

**AMENDMENTS TO THE REGULATIONS
UNDER THE PATENT COOPERATION TREATY (PCT)**

Adopted on October 14, 2015, by the Assembly of the International Patent Cooperation Union
(PCT Union) at its Forty-Seventh (20th Ordinary) Session held from October 5 to 14, 2015,
with effect from July 1, 2017

**Rule 12bis
Submission by the Applicant of Documents Relating to Earlier Search**

*12bis.1 Furnishing by the Applicant of Documents Related to Earlier Search in Case of
Request under Rule 4.12*

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to paragraphs (b) to (d), submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.

(b) Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copy referred to in paragraph (a), indicate the wish that the receiving Office prepare and transmit it to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.

(c) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy referred to in paragraph (a) shall be required to be submitted under that paragraph.

(d) Where a copy referred to in paragraph (a) is available to the receiving Office or the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, and the applicant so indicates in the request, no copy shall be required to be submitted under that paragraph.

*12bis.2 Invitation by the International Searching Authority to Furnish Documents Related to
Earlier Search in Case of Request under Rule 4.12*

(a) The International Searching Authority may, subject to paragraphs (b) and (c), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:

- (i) a copy of the earlier application concerned;
- (ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;

(iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;

(iv) a copy of any document cited in the results of the earlier search.

(b) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, or where a copy or translation referred to in paragraph (a) is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, or in the form of the priority document, no copy or translation referred to in paragraph (a) shall be required to be submitted under that paragraph.

(c) Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (a)(i) and (ii) shall be required to be submitted under those paragraphs.

Rule 23bis

Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 Transmittal of Documents Relating to Earlier Search in Case of Request under Rule 4.12

(a) The receiving Office shall transmit to the International Searching Authority, together with the search copy, any copy referred to in Rule 12bis.1(a) related to an earlier search in respect of which the applicant has made a request under Rule 4.12, provided that any such copy:

- (i) has been submitted by the applicant to the receiving Office together with the international application;
- (ii) has been requested by the applicant to be prepared and transmitted by the receiving Office to that Authority; or
- (iii) is available to the receiving Office in a form and manner acceptable to it, for example, from a digital library, in accordance with Rule 12bis.1(d).

(b) If it is not included in the copy of the results of the earlier search referred to in Rule 12bis.1(a), the receiving Office shall also transmit to the International Searching Authority, together with the search copy, a copy of the results of any earlier classification effected by that Office, if already available.

23bis.2 Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2

(a) For the purposes of Rule 41.2, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, the receiving Office shall, subject to paragraphs (b), (d) and (e), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are available to the Office, and a copy of the results of any such earlier classification effected by the Office, if already available. The receiving Office may also transmit to the International Searching Authority any further documents relating to such an earlier search which it considers useful to that Authority for the purposes of carrying out the international search.

(b) Notwithstanding paragraph (a), a receiving Office may notify the International Bureau by April 14, 2016 that it may, on request of the applicant submitted together with the international application, decide not to transmit the results of an earlier search to the International Searching Authority. The International Bureau shall publish any notification under this provision in the Gazette.

(c) At the option of the receiving Office, paragraph (a) shall apply *mutatis mutandis* where the international application claims the priority of one or more earlier applications filed with an Office different from the one which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, and the results of any such earlier search or classification are available to the receiving Office in a form and manner acceptable to it, for example, from a digital library.

(d) Paragraphs (a) and (c) shall not apply where the earlier search was carried out by the same International Searching Authority or by the same Office as that which is acting as the International Searching Authority, or where the receiving Office is aware that a copy of the earlier search or classification results is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library.

(e) To the extent that, on October 14, 2015, the transmission of the copies referred to in paragraph (a), or the transmission of such copies in a particular form, such as those referred to in paragraph (a), without the authorization by the applicant is not compatible with the national law applied by the receiving Office, that paragraph shall not apply to the transmission of such copies, or to the transmission of such copies in the particular form concerned, in respect of any international application filed with that receiving Office for as long as such transmission without the authorization by the applicant continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 14, 2016. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 41

Taking into Account Results of Earlier Search and Classification

41.1 Taking into Account Results of Earlier Search in Case of a Request under Rule 4.12

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12bis.1 and:

(i) [no change]

(ii) [no change]

41.2 *Taking into Account Results of Earlier Search and Classification in Other Cases*

(a) Where the international application claims the priority of one or more earlier applications in respect of which an earlier search has been carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take the results of any such earlier search into account in carrying out the international search.

(b) Where the receiving Office has transmitted to the International Searching Authority a copy of the results of any earlier search or of any earlier classification under Rule 23bis.2(a) or (b), or where such a copy is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, the International Searching Authority may take those results into account in carrying out the international search.

Rule 86 The Gazette

86.1 *Contents*

The Gazette referred to in Article 55(4) shall contain:

(i) to (iii) [no change]

(iv) information concerning events at the designated and elected Offices notified to the International Bureau under Rule 95.1 in relation to published international applications;

(v) [no change]

86.2 to 86.6 [No change]

Rule 95 Information and Translations from Designated and Elected Offices

95.1 *Information Concerning Events at the Designated and Elected Offices*

Any designated or elected Office shall notify the International Bureau of the following information concerning an international application within two months, or as soon as reasonably possible thereafter, of the occurrence of any of the following events:

- (i) following the performance by the applicant of the acts referred to in Article 22 or Article 39, the date of performance of those acts and any national application number which has been assigned to the international application;
- (ii) where the designated or elected Office explicitly publishes the international application under its national law or practice, the number and date of that national publication;
- (iii) where a patent is granted, the date of grant of the patent and, where the designated or elected Office explicitly publishes the international application in the form in which it is granted under its national law, the number and date of that national publication.

95.2 Furnishing of Copies of Translations

- (a) At the request of the International Bureau, any designated or elected Office shall provide it with a copy of the translation of the international application furnished by the applicant to that Office.
- (b) The International Bureau may, upon request and subject to reimbursement of the cost, furnish to any person copies of the translations received under paragraph (a).