

Patent Cooperation Treaty (PCT) Working Group

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Excuse of Delay in Meeting Certain Time Limits due to *Force Majeure*

Document prepared by the International Bureau

SUMMARY

1. The recent natural catastrophes in Japan have provided a reminder that the Patent Cooperation Treaty legal framework does not contain a general provision for excuse of delay in meeting PCT time limits due to circumstances beyond the control of the applicant. It is thus proposed to amend the PCT Regulations in order to fill this gap, and provide a limited measure of flexibility within the PCT to provide relief to adversely affected PCT applicants in exceptional circumstances.

BACKGROUND

2. In response to the recent series of disasters in Japan, a number of IP offices have announced measures to attempt to assist applicants in meeting their obligations, in particular as they relate to relevant time limits within which to file or react to invitations, etc. These laudable efforts have resulted in the reflection by the International Bureau that the PCT is quite limited in what it can do to help PCT applicants who find themselves in such difficult circumstances; the existing PCT legal framework does not include significant flexibility as regards being able to excuse delay in complying with PCT time limits generally.
3. The PCT does contain a number of provisions which directly or indirectly provide for excuse of delay in meeting certain time limits in certain circumstances or before certain authorities, such as:

- (a) Article 48 and Rule 82*bis* (Excuse by Designated Offices/Elected Offices of delays in meeting certain time limits);
 - (b) Rule 82.1 & 82.2 (Delay or loss in mail/Interruption of mail service—mail from applicant to Office);
 - (c) Rule 26*bis*.3 (Restoration of Right of Priority by Receiving Office); Rule 49*ter*.1 (Effect of Restoration of Right of Priority by Receiving Office); Rule 49*ter*.2 (Restoration of Right of Priority by Designated Office);
 - (d) Rule 49.6 (Excuse of delay in failing to enter national phase within applicable time limit);
 - (e) Rule 80.5 (Expiration of a time limit on a non-working day at the relevant Office); and
 - (f) Rule 80.6 (Extension of time limit in case of delay in mail from Office to applicant)
4. However, none of these PCT provisions provides a basis for a general excuse of delay in meeting PCT time limits before all relevant authorities such as would be necessary to adequately protect PCT applicants who had suffered something akin to the series of natural disasters in Japan in March.
5. In past years, PCT bodies and the Standing Committee on the Law of Patents have considered related issues.

1997 Ad Hoc Advisory Group on Proposed Amendments of the PCT Regulations

6. The Ad Hoc Advisory Group on Proposed Amendments of the PCT Regulations, at its November 1997 session, considered a proposal (Topic 17: Proposal by the United States Patent and Trademark Office relating to extraordinary situations not otherwise provided for and suspension of Rules) which was motivated by the same general intention, that is, to provide flexibility when circumstances require. The proposed PCT Rule 97, inspired by US Rule 1.183 would have provided the IB and other Authorities with the flexibility to waive or suspend the Rules in extraordinary situations.
7. The discussion of this proposal by the Ad Hoc Group showed that the PCT Contracting States were concerned about giving that level of discretion to the IB and to themselves as PCT Authorities; while there was sympathy expressed with the intention, there was no support at that time for the USPTO proposal.

2001 Standing Committee on the Law of Patents (SCP)

8. After the attacks on the United States of America in 2001, the USPTO—noting the “grace periods” which were provided for Convention filings from Japan in the aftermath of the Kobe earthquake in January 1995—proposed to add to the agenda of the Standing Committee on the Law of Patents

“discussion of the need for immediate and longer-term worldwide relief for those patent applicants and patentees affected by the terrorist attacks in the United States of America, as well as other ‘*force majeure*’-type circumstances.” (SCP/6/7)

9. The result of this discussion was an agreement by the SCP to a suggestion of the International Bureau to send an invitation to all members of the SCP to submit information on existing or planned measures to remedy such cases, which would be published on the SCP electronic forum (paragraph 215 of document SCP/6/9). The "Information concerning relief under "*force majeure*" circumstances" continues to be available at http://www.wipo.int/scp/en/force_majeure/ and contains submissions from 18 national patent Offices, and three intergovernmental organizations.

