



C. PCT 938
-04

October 3, 2003

Madam,
Sir,

./ Please find enclosed a copy of Note C. PCT 937 addressed today to the Minister for Foreign Affairs of your country. That Note constitutes the invitation to participate in the fifth session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, convened to meet in Geneva from November 17 (10 a.m.) to 21, 2003.

./ Working documents PCT/R/WG/5/1, 2, 3, 4, 5, 6, 7, 8 and 9, established for the fifth session of the Working Group, are enclosed; they are also available on WIPO's web site (see <http://www.wipo.int/pct/en/meetings>).

Sincerely yours,

A handwritten signature in black ink, appearing to read 'Francis Gurry', is written over a light blue horizontal line.

Francis Gurry
Assistant Director General

Enclosures: Note C. PCT 937
documents PCT/R/WG/5/1, 2, 3, 4, 5, 6, 7, 8 and 9



C. PCT 937

-04

The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments to the Minister for Foreign Affairs and has the honor to invite His Excellency's Government to be represented at the fifth session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which will be held in Geneva, at the headquarters of WIPO, from November 17 (10 a.m.) to 21, 2003.

The proceedings will be informal, and it is envisaged that the five days of the session will be devoted to discussions. There is no formal agenda and there will be no formal report, but it is envisaged that a summary of the session will, as at the previous sessions of the Working Group, be prepared by the Chair and issued as a document. The topics for discussion at the session will be the following:

1. further streamlining and simplification of PCT procedures;
2. rectification of clear mistakes (obvious errors);
3. central deposit system for nucleotide and amino acid sequence listings;
4. formalities checking under the PCT;
5. aspects of copyright and other rights in non-patent literature made available by intellectual property offices;
6. divisional applications under the PCT;
7. restoration of right of priority;
8. "missing part" requirements;
9. future development of international search and examination: making greater use of international reports.

Working documents will be available in English and French. Simultaneous interpretation will be provided in English, French and Spanish.

Working documents will be communicated direct to the industrial property Office of His Excellency's Government and, on request, to His Excellency's Ministry. They are also being made available on WIPO's website (see <http://www.wipo.int/pct/en/meetings>).

An electronic forum has been established to facilitate the work of the Working Group and other bodies concerning reform of the PCT. The forum, which is accessible via the web page relating to the session, enables the submission by e-mail, and subsequent posting and browsing, of comments on matters concerning PCT reform. Provision is also made for subscription to an electronic mailing list by persons wishing to be informed when additional documents are made available on the web page and when comments are posted on the electronic forum.

The International Bureau would appreciate it if the name(s), title(s) and e-mail address(es) of the representative(s) of His Excellency's Government who will attend the session could be communicated to it by October 24, 2003.

October 3, 2003

WIPO



PCT/R/WG/5/1
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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Fifth Session

Geneva, November 17 to 21, 2003

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS;
SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION;
PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT;
INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified above [in document PCT/A/32/2], on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will thence cease to be provisional in nature.

BACKGROUND

3. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group were certain proposals aimed at further streamlining and simplifying the PCT procedure.

4. The Working Group agreed that specific proposals for amendment of the Regulations would be prepared by the Secretariat, taking into account the discussion and conclusions reflected in the summary of the third session of the Working Group by the Chair and other points of detail noted by the International Bureau, for further consideration by the Working Group, where possible at its next session. Proposals for consideration in the short term would primarily be dealt with by way of amending the Regulations, but longer term proposals involving revision of the Treaty should also be identified and draft provisions prepared (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 112).¹

5. For the fourth session of the Working Group, the International Bureau had prepared a number of proposed amendments of the PCT Regulations aimed at further streamlining and simplifying the PCT procedure. However, having regard to the time available during the fourth session, discussions on the contents of document PCT/R/WG/4/4 were limited to proposals concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13^{ter}.1 (see Annex I of document PCT/R/WG/4/4) and proposals in the nature of corrigenda and consequential amendments (see Annex V of document PCT/R/WG/4/4). With regard to Annex I of document PCT/R/WG/4/4, the Working Group agreed that the International Bureau should prepare revised proposals taking into account the comments and clarifications set out in the summary of the fourth session of the Working Group by the Chair (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 97 to 102). With regard to Annex V of document PCT/R/WG/4/4, the Working Group concluded its discussion and approved certain amendments of the Regulations with a view to their submission to the Assembly (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 5 to 15). Discussions on the remaining matters (Annexes II to IV of document PCT/R/WG/4/4) were deferred until the next session of the Working Group (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraph 104).

6. The Annexes to this document contain a number of proposed amendments of the PCT Regulations aimed at further streamlining and simplifying the PCT procedure:

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. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

(i) Annex I contains proposals concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13ter.1, taking into account the comments and clarifications set out in the summary of the fourth session of the Working Group by the Chair (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 97 to 102; and paragraphs 8 to 11, below);

(ii) Annex II reproduces the contents of Annex II of document PCT/R/WG/4/4 and contains proposals to simplify the protest procedure before both the International Searching Authority ("ISA") and the International Preliminary Examining Authority ("IPEA") in case of non-unity of invention (see document PCT/R/WG/3/1, Annex I, items 4 and 10; the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97; and paragraphs 12 to 14, below);

(iii) Annex III reproduces the contents of Annex III of document PCT/R/WG/4/4 and contains proposals to permit, upon request of the applicant, the publication of a translation furnished by the applicant, or of the international application as filed, if filed in a non-publication language, together with the international application (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 82; and paragraphs 15 and 16, below);

(iv) Annex IV reproduces the contents of Annex IV of document PCT/R/WG/4/4 and contains a proposal to allow for the use of, and to introduce, a standardized international form for entry into the national phase (see document PCT/R/WG/3/5, paragraphs 67 and 68; the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 67 and 68; and paragraphs 17 and 18, below).

7. The proposals are further outlined in the following paragraphs.

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

8. At its third session, the Working Group reviewed a proposal to amend Rule 13ter and to provide that International Searching Authorities and International Preliminary Examining Authorities would no longer be obliged to issue invitations to furnish sequence listings in computer readable form complying with the prescribed standard or to carry out an international search and international preliminary examination in case where a sequence listing complying with that standard had not been filed (see document PCT/R/WG/3/1, Annex I, item 5).

9. The Working Group agreed not to proceed with the proposal. However, recognizing that it was desirable that sequence listings complying with the prescribed standard should be furnished together with the international application so as not to delay the start of the international search, it was agreed that the International Bureau should prepare a proposal which would permit Authorities to require the payment of a late furnishing fee where an invitation had to be issued under Rule 13ter.1(a)(ii) or (e) (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57).

10. At its fourth session, the Working Group discussed proposals prepared by the International Bureau concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13ter.1. The Working Group's discussions are outlined in document PCT/R/WG/4/14, paragraphs 97 to 102:

“97. Discussions were based on document PCT/R/WG/4/4, Annex I.

“98. The Working Group agreed that the Secretariat should prepare revised proposals taking into account the comments and clarifications set out in the following paragraphs.

“*Rule 13 ter.1*

“99. The Working Group agreed that Rule 13 *ter.1(a)* as proposed to be amended should be further amended so as to also require the payment of a late furnishing fee in the case where an invitation was issued under Rule 13 *ter.1(a)(i)*.

“100. The Working Group agreed that Rule 13 *ter.1(c)* as proposed to be amended should be further amended to read:

“(c) If the applicant has ~~does not~~, within the time limit fixed in the invitation, furnished the required sequence listing and paid any required late furnishing fee ~~comply with an invitation under paragraph (a) within the time limit fixed in the invitation~~, the International Searching Authority shall not be required to search the international application to the extent that ~~such non-compliance has the result that~~ a meaningful search cannot be carried out without the required sequence listing.”

“101. Certain delegations suggested the fixing of a maximum amount for the late furnishing fee, but other delegations noted that the Regulations in general left the fixing of fees to the discretion of each Authority.

“102. One delegation expressed concern as to the operation of Rule 13 *ter.1* in the case where an international application is forwarded from one (non-competent) Authority to another (competent) Authority.”

11. As agreed by the Working Group at its fourth session, Annex I to this document contains revised proposals for amendment of the PCT Regulations concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13 *ter.1*, taking into account the comments and clarifications set out in the summary of the fourth session of the Working Group by the Chair (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 97 to 102).

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

12. With regard to the protest procedure before both the International Searching Authority (“ISA”) and the International Preliminary Examining Authority (“IPEA”) in case of non-unity of invention, the Working Group during its third session agreed that the International Bureau should prepare a proposal for simplifying the protest procedure under Rules 40 and 68 (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97, in particular, paragraph 97).

13. It was also agreed (see document PCT/R/WG/3/5, paragraph 97) that:

“...inordertodiscovermoreinformationabouttheexperienceofAuthoritiesregarding thisissue,theInternationalBureaushouldsendoutaquestionnaireaskingthemto indicatehowmanyinvitationstheyissuedperyearunderRules 40and68,howmany additionalfeeswerepaidunderprotest,andhowmanyoftheinvitationswereinrespect ofapplicationscontainingclaimsmorethan,say,10inventions.”

14. ForthefourthsessionoftheWorkingGroup,theInternationalBureauhadprepareda proposaltoamendRules 40and68accordingly(seeAnnexIIofdocumentPCT/R/WG/4/4). However,havingregardtothetimeavailablefordiscussionduringthefourthsession, discussionsonthisproposalweredefereduntilthenextsessionoftheWorkingGroup. AnnexIItothisdocumentreproducesthecontentsofAnnexIIofdocumentPCT/R/WG/4/4 fordiscussionatthissession.Anoverviewoftherepliesreceivedinresponsetothe questionnairesentoutbytheInternationalBureautoallInternationalSearchingand PreliminaryExaminingAuthorities(CircularC.PCT896)iscontainedindocument PCT/R/WG/4/4Add.1.

PUBLICATIONOFTRANSLATIONFURNISHEDBYTHEAPPLICANT

15. Duringitsthirdsession,theWorkingGroupdiscussedproposalsforaposibledeletion ofArticle64(4),basedondocumentPCT/R/WG/3/1,AnnexII,item28.TheWorkingGroup agreedthatfurtherconsiderationofthismatter,whileit wouldbewithinthecompetenceof theWorkingGroup,shouldbedeferreduntilprogresshadbeenmadeindiscussionsofprior artissuesbytheStandingCommitteefortheLawofPatents(SCP).Asarelatedmatter,the WorkingGroupagreed,however,thatt heInternationalBureaushouldlookintothe possibilityofamendingRule48soastoprovidefortheelectronicpublicationbythe InternationalBureauoftranslations,furnishedbytheapplicant,oftheinternational application(seethesummaryoftheChair'sreportofthethirdsessionoftheWorkingGroup, document PCT/R/WG/3/5,paragraphs78to82).

16. ForthefourthsessionoftheWorkingGroup,theInternationalBureauhadprepareda proposaltoamendRule48soastorequiretheInternationalBureau,onrequestofthe applicant,topublish,togetherwiththeinternationalapplication,anytranslationofthe internationalapplicationfurnishedbytheapplicantor,wheretheinternationalapplicationwas filedinalanguagewhichisnotalanguageofpublication,theinternationalapplicationinthe languageinwhichitwasfiled(seeAnnexIIIofdocumentPCT/R/WG/4/4).However, havingregardtothetimeavailablefordiscussionduringthefourthsession,discussionson thisproposal weredefereduntilthenextsessionoftheWorkingGroup.AnnexIIItothis documentreproducesthecontentsofAnnexIIIofdocumentPCT/R/WG/4/4fordiscussionat thissession.

