	26H. Publication of Treaty applications
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<i>Treaty Application</i>	9. Regulations
26A. Treaty application deemed to be application accompanied by complete specification	10. Fees
26B. Description, claims, and drawings	11. Annual report of Commissioner Schedules

 1992, No. 81
An Act to amend the Patents Act 1953

[18 August 1992]

BE IT ENACTED by the Parliament of New Zealand as follows:

1. Short Title and commencement—(1) This Act may be cited as the Patents Amendment Act 1992, and shall be read together with and deemed part of the Patents Act 1953 (hereinafter referred to as the principal Act).

(2) Except as provided in subsection (3) of this section, this Act shall come into force on the 1st day of December 1992.

(3) Sections 3, 8, and 11 of this Act shall come into force on the day after the date on which this Act receives the Royal assent.

2. Interpretation—Section 2 (1) of the principal Act is hereby amended by inserting, in their appropriate alphabetical order, the following definitions:

“ ‘International application’ means an application made under the Patent Cooperation Treaty for the protection of an invention:

“ ‘International Bureau’ means the International Bureau of the World Intellectual Property Organization:

“ ‘International filing date’ means the international filing date given to an international application under Article 11 or Article 14 (2) of the Patent Cooperation Treaty:

“ ‘Patent Cooperation Treaty’—

“(a) Means the Patent Cooperation Treaty, signed at Washington on the 19th day of June 1970, the text of which, as amended on the 2nd day of October 1979 and modified on the 3rd day of February 1984, is set out in the First Schedule to the Patents Amendment Act 1992; and

“(b) Includes any amendments, modifications, and revisions from time to time made to the Treaty, being amendments, modifications, and revisions to which New Zealand is a party and by which New Zealand is bound:

“ ‘Receiving Office’ has the same meaning as in Article 2 (xv) of the Patent Cooperation Treaty:

“ ‘Treaty application’ means an international application—

“(a) Which contains a request specifying New Zealand as a designated State under Article 4 (1) (ii) of the Patent Cooperation Treaty; and

“(b) Which has been given an international filing date:

“ ‘Treaty regulations’—

“(a) Means the regulations made under the Patent Cooperation Treaty and set out in the Second Schedule to the Patents Amendment Act 1992; and

“(b) Includes any amendments from time to time made to those regulations.”

3. Persons entitled to make application—Section 7 of the principal Act is hereby amended by inserting, after subsection (2), the following subsection:

“(2A) For the purposes of this section, where more than one application for protection in a convention country has been made, the first application may be disregarded and the second application shall be substituted for the first application where—

“(a) The first application was made in or in respect of the same convention country and by the same applicant as the second application; and

“(b) Not later than the date of filing of the second application, the first application was unconditionally withdrawn, abandoned, or refused; and—

“(i) The first application had not been made available to the public in New Zealand or elsewhere before its unconditional withdrawal, abandonment, or refusal; and

“(ii) No rights remain outstanding in respect of the first application; and

“(iii) The first application has not served to establish a priority date (as defined in section 2 of this Act) in relation to another application in any country.”

4. Examination of application—Section 12 (1) of the principal Act is hereby amended by inserting, before the word “When”, the words “Subject to section 26G of this Act,”.

5. Commissioner may require information as to corresponding applications overseas—(1) Section 15 of the principal Act is hereby amended by inserting, before the word “For”, the words “Subject to subsection (2) of this section,”.

(2) Section 15 of the principal Act is hereby further amended by adding, as subsection (2), the following subsection:

“(2) This section shall not apply to Treaty applications.”

6. Time for putting application in order for acceptance—(1) Section 19 (1) of the principal Act is hereby amended by inserting, before the word “An”, the words “Subject to subsection (1A) of this section,”.

(2) Section 19 of the principal Act is hereby further amended by inserting, after subsection (1), the following subsection:

“(1A) The time period allowed in subsection (1) of this section, in relation to a Treaty application, shall commence on the day on which the applicant fulfils the applicant’s obligations under Article 22 (1) or Article 39 (1) of the Patent Cooperation Treaty, as the case may require.”

7. New heading and sections inserted—The principal Act is hereby amended by inserting, after section 26, the following heading and sections:

“Treaty Application

“26A. Treaty application deemed to be application accompanied by complete specification—For the purposes of this Act, a Treaty application shall be deemed to be an application for a patent for an invention accompanied by a complete specification.

“26B. Description, claims, and drawings—(1) The description, claims, and drawings (if any) contained in a Treaty application shall be deemed to be a complete specification for the purposes of this Act.

“(2) Any indications, being indications referred to in Rule 13^{bis}. 3 (a) of the Treaty regulations, that are contained in a reference to a deposited micro-organism,—

“(a) Shall be deemed to form part of the description contained in an international application; and

“(b) Shall accordingly, pursuant to subsection (1) of this section, form part of the complete specification, even if such indications are contained in another document.

“26C. International filing date—A Treaty application shall be deemed to have been filed in New Zealand on its international filing date.

“26D. Commissioner to provide international filing date—(1) Subject to subsections (2) and (3) of this section, where—

“(a) A request contained in an international application specifies New Zealand as a designated State under Article 4 (1) (ii) of the Patent Cooperation Treaty; and

“(b) Either—

“(i) The receiving Office has refused to accord the international application an international filing date under Article 11 (1) of the Patent Cooperation Treaty or has declared that the international application is considered withdrawn; or

“(ii) The International Bureau has made a finding under Article 12 (3) of the Patent Cooperation Treaty that the international application is considered withdrawn; and

“(c) The Commissioner has decided under Article 25 (2) (a) of the Patent Cooperation Treaty that the refusal or the declaration or the finding was the result of an

error or omission on the part of the receiving Office or the International Bureau,—

the Commissioner shall give the application an international filing date, which date shall be the date of receipt of the application by the receiving Office under Article 11 (1) of the Patent Cooperation Treaty, and the provisions of this Act shall apply to the application accordingly.

“(2) Where, for the purposes of subsection (1) of this section, the date of receipt of the application by the receiving Office cannot be ascertained, the Commissioner may give the application an international filing date, and the provisions of this Act shall apply to the application accordingly.

“(3) This section shall not apply to an international application that has been filed in a receiving Office in a language other than the English language, unless a translation of that application into the English language, verified in accordance with regulations made under this Act, has been furnished to the Commissioner.

“**26E. Amendments to documents forming part of complete specification**—(1) Where an English translation of a Treaty application has been filed with the Commissioner, or has been published under Article 21 of the Patent Cooperation Treaty by the International Bureau, the description, claims, and any matter associated with the drawings, contained in the application, are deemed for the purposes of this Act, to have been amended, on the day the translation was filed, by substituting the translated documents for those originally filed.

“(2) Where—

“(a) A Treaty application has been amended under Article 19 (1) of the Patent Cooperation Treaty; or

“(b) A Treaty application has been amended under Article 34 of the Patent Cooperation Treaty, and New Zealand has been chosen by the applicant to be an elected State under Article 31 (4) (a) of the Patent Cooperation Treaty within the prescribed time limit,—

the description, claims, and drawings contained in that Treaty application shall be deemed, for the purposes of this Act, to have been amended on the day on which the amendment was made.

“(3) Where a Treaty application has been rectified under Rule 91 of the Treaty regulations, the description, claims, and drawings contained in that Treaty application shall be deemed,

for the purposes of this Act, to have been amended on the application's international filing date.

“26F. Treaty application void—A Treaty application shall be deemed to be void for the purposes of this Act where—

- “(a) An applicant withdraws his or her international application, or withdraws the application in relation to New Zealand as a designated State; or
- “(b) Subject to Article 25 of the Patent Cooperation Treaty, an international application is considered to be withdrawn pursuant to Article 12 (3) or Article 14 (1) (b) or Article 14 (3) (a) or Article 14 (4) of the Patent Cooperation Treaty; or
- “(c) Subject to Article 25 of the Patent Cooperation Treaty, the designation of New Zealand as a designated State is considered to be withdrawn pursuant to Article 14 (3) (b) of the Patent Cooperation Treaty; or
- “(d) The applicant fails to fulfil the applicant's obligations under Article 22 (1) of the Patent Cooperation Treaty within the prescribed time limit; or
- “(e) The applicant fails to fulfil the applicant's obligations under Article 39 (1) (a) of the Patent Cooperation Treaty within the prescribed time limit.

