

# WIPO



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## DIPLOMATIC CONFERENCE FOR THE ADOPTION OF THE PATENT LAW TREATY

**Geneva, May 11 to June 2, 2000**

ARTICLES 7, 9 AND 11, AND RULE 12

*Proposal by the Delegation of Germany*

The following modifications are suggested by the German Delegation in order to clarify meaning of certain provisions.

In Article 7(2), item (ii) should be deleted because the procedures concerned described in Article 5 can be very complicated and are much more important than the simple filing of the application. The Office should be permitted to require representation to facilitate the procedure in favour of the applicant.

In Article 7(2), item (vi) should be deleted because the fact that a notification has to be transmitted to the applicant is one of the most important cases where the requirement of representation is needed. In practice, transmission in a foreign country is one of the most complicated and laborious procedures. It is advantageous for the applicant and for the procedure relating to the application for an applicant who does not have any address in the relevant territory to have a representative for the purpose of transmission.

In Article 9, it should be added that a time limit cannot start to run before the applicant has been notified about the time limit and the consequent loss of rights. This addition clarifies the spirit of the Treaty that no loss of rights can occur without any notification by the Office and without any opportunity for the applicant to give his opinion.

In Article 11, clarification is suggested to the effect that the time limit set by the Office will have the direct loss of rights as a consequence. Without that clarification, the relief provided in Article 11 can be confused with the possible appeal against the decision of an Office which is part of the jurisdiction. The aim of the Patent Law Treaty is to harmonize the provisions of formal patent law. It cannot achieve a harmonization of the provisions governing court procedure.

The amendment in Rule 12(4) is suggested in the event that the clarification suggested in Article 11 cannot be adopted. Without the clarification in Article 11, there will be a difference in the time limits provided for the relief in Article 11 and the time limit provided for court procedure. In most cases, the time limit requested for the appeal to a court is shorter than two months. If the clarification suggested in Article 11 cannot be adopted, there will be a need to adjust time limits in court procedures. As the aim of the Patent Law Treaty is not the harmonization of court procedures, there should be more flexibility in Rule 12(4). If the suggested wording cannot be adopted there will be need for a more detailed regulation.

It is suggested that Rule 12(5)(vii) be deleted because there is no need to restrict the Office to giving relief in respect of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted. There can be legitimate reasons for the applicant asking for such relief so that the Office should have the opportunity to decide on its own authority whether to give that relief or not.

The following wording is suggested in the Articles and Rules referred to:

#### *Article 7*

#### *Representation*

(2) [*Mandatory Representation*] A Contracting Party may require that an applicant, owner or other interested person appoint a representative for the purposes of any procedure before the Office after the filing date, other than:

(i) the payment of maintenance fees;

~~[(ii) any procedure referred to in Article 5;]~~

[(iii) the payment of fees;]

[(iv) the filing of a translation;]

[(v) any other procedure as prescribed in the Regulations;]

~~[(vi) the issue of a receipt or notification by the Office in respect of any procedure referred to in item[s] (i) [to (v)].~~

*Article 9*

*Notifications*

(3) [*Failure to Notify*] Subject to Article 10(1), where an Office does not notify an applicant, owner or other interested person of a failure to comply with any requirement under this Treaty or the Regulations, that absence of notification does not relieve that applicant, owner or other interested person of the obligation to comply with that requirement and does not set in motion a time limit fixed by the Office.

*Article 11*

*Relief in Respect of Time Limits*

(1) [*Extension of Time Limits*] A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office in respect of an application or a patent, if the expiry of that time limit has as a consequence the immediate loss of rights, and a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations, and the request is made, at the option of the Contracting Party:

(i) prior to the expiration of the time limit; or

(ii) after the expiration of the time limit, and within the time limit prescribed in the Regulations.

(2) [*Continued Processing*] Where an applicant or owner has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office in respect of an application or a patent, and the expiry of that time limit has as a consequence the immediate loss of rights, and that Contracting Party does not provide for extension of a time limit under paragraph (1)(ii), the Contracting Party shall provide for continued processing with respect to the application or patent and, if necessary, re-instatement of the rights of the applicant or owner with respect to that application or patent, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is made, and all of the requirements in respect of which the time limit for the action concerned applied are complied with, within the time limit prescribed in the Regulations.

*Rule 12*

*Details Concerning Relief in Respect of  
Time Limits Under Article 11*

(4) [*Time Limit for Filing a Request Under Article 11(2)(ii)*] The time limit referred to in Article 11(2)(ii) shall expire not earlier than at least one ~~two~~ months after a notification of the Office that the applicant did not comply with the time limit fixed by the Office. ~~from the date of the expiration of the time limit that was not complied with.~~

(5) [*Exceptions Under Article 11(3)*] (a) No Contracting Party shall be required under Article 11(1) or (2) to grant:

(i) a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 11(1) or (2);]

(ii) relief for filing a request for relief under Article 11(1) or (2) or a request for re-instatement under Article 12(1);

(iii) relief in respect of a time limit for the payment of maintenance fees;

(iv) relief in respect of a time limit referred to in Article 13(1), (2) or (3);

[(v) relief in respect of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;]

(vi) relief in respect of a time limit for an action in *inter partes* proceedings;

~~[(vii) relief in respect of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted.]~~

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