

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

NATIONAL AND REGIONAL OFFICES

Means of Receipt of Documents

The **Japanese Patent Office** has notified the International Bureau that it is prepared to receive documents referred to in PCT Rule 92.4 by means of telecopier as from January 4, 1985. The number of the telecopier is (03)501-6803 (groups 2 and 3).

RECEIVING OFFICES

Competent International Preliminary Examining Authorities

Pursuant to information received from the **National Office of Inventions of Hungary**, the **Austrian Patent Office** is, with effect from November 14, 1984, at the choice of the applicant, a competent International Preliminary Examining Authority in respect of international applications filed with the National Office of Inventions for the Grant of European patents.

DESIGNATED (OR ELECTED) OFFICES

Time Limit under PCT Article 39(1)(a)

The modified time limit of 30 months from the priority date under Article 39(1)(a) applies for the procedure before the national Office of **Sweden** as an elected Office as from January 1, 1985. The notice published in PCT Gazette No. 25/1984, on page 3098, is hereby amended. Therefore, the time limit of 25 months from the priority date continues to apply, after January 1, 1985, under Article 39(1)(a) only with respect to the national Offices of Finland, Japan (only for the payment of the national fee; for the other acts referred to in Article 39(1)(a), the time limit applicable under Article 22 continues to apply) and the United Kingdom.

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CONTRACTING STATES

States Party to the Patent Cooperation Treaty (PCT)

On December 12, 1984, **Barbados** deposited its instrument of accession to the Patent Cooperation Treaty (PCT). Thus, Barbados will become the 38th Contracting State of the PCT on March 12, 1985.

Consequently, as from March 12, 1985, nationals and residents of Barbados will become entitled to file international applications under the PCT and, from the same date, it will be possible to file international applications designating Barbados.

On December 28, 1984, **Italy** deposited its instrument of ratification of the Patent Cooperation Treaty (PCT). Thus, Italy will become the 39th Contracting State of the PCT on March 28, 1985.

Consequently, as from March 28, 1985, nationals and residents of Italy will become entitled to file international applications under the PCT and, from the same date, it will be possible to file international applications designating Italy.

The designation of Italy in an international application will have the effect of an indication of the wish to obtain a European patent for Italy under the European Patent Convention (PCT Article 45(2)); a **national** Italian patent cannot be obtained through an international application under the PCT.

The entry into force of the PCT for Italy has the consequence that, as from March 28, 1985, all States party to the European Patent Convention (Austria, Belgium, France, Germany (Federal Republic of), Italy, Liechtenstein, Luxembourg, the Netherlands, Sweden, Switzerland and the United Kingdom) will also be party to the PCT. This opens the possibility of obtaining, by filing a single international application under the PCT, a European patent for all those States.

DESIGNATED (OR ELECTED) OFFICES

The International Bureau has, by January 15, 1985, received notifications under PCT Rule 49.1(a-bis) from the following Contracting States: **Bulgaria, Hungary, Republic of Korea, Sudan and Switzerland**. Under those notifications, the above-mentioned Contracting States do not require 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 applicable time limit under Article 22). Pursuant to Rule 76.5, those notifications are also applicable for the furnishing of a copy of the international application under Article 39(1) for those of the said States which are bound by Chapter II, namely, Bulgaria, Hungary and Sudan.

INTERNATIONAL BUREAU

Non-Working Days

For the purpose of computing time limits under Rule 80.5* the days on which the International Bureau is **not open for business** are, for the period from February 1, 1985 to February 1, 1986, the following:

all Saturdays and Sundays and
April 5, 1985
April 8, 1985
May 16, 1985
May 27, 1985
September 5, 1985
December 25 and 26, 1985
January 1 and 2, 1986

It is important to note that the days indicated above concern **only the International Bureau** and not the national Offices and other international organizations.

* Rule 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.”

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STATISTICS RELATING TO RECORD COPIES RECEIVED BY THE INTERNATIONAL BUREAU

GUIDANCE NOTE CONCERNING STATISTICS

Certain codes are used in the statistical tables to indicate the identity of receiving Offices and of designated States. These codes have been taken from the "Code for Identifying States and Organizations" contained in Annex B* to the Administrative Instructions under the Patent Cooperation Treaty (PCT). The codes and the States to which they refer are set out at the foot of this note.

In the case of receiving Offices, the codes indicate the Contracting State of the Patent Cooperation Treaty (PCT) for which the receiving Office is the national industrial property office except in the case of the European Patent Office which acts (as well as the national industrial property office) as receiving Office for the Contracting States of the PCT which are also party to the European Patent Convention. In the statistical table relating to the designations of States, the figures shown relate to the indications as to designations contained in the record copies as received by the International Bureau of WIPO and notified by it to the designated Offices. Against the code of each designated State, the abbreviations "NAT" and/or "EPO" and/or "OAPI" are indicated. These abbreviations mean that, for the designated State, a national patent ("NAT") and/or a European patent ("EPO") and/or a patent granted by the African Intellectual Property Office ("OAPI") is sought.

AT	Austria	LK	Sri Lanka
AU	Australia	LU	Luxembourg
BE	Belgium	MC	Monaco
BG	Bulgaria	MG	Madagascar
BR	Brazil	ML	Mali
CF	Central African Republic	MR	Mauritania
CG	Congo	MW	Malawi
CH	Switzerland	NL	Netherlands
CM	Cameroon	NO	Norway
DE	Germany, Federal Republic of	RO	Romania
DK	Denmark	SD	Sudan
FI	Finland	SE	Sweden
FR	France	SN	Senegal
GA	Gabon	SU	Soviet Union
GB	United Kingdom	TD	Chad
HU	Hungary	TG	Togo
JP	Japan	US	United States of America
KP	Democratic People's Republic of Korea	EP	European Patent Office
KR	Republic of Korea		

* Published on pages 3566 and 3567 of PCT Gazette No. 29/1984.

RECORD COPIES RECEIVED BROKEN DOWN
ACCORDING TO RECEIVING OFFICES AND LANGUAGES OF FILING

(From 1 January 1984 to 31 December 1984)

LANGUAGES	RECEIVING OFFICES																				Total Number of Record Copies Received
	AT	AU	BE	BR	CH	DE	DK	FI	FR	GB	HU	JP	KR	NL	NO	RO	SE	SU	US	EP	
Danish	-	-	-	-	-	-	065	-	-	-	-	-	-	-	-	-	-	-	-	-	0065
Dutch	-	-	-	-	-	-	-	-	-	-	-	-	-	014	-	-	-	-	-	-	0014
English	-	274	003	006	-	-	055	056	-	450	032	-	006	027	021	002	234	-	2233	064	3463
Finnish	-	-	-	-	-	-	-	040	-	-	-	-	-	-	-	-	-	-	-	-	0040
French	-	-	021	-	069	-	-	-	310	-	-	-	-	-	-	-	-	-	-	002	0402
German	044	-	-	-	134	281	-	-	-	-	024	-	-	-	-	-	-	-	-	286	0769
Japanese	-	-	-	-	-	-	-	-	-	-	-	621	004	-	-	-	-	-	-	-	0625
Norwegian	-	-	-	-	-	-	-	-	-	-	-	-	-	-	038	-	-	-	-	-	0038
Russian	-	-	-	-	-	-	-	-	-	-	-	-	-	-	-	-	-	060	-	-	0060
Swedish	-	-	-	-	-	-	001	-	-	-	-	-	-	-	-	-	242	-	-	-	0243
Total Number of Record Copies Received	044	274	024	006	203	281	121	096	310	450	056	621	010	041	059	002	476	060	2233	352	5719

Note: During the period reported upon in this table, the International Bureau received no record copies from the Patent Offices of Bulgaria, the Democratic People's Republic of Korea, Luxembourg, Monaco, Malawi, Sri Lanka and Sudan acting as receiving Offices. Neither did the International Bureau receive any international application in its capacity of a receiving Office acting for Cameroon, the Central African Republic, Chad, Congo, Gabon, Mali, Mauritania, Senegal and Togo.