“26G. Requirements for examination of Treaty application—(1) Subject to the provisions of subsection (2) of this section, and notwithstanding section 26A of this Act, the Commissioner shall not exercise his or her powers under section 12 of this Act until—

- “(a) The applicant has fulfilled the applicant's obligations under Article 22 (1) or Article 39 (1) of the Patent Cooperation Treaty; and
- “(b) The prescribed time limit has expired; and
- “(c) Where applicable, a translation of the international application into the English language has been filed with the Commissioner and verified in accordance with regulations made under this Act; and
- “(d) All documents required to be filed pursuant to this Act and any regulations made under this Act have been filed; and
- “(e) All fees required to be paid pursuant to this Act and any regulations made under this Act have been paid.

“(2) Notwithstanding the provisions of subsection (1) of this section, the Commissioner may, on the express request of the

applicant, exercise his or her powers under section 12 of this Act at any time.

“26H. Publication of Treaty applications—The publication of a Treaty application, pursuant to Article 21 of the Patent Cooperation Treaty, shall confer no rights or privileges on the applicant under this Act, and shall have no effect other than to confer upon the application the status of a published document for the purpose of any investigation under this Act.”

8. Repeal of section dealing with inventions relating to food or medicine, etc.—(1) Section 51 of the principal Act is hereby repealed.

(2) Sections 52 (1) and 53 (1) of the principal Act are hereby amended by omitting the expression “51” wherever it appears, and substituting in each case the expression “50”.

(3) As at the commencement of this section,—

- (a) Every application made under section 51 of the principal Act, that has not been determined by the Commissioner, shall be deemed to be cancelled; and
- (b) Every order made or licence granted under section 51 of the principal Act shall be deemed to be cancelled; and
- (c) Every appeal pending under section 53 of the principal Act in relation to any application or order made under section 51 of the principal Act shall be deemed to be withdrawn; and
- (d) Every arbitration pending under section 53 of the principal Act in relation to any application made under section 51 of the principal Act and every order or reference made under section 53 (3) of this Act in relation to any such arbitration shall be deemed to be cancelled.

9. Regulations—Section 114 (2) of the principal Act is hereby amended by adding, after paragraph (k), the following paragraph:

“(l) For the carrying out, or giving effect to, New Zealand’s obligations under the Patent Cooperation Treaty.”

10. Fees—Section 115 of the principal Act is hereby amended by adding the following subsection:

“(3) Fees in respect of international applications may, in accordance with New Zealand’s obligations under the Patent

Cooperation Treaty, be collected by the Commissioner on behalf of—

“(a) The International Bureau; or

“(b) Any international search authority that has been approved, for the purposes of this subsection, by the Minister as an appropriate authority on whose behalf the Commissioner may collect such fees.”

11. Annual report of Commissioner—(1) The principal Act is hereby amended by repealing section 116, and substituting the following section:

“116. (1) The Commissioner shall, in July of each year, furnish to the Minister a report on the operation of this Act during the year ended on the immediately preceding 30th day of June.

“(2) The report shall include an account of fees, salaries, allowances, and other money received and paid under this Act during that year.

“(3) The Minister shall lay a copy of the report before the House of Representatives within 28 sitting days of receiving it.”

(2) Notwithstanding subsection (1) of this section, the report that the Commissioner is required pursuant to that subsection to furnish to the Minister in July 1992 shall relate to the period commencing on the 1st day of April 1991 and ending with the close of the 30th day of June 1992.

SCHEDULES

FIRST SCHEDULE

Section 2

PATENT COOPERATION TREATY

**Done at Washington on June 19, 1970,
amended on October 2, 1979,
and modified on February 3, 1984**

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* This Table of Contents is added for the convenience of the reader. It does not appear in the signed text of the Treaty.

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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.

Introduction 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

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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;

(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 consists 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 inter-governmental 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;

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

(xv) “receiving Office” means the national Office or the inter-governmental 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.

(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;

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

(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.

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.

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued***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.

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,

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

- (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, fulfil 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.

(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.

FIRST SCHEDULE—*continued***PATENT COOPERATION TREATY—*continued***

(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).

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

(4) The International Searching Authority referred to in Article 16 shall endeavor 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.

(5)(a) If the national law of the Contracting State so permits, the applicant who files a national application within 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

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

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.

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.

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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 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 requirement 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.

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

(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.

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 the 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.

FIRST SCHEDULE—*continued***PATENT COOPERATION TREATY—*continued***

(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 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

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

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 favorable 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.

(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

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

(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

(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.

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

(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.

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.

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

(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, *murtatis 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.

(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

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

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.

(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.

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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.

(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.

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

(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 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 at 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

FIRST SCHEDULE—*continued***PATENT COOPERATION TREATY—*continued***

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.

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

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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.

FIRST SCHEDULE—*continued***PATENT COOPERATION TREATY—*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).

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

(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 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.

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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;

(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.

* *Editor's Note:* Since 1980, the budget of the Union is biennial.

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

(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.

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.

* *Editor's Note:* Since 1980, the program and budget of the Union are biennial.

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

(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;

(iii) *[deleted]*

(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.

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.

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

(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

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PATENT COOPERATION TREATY—*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 interest the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of coordination 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.

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

(5)(a) Should any financial year close with a deficit, the Contracting States shall, subject to the provisions of subparagraphs (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.

(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

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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

(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 or, 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.

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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.

(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

FIRST SCHEDULE—*continued*PATENT COOPERATION TREATY—*continued*

(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.

(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:

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

(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 State 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.

(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

FIRST SCHEDULE—*continued***PATENT COOPERATION TREATY—*continued***

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.

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

FIRST SCHEDULE—*continued*

PATENT COOPERATION TREATY—*continued*

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).
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SECOND SCHEDULE
REGULATIONS UNDER THE PATENT COOPERATION TREATY
(as in force from 1 July 1992)

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*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, October 1, 1985, July 12, 1991, and October 2, 1991.

**This Table of Contents is added for the convenience of the reader. It does not appear in the original.

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Schedule of Fees

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.

2.2 *“Agent”*

Whenever the word “agent” is used, it shall be construed as meaning an agent appointed under Rule 90.1, unless the contrary clearly follows from the wording or the nature of the provision, or the context in which the word is used.

2.2^{bis} *“Common Representative”*

Whenever the expression “common representative” is used, it shall be construed as meaning an applicant appointed as, or considered to be, the common representative under Rule 90.2.

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 require 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 *Form of Request*

The request shall be made on a printed form or be presented as a computer print-out.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 request shall contain a list indicating:

(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 suggest should accompany the abstract when the abstract is published; in exceptional cases, the applicant may suggest more than one figure.

(b) The list shall be completed by the applicant, failing which the receiving Office shall make the necessary indications, except that the number referred to in paragraph (a)(iii) shall not be indicated by the receiving Office.

3.4 *Particulars*

Subject to Rule 3.3, particulars of the printed request form and of a request presented as a computer print-out 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,

(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,

(v) a reference to a parent application or parent patent.

(c) The request may contain:

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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. In order to allow rapid communication with the applicant, it is recommended to indicate any teleprinter address, telephone and facsimile machine numbers, or corresponding data for other like means of communication, of the applicant or, where applicable, the agent or the common representative.

(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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(c) The applicant's residence shall be indicated by the name of the State of which he is a resident.

(d) The request may, for different designated States, indicate different applicants. In such a case, the request shall indicate the applicant or applicants for each designated State or group of designated States.

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 *Common Representative*

If a common representative is designated, the request shall so indicate.

4.9 *Designation of States*

(a) Contracting States shall be designated in the request:

(i) in the case of designations for the purpose of obtaining national patents, by an indication of each State concerned;

(ii) in the case of designations for the purpose of obtaining a regional patent, by an indication that a regional patent is desired either for all Contracting States which are party to the regional patent treaty concerned or only for such Contracting States as are specified.

(b) The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:

(i) at least one Contracting State is designated under paragraph (a), and

(ii) the request also contains a statement that any designation made under this paragraph is subject to confirmation as provided in paragraph (c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.

(c) The confirmation of any designation made under paragraph (b) shall be effected by

(i) filing with the receiving Office a written notice containing an indication as referred to in paragraph (a)(i) or (ii), and

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(ii) paying to the receiving Office the designation fee and the confirmation fee referred to in Rule 15.5 within the time limit under paragraph (b)(ii).

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 such earlier application was filed; when the earlier application is a regional or an international application, at least one country for which such earlier application was filed, and

(ii) the date on which the earlier application was filed, the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made. However, where, resulting from an obvious error, the indication of the said country or the said date is missing or is erroneous, the receiving Office may, at the request of the applicant, make the necessary correction. The error shall be considered as an obvious error whenever the correction is obvious from a comparison with the earlier application. Where the error consists of the omission of the indication of the said date, the correction can only be made before the transmittal of the record copy to the International Bureau. In the case of any other error relating to the indication of the said date or in the case of any error relating to the indication of the said country, the correction can only be made before the expiration of the time limit under Rule 17.1(a) computed on the basis of the correct priority date.