INTERNATIONALFORMFORNATIONALPHASEENTRY

17. AtthethirdsessionoftheWorkingGroup,severaldelegationsandrepresentativesof userssupportedtheproposedintroductionofastandardizedinternationalformforentryinto thenationalphase(see documentPCT/R/WG/3/1,AnnexI,item11(introduceinternational formsfornationalphaseentry)),includingstandardtextsofdeclarationssimilar tothose providedforinthecaseoftherequestformunderRule4.17,ontheunderstandingthattheuse ofsuchaformbyapplicantswouldbeoptionalandnota requirementforavalidnational phaseentry.TheWorkingGroupagreedthattheInternationalBureau shouldprepare sucha proposal(see document PCT/R/WG/3/5,paragraphs 67and68).

18. For the fourth session of the Working Group, the International Bureau had prepared a proposal to amend Rule 49.4 accordingly (see Annex IV of document PCT/R/WG/4/4). However, having regard to the time available for discussion during the fourth session, discussions on this proposal were deferred until the next session of the Working Group. Annex IV to this document reproduces the contents of Annex IV of document PCT/R/WG/4/4 for discussion at this session. As regards the draft of a standardized international form for entry into the national phase, the International Bureau is studying the possible content of such form, taking into account the various national requirements of designated and elected Offices allowed under Rule 51*bis*.

19. The Working Group is invited to consider the proposals contained in the Annexes to this document.

[Annexes follow]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ²

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

TABLE OF CONTENTS

| | |
|--|---|
| Rule 13 ^{ter} Nucleotide and/or Amino Acid Sequence Listings | 2 |
| 13 ^{ter} .1 <i>Sequence Listing for International Authorities</i> | 2 |
| 13 ^{ter} .2 [No change] | 4 |

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 13ter

Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Sequence Listing for International Authorities

(a) Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:

(i) [No change]

(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it and to pay, where applicable, the late furnishing fee referred to paragraph (a) -bis, within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.

[COMMENT: Text modeled after Rule 12.3(c)(ii). Further amendments of Rule 13ter are proposed in document PCT/R/WG/5/3 (Deposit of Sequence Listings).]

(a-bis) The furnishing of a sequence listing in response to an invitation under paragraph (a)(ii) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee. The amount of the late furnishing fee shall be determined by the International Searching Authority and shall be specified in the invitation under paragraph (a)(ii).

[Rule 13ter.1(a), cont. inued]

[COMMENT: Text modeled after Rules 12.3(e) and 40.2(a). During the fourth session of the Working Group, certain delegations suggested the fixing of a maximum amount for the late furnishing fee but other delegations noted that the Regulations generally left the fixing of fees for the benefit of Authorities to the discretion of each Authority (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 101). In view of the latter, the proposal has not been further revised and remains as presented in Annex I of document PCT/R/WG/4/4.]

(b) [Remains deleted]

(c) If the applicant ~~has~~ does not within the time limit fixed in the invitation, furnished
the required sequence listing and paid any required late furnishing fee ~~comply with an~~
~~invitation under paragraph (a) within the time limit fixed in the invitation~~, the International
Searching Authority shall not be required to search the international application to the extent
that ~~such non-compliance has the result that~~ a meaningful search cannot be carried out.

[COMMENT: The proposed amendment of paragraph (c) was approved by the Working Group at its fourth session (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 100).]

(d) [No change]

(e) [No change] Paragraphs (a) and (c) shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

[COMMENT: No change is proposed to paragraph (e) which is included in this document only for ease of reference. The effect of the proposed change to paragraph (a) would be that the International Preliminary Examining Authority would be permitted, under paragraph (e), to require the payment of a late furnishing fee where it had issued an invitation to furnish a sequence listing complying with the prescribed standard.]

13ter.2 [Nochange]

[Annex II follows]

ANNEXII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ³

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

TABLE OF CONTENTS

| | |
|--|---|
| Rule 40 Lack of Unity of Invention (International Search) | 2 |
| 40.1 <i>Invitation to Pay</i> <u><i>Additional Fees; Time Limit</i></u> | 2 |
| 40.2 <i>Additional Fees</i> | 3 |
| 40.3 <i>[Deleted] Time Limit</i> | 4 |
| Rule 68 Lack of Unity of Invention (International Preliminary Examination) | 5 |
| 68.1 [No change] | 5 |
| 68.2 <i>Invitation to Restrictor Pay</i> | 5 |
| 68.3 <i>Additional Fees</i> | 6 |
| 68.4 and 68.5 [No change] | 8 |

³ 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 40

Lack of Unity of Invention (International Search)

40.1 Invitation to Pay Additional Fees; Time Limit

[COMMENT: Clarification only.]

The invitation to pay additional fees provided for in Article 17(3)(a) shall:

(i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention ~~; and shall~~

(ii) invite the applicant to pay the additional fees within [one month] [two months] from the date of the invitation, and indicate the amount of those fees to be paid ; and

(iii) invite the applicant to pay, where applicable, the protest fee referred to in Rule 40.2(e) within [one month] [two months] from the date of the invitation, and indicate the amount to be paid.

[COMMENT: It is proposed to amend Rule 40.1 so as to deal with all matters to be included in the invitation to the applicant (reasons, time limit for payment of additional fees and amount of those fees; where applicable, time limit for payment of protest fee and amount of that fee) for in just one Rule. See also Rule 40.3, below, which is proposed to be deleted. For the time limit for compliance with the invitation under items (ii) and (iii), two months would be consistent with the PLT but one month may be more appropriate to the tight time frame under which the PCT procedure operates.]

40.2 *Additional Fees*

(a) and (b) [No change]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protests shall be examined by a ~~three-member~~ board of appeal or other review body constituted in the framework ~~special instance~~ of the International Searching Authority ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

[COMMENT: To simplify the procedure, it is proposed to leave the form of the review body and its composition to the ISA. The expression “board of appeal or other review body constituted in the framework of...” is modeled after the terminology in paragraph 1.11 of the Explanatory Notes on the Patent Law Treaty. Furthermore, it does not appear necessary to provide for a protest in respect of unity of invention to be considered, in the first instance, by a higher authority than a board of appeal or other review body constituted in the framework of the ISA. This would, of course, not prevent a higher authority from hearing an appeal against a decision of that board of appeal or other review body.]

(d) [Deleted] ~~The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person whom made the decision which is the subject of the protest.—~~

[COMMENT: It is proposed that the form of the review body and its composition should be left to the ISA.]

[Rule 40.2, *con tinued*]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee.

~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest ("protest fee"). The protest fees shall be paid within one month from the date of the notification to the applicant of the result of the review. Where the applicant has not, within the time limit under Rule 40.1(iii), paid any required~~ If the protest fee is not so paid, the protest shall be considered withdrawn and the International Searching Authority shall so declare. The protest fees shall be refunded to the applicant where the ~~three member~~ board of appeal or other review body, ~~special instance or higher authority~~ referred to in paragraph (c) find that the protest was entirely justified.

[COMMENT: The amendment to the first sentence is proposed for the purposes of simplification – it does not appear necessary to oblige an ISA which wishes to require the payment of a protest fee for the examination of the protest to apply at two stages of the review process. The proposed amendment to the last sentence is consequential on the proposed amendment of paragraph (c).]

40.3 [Deleted] *Time Limit*

~~The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant's address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.~~

[COMMENT: See Comment on Rule 40.1 as proposed to be amended, above.]

Rule 68

Lack of Unity of Invention (International Preliminary Examination)

68.1 [No change]

[PRODOMO: Rule 68 could be further simplified by deleting Rule 68.1 and amending Rule 68.2 to provide an invitation in all cases (subject to Rule 66.1(e)), in line with the Chapter I procedure under Rule 40.1. However, this is not proposed since it would take away the present applicant-friendly “no invitation” procedure under Rule 68.1.]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, the invitation shall :

(i) specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement; ~~and shall~~

(ii) specify the amount of the additional fees and — the reasons for which the international application is not considered as complying with the requirement of unity of invention; ~~It shall, at the same time,~~ —

[Rule 68.2, continued]

(iii) invite the applicant to comply with the invitation within [one month] [two months] from the date of the invitation; ~~fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limits shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation~~

(iv) indicate the amount of the required additional fee to be paid in case the applicant so chooses; and

(v) invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within [one month] [two months] from the date of the invitation, and indicate the amount to be paid .

[COMMENT: The amendments proposed to Rule 68.2 correspond to those proposed to Rule 40.1.]

68.3 *Additional Fees*

(a) and (b) [No change]

[Rule 68.3, continued]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protests shall be examined by a ~~three-member~~ board of appeal or other review body constituted in the framework ~~special instance~~ of the International Preliminary Examining Authority ~~, or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the ~~text of both~~ ~~the protest and~~ ~~the decision thereon~~ shall be notified to the elected Offices as an annex to the international preliminary examination report.

[COMMENT: The amendments proposed to paragraph (c) correspond to those proposed to Rule 40.2(c).]

(d) ~~[Deleted] The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person whom the decision which is the subject of the protest.~~

[COMMENT: The proposed deletion of paragraph (d) corresponds to the proposed deletion of Rule 40.2(d).]

[Rule 68.3, continued]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a protest fee. ~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fee shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 68.2(iii), paid any required ~~If the~~ protest fee is not paid, the protest shall be considered ~~withdrawn~~ and the International Preliminary Examining Authority shall so declare. The protest fee shall be refunded to the applicant where the ~~three-member~~ board of appeal or other review body, ~~special instance or higher authority~~ referred to in paragraph (c) finds that the protest was entirely justified.

[COMMENT: The amendments proposed to paragraph (e) correspond to those proposed to Rule 40.2(e).]

68.4 and 68.5 [No change]

[Annex III follows]

ANNEXIII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ⁴

PUBLICATION OF TRANSLATIONS IN ADDITION TO
INTERNATIONAL PUBLICATION OF THE INTERNATIONAL APPLICATION

TABLE OF CONTENTS

| | |
|---|---|
| Rule 47 Communication to Designated Offices | 2 |
| 47.1 and 47.1 [No change] | 2 |
| 47.3 <i>Languages; <u>Translations</u></i> | 2 |
| 47.4 [No change] | 2 |
| Rule 48 International Publication | 3 |
| 48.1 and 48.2 [No change] | 3 |
| 48.3 <i>Languages of Publication</i> | 3 |
| 48.4 to 48.6 [No change] | 4 |

⁴ 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 47

Communication to Designated Offices

47.1 and 47.1 [No change]

47.3 *Languages; Translations*

(a) The international application communicated under Article 20 shall be in the language in which it is published.

(b) Where the language in which the international application is published is different from the language in which it was filed, the International Bureau shall furnish to any designated Office, upon the request of that Office, a copy of that application in the language in which it was filed or of any translation furnished under Rule 48.3(d)(ii).

47.4 [No change]

Rule 48

International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) [No change] If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.

(b) [No change] If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 or 12.4, that application shall be published in the language of that translation.

(c) If the international application is published under paragraph (a) or (b) in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

[Rule 48.3, continued]

(d) Upon request by the applicant received by the International Bureau prior to the expiration of 16 months from the priority date, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, the International Bureau shall publish, together with the international application as published under paragraph (a) or (b):

(i) in the case referred to in paragraph (b), the international application in the language in which it was filed;

(ii) any translation of the international application furnished by the applicant within the time limit under paragraph (e).

[COMMENT: The proposed publication of the international application in the language in which it was filed (if filed in a non-publication language) and of any translation of the international application furnished by the applicant would take place in addition to, but would not form part of, the international publication of the international application under Article 21. Publication and communication to designated Offices of the international application in a language different from the language in which international publication takes place would be beneficial for the protection of rights of the applicant under the national law of certain designated States, for example, designated States which make provisional protection after the international publication of an international application conditional on the furnishing of a translation, or States where the prior art effect of an international application is, in accordance with Article 64(4), dependent on the publication of a translation into a language accepted by the Office of the designated State concerned.]

