

Patent Cooperation Treaty (PCT) Working Group

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Proposed Amendments of Rules 17.1(b-*bis*) and 20.7(b)

Document prepared by the International Bureau

CORRECTIONS AND ADDITIONS COMPARED TO DOCUMENT PCT/WG/4/10

Following informal comments on the proposed amendment to Rule 17.1(b-*bis*) in the Annex to document PCT/WG/4/10, the International Bureau wishes (i) to correct an error in that proposal (which should have referred to the priority document being available to the International Bureau before international publication, rather than the request to obtain it being made before international publication), (ii) to explain more clearly the intended policy underlying the Rules concerning provision of the priority document, and (iii) to introduce an unconnected proposal relating to the same Rule.

The summary below has been adjusted compared to that in document PCT/WG/4/10. Paragraphs 2 to 9 completely replace old paragraphs 2 to 5. Paragraphs 10 to 12 explain the new proposal. Paragraphs 13 to 19 are unchanged, save for minor editorial changes and the renumbering of the paragraphs.

SUMMARY

1. This document contains three proposals (not related to one other) to amend the PCT Regulations. The first two proposals relate to Rule 17.1(b-bis) (dealing with the submission of priority documents), first to effectively extend the time limit within which the applicant can request the International Bureau to obtain a priority document from a digital library, and second, to remove the (unused) option of requesting that a receiving Office obtain a priority document that way. The third proposal is to amend Rule 20.7(b) (dealing with the incorporation by reference of elements or parts of the international application) so as to clarify the wording of that Rule which, as it stands today, appears to leave room for a misinterpretation.

PROPOSED AMENDMENTS OF RULE 17.1(b-bis)

Time Limit to Request Retrieval of Priority Document

2. There are currently three permitted ways of meeting the requirement to furnish a priority document during the international phase of the PCT:
 - (a) *Rule 17.1(a)* – The applicant may obtain a copy of the priority document from the Office where the earlier application was filed and forward that copy to either the receiving Office or the International Bureau. The time limit for doing this is in principle 16 months from the priority date, but the time limit is also considered to be met if the priority document is received by the International Bureau (whether directly from the applicant or forwarded by the receiving Office) before the date of international publication.
 - (b) *Rule 17.1(b)* – Where the priority document is issued by the receiving Office, the applicant may request the receiving Office to prepare the priority document and transmit it directly to the International Bureau. There is a strict time limit of 16 months from the priority date for requesting the receiving Office to perform this action, but there is no consequence for the applicant if the receiving Office fails to deliver the priority document to the International Bureau before the international publication date.
 - (c) *Rule 17.1(b-bis)* – Where the priority document is available to either the receiving Office or the International Bureau from a digital library, the applicant can request the receiving Office or the International Bureau to retrieve the document directly. There is a strict time limit of 16 months from the priority date for making such a request.
3. The goal underlying these Rules is that the priority document should, in normal circumstances, be available for public inspection from the international publication date so that third parties interested in the likely validity of the international application – and, where applicable, the International Preliminary Examining Authority – are able to assess whether the priority claims are supported.
4. The main (16 month) time limit stated in each of the above Rules is such that, in normal cases, the Offices concerned should be able to complete the processing and, where relevant, the transmission of the document in time to meet that underlying goal of making the priority document available at the time of publication. In any case, if the applicant complies with the 16 month time limit, any delays in making the document available caused by the Offices concerned will not penalize the applicant.