(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 one month

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

4.15 *Signature*

(a) Subject to paragraph (b), the request shall be signed by the applicant or, if there is more than one applicant, by all of them.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.

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”

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

5.2 *Nucleotide and/or Amino Acid Sequence Disclosure*

Where the international application contains disclosure of a nucleotide and/or amino acid sequence, the description shall contain a listing of the sequence complying with the standard prescribed by the Administrative Instructions.

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

SECOND SCHEDULE—continued**REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued**

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 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 two 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 two months

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*
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.

(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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

(c) *[Deleted]*

(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.

SECOND SCHEDULE—continued

REGULATIONS UNDER THE PATENT COOPERATION TREATY—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 applications 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 the 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 description, the claims, and the abstract, shall be as follows:

—top: 2 cm

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

—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

(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) Subject to paragraph (f) and to Rule 11.8 (b), the margins of the international application, when submitted, must be completely blank.

(f) The top margin may contain in the left-hand corner an indication of the applicant's file reference, provided that the reference appears within 1.5 cm from the top of the sheet. The number of characters in the applicant's file reference shall not exceed the maximum fixed by the Administrative Instructions.

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 centred at the top or bottom of the sheet, but shall not be placed 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 in the right half of the left 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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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 catchwords 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.

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 authorised 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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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 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) Notwithstanding paragraph (a), the request, any text matter of the drawings, and the abstract need not be in the same language as other elements of the international application, provided that:

(i) the request is in a language admitted under paragraph (a) or in the language in which the international application is to be published;

(ii) the text matter of the drawings is in the language in which the international application is to be published;

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(iii) the abstract is in the language in which the international application is to be published.

(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 *Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled*

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

13.3 *Determination of Unity of Invention Not Affected by Manner of Claiming*

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single 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 the invention claimed in an independent claim,

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 two 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

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 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

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

furnishing of samples of 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.

(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 13^{ter}**Nucleotide and/or Amino Acid Sequence Listings****13^{ter}.1** *Sequence Listing for International Authorities*

(a) If the International Searching Authority finds that a nucleotide and/or amino acid sequence listing does not comply with the standard prescribed in the Administrative Instructions under Rule 5.2, and/or is not in a machine readable form provided for in those Instructions, it may invite the applicant, within a time limit fixed in the invitation, as the case may be:

(i) to furnish to it a listing of the sequence complying with the prescribed standard, and/or

(ii) to furnish to it a listing of the sequence in a machine readable form provided for in the Administrative Instructions or, if that Authority is prepared to transcribe the sequence listing into such a form, to pay for the cost of such transcription.

(b) Any sequence listing furnished under paragraph (a) shall be accompanied by a statement to the effect that the listing does not include matter which goes beyond the disclosure in the international application as filed.

(c) If the applicant does not comply with the invitation within the time limit fixed in the invitation, the International Searching Authority shall not be required to search the international application to the extent that such non-compliance has the result that a meaningful search cannot be carried out.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(d) If the International Searching Authority chooses, under paragraph (a)(ii), to transcribe the sequence listing into a machine readable form, it shall send a copy of such transcription in machine readable form to the applicant.

(e) The International Searching Authority shall, upon request, make available to the International Preliminary Examining Authority a copy of any sequence listing furnished to it, or as transcribed by it, under paragraph (a).

(f) A sequence listing furnished to the International Searching Authority, or as transcribed by it, under paragraph (a) shall not form part of the international application.

13^{ter}.2 *Sequence Listing for Designated Office*

(a) Once the processing of the international application has started before a designated Office, that Office may require the applicant to furnish to it a copy of any sequence listing furnished to the International Searching Authority, or as transcribed by that Authority, under Rule 13^{ter}.1(a).

(b) If a designated Office finds that a nucleotide and/or amino acid sequence listing does not comply with the standard prescribed in the Administrative Instructions under Rule 5.2, and/or is not in a machine readable form provided for in those Instructions, and/or no listing of the sequence was furnished to the International Searching Authority, or transcribed by that Authority, under Rule 13^{ter}.1(a), that Office may require the applicant;

(i) to furnish to it a listing of the sequence complying with the prescribed standard, and/or

(ii) to furnish to it a listing of the sequence in a machine readable form provided for in the Administrative Instructions or, if that Office is prepared to transcribe the sequence listing into such a form, to pay for the cost of such transcription.

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 component 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,

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(i) a “basic fee,” and

(ii) as many “designation fees” as there are national patents and regional patents sought under Rule 4.9(a) 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 for that designation.

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.

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

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

15.5 *Fees Under Rule 4.9(c)*

(a) Notwithstanding Rule 15.4(b), the confirmation under Rule 4.9(c) of any designations made under Rule 4.9(b) shall be subject to the payment to the receiving Office of as many designation fees (for the benefit of the International Bureau) as there are national patents and regional patents sought by the applicant by virtue of the confirmation, together with a confirmation fee (for the benefit of the receiving Office), as set out in the Schedule of Fees.

(b) Where moneys paid by the applicant within the time limit under Rule 4.9(b)(ii) are not sufficient to cover the fees due under paragraph (a), the receiving Office shall allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.

15.6 *Refund*

The receiving Office shall refund the international fee to the applicant:

(i) if the determination under Article 11(1) is negative, or

(ii) if, before the transmittal of the record copy to the International Bureau, the international application is withdrawn or considered withdrawn.

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

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 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 receiving Office shall refund the search fee to the applicant:

- (i) if the determination under Article 11(1) is negative, or
- (ii) if, before the transmittal of the search copy to the International Searching Authority, the international application is withdrawn or considered withdrawn.

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}**Extension of Time Limits for Payment of Fees****16^{bis}.1 Invitation by the Receiving Office**

(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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

paid to it by the applicant is less than what is necessary to cover the transmittal fee, the basic fee and search fee, the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16^{bis}.2, within one month from the date of the invitation.

(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 under Rule 4.9(a), the receiving Office shall invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16^{bis}.2, within one month from the date of the invitation.

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) or (b) and the applicant has not, within one month from the date of the invitation, paid in full the amount due, including, where applicable, the late payment fee under Rule 16^{bis}.2, the receiving Office shall:

(i) allocate any moneys paid as specified by the applicant or, in the absence of such specification, as prescribed by the Administrative Instructions.

(ii) make the applicable declaration under Article 14(3), and

(iii) proceed as provided in Rule 29.

16^{bis}.2 *Late Payment Fee*

(a) The payment of fees in response to an invitation under Rule 16^{bis}.1(a) or (b) may be subjected by the receiving Office to the payment to it of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

(b) The amount of the late payment fee shall not, however, exceed the amount of the basic fee.

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 made not later than the expiration of the

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

- (i) the international application was withdrawn,
- (ii) the relevant priority claim was withdrawn or was considered, under Rule 4.10(b), not to have been made, or
- (iii) the relevant declaration under Article 8(1) was cancelled under Rule 4.10(d).

(d) Paragraphs (a) to (c) 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.

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*18.3 *Two or More Applicants*

If there are two or more applicants, 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 *Information on Requirements Under National Law as to Applicants*

(a) *[Deleted]*

(b) *[Deleted]*

(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 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 *Two or More Applicants*

If there are two or more 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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 on the request of each copy received and the international application number 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;

(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.

20.4 *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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

(c) For the purposes of Article 11(1)(ii), it shall be sufficient that the elements referred to in Article 11(1)(iii)(d) and (e) be in a language admitted under Rule 12.1(a) or (c).

(d) If, on July 12, 1991, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

20.5 *Positive Determination*

(a) If the determination under Article 11(1) is positive, the receiving Office shall stamp on the request 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 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 one month, from the date of the invitation. If such time limit expires after the expiration of one 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.

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,

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

copy not later than five 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.

(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).

22.2 *[Deleted]*

22.3 *Time Limit under Article 12(3)*

The time limit referred to in Article 12(3) shall be three 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 unless no search fee

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*
has been paid. In the latter case, it shall be transmitted promptly after payment of the search fee.

(b) *[Deleted]*

Rule 24

Receipt of the Record Copy by the International Bureau

24.1 *[Deleted]*

24.2 *Notification of Receipt of the Record Copy*

(a) The International Bureau shall promptly notify:

- (i) the applicant,
 - (ii) the receiving Office, and
 - (iii) the International Searching Authority (unless it has informed the International Bureau that it wishes not to be so notified),
- 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 and the name of the applicant, and shall indicate the filing date of any earlier application whose priority is claimed. The notification sent to the applicant shall also contain a list of the States designated under Rule 4.9(a) and, where applicable, of those States whose designations have been confirmed under Rule 4.9(c).