48.4 to 48.6 [No change]

[Annex IV follows]

ANNEXIV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:⁵

INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

TABLE OF CONTENTS

| | |
|--|---|
| Rule 49 Copy, Translation and Fee Under Article 22 | 2 |
| 49.1 to 49.3 [No change] | 2 |
| 49.4 Use of National <u>or International</u> Form | 2 |

⁵ 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 49

Copy, Translation and Fee Under Article 22

49.1 to 49.3 [No change]

49.4 *Use of National or International Form*

(a) No applicant shall be required to use a ~~national~~ form when performing the acts referred to in Article 22.

(b) The designated Offices shall accept the use by the applicant, when performing the acts referred to in Article 22, of the form prescribed by the Administrative Instructions for the purposes of this paragraph, provided that the Office may require that the form shall be filed in a language of publication which it accepts for the purposes of this paragraph.

[COMMENT: The provision and use of any form for national phase entry (be it a national form made available by the designated Office concerned or the new international form) would remain optional, as at present. In addition, it is proposed to require any designated Office to accept the prescribed international form where the applicant chooses to use that form. By virtue of Rule 76.5, the same would apply to any elected Office. As is the case for all forms under the PCT which are to be used by the applicant, the form would be made available by the International Bureau in all seven languages of publication. As regards the draft of a standardized international form for entry into the national phase, the International Bureau is studying the possible content of such form, taking into account the various national requirements of designated and elected Offices allowed under Rule 51bis.]

49.5 to 49.6 [No change]

[End of Annexes and of document]

WIPO



PCT/R/WG/5/2
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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORM OF THE PATENT
COOPERATION TREATY (PCT)

Fifth Session
Geneva, November 17 to 21, 2003

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

RECTIFICATION OF CLEAR MISTAKES (OBVIOUS ERRORS)

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified above [in document PCT/A/32/2], on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will thence cease to be provisional in nature.

BACKGROUND

3. The present document reproduces the contents of document PCT/R/WG/4/4 Add.2, which was submitted to the fourth session of the Working Group, held in Geneva from May 19 to 23, 2003. Having regard to the time available, discussions on that document were deferred until this session (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraph 104).

4. At its first session, held on November 12 to 16, 2001, the Working Group discussed a proposal by the United States of America that Rule 91¹ be amended to limit the rectification of obvious errors to errors occurring in the request and to eliminate the rectification of obvious errors in the description, claims, drawings, and abstract of international applications (see document PCT/R/WG/1/4, paragraphs 8 to 12). Those discussions are summarized in document PCT/R/WG/1/9, as follows:

“Proposal to amend Rule 91 (see document PCT/R/WG/1/4)

“34. The comments and concerns expressed by various delegations included the following:

(i) while some delegations expressed support for the approach taken in the proposal, others felt that the correction of obvious errors should not be limited to errors occurring in the request but should continue to be possible also with regard to such errors in the description, claims and drawings; any such requests for corrections should be dealt with as early as possible during the international phase rather than by individual [designated Offices] in the national phase;

(ii) noting the workload of Offices in dealing with requests under present Rule 91, it was recognized that a balanced solution would have to be found which would continue to give applicants the flexibility needed to correct obvious errors without putting too heavy a burden on Offices dealing with requests for rectifications;

(iii) noting ongoing discussions in the context of the draft [Substantive Patent Law Treaty], some delegations expressed their desire for a review of the present definition of “obvious error” under Rule 91.1(b).

“35. It was agreed that the proposal to amend Rule 91 should not be included in revised drafts to be prepared by the International Bureau, although delegations may wish to further consider the matter in the light of the discussion.”

5. For the second session of the Working Group, the International Bureau prepared a paper (document PCT/WG/2/6) outlining possible further PLT-related changes to the PCT. In

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. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

relation to the correction of mistakes under PLTR Rule 18, paragraph 14 of that document explained:

“Correction of mistakes

“14. The PLT sets out the requirements that a Contracting Party is permitted to apply as regards requests for correction by the Office of mistakes in respect of an application (see PLTR Rule 18). In particular, it sets out the contents of the request that an Office may require; it also obliges the Office to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements. However, it does not regulate what mistakes may be corrected. PCT Rule 91.1 provides for rectification of obvious errors in the international application or other papers. However, it does not set out any requirements as to the contents of the request for rectification. It also does not require the receiving Office, International Searching Authority or International Preliminary Examining Authority or International Bureau, as the case may be, to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements.”

6. However, it was suggested “that any proposal to align the PCT with PLTR Rule 18 in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority” (see document PCT/WG/2/6, paragraph 15; the Working Group at its second session was unable in the time available to consider document PCT/WG/2/6 (see document PCT/WG/2/12, paragraph 59)).

7. During its third session, the Working Group reviewed a proposal by the Representative of the European Patent Office (EPO) that Rule 91.1(b) be amended so as to refer to a “person skilled in the art” rather than “anyone” when determining whether a rectification offered by the applicant was “obvious” under Rule 91.1(b). Several delegations supported the proposal and also expressed the view that, in general, Rule 91 was unnecessarily strict. It was agreed that the EPO and the International Bureau should work together to review Rule 91 and to submit a written proposal for consideration by the Working Group (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraph 64).

8. The Annex to this document contains proposals to amend Rule 91 accordingly, and proposals for consequential amendments of Rules 12, 48, 66 and 70. For information and clarity, the proposals for an amendment of Rule 91 are presented both in the form of a “clean” text of the Rule 91 as it would stand after an amendment and in the form of a marked-up text of Rule 91 as proposed to be amended.

9. The Working Group is invited to consider the proposals contained in the Annex.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ²

RECTIFICATION OF CLEARMISTAKES (OBVIOUS ERRORS)

TABLE OF CONTENTS

| | |
|---|----|
| Rule 12 Language of the International Application and Translation for the Purposes of International Search and International Publication | 2 |
| 12.1 [No change] | 2 |
| 12.2 <i>Language of Changes in the International Application</i> | 2 |
| 12.3 and 12.4 [No change] | 2 |
| Rule 48 International Publication | 3 |
| 48.1 [No change] | 3 |
| 48.2 <i>Contents</i> | 3 |
| 48.3 to 49.6 [No change] | 4 |
| Rule 66 Procedure Before the International Preliminary Examining Authority | 5 |
| 66.1 to 66.5 [No change] | 5 |
| 66.5 <i>Amendment</i> | 5 |
| 66.6 to 66.9 [No change] | 5 |
| Rule 70 International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Preliminary Examination Report) | 6 |
| 70.1 to 70.15 [No change] | 6 |
| 70.16 <i>Annex to the Report</i> | 6 |
| 70.17 [No change] | 6 |
| Rule 91 [“clean” copy] Rectification of Mistakes in the International Application and Other Documents | 7 |
| 91.1 <i>Rectification of Mistakes</i> | 7 |
| 91.2 <i>Requests for Rectification</i> | 9 |
| 91.3 <i>Authorization of Rectifications</i> | 10 |
| Rule 91 [“marked -up” copy] <u>Rectification of Mistakes in the International Application and Other Obvious Errors in Documents</u> | 12 |
| 91.1 <u><i>Rectification of Mistakes</i></u> | 12 |
| <u>91.2 <i>Requests for Rectification</i></u> | 17 |
| <u>91.3 <i>Authorization of Rectifications</i></u> | 20 |

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.

Rule12

**LanguageoftheInternationalApplicationandTranslation
forthePurposesofInternationalSearchandInternationalPublication**

12.1 [Nochange]

12.2 *LanguageofChangesintheInternationalApplication*

(a) [Nochange]

(b) AnyrectificationunderRule91 __ 91.1 of amistake ~~anobviouserror~~ inthe internationalapplicationshall beinthelanguageinwhichtheapplicationisfiled,provided that:

[COMMENT:ConsequentialontheproposedamendmentofRule91(seebelow).]

(i) and(ii) [Nochange]

(c) [Nochange]

12.3 and12.4 [Nochange]

Rule 48

International Publication

48.1 [Nochange]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (vi) [Nochange]

(vii) any request for rectification of a mistake, any reasons and any comments referred to in Rule 91.3(d) where the request for publication under Rule 91.3(d) was received by the International Bureau before the completion of the technical preparations for international publication ~~referred to in the third sentence of Rule 91.1(f)~~,

(viii) to (x) [Nochange]

(b) to (h) [Nochange]

(h-bis) If the authorization for rectification of a mistake in the international application referred to in Rule 91.1(b)(i) and (ii) is received by the International Bureau after completion of the technical preparations for international publication, either the pamphlet (containing the international application as rectified) will be republished or a statement reflecting all the rectifications will be published. In the latter case, at least the front pages shall be republished

and the sheets containing the rectifications, or thereplacement pages and the letter furnished under Rule 91.2(c), as the case may be, shall be published.

(i) The Administrative Instructions shall determine the cases in which the various alternatives referred to in paragraphs (g) ~~and~~ (h) and (h -bis) shall apply. Such determination shall depend on the volume and complexity of the amendments or rectifications and/or the volume of the international application and the cost factors.

(j) If the request for publication under Rule 91.3(d) was received by the International Bureau after the completion of the technical preparations for international publication, the request for rectification, any reasons and any comments referred to in Rule 91.3(d) shall be promptly published after the receipt of the request for publication, and the front pages shall be republished.

[COMMENT: The proposed amendments of Rule 48.2 are consequential on the proposed change of approach with regard to the time limit within which a request for rectification of a mistake may be made; see proposed new Rule 91.2(a), below.]

48.3 to 49.6 [No change]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 to 66.5 [No change]

66.5 *Amendment*

Any change, other than the rectification of amistake ~~obvious errors~~, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

[COMMENT: Consequential on the proposed amendment of Rule 91 (see below) .]

66.6 to 66.9 [No change]

Rule 70

**International Preliminary Report on Patentability by
the International Preliminary Examining Authority
(International Preliminary Examination Report)**

70.1 to 70.15 [No change]

70.16 *Annex to the Report*

Each replacement sheet under Rule 66.8(a) or (b), each replacement sheet containing amendments under Article 19 and each replacement sheet containing rectifications of [a mistake](#) ~~obvious errors~~ authorized under Rule [91.1\(b\)\(iii\)](#) ~~91.1(e)(iii)~~ shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

70.17 [No change]

Rule 91³

**Rectification of Mistakes in
the International Application and Other Documents**

91.1 *Rectification of Mistakes*

(a) A mistake in the international application or other documents submitted by the applicant may, subject to paragraphs (b) to (e) and Rules 91.2 and 91.3, be rectified on the request of the applicant.

(b) A rectification shall be made only if it is authorized by "the relevant authority," that is to say:

(i) by the receiving Office if the mistake is in the request;

(ii) by the International Searching Authority if the mistake is in any part of the international application other than the request, or in any amendment or correction of that application, or in any documents submitted to that Authority;

(iii) by the International Preliminary Examining Authority if the mistake is in any part of the international application other than the request, or in any amendment or correction of that application, or in any documents submitted to that Authority;

³ Comment on particular provisions appear only in the "marked -up" copy following.

[Rule 91.1(b), continued]

(iv) by the International Bureau if the mistake is in any document, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

(c) The relevant authority shall authorize a rectification if it finds that, as at the applicable date under paragraph (d), the alleged mistake was clearly a mistake and that the meaning which would result from the proposed rectification was clearly the same as the meaning intended in the international application or other document; otherwise, the relevant authority shall refuse to authorize the rectification. In the case of a mistake in the description, the claims or the drawings, or in an amendment thereof for a correction thereof under Rule 26, that findings shall be made on the basis of what a person skilled in the art would have understood, as at the applicable date under paragraph (d), from reading the international application or the amendment or correction.

