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SCP/3/4
ORIGINAL: English
DATE: July 30, 1999

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF PATENTS

Third Session
Geneva, 6 to 14 September 1999

INTERFACE BETWEEN THE DRAFT PATENT LAW
TREATY (PLT) AND THE PATENT COOPERATION TREATY (PCT);
SUGGESTED AMENDMENTS TO ARTICLE 5 OF THE DRAFT PLT

prepared by the International Bureau

Introduction

1. At the second session of the Standing Committee on the Law of Patents (SCP), the SCP discussed the possible inclusion in the draft Patent Law Treaty (PLT) of additional requirements which were considered not to be incorporated by reference into the draft Patent Law Treaty (PLT) under Article 5(1), but which would be required by Contracting Parties of the PLT. These would include, in particular, the Patent Cooperation Treaty (PCT) requirements which could be imposed under national or regional law once the processing of the international application has started in the designated Office in the national phase, and which were not covered by Article 5(1) of the draft Treaty, as well as certain additional elements required by the delegations to the SCP.

2. During its second session, the SCP agreed to refer the question of the interface between the PLT and the PCT to the International Bureau for further study. The International Bureau, in carrying out this further study, began by examining the two following issues:

(i) the need for express inclusion by reference into the draft PLT of the documents or evidence which the national law may require the applicant to furnish once the processing of an international application has started in the designated Office;

(ii) the necessity to amend draft PLT Article 5(6) to allow a Contracting Party to require evidence, as provided for under PCT Article 27(2)(ii).

Documents Which May Be Required by the National Law under PCT Article 27(2)(ii)

3. Concerning item (i) above, the International Bureau identified the following factors for consideration:

- PCT Article 27(2)(ii) provides that national law may require, once the processing of an international application has started in a designated Office, the furnishing of documents that are not part of the international application, but constitute proof of allegations or statements made in that application. Examples of such documents are provided in some of the provisions of PCT Rule 51*bis*.1(a);

- Former draft PLT Article 5(2)(b) contained in document SCP/2/3 required a Contracting Party to accept the presentation of the contents of an application which correspond to the mandatory contents of an international application under the PCT on a request Form, corresponding to the PCT Request Form, with any modifications provided for in the Regulations. It would be beneficial for applicants if matters about which the national law may require the applicant to furnish documents or evidence once the processing of an international application has started in the designated Office under the PCT could also be covered in that request Form. Under the PCT Regulations at present, such matters may not be covered in the Request Form. However, modifications to the PCT Regulations which would provide the possibility to include such matters in the PCT Request Form are currently envisaged (see paragraphs 7 and 8 below).

4. Under the PCT, there are two phases, namely the international phase and the national phase. Under the PLT, however, there is only one phase, namely the national or regional filing. In order to ensure the widest parallelism possible between the PLT and the PCT, it is suggested that draft PLT Article 5(1) incorporate both the requirements relating to the international phase and the requirements as to matters about which the national or regional law may require the applicant to furnish documents or evidence once the processing of the international application has started in a designated Office. In consequence, it is also suggested to refer, in draft PLT Article 5(2), to the mandatory and the optional contents of the Request Form provided in the PCT.

Further Evidence Which May Be Required under PCT Article 27(2)(ii)

5. Concerning item (ii) above, the International Bureau identified the following factors for consideration:

- The additional requirements allowed under PCT Article 27(2)(ii) are stated in terms of evidentiary requirements. As stated above, the documents which may thus be required constitute proof of allegations or statements made in the international application. These evidentiary requirements can be imposed by Contracting States on a regular basis; that is, they can be required in the case of every application which does not already contain the matter referred to.

- However, in accordance with draft PLT Article 5(6), evidence can only be required under the PLT in the case of reasonable doubt. Evidence cannot be required as a matter of course by the Office of a Contracting Party (see Note 5.17 contained in document SCP/3/3).

6. Consequently, the International Bureau suggests that draft PLT Article 5(6) should allow a Contracting Party to require evidence as provided for under PCT Article 27(2)(ii). In view of the suggested amendment of PLT Article 5(1), this may be accomplished by a simple reference in paragraph (6) of draft PLT Article 5 to paragraph (1) of that Article.

Possible Modifications of the PCT

7. With respect to the PCT, the Ad Hoc Advisory Group on PCT Legal Matters is scheduled to consider at its next meeting, to be held from August 30 to September 3, 1999, suggested modifications to PCT Rules 4.1 and 51*bis*.1.

8. Suggested modifications to PCT Rule 51*bis*.1(a) would allow the national laws to require applicants to furnish additional documents relating to certain matters to the designated Offices once processing of the international application has started in the national phase. Such matters could, however, according to the suggested modifications of PCT Rule 4.1, be dealt with by including standard declarations or statements in the request, if the applicant so wishes. Such declarations or statements could also be furnished at a later point in time during the international phase of the processing of the international application, or at the start of processing before the designated Offices. Regardless of when they are furnished, if an applicant indeed furnishes such standard statements or declarations, then, in accordance with proposed PCT Rule 51*bis*.1(a-*bis*), a PCT Contracting State could not require them again, and could require further evidence only in the case of reasonable doubt concerning the completeness or veracity of the declaration or statement. This approach would, if adopted by the PCT Assembly, be similar to the approach contained in the draft PLT.

