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INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

COMMITTEE ON REFORM  
OF THE PATENT COOPERATION TREATY (PCT)

Second Session  
Geneva, July 1 to 5, 2002

MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

*Document prepared by the International Bureau*

## INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, *inter alia*, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces the second session summary as an Annex.<sup>1</sup>

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<sup>1</sup> Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

*Reinstatement of rights after failure to comply with requirements for entering the national phase within the time limits under Articles 22 and 39(1)*

3. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT<sup>2</sup> relating, as recommended by the Committee, to changes necessary or desirable to bring the requirements under the PCT into line with the letter and spirit of the Patent Law Treaty (PLT) (see the report of the first session of the Committee, document PCT/R/26, paragraphs 72 to 74).

4. There was wide agreement at the first session of the Working Group on the general approach to be taken (see document PCT/R/WG/1/9, paragraph 21). Among the matters agreed was that (see paragraph 21(v)):

“priority should be given by the Working Group to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities; for example, priority might be given to the following:

...

– relief when time limits were missed, especially the time limit for entering the national phase.”

The Working Group further agreed at its first session (see document PCT/R/WG/1/9, paragraph 24):

“that the International Bureau should prepare a proposal which would provide in the PCT Regulations for extensions of the time limit for entering the national phase, similarly to PLT Article 3(1)(b)(i) read in the light of PLT Articles 11 and 12”.

5. At its second session, the Working Group considered proposals, prepared by the International Bureau, designed to afford relief where the time limit for entering the national phase was missed (see document PCT/R/WG/2/4). The discussion by the Working Group is outlined in the summary of the session (see document PCT/R/WG/2/12, paragraphs 51 and 52):

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<sup>2</sup> References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be (the current texts are available on WIPO’s Web site at [http://www.wipo.int/pct/en/access/legal\\_text.htm](http://www.wipo.int/pct/en/access/legal_text.htm)). References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO’s Web site at [http://www.wipo.int/eng/document/pt\\_dc/index.htm](http://www.wipo.int/eng/document/pt_dc/index.htm)).

“51. Although the contents of document PCT/R/WG/2/4 could not, in the time available, be discussed in detail, the majority of the delegations which expressed their views agreed with the general approach outlined in the document, and it was agreed that the proposals should be submitted to the next session of the Committee. The revised proposals would envisage the possibility that national laws could make provisions concerning the prior rights of third parties and the right of third parties to intervene.

“52. The Delegation of Japan expressed its concern about the proposed inclusion in the PCT Regulations of provisions having a similar effect to PLT Article 12 and PLT Rule 13(2). The Delegation believed that the PCT should not duplicate provisions which already are included in the PLT, noting that PLT Article 12 and PLT Rule 13(2) expressly applied to the time limits under PCT Articles 22 and 39(1) (see Note 3.08 on PLT Article 3(1)(b)). The Delegation also believed that the proposals dealt with substantive matters which should be left to national law to decide. The Delegation also believed that the proposal would cause severe practical problems for designated Offices because of the delays in national processing which would result.”

6. PLT Articles 3 and 12 and PLT Rule 13(2) are reproduced for ease of reference in Annex I. Revised proposals for amendment of the PCT Regulations to enable the reinstatement of rights after failure to comply with the requirements for national phase entry within the time limit under PCT Article 22 or 39(1) is set out in Annex II to the present document. The key features of the proposals are outlined in the following paragraphs.

#### *Present situation*

7. If the applicant fails to perform the acts referred to in PCT Article 22 or 39(1) (generally, the furnishing of a translation of the international application and the payment of the national fee) before any designated or elected Office within the applicable time limit, the international application ceases to have the effect provided for in PCT Article 11(3) (that is, the effect of a regular national application) as far as that State is concerned, with the same consequences as the withdrawal of any national application in that State (see PCT Article 24(1)(iii)).

8. As regards the possibility for the applicant to excuse any delay in meeting the time limits under PCT Article 22 and 39(1), at present, the PCT provides for such possibility only in the particular case of irregularities in the mail service (delay or loss in mail, interruption in the mail service) under PCT Article 48(1) and PCT Rule 82.