2006 Working Group on Reform of PCT

10. The last time a PCT Working Group considered this issue was at the time of the avian flu scare in 2006. In May 2006, the Working Group on Reform of PCT considered document PCT/R/WG/8/8 which referred to existing PCT legal provisions which might prove useful (paragraph 21), and stated:
 - "21. One question raised by this scenario and plan which is of relevance to the PCT Contracting States is whether the States would like the International Bureau to possess special emergency powers beyond those provisions contained in the current PCT Regulations, in order to better deal with such cases, for example, giving more flexibility to extend deadlines, etc. and otherwise protect applicants from consequences of emergencies."
11. The document also offered to facilitate access to information by national offices on their emergency preparedness measures, if any.
12. The report of the 8th Session of the Working Group on Reform of the PCT (document PCT/R/WG/8/9) states:
 - "85. Another delegation expressed support for the proposed exchange of information on this subject, noting that not only a possible future avian flu pandemic but a variety of other emergency situations ought to be considered. The delegation referred to information provided by various offices in the context of the Standing Committee on the Law of Patents, which had been made available on the WIPO website, concerning relief for patent applicants and patentees in light of "*force majeure*"-type circumstances.
 - "86. ... The Working Group agreed that the Secretariat should continue to study the possible need for amendments to the PCT Regulations in order to provide the International Bureau with enhanced flexibility to respond to emergency situations in the near term, ..."
13. As a result, PCT Circular 1081 (June 19, 2006) was sent to all PCT Contracting States and responses received were posted at:
http://www.wipo.int/pct/en/emergency/emergency_preparedness_plans.html.

PROPOSAL

14. Prompted by recent emergency situations, this document invites the Working Group to consider a proposal for amendment to the PCT Regulations in order to provide the International Bureau (and other PCT Authorities) with enhanced flexibility to respond to the effects of emergency situations on PCT applicants.

15. It is proposed to add a new Rule (Rule 82*quater*) containing a general provision which would offer protection to applicants by excusing delays in meeting PCT time limits when that delay resulted from *force majeure* circumstances. The draft new Rule (see Annex):
 - (a) contemplates a case by case evaluation of applicability by PCT Offices and Authorities;
 - (b) would not apply to the 12 month period in the Paris Convention nor to the national phase entry time limits in PCT Articles 22 and 39;
 - (c) does not provide for a payment of a fee;
 - (d) does not provide for a specific time limit within which such a request must be made.
16. Although not including a specific time limit, the Rule requires the applicant or agent to take the relevant action "as soon as reasonably possible". This is something which should be judged by the relevant Office on the facts of the case. Commonly, this would mean within a short period of the cause of the delay ceasing to apply. For example, in cases where a strike prevented an agent from reaching his Office, it would be expected that the action should in most cases be taken either the next working day or shortly thereafter, depending on how much preparatory work had been disrupted. On the other hand, where a disaster had resulted in the complete destruction of an agent's files, it would naturally be expected to take longer to reassemble all the necessary documents and systems to allow the necessary action to be taken. The proposed Rule does not specifically refer to the action being taken "as soon as reasonably possible after the removal of the cause of the delay", because an applicant should still be expected to take reasonable steps to overcome problems in cases where it can be seen that the relevant emergency situation will continue for a considerable period and the applicant is not himself prevented by the emergency from taking remedial action.
17. As a consequence of the addition of new Rule 82*quater*, it is proposed to delete Rule 82.2, which would appear to become unnecessary.
18. As noted in paragraph 16(b), above, this proposal does not cover the time limits for filing an application validly claiming priority, since the time limits are not set by the Regulations but by Article 8 of the PCT and Article 4C of the Paris Convention, though some relief may be available through Rules 26*bis*.3 and 49*ter* (restoration of the right of priority) or Rule 80.5 (expiration of a time limit on a non working day at the relevant Office).
19. Similarly, the proposal also does not cover the time limit for entering the national phase, since the minimum time limit is set by Articles 22(1) and 39(1). However, it should be emphasized that these are minimum limits and it is open to Contracting States to provide for longer periods, or for reinstatement of rights which have been lost in the international phase either generally or in specific cases, such as *force majeure*. Moreover, Rule 49.6 specifically requires (subject to notifications of incompatibility with national law) the possibility of reinstatement of rights where a failure to enter the national phase was either unintentional or, at the option of the designated Office, despite the applicant having taken due care. The International Bureau would encourage national Offices to review their national legislation to see whether the remedies currently available in the national phase are sufficient to address with loss of rights (not limited specifically to missing the deadline for national phase entry) in cases of *force majeure* where this would seem appropriate and, if not, to prepare recommendations for change if an opportunity arises to amend the legislation. In the case of remedies currently possible, the International Bureau invites designated Offices to ensure that the national phase chapter of the PCT Applicant's Guide for their Office is complete and correct.

20. *The Working Group is invited to consider the proposed amendments contained in the Annex to this document.*

[Annex follows]

ANNEX

PROPOSED AMENDMENTS TO THE PCT REGULATIONS:

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Rule 82

Irregularities in the Mail Service

82.1 [No change]

82.2 [Deleted] *Interruption in the Mail Service*

~~(a) Any interested party may offer evidence that on any of the 10 days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.~~

~~(b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, provided that the interested party proves to the satisfaction of the said Office or organization that he effected the mailing within five days after the mail service was resumed. The provisions of Rule 82.1(c) shall apply mutatis mutandis.~~

Rule 82quater

Excuse of delay in meeting time limits

82quater.1 Excuse of Delay in Meeting Time Limits

- (a) Any interested party may offer evidence that a time limit fixed in the Regulations was not met due to war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.
- (b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in meeting the time limit shall be excused.

[End of Annex and of document]