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FEE PAYABLE UNDER THE PCT

As a consequence of the entry into force of the PCT for Italy on March 28, 1985, the Director General of WIPO has established, pursuant to PCT Rules 15.2(b) and 57.2(c), the equivalent amounts in Lira of the following fees:

Kind of fee	Amount Lira
Basic Fee	476,000
Supplement per sheet over 30	10,000
Designation fee	115,000
Handling fee	146,000

In addition, the equivalent amounts in Lira of the following fees have been fixed by the European Patent Office:

Kind of Fee	Amount Lira
Transmittal fee	119,000
Search fee (for an international search)	1,352,000
Additional search fee	1,352,000
Preliminary examination fee	1,368,000
Additional preliminary examination fee	1,368,000
Fee for copies of documents cited in the international preliminary examination report	800
Fee for copies of documents contained in the file of the international application	800

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

PCT TEXT BROCHURE

A consolidated text of the PCT and the Regulations as in force on January 1, 1985, has been published by the International Bureau in English, French and German. Official texts in Arabic, Italian, Portuguese, Russian and Spanish are under preparation. The text brochures can be ordered from WIPO. The price is Swiss francs 10 (at WIPO headquarters) or 12 (by surface mail) or 15 (by airmail). The WIPO publication number should be indicated in the order: No. 274(E) for English, No. 274(F) for French and No. 274(G) for German.

ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

Modification of Annex F-Forms

Form PCT/RO/101 (Request) and **Form PCT/IPEA/401 (Demand)** have been (partly) modified with effect from January 1985. A further modification of the "second sheet" of the Request Form (reflecting the complete list of Contracting States, including Barbados and Italy) takes effect on March 28, 1985.

The said modified Forms can be obtained - free of charge - from the receiving Offices and from the International Bureau.

Various other PCT Forms contained in Annex F to the Administrative Instructions have also been modified with effect from January 1985. The PCT Forms can be obtained (in English or French) from WIPO.

Kind of Form	Price (in Swiss francs)		
	At WIPO headquarters	By surface mail	By Airmail
Receiving Office (RO) Forms	10	12	15
International Searching Authority (ISA) Forms	10	12	15
International Bureau (IB) Forms	10	12	15
International Preliminary Examining Authority (IPEA) Forms	10	12	15
Printed Forms	10	12	15
Complete set of all PCT Forms listed above	50	60	75

FEES PAYABLE UNDER THE PCT**Fees payable to the Receiving Office****United States of America**

Pursuant to Rules 15.2(d) and 16.1(d) of the Regulations under the PCT, new amounts in **US dollars**, as indicated below, have been established.

Kind of fee	Amount US dollar
Basic fee:	230
Supplement per sheet over 30:	4
Designation fee:	55
Maximum of designation fee:	550
Fee for international search by the European Patent Office:	620

The new amount of the fee for international search by the European Patent Office is applicable as from May 7, 1985. The new amounts for the other fees referred to above are applicable as from May 28, 1985.

INFORMATION ON CONTRACTING STATES**Italy**

General information on **Italy** as a new Contracting State and on the Central Patent Office of Italy as a receiving Office is given on the next two pages ("Annex B1" and "Annex C") in the format which was used for the first time in the latest special issue of the PCT Gazette containing only Section IV (No. 06/1985).

Information on Contracting States

ANNEX B1

IT

ITALY

IT

General Information

Country code:	IT
Name of Office:	Ufficio Centrale Brevetti Central Patent Office
Location and mailing address:	19, via Molise, 00187 Rome, Italy
Telegraphic address:	MININDUSTRIA, Ufficio Brevetti
Teleprinter address:	610154 MININDUSTRIA
Telephone:	(6)4705, ext. 3032
Means of receipt of documents under PCT Rule 92.4:	Telegraph, teleprinter
Competent receiving Office for nationals and residents of Italy:	Central Patent Office (Italy) or European Patent Office, at the choice of the applicant*
Competent designated (or elected) Office if Italy is designated (or elected):	European Patent Office
May Italy be elected?	Yes (bound by Chapter II of the PCT)
Types of protection available:	European patents
Provisions of the Italian law concerning international-type search:	None
Provisional protection pursuant to international publication:	European protection only: After international publication or, where that publication was in a language other than one of the official languages of the EPO, after publication by the EPO of the international application in a translation into one of its official languages furnished to it, the applicant may, as from the date on which a translation into Italian of the claims is made available to the public or communicated to the user, obtain damages and possibly the description and seizure of the articles infringing the patent and anything used in the making thereof.

* However, a resident of Italy may only file direct at the European Patent Office with the authorization of the Ministry for Industry, Commerce and Handicraft, except if the international application claims the priority of a national application filed in Italy over 90 days previously and such application has not been made subject to the official secrets regulation.

Receiving Offices

ANNEX C

IT

CENTRAL PATENT OFFICE (ITALY)

IT

Competent receiving Office
for nationals and residents of:

Italy

Language in which international
application may be filed:

English, French or German

Number of copies required by the
receiving Office:

3

Competent International Searching
Authority:
Patent Office

European

Competent International Preliminary
Examining Authority:

European Patent Office

Fees payable to the receiving Office: Currency: Lira (ITL)

Transmittal fee:

ITL 60,000

Basic fee:

ITL 476,000

Supplement per sheet over 30:

ITL 10,000

Designation fee:

ITL 115,000

Search fee:

ITL 1,352,000

Fee for priority document
(PCT Rule 17.1(b)):

ITL 3,000 (in fee stamps) per page (except for
the description, for which ITL 3,000 (in fee
stamps) are due for each fourth page) plus
ITL 100 (payable to the current account of the
Office) per page

Is an agent required by
the receiving Office?

No (but an address for service is required if the
applicant does not reside in Italy)

Who can act as an agent?

Any agent whose name appears on a list maintained
by the Central Patent Office, any lawyer or
attorney-at-law whose name appears in the
respective professional roll.

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Information on Intergovernmental Organizations

ANNEX B2--WO--WIPO-- (WORLD INTELLECTUAL PROPERTY ORGANIZATION)

Corrigendum

relating to the information published in PCT Gazette No. 06/1985, Section IV, of March 14, 1985, on page 702.

The telephone number of the telecopier (facsimile copy) of the Swiss Postal Service which may be used for communications to the International Bureau of WIPO is for Group III: (022) 21 79 70.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

REFERENCES TO DEPOSITS OF MICROORGANISMS

Pursuant to Rule 13bis.7 of the Regulations under the PCT, the **Patent and Trademark Office of Denmark** has notified the International Bureau about amendments to the national law concerning microbiological inventions which take effect on July 1, 1985.

The table concerning References to Deposits of Microorganisms, contained in Annex M1, published in PCT Gazette No. 06/1985 on pages 748 to 750, is, pursuant to the notification received from the Danish Patent and Trademark Office, amended as follows:

1st column (Designated Office):	Denmark, Patent and Trademark Office
2nd column (Additional Indications):	To the extent available to the applicant, all significant information on the characteristics of the microorganism
3rd column (Time Earlier Than 16 Months From the Priority Date):	In the case of (A): where applicant requests publication earlier than 16 months from the priority date, not later than that request In the case of (B): at the time of filing (as part of the application)
4th column (Depositary Institutions):	See footnotes (1) and (11), below

Footnote (1): the text is reproduced in PCT Gazette No. 06/1985, page 749.