(d) For the purposes of paragraph (c), the applicable date shall be:

(i) in the case of a mistake in the international application, the international filing date;

(ii) in the case of a mistake in any other document, including an amendment or a correction of the international application, the date on which that document was submitted.

[Rule 91.1, continued]

(e) The omission of an entire element or sheet of the international application shall not be rectifiable under this Rule[, but nothing in this Rule shall prevent the inclusion under Rule 20.5 of a missing part containing an entire element or sheet].

(f) Where the receiving Office, the International Bureau, the International Searching Authority or the International Preliminary Examining Authority discovers what appears to be a rectifiable mistake in the international application or other document, it may invite the applicant to request rectification in accordance with this Rule.

91.2 Requests for Rectification

(a) The request for rectification shall be submitted to the relevant authority within the following time limit, as applicable:

(i) where the relevant authority is the receiving Office, the International Bureau or the International Searching Authority, [26][27][28] months from the priority date;

(ii) where the relevant authority is the International Preliminary Examining Authority, the time when that Authority begins to draw up the international preliminary examination report.

[Rule 91.2, continued]

(b) The request for rectification shall contain the following indications:

(i) an indication to the effect that rectification of a mistake is requested;

(ii) the mistake to be rectified; and

(iii) the proposed rectification;

and may, at the option of the applicant, contain:

(iv) a brief explanation of the mistake and the proposed rectification.

(c) Rule 26.4 shall apply *mutatis mutandis* as to the manner in which a rectification shall be requested.

91.3 *Authorization of Rectifications*

(a) The relevant authority shall promptly decide whether, in accordance with Rule 91.1(c), to authorize or refuse to authorize the rectification and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor.

[Rule 91.3, continued]

(b) Where the rectification is authorized by the relevant authority, it shall be made in the international application or other document concerned as provided in the Administrative Instructions.

(c) Where a rectification is authorized by the relevant authority, it shall be effective:

(i) in the case of a mistake in the international application, from the international filing date;

(ii) in the case of a mistake in another document, including an amendment or a correction of the international application, from the date on which that document was submitted.

(d) Where authorization of the rectification is refused, the International Bureau shall, upon requests submitted to it by the applicant within [one month] [two months] from the date of the decision by the relevant authority, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the relevant authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of that request, of those reasons and of those comments (if any) shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

Rule 91 [marked -up copy]

Rectification of Mistakes in the International Application
and Other ~~Obvious Errors in~~ Documents

91.1 *Rectification of Mistakes*

(a) A mistake ~~Subject to paragraphs (b) to (g) — *quater*~~, ~~obvious errors~~ in the international application or other document ~~papers~~ submitted by the applicant may , subject to paragraphs (b) to (e) and Rule 91.2 and 91.3, be rectified on the request of the applicant.

[COMMENT: Although the draft SPLT uses the term “correction” instead of “rectification” (see draft SPLT Article 7(3) and draft SPLT Rule 7(2)), it is proposed, in the context of PCT Rule 91, to continue to use the term “rectification” so as to maintain the distinction between “amendments” of the description, claims or drawings (under Articles 19 and 34) and “corrections” of formal defects (under Article 14 and Rule 26).]

[Rule 91.1, continued]

(b) ~~(e)~~ ~~A~~ ~~No~~ rectifications shall be made only if it is authorized by “the relevant authority,” that is to say ~~except with the express authorization~~:

(i) by ~~of~~ the receiving Office if the mistake ~~error~~ is in the request ~~;~~;

(ii) by ~~of~~ the International Searching Authority if the mistake ~~error~~ is in any part of the international application other than the request , or in any amendment or correction of that application, or in any document ~~paper~~ submitted to that Authority ~~;~~;

(iii) by ~~of~~ the International Preliminary Examining Authority if the mistake ~~error~~ is in any part of the international application other than the request , or in any amendment or correction of that application, or in any document ~~paper~~ submitted to that Authority ~~;~~;

(iv) by ~~of~~ the International Bureau if the mistake ~~error~~ is in any document ~~paper~~, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

[COMMENT: The purpose of the proposed amendment is to clarify that “the relevant authority” referred to in paragraphs (c), (f) and (g) of Rule 91.1 and paragraphs (b), (c), (d) and (e) of Rule 91.2 is the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, as the case may be.]

[Rule 91.1, continued]

~~(c) (b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other papers shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.~~ Therelevant authority shall authorize a rectification if it finds that as at the applicable date under paragraph (d), the alleged mistake was clearly a mistake and that the meaning which would result from the proposed rectification was clearly the same as the meaning intended in the international application or other document; otherwise, the relevant authority shall refuse to authorize the rectification. In the case of a mistake in the description, the claims or the drawings, or in an amendment thereof for a correction thereof under Rule 26, that findings shall be made on the basis of what a person skilled in the art would have understood, as at the applicable date under paragraph (d), from reading the international application or the amendment or correction.

[COMMENT: Noting the discussion by the Working Group at its third session, it is proposed to make the requirements under this paragraph more realistic and, in the case of a mistake in the description, claims or drawings, to refer to a “person skilled in the art” rather than “anyone” when determining whether such a mistake is rectifiable.]

[Rule 91.1, continued]

(d) For the purposes of paragraph (c), the applicable date shall be:

(i) in the case of a mistake in the international application, the international filing

date;

(ii) in the case of a mistake in any other document, including an amendment or a correction of the international application, the date on which that document was submitted.

[COMMENT: A finding under paragraph (c) would thus be made: (i) where the mistake was in the description, claims or drawings: on the basis of what a person skilled in the art would have understood, as at the international filing date, from reading the international application; (ii) where the mistake was in the request: on the basis of what the person in the receiving Office in charge of authorizing the request for rectification would have understood, as at the international filing date, from reading the international application; (iii) where the mistake is in an amendment or a correction of the international application, on the basis of what a person skilled in the art would have understood, at the time on which the amendment or correction in question was submitted, from reading the amendment or correction; (iv) where the mistake is in any other document: on the basis of what the person in the relevant authority in charge of authorizing the request for rectification would have understood, at the time on which the document in question was submitted, from reading that document.]

[Rule 91.1, continued]

(e) ~~(e)~~ The omission or omission of an entire element or sheet of the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable under this Rule [but nothing in this Rule shall prevent the inclusion under Rule 20.5 of a missing part containing an entire element or sheet].

[COMMENT: The words in square brackets would be included only if the proposed amendments of Rule 20 in document PCT/R/WG/4/2 relating to inclusion of “missing parts” proceed at the same time as the present amendments; otherwise, those words would need to be added at a later date when Rule 20 is amended.]

(f) ~~(d)~~ Where the receiving Office, the International Bureau, the International Searching Authority or the International Preliminary Examining Authority discovers a rectifiable mistake in the international application or other document, it may invite the applicant to present a request for rectification as provided in paragraphs (e) to (g-*quater*) in accordance with this Rule. Rule 26.4 shall apply *mutatis mutandis* to the manner in which rectifications shall be requested.

[COMMENT: Clarification only. It is proposed to move the last sentence of present paragraph (d) to proposed new Rule 91.2(b) (see below).]

91.2 Requests for Rectification

(a) The request for rectification shall be submitted to the relevant authority within the following time limit, as applicable ~~The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g ~~bis~~), (g ~~ter~~) and (g ~~quater~~), be effective:~~

[COMMENT: It is proposed to fix a clear time limit for the submission of the request for rectification by the applicant rather than, as under present Rule 91.1(g), making the effectiveness of the authorization for rectification dependent on the timely receipt by the International Bureau of the authorization (and hence of the timely processing by the relevant authority of the request for rectification).]

(i) where the relevant authority is ~~it is given by~~ the receiving Office the International Bureau or ~~by~~ the International Searching Authority, [26][27][28] months ~~if its notification to the International Bureau reaches that Bureau before the expiration of 17 months~~ from the priority date;

[COMMENT: Existing items (i) and (iii) were redesigned to ensure that a rectification authorized during the Chapter I procedure (if the applicant did not request international preliminary examination under Chapter II) would be included in the international application as published 18 months from the priority date, noting also that the application had to enter the national phase of processing 20 months from the priority date. Where the applicant requested international preliminary examination under Chapter II, present item (ii) provided for rectification to be made after the publication of the application but before the applicant entered the national phase 30 months from the priority date. However, the time limit for entering the national phase under Chapters I and II is now the same, namely, 30 months from the priority date, so it does not seem necessary to maintain the present distinction between Chapters I and II in this respect. It is therefore proposed to link the time limit for rectification to the time for national phase entry in all cases. Under Chapter I, a time limit towards the end of the 30 month period seems appropriate.]

[Rule 91.2(a), continued]

(ii) where the relevant authority is ~~it is given by~~ the International Preliminary Examining Authority, the time when that Authority begins to draw up ~~if it is given before the~~ ~~establishment of~~ the international preliminary examination report ;

[COMMENT: See the Comment concerning item (i). Where the applicant requests international preliminary examination under Chapter II, slightly different considerations apply since the International Preliminary Examining Authority will be actively processing the application. Each replacement sheet containing a rectification of a mistake authorized by the International Preliminary Examining Authority is annexed to the international preliminary examination report (see Rule 70.16 as proposed to be amended, above). The appropriate time limit therefore would be the time when the Authority begins to draw up the international preliminary examination report.]

~~(iii) where it is given by the International Bureau, if it is given before the expiration~~
~~of 17 months from the~~ ~~priority date.~~

[COMMENT: Rectification by the International Bureau is dealt with in proposed amended item (i).]

[Rule 91.2, continued]

(b) The request for rectifications shall contain the following indications:

(i) an indication to the effect that rectification of a mistake is requested;

(ii) the mistake to be rectified; and

(iii) the proposed rectification;

[COMMENT: See PLT Rule 18(1)(a)(i), (iii) and (iv). The indication under PLT Rule 18.1(a)(ii) (the number of the application or patent concerned) is not included here since the request for rectification must be in the form of, or accompanied by, a letter identifying the international application to which it relates (see PCT Rule 92.1(a)). The indication under PLT Rule 18.1(a)(v) (the name and address of the requesting party) is not included since rectification may be made only on the request of the applicant (see paragraph (d), above).]

and may, at the option of the applicant, contain:

(iv) a brief explanation of the mistake and the proposed rectification.

[COMMENT: Such an explanation would assist the relevant authority in deciding whether a rectification should be authorized. Note that Article 19(1) provides for a statement explaining amendments of the claims under that Article.]

(c) Rule 2.6.4 shall apply *mutatis mutandis* as to the manner in which a rectification shall be requested.

91.3 Authorization of Rectifications

(a) ~~[91.1](f)~~ The relevant authority shall promptly decide whether, in accordance with Rule 91.1(c), to authorize or refuse to authorize the rectification and ~~Any authority which authorizes or refuses any rectification~~ shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. ~~The authority which authorizes a rectification shall promptly notify the International Bureau~~ accordingly.

[COMMENT: The proposed amendments would align the wording with that used elsewhere in the amended Rule.]

(b) Where the rectification is authorized by the relevant authority, it shall be made in the international application or other document concerned as provided in the Administrative Instructions.

[COMMENT: Sections 325, 413, 511 and 607 of the Administrative Instructions would have to be modified.]

[Rule 91.3, continued]

(c) Where rectification is authorized by the relevant authority, it shall be effective:

(i) in the case of a mistake in the international application, from the international
filing date;

(ii) in the case of a mistake in another document, including an amendment or a
correction of the international application, from the date on which that document was
submitted.

[COMMENT: Proposed new paragraph (c) would clearly spell out the effective date of a rectification once authorized.]

