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MODEL INTERNATIONAL REQUEST FORM AND OTHER FORMS

Document prepared by the International Bureau

I. INTRODUCTION

1. Article 17(2)(ii) and (iv) of the Patent Law Treaty (PLT) provides that the PLT Assembly shall establish the Model International Forms, and the request Form, referred to in Article 14(1)(c), and determine the conditions for the date of application of such Forms. At its first session, the PLT Assembly adopted a consultation procedure utilizing, in principle, electronic communication means in order to facilitate the establishment of the above-mentioned Forms.

2. Consequently, the PLT Web Forum was created on the WIPO web site in March 2006. The draft Model International Forms and the draft Model International Request Form, as well as comments submitted on those draft Forms, are posted at <http://www.wipo.int/plt-forum/>.

3. Following consideration of the comments received, the present document contains revised drafts of the Model International Request Form as well as of certain Model International Forms, namely those relating to the power of attorney, the request for recordation of change in name or address and the request for correction of a mistake, for consideration and adoption by the Assembly.

4. As regards the other Model International Forms, namely those relating to the request for recordation of change in applicant or owner, the certificate of transfer, the request for recordation, or cancellation of recordation, of a license and the request for recordation, or cancellation of recordation, of a security interest, further consultations appear to be necessary in view of the comments received.

II. PROPOSED MODEL INTERNATIONAL FORMS

A. Model International Request Form

(a) Background

5. PLT Article 6(2) provides that:

“(2) [*Request Form*] (a) A Contracting Party may require that the contents of an application which correspond to the contents of the request of an international application under the Patent Cooperation Treaty be presented on a request Form prescribed by that Contracting Party. A Contracting Party may also require that any further contents allowed under paragraph (1)(ii) or prescribed in the Regulations pursuant to paragraph (1)(iii) be contained in that request Form.

“(b) Notwithstanding subparagraph (a) and subject to Article 8(1), a Contracting Party shall accept the presentation of the contents referred to in subparagraph (a) on a request Form provided for in the Regulations.”

6. Notes 6.10 and 6.11 of the Explanatory Notes on the Patent Law Treaty and the Regulations Under The Patent Law Treaty (“PLT Notes”) state the following:

“6.10 *Paragraph (2)(a)*. This provision permits, but does not oblige, a Contracting Party to require the use of a request Form prescribed by that Contracting Party. It also allows a Contracting Party to require that the contents of the request which are provided for in respect of international applications under PCT Rule 4.1, as well as any contents allowed to be required under paragraph (1)(ii) or prescribed in Rule 3(1), be contained in the request. For example, a Contracting Party may require that the request contain various declarations as provided in PCT Rule 4.17.

“6.11 *Paragraph (2)(b)*. This provision obliges a Contracting Party, notwithstanding paragraph (2)(a), to accept the presentation of the formal contents of a request on a request Form, as prescribed in Rule 3(2) (see Notes R3.02 to R3.04).”

7. PLT Rule 3(2)(i) provides that:

“(2) [*Request Form Under Article 6(2)(b)*] A Contracting party shall accept the presentation of the contents referred to in Article 6(2)(a):

“(i) on a request Form if that request form corresponds to the Patent Cooperation Treaty request Form with any modifications under Rule 20(2);

...”

8. Note R3.02 of the PLT Notes clarifies as follows:

“R3.02 *Paragraph (2), item (i)*. This item obliges a Contracting Party to accept the use of a request Form corresponding to the PCT request Form with any modifications established by the Assembly under Rule 20(2). Such modifications could include, for example, omission of the indication for the designation of PCT Contracting States, omission of the indication for the designation of States of regional organizations, and the addition of the indications for a request that the application be treated as a divisional application or an entitlement application referred to in Rule 2(6)(i) and (iii).”

(b) Model International Request Form

9. It is proposed that the modifications of the Patent Cooperation Treaty request Form (PCT/RO/101) under PLT Rule 20(2) be established in the form of a Model International Request Form, the draft of which is contained in the Annex of this document. The proposed modifications include the changes necessary to adapt the PCT request Form for international applications under the PCT to a Form suited for requesting the grant of a national patent by a national Office, or the grant of a regional patent by the Office of a regional Patent Organization, under the applicable law in accordance with the PLT.