Footnote (11): *Danish Patent and Trademark Office:* The applicant may request that, until the application has been laid open to public inspection (by the Danish Patent and Trademark Office), or has been finally decided upon by the Danish Patent and Trademark Office without having been laid open to public inspection, the furnishing of a sample shall only be effected to an expert in the art. The request to this effect shall be filed by the applicant with the Danish Patent and Trademark Office not later than at the time when the application is made available to the public under Sections 22 and 33(3) of the Danish Patents Act. Such request shall indicate the expert to be used. That expert may be any person entered on a list of recognized experts drawn up by the Danish Patent and Trademark Office or any person approved by the applicant in the individual case.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

FEES PAYABLE UNDER THE PCT

NEW AMOUNTS OF FEES IN AUSTRALIAN DOLLARS ESTABLISHED UNDER RULES 15.2(d) AND 57.2(e)

New amounts in Australian Dollars (AUD), as indicated below, have been established for the fees specified pursuant to Rules 15.2(d) and 57.2(e) of the Regulations under the PCT. The new amounts are applicable on and from July 23, 1985.

Kind of fee	Amount
1. <i>Basic Fee</i> (Rule 15.2(a)) if the international application contains not more than 30 sheets	AUD 380
if the international applications contains more than 30 sheets	AUD 380 plus AUD 8 for each sheet in excess of 30 sheets
2. <i>Designation Fee</i> (Rule 15.2(a)) maximum of the designation fee	AUD 920
3. <i>Handling Fee</i> (Rule 57.2(a))	AUD 116

CORRIGENDUM

relating to the information published in PCT Gazette No. 06/1985, Section IV, of March 14, 1985, on page 715.

Receiving Offices

ANNEX C--FR--(NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY (FRANCE))

The correct amount of the fee for priority document (PCT Rule 17.1(b)) is French franc (FRF) 84.

SECTION IV

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LEGAL DECISIONS

European Patent Office

Decision of the Legal Board of Appeal of 25 September 1984, J 06/1983* (published in the Official Journal of the European Patent Office No. 4/1985, pages 97 to 101)

Headword: "Refund of Examination Fee (PCT)/CATERPILLAR"

EPC Articles 17, 18(1), 92, 94(1)(2), 157, Rules relating to Fees Article 10, PCT Articles 23, 40

"Reimbursement of the examination fee"—"withdrawal of application"

Headnote

If an international application which is deemed to be a European patent application in accordance with Article 150 (3) EPC is withdrawn before the drawing up of the supplementary European search report can be begun, examination of the application is precluded. In such circumstances, if the examination fee has already been paid, it must be refunded.

Summary of Facts and Submissions

I. On 13 August 1979, the appellant filed an international application under the Patent Cooperation Treaty (PCT) in the United States of America. No claim was made to a priority date earlier than the date of the application. The European Patent Office was the designated office for the purposes of the PCT, as several EPC Contracting States were designated, it being indicated that it was desired to obtain a European patent for those States. The application thus being deemed to be a European patent application (Article 150 (3) EPC) was accorded the number 79901397.4.

II. The appellant filed a request for examination of the European patent application on 8 January 1981. The examination fee was paid on 23 January 1981. The international search report was published on 19 February 1981.

III. By letter dated 1 June 1981, received on 3 June 1981, the appellant requested withdrawal of the European patent application, the refund of the search fee in respect of the supplementary European search report and the refund of the examination fee. As the EPO had not begun to draw up the supplementary European search report, the search fee was duly refunded in accordance with Article 10 (4), Rules relating to Fees. The EPO did not refund the examination fee and after correspondence between the

appellant's representative and the EPO and reference of the matter to the EPO's Legal Division, the refusal to refund the examination fee was made the subject of the decision under appeal, dated 18 April 1983.

IV. In the decision it was held that:

(1) In accordance with Article 22 (1) PCT, the regional phase of processing the application had commenced on 14 April 1981, i.e. at the expiration of 20 months from the priority date.

(2) The request for examination and payment of the examination fee had had immediate effect, by virtue of the provisions of Article 150 (3) EPC and Articles 11 (3) and 11 (4) PCT.

(3) Fees due under the EPC are as a general rule refunded only if there is express provision for such a refund.

(4) Under a practice of the EPO (cf. Legal Advice No. 1/79 Official Journal EPO, 1979, p. 61) a refund of the examination fee will occur if processing of a European patent application is terminated before responsibility for it is transferred from the Receiving Section to the Examining Division. However, this practice could not be applied to an international application because, under Articles 23 (1) and 40 (1) PCT, the EPO may neither process nor examine the international application before the start of the regional phase. The Examining Division always assumes responsibility for an international application from the moment when the request for examination is filed, even though it cannot process or examine the application before the start of the regional phase.

(5) It follows that an examination fee paid during the international phase can only be refunded if the application is withdrawn before the start of the regional phase. This was not the case with the present application.

V. By telex, on 17 June 1983, duly confirmed by letter dated 20 June 1983, the appellant gave notice of appeal against the decision. The appeal fee was duly paid. In the notice of appeal, the appellant requested full refund of the examination fee and reimbursement of the appeal fee. Reference of the case to the Enlarged Board of Appeal was also requested.

VI. In the Statement of Grounds of the Appeal, filed on 17 August 1983, the appellant contended that:

(1) The supplementary European search report is the definitive search report for the purposes of examination;

(2) Not only is it convenient to pay the examination fee earlier than necessary but it is also frequently impracticable to wait until the supplementary search report is received before paying the fee;

(3) The applicant could not have known at any material time that the Examining Division assumed responsibility for the application immediately the request for examination became effective since the matter was the subject of an amendment to the Guidelines for Examination not published until October 1981. Furthermore, in fact, action had been taken in the case by the Receiving Section and the Search Division;

* Official text.

(4) It was absurd and illogical to refund the supplementary search fee and not the examination fee, since examination must follow search.

The appellant repeated the request that the matter be referred to the Enlarged Board of Appeal.

VII. By a communication dated 17 July 1984, the Legal Board of Appeal indicated that it was able to envisage giving a positive decision in the present case, on the basis that where the fee for the supplementary European search can be refunded because the EPO has not begun to draw up the supplementary European search report, the examination fee can also be refunded. However, as there were other cases pending before the Board in which the question arose of refunding examination fees after the supplementary European search report had been drawn up and the arguments in those cases might conceivably affect the Board's view of the present case, the Board would not decide the present case immediately unless the appellant asked for that. By letter dated 1 August 1984, the appellant's representative asked for an immediate decision.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.

2. The question of the refund of the examination fee in the case of withdrawal of an international application after receipt of the supplementary European search report is one which is recognised as giving rise to legal difficulty and, as it is the subject of other appeals pending before the Legal Board of Appeal, it is not a question which will be examined in the present decision.

3. It is possible to decide the present case without prejudging the issues which arise in those other cases, since it turns on a different point.

4. There is an inherent illogicality in a situation in which, as a result of withdrawal of an international application, it is lawful to refund the fee for a supplementary European search, in accordance with Article 10 (4) Rules relating to Fees, but allegedly not lawful to refund the fee for a substantive examination which can never take place.

5. Now it is a well-established principle of interpretation of treaties that one should, if possible, avoid an interpretation which leads to a result which is manifestly absurd or unreasonable in the light of the objects and purposes of the treaty in question. It is undoubtedly for this reason that Article 32 of the Vienna Convention on the Law of

Treaties (cf. Official Journal EPO 1984, at p. 196) permits recourse to supplementary means of interpretation, including preliminary documents, to avoid manifest absurdity or unreasonableness.

6. The Board therefore considers it necessary to examine whether there is any justification in any provision of the EPC, the Implementing Regulations or the Rules relating to Fees for refusing to refund the examination fee in the circumstances of the present case. The provision that a request for examination cannot be withdrawn (Article 94 (2) EPC) clearly does not have the effect that if an application is withdrawn the examination fee paid cannot be repaid: Legal Advice No. 1/79 (*ubi supra*: para IV (4)) could not have been given, if that were so. There is no other provision of the EPC, the Implementing Regulations or the Rules relating to Fees which even implies that an examination fee cannot be refunded if the examination cannot take place.

