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PROPOSALS WITH RESPECT TO PROCESSING UNDER ARTICLE 14(4)

Document prepared by the United States of America

SUMMARY

1. This document contains recommendations for modification of the Receiving Office Guidelines and proposals for amendment of the Regulations under the PCT as they relate to processing under Article 14(4)¹. Specifically, the document recommends that the Receiving Office Guidelines be modified and the Regulations be amended so as to bring the processing instructions currently set forth in the Receiving Office Guidelines into agreement with the language of Article 14(4).

BACKGROUND

2. Article 14 of the PCT requires the receiving Office to perform checks for certain defects in the international application and to invite the applicant to submit corrections. Article 14(4) is directed to the situation where the receiving Office, when reviewing the international application, fails to detect a defect under Article 11(1)(i) to (iii) and, as a result, improperly accords an international filing date. In respect of such a situation Article 14(4) states:

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.

“If, after having accorded an international filing date to the international application, the receiving Office finds, within the prescribed time limit, that any of the requirements listed in items (i) to (iii) of Article 11(1) was not complied with at that date, the said application shall be considered withdrawn and the receiving Office shall so declare.”

3. In discussing receiving Office processing under Article 14(4), the last two sentences of paragraph 52 of the Receiving Office Guidelines set forth procedures to be followed by the receiving Office in the situation where the application is missing the entire description or claims. Specifically, the last two sentences of paragraph 52 state:

“Furthermore, where the receiving Office finds that no part which on the face of it appears to be a description or claims was contained in the international application at the time of filing, it first invites the applicant to either incorporate the missing element by reference (see paragraph 49) or to correct the defect under Rule 20.3 within the time limit of Rule 20.7(a)(i) (Form PCT/RO/103). If no response is received to this invitation within the time limit under Rule 20.7(a)(i), the receiving Office proceeds as outlined in paragraphs 53 and 54.”

4. In the situation where the applicant is able to incorporate the missing element by reference, there is no conflict with the language of Article 14(4) since the applicant is merely establishing that the missing element was indeed contained in the application on the international filing date as originally accorded by the receiving Office. However, the procedures under paragraph 52 are *ultra vires* to Article 14(4) in the situation where the applicant is unable to incorporate the missing element by reference and therefore unable to establish that Article 11(1) was complied with on the originally accorded international filing date. Specifically, while the Article requires that the application be considered withdrawn in such a situation, the Guidelines indicate that the receiving Office is allowed to accord the application a new filing date in accordance with Rule 20.3(b)(i).

5. Therefore, it is recommended that the Receiving Office Guidelines be modified to bring them into agreement with Article 14(4) by removing the option of allowing applicant to correct the application and receive a new filing date. Specifically, it is recommended that the last two sentences of paragraph 52 be deleted. Further, it is recommended that paragraph 53 be modified to provide that, in the situation where (i) the application is missing the entire description or claims and (ii) the request includes the appropriate statement under Rule 4.18, the notice that the receiving Office intends to declare the international application withdrawn under Article 14(4) include an invitation to provide the missing element and confirm the incorporation by reference in accordance with Rule 20.6. Such a modification of the Guidelines would also necessitate a modification of Form PCT/RO/115.

6. Additionally, it is proposed that Rule 29.4 be amended to provide that applicant's arguments in response to the notification of intent to declare the international application withdrawn under Article 14(4) may include a confirmation of incorporation by reference under Rule 20.6. Further, in order to avoid confusion for applicants as to what time limit the confirmation must be filed under, Rule 29.4 is also proposed to be amended to make the period for response to the notification of intent to declare the international application withdrawn under Article 14(4) the same as the period for response set in Rule 20.7.

RECOMMENDATIONS WITH RESPECT TO THE RECEIVING OFFICE GUIDELINES
AND PROPOSALS WITH RESPECT TO AMENDING RULE 29

7. It is recommended that the Receiving Office Guidelines be modified as discussed above. Further, it is proposed that Rule 29 be amended as discussed above and as presented in the Annex to this document.

8. *The Working Group is invited to:*

(i) consider whether the Receiving Office Guidelines should be modified as discussed above; and

(ii) consider the proposals contained in the Annex.

[Annex follows]

ANNEX

PROPOSALS WITH RESPECT TO PROCESSING UNDER ARTICLE 14(4)

PROPOSED AMENDMENTS OF THE PCT REGULATIONS²

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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 29

International Applications Considered Withdrawn

29.1 to 29.3 [No change]

29.4 *Notification of Intent to Make Declaration Under Article 14(4)*

Before the receiving Office issues any declaration under Article 14(4), it shall notify the applicant of its intent to issue such declaration and the reasons therefor. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within ~~one month~~ two months from the notification. The applicant's arguments may include a confirmation of incorporation by reference in accordance with Rule 20.6.

[End of Annex and of document]