[~~Rule~~91.3, continued]

(d) ~~[91.1](f)~~ Where ~~the~~ authorization of the rectification ~~is was~~ refused, the International Bureau shall, upon request submitted to it ~~made~~ by the applicant within [one month][two months] from the date of the decision by the relevant authority, ~~prior to the time—~~ ~~relevant under paragraph (g—bis), (g—ter) or (g—quater)~~ and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the relevant authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of that ~~the~~ request of those reasons and of those comments (if any) ~~for rectification—~~ shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: Under paragraph (d) as proposed to be amended, upon request of the applicant, the International Bureau would also publish information with regard to a request for rectification which was refused by the International Preliminary Examining Authority, even if the request for publication is received after international publication. This would fill a gap which exists under the present Regulations: under present Rule 91.1(f), any request for publication of information with regard to a refused request for rectification has to be received by the International Bureau prior to completion of technical preparations for international publication. In practice, this means that information concerning a request for rectification which has been refused by the International Preliminary Examining Authority after international publication is neither published nor mentioned in the international preliminary examination report: only authorized rectifications are annexed to that report (see present Rule 70.16; see also Rule 70.16 as proposed to be amended, above).]

[Rule 91.3, continued]

[91.1](g-bis) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectifications shall be incorporated in the said publication.

[91.1](g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.

[91.1](g-quater) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.

[End of Annex and of document]

WIPO



PCT/R/WG/5/3

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORMOF THE PATENT
COOPERATION TREATY (PCT)

Fifth Session

Geneva, November 17 to 21, 2003

CENTRAL ELECTRONIC DEPOSITS SYSTEM FOR
NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified above [in document PCT/A/32/2], on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will thence be provisional in nature.

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BACKGROUND

3. The present document reproduces the contents of document PCT/R/WG/4/6, which was submitted to the fourth session of the Working Group, held in Geneva from May 19 to 23, 2003. Having regard to the time available, discussions on that document were deferred until this session (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraph 104).

4. At its third session, the Working Group agreed that, in order to facilitate the processing of sequence listings for the purposes of the international and the national phase of the PCT procedure, the International Bureau should further investigate the possibility of establishing a central electronic deposits system for such listings (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraph 58).

5. The Annex to this document contains proposals for an amendment of the Regulations under the PCT¹ so as to establish a central electronic deposits system for sequence listings for the purposes of disclosure of the invention and to facilitate access to deposited sequence listings by Offices and Authorities and also third parties. The main features of the proposed new system are outlined in the following paragraphs.

DEPOSIT OF SEQUENCE LISTINGS

6. The idea of establishing a central electronic deposits system for sequence listings is not new. Previous discussions on this issue in the 1990s focused on the need to establish a data bank containing sequence listings of all published applications in a standardized form suitable for patent search purposes (the issue was discussed, for example, at the fifth session of the Meeting of International Authorities under the PCT; see document PCT/MIA/V/3, paragraphs 27 to 32). At that time it was envisaged that, where the International Searching Authority had received a sequence listing in computer readable form from the applicant, it would make that sequence listing available, promptly after international publication, to one of the existing sequence listing database institutions. Those institutions would then have served as data repositories for future access to these sequence listings, including by the International Preliminary Examining Authorities, designated/elected Offices and third parties. No such Authority or Office would have been entitled to ask the applicant to furnish it with a copy of these sequence listings in computer readable form where it was available from such an institution. However, the idea was not proceeded with when it was ascertained that the procedures followed by the institutions concerned did not meet certain general needs of the patent procedure (for example, in respect of guaranteeing the documentary integrity of sequence listings as originally filed).

7. In practice, the Trilateral Patent Offices, for example, systematically place sequence listings with public sequence listing database institutions: the European Patent Office with the European Bioinformatics Institute (EBI); the Japan Patent Office with the DNA Data Bank of Japan (DDBJ); and United States Patent and Trademark Office with the National Center

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.

for Biotechnology Information (NCBI). This applies in the case of sequences disclosed in patents and published patent applications, both in national/regional applications and in international applications for which the Office concerned acts as International Searching Authority.

8. A distinction needs to be drawn between three related purposes for which sequence listings in electronic form might usefully be stored in databanks:

(i) *international search (and international preliminary examination)*: a sequence listing in electronic form is needed to enable the International Searching Authority to carry out the international search, and provision of a listing in such form is the subject of present Rule 13 *ter*; for this purpose, it is presently envisaged, although not expressly mentioned in Rule 13 *ter*, that a sequence listing in electronic form which is furnished by the applicant to the International Searching Authority will be placed by that Authority in a sequence listing database in such a way that it can be searched using highly sophisticated algorithms designed to aid the examiner in deciding whether the invention is novel and involves an inventive step; similar considerations apply in the case of international preliminary examination;

(ii) *disclosure*: another purpose, not presently catered for, would be to enable the applicant to disclose the invention by way of reference to a deposit, so that there would be no need to file, as part of the international application, a sequence listing requiring up to many thousand sheets of paper or even on a CD as is presently provided for under Part 8 (Sections 800 to 806) of the Administrative Instructions under the PCT;

(iii) *access*: patent Offices, PCT Authorities and third parties may need or wish to have access to deposited sequence listings for a number of purposes, including scientific research, technical information, international search and ascertaining the exact nature of the disclosure contained in a patent application as originally filed.

9. The presently available database institutions do not cater fully for all of those purposes. Their operations are geared towards practical needs for technical information for research purposes. While they are certainly useful or even essential for the carrying out of searches of the prior art in relation to patent applications, they are not designed or maintained in a way which meets certain more specialized needs of the patenting procedure, notably in relation to establishing the precise nature of the disclosure made on a certain date (normally, in the case of a patent application, the filing date) in a way which would meet evidentiary requirements in the event that the nature or date of the disclosure is contested in court proceedings. The proposals made in the present document refer to a deposit system intended to meet those more specialized needs.

10. It is thus proposed to set up a system, similar in certain ways to the system for the deposit of biological material with a depositary institution under the Budapest Treaty, under which a reference to a sequence listing in electronic form deposited with a prescribed sequence listing databank would replace the need to include such listing in the description itself. Provided that the International Searching Authority has access to such deposited sequence listing, there would then also be no need for the applicant to furnish a separate listing in electronic form to the International Searching Authority for the purposes of the international search (and similar considerations would apply to the procedure before the International Preliminary Examining Authority and designated/elected Offices).

11. Since the deposited sequence listing would replace a listing which would otherwise have to be handled by the International Bureau, whether in form of a sequence listing part of the description (on paper) or as a listing in electronic form separately furnished under Part 8 of the Administrative Instructions, and since its storage in the databank would be for the purposes of disclosure and simple access rather than research or patent searching, it would appear to be logical for the functions of the databank to be carried out by the International Bureau, while still allowing for the possibility that other databanks may also be prescribed. However, a study of the feasibility of such a possibility would need to be undertaken.

12. The main features of the proposed system would be as follows:

(i) the applicant would have the option, if so wished, to deposit, for the purposes of the PCT procedure in relation to an international application, a sequence listing in electronic form with a prescribed sequence listing databank (which may include the International Bureau, as mentioned in paragraph 11, above);

(ii) in order to attract the operation of the provisions outlined further below, the sequence listing would have to be deposited on or before the international filing date and to comply with the standard prescribed in the Administrative Instructions (see present Annexes C and C *-bis*, which would have to be modified accordingly);

(iii) a reference in the description to a deposited sequence listing would replace the need to include such listing in the description itself ("sequence listing part of the description" – see present Rule 5.2(a));

(iv) a reference to a deposited sequence listing would replace the need to furnish, for the purposes of international search, the listing in electronic form to the International Searching Authority (and the International Preliminary Examining Authority and designated/elected Offices) as under present Rule 13*ter*;

(v) the deposited sequence listing would be published in electronic form only, similar as is presently provided for under Part 8 (Section 805) of the Administrative Instructions under the PCT;

(vi) access to the deposited sequence listing would be restricted, until the international publication of the international application concerned, in a similar way as access to the application itself;

(vii) Authorities and Offices would be entitled to access the deposited sequence listing, including for the purposes of search and examination, as they would be entitled to access the international application itself;

(viii) third parties would be entitled to access the deposited sequence listing on the same basis as they would be entitled to access the international application itself (that is, in general, only after the international publication of the international application concerned).

13. Details concerning the making of deposits (including details concerning submission of corrections under Rule 26.3, rectifications of obvious errors under Rule 91 and amendments under Article 34 in respect of a deposited sequence listing), the prescribing of databanks and the obligations of and procedure to be followed by prescribed databanks would be set out in the Administrative Instructions. nd

14. Adoption of proposals for amendment of the Regulations to implement such a system would necessitate consequential modifications of the Administrative Instructions to set out procedural details, and consequential modifications would be needed to Part 7 and Annex C of the Instructions. The procedures set out in Part 8 and Annex C *-bis* of the Instructions would probably be completely superseded by, or incorporated into, the new system and would thus be deleted.

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

DEPOSIT OF SEQUENCE LISTINGS

TABLE OF CONTENTS

| | |
|--|---|
| Rule 5 The Description | 2 |
| 5.1 [No change] | 2 |
| 5.2 <i>Nucleotide and/or Amino Acid Sequence Disclosure</i> | 2 |
| Rule 13 <i>ter</i> Nucleotide and/or Amino Acid Sequence Listings | 4 |
| <u>13ter.1 Sequence Listing Deposits</u> | 4 |
| <u>13ter.2 References to Sequence Listings: Contents; Failure to Include Reference or Indication</u> | 4 |
| <u>13ter.3</u> 13ter.1 <i>Sequence Listings Required for the Purposes of International Search or International Preliminary Examination</i> for International Authorities | 6 |
| <u>13ter.4</u> 13ter.2 <i>Sequence Listing s for Designated Office s</i> | 9 |
| <u>13ter.5 Prescribed Sequence Listing Data Banks</u> | 9 |

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 5

The Description

5.1 [No change]

5.2 *Nucleotide and/or Amino Acid Sequence Disclosure*

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the descriptions shall contain at the option of the applicant, either:

(i) a sequence listing complying with the standard provided for in the Administrative Instructions and presented as a separate part of the description in accordance with that standard (“sequence listing part of the description”); or

[COMMENT: Clarification only; for the standard provided for in the Administrative Instructions, see Section 208 and Annex C to the Administrative Instructions.]

(ii) a reference complying with Rule 13 *ter.2(a)* to a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions that was deposited with a prescribed sequence listing data bank in accordance with Rule 13 *ter.1* (“deposited sequence listing”) on or before the international filing date.

[COMMENT: See paragraphs 8(ii), 10 and 12 of the Introduction to this document. The Working Group may wish to consider whether an indication that a sequence listing has been deposited in accordance with Rule 5.2(a)(ii) should also be provided for in the request form (Rule 4 would have to be amended accordingly).]

[Rule 5.2, continued]

(b) Where the sequence listing part of the description [or the deposited sequence listing](#) contains any free text as defined in the standard provided for in the Administrative Instructions, that free text shall also appear in the main part of the description in the language thereof.

[COMMENT: Consequential on proposed amendment to Rule 5.2(a), above.]

Rule 13 ter

Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Sequence Listing Deposits

A deposit of a sequence listing in electronic form for the purposes of Rule 5.2(a)(ii)
shall be made in accordance with the Administrative Instructions.

[COMMENT: See paragraphs 13 and 14 of the Introduction to this document.]

13ter.2 Reference to Sequence Listings: Contents; Failure to Include Reference or

Indication

(a) Any reference to a deposited sequence listing for the purposes of Rule 5.2(a)(ii)
shall indicate:

(i) the name and address of the sequence listing database with which the deposit
was made;

(ii) the date of the deposit; and

(iii) the number given to the deposit by that sequence listing database.