(b) Each designated Office which has informed the International Bureau that it wishes to receive the notification under paragraph (a) prior to the communication under Rule 47.1 shall be so notified by the International Bureau:

(i) if the designation concerned was made under Rule 4.9(a), promptly after the receipt of the record copy;

(ii) if the designation concerned was made under Rule 4.9(b), promptly after the International Bureau has been informed by the receiving Office of the confirmation of that designation.

(c) 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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 one 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 one 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.

26.3^{ter} *Invitation to Correct Defects under Article 3(4)(i)*

(a) Where any element of the international application, other than those referred to in Article 11(1)(iii)(d) and (e), does not comply with Rule 12.1, the receiving Office shall invite the applicant to file the required correction. Rules 26.1(a), 26.2, 26.5 and 29.1 shall apply *mutatis mutandis*.

(b) If, on July 12, 1991, paragraph (a) is not compatible with the national law applied by the receiving Office, paragraph (a) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(b) to (d) *[Deleted]*

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.

(b) *[Deleted]*

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)), the search fee (Rule 16), and, where required, the late payment fee (Rule 16^{bis}.2).

(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)) and, where required, the late payment fee (Rule 16^{bis}.2).

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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 each designated Office which has already been notified of its designation;

(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 Search Authority of the said declaration;

(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 each designated Office which has already been notified of its designation.

29.2 *[Deleted]*

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 one 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 four 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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*
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

[Deleted]

Rule 32^{bis}

[Deleted]

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 which is the same as, or later than, the international filing date.

(c) Any published application or any patent whose publication date is the same as, or later than, 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.

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(d) Where an application is republished once (for example, an *Offenlegungsschrift* 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 (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 six 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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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 organisation must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media;

(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.

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 or Defective 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

SECOND SCHEDULE—continued**REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued**

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).

(b) The applicant may, within one month from the date of mailing of the international search report, submit comments on the abstract established by the International Searching Authority. Where that Authority amends the abstract established by it, it shall notify the amendment to the International Bureau.

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 of 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.

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

SECOND SCHEDULE—continued**REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued**

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.

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest ("protest fee"). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the three-member board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified.

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 three months from the

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*
receipt of the search copy by the International Searching Authority, or nine 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, 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 or, if the priority of more than one earlier application is claimed, the filing date of the earliest among them.

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. If the entire document is relevant but some passages are of particular relevance, such passages shall be identified unless such identification is not practicable.

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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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.

(c) If the international search was based on, or was extended to, any electronic data base, the international search report may indicate the name of the data base and, where considered useful to others and practicable, the search terms used.

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 or on less than all the inventions (Article 17 (3) (a)), the international search report shall indicate what parts of the international application were and what parts were not searched.

43.8 Authorised Officer

The international search report shall indicate the name of the officer of the International Searching Authority responsible for that report.

43.9 Additional Matter

The international search report shall contain no matter other than that specified in Rules 33.1 (b) and (c), 43.1 to 43.3, 43.5 to 43.8, and 44.2 (a), and the indication referred to in Article 17 (2) (b), provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. The international search report shall not contain, and the Administrative Instructions shall not permit the inclusion of, any 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.

SECOND SCHEDULE—continued**REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued****44.2 Title or Abstract**

(a) 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) *[Deleted]*

(c) *[Deleted]*

44.3 Copies of Cited Documents

(a) The request referred to in Article 20(3) may be presented any time during seven 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) *[Deleted]*

(d) Any International Searching Authority may perform the obligations referred to in paragraphs (a) and (b) 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.

Rule 46**Amendment of Claims before the International Bureau****46.1 Time Limit**

The time limit referred to in Article 19 shall be two 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.

46.2 Where to File

Amendments made under Article 19 shall be filed directly with the International Bureau.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

(b) and (c) *[Deleted]*

Rule 47

Communication to Designated Offices

47.1 *Procedure*

(a) The communication provided for in Article 20 shall be effected by the International Bureau.

(a^{bis}) The International Bureau shall notify each designated Office, at the time of the communication provided for in Article 20, of the fact and date of receipt of the record copy and of the fact and date of receipt of any priority document. Such notification shall also be sent to any designated Office which has waived the communication provided for in Article 20, unless such Office has also waived the notification of its designation.

(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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

(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.

47.4 Express Request under Article 23 (2)

Where the applicant makes an express request to a designated Office under Article 23 (2) before the communication provided for in Article 20 has taken place, the International Bureau shall, upon request of the applicant or the designated Office, promptly effect that communication to that Office.

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,

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

- (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),
 - (viii) any indications in relation to a deposited microorganism furnished under Rule 13^{bis} separately from the description, together with an indication of the date on which the International Bureau received such indications.
- (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.
- (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.

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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 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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

(b) *[Deleted]*

(c) If the international application, the designation of any designated State or the priority claim is withdrawn under Rule 90^{bis} after the technical preparations for international publication have been completed, notice of the withdrawal 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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

applicant by the expiration of the time limit applicable under Article 22 shall notify the International Bureau accordingly.

(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 two 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), (c^{bis}) 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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

(c^{bis}) Where the applicant furnishes, to a designated Office which requires under paragraph (a)(ii) a translation of both the claims as filed and the claims as amended, only one of the required two translations, the designated Office may disregard the claims of which a translation has not been furnished or invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation. Where the designated Office chooses to invite the applicant to furnish the missing translation and the latter is not furnished within the time limit fixed in the invitation, the designated Office may disregard those claims of which a translation has not been furnished or consider the international application withdrawn.

(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, 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.

(f) The expression "Fig." does not require translation into any language.

(g) Where any copy of the drawings or any 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 the abstract or 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.

(k) Where a title has been established by the International Searching Authority pursuant to Rule 37.2, the translation shall contain the title as established by that Authority.

(l) If, on July 12, 1991, paragraph (c^{bis}) or paragraph (k) is not compatible with the national law applied by the designated Office, the paragraph concerned shall not apply to that designated Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The

SECOND SCHEDULE—continued**REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued**

information received shall be promptly published by the International Bureau in the Gazette.

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 three 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 two months computed from the date of the notification sent to the applicant under Rules 20.7(i), 24.2(c), 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

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,

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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.

SECOND SCHEDULE—continued**REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued****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 four 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 or be presented as a computer print-out. The particulars of the printed form and of a demand presented as a computer print-out shall be prescribed by the Administrative Instructions.

(b) Copies of printed demand forms shall be furnished free of charge by the receiving Office or by the International Preliminary Examining Authority.

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,
- (v) where applicable, a statement concerning amendments.

(b) The demand shall be signed.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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*. Only applicants for the elected States are required to be indicated in the demand.

53.5 *Agent or Common Representative*

If an agent or common representative is designated, the demand shall so indicate. Rules 4.4 and 4.16 shall apply, and Rule 4.7 shall apply *mutatis mutandis*.

53.6 *Identification of the International Application*

The international application shall be identified by the name and address of the applicant, the title of the invention, the international filing date (if known to the applicant) and the international application number or, where such number is not known to the applicant, the name of the receiving Office with which the international application was filed.

53.7 *Election of States*

(a) The demand shall indicate at least one Contracting State from among those States which are designated and are bound by Chapter II of the Treaty (“eligible States”), as an elected State.

(b) Election of Contracting States in the demand shall be made:

(i) by an indication that all eligible States are elected, or,

(ii) in the case of States which have been designated for the purpose of obtaining national patents, by an indication of those eligible States that are elected, and, in the case of States which have been designated for the purpose of obtaining a regional patent, by an indication of the regional patent concerned together with either an indication that all eligible States party to the regional patent treaty concerned are elected or an indication of those among the said States that are elected.

53.8 *Signature*

(a) Subject to paragraph (b), the demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.

(b) Where two or more applicants file a demand which elects a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the demand or could not be found or reached after diligent effort, the demand need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(i) a statement is furnished explaining, to the satisfaction of the International Preliminary Examining Authority, the lack of signature of the applicant concerned, or

(ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with.

53.9 *Statement Concerning Amendments*

(a) If amendments under Article 19 have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments

(i) to be taken into account, in which case a copy of the amendments shall preferably be submitted with the demand, or

(ii) to be considered as reversed by an amendment under Article 34.

(b) If no amendments under Article 19 have been made and the time limit for filing such amendments has not expired, the statement may indicate that the applicant wishes the start of the international preliminary examination to be postponed in accordance with Rule 69.1(d).

(c) If any amendments under Article 34 are submitted with the demand, the statement shall so indicate.

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 *Two or More Applicants*

If there are two or more applicants, the right to make a demand under Article 31 (2) shall exist if at least one of the applicants making the demand is

(i) a resident or national of a Contracting State bound by Chapter II and the international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II, 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 *[Deleted]*

54.4 *Applicant Not Entitled to Make a Demand*

(a) If the applicant does not have the right to make a demand or, in the case of two or more applicants, if none of them has the right to make a demand under Rule 54.2, the demand shall be considered not to have been submitted.

