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ADDENDUM TO WORKING DOCUMENT PCT/AAQ/VI/2

prepared by the International Bureau

This document contains the observations of the United States of America on the "Administrative Instructions under the Patent Cooperation Treaty (Third revised draft)" contained in document PCT/AAQ/VI/2.

DRAFT ADMINISTRATIVE INSTRUCTION I

The definitive date that is to be used as the priority date for the purposes of calculating time under the Treaty shall be:

- a) in applications that contain a single priority claim that is not defective under Rule 4.10(b) or (d), the date of the earlier filed application whose priority is claimed;
- b) in applications that contain a single priority claim that is found to be defective under Rule 4.10(b), the International filing date of the application;
- c) in applications that contain a single priority claim that is found to be defective under Rule 4.10(d)
 - i) if the corrected date timely submitted by the applicant falls within one year from the International filing date, that corrected date;
 - ii) if the corrected date submitted by the applicant falls more than one year from the International filing

date, or if no timely response is received from the applicant, the International filing date;

- d) in applications containing two or more priority claims, one or more of which is defective under Rule 4.10(b) or Rule 4.10(d), the earliest date that remains after correction or cancellation provided that date falls within the priority year.

DRAFT ADMINISTRATIVE INSTRUCTION II

Where the International filing date is considered to be the priority date for the purposes of calculating time under the Treaty, the definitive International filing date, as established under Rule 20.2 and Administrative Instructions 309 and 310 shall be used.

DISCUSSION OF EFFECTS OF A CHANGE OR
WITHDRAWAL OF THE PRIORITY CLAIM

Administrative Instruction 302

Under PCT, certain time limits, such as those for transmitting the Record Copy and for international publication, are based upon the priority date of the international applications.

At the 1974 AAQ meeting, the United States questioned what "priority date" would be used if the applicant spontaneously withdrew his priority claim during International processing. The answer received at that time was that the original priority claim would govern the timing regardless of later withdrawals of the claim (PCT/AAQ/V/6, paragraph 31). This answer, however, does not consider the intricacies of the issue: the priority date can, in fact, be changed or cancelled during processing and the Treaty and Rules do not define the effect of these changes or cancellations on the timing sequence of the individual international application.

Rule 4.10 sets forth the necessary contents of the priority claim, and the procedures for cancelling the claim and correcting the date. Under Rule 4.10(b), the claim shall be considered not to have been made if both the country of filing and the date of the earlier filed application are not present. Therefore, if the Receiving Office determines that the claim

is insufficient, that claim is considered not to exist for purposes of processing under the Treaty, and Article 2(xi)(c) would seem to apply, that is, the International filing date is considered to be the "priority date" for purposes of calculating time under the Treaty. This is practical reasoning, as if either the country of filing or the date is missing, the Receiving Office has little or no information on which to base the timing of the application. Yet Article 2(xi)(c) speaks specifically to the case where no priority claim is contained in the international application rather than the case where a priority claim has been cancelled.

Rule 4.10(d) sets forth the procedure for correcting the erroneous date of a priority claim that meets the requirements of Rule 4.10(a). If the date of the earlier application precedes the international filing date by more than one year, the Receiving Office will invite the applicant to correct the date if it is in error, or to cancel the claim if the date has been accurately stated in the Request. This is done to conform to the Paris Union convention period of one year. The applicant is allowed one month to respond to the Receiving Office invitation. During this month, the Receiving Office does not know if the date is erroneous or if the claim will be cancelled, and the application can be said to have no date on which to base timing. If the applicant corrects the date to fall within the priority year, the corrected date becomes the valid priority date on which timing is based. This is procedurally logical, as, if the original priority date is used to compute

time, because that original date falls more than one year from the International filing date of the application, the 13-month deadline for Receiving Office transmittal of the Record Copy is likely to have expired. The Receiving Office would, therefore, be placed in the position of incurring the penalty for late transmittal of the Record Copy: having it's failure to meet responsibilities published in the Gazette. It may be assumed, then, that the definitive priority date that is used for computing time in cases where the application is defective under Rule 4.10(d) is the corrected date submitted by the applicant.

However, in cases where the applicant does not respond to the Receiving Office's invitation to correct within one month, the claim, and therefore the date, is cancelled ex officio by the Receiving Office. In cases where the applicant cannot correct the date to fall within the Convention year, the applicant cancels the claim to the priority date. In the cases where the priority claim is cancelled either by the Receiving Office or by the applicants, such claims, although originally appearing in the application as filed, would seem to be nonexistent for purposes of computing time under the Treaty and Article 2(xi)(c) may be said to apply, but once again this application of the Article is not clear.

A change in timing such as outlined above may occur more frequently that is readily obvious, as any submission of missing sheets or drawings within thirty days from the date of first receipt will cause the filing date to change. And, if the application was received during the eleventh month after

the claimed priority date, the changed filing date resulting from the submission of missing sheets and drawings may be more than twelve months from the priority date. We are assuming in this discussion that a Rule 4.10(d) check is made not only very early as a regular step in PCT processing, but also whenever any change in the filing date occurs.

Although the Rule 4.10(d) states that the International Bureau shall invite the applicant to correct an erroneous priority date if the Receiving Office has failed to do so, it is unlikely that the Receiving Office would fail to notice an erroneous date as an early step in processing when the important matter of timely transmittal of the Record Copy depends on this date.

However, if the application claims a priority date close to twelve months from the date of receipt and the Receiving Office has transmitted the Record Copy shortly after twelve months, then the applicant should spontaneously submit missing sheets or drawings. A question of responsibility for conducting Rule 4.10(d) checks and correcting timing arises.

From the foregoing discussion, it can be seen that, as a practical matter, the priority date as originally indicated in the Request cannot be used to compute time in all cases. It can also be seen that, although Article 2(xi)(c) may be considered to apply in cases where the priority date has been cancelled, it does so only by interpretation. An administrative instruction could close this gap.

There are further complications to the issue of time sequences based on a possibly changing priority date. If it can be assumed from the discussion of Rule 4.10 above that the definitive "priority date" for the purposes of calculating time under the Treaty may be the date established through Rule 4.10 procedures, and that this determination is made by the Receiving Office very early in PCT processing, questions still remain as to whether the priority date may change and therefore affect the timing of the application. Three situations may be used as examples:

- (1) The applicant spontaneously corrects a priority date that was erroneously indicated to be later yet still falling within the priority year, as when the priority date of 07.05.76 is indicated as 05.07.76 and the filing date is 29.-07.76;
- (2) The applicant spontaneously withdraws his priority claim at any time during international processing; and
- (3) The discovery by the Receiving Office, or perhaps more likely, by the International Bureau, that the date on the priority document itself does not correspond with the date in the Request though both dates may fall within the Convention year.

It is our opinion that for reasons of practicality and simplicity, the "priority date" established early in Receiving Office processing through Rule 4.10 procedures should be the date from which time limits for international processing, based on the priority date, are counted.

At this point, we can see no circumstances other than those in Rule 4.10 that should be considered to be of enough importance to cause a change in the "priority date", as a change in dates, and therefore timing, at a later stage of International processing would lead to confusion in procedures and unnecessary communications that, for the International Authorities, far outweigh the benefits of the change.

We recognize, however, that with the Rule 4.10 procedure, when the original priority claim is cancelled and the International filing date becomes the "priority date" for timing purposes, certain timing problems may again be encountered, as when the date of receipt and filing date change as a result of later filed sheets and drawings under Rule 20.2 and Administrative Instructions 309 and 310. This problem could be handled in a second administrative instruction.

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