Suggested Amendments to the PLT

9. The Annex of the present document contains suggestions by the International Bureau for draft PLT Article 5(1), (2) and (6). These suggested provisions are also contained in document SCP/3/7.

10. It is considered that draft PLT Article 5(1) as presently drafted already incorporates by reference the system for declarations under suggested PCT Rule 4.1 referred to in paragraph 8 above. However, this may not be the case with respect to the documents which may be required by the national law under PCT Article 27(2)(ii). It is therefore suggested to add a new item (ii) to draft PLT Article 5(1) to cover these elements as well. It is further suggested to refer, in draft PLT Article 5(2), to the mandatory and the optional contents of the request Form provided in the PCT. As a consequence, there would be no need either to specify the PCT provisions relating to form or contents of an international application incorporated by reference into the draft PLT under Article 5(1), or to provide for any provision with respect to additional permitted requirements under Article 5(1), since all the relevant requirements provided under the PCT would be incorporated by reference into the PLT.

11. As to item (ii) of paragraph (2) above, according to draft PLT Article 5(6), a Contracting Party may only require evidence in the case of reasonable doubt. The suggested amendments of draft PLT Article 5(1) would require a modification of paragraph (6) in order to allow Contracting Parties to require evidence, where they have reasonable doubts, in the cases covered by both paragraphs (1) and (2) of draft PLT Article 5.

Express Exclusion of Substantive Matters from the Draft Treaty

12. Suggested draft PLT Article 5(1)(c) is inspired by PCT Article 27(5), and is included for purposes of clarity and avoidance of doubt. Since the suggested approach would not establish a list of provisions considered to constitute form or contents of an international application incorporated by reference into the PLT, it appears appropriate, as is the case in PCT Article 27(5), to specifically mention that substantive conditions of patentability are not covered.

Common Request Form for National and International Applications

13. The above suggestions make an even further step possible, which became apparent during consideration by the International Bureau of the PLT-PCT interface, as an eventual goal of the link between the PLT and the PCT, namely the use of a single request Form for both national and international applications.

14. This could be achieved through relatively minor amendments to the draft PLT, for example, by modifying draft PLT Article 5(2)(b) in order to allow applicants to use the PCT Request Form also for filing national applications in the following two cases: (i) if that Request Form is accompanied by an indication to the effect that the application is to be treated as a national application, or (ii) if, in the future, the PCT provides for a Request Form

which contains an indication to the effect that the application is to be treated as a national application. Of course, option (ii) would require some modification of the PCT Regulations.

15. The International Bureau considers that provision for the possibility of a common application for PCT and national filing would be of significant benefit for applicants, and that it would follow the principle accepted by the SCP, namely, that the draft PLT should be founded on a close link with the PCT.

[Annex follows]

ANNEX

Suggested Amendment of Draft PLT Article 5(1), (2) and (6)

Article 5

Application

(1) [*Form or Contents of Application*] (a) Except where otherwise provided for by this Treaty or prescribed in the Regulations, and subject to paragraph (6), n No Contracting Party shall require compliance with any requirement relating to the form or contents of an application different from or additional to the requirements relating to the form or contents: those

(i) which are provided for in respect of international applications under the Patent Cooperation Treaty;

~~except where otherwise provided for by this Treaty or prescribed in the Regulations, it being understood that~~

(ii) which, under the Patent Cooperation Treaty, may be provided for under the national law once the processing of the international application has started in the designated Office.

(b) Notwithstanding subparagraph (a), a Contracting Party shall be free to provide for requirements which, from the viewpoint of applicants, are more favorable than the requirements applicable under the Patent Cooperation Treaty.

(c) Nothing in this paragraph is intended to be construed as prescribing anything that would limit the freedom of a Contracting Party to prescribe such substantive conditions of patentability as it desires.

(2) [*Request Form or Format*] (a) A Contracting Party may require that the contents of an application which correspond to the ~~mandatory~~ contents of the request of an international application under the Patent Cooperation Treaty be presented on a request Form or in a format prescribed by that Contracting Party.

(b) Notwithstanding subparagraph (a), and subject to Article 7(1), a Contracting Party shall accept the presentation of the contents referred to in subparagraph (a):

(i) on a request Form, ~~filed on paper~~, if that request Form corresponds to the Patent Cooperation Treaty Request Form with any modifications provided for in the Regulations;

(ii) on a Patent Cooperation Treaty Request Form, if that request Form is accompanied by an indication to the effect that the applicant wishes the application to be treated as a national application;

(iii) on a Patent Cooperation Treaty Request Form which contains an indication to the effect that the applicant wishes the application to be treated as a national application, if such a request Form is available under the Patent Cooperation Treaty.

(c) Notwithstanding subparagraph (a), and subject to Article 7(1), a Contracting Party shall accept the presentation of the contents referred to in subparagraph (a) in a format, if that format corresponds to the Model International Request Format provided for in the Regulations.

...

(6) [*Evidence*] A Contracting Party may require that evidence be filed with its Office in the course of the processing of the application only where that Office may reasonably doubt the veracity of any matter ~~contained in the request Form or format~~ referred to in paragraphs (1) and (2), or in a declaration of priority, or the accuracy of any translation ~~required under~~ referred to in paragraph (3) or (5).

[End of document]