(b) *[Deleted]*

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

Rule 56

Later Elections

56.1 *Elections Submitted Later Than the Demand*

(a) The election of States subsequent to the submission of the demand (“later election”) shall be effected by a notice submitted to the International Bureau. The notice shall identify the international application and the demand, and shall include an indication as referred to in Rule 53.7(b)(ii).

(b) Subject to paragraph (c), the notice referred to in paragraph (a) shall be signed by the applicant for the elected States concerned or, if there is more than one applicant for those States, by all of them.

(c) Where two or more applicants file a notice effecting a later election of a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the notice or could not be found or reached after diligent effort, the notice need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and

(i) a statement is furnished explaining, to the satisfaction of the International Bureau, the lack of signature of the applicant concerned, or

(ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or did not sign the demand but the requirements of Rule 53.8(b) were complied with.

(d) An applicant for a State elected by a later election need not have been indicated as an applicant in the demand.

(e) If a notice effecting a later election is submitted after the expiration of 19 months from the priority date, the International Bureau shall notify the applicant that the election does not have the effect provided for under Article 39(1)(a) and that the acts referred to in Article 22 must be performed in respect of the elected Office concerned within the time limit applicable under Article 22.

(f) If, notwithstanding paragraph (a), a notice effecting a later election is submitted by the applicant to the International Preliminary Examining Authority rather than the International Bureau, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

SECOND SCHEDULE—continued**REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued****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 notice effecting the later election 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) *[Deleted]*

57.2 Amount

(a) The amount of the handling fee is as set out in the Schedule of Fees.

(b) *[Deleted]*

(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.

(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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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) *[Deleted]*

(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.

57.4 *Failure to Pay*

(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 *[Deleted]*

57.6 *Refund*

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

(i) if the demand is withdrawn before the demand has been sent by that Authority to the International Bureau, or

(ii) if the demand is considered, under Rule 54.4(a), not to have been submitted.

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.

(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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 receiving Office of or acting for a 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 it. 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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to 53.8 and 55, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(b) If the applicant complies with the invitation within the time limit under paragraph (a), 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) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had not been submitted.

(d) Where, after the expiration of the time limit under paragraph (a), a signature required under Rule 53.8 or a prescribed indication is lacking in respect of an applicant for a certain elected State, the election of that State shall be considered as if it had not been made.

(e) 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 (d).

(f) If the demand does not contain a statement concerning amendments, the International Preliminary Examining Authority shall proceed as provided for in Rules 66.1 and 69.1(a) or (b).

(g) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall invite the applicant to submit the amendments within a time limit fixed in the invitation and shall proceed as provided for in Rule 69.1(e).

60.2 *Defects in Later Elections*

(a) If the notice effecting a later election does not comply with the requirements of Rule 56, the International Bureau shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Bureau at any time before a decision is taken.

(b) If the applicant complies with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had been received on the actual filing date, provided that the notice as submitted contained at least one election and permitted the international application to be identified; otherwise, the notice shall be considered as if it had been

SECOND SCHEDULE—continued**REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued**

received on the date on which the International Bureau receives the correction.

(c) Subject to paragraph (d), if the applicant does not comply with the invitation within the time limit under paragraph (a), the notice shall be considered as if it had not been submitted.

(d) Where, in respect of an applicant for a certain elected State, the signature required under Rule 56.1(b) and (c) or the name or address is lacking after the expiration of the time limit under paragraph (a), the later election of that State shall be considered as if it had not been made.

Rule 61**Notification of the Demand and Elections****61.1 Notification to the International Bureau and the Applicant**

(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 file.

(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 60.1(d) 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 applicant of the receipt, and the date of receipt, of any notice effecting a later election. That date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b). Where the notice has been considered under Rule 60.2(c) as if it had not been submitted or where a later election has been considered under Rule 60.2(d) as if it had not been made, the International Bureau shall notify the applicant accordingly.

61.2 Notification 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 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 a later election—the date of receipt of the notice effecting the later election. The latter date shall be the actual date of receipt by the International Bureau or, where applicable, the date referred to in Rule 56.1(f) or 60.2(b).

(c) The notification shall be sent to the elected Office together with the communication provided for in Article 20. Elections effected after such communication shall be notified promptly after they have been made.

(d) Where the applicant makes an express request to an elected Office under Article 40(2) before the communication provided for in Article 20

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*
has taken place, the International Bureau shall, upon request of the applicant or the elected Office, promptly effect that communication to that Office.

61.3 *Information for the Applicant*

The International Bureau shall inform the applicant in writing of the notification referred to in Rule 61.2 and of the elected Offices notified under Article 31(7).

61.4 *Publication in the Gazette*

Where a demand has been filed prior to the expiration of the 19th month from the priority date, the International Bureau shall publish a notice of that fact in the Gazette promptly after the filing of the demand, but not before the international publication of the international application. The notice shall indicate all designated States bound by Chapter II which have not been elected.

Rule 62

Copy of Amendments Under Article 19 for the International Preliminary Examining Authority

62.1 *Amendments Made before the Demand is Filed*

Upon receipt of a demand from the International Preliminary Examining Authority, the International Bureau shall promptly transmit a copy of any amendments under Article 19 to that Authority, unless that Authority has indicated that it has already received such a copy.

62.2 *Amendments Made after the Demand is Filed*

(a) If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, 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. In any case, the International Bureau shall promptly transmit a copy of such amendments to that Authority.

(b) *[Deleted]*

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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

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 on a date which is the same as, or later than, 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 on a date which is the same as, or later than, 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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*
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*

(a) Subject to paragraphs (b) to (d), the international preliminary examination shall be based on the international application as filed.

(b) The applicant may submit amendments under Article 34 at the time of filing the demand or, subject to Rule 66.4^{bis} until the international preliminary examination report is established.

(c) Any amendments under Article 19 made before the demand was filed shall be taken into account for the purposes of the international preliminary examination unless superseded, or considered as reversed, by an amendment under Article 34.

(d) Any amendments under Article 19 made after the demand was filed and any amendments under Article 34 submitted to the International Preliminary Examining Authority shall, subject to Rule 66.4^{bis} be taken into account for the purposes of the international preliminary examination.

(e) Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

66.2 *First Written Opinion of the International Preliminary Examining Authority*

(a) If the International Preliminary Examining Authority

- (i) considers that any of the situations referred to in Article 34 (4) exists,
- (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,
- (iv) considers that any amendment goes beyond the disclosure in the international application as filed,
- (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,
- (vi) considers that a claim relates to an invention in respect of which no international search report has been established and has decided not to carry out the international preliminary examination in respect of that claim, or

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(vii) considers that a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, 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 two months after the date of notification. In no case shall it be shorter than one month after the said date. It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification. It shall not be more than three months after the said date but may be extended if the applicant so requests before its expiration.

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.

66.4^{bis} Consideration of Amendments and Arguments

Amendments or arguments need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if they are received after that Authority has begun to draw up that opinion or report.

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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*
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.

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 the 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 two 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 previously filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets. Where the amendment consists in the deletion of passages or in minor alterations or additions, it may be made on a copy of the relevant sheet of the international application, provided that the clarity and direct reproducibility of that sheet are not adversely affected. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.

(b) *[Deleted]*

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.

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued***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 proceed with the international preliminary examination, subject to Article 34 (4) (b) and Rule 66.1 (e) in respect of the entire international application, but shall indicate, in any written opinion and in the international preliminary examination report, that it considers that the requirement of unity of invention is not fulfilled and it shall specify the reasons therefor.

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 one month, and it shall not be longer than two months, from the date of the invitation.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

(e) Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest ("protest fee"). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review. If the protest fee is not so paid, the protest shall be considered withdrawn. The protest fee shall be refunded to the applicant where the three-member board, special instance or higher authority referred to in paragraph (c) finds that the protest was entirely justified.

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

Start of and Time Limit for International Preliminary Examination

69.1 *Start of International Preliminary Examination*

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession both of the demand and of either the international search report or a notice of the declaration by the International Searching

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

Authority under Article 17 (2) (a) that no international search report will be established.

(b) If the competent International Preliminary Examining Authority is part of the same national Office or intergovernmental organisation as the competent International Searching Authority, the international preliminary examination may, if the International Preliminary Examining Authority so wishes and subject to paragraph (d), start at the same time as the international search.

(c) Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9 (a) (i)), the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned.

(d) Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9 (b)), the International Preliminary Examining Authority shall not start the international preliminary examination before

(i) it has received a copy of any amendments made under Article 19,

(ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19, or

(iii) the expiration of 20 months from the priority date, whichever occurs first.