9. In all other cases (that is, not related to irregularities in the mail service), the possibility of excusing a missed time limit under PCT Article 22 or 39(1) must be pursued before each designated or elected Office individually, and only as far as that Office is concerned. For each designated or elected Office where the applicant wishes to attempt to have such a delay excused, the applicant must perform all acts required for entry into the national phase and, at the same time, request the Office to maintain the effect of the application and to excuse the delay. In determining whether a delay may be excused, each Office must apply the conditions laid down by the applicable national law in the same way and under the same conditions as they are applied to national applications, including any time limit for filing a request to excuse the delay (see PCT Article 48(2)).

10. Examples of national provisions for excusing delays are those that allow reinstatement of rights, restoration, *restitutio in integrum*, revival of abandoned applications, further processing, continuation of proceedings, and so on (see PCT Rule 82*bis*.2).

11. While the national laws of many designated and elected Offices contain provisions which allow for the excuse of delays in meeting time limits, including the time limits applicable under PCT Articles 22 and 39(1), this is not the case in respect of all designated and elected Offices. Where the applicant misses the applicable time limit for entry into the national phase before an Office whose national law does not contain such provisions, the international application ceases to have the effect as far as that State is concerned, with the same consequences as the withdrawal of any national application in that State, and no further remedy is generally available.

#### *Patent Law Treaty*

12. In order to provide a remedy for applicants in such situations, PLT Article 3(1)(b)(i) expressly provides that the provisions of the PLT and the Regulations under the PLT (once in force) would be applicable, subject to the provisions of the PCT, to international applications in respect of the time limits applicable under PCT Articles 22 and 39(1) in the Office of the PLT Contracting Party. In other words, under the PLT, any national Office of a State which is a Contracting Party of both the PLT and the PCT and which acts as a designated or elected Office under the PCT would be obliged to apply the provisions of the PLT, in particular PLT Article 12, to an international application which missed the applicable time limit for entry into the national phase before that Office.

#### *Intervening rights of third parties*

13. Note 12.10 on PLT Article 12 describes intervening rights of third parties as “the rights, if any, acquired by a third party for any acts which were started, or for which effective and serious preparations were started, in good faith, during the period between the loss of rights resulting from the failure to comply with the time limit concerned and the date on which those rights are reinstated” and the right of third parties to intervene (that is, to intervene in the matter of a request for the reinstatement of rights by furnishing, to the Office concerned, grounds for refusing such request). Noting that any such rights are, and remain, a matter for the national law applied by the designated or elected Office, there appears to be no need to expressly include a provision covering them in the PCT Regulations as was suggested in document PCT/R/WG/2/12, paragraph 51.

#### *Amendments of the PCT Regulations*

14. Noting that the PLT has not yet entered into force, it is proposed, as suggested in paragraph 24 of the first session summary, to incorporate into the PCT Regulations a provision with similar effect to PLT Article 12 and PLT Rule 13(2) so as to oblige all designated and elected Offices<sup>3</sup> to provide for the reinstatement of rights of the applicant if the applicant has missed the applicable time limit under Article 22 or 39(1) for entry into the national phase in spite of due care required by the circumstances having been taken or, at the option of the designated or elected Office, where the delay was unintentional. Annex II to the

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<sup>3</sup> Existing Rule 76.5 would ensure that proposed new Rule 49.6 is also applied by elected Offices.

present document contains specific proposals to amend the PCT Regulations accordingly. A transitional reservation provision is included, recognizing that some national laws will need to be amended to bring them into line with the PCT Regulations as proposed to be amended.

*15. The Committee is invited to consider the proposals contained in Annex II.*

[Annex I follows]

PLT ARTICLES 3 AND 12 AND RULE 13

*Article 3*

*Applications and Patents to Which the Treaty Applies*

(1) [*Applications*] (a) The provisions of this Treaty and the Regulations shall apply to national and regional applications for patents for invention and for patents of addition, which are filed with or for the Office of a Contracting Party, and which are:

(i) types of applications permitted to be filed as international applications under the Patent Cooperation Treaty;

(ii) divisional applications of the types of applications referred to in item (i), for patents for invention or for patents of addition, as referred to in Article 4G(1) or (2) of the Paris Convention.

