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WORKING GROUP ON REFORM OF THE PATENT COOPERATION TREATY (PCT)

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SIGNATURE REQUIREMENTS

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BACKGROUND

1. On October 1, 2002, with effect from January 1, 2004, the PCT Assembly adopted amendments to the Regulations relating to the concept and operation of the designation system (see document PCT/A/31/10, Annex V). Among the amendments adopted by the Assembly were amendments concerning signature requirements in respect of the request and the demand (see Rules 26.2*bis*(a) and 60.1(a-*ter*)). Under those Rules as amended, it is sufficient that the request and the demand, respectively, be signed by at least one applicant.¹
2. The amendments outlined above have resulted in differing signature requirements for different acts performed by the applicant during the course of the international procedure. While, as of January 1, 2004, if there are several applicants, the signature of the request and the demand by just one applicant is sufficient for the purposes of Article 14(1)(a)(i),

¹ 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. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc.

(i) any correspondence by the applicant in the course of the international procedure, other than the international application, still requires the signature of all applicants (or of a common agent, or of an appointed or a deemed common representative, representing all applicants) (see Rule 92.1);

(ii) any withdrawal of the international application, designations, priority claims, or of the demand or elections, still requires the signature of all applicants (or of a common agent, or of an appointed common representative, representing all applicants; the deemed common representative is not entitled to sign a notice of withdrawal on behalf of all other applicants) (see Rule 92*bis*).

3. In general, it would appear that differing signature requirements for the request and the demand, on the one hand, and for later acts by the applicant in the course of the international procedure, on the other hand, will likely lead to confusion among applicants and add unnecessary complexity to the system and should thus be avoided.

4. In particular, the fact that the signature of all applicants (or of the common agent, or the appointed or deemed common representative) is still required for such acts such as the submission of a correction or addition of a priority claim (see Rules 26*bis* and 92.1) or the recording of changes in certain indications concerning the applicant, agent, common representative or inventor (see Rules 92*bis* and 92.1) appears to defeat the purpose of the amendments to Rules 26.2*bis*(a) and 60.1(a-*ter*)) as adopted by the Assembly on October 1, 2002, namely, to avoid the need for signatures of all of two or more applicants, in particular in cases where certain applicants are indicated as applicants/inventors for the purposes of the United States of America only and where the applicants have no intention to proceed with the international application into the national phase in that State (but which, due to the new all-inclusive designation system, is automatically designated in the international application).

5. Moreover, the fact that the signature of all applicants is still required in the case of any withdrawal (of the international application, designations, priority claims, demands and elections; see Rule 90*bis*.5) could form a trap for applicants who, relying on the fact that one signature is sufficient for the filing of the international application, wish to withdraw, say, the international application shortly prior to international publication by submitting a notice of withdrawal with the signature of just one applicant, only to be informed that such notice of withdrawal is not effective unless signed by all applicants (or signed by a common agent or an appointed common representative, representing all applicants; note that a deemed common representative is not entitled to sign any notice of withdrawal on behalf of all applicants; see Rule 90.3(c)).

6. The Annex to this document contains proposals for amendment of the Regulations so as to align, at least partially, the signature requirements in respect of correspondence submitted by the applicant in the course of the international procedure and in respect of withdrawals with the signature requirements in respect the request and the demand, as adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004.

SIGNATURE REQUIREMENTS FOR CORRESPONDENCE

7. It is proposed to amend Rules 92.1 so as to provide that, where there are two or more applicants, the signature of each applicant who, or whose predecessor in title, has signed the request or the demand is sufficient for any correspondence submitted by the applicant(s) in

the course of the international procedure, other than the international application itself. Note that, as at present, the signature of the common agent, the appointed common representative or the deemed common representative would, of course, also be sufficient.

SIGNATURE REQUIREMENTS FOR WITHDRAWALS

8. Furthermore, it is proposed to amend Rules 90*bis*.5 so as to provide that, where there are two or more applicants, the signature of each applicant who, or whose predecessor in title, has signed the request or the demand, as the case may be, is sufficient for any notice of withdrawal of the international application, designations or of priority claims, or of the demand or elections. Note that, as at present, the signature of the common agent and the appointed common representative would, of course, also be sufficient, whereas the deemed common representative, as at present, merely by virtue of that fact could not sign any notice of withdrawal on behalf of all applicants.

9. In order to provide a safeguard for those applicants who did not sign a notice of withdrawal, it is proposed to require the recipient of the notice of withdrawal (the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be) to promptly notify the receipt of a notice of withdrawal to all applicants whose addresses have been furnished in compliance with Rule 4.5(a)(ii) (in the request) or Rule 53.4 (in the demand) of the withdrawal; should an applicant who did not sign the notice of withdrawal object to the withdrawal within a time limit of one month following the notification, the notice of withdrawal would be considered not to have been submitted.

10. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

SIGNATURE REQUIREMENTS

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² 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 90

Agents and Common Representatives

90.1 [No change]

90.2 [No change] *Common Representative*

(a) [No change] Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a “common agent”) under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 may be appointed by the other applicants as their common representative.

(b) [No change] Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office shall be considered to be the common representative of all the applicants.

90.3 *Effects of Acts by or in Relation to Agents and Common Representatives*

(a) [No change] Any act by or in relation to an agent shall have the effect of an act by or in relation to the applicant or applicants concerned.

[Rule 90.3, continued]

(b) [No change] If there are two or more agents representing the same applicant or applicants, any act by or in relation to any of those agents shall have the effect of an act by or in relation to the said applicant or applicants.

(c) [No change] Subject to Rule 90*bis*.5(a), second sentence, any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

90.4 to 90.6 [No change]

Rule 90bis

Withdrawals

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

(a) Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, ~~subject to paragraph (b)~~, be signed by the applicant or, if there are two or more applicants, subject to paragraphs (b) and (c), by each applicant who, or whose predecessor in title, has signed, in the case of a withdrawal referred to in Rule 90bis.1 to 90bis.3, the request or, in the case of a withdrawal referred to in Rule 90bis.4, the demand ~~all of them~~. An applicant who is considered to be the common representative under Rule 90.2(b) shall, ~~subject to paragraph (b)~~, not be entitled, merely by virtue of that fact, to sign such a notice on behalf of the other applicants.

[COMMENT: See paragraphs 7 and 8 in the Introduction to this document. As at present, a deemed common representative could not sign a notice of withdrawal on behalf of all the other applicants (see also Rule 90.3(c), which is not proposed to be amended, above). Rather, the signature of each applicant who, or whose predecessor in title, has signed the request or the demand, as the case may be, would be required. Of course, if the deemed common representative was the only applicant who signed the request, he can sign a notice of withdrawal (see the first sentence of paragraph (a) as proposed to be amended), but such notice of withdrawal would, under paragraph (c), be open to an objection by any applicant who did not sign the notice of withdrawal, in which case the notice would be considered not to have been submitted. The Receiving Office Guidelines would have to be modified so as to clarify that an applicant who signed the request or the demand, as the case may be, but who, following the recordal of a change under Rule 92bis, is no longer an applicant and has no successor in title, would not have to sign any notice of withdrawal.]

[Rule 90bis.5, continued]

(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor and has signed the request or the demand, as the case may be, could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant whose signature is required under paragraph (a) and

(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned: ~~or~~

~~(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d) or 90bis.3(e), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or~~

~~(iii) in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with.~~

[COMMENT: The proposed amendment of paragraph (b) is consequential on the proposed amendment of paragraph (a).]

[Rule 90bis.5, continued]

(c) Where there are two or more applicants and a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 has been signed in accordance with paragraph (a) but has not been signed by all of the applicants, the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, shall promptly notify the receipt of the notice of withdrawal to all applicants whose addresses have been furnished in accordance with Rule 4.5(a)(ii) or Rule 53.4. If any applicant who did not sign the notice of withdrawal objects to the withdrawal within a time limit of one month from the date of the notification, the notice of withdrawal shall be considered not to have been submitted and the receiving Office, the International Bureau or the International Preliminary Examining Authority, as the case may be, shall so inform all applicants whose addresses have been furnished in accordance with Rule 4.5(a)(ii) or Rule 53.4.

[COMMENT: See paragraphs 7 and 8 in the Introduction to this document. Of course, paragraph (c) would not apply where the notice of withdrawal is signed by a common agent or an appointed common representative, representing all applicants, since the signature of the common agent or the appointed common representative would be on behalf of all applicants.]

90bis.6 and 90bis.7 [No change]

Rule 92

Correspondence

92.1 *Need for Letter and for Signature*

(a) Any paper submitted by the applicant in the course of the international procedure provided for in the Treaty and these Regulations, other than the international application itself, shall, if not itself in the form of a letter, be accompanied by a letter identifying the international application to which it relates. The letter shall be signed by the applicant or, where there are two or more applicants, subject to paragraph (a-bis), by each applicant who, or whose predecessor in title, has signed the request or the demand.

[COMMENT: See paragraph 7 in the Introduction to this document. It would, of course, be sufficient for the letter to be signed by the common agent or the appointed common representative. It would also be sufficient for the letter to be signed by the deemed common representative, even if he had not signed the request or the demand, since, pursuant to Rule 90.3(c), the signature of the deemed common representative has the effect of an act by or in relation to all the applicants, including those who had signed the request or the demand.]

(a-bis) Rule 90bis.5(b) shall apply *mutatis mutandis*.

[COMMENT: It is proposed to add new paragraph (a-bis) so as to clarify that the signature of an applicant/inventor for the designation of the United States of America who had signed the request (or the demand) is not needed where that applicant could not be found or reached after diligent effort, provided that at least one other applicant who has signed the request or the demand signs the correspondence.]

(b) and (c) [No change]

92.2 to 92.4 [No change]

[End of Annex and of document]