10. In particular, the proposed Model International Request Form incorporates the modifications foreshadowed in Note R3.02 of the PLT Notes (see paragraph 8, above). The title of the request Form “Request for the grant of a patent”, together with an indication of national or regional patent Office that is requested to grant a patent, fulfills the requirement that an application contain an express or implicit indication to the effect that the submitted document is intended to be a patent application (see PLT Article 5(1)(i)). In accordance with PLT Article 3, since the PLT, in addition to “conventional” applications for patents for inventions, also applies to applications for patents of addition as well as to applications for continuation or continuation-in-part of an earlier application and to divisional applications, the draft Model International Request Form provides, in Box No. VII, the possibility to indicate those types of applications.

11. The proposed modifications also take into account express provisions under the PLT in respect of representatives under Article 7 and communications and addresses under Article 8. The final box “For Office use only” is provided for the Office to note any indications or references that may be convenient for the purpose of processing patent applications (for example, in order to facilitate the determination of the date of filing, the date on which a missing drawing was subsequently filed with the Office may be indicated in this Box).

12. Since the PCT request Form may contain various declarations as referred to in PCT Rule 4.17, the Model International Request Form provides the possibility of including those declarations in the request. Although the Notes to the Model International Request Form provides texts for those declarations, those texts, which are based on the declarations under PCT Rule 4.17, are meant to be guidelines for the drafting of the declarations, keeping in mind that an applicant will have to comply with the requirements under the applicable national/regional law. It should also be noted that the PLT does not limit the freedom of a Contracting Party to prescribe any requirements of the applicable substantive law, as referred to in Article 2(2).

13. As regards the indication of the contact information of a person, although the PCT request Form provides a box to indicate a teleprinter number, it is suggested to replace the indication of a teleprinter number by that of an e-mail address in view of the widespread use of electronic communication.

14. Where the elements required by the applicable law (they may be all of the elements prescribed in the Model International Request Form, but most likely, they will consist of merely some of those prescribed elements) are fully indicated and presented in the Model International Request Form, a Contracting Party shall accept such a Request (see PLT Rule 3(2)(i)). A Contracting Party, however, is free to require evidence in respect of any matter concerning the request Form where the Office of the Contracting Party has reasonable doubts as to the veracity of that matter or the accuracy of the translation.

(c) Notes to the Model International Request Form

15. The Model International Request Form contains Notes to the Model International Request Form. Since the Model International Request Form is based on the PCT request Form with appropriate modifications, the Notes are also based on the Notes to the PCT request Form. Similarly to the case of those PCT Notes, the Notes to the Model International Request Form are intended to facilitate completion of the Form by the applicant. Since the PLT contains no provision for the establishment of the Notes by the Assembly, such Notes will be established by the International Bureau for explanatory purposes only.

(d) Individualized Model International Request Form

16. The Model International Request Form refers to, and leaves space for filling in, all the elements (information) that Contracting Parties may require under the PLT and its Regulations. Some of those elements, however, will not always be required under the national (or regional) law applicable to the Office concerned, since the PLT provides, except for Article 5, maximum requirements a Contracting Party may impose. Therefore, any Contracting Party would be free to individualize the Model International Request Form for its applicants in accordance with PLT Article 6(2)(a).

17. In particular, an individualized Model International Request Form could provide the name of the Office pre-printed in the title, could be in the language(s) accepted by the Office, could omit any boxes not relevant to that Office and, in the case of a regional patent organization, Box No. VI (Regional Patent Application) could list the Member States of that organization together with check-boxes for the purposes of indicating those States in which protection is sought. Since a Contracting Party is free to determine the acceptable language(s) of applications as well as the requirements relating to fees in accordance with PCT Article 6(3) and (4), it is entitled to require any translation or transliteration of certain words (for example, in a way referred to in PCT Rule 4.16) or to require certain means of payment. As prescribed in PLT Article 4, a Contracting Party is also free to take any action it deems necessary for the preservation of essential security interests. Consequently, the individualized Form may include specific requirements relating to national security.

18. Any Contracting Party which individualizes a Model International Request Form could, of course, also individualize the Notes so that they relate expressly to the individualized Form.