7. What is suggested in the decision under appeal is that an examination fee paid during the international phase of an international application can be repaid if the application is withdrawn during that phase, because the EPO is precluded from examining the application during that phase by the express provisions of Articles 23 and 40 PCT.

8. The question which arises in the present case is whether the EPO is not also precluded from examining an application under Article 94 (1) EPC when the regional phase has begun, if no supplementary European search report can be drawn up in accordance with Article 157 (2) (a) EPC, because the application has been withdrawn? If it is, then by parity of reasoning with the considerations mentioned in the previous paragraph, the examination fee must be repayable.

9. A *supplementary* European search report is clearly a "European search report" within the meaning of the EPC. (If this were not so, one consequence would be that the fee paid for such a search could not lawfully be refunded in accordance with Article 10 (4) Rules relating to Fees). No special provisions of the Convention or the Implementing Regulations apply to a supplementary report. It follows that Articles 17 and 92 EPC apply to the drawing up of a supplementary European search report: i.e. that the Search Division alone, not the Examining Division, is responsible for drawing it up and sending it to the applicant. The consideration that at that point in time the Examining Division may be responsible for any examination of the application, in accordance with Article 18 (1) EPC, cannot have the effect

of authorising the Examining Division to commence examination, if a supplementary European search report — which is obligatory (Article 157 (2) (a) EPC) — is never going to be made. It follows that if the application is withdrawn before the drawing up of the supplementary European search report can be begun, examination of the application is precluded. In these circumstances, the examination fee is repayable. Reasoning in this way avoids the illogicality referred to in paragraph 4 above.

10. The decision under appeal failed to consider the relevant circumstances of the present case and erred in holding that an examination fee paid during the international phase can "only" be refunded if the application is withdrawn before the start of the regional phase. Accordingly, the decision must be set aside.

11. Since the questions of law arising in this case can be answered clearly by reference to the applicable provisions of the PCT, the EPC and the Rules relating to Fees, the Legal Board of Appeal finds no reason to refer any question to the Enlarged Board of Appeal.

12. Since no substantial procedural violation appears to have taken place, there is no ground for ordering reimbursement of the appeal fee.

ORDER

For these reasons,
it is decided that:

1. The decision of the Formalities Section of Directorate-General 2 dated 18 April 1983 is set aside.
2. The examination fee paid in respect of European patent application No. 79901397.4 shall be refunded in full to the appellant.
3. The request that a question or questions of law should be referred to the Enlarged Board of Appeal is refused.
4. The request for reimbursement of the appeal fee is refused.

Decision of the Legal Board of Appeal of 13 February 1985, J 08/83* (published in the Official Journal of the European Patent Office No. 4/1985, pages 102 to 108)

Headword: "Refund of Examination Fee (PCT)II/WESTERN ELECTRIC"

EPC Articles 16, 18(1), 92, 96, 150, 157, Rule 51(1), Rules of Procedure of the Boards of Appeal Article 9(2), Articles 18, 19 PCT

"Invitation by the EPO"—"Refund of examination fee"

Headnote

I. If a supplementary European search report has to be drawn up in respect of an international application which is deemed to be a European patent application, the applicant is entitled to receive the invitations provided for in Article 96 (1) EPC and Rule 51 (1) EPC.

II. Since in the case of such an international application, responsibility for examination of the application does not pass to the Examining Division until the applicant has indicated under Article 96 (1) EPC that he desires to proceed further with his application, the applicant may obtain a refund of the examination fee if in response to the invitation under Article 96 (1) EPC he withdraws his application, or allows it to be deemed to be withdrawn.

Summary of Facts and Submissions

I. On 28 July 1980, the appellant filed an international application under the Patent Cooperation Treaty (PCT) in the United States of America, claiming priority from a U.S. national patent application filed on 30 August 1979. The European Patent Office was a designated Office for the purposes of the PCT, as three EPC Contracting States were designated, it being indicated that it was desired to obtain a European patent for those States. The application was allotted the European patent application number 80901737.9.

II. The international search report was transmitted to the appellant by the United States PCT International Searching Authority on 30 October 1980. In December 1980, the appellant filed amended claims with the International Bureau. The international application was published with the amended claims and the international search report on 5 March 1981. Having paid the national fees on 21 April 1981 and the examination fee on 6 August 1981, the appellant filed a request for examination with the European Patent Office in due time on 11 August 1981.

III. The supplementary European search report was transmitted to the appellant's representative on 16 February 1982. By letter dated 22 April 1982, the representative informed the European Patent Office that the applicant did not wish to proceed further with the application and that it was thereby withdrawn. In reliance on the reasoning of Legal Advice No. 1/1979 (OJ EPO 1979, 61), a refund of the examination fee was claimed.

IV. By a communication dated 20 May 1982, a Formalities Officer of Directorate-General 2 advised the appellant's representative that no refund of the examination fee was possible and that, if the appellant disagreed with this finding, a decision might be requested under Rule 69 (2) EPC.

V. By letter dated 5 July 1982, the appellant's representative duly requested such a decision. It was submitted that the supplementary European search report was part of the European search report for the purposes of Article 96 (1) EPC.

The transmittal of the supplementary European search report was the relevant act for the purposes of Article 96 (1) EPC and the appellant had been denied the opportunity to claim the benefit of a refund of the examination fee in accordance with Legal Advice No. 1/1979 as no invitation under that Article had been sent.

VI. The Decision under appeal, given on 18 April 1983, refused the request for a refund of the examination fee on the ground that an applicant for an international application which was deemed to be a European patent application (a "Euro-PCT application") had the right to a refund only if the application was withdrawn before the start of the regional phase, prior to which, in accordance with Articles 23 (1) and 40 (1) PCT, the EPO was forbidden to process or examine the application.

VII. By letter dated 8 June 1983, the appellant gave notice of appeal against the Decision, appealing against the whole of the decision and requesting that it be reversed and that the refund of the examination fee be ordered. The appeal fee was duly paid.

VIII. In the Statement of Grounds of the appeal, duly filed on 25 July 1983, the appellant contended that no provision of the EPC or the Implementing Regulations ruled out a refund of the examination fee. Article 96 (1) EPC applied in the present case, as did Legal Advice No. 1/1979. Furthermore, it was in the public interest and also that of the EPO that by having the prospect of a refund of the examination fee applicants should be positively encouraged to review their applications when invited to do so and to withdraw those that were likely to be unsuccessful before examination was commenced. There was also a moral justification for a refund: the examination fee was a fee for substantive examination and in the present case there had been no such examination.

IX. In a communication issued on 17 July 1984, the Legal Board of Appeal indicated that there appeared to be difficulties in accepting that Article 96 (1) EPC applied in the case of a Euro-PCT application. Attention was drawn *inter alia* to statements made to the Standing Advisory Committee of the European Patent Office (SACEPO) in 1981, by a representative of Directorate-General 5.

X. In reply to the communication, by letter dated 11 September 1984, the appellant's representative requested to be heard in oral proceedings. After consultation with the representative and also with the representative of the appellant in Case No. J 09/83, in which case the same points of law arose, oral proceedings were appointed for and held on 23 January 1985.

* Official text.

XI. With the agreement of the representatives concerned, the oral proceedings in both cases were consolidated (cf. Rules of Procedure of the Boards of Appeal, Article 9 (2)). After hearing the representatives of both appellants the Board stated that it would reserve its decision in each case and that if it did not find it possible to come to a positive decision in favour of the appellant it would consider submitting a point of law to the Enlarged Board of Appeal. The appellant's representative indicated that he would like the Board to formulate any question to be put to the Enlarged Board of Appeal but that he would appreciate the opportunity of making observations to the Board before the question was submitted.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.

