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ASSEMBLY

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AMENDMENTS TO THE REGULATIONS UNDER THE PCT
IN CONNECTION WITH CERTAIN NEWLY INDEPENDENT STATES

Document prepared by the International Bureau

1. Certain States (hereinafter referred to as “successor States”; for example, Ukraine) which became independent recently and whose territory was, before their independence, part of the territory of a State (the Soviet Union) which was party to the Patent Cooperation Treaty (PCT) (referred to in the Annex to this document as “the predecessor State”) intend to deposit, with the Director General of the World Intellectual Property Organization (WIPO), a declaration of continuation. One of the effects of such declaration is that they apply the PCT in their territory.
2. It is to be noted that the procedures proposed in this document would not apply to the Russian Federation as a successor State of the Soviet Union since the Russian Federation has already declared, immediately after the Soviet Union ceased to exist, that it remained responsible in full for all rights and obligations of the Soviet Union in WIPO. Consequently, all international applications designating the Soviet Union, irrespective of their international filing dates, are considered to be applications designating the Russian Federation. The situation, however, is less clear as regards any other State whose territory was part of the Soviet Union because none of such States has so far deposited a declaration of continuation covering the PCT so that, should such a State deposit such a declaration in the future, there will be a gap between the ceasing of the Soviet Union and the declaration. Some at least of these other States are expected to

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deposit declarations of continuation, and if they do, they are successor States in respect of which the situation during the said gap needs to be clarified and regulated. This is what the proposed new Rules 32.1 and 32.2 are intended to accomplish.

3. Before coming to this question it should be noted that, as regards international applications designating the Soviet Union whose international filing date is earlier than a certain date (which can be either the date of the day following the last day of the existence of the Soviet Union or the date of independence of the successor State, see paragraph 6, below) and which were having effect with respect to the Soviet Union on that date, there is no gap of the kind just mentioned, and the effects of the declaration of continuation deposited by the successor State are that the successor State must recognize the “national filing effect” of those international applications under Article 11(4) of the PCT. Consequently, the International Bureau will publish the fact that all designations of the Soviet Union made in the international applications concerned have the effect of a designation of the successor State. Whether or not such an international application has entered the national phase in the Soviet Union, the successor State seems to be entitled to impose certain conditions (which could be considered as a kind of “entry into the national phase” in the successor State) for the continued effect of the international application in its territory, in the same way as it may decide to proceed with respect to national applications which had been filed directly with the Patent Office of the former Soviet Union. There does not seem to be any need to regulate such situations in the PCT Regulations.

4. As regards an international application whose filing date is later than the applicable date referred to in paragraph 3, above, it should be possible to ask for protection in the successor State even if the international application has already been filed. It should be possible to ask for such protection as if the successor State had been designated in the international application at the time of filing the latter. Furthermore, in order to take into account the fact that applicants may be unaware, during a certain period after the deposit of the declaration of continuation, that they can designate the successor State in their international applications, it should be possible to ask for protection in the successor State even with respect to international applications filed during a certain period after the deposit of the declaration of continuation. It is proposed that such period should end two months after the notification of the said declaration to the States party to the Paris Convention for the Protection of Industrial Property.

5. In order to implement the above ideas, it seems necessary to insert specific provisions in the PCT Regulations. It is therefore proposed to adopt two new Rules, which could be Rules 32.1 and 32.2 (these numbers are available, and the location of the new provisions in the Regulations would seem to be appropriate). The texts of the proposed new Rules appear in the Annex to this document. Rule 32.1 would provide for a procedure by which any applicant concerned could ask for protection in the successor State. Rule 32.2 would specify the effects of such action undertaken by the applicant.

6. Proposed Rule 32.1 seems to be largely self-explanatory, taking into account the contents of the previous paragraphs. As regards the determination of the international applications whose effects could be extended to the successor State, the international filing date would be the decisive criterion. The international filing date would have to fall within a certain period. The starting point of that period would, in principle, be December 25, 1991 (since the Soviet Union ceased to exist on December 24, 1991, at midnight). However, the successor State could choose, if it became independent before December 25, 1991, the date of its independence as the starting point of the said period. The said period would end, as explained in paragraph 4, above, two months after the notification of the declaration of continuation to the States party to the Paris Convention.

7. The applicant of each international application whose international filing date falls within the said period would be individually informed by the International Bureau of the possibility to use the proposed procedure and would have three months for performing the required acts. It should be noted that the receiving Office would not be involved: the acts to be performed by the applicant would have to be performed with the International Bureau, namely, the filing of a “request for extension” and the payment of an “extension fee” of the same amount as the designation fee.

8. Upon receipt of the request and the fee, the International Bureau would, if the international application had already been published (or the technical preparations for such publication had already been completed), publish in the PCT Gazette the fact that an extension had been effected with respect to the international application concerned, republish the front page of the pamphlet and communicate the international application to the Office of the successor State. If the international application had not yet been published (or the technical preparations for such publication had not yet been completed), the International Bureau would proceed as usual, except that the extension would be mentioned specially in the PCT Gazette and on the front page of the pamphlet. All these details do not seem to have to be regulated in the PCT Regulations. They can be dealt with in the PCT Administrative Instructions.