5. However, applicants frequently have difficulty obtaining a copy of the priority document in time to deliver it to the receiving Office or the International Bureau within 16 months from the priority date. To mitigate this problem for applicants without changing the main time limit (which would certainly increase the number of international applications where the priority document was missing at the time of international publication), Rule 17.1(a) contains a derogation, whereby the time limit is considered to have been met as long as the International Bureau actually receives the priority document before the date of international publication.
6. This derogation does not apply to Rules 17.1(b) and 17.1(b-bis). In the case of Rule 17.1(b), it is not considered desirable. There should rarely be a situation where it is difficult for the applicant to request the receiving Office within 16 months from the priority date and, as noted above, the applicant will not be penalized if the receiving Office is slow in delivering the priority document to the International Bureau. To allow applicants to make that request later as long as the document was actually received by the International Bureau before the date of international publication would inevitably result in undue pressure on receiving Offices to quickly furnish documents to correct the applicant's own omission.
7. On the other hand, in the case of Rule 17.1(b-bis), priority documents can be retrieved automatically by the International Bureau from a digital library almost immediately as long as they have been properly made available without any further work being required by the receiving Office or the Office from whose digital library the document is to be retrieved. However, the complexity of the current processes for ensuring that the priority document is available from a digital library means that many of requests to retrieve such documents are rendered invalid because the document is initially found not to be available to the International Bureau from the digital library within the current time limit of 16 months from the priority date and the applicant needs to take some action to correct this. The International Bureau will seek to reduce the complexity of these processes, but this will take time and requires agreement between all of the participating Offices in the WIPO Digital Access Service for Priority Documents (DAS).
8. Consequently, while it seems desirable to keep the same main time limit in Rule 17.1(b-bis) as for Rules 17.1(a) and (b) for the sake of simplicity, there is scope for providing the same type of derogation in this case as already applies in Rule 17.1(a). In other words, the time limit should be considered to have been met even if the initial request is defective as long as the document becomes available to the International Bureau before the date of publication. While still achieving the underlying goal described in paragraph 3 above, this would provide further flexibility for the applicant in dealing with errors, with little administrative difficulty for the International Bureau.
9. The proposed inserted passage in the last sentence of Rule 17.1(b-bis) shown in the Annex to this document would give this effect.

Offices Which May Be Requested to Obtain a Document from a Digital Library

10. Rule 17.1(b-bis) permits applicants to request either the receiving Office or the International Bureau to retrieve a priority document from a digital library. However, even though this option is provided for on the request form, no receiving Office presently offers this service. This leads to significant confusion and errors, with applicants ticking boxes to request a service which in reality does not exist. Furthermore, as long as the International Bureau has access to the same range of digital libraries as the receiving Office, there is no benefit in the priority document being obtained by the receiving Office. This would simply involve additional processing by the receiving Office to forward the document to the International Bureau, with consequent possibilities for delays and errors.

11. Consequently, it is proposed to delete the option in Rule 17.1(b-bis) allowing a request for the receiving Office to obtain the priority document from a digital library. The International Bureau would then encourage Offices with suitable digital libraries to join DAS so that their applicants' documents can be made available to the PCT system that way. Since the International Bureau does not wish to collect a fee for this service, the reference to permitting a fee could be deleted at the same time.
12. This proposal is independent of the proposal relating to time limits and either one could be adopted separately, if so required.

PROPOSED AMENDMENT OF RULE 20.7(b)

13. There appears to be room for a misinterpretation of the provisions of present Rule 20.7(b), dealing with the incorporation by reference of elements or parts of the international applications, which should be closed by an appropriate amendment to the PCT Regulations.
14. The following example (based on a real case) is given to illustrate that gap:
 - (a) an applicant files an international application without any claims (an element of the international application which, in order for the application to be accorded an international filing date, has to be present on the date of receipt of the international application; see Article 11(1)(iii)(e));
 - (b) the receiving Office issues an invitation to the applicant under Rule 20.3(a) to furnish the required correction under Article 11(2) (i.e., the missing claims) or to confirm in accordance with Rule 20.6(a) that the missing element "claims" were incorporated by reference under Rule 4.18;
 - (c) the applicant furnishes, within the time limit under Rule 20.7(a)(i), a set of claims without confirming their incorporation by reference under Rule 4.18;
 - (d) the receiving Office processes the submission of the set of claims as a correction under Article 11(2) and accords the date of receipt of the set of claims as the international filing date, in accordance with Rule 20.3(b)(i);
 - (e) following the according of the international filing date (see paragraph (d), above), the applicant confirms, after the expiration of the time limit under Rule 20.7(a)(i), that the missing claims were incorporated by reference under Rule 4.18 and argues, with reference to the wording of Rule 20.7(b), that the incorporation by reference should be considered timely because it was received by the receiving Office before that Office had sent a notification to the applicant under Rule 20.4(i) that the application is not and will not be treated as an international application.
15. Present Rule 20.7(b) reads as follows:

"Where a correction under Article 11(2) or a notice under Rule 20.6(a) confirming the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) is received by the receiving Office after the expiration of the applicable time limit under paragraph (a) but before that Office sends a notification to the applicant under Rule 20.4(i), that correction or notice shall be considered to have been received within that time limit."

16. When that Rule was added to the PCT Regulations with effect from April 1, 2007, the intention was clearly that it should only apply in the case that *neither* a correction under Article 11(2) *nor* the confirmation of an incorporation by reference is received within the applicable time limit and where the receiving Office consequently is required to send the notification under Rule 20.4(i) that the application is not and will not be treated as an international application. The intention was that it should *not* apply where the applicant corrected the application under Article 11(2) within the applicable time limit (as in the example referred to in paragraph 14, above), since in such a situation a filing date is accorded and a notification under Rule 20.4(i) that the application is not and will not be treated as an international application is never sent. If Rule 20.7(b) were to apply in this situation, it would mean that the time limit for the applicant to confirm the incorporation by reference of any missing element would never expire since the act which triggers the expiration of that time limit, namely, the sending by the receiving Office of the notification under Rule 20.4(i), would never occur.
17. The applicant in the case at hand argued that the current wording of Rule 20.7(b) allowed for an interpretation of Rule 20.7(b) in his favor, noting that the Rule was an “*or*” provision (“where a correction under Article 11(2) *or* a notice under Rule 20.6(a) confirming the incorporation by reference ... is received ... after the expiration of the applicable time limit ...”) rather than a “*neither ... nor ...*” provision, and that Rule 20.7(b) thus applied even in the case where an invitation to correct under Article 11(2) had already been issued and despite the fact that, in such as case, a notification under Rule 20.4(i) would never be sent.
18. While such an interpretation is contrary to the obvious intent of the Rule, upon consideration, and so as to put the matter beyond doubt, it is proposed to amend Rule 20.7(b) as set out in Annex II to this document.
 19. *The Working Group is invited to consider the proposed amendments of the PCT Regulations contained in the Annex to this document.*

[Annex follows]

ANNEX
PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ 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 17

The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) and (b) [No change]

(b-*bis*) Where the priority document is, in accordance with the Administrative Instructions, available to ~~the receiving Office or to~~ the International Bureau from a digital library, the applicant may, ~~as the case may be,~~ instead of submitting the priority document, ~~:~~

- ~~(i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or~~
- (ii) request the International Bureau to obtain the priority document from such digital library.

Such request shall be made not later than 16 months after the priority date, provided that any request which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if the priority document is available to the International Bureau from the digital library before the date of international publication of the international application ~~and may be subjected by the receiving Office or the International Bureau to the payment of a fee.~~

(c) and (d) [No change]

17.2 [No change]

Rule 20
International Filing Date

20.1 to 20.6 [No change]

20.7 *Time Limit*

(a) [No change]

(b) Where neither a correction under Article 11(2) ~~nor~~ ~~or~~ a notice under Rule 20.6(a) confirming the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) is received by the receiving Office prior to ~~after~~ the expiration of the applicable time limit under paragraph (a), any such correction or notice received by that Office after the expiration of that time limit but before it ~~that Office~~ sends a notification to the applicant under Rule 20.4(i), ~~that correction or notice~~ shall be considered to have been received within that time limit.”

20.8 [No change]

[End of Annex and of document]