2. The question raised in the present case, whether the examination fee may be refunded when a "Euro-PCT" application is withdrawn after receipt of the supplementary European search report, is one which has long been recognised as giving rise to legal difficulty. It has been considered on several occasions by the Legal Service of the European Patent Office and was discussed in 1981 by the Standing Advisory Committee of the European Patent Office (SACEPO), without positive result.

3. Since an early stage in the work of the European Patent Office, it has been the practice to refund the examination fee when a European patent application which is not a "Euro-PCT" application is withdrawn before responsibility for the application has passed from the Receiving Section to an Examining Division. According to the views expressed in Legal Advice No. 1/79 (OJ EPO 1979, 61), this is justified because the purpose behind the provisions of Article 96 (1) EPC is to avoid unnecessary initiation of the examining procedure.

4. Article 96 (1) EPC provides that "if the applicant for a European patent has filed the request for examination before the European search report has been transmitted to him, the European Patent Office shall invite him after the transmission of the report to indicate whether he desires to proceed further with the European patent application." If he does not wish to proceed further, he may simply refrain from answering the invitation within the time limit, so that the application is deemed to be withdrawn pursuant to Article 96 (3) EPC.

5. Rule 51 (1) EPC provides that, in the invitation pursuant to Article 96 (1) EPC, the European Patent Office shall invite the applicant, if he wishes, to comment on the European search report and to amend, where appropriate, the description, claims and drawings.

6. The provisions of Article 96 (1) EPC and Rule 51 (1) EPC clearly operate in the respective interests of applicants, third parties and the European Patent Office by encouraging applicants to review their applications critically and realistically in the light of the European search report, before substantive examination begins. The opportunity given by the Office to obtain a refund of the substantial fee for examination by withdrawing the application at that stage, or allowing it to be deemed to be withdrawn, provides an additional incentive to withdraw cases which are unlikely to succeed.

7. Article 96 (1) EPC and Rule 51 (1) EPC confer rights upon an applicant for a European patent which he otherwise would not enjoy.

The applicant may of his own volition amend the description, claims and drawings after receiving the European search report (Rule 86 (2) EPC). Moreover, since he has the right under Rule 51 (1) EPC to comment on the European search report at that stage, he can expect to receive the Examining Division's response to his comments in the first communication, which can be to his advantage because of his right to submit amendments with his reply to that communication (Rule 86 (3) EPC).

8. As a matter of principle, the applicant for an international application which is deemed to be a European patent application in accordance with the provisions of Article 150 (3) EPC must be entitled to the same rights as any other applicant for a European patent. There can be no discrimination between applicants. Nevertheless, distinctions can properly be made between applicants in different legal situations.

9. In the case of an international application, Article 157 (1) EPC provides *inter alia* that, without prejudice to the provisions of Article 157 (2) to (4) EPC, the international search report, which is drawn up and transmitted to the applicant by the international searching authority under Article 18 PCT, shall take the place of the European search report. Article 19 PCT gives the applicant the opportunity to amend the claims of the international application in the international phase.

In contrast, Article 92 (1) EPC provides for the drawing up and Article 92 (2) EPC provides for transmittal to the applicant of the European search report by the EPO. The invitations required to be given under Article 96 (1) EPC and Rule 51 (1) EPC are sequential to and consequent upon the provisions relating to the drawing up and transmittal of the European search report. Hence, it can be concluded from the context that if those provisions do not apply, then Article 96 (1) EPC and Rule 51 (1) EPC do not apply either.

10. According to Article 16 EPC, the Receiving Section ceases to be responsible for a European patent application when a request for examination has been made or the applicant has indicated under Article 96 (1) EPC that he desires to proceed further with his application. In the case of an international application for which no supplementary European search report has to be drawn up, for the reason given in the previous paragraph, the reference to Article 96 (1) EPC in Article 16 EPC has to be ignored as inapplicable. Therefore, it is correct to say that the Examining Division assumes responsibility for such an international application when the request for examination has been made.

11. The question whether Article 16 EPC applies differently in a case in which a supplementary European search report is required in accordance with Article 157 (2) (a) EPC can only be answered by considering the legal nature of a supplementary European search report. As the Board has already decided in Case J 06/83** (Decision of 25 September 1984), a supplementary European search report has to be considered to be a European search report within the meaning of the EPC for certain purposes and the provisions of Articles 17 and 92 EPC apply to its drawing up and transmittal to the applicant by a Search Division.

12. Bearing in mind the matters considered above in paragraphs 7 to 9, the Board concludes from the language of Article 96 (1) EPC, from its purpose, and from its context in the other provisions of the EPC, that there is every reason to consider that the reference in Article 96 (1) EPC to transmittal of the European search report must be interpreted as including transmittal of a supplementary European search report.

13. It follows that Article 16 EPC applies to its full extent in a case in which a supplementary European search report is transmitted. The making of a request for examination before the supplementary European search report has been transmitted to the applicant does not have the effect of immediately transferring responsibility for the application to the Examining Division. In this respect, the Guidelines for Examination in the European Patent Office Part C-VI, 1.1.3., October 1981, cannot be followed by the Board. Thus, the applicant is in the same legal position as any other applicant who is entitled to receive invitations under Article 96 (1) and Rule 51 (1) EPC.

14. Applying Article 16 EPC in the present case, it is clear that responsibility for the application did not pass from the Receiving Section to the Examining Division at any time. Since the appellant corporation never received the invitations under Article 96 (1) and Rule 51 (1) EPC to which it was entitled, it never had any opportunity to respond.

15. In these circumstances, the decision under appeal must be set aside and the appellant is entitled to a refund of the examination fee.

16. The Legal Board of Appeal considers that as the legal position under the EPC is clear, it is unnecessary to refer any question of law to the Enlarged Board of Appeal for decision.

17. Although the Legal Board of Appeal has decided that, contrary to the previously accepted general opinion, the responsibility for the application did not pass to the Examining Division at any time, the action of the Examining Division in deciding the case in accordance with the prevailing interpretation of the EPC cannot be regarded as a substantial procedural violation within the meaning of Rule 67 EPC such as to justify reimbursement of the appeal fee.

ORDER

For these reasons,

it is decided that:

1. The decision of the Formalities Section of Directorate-General 2 of the European Patent Office dated 18 April 1983 is set aside.
2. The examination fee paid in respect of the European patent application shall be refunded to the appellant.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

FEES PAYABLE UNDER THE PCT

Fees Payable to the Receiving Office

United States of America

Pursuant to Rule 16.1(d) of the Regulations under the PCT, a new amount in US Dollar, as indicated below, has been established for the search fee for an international search by the European Patent Office. The new amount is applicable as from August 10, 1985.

Kind of Fee	Amount US Dollar
Search Fee (international search by the European Patent Office)	680

DESIGNATED (OR ELECTED) OFFICES

Norwegian Patent Office

Time Limit under PCT Article 22(2)

The International Bureau has been notified by the Patent Office of Norway of the withdrawal of its notification excluding, for a transitory period, the modified time limit of 20 months from the priority date under Article 22(2) (see PCT Gazette no. 25/1984, page 3098). The modified time limit under Article 22(2) is, according to that notification, compatible with the Norwegian Patents Act as from July 1, 1985.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

RECEIVING OFFICES

Competent Receiving Offices

Barbados has, pursuant to Rule 19.1(b), agreed with the International Bureau of WIPO that the International Bureau shall act instead of its national Office (Corporate Affairs and Industrial Property Office) as receiving Office for international applications filed by applicants who are residents or nationals of Barbados.

Competent International Searching and International Preliminary Examining Authorities

The competent **International Searching Authorities** for international applications filed by applicants who are residents or nationals of **Barbados** are: Austrian Patent Office, European Patent Office, Royal Patent and Registration Office (Sweden) or United States Patent and Trademark Office.