(e) Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9 (c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1 (g) has expired, whichever occurs first.

69.2 *Time Limit for International Preliminary Examination*

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;

(ii) nine months from the start of the international preliminary examination if the demand was filed after the expiration of 19 months from the priority date.

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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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.

(d) Where claims relate to inventions in respect of which no international search report has been established and have therefore not been the subject of international preliminary examination, the international preliminary examination report shall so indicate.

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, 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.

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.

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*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.

70.12 *Mention of Certain Defects and Other Matters*

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;

(iii) any of the situations referred to in Article 34 (4) exists, it shall state this opinion and the reasons therefore in the report;

(iv) a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, it shall so state in the report.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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. The report shall contain the indications provided for in Rule 68.1, where the International Preliminary Examining Authority chose not to invite the applicant to restrict the claims or to pay additional fees.

70.14 *Authorised Officer*

The report shall indicate the name of the officer of the International Preliminary Examining Authority responsible for that report.

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*

Each replacement sheet under Rule 66.8 (a) and each replacement sheet containing amendments under Article 19 shall, unless superseded by later replacement sheets, be annexed to the report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 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.

(b) *[Deleted]*

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 seven 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)

SECOND SCHEDULE—continued

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*
between the International Preliminary Examining Authorities and the International Bureau.

(c) *[Deleted]*

(d) Any International Preliminary Examining Authority may perform the obligations referred to in paragraphs (a) and (b) 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.

(b) Any such requirement shall be notified to the International Bureau, which shall promptly publish it in the Gazette.

72.2 Copy of Translation for the Applicant

The International Bureau shall transmit a copy of the translation referred to in Rule 72.1 (a) 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 but not earlier than the communication under Article 20.

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

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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

[Deleted]

Rule 76

Copy, Translation and Fee under Article 39(1); Translation of Priority Document

76.1, 76.2 and 76.3 *[Deleted]*

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 or Article 24 (2) shall be construed as a reference to Article 39 (1) or Article 39 (3), respectively;

(iii) the words “international applications filed” in Rule 49.1(c) shall be replaced by the words “a demand submitted”;

(iv) for the purposes of Article 39 (1), where an international preliminary examination report has been established, a translation of any amendment under Article 19 shall only be required if that amendment is annexed to that report.

76.6 Transitional Provision

If, on July 12, 1991, Rule 76.5 (iv) is not compatible with the national law applied by the elected Office in respect of claims amended under Article 19, Rule 76.5 (iv) shall not apply in that respect to that elected Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1991. The information received shall be promptly published by the International Bureau in the Gazette.

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.

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(c) Notifications concerning the shortening of the previously fixed time limit shall be effective in relation to demands submitted after the expiration of three 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, exercise the right under Article 41 to amend the claims, the description and the drawings, before the elected Office concerned within one month from the fulfilment of the requirements under Article 39 (1) (a), provided that, if the transmittal of the international preliminary examination report under Article 36 (1) has not taken place by the expiration of the time limit applicable under Article 39, he shall exercise the said right not later than four 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 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 paragraph (a).

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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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.

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.

SECOND SCHEDULE—*continued***REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*****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 seven 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 seven days after the date it bears.

(b) *[Deleted]*

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.

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 two 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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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 three 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 five days prior to the expiration of the time limit. Except in cases where surface mail normally arrives at its destination within two 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 the mailing, in accordance with paragraph (a), of a document or letter 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 one month after the date on which the interested party noticed—or with due diligence should have noticed—the delay or the loss, and in no case later than six months after the expiration of the time limit applicable in the given case.

(d) Any national Office or intergovernmental organization which has notified the International Bureau that it will do so shall, where a delivery service other than the postal authorities is used to mail a document or letter, apply the provisions of paragraphs (a) to (c) as if the delivery service was a postal authority. In such a case, the last sentence of paragraph (a) shall not apply but evidence may be offered only if details of the mailing were recorded by the delivery service at the time of mailing. The notification may contain an indication that it applies only to mailings using

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

specified delivery services or delivery services which satisfy specified criteria. The International Bureau shall publish the information so notified in the Gazette.

(e) Any national Office or intergovernmental organization may proceed under paragraph (d):

(i) even if, where applicable, the delivery service used was not one of those specified, or did not satisfy the criteria specified, in the relevant notification under paragraph (d), or

(ii) even if that Office or organization has not sent to the International Bureau a notification under paragraph (d).

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 five 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.

SECOND SCHEDULE—continued

REGULATIONS UNDER THE PATENT COOPERATION TREATY—continued

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.

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

SECOND SCHEDULE—*continued***REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued***

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 three 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.

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*

The frequency of publication of the Gazette shall be determined by the Director General.

86.4 *Sale*

The subscription and other sale prices of the Gazette shall be determined by the Director General.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

86.5 *Title*

The title of the Gazette shall be determined by the Director General.

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. If any publication is available in more than one language, the request shall specify the language or languages 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:

- (i) Rule 14.1 (Transmittal Fee),
- (ii) *[Deleted]*
- (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).

88.2 *[Deleted]*

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).

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*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 two 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.

PART F**Rules Concerning Several Chapters of the Treaty****Rule 90****Agents and Common Representatives**90.1 *Appointment as Agent*

(a) A person having the right to practice before the national Office with which the international application is filed may be appointed by the applicant as his agent to represent him before that Office acting as the receiving Office and before the International Bureau, the International

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

Searching Authority and the International Preliminary Examining Authority.

(b) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(c) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Preliminary Examining Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed;

(ii) specifically before the International Searching Authority or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority or International Preliminary Examining Authority, as the case may be.

90.2 *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a "common agent") under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 may be appointed by the other applicants as their common representative.

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office shall be considered to be the common representative of all the applicants.

90.3 *Effects of Acts by or in Relation to Agents and Common Representatives*

(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 concerned.

(b) If there are two or more agents representing the same applicant or applicants, any act by or in relation to any of those agents shall have the effect of an act by or in relation to the said applicant or applicants.

(c) Subject to Rule 90^{bis}.5(a), second sentence, 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.

90.4 *Manner of Appointment of Agent or Common Representative*

(a) The appointment of an agent shall be effected by the applicant signing the request, the demand or a separate power of attorney. Where

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

there are two or more applicants, the appointment of a common agent or common representative shall be effected by each applicant signing, at his choice, the request, the demand or a separate power of attorney.

(b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be submitted to the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

(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.

90.5 *General Power of Attorney*

(a) Appointment of an agent in relation to a particular international application may be effected by referring in the request, the demand or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a “general power of attorney”), provided that:

(i) the general power of attorney has been deposited in accordance with paragraph (b), and

(ii) a copy of it is attached to the request, the demand or the separate notice, as the case may be; that copy need not be signed.

(b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be deposited with the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

90.6 *Revocation and Renunciation*

(a) Any appointment of an agent or common representative may be revoked by the persons who made the appointment or by their successors in title, in which case any appointment of a sub-agent under Rule 90.1(d) by that agent shall also be considered as revoked. Any appointment of a sub-agent under Rule 90.1(d) may also be revoked by the applicant concerned.

(b) The appointment of an agent under Rule 90.1(a) shall, unless otherwise indicated, have the effect of revoking any earlier appointment of an agent made under that Rule.

(c) The appointment of a common representative shall, unless otherwise indicated, have the effect of revoking any earlier appointment of a common representative.

(d) An agent or a common representative may renounce his appointment by a notification signed by him.

(e) Rule 90.4(b) and (c) shall apply, *mutatis mutandis*, to a document containing a revocation or renunciation under this Rule.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

Rule 90^{bis}

Withdrawals

90^{bis}.1 *Withdrawal of the International Application*

(a) The applicant may withdraw the international application at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(c) No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

90^{bis}.2 *Withdrawal of Designations*

(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies in respect of that State, prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90^{bis}.4.

(b) Where a State has been designated for the purpose of obtaining both a national patent and a regional patent, withdrawal of the designation for designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.

(c) Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90^{bis}.1.

(d) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(e) No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

90^{bis}.3 *Withdrawal of Priority Claims*

(a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, 30 months from the priority date.

(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 the priority claims.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(c) Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.

(d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change.

(e) In the case of the time limit 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 of withdrawal sent by the applicant or transmitted by the receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for international publication.

90^{bis}.4 *Withdrawal of the Demand or of Elections*

(a) The applicant may withdraw the demand or any or all elections at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective upon receipt of a notice addressed by the applicant to the International Bureau.

(c) If the notice of withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

90^{bis}.5 *Signature*

(a) Any notice of withdrawal referred to in Rules 90^{bis}.1 to 90^{bis}.4 shall, subject to paragraph (b), be signed by the applicant. Where one of the applicants is considered to be the common representative under Rule 90.2(b), such notice shall, subject to paragraph (b), require the signature of all the applicants.