9. Paragraph (d) of proposed Rule 32.1 ensures that the provisions of the proposed Rule would not apply to the Russian Federation (see paragraph 2, above).

10. Proposed Rule 32.2 deals with the effects of an extension to the successor State. Paragraph (a)(i) establishes the principle that the successor State is considered as having been designated in the international application. This mainly means that the international filing date and the priority claim, if any, will be valid also with respect to the successor State. Furthermore, the successor State can be elected under Chapter II of the PCT, either in a demand for international preliminary examination or in a later election (see also paragraph 12, below). If the election is made before 19 months from the priority date, that fact would be published in the PCT Gazette.

11. A special problem arises if the time limit for entering the national phase (20 or 30 months from the priority date, depending on whether a demand has been filed within 19 months from the priority date) has already expired, or is about to expire, when the request for extension is made. In that case, paragraph(a)(ii) obliges the successor State to make sure that the applicant has, for entering the national phase before its Office, at least three months from the date of the request for extension.

12. Another problem may arise in connection with Chapter II. If a demand has been filed prior to the expiration of 19 months from the priority date so that the normal time limit for entering the national phase with respect to the Contracting States elected in the demand is 30 months from the priority date, and if the request for extension is made after the expiration of the said 19 months (for example, 23 months after the priority date), what should the time limit for entering the national phase with respect to the successor State be? If the successor State is not elected, the applicant would have, under paragraph (a)(ii), at least three months (i.e., until the expiration of 26 months from the priority date, in the example given above) from the date of the request for extension in which to enter the national phase. If, however, the successor State is elected before the three-month time limit for entering the national phase has expired, he should benefit from the full 30-month time limit under Article 39(1) for entering the national phase, and not be obliged to do so before having received and considered the international preliminary examination report (in the above example, the application of paragraph (a)(ii) would oblige the applicant to enter the national phase before receiving the said report). Paragraph (b) therefore gives the applicant the assurance that, in such a situation, he will not have to enter the national phase before the expiration of the 30-month time limit.

13. It is proposed that new Rules 32.1 and 32.2 enter into force on October 1, 1992.

14. The Assembly of the PCT Union is invited

(i) to adopt Rules 32.1 and 32.2 as proposed in the Annex to the present document, and

(ii) to decide that the said Rules would enter into force on October 1, 1992.

[Annex follows]

Rule 32 [New]

Extension of Effects of International Application to
Certain Successor States

32.1 Request for Extension of International Application to Successor State

(a) The effects of any international application whose international filing date falls in the period defined in paragraph (b) may, subject to the performance by the applicant of the acts specified in paragraph (c), be extended to a State (“the successor State”) whose territory was, before the independence of that State, part of the territory of a Contracting State which subsequently ceased to exist (“the predecessor State”), provided that the successor State has become a Contracting State through the deposit, with the Director General, of a declaration of continuation the effect of which is that the Treaty is applied by the successor State.

(b) The period referred to in paragraph (a) starts on the day following the last day of the existence of the predecessor State and ends two months after the date on which the declaration referred to in paragraph (a) was notified by the Director General to the Governments of the States party to the Paris Convention for the Protection of Industrial Property. However, where the date of independence of the successor State is earlier than the date of the day following the last day of the existence of the predecessor State, the successor State may declare that the said period starts on the date of its independence; such a declaration shall be made together with the declaration referred to in paragraph (a) and shall specify the date of independence.

[Rule 32.1, continued]

(c) In respect of any international application whose filing date falls within the applicable period under paragraph (b), the International Bureau shall send the applicant a notification informing him that he may make a request for extension by performing, within three months from the date of that notification, the following acts:

(i) filing with the International Bureau the request for extension;

(ii) paying to the International Bureau an extension fee in Swiss francs, the amount of which shall be the same as the amount of the designation fee referred to in Rule 15.2(a).

(d) This Rule shall not apply to the Russian Federation as a successor State.

32.2 Effects of Extension to Successor State

(a) Where a request for extension is made in accordance with Rule 32.1,

(i) the successor State shall be considered as having been designated in the international application, and

(ii) the applicable time limit under Article 22 or 39(1) in relation to that State shall be extended until the expiration of at least three months from the date of the request for extension.

(b) Where, in the case of a successor State which is bound by Chapter II of the Treaty, the request for extension was made after, but the demand was made before, the expiration of the 19th month from the priority date, and a later election is made of the successor State within three months from the date of the request for extension, the applicable time limit under paragraph (a)(ii) shall be at least 30 months from the priority date.

(c) The successor State may fix time limits which expire later than those provided in paragraphs (a)(ii) and (b). The International Bureau shall publish information on such time limits in the Gazette.

[End of Annex and of document]