The competent **International Preliminary Examining Authorities** for international applications filed by applicants who are residents or nationals of **Barbados** are: Austrian Patent Office, European Patent Office, Royal Patent and Registration Office (Sweden) or United Kingdom Patent Office.

INTERNATIONAL SEARCHING AUTHORITIES

AGREEMENT BETWEEN THE UNITED STATES PATENT AND TRADEMARK OFFICE AND THE INTERNATIONAL BUREAU OF WIPO

The United States Patent and Trademark Office has notified the International Bureau of WIPO, pursuant to Article 15(2) of the Agreement (published in PCT Gazette No. 02/1978, pages 139 to 145, and No. 03/1978, page 180), of an amendment to Annex A of this Agreement. The amended Annex A reads as follows:

“ANNEX A

COUNTRIES AND LANGUAGES UNDER ARTICLE 3 OF THIS AGREEMENT

The Authority will conduct international searches and prepare international search reports

(i) for the following countries:*

United States of America, Brazil, Barbados

(ii) in the following languages:

English.”

* In the second session of the Preparatory Intergovernmental Committee on the Revision of the Paris Convention for the Protection of Industrial Property, June 29 to July 8, 1977, the Delegation of the United States of America offered the services of its International Searching Authority (the Authority under this Agreement) to all nationals of countries of the western hemisphere party to the PCT on the same conditions these services would be available to its own nationals. This offer stands.

DESIGNATED (OR ELECTED) OFFICES**Finnish Patent Office****Time Limits under PCT Articles 22(2) and 39(1)(a)**

The International Bureau has been notified by the Patent Office of Finland of the withdrawal of its notification excluding, for a transitory period, the modified time limit of 20 months from the priority date under Article 22(2) and the modified time limit of 30 months from the priority date under Article 39(1)(a) (see PCT Gazette No. 25/1984, page 3098). The modified time limits under Articles 22(2) and 39(1)(a) are, according to that notification, compatible with the Finnish Patents Act as from September 1, 1985.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

RECEIVING OFFICES

Computation of Dates: Offices Excluding Rule 80.6(a), second sentence

The International Bureau has been notified of the withdrawal of earlier notifications pursuant to PCT Rule 80.6(b) for the purpose of excluding the application of PCT Rule 80.6(a), second sentence, by the Offices, as receiving Offices under the PCT, of the following three countries:

Denmark, with effect from July 5, 1985,
Finland, with effect from September 1, 1985,
Norway, with effect from July 1, 1985.

Thus, as from September 1, 1985, PCT Rule 80.6(a), second sentence, will be applicable for all receiving Offices.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

FEES PAYABLE UNDER THE PCT

New Amounts of Fees

The **European Patent Office** has established new amounts in **Lira** and in **Pound Sterling** of fees fixed in the EPO's Schedule of Fees as specified below. The new amounts, which correspond to the fees published in PCT Gazette No. 06/1985 of March 14, 1985, are applicable as from August 16, 1985.

Kind of Fee	New Amount	
	(Lira)	(Pound Sterling)
Transmittal fee	128,000	49
Fee for priority document (PCT Rule 17.1(b))	22,000	8
Search Fee (for an international search)	1,445,000	554 *
Preliminary examination fee	1,462,000	560
Fee for copies	900	0.30
National fee	386,000	148
Search fee (for a European search)	1,234,000	473
European designation fee	193,000	74
Claims fee	45,000	17
Examination fee	1,462,000	560
Renewal fee for the third year	317,000	122

The **National Institute of Industrial Property of Brazil** has notified new amounts of fees, as specified below. The new amounts are applicable as from July 1, 1985:

Kind of Fee	New Amount (Cruzeiro)
Transmittal fee	100,264
Fee for priority document	32,586
National filing fee for patent	75,198
National filing fee for utility model	50,132
First annual fee for patent	125,330
First annual fee for utility model	62,665

DESIGNATED (OR ELECTED) OFFICES

United Kingdom Patent Office

Time limits under PCT Articles 22(2) and 39(1)(a)

The International Bureau has been notified by the United Kingdom Patent Office of the withdrawal of its notification excluding, for a transitory period, the modified time limit of 20 months from the priority date under Article 22(2) and the modified time limit of 30 months from the priority date under Article 39(1)(a) (see PCT Gazette No. 25/1984, page 3098). The modified time limits under Articles 22(2) and 39(1)(a) are, according to that notification, compatible with the national law of the United Kingdom as from September 1, 1985.

* This amount applies also to payments made to the **United Kingdom Patent Office** as receiving Office from the same date.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

FEES PAYABLE UNDER THE PCT

Fees payable to the Receiving Office

United States of America

Pursuant to Rules 15.2(d) and 16.1(d) of the Regulations under the PCT, new amounts in **US dollars**, as indicated below, have been established.

Kind of fee	Amount US dollar
Basic fee:	280
Supplement per sheet over 30:	6
Designation fee:	70
Maximum of designation fee:	700
Fee for international search by the European Patent Office:	750

The new amount of the fee for international search by the European Patent Office is applicable as from October 12, 1985. The new amounts for the other fees referred to above are applicable as from October 29, 1985.

INFORMATION ON CONTRACTING STATES

United Kingdom

The United Kingdom Patent Office has notified a new address as from September 23, 1985, as follows:

The Patent Office
State House
67-71 High Holborn
London WC1R 4TP
United Kingdom
Telephone: (01) 831-2525

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

FEES PAYABLE UNDER THE PCT

New Amounts of fees

Italy

Pursuant to Rules 15.2(d) and 57.2(e) of the Regulations under the PCT, new amounts in Lira, as indicated below, have been established. The new amounts are applicable as from November 12, 1985.

Kind of fee	New Amount Lira
Basic fee:	541,000
Supplement per sheet over 30:	11,000
Designation fee:	131,000
Maximum of designation fee:	1,310,000
Handling fee:	165,000

United States of America

The United States Patent and Trademark Office has notified the following new amounts of fees applicable as from October 5, 1985.

Kind of fee	New Amount US dollar
Transmittal fee	170
Search fee*	420
Additional search fee*	140
Fee for priority document	12
National fee*	
Basic filing fee	340 (170)**
Additional fee for each claim in independent form in excess of 3	34 (17)**
Additional fee for each claim, independent or dependent, in excess of 20	12 (6)**
In addition, if the application contains a multiple dependent claim(s), per application	110 (55)**

* See also the amendment to Annex C, published below, of the Agreement between the United States Patent and Trademark Office and WIPO.

** The amount in parentheses is applicable in case of filing by a "small entity".

INTERNATIONAL SEARCHING AUTHORITIES

AGREEMENT BETWEEN THE UNITED STATES PATENT AND TRADEMARK OFFICE AND THE INTERNATIONAL BUREAU OF WIPO*

AMENDMENT TO ANNEX C

The United States Patent and Trademark Office has notified the International Bureau, pursuant to Article 15(4) of the Agreement, of amendments to Annex C of the Agreement. The new amounts of fees are payable as from October 5, 1985. The amended Annex C reads as follows:

"ANNEX C

SCHEDULE OF FEES AND EXTENT AND CONDITIONS OF REDUCTIONS OR REFUNDS OF THE SEARCH FEE FOR THE PURPOSES OF ARTICLE 7 OF THE AGREEMENT

(a) Fees

Search fee

(i) where no corresponding prior U.S national application with basic filing fee has been filed	\$420.00
(ii) where a corresponding prior U.S. national application with basic filing fee has been filed	\$250.00
Supplemental Search Fee (per additional invention).....	\$140.00
Preparation of an International-Type Search Report in a U.S. national application.....	\$28.00

(b) Extent and Conditions of Refunds of the Search Fee

- (i) Money paid for Search Fees, where paid by actual mistake or in excess will be refunded.
- (ii) A credit of \$170.00 may be made where a Search Fee has been paid on the corresponding international application to the Authority, if requested at the time of paying the national fee.
- (iii) Refund of the Supplemental Search Fee will be made if such refund is determined to be warranted by the Commissioner of Patents and Trademarks or his designee acting under Rule 40.2(c).
- (iv) The Search Fee will be refunded if the determination under Article 11(1) is negative."