[Rule 13ter.2, continued]

(b) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences and the description as filed:

(i) does not contain a sequence listing part of the description or a reference to a deposited sequence listing; or

(ii) contains a reference to a deposited sequence listing but any of the indications referred to in paragraph (a) is not included in that reference;

the International Searching Authority shall invite the applicant to file a correction by furnishing a reference to a deposited sequence listing complying with Rule 5.2(a)(ii) or the missing indication within a time limit fixed in the invitation. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau. Any reference or indication furnished within the time limit fixed in the invitation shall be considered by any designated Office to have been furnished in time.

[COMMENT: Similar to the situation under Rule 13bis.4 with regard to the furnishing of a reference to deposited biological material, where the international application as filed does not contain a sequence listing part of the description and also does not contain a reference to a deposited sequence listing, or where any of the indications required under Rule 13ter.2(a) is missing from a reference contained in the international application as filed, the applicant would be given the opportunity, upon invitation by the International Searching Authority, to make the required correction by furnishing such a reference or the missing indication within the time limit fixed in the invitation. If furnished within that time limit, any designated Office would have to consider any such reference or indication to have been furnished in time. Note that, in practice, the invitation under Rule 13ter.2(b) would be combined with the invitation under Rule 13ter.3(a) (see below): the applicant would have the option either to comply with the invitation under Rule 13ter.2(b), in which case the deposited sequence listing referred to

[Rule 13ter.2(b), continued]

in the description would be used for the purposes of disclosure, international search and international preliminary examination, and access (see paragraph 8 in the Introduction to this document, above); or, alternatively, to comply with the invitation under Rule 13ter.3(a), in which case these sequence listings in electronic form furnished to the International Searching Authority would be used for the purposes of international search only. Not that any sequence listing deposited after the international filing date would not comply with the requirements of Rule 5.2(a)(ii) and thus not be accepted as a correction under Rule 13ter.2(b); any sequence listing deposited after the international filing date would also not be taken into account for the purposes of international search (see Rule 13ter.3(a), below).]

(c) ~~13ter.1(d)~~ Where the International Searching Authority finds that the description does not comply with Rule 5.2(b), it shall invite the applicant to file the required correction within a time limit fixed in the invitation. Rule 26.4 shall apply *mutatis mutandis* to any correction offered by the applicant. The International Searching Authority shall transmit the correction to the receiving Office and to the International Bureau.

[COMMENT: Clarification only.]

13ter.3 ~~13ter.1~~ *Sequence Listing* Required for the Purposes of International Search or International Preliminary Examination ~~for International Authorities~~

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences and the description does not contain a reference to a deposited sequence listing, or the description contains a reference to a deposited sequence listing but the deposited sequence listing does not comply with Rule 5.2(a)(ii), the International Searching Authority may require that the applicant furnish to that Authority, for the purposes of the

[Rule 13ter.3(a), continued]

international search, a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions. Where such a listing is so required but has not been furnished by the applicant, the International Searching Authority may invite the applicant to furnish such a listing within a time limit fixed in the invitation.

[COMMENT: A sequence listing in electronic form is needed to enable the International Searching Authority to carry out the international search. Provided that the International Searching Authority has access to a deposited sequence listing complying with the standard provided for in the Administrative Instructions, there is no need for the applicant to furnish a separate listing in electronic form to the International Searching Authority for the purposes of international search. In all other cases, that is, in cases where the International Searching Authority does not have access to a deposited sequence listing complying with the standard provided for in the Administrative Instructions, the International Searching Authority would be entitled to invite the applicant to furnish such a separate listing in electronic form. Any such listing in electronic form furnished by the applicant would not form part of the international application (see Rule 13ter.3(d), below). In practice, the invitation under Rule 13ter.3(a) would be combined with the invitation under Rule 13ter.2(b) (see Comment on Rule 13ter.2(b), above). Note that proposed new Rule 13ter.3(a) would no longer provide for an invitation to furnish a sequence listing in paper format (as present Rule 13ter.1(a) does), taking into account that such a listing in paper format would not allow a meaningful search to be carried out by the International Searching Authority. Note further that that proposed new Rule 13ter.3(a) would not provide for an applicant to furnish, in response to an invitation under that Rule, a reference to a sequence listing deposited with a sequence listing database.]

~~[13ter.1](a) Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:~~

~~(i) the international application does not contain a sequence listing complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing complying with that standard;~~

[Rule 13ter.3(a), continued]

~~(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions; that Authority may invite the applicant to furnish to it, within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.~~

(b) ~~[13ter.1](e)~~ If the applicant does not comply with an invitation under paragraph (a) within the time limit fixed in the invitation, the International Searching Authority shall not be required to search the international application to the extent that such non-compliance has the result that a meaningful search cannot be carried out.

(c) ~~[13ter.1](e)~~ Paragraphs (a) and (b) ~~(e)~~ shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

(d) ~~[13ter.1](f)~~ Any sequence listing in electronic form furnished pursuant to paragraphs (a) to (c) ~~not contained in the international application as filed~~ shall not ~~be subject to Article 34,~~ form part of the international application.

[COMMENT: The proposed amendment of present Rule 13ter.1(f) (new paragraph (d)) is consequential on the proposed deletion of present Rule 13ter.1(a) (see above) and the fact that Rule 13ter.3(a) as proposed to be amended would no longer provide for an invitation to furnish a sequence listing in paper format (see Comment on Rule 13ter.3(a), above).]

13ter.4 ~~13ter.2~~ *Sequence Listing s for Designated Office s*

Once the processing of the international application has started before a designated Office, Rules 13ter.2(b) and 13 ter.3(a) ~~13ter.1(a)~~ shall apply *mutatis mutandis* to the procedure before that Office. No designated Offices shall require the applicant to furnish to it :

(i) a sequence listing where a reference to a deposited sequence listing complying with Rule 5.2(a)(ii) is included in the description;

(ii) a sequence listing other than a sequence listing complying with the standard provided for in the Administrative Instructions.

[COMMENT: Proposed amendment of present Rule 13 *ter.2* (new Rule 13 *ter.4*) is consequential on the proposed creation of a central electronic deposits system for sequence listings under which a sequence listing data bank would serve as a data repository for future access to these sequence listings, including by the designated/elected Offices.]

13ter.5 Prescribed Sequence Listing Data Banks

The Administrative Instructions shall set out these sequence listing data banks that are prescribed for the purposes of Rules 5.2(a)(ii) and 13 *ter.1* and the provisions and requirements in relation to deposited sequence listings, including but not limited to, provisions and requirements in relation to [the status of sequence listing data banks, making of deposits, issuance of receipts for deposits, recognition and effect of a deposit, storage of deposited sequence listings, furnishing of copies of deposited sequence listings, and fees].

[Rule 13ter.5, continued]

[COMMENT: The Administrative Instructions may, subject to further study of the feasibility (see paragraph 11 of the Introduction to this document) prescribe the International Bureau as a databank. In that case, a deposit with the International Bureau as a databank should be possible by way of filing the sequence listing in electronic form together with the international application with the receiving Office, in which case it would be considered to have been deposited with the International Bureau on the date of receipt by the receiving Office.]

[End of Annex and of document]

WIPO



PCT/R/WG/5/4
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DATE:August21,2003

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORMOF THE PATENT
COOPERATION TREATY (PCT)

Fifth Session
Geneva, November 17 to 21, 2003

FORMALITIES CHECKING UNDER THE PCT

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified above [in document PCT/A/32/2], on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will thence cease to be provisional in nature.

BACKGROUND

3. The present document reproduces the contents of document PCT/R/WG/4/5, which was submitted to the fourth session of the Working Group, held in Geneva from May 19 to 23, 2003. Having regard to the time available, discussions on that document were deferred until this session (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraph 104).

4. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group was a proposal to reduce or eliminate formalities review procedures at both the receiving Offices and the International Bureau.

5. The Working Group's discussions on this proposal are summarized in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 41 to 43, as follows:

“Formalities Review

“41. Discussions were based on document PCT/R/WG/3/1, Annex I, item 1 (reduce or eliminate formalities review).

“42. Several delegations expressed the view that procedures relating to the checking of formalities by both the receiving Offices and the International Bureau should be reviewed so as to avoid unnecessary duplication of work and further streamline procedures. This would require consideration of many current processes, but would be particularly relevant to procedures relating to international applications filed and processed, in the future, in electronic form.

“43. It was agreed that the International Bureau should work with interested delegations and representatives of users, using the PCT reform electronic forum, to identify:

(i) formalities checking processes that were carried out by both receiving Offices and the International Bureau, with a view to proposing changes to the Administrative Instructions and the PCT Receiving Office Guidelines to do away with any unnecessary duplication;

(ii) simplifications in the formalities review that could be progressively implemented together with the planned implementation of electronic filing and processing of international applications under the PCT.”

6. This document outlines the roles which the Treaty and the Regulations¹ have assigned to receiving Offices and the International Bureau with regard to the checking of formalities,

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.

gives some statistical information on formal defects in international applications, and elaborates on the likely impact of recent developments (the latest Rule changes adopted by the Assembly in October 2002, the ongoing reorganization of the International Bureau's Office of the PCT and the planned implementation of electronic filing) may have on the formalities checking of international applications.

THE ROLES OF RECEIVING OFFICES AND THE INTERNATIONAL BUREAU WITH REGARD TO FORMALITY CHECKING

7. Before taking a closer look at how and by whom formality checking of international applications is carried out under the present system, it is worthwhile to recall the history of the PCT so as to better understand the roles of receiving Offices and the International Bureau with regard to formality checking.

Early Drafts of the PCT

8. The 1967 draft of the PCT provided that the International Bureau should be responsible for carrying out the examination of all international applications "as to form," including compliance with what today would be referred to as filing date requirements under Article 11. Draft Article 7(1) of the 1967 draft PCT ("Examination of International Application as to Form") provided (see document PCT/I/4, page 23):

"(1) The International Bureau shall examine the international application in order to discover whether it complies with the requirements prescribed in Article 5; however, as far as the description, claims, drawings, and the abstract, are concerned, the examination shall be limited to discovering whether they contain obvious formal defects."

9. This proposal for draft Article 7(1), however, was not supported by a majority of delegations attending the first meeting of the "Committee of Experts on a Patent Cooperation Treaty (PCT)." The report of that meeting summarizes the discussion on draft Article 7 as follows (see document PCT/I/11, page 7):

"24. The majority of the Committee was of the opinion that the examination of the international application as to form should not be done by the International Bureau except when other authorities were not available, for example, when the international application is filed direct with the International Bureau. Opinions differed on who should, as a rule, do such examination. Some proposed that it be done by the searching Authorities, others that it be done by any national Office which is ready to receive and transmit international applications even if such an Office is not a searching Authority. In any case, the International Bureau should set up a machinery to harmonize the practices of all authorities controlling the conformity of applications with the formal requirements of the PCT."

10. Consequently, later drafts and the final text of the Treaty and the Regulations assigned at the Washington Diplomatic Conference in June 1970 no longer provided for the International Bureau to be responsible for the examination of the international application "as to form." Rather, the receiving Offices were made responsible for the checking and processing of international applications (see Article 10), including checking for compliance with the filing date requirements under Article 11 and checking for formal defects under Article 14.

11. However, the International Bureau and, to a lesser extent, the International Searching Authorities, were given the responsibility of supporting the receiving Offices in carrying out their tasks. Procedures were put in place to ensure that certain defects noted by the International Bureau (and, in certain cases, by the International Searching Authority) were brought to the attention of the receiving Office (see present Rules 28.1 and 29.3; see also Rule 60.1(e) with regard to defects in the demand).

12. Moreover, certain other responsibilities with regard to the checking of formalities were directly assigned to the International Bureau, requiring the International Bureau to invite the applicant to correct a defect rather than calling the defect to the attention of the receiving Office. For example, where the receiving Office fails to notice that a priority claim does not comply with the requirements of Rule 4.10, it is the International Bureau's responsibility to invite the applicant to correct such defective priority claim by furnishing the required correction directly to the International Bureau (see present Rule 26bis.2; a similar provision was already contained in Rule 4.10 in the final text of the Regulations as adopted at the Washington Diplomatic Conference in 1970). Similar responsibilities have been assigned to the International Bureau later by way of amendment of the Regulations, for example, in the context of the processing of declarations referred to in Rule 4.17 (both the receiving Office and the International Bureau may invite the applicant to correct a defective declaration (see Rule 26ter.2)).

13. While the records of the Washington Diplomatic Conference on the PCT and other available documents do not expressly elaborate on the reasoning behind this division of labor between receiving Offices and the International Bureau, the "founders" of the PCT clearly were concerned about issues such as how best to ensure uniform processing of all international applications by all receiving Offices² and "reasonably uniform international publication."³ Moreover, it must have seemed logical in view of the division of labor between different Offices and Authorities and the International Bureau, to require the International Bureau to call a defect to the attention of the receiving Office where such defect had apparently been overlooked by that Office but had been noted by the International Bureau in the course of the processing of the international application, or to let the International Bureau deal directly with the applicant where the correction of a defect was required urgently in view of pending international publication.

Present System

14. The role of the International Bureau under the present system in respect of formalities checking may thus best be described as:

² See the report of the first meeting of the Committee of Experts, document PCT/I/11, page 7, paragraph 24, at the end (cited in paragraph 9, above): "In any case, the International Bureau should set up a machinery to harmonize the practices of all authorities controlling the conformity of applications with the formal requirements of the PCT."

³ The 1968 draft of Rule 26.1(a) (which later was renumbered and became present Rule 28.1(a)) provided: "If, in the opinion of the International Bureau or of the Searching Authority, the international application contains certain defects, particularly that it does not comply with the prescribed physical requirements necessary for reasonable uniform publication, the International Bureau or the Searching Authority, respectively, shall bring such defects to the attention of the Receiving Office."

(i) supporting receiving Offices and International Preliminary Examining Authorities in carrying out their tasks with regard to the formalities checking of the international application and of the demand, respectively, in the interest, in particular, of uniform processing of all international applications and demands by all receiving Offices and International Preliminary Examining Authorities, respectively, and “reasonably uniform international publication”; and

(ii) carrying out certain formalities checks directly assigned to it, in particular with regard to defects the correction of which is required in view of the pending international publication.

15. Accordingly, the International Bureau performs a formalities check of every record copy received and:

(i) where it considers that any of the filing date requirements listed in Article 11(1)(i) to (iii) was not complied with on the date which was accorded as the international filing date and the receiving Office had not invited the applicant to correct such defect, brings such defect to the attention of the receiving Office (see Article 14(4) and Rule 29(3));

(ii) where, in its opinion, the international application contains any of the defects referred to in Article 14(1)(a)(i) (“it is not signed as provided in the Regulations”), Article 14(1)(a)(ii) (“it does not contain the prescribed indications concerning the applicant”) and Article 14(1)(a)(v) (“it does not comply to the extent provided in the Regulations with the prescribed physical requirements”) and the receiving Office had not invited the applicant to correct such defect, brings such defect to the attention of the receiving Office (see Rule 28.1);

(iii) where it finds that any priority claim does not comply with the requirements of Rule 4.10 and the receiving Office has failed to do so, invites the applicant to correct the priority claim (see Rule 26*bis*.2);

(iv) where it finds that any declaration referred to in Rule 4.17 does not comply with the requirements of that Rule, invites the applicant to correct the declaration (see Rule 26*ter*.2);

(v) under Chapter II, where a defect in the demand is noticed by the International Bureau, brings such defect to the attention of the International Preliminary Examining Authority (see Rule 60.1(e)).

16. Since record copies are usually received by the International Bureau together with copies of the invitation to correct formal defects sent by the receiving Office to the applicant, the International Bureau is in a position to see which defects, if any, the receiving Office had noticed and invited the applicant to correct. It is thus ensured, in accordance with the Regulations, that the International Bureau brings only those formal defects to the attention of the receiving Office which had been overlooked by that Office, or that the International Bureau invites the applicant to correct a defect only where the receiving Office had failed to do so.

Occurrence in Practice of Defects Found by the International Bureau

17. The following figures regarding defects noticed by the International Bureau and, in accordance with Rule 28.1, called to the attention of the receiving Office concerned illustrate the role of the International Bureau in the formalities checking of international applications.

18. In 2002, the International Bureau received a total number of 84,102 record copies of international applications filed with the five biggest receiving Offices acting under the PCT, that is, the United States Patent and Trademark Office, the European Patent Office, the Japan Patent Office, the United Kingdom Patent Office and the German Patent Office. In respect of those 84,102 record copies, the International Bureau noted a total of 59,900 defects, which apparently had been overlooked by the receiving Office concerned, and brought those defects to the attention of that Office or, where the International Bureau has the authority to do so, directly invited the applicant to correct the defect.

19. Most of the defects noted by the International Bureau and brought to the attention of the receiving Office concerned fell into one of the following three categories:

(i) the international application was not signed as provided in the Regulations (see Article 14(1)(a)(i)) (32,540 defects related to missing or defective powers of attorney; 4,142 defects related to missing or defective signatures);

(ii) the international application did not comply to the extent provided in the Regulations with the prescribed physical requirements (Article 14(1)(a)(v)) (10,774 defects related to drawings; 1,606 defects related to description, claim or abstract; 2,214 defects related to the title of the invention (in particular, discrepancy between request and description); 114 defects related to the request; 237 missing abstracts);

(iii) the international application did not contain the prescribed indications concerning the applicant (see Article 14(1)(a)(ii)) (3,329 defects related to addresses and indications concerning nationality and residence of the applicant).

20. In addition, the International Bureau noted a total of 4,944 "other" defects (in particular, defects related to priority claims and declarations referred to in Rule 4.17) in respect of most of which the International Bureau invited the applicant to correct the defect rather than bringing the defect to the attention of the receiving Office.

21. Overall, more than 60% of all defects noted by the International Bureau related to signature requirements (in particular, missing powers of attorney), about 25% related to physical requirements of the international application (in particular, drawings), more than 5% related to defects relating to indications concerning the applicant, and more than 8% related to "other" defects.

IMPACT OF RECENT DEVELOPMENTS ON FORMALITIES CHECKING

22. A number of recent developments will likely have a substantial impact on the formalities checking of international applications by receiving Offices and the International Bureau, as outlined in the following paragraphs.

Rule Changes Adopted by the PCT Assembly in October 2002

23. In October 2002, in the context of the overhaul of the designations system, the PCT Assembly adopted amendments to the PCT Regulations which likely will have an immediate and considerable impact on formalities checking of international applications, in particular with regard to defects related to signature requirements (see paragraph 19(i), above) and furnishing of indications concerning the applicant (see paragraph 19(iii), above), which in 2002 made up more than 65% of all defects noted by the International Bureau and called to the attention of the receiving Office concerned.

24. In order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide signatures and indications in respect of all applicants (where there are two or more), under the amended Regulations as in force from January 1, 2004, it will be sufficient that the request be signed by at least one applicant and that indications be provided in respect of at least one applicant who is entitled under Rule 19 to file the international application with the receiving Office concerned. Moreover, as of January 1, 2004, where a sole applicant is represented by an agent, or where all co-applicants are represented by a common agent or a common representative, the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the International Bureau will be entitled to waive the requirement that a separate power of attorney be submitted.

25. Consequently, as of January 1, 2004:

(i) where there are two or more applicants, the receiving Office will no longer be required to invite the furnishing of missing signatures if the request is signed by at least one applicant (see Rule 26.2*bis* as in force from January 1, 2004); this should dramatically reduce the number of defects related to signature requirements, the number of invitations to be issued by the receiving Office and, consequently, the number of cases in which the International Bureau has to bring such defect to the attention of the receiving Office (see paragraph 19(i), above);

(ii) where there are two or more applicants, the receiving Office will no longer be required to invite the furnishing of missing indications with regard to address and nationality and residence, or the correction of defective indications, if such indications are furnished in respect of at least one applicant who is entitled to file the international application with the receiving Office concerned; this should dramatically reduce the number of defects related to indications concerning the applicant, the number of invitations to be issued by the receiving Office and, consequently, the number of cases in which the International Bureau has to bring such defect to the attention of the receiving Office (see paragraph 19(iii), above);

(iii) the receiving Office may waive the requirement that a separate power of attorney be submitted, in which case a missing power of attorney would no longer be considered a defect and thus no invitation would have to be issued by the receiving Office.

Reorganization of the Office of the PCT

26. In the context of the ongoing project to automate PCT operations at the International Bureau (the IMPACT project), a new organizational structure and new and more efficient business processes have been introduced within the Office of the PCT. The Office of the PCT has moved away from the previously rigid and task-specific hierarchical organizational

structure and adopted a team-oriented approach, resulting in a more flexible organizational structure that will allow for innovative new functions and services to be introduced over time, with a view, in particular, to improving the day-to-day operational cooperation between the International Bureau and receiving Offices, International Authorities and designated/elected Offices.

27. Under the new organizational structure, small processing teams have been put in place, each being responsible for the processing of record copies received from a limited number of particular receiving Offices. In each processing team, experienced senior staff will act as points of contact for questions by applicants, receiving Offices, International Authorities and designated/elected Offices relating to international applications processed by that team, with the aim of providing a superior level of customer-oriented service. So as to improve the day-to-day cooperation between each processing team and "its" receiving Office, particular emphasis will be put on training, advice and support, and personal contacts between staff in receiving Offices and the processing teams. It is hoped and expected that these measures will lead to a more uniform and efficient processing of international applications by all receiving Offices and the International Bureau, including uniform international publication.

28. In this context, it is to be noted that one of the processing teams, namely, the processing team which processes record copies received from the International Bureau as receiving Office, has started a pilot study, together with the staff from the International Bureau as receiving Office, to identify inefficiencies and unnecessary duplication of work in the formalities checking processes that are carried out by both the International Bureau as receiving Office and the International Bureau (proper), with a view to introducing simplified and more efficient business processes in the day-to-day cooperation between all receiving Offices and the International Bureau. It may be worth while to consider whether a similar study should also be carried out with regard to further simplifications in the formalities review of international applications filed in electronic form.

Filing and Processing of International Applications in Electronic Form

29. Filing and processing of international applications and related documents in electronic form has become possible and will inevitably change the way in which Offices, Authorities and the International Bureau process international applications. Modifications of the Administrative Instructions under the PCT designed to enable the implementation of electronic filing and processing of international applications and related documents entered into force on January 7, 2002. The modifications (Part 7 and Annex F of the Administrative Instructions) contained, respectively, the necessary legal framework and technical standard. In November 2002, the European Patent Office as receiving Office received the first international application filed in electronic form. PCT-SAFE, the electronic filings software being developed by the International Bureau as an extension of the PCT-EASY software, will be made available to applicants and receiving Offices later this year. In the context of the checking of formalities, it is of particular interest to note that:

(i) the PCT-SAFE electronic filings software will contain approximately 200 validations; the validation function is used to check and confirm that data entered by the applicant are consistent and meet the PCT requirements for according an international filing date as well as formality requirements, avoiding mistakes made by the applicant before the international application is filed;

(ii) compliance of the body of the international application (description, claims, abstract) with certain physical requirements (such as margins, writing of text matter, numbering of sheets, etc.) in the interest of "reasonable uniform international publication" will be of less importance, given that the body of the international application will be in fully electronic form and thus can be brought into any required form or shape for the purposes of international publication;

(iii) receiving Offices, when performing the formalities check, will benefit from the automated validation functions of the software, automatically detecting defects still contained in the international application.

REVIEW OF FORMALITIES CHECKING PROCESSES CARRIED OUT BY BOTH RECEIVING OFFICES AND THE INTERNATIONAL BUREAU

30. In light of what has been outlined above, the Working Group, when reviewing the formalities checking processes that are carried out by both receiving Offices and the International Bureau, may wish to consider the following questions:

(i) In the context of formalities checking, is the "division of labor" between the receiving Offices and the International Bureau as envisaged by the "founding fathers" of the PCT and provided for in the Regulations still appropriate?

(ii) Are the issues of "uniform international processing of all international applications by all receiving Offices" and "uniform international publication" still of concern?

(iii) Do the formalities checking processes that are carried out by both receiving Offices and the International Bureau add any value to the system, in particular, from the applicant's point of view, or do they constitute an unnecessary duplication of work which should be avoided and done away with?

(iv) In view of the likely impact of the Rule changes adopted in October 2002 and the ongoing "pilot study" by the International Bureau on formalities checking processes (see paragraph 28, above), should proposals for changes to the Regulations, the Administrative Instructions or the Receiving Office Guidelines be included in the work program of the Working Group now, or should such proposals await the likely impact of these Rule changes and the results of the pilot study?

31. The Working Group is invited to consider the issues raised in this document.

[End of document]

WIPO



PCT/R/WG/5/5

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

WORKING GROUP ON REF ORMOF THE PATENT COOPERATION TREATY (PCT)

Fifth Session

Geneva, November 17 to 21, 2003

ASPECTS OF COPYRIGHT AND OTHER RIGHTS IN NON -PATENT LITERATURE
MADE AVAILABLE BY INTELLECTUAL PROPERTY OFFICES

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified above [in document PCT/A/32/2], on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will thence be provisional in nature.

BACKGROUND

3. The present document reproduces the contents of document PCT/R/WG/4/3, which was submitted to the fourth session of the Working Group, held in Geneva from May 19 to 23, 2003. Having regard to the time available, discussions on that document were deferred until this session (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraph 104).

4. The Summary by the Chair of the third session of the Working Group on Reform of the Patent Cooperation Treaty states, in paragraph 63 (see document PCT/R/WG/3/5):

“Copyright Issues Raised by the International Search and Preliminary Examination Procedure

“63. Two delegations observed that the making and sending, by the International Searching Authority, of copies of documents cited in the international search report, as provided by Article 20(3) and Rule 44.3, could involve copyright infringement, in particular where it involved non-patent literature and the first digitization of a document. The International Bureau observed that the library community may also experience similar problems. It was agreed that the International Bureau, in cooperation with the Delegation of Canada and other Authorities, should study the matter with a view to having the matter considered by the appropriate body or bodies within WIPO.”

5. The present document contains a preliminary outline and discussion of certain legal issues arising from the making available of non-patent literature by industrial property offices (“Offices”) and outlines the broader context in which these issues might arise, taking into account also the likely evolution of office practices in the digital environment. In light of this purpose, the document focuses not only on questions resulting from the application of Article 20(3) of the PCT and Rule 44.3 of the Regulations under the PCT,¹ as mentioned in the summary of the Chair of the third session of the Working Group, but also on those that might arise from other, more technologically advanced, means for Offices to make non-patent literature available. The document was prepared by the International Bureau after making preliminary contacts with the Delegations of Australia and Canada, but it does not represent an agreed position.

INTRODUCTION

6. Examination of the novelty of a claimed invention requires a review of the relevant prior art. Traditionally, such examination was performed principally by reviewing paper-based sources of prior art, namely copies of published patent documents and of non-patent literature (the latter including, for instance, technical articles and textbooks).

7. During the last decade, in particular, the method by which the prior art review is performed has been profoundly affected by information technology, including the Internet. Sources of prior art which previously were only available on paper now also exist in digital form. Furthermore, in recent years, numerous databases providing online access to a wealth

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.

of patent and non-patent literature have become available, many of which can be consulted through the Internet. It is to be expected that this trend will intensify in the future. Some of these databases are made available on a commercial basis by private entities, while others have been developed by public authorities, most notably Offices. The value of these patent databases is a function of the richness of their content, as well as the ease of use.

Aggregating a large amount of easily retrievable and relevant information, including non-patent literature, in such a database is a highly attractive proposition for the users of the patent system.

8. In the course of the performance of their functions, Offices make available sources of prior art, including non-patent literature, to a variety of persons and entities, including staff members within the Office, other Offices and applicants, and also third parties. There are various means by which these sources may be made available by the Offices concerned, including the mailing or distribution of paper copies of the materials at issue, the transmission of the same materials in electronic form through networks including the Internet (e-mail) and the making available of databases permitting online access to the materials in question. To the extent that those prior art sources include non-patent literature, their being made available in this manner by Offices may affect third parties' rights in the works concerned. Offices should therefore be aware of the legal implications which their practices may have in respect of those third party rights.

THE MAKING AVAILABLE BY OFFICES OF NON-PATENT LITERATURE: SCENARIOS

9. As explained above, Offices may make non-patent literature available to different persons or entities by various means. While it is recognized that the list below is not exhaustive, it would appear that current and future Office practices typically would fall under one or more of the following categories:

(i) the making by Offices of physical or digital copies of non-patent literature for consultation only by staff members of the Offices concerned ("Scenario A");

(ii) the creation by Offices of searchable databases containing non-patent literature, for consultation only by staff members of the Offices concerned, through the scanning, using Optical Character Recognition, and uploading of non-patent literature ("Scenario B");²

(iii) the transmission by Offices of physical or digital copies of non-patent literature to designated Offices or applicants under Article 20(3) of the PCT ("Scenario C");

(iv) the transmission by relevant Authorities of International Search Reports and International Preliminary Examination Reports containing hyperlink to non-patent literature hosted on third party Internet resources (for instance, a hyperlink to an article in a technical magazine posted on the website of an Internet publisher) ("Scenario D");

(v) the creation and making available by Offices of databases, for consultation by the public through the Internet, containing hyperlink to non-patent literature hosted on third party Internet resources ("Scenario E");

² See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).

(vi) themakingavailablebyOfficesofdatabasesdescribedin(ii)tothepublicfor consultationthroughtheInternet(“ScenarioF”).

10. Afterageneralreviewoftherelevantlegalprinciples,theremainderofthisdocument willoutlinelegalissueswhichmayarisefromeachoftheabovescenarios.

RELEVANTLEGALPRINCIPLES

11. Asubstantialportionofthenon-patentliterature,typicallytechnicaltextbooksor articlesintechnicalpublications,aresubjecttoexclusivecopyrightsgrantedtotheirauthorsbythe copyrightsystemandmayalsobenefitfromotherformsofprotectionofferedbysimilar rights.Theseexclusivecopyrightsorotherformsofprotectionplaceimportantrestrictionsonthe usewhichotherpartiesmaymakeoftheworksinquestion,absentauthorizations(licenses) fromtherightsholders.Theinternationallegalbasisoftheserestrictionsisdiscussedinthelater subsequentparagraphsofthispaper.

ProtectionUnderCopyright

12. Article2oftheBerneConventionfortheProtectionofLiteraryandArtisticWorks(the BerneConvention)statesthat“[t]heexpression‘literaryandartisticworks’shallinclude everyproductionintheliterary,scientificandartisticdomain,whatevermaybethemodeor formofitsexpression,suchasbooks,pamphletsandotherwritings...”Manyformsof non-patentliterature,andcertainlytechnicaltextbooksandarticlesintechnicalpublications, qualifyas“literaryandartisticworks”undertheBerneConvention.Theessentialelementsof theBerneConventionhavebeenincorporatedintotheTRIPSAgreementthroughits Article9(1)statingthat“[m]embersshallcomplywithArticles1through21oftheBerne Convention.”³

13. Thecopyrightsystemconfersupontheauthorsofliteraryandartisticworksabundleof differentrights.Amongthevariousrightsgranted,thosethatconcernmostdirectlythetopic atissuearetherightofreproduction,therightofdistributionandtherightofmakingavailable tothepublic.

14. TherightofreproductionisenshrinedinArticle9oftheBerneConvention,which providesthat“[a]uthorsofliteraryandartisticworksprotectedbythisConventionshallhave theexclusivecopyrightofauthorizingthereproductionoftheseworks,inanymannerorform.” Withrespecttotheapplicationofthisrightinthedigitalenvironment,theagreedstatement concerningArticle1(4)oftheWIPOCopyrightTreaty(WCT)⁴readsasfollows:

³ ExceptinrespectoftherightsconferredunderArticle6bisoftheBerneConvention.

⁴ TheWCTisoneoftwotreatieswhichwereadoptedin1996bytheWIPOMemberStates(both commonlyreferredtoasthe“WIPOInternetTreaties”),theotherbeingtheWIPOPerformances andPhonogramsTreaty(WPPT).Thetreaties,eachhavingreachedtheir30thratificationor accession,havebothenteredintoforce:theWCTonMarch6,2002,andtheWPPTonMay20, 2002.TheWIPOInternetTreatiesaredesignedtoupdateandsupplementtheexisting internationaltreatiesoncopyrightandrelatedrights,namely,theBerneConventionandthe Rome Convention.

“Thereproductionright,assetoutinArticle9oftheBerneConvention,andthe exceptionspermittedthereunder,fullyapplyinthedigitalenvironment,inparticularto theuseofworksindigitalform.Itisunders toodthatthestorageofaprotectedworkin digitalforminanelectronicmediumconstitutesareproductionwithinthemeaningof Article9oftheBerneConvention.”

15. TherightofdistributionislaiddowninArticle6(1)oftheWCTwhichsti pulatesas follows:

“Authorsofliteraryandartisticworksshallenjoytheexclusiverightofauthorizingthe makingavailabletothepublicoftheoriginalandcopiesoftheirworksthroughsaleor othertransferofownership.”

16. Withrespects totherightofmakingavailabletothepublic,Article8oftheWCTstates asfollows:

“Withoutprejudiceto[certainprovisionsoftheBerneConvention],authorsofliterary andartisticworksshallenjoytheexclusiverightofauthorizinganycom municationto thepublicoftheirworks,bywireorwirelessmeans,includingthemakingavailableto thepublicoftheirworksinsuchawaythatmembersofthepublicmayaccessthese worksfromaplaceandatatimeindividuallychosenbythem.”

Thepassage“makingavailabletothepublicof...worksinsuchawaythatmembersofthe publicmayaccessthese worksfromaplaceandatatimeindividuallychosenbythem” coversthepostingofworksontheInternetinordertoallowthepublictoaccessord ownload them.⁵

Protection Under Similar Rights

17. Whilecopyrightisthemostimportant,aswellasthemostinternationallyharmonized, legalsourceoflimitationsontheusewhichthirdpartiesmaymakeofprotectedworks,it is nottheonlysuchsource.Dependingonthejurisdictioninquestion,avarietyofcomparable userrestrictionsmaybegroundedonlegalfoundationsotherthancopyright,including,in particular,misappropriation,unfaircompetitionandtheprotectionofdatabases. Thelatter conceptisdiscussedinmoredetailbelow,inlightofitsspecialrelevancetothetopicatissue.

18. Theregionoftheworldwheretheprotectionofdatabaseshasfounditsmostexplicit legalarticulationistheEuropeanUnion,throughDirective96/9/ECoftheEuropean ParliamentandoftheCouncilofMarch11,1996ontheLegalProtectionofDatabases(the DatabaseDirective).⁶Article1(1)