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90^{bis}.1 to 90^{bis}.4 need not be signed by that applicant ("the applicant concerned") if it is signed by at least one applicant and

(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or

(ii) in the case of a notice of withdrawal referred to in Rule 90^{bis}.1(b), 90^{bis}.2(d), or 90^{bis}.3(c), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or

(iii) in the case of a notice of withdrawal referred to in Rule 90^{bis}.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with, or did not sign the later

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

election concerned but the requirements of Rule 56.1(c) were complied with.

90^{bis}.6 *Effect of Withdrawal*

(a) Withdrawal under Rule 90^{bis} of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2).

(b) Where the international application is withdrawn under Rule 90^{bis}.1, the international processing of the international application shall be discontinued.

(c) Where the demand or all elections are withdrawn under Rule 90^{bis}.4, the processing of the international application by the International Preliminary Examining Authority shall be discontinued.

90^{bis}.7 *Faculty under Article 37(4)(b)*

(a) Any Contracting State whose national law provides for what is described in the second part of Article 37(4)(b) shall notify the International Bureau in writing.

(b) The notification referred to in 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 one month after the date of such publication.

Rule 91

Obvious Errors in Documents

91.1 *Rectification*

(a) Subject to paragraphs (b) to (g^{quater}), 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 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,

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

(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 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.

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

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 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 not be 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. Where the international application has been translated under Rule 12.1(c), the language of such translation shall be used.

(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 authorizes the use of such language.

(c) *[Deleted]*

(d) Any letter from the applicant to the International Bureau shall be in English or French.

(e) Any letter of 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 air mail, provided that surface mail may be used instead of air mail in cases where surface mail normally arrives at its destination within two days from mailing or where air mail service is not available.

SECOND SCHEDULE—*continued*REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*92.4 *Use of Telegraph, Teleprinter, Facsimile Machine, Etc.*

(a) A document making up the international application, and any later document or correspondence relating thereto, may, notwithstanding the provisions of Rules 11.14 and 92.1(a), but subject to paragraph (h), be transmitted, to the extent feasible, by telegraph, teleprinter, facsimile machine or other like means of communication producing a printed or written document.

(b) A signature appearing on a document transmitted by facsimile machine shall be recognized for the purposes of the Treaty and these Regulations as a proper signature.

(c) Where the applicant has attempted to transmit a document by any of the means referred to in paragraph (a) but part or all of the received document is illegible or part of the document is not received, the document shall be treated as not having been received to the extent that the received document is illegible or that the attempted transmission failed. The national Office or intergovernmental organization shall promptly notify the applicant accordingly.

(d) Any national Office or intergovernmental organization may require that the original of any document transmitted by any of the means referred to in paragraph (a) and an accompanying letter identifying that earlier transmission be furnished within 14 days from the date of the transmission, provided that such requirement has been notified to the International Bureau and the International Bureau has published information thereon in the Gazette. The notification shall specify whether such requirement concerns all or only certain kinds of documents.

(e) Where the applicant fails to furnish the original of a document as required under paragraph (d), the national Office or intergovernmental organization concerned may, depending on the kind of document transmitted and having regard to Rules 11 and 26.3,

(i) waive the requirement under paragraph (d), or

(ii) invite the applicant to furnish, within a time limit which shall be reasonable under the circumstances and shall be fixed in the invitation, the original of the document transmitted,

provided that, where the document transmitted contains defects, or shows that the original contains defects, in respect of which the national Office or intergovernmental organization may issue an invitation to correct, that Office or organization may issue such an invitation in addition to, or instead of, proceeding under item (i) or (ii).

(f) Where the furnishing of the original of a document is not required under paragraph (d) but the national Office or intergovernmental organization considers it necessary to receive the original of the said document, it may issue an invitation as provided for under paragraph (e)(ii).

(g) If the applicant fails to comply with an invitation under paragraph (e)(ii) or (f):

(i) where the document concerned is the international application, the latter shall be considered withdrawn and the receiving Office shall so declare;

SECOND SCHEDULE—*continued*

REGULATIONS UNDER THE PATENT COOPERATION TREATY—*continued*

Fees—*continued*

Amounts—*continued*

2. Designation Fee:

(Rule 15.2(a))

(a) for designations made under Rule 4.9(a) 185 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 10 shall not require the payment of a designation fee

(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c) 185 Swiss francs per designation

3. Confirmation Fee:

(Rule 15.5(a))

50% of the sum of the designation fees payable under item 2(b)

4. Handling Fee:

(Rule 57.2(a))

233 Swiss francs.

This Act is administered in the Ministry of Commerce.



ANALYSIS

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1. Short Title and commencement	15. New sections substituted
2. Interpretation	58. Special provisions as to Crown use during emergency
3. Refusal of application in certain cases	58A. Nature and scope of rights under section 55
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6. Revocation of patent by Court	16. Burden of proof for infringement of process patent
7. Compulsory licence	17. Transitional provisions
8. Section 47 (relating to licences under section 46) repealed	18. Term of existing patents
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1994, No. 122

An Act to amend the Patents Acts 1953

[9 December 1994]

BE IT ENACTED by the Parliament of New Zealand as follows:

1. Short Title and commencement—(1) This Act may be cited as the Patents Amendment Act 1994, and shall be read together with and deemed part of the Patents Act 1953 (hereinafter referred to as the principal Act).

(2) This Act shall come into force on a date to be appointed by the Governor-General by Order in Council; and one or more orders may be made bringing different provisions into force on different dates.

2. Interpretation—Section 2 (1) of the principal Act is hereby amended by inserting, after the definition of the term “Government Department”, the following definition:

“ ‘Integrated circuit’ means a circuit, in its final or an intermediate form, in which the elements, at least one of which is an active element, and some or all of

the interconnections are integrally formed in or on a piece of material and that is intended to perform an electronic function:”.

3. Refusal of application in certain cases—The principal Act is hereby amended by repealing section 17, and substituting the following section:

“17. (1) If it appears to the Commissioner in the case of any application for a patent that the use of the invention in respect of which the application is made would be contrary to morality, the Commissioner may refuse the application.

“(2) An appeal to the Court shall lie from any decision of the Commissioner under this section.”

4. Date and term of patent—(1) Section 30 of the principal Act is hereby amended by repealing subsection (3), and substituting the following subsection:

“(3) The term of every patent shall be 20 years from the date of the patent.”

(2) Section 30 (5) of the principal Act is hereby amended by omitting the expression “3 months”, and substituting the expression “6 months”.

5. Sections repealed—The principal Act is hereby amended by repealing sections 31 to 33.

6. Revocation of patent by Court—Section 41 (1) of the principal Act is hereby amended by repealing paragraph (k).

7. Compulsory licence—The principal Act is hereby amended by repealing section 46, and substituting the following section:

“46. (1) At any time after the expiration of 3 years from the date of the sealing of a patent or 4 years from the date of the patent, whichever is the later, any person interested may apply to the Court for the grant of a licence under the patent upon any of the grounds specified in subsection (2) of this section.

“(2) The grounds upon which a licence may be granted under this section are that a market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in New Zealand.

“(3) Subject to subsections (4), (5), (6), and (7) of this section, if the Court is satisfied that either of the grounds referred to in subsection (2) of this section are established, the Court may

make an order for the grant of a licence in accordance with the application upon such terms as the Court thinks fit.

“(4) A licence granted under this section—

“(a) Is not exclusive:

“(b) Must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used:

“(c) Is limited to the supply of the patented invention predominantly in New Zealand.

“(5) Any licence granted under this section may, on the application of any interested party, be terminated by the Court, where the Court is satisfied that the grounds on which the licence was granted have ceased to exist.

“(6) Where a licence is granted under this section to any person, that person shall pay such remuneration to the patentee as may be agreed, or as may be determined by a method agreed, between that person and the patentee or, in default of agreement, as is determined by the Court on the application of that person or the patentee.

“(7) No licence shall be granted under this section unless the person applying for the licence, having taken all reasonable steps to do so, has been unable to obtain a licence, or to obtain a licence on reasonable terms, from the patentee.

“(8) No licence shall be granted under this section in respect of a patent relating to an integrated circuit.”

8. Section 47 (relating to licences under section 46) repealed—The principal Act is hereby amended by repealing section 47.

9. Exercise of powers on applications under section 46—The principal Act is hereby amended by repealing section 48, and substituting the following section:

“48. The powers of the Court on an application under section 46 of this Act shall be exercised with a view to securing that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention.”