* Published in PCT Gazette No. 02/1978, pages 139 to 145, PCT Gazette No. 03/1978, page 180, PCT Gazette No. 21/1982, page 2359, PCT Gazette No. 23/1983, page 2483, and PCT Gazette No. 16/1985, page 2261.

REFERENCES TO DEPOSITS OF MICROORGANISMS

Pursuant to Rule 13bis.7 of the Regulations under the PCT, the **National Board of Patents and Registration of Finland** has notified the International Bureau about amendments to the national law concerning micro-biological inventions which took effect on September 1, 1985.

The table concerning References to Deposits of Microorganisms, contained in Annex M1, published in PCT Gazette No. 06/1985 on pages 748 to 750, is, pursuant to the information received from the Finnish National Board of Patents and Registration, amended as follows:

1st column (Designated Office):	Finland, National Board of Patents and Registration
2nd column (Additional Indications):	To the extent available to the applicant, all significant information on the characteristics of the microorganism
3rd column (Time Earlier Than 16 Months From The Priority Date):	In the case of (A): where applicant requests publication earlier than 16 months from the priority date, not later than that request In the case of (B): at the time of filing (as part of the application)
4th column (Depositary Institutions):	See footnotes (1) and (12), below

Footnote (1): the text is reproduced in PCT Gazette No. 06/1985, page 749.

Footnote (12): *Finnish National Board of Patents and Registration:* The applicant may request that, until the application has been laid open to public inspection (by the National Board of Patents and Registration), or has been finally decided upon by the National Board of Patents and Registration without having been laid open to public inspection, the furnishing of a sample shall only be effected to an expert in the art. The request to this effect shall be filed by the applicant with the International Bureau before the expiration of 16 months from the priority date (preferably on the Form PCT/RO/134 reproduced in Annex M3 of Volume I of the PCT Applicant's Guide). Such request shall indicate the expert to be used. That expert may be any person entered on a list of recognized experts drawn up by the National Board of Patents and Registration or any person approved by the applicant in the individual case.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

RECEIVING OFFICES

INTERNATIONAL SEARCHING AUTHORITIES

INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES

1. As from October 1, 1985, it will be possible to file international applications in English with the **Japanese Patent Office** as receiving Office.

2. The **Japanese Patent Office** has made the following declaration, with effect as from October 1, 1985:

(i) the **European Patent Office** is specified as International Searching and Preliminary Examining Authority for 200 international applications per year which are filed in English with the Japanese Patent Office as receiving Office;

(ii) the **Japanese Patent Office** will act as International Searching and Preliminary Examining Authority for the international applications filed in English with the Japanese Patent Office as receiving Office which exceed the limit of 200 per year.

3. The equivalent in Yen of the fee for an international search by the **European Patent Office** has been established as indicated below:

Kind of fee	Amount
Search fee (PCT Rule 16)	Yen 179,000

INTERNATIONAL SEARCHING AUTHORITIES

INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES

AGREEMENT BETWEEN THE JAPANESE PATENT OFFICE AND THE INTERNATIONAL BUREAU OF WIPO

AMENDMENT TO ANNEX A

The **Japanese Patent Office** has notified the International Bureau of WIPO, pursuant to Article 16(3)(i) of the Agreement*, of an amendment in Annex A(b) of the Agreement. The amendment becomes effective on October 1, 1985.

“ANNEX A

CONTRACTING STATES AND LANGUAGES SPECIFIED FOR THE PURPOSES OF ARTICLE 3 OF THE AGREEMENT

(a) Contracting States

Japan
Republic of Korea

(b) Languages

Japanese
English (where the international application is filed with the Japanese Patent Office)”.
* Published in PCT Gazette No. 04/1978, pages 213 to 221, No. 06/1984, page 663, No. 15/1984, page 1805, and No. 23/1984, page 2819.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

INFORMATION ON CONTRACTING STATES

United Kingdom

Corrigendum

relating to the information published in PCT Gazette No. 19/1985,
Section IV, of August 29, 1985, on page 2695

The United Kingdom Patent Office has corrected and supplemented the notification of its new address as from September 23, 1985, as follows:

The Patent Office
State House
66-71 High Holborn
London WC1R 4TP
United Kingdom

Telephone: (01) 829 6906 - for procedural matters relating to international applications under the PCT
(01) 831 2525 - for operator service if extension is not known.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

MEETINGS OF THE INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Thirteenth Session
(5th Ordinary)
(Geneva, September 23 to October 1, 1985)

Note*

The Assembly of the International Patent Cooperation Union (PCT Union) held its thirteenth session (5th ordinary) in Geneva from September 23 to October 1, 1985, within the framework of the sixteenth series of meetings of the Governing Bodies of the World Intellectual Property Organization (WIPO) and the Unions administered by WIPO.

Twenty-nine PCT Contracting States were represented at the session: Australia, Austria, Belgium, Brazil, Bulgaria, Cameroon, Democratic People's Republic of Korea, Denmark, Finland, France, Germany (Federal Republic of), Hungary, Italy, Japan, Luxembourg, Madagascar, Monaco, Netherlands, Norway, Republic of Korea, Romania, Senegal, Soviet Union, Sri Lanka, Sudan, Sweden, Switzerland, United Kingdom and United States of America.

A number of other States, of intergovernmental organizations and of international non-governmental organizations participated in the session as observers.

New amounts of fees set out in the Schedule of Fees annexed to the PCT Regulations were fixed by the Assembly as from January 1, 1986. They are, in Swiss Francs, approximately 8% higher than the fees applicable in 1985. The amended Schedule of Fees appears on page 3306. The equivalent amounts in other currencies, established on the basis of the exchange rates applicable in Switzerland on September 30, 1985, are published on page 3307. The Assembly also decided that no further increase in the fees in Swiss Francs should be made for 1987.

Moreover, the Assembly:

- decided that the PCT Gazette would continue to be published in an English-language edition and a French-language edition, the two editions being separate;

- noted that the sales price of the PCT pamphlets would be 11 Swiss francs per copy for 1986 and 1987;

- decided that the present format of the PCT pamphlets should not be changed, at least as regards the printing of drawings and the number of pages of the international application which should appear on each page of the pamphlet;

- agreed to postpone any decision concerning the establishment of the Executive Committee until any State member of the PCT Union or the Director General proposed that the matter be reconsidered;

- decided that all PCT Contracting States--in addition, in the case of the Committee for Technical Cooperation, to the *ex officio* members according to Article 56(2)(b) of the PCT--would continue to be members of the Committee for Technical Cooperation and the Committee for Technical Assistance until any State member of the PCT Union or the Director General proposed that the matter be reconsidered.

* This Note was prepared by the International Bureau.

FEES PAYABLE UNDER THE PATENT COOPERATION TREATY (PCT)

SCHEDULE OF FEES

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
if the international application contains not more than 30 sheets	706 Swiss francs
if the international application contains more than 30 sheets	706 Swiss francs plus 14 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	171 Swiss francs per designation for which the fee is due, with a maximum of 1,710 Swiss francs, any such designation in excess of 10 being free of charge
3. Handling Fee: (Rule 57.2(a))	216 Swiss francs
4. Supplement to the Handling Fee: (Rule 57.2(b))	216 Swiss francs
Surcharges	
5. Surcharge for late payment: (Rule 16bis.2(a))	Minimum: 268 Swiss francs Maximum: 674 Swiss francs

EQUIVALENT AMOUNTS

New amounts as indicated below have been established for the fees specified, pursuant to Rules 15.2(b) and (c) and 57.2(c) and (d) of the Regulations under the PCT. The new amounts are applicable as of January 1, 1986.