B. Model International Forms

(a) Background

19. PLT Article 8(3) provides that:

“(3) [*Model International Forms*] Notwithstanding paragraph (1)(a), and subject to paragraph (1)(b) and Article 6(2)(b), a Contracting Party shall accept the presentation of the contents of a communication on a Form which corresponds to a Model International Form in respect of such a communication provided for in the Regulations, if any.”

20. As explained in Note 8.07 of the Explanatory Notes on the Patent Law Treaty and the Regulations Under The Patent Law Treaty (“PLT Notes”):

“8.07 *Paragraph (3)*. This paragraph obliges a Contracting Party to accept communications filed on a Model International Form established under Article 14(1)(c) and Rule 20. The effect of the phrase “subject to paragraph (1)(b)” is that a Contracting Party that does not accept the filing of communications other than on paper is not obliged to accept the filing of a communication on a Model International Form that applies, for example, to communications filed in electronic form or by electronic means of transmittal. [...]”

21. PLT Rule 20(1) provides that:

“(1) [*Model International Forms*] The Assembly shall, under Article 14(1)(c), establish Model International Forms, in each of the languages referred to in Article 25(1), in respect of:

- (i) a power of attorney;
- (ii) a request for recordation of change in name or address;
- (iii) a request for recordation of change in applicant or owner;
- (iv) a certificate of transfer;
- (v) a request for recordation, or cancellation of recordation, of a license;
- (vi) a request for recordation, or cancellation of recordation, of a security interest;
- (vii) a request for correction of a mistake.”

22. Rules 15 to 18, in particular, provide requirements with respect to the above Model International Forms. Further, the Model International Forms should be in compliance with other requirements prescribed in Articles 7 and 8 and Rules 7, 8, 9, 10 and 19.

(b) Model International Forms

23. As explained above, draft Model International Forms concerning a power of attorney, a request for recordation of change in name or address and a request for correction of a mistake are contained in the Annex for consideration and adoption by the Assembly.

24. According to PLT Article 8(3), a Contracting Party shall accept the presentation of the contents of a communication utilizing a Model International Form, provided that the contents of the communication and the means of communication are in compliance with the requirements under the applicable law, which shall in turn be compliant with the provisions of the PLT.

25. With respect to the indication of the contact information of a person, as for the Model International Request Form, it is suggested to replace the indication of the teleprinter number by that of the e-mail address.

(c) Notes to the Model International Request Form

26. Each Model International Form contains Notes to the relevant Model International Form, established by the International Bureau for explanatory purposes only. As it is the case with the Model International Request Form, the Notes to the Model International Forms are intended to facilitate the completion of those Forms.

(d) Individualized Model International Request Form

27. As in the case of the Model International Request Form (see paragraphs 16 to 18), any Contracting Party would be free to individualize the Model International Forms in order to adapt them to the applicable law, as long as they comply with the PLT.

III. ENTRY INTO FORCE

28. It is suggested that the Model International Request Form and the Model International Forms referred to in paragraph 23 will enter into force on April 1, 2007. In particular, in order to be in line with PCT Rule 4.1(iv) and (v), which will enter into force on April 1, 2007, Box No. X of the Model International Request Form provides, in the left column, the possibility of submitting a reference to a previously filed application replacing the description and drawings for the purpose of the filing date as well as a request for restoration of the right of priority. Therefore, as far as the Model International Request Form is concerned, the date of entry into force is suggested to be April 1, 2007.

29. In accordance with PLT Rule 20(1), the Model International Forms shall be established in English, Arabic, Chinese, French, Russian and Spanish. Although there is no explicit provision in the PLT with respect to the language of the Model International Request Form, the context suggests that such Form be also established in the above six languages. As suggested in the Notes to each Form, once adopted by the Assembly, the Forms as well as their Notes will be available on the WIPO web site.

30. *The PLT Assembly is invited:*

(i) to establish the Model International Request Form and the Model International Forms as set out in the Annex; and

(ii) to decide that those Forms will enter into force on April 1, 2007.

[Annex follows]

ANNEX

I. Model International Request Form

II. Model International Forms

1. Power of Attorney
2. Request for Recordation of Change in Name or Address
3. Request for Correction of Mistakes