(b) Subject to the provisions of the Patent Cooperation Treaty, the provisions of this Treaty and the Regulations shall apply to international applications, for patents for invention and for patents of addition, under the Patent Cooperation Treaty:

(i) in respect of the time limits applicable under Articles 22 and 39(1) of the Patent Cooperation Treaty in the Office of a Contracting Party;

(ii) in respect of any procedure commenced on or after the date on which processing or examination of the international application may start under Article 23 or 40 of that Treaty.

(2) [*Patents*] The provisions of this Treaty and the Regulations shall apply to national and regional patents for invention, and to national and regional patents of addition, which have been granted with effect for a Contracting Party.

*Article 12*

*Reinstatement of Rights After a Finding of Due Care  
or Unintentionality by the Office*

(1) [*Request*] A Contracting Party shall provide that, where an applicant or owner has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or patent, the Office shall reinstate the rights of the applicant or owner with respect to the application or patent concerned, 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 filed, and all of the requirements in respect of which the time limit for the said action applied are complied with, within the time limit prescribed in the Regulations;

(iii) the request states the reasons for the failure to comply with the time limit; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(2) [*Exceptions*] No Contracting Party shall be required to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

(3) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(4) [*Evidence*] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.

(5) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraph (1) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

### *Rule 13*

#### *Details Concerning Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office Under Article 12*

(1) [*Requirements Under Article 12(1)(i)*] A Contracting Party may require that a request referred to in Article 12(1)(i) be signed by the applicant or owner.

(2) [*Time Limit Under Article 12(1)(ii)*] The time limit for making a request, and for complying with the requirements, under Article 12(1)(ii), shall be the earlier to expire of the following:

(i) not less than two months from the date of the removal of the cause of failure to comply with the time limit for the action in question;

(ii) not less than 12 months from the date of expiration of the time limit for the action in question, or, where a request relates to non-payment of a maintenance fee, not less than 12 months from the date of expiration of the period of grace provided under Article 5*bis* of the Paris Convention.

(3) [*Exceptions Under Article 12(2)*] The exceptions referred to in Article 12(2) are failure to comply with a time limit:

(i) for an action before a board of appeal or other review body constituted in the framework of the Office;

(ii) for making a request for relief under Article 11(1) or (2) or a request for reinstatement under Article 12(1);

- (iii) referred to in Article 13(1), (2) or (3);
- (iv) for an action in *inter partes* proceedings.

[Annex II follows]



PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>1</sup>  
MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

**Rule 49**

**Copy, Translation and Fee Under Article 22**

49.1 to 49.5 [No change]

49.6 Reinstatement of Rights After Failure to Perform the Acts Referred to in Article 22

(a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, notwithstanding Rule 82 and subject to paragraphs (b) to (g) of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit occurred in spite of due care required by the circumstances having been taken.

[COMMENT: See PLT Article 12(1)(iv). As is the case in PLT Article 12(1)(iv), it is proposed to leave it at the option of the designated Office to decide which standard it wishes to apply in deciding whether or not to reinstate the rights of an applicant who failed to perform the acts referred to in Article 22 within the applicable time limit. Note that the provisions of Rule 82 would still apply as a *lex specialis*.]

*[Rule 49.6, continued]*

(b) The request under paragraph (a) shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within whichever of the following periods expires first:

(i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or

(ii) 12 months from the date of the expiration of the applicable time limit under Article 22.

[COMMENT: See PLT Article 12(1)(ii) and PLT Rule 13(2).]

(c) The request under paragraph (a) shall state the reasons for the failure to comply with the applicable time limit under Article 22.

[COMMENT: See PLT Article 12(1)(iii).]

*[Rule 49.6, continued]*

(d) The national law applicable by the designated Office may require:

(i) that a fee be paid in respect of a request under paragraph (a);

[COMMENT: See PLT Article 12(3).]

(ii) that a declaration or other evidence in support of the reasons referred to in paragraph (a) be filed.

[COMMENT: See PLT Article 12(4).]

(e) Where any requirement referred to in paragraphs (c) and (d) is not already fulfilled during the same period within which the request under paragraph (a) for reinstatement of rights must, under paragraph (b), be submitted, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation.

[COMMENT: Modeled after present Rule 51*bis*.3(a).]

(f) The designated Office shall not refuse a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[COMMENT: See PLT Article 12(5).]

*[Rule 49.6, continued]*

(g) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (f) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in that respect of that designated Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[End of Annex and of document]