Country Currency	Basic Fee where no Additional Amount Payable for Sheets in Excess of 30 Sheets Rule 15.2(a)	Amount Added to Basic Fee for Each Sheet in Excess of 30 Sheets Rule 15.2(a)	Designation Fee Rule 15.2(a)	Handling Fee Rule 57.2(a)
Australia <i>Australian Dollar</i>	450	9	109	138
Austria <i>Schilling</i>	6,100	120	1,480	1,870
Belgium <i>Belgian Franc</i>	17,800	350	4,300	5,400
Denmark <i>Danish Krone</i>	3,180	63	770	—
Finland <i>Markka</i>	1,880	37	455	see Sweden
France <i>French Franc</i>	2,670	53	645	815
Germany (Federal Republic of) <i>Deutsche Mark</i>	870	17	210	265
Italy <i>Lira</i>	588,000	12,000	143,000	180,000
Japan <i>Yen</i>	70,300	1,400	17,000	21,500
Luxembourg <i>Luxembourg Franc or Belgian Franc</i>	17,800	350	4,300	5,400
Malawi <i>Kwacha</i>	568	11	138	see United Kingdom
Monaco <i>French Franc</i>	2,670	53	645	815
Netherlands <i>Netherlands Guilder</i>	980	19	240	300
Norway <i>Norwegian Krone</i>	2,600	52	630	—
Republic of Korea <i>Won</i>	280,000	5,500	68,000	—
Soviet Union <i>Rouble</i>	244	5	59	75
Sweden <i>Swedish Krona</i>	2,630	52	640	810
United Kingdom <i>Pound Sterling</i>	232	5	56	71
United States of America <i>US Dollar</i>	325	6	80	—

Note: For payments to the European Patent Office, the amounts, if not in Swiss Francs, are those appearing in the table above in the following currencies: Belgian Franc, Deutsche Mark, French Franc, Lira, Luxembourg Franc, Netherlands Guilder, Pound Sterling, Schilling, Swedish Krona.

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

DESIGNATED (OR ELECTED) OFFICES

Japanese Patent Office

Time limits under PCT Articles 22(2) and 39(1)(a)

The International Bureau has been notified by the **Japanese Patent Office** of the withdrawal of its notification excluding, for a transitory period, the modified time limit of 20 months from the priority date under Article 22(2) and the modified time limit of 30 months from the priority date under Article 39(1)(a) (see PCT Gazette No. 25/1984, page 3098). The modified time limits under Articles 22(2) and 39(1)(a) are, according to that notification, compatible with the Japanese Patent Law as from November 1, 1985. However, it is recalled that, even where Article 39(1) applies, the translation of the international application into Japanese must always be furnished within 20 months from the priority date.

Thus, all notifications excluding, for a transitory period, the modified time limits under Articles 22(2) and 39(1)(a) have been withdrawn.

Reduction of Fees in the National Phase

The International Bureau has been informed by the **Japanese Patent Office** that, as from November 1, 1985, the fee for request for examination payable to the Japanese Patent Office is as follows:

	Patents	Utility Models
	(Currency: Yen)	
Where the international search report has been established		
- by the Japanese Patent Office (80% reduction)	6,600, plus 1,100 per invention	4,200
- by an International Searching Authority other than the Japanese Patent Office (20% reduction)	26,000, plus 4,200 per invention	17,000

Requirements Concerning the Entry into the National Phase

The **Japanese Patent Office** has also informed the International Bureau that, as from November 1, 1985:

- (i) the translation of the international application into Japanese no longer needs to contain the request;
- (ii) a copy of the drawings is no longer required to be furnished together with the translation of the international application into Japanese (see, however, PCT Rule 49.5(d) for the case where any drawing contains text matter);
- (iii) as regards the requirements referred to in PCT Rule 51bis.1(a)(vi) (evidence concerning exceptions to lack of novelty) and in PCT Rule 51bis.1(b)(i) (representation by an agent), another opportunity of fulfilling those requirements is given to the applicant even after the expiration of the time limit applicable under PCT Article 22 or 39(1).

SECTION IV

NOTICES AND INFORMATION OF A GENERAL CHARACTER

INTERNATIONAL SEARCHING AUTHORITIES

AGREEMENT BETWEEN THE ROYAL PATENT AND REGISTRATION OFFICE OF SWEDEN AND THE INTERNATIONAL BUREAU OF WIPO

AMENDMENT TO ANNEX C

The **Royal Patent and Registration Office of Sweden** has notified the International Bureau of WIPO, pursuant to Article 16(3)(iii) of the Agreement*, of an amendment (new amount of the fee for translation of the international application) of Annex C, paragraph (a), of the Agreement with effect from January 1, 1986. The amended Schedule of fees and charges reads as follows:

"ANNEX C

SCHEDULE OF FEES AND CHARGES OF THE AUTHORITY AND EXTENT AND CONDITIONS OF REFUNDS OF THE SEARCH FEE FOR THE PURPOSES OF ARTICLE 7 OF THE AGREEMENT

(a) Schedule of fees and charges

Fee	Amount in Sw. Crs.
Search fee (Rule 16.1(a)).....	2,200.--
Search fee in case the search report is based on an earlier search report already prepared by the Royal Patent and Registration Office of Sweden or by a national Office of a Contracting State referred to in Article 3(1)(i) of this Agreement on an application whose priority is claimed for the international patent application.....	1,600.--
Additional fee (Rule 40.2(a)).....	2,200.--
Translation of international application (Rule 48.3).....	1.10/word
Preparing and mailing copies of all documents cited in the:	
- international search report (Rule 44.3(b)) (as requested when the international application is filed).....	150.--/set
- international preliminary examination report (Rule 71.2(b)) (as requested when the demand is filed).....	150.--/set
Preparing and mailing copies of individual documents cited in the international search report or the international preliminary examination report (Rule 44.3(b) and 71.2(b)).....	1.75/page
Preliminary examination fee (Rule 58.1(b))	1,500.--
Additional fee (Rule 68.3(a)).....	1,500.--"

* Published in PCT Gazette No. 02/1978, pages 116 to 124, No. 09/1980, page 606, No. 13/1982, pages 1331 and 1332, and No. 06/1984, page 663.

REFERENCES TO DEPOSITS OF MICROORGANISMS

Pursuant to Rule 13bis.7 of the Regulations under the PCT, the **Norwegian Patent Office** has notified the International Bureau about amendments to the national law concerning microbiological inventions which will take effect on January 1, 1986.

The table concerning References to Deposits of Microorganisms, contained in Annex M1, published in PCT Gazette No. 06/1985 on pages 748 to 750, is, pursuant to the information received from the Norwegian Patent Office, amended as follows:

1st column (Designated Office):	Norway, Norwegian Patent Office
2nd column (Additional Indications):	To the extent available to the applicant, all significant information on the characteristics of the microorganism
3rd column (Times Earlier Than 16 Months From the Priority Date):	In the case of (A): where applicant requests publication earlier than 16 months from the priority date, not later than that request In the case of (B): at the time of filing (as part of the application)
4th column (Depositary Institutions):	See footnotes (1) and (13), below

Footnote (1): the text is reproduced in PCT Gazette No. 06/1985, page 749.

Footnote (13): *Norwegian Patent Office:* The applicant may request that, until the application has been laid open to public inspection (by the Norwegian Patent Office), or has been finally decided upon by the Norwegian Patent Office without having been laid open to public inspection, the furnishing of a sample shall only be effected to an expert in the art. The request to this effect shall be filed by the applicant with the International Bureau before the completion of technical preparations for international publication (preferably on the Form PCT/RO/134 reproduced in Annex M3). Any request for furnishing of a sample shall indicate the expert to be used. That expert may be any person entered on a list of recognized experts drawn up by the Norwegian Patent Office or any person approved by the applicant in the individual case.