10. Sections repealed—(1) The principal Act is hereby amended by repealing sections 49 and 50.

(2) The principal Act is hereby further amended by repealing sections 52 and 53 (each as amended by section 8 (2) of the Patents Amendment Act 1992).

(3) Section 8 (2) of the Patents Amendment Act 1992 is hereby consequentially repealed.

11. Supplementary provisions—(1) Section 54 of the principal Act is hereby amended by repealing subsection (2).

(2) Section 54 (3) of the principal Act is hereby amended by omitting the expression “sections 46 to 50”, and substituting the expression “section 46”.

12. Use of patented inventions for services of the Crown—The principal Act is hereby amended by repealing section 55, and substituting the following section:

“55. (1) Subject to sections 58A to 58C of this Act, but notwithstanding any other provision of this Act, any Government Department, and any person authorised in writing by a Government Department, may make, use, exercise, and vend any patented invention for the services of the Crown and anything done by virtue of this subsection shall not amount to an infringement of the patent concerned.

“(2) For the purposes of this section and section 56 of this Act,—

“(a) Any use of an invention for the supply to the Government of any country outside New Zealand, in pursuance of any agreement or arrangement between the Government of New Zealand and the Government of that country, of articles required for the defence of that country shall be deemed to be a use of the invention for the services of the Crown:

“(b) The power of a Government Department or a person authorised by a Government Department under this section to make, use, exercise, and vend a patented invention shall include power to sell to any person any articles made in the exercise of the powers conferred by this section that are no longer required for the purpose for which they were made:

“(c) The power of a Government Department or a person authorised by a Government Department under this section to vend a patented invention shall not, in the case of a patent relating to an integrated circuit, extend to sale of the invention to the public.

“(3) Where the Governor-General, by Order in Council, declares that the use of any patented invention by any person or by any class of persons engaged in a particular industry is necessary or desirable to enable full benefit to be derived by the members of the public in New Zealand of any enterprise or

undertaking in which the Crown or any Government Department has a complete or almost complete monopoly, any such use of the invention or inventions shall for the purposes of this section and sections 56 and 57 of this Act be deemed to be a use for the services of the Crown.

“(4) The purchaser of any articles sold in the exercise of powers conferred by this section, and any person claiming through the purchaser, shall have power to deal with them in the same manner as if the patent were held on behalf of the Crown.”

13. Rights of third parties in respect of Crown use—

(1) Section 56 (1) of the principal Act is hereby amended by inserting, before the words “be of no effect”, the words “, subject to sections 58A and 58C of this Act,”.

(2) Section 56 of the principal Act is hereby further amended by repealing subsections (2), (3), and (4).

14. Reference of disputes as to Crown use—The principal Act is hereby amended by repealing section 57, and substituting the following section:

“57. (1) Any dispute as to the exercise by a Government Department or a person authorised by a Government Department of the powers conferred by section 55 of this Act, or as to the terms for the use of an invention for the services of the Crown thereunder may be referred to the Court by either party to the dispute in such manner as may be prescribed by rules of the Court.

“(2) In any proceedings under this section to which a Government Department is a party, the Department may,—

“(a) If the patentee is a party to the proceedings, apply for revocation of the patent upon any ground upon which a patent may be revoked under section 41 of this Act;

“(b) In any case, put in issue the validity of the patent without applying for its revocation.

“(3) In determining any dispute referred to the Court under this section, the Court shall have regard to—

“(a) Any benefit or compensation that the patentee of the patented invention may have received, or may be entitled to receive, directly or indirectly from any Government Department or person authorised by a Government Department in respect of the invention in question:

“(b) The need to ensure that the patentee shall receive reasonable remuneration having regard to the nature of the patented invention.

“(4) In any proceedings under this section, the Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to a special or official referee or an arbitrator on such terms as the Court may direct; and references to the Court in the foregoing provisions of this section shall be construed accordingly.”

15. New sections substituted—The principal Act is hereby amended by repealing section 58, and substituting the following sections:

“58. Special provisions as to Crown use during emergency—Subject to sections 58A to 58C of this Act, the powers exercisable in relation to an invention by a Government Department or a person authorised by a Government Department under section 55 of this Act, shall include power to make, use, exercise, and vend the patented invention for any purpose which appears to the Department necessary or expedient—

“(a) To avoid prejudice to the security or defence of New Zealand; or

“(b) To assist in the exercise of powers and the implementation of civil defence measures during a state of national emergency under section 46 of the Civil Defence Act 1983 or a state of national civil defence emergency under section 50 of that Act.

“58A. Nature and scope of rights under section 55—
(1) The right to use a patented invention under section 55 of this Act—

“(a) Is not exclusive:

“(b) Must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used:

“(c) Is, notwithstanding subsection (2) (a) of that section, limited to the supply of the patented invention predominantly in New Zealand by a Government Department or a person authorised by a Government Department under that section.

“(2) The right to use a patented invention under section 55 of this Act may, on the application of any interested party, be terminated by the Court, where the Court is satisfied that the

circumstances that gave rise to the right to use the patented invention have ceased to exist and are unlikely to recur.

“(3) Except in a case to which section 58 of this Act applies, the right to use a patented invention under section 55 of this Act is subject to the Government Department or person authorised by a Government Department under section 55 of this Act having first taken all reasonable steps to obtain the consent of the patentee to the use of the patented invention on reasonable terms and conditions, and having failed to obtain such consent within a reasonable period of time.

“58B. **Duty to inform owner**—(1) Where any use of a patented invention is made by or with the authority of a Government Department under section 55 of this Act, the Department shall, as soon as practicable after the use of the patented invention has begun, notify and furnish the patentee with such information as to the extent of the use as the patentee may from time to time require.

“(2) Nothing in subsection (1) of this section requires the Government Department to notify or disclose information to the patentee if to do so would, or might reasonably be expected to, prejudice the security or defence of New Zealand.

“58C. **Patentee entitled to remuneration**—Where an act is done under section 55 of this Act, the Crown shall pay such remuneration to the patentee as may be agreed, or as may be determined by a method agreed, between the Crown and the patentee or as may, in default of agreement, be determined by the Court under section 57 of this Act.”

16. Burden of proof for infringement of process patent—The principal Act is hereby amended by inserting, after section 68, the following section:

“68A. (1) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the patentee or a licensee of the patentee shall, unless the contrary is proved, be taken in any proceedings for infringement of the patent to have been obtained by that process.

“(2) In applying subsection (1) of this section, the Court shall not require any person to disclose any manufacturing or commercial secrets if it appears to the Court that it would be unreasonable to do so.

Cf. Patents Act 1977 (U.K.), s. 100”

17. Transitional provisions—(1) Nothing in this Act applies to or affects—

- (a) Any proceedings for revocation of a patent commenced before the commencement of this Act:
- (b) Any proceedings for infringement of a patent commenced before the commencement of this Act:
- (c) Any existing licences or applications for licences of right under section 46 of the principal Act in existence or made before the commencement of this Act:
- (d) Any application for the extension of the term of a patent made before the commencement of this Act:
- (e) Any reference to the Court under section 57 of the principal Act made before the commencement of this Act:
- (f) Subject to subsection (2) of this section, any application for a patent in respect of which a complete specification has been filed before the commencement of this Act,—

and any such proceedings, licences, applications, or references to the Court shall continue as if this Act had not been enacted.

(2) Where, in respect of an application for a patent, a complete specification has not been advertised under section 20 (2) of the principal Act before the commencement of this Act, the application must be determined in accordance with the principal Act (as amended by this Act) if the applicant gives notice to the Commissioner in accordance with subsection (3) of this section, requesting that the application be determined in accordance with the principal Act (as so amended).

(3) Any notice under subsection (2) of this section—

- (a) Must be in the prescribed form:
- (b) Must be accompanied by the prescribed fee:
- (c) Must be given on or before the date falling 6 months after the commencement of this Act, or on or before the date of grant of the patent, whichever occurs first.

18. Term of existing patents—(1) Subject to subsections (2) and (3) of this section, the term of every patent that has not expired before the commencement of this Act shall, notwithstanding anything contained in the principal Act, be deemed to be 20 years from the date of the patent.

(2) Nothing in subsection (1) of this section applies to a patent the term of which has, before the commencement of this Act, been extended by the Court or the Commissioner for a period exceeding 20 years from the date of the patent.

(3) Nothing in subsection (1) of this section applies to a patent the term of which is extended by the Court or the Commissioner for a period exceeding 20 years from the date of the patent pursuant to an application for the extension of the term of the patent made before the commencement of this Act.

19. Repeal of section 24 (4) of Health Reforms (Transitional Provisions) Act 1993—Section 24 (4) of the Health Reforms (Transitional Provisions) Act 1993 is hereby repealed.

This Act is administered in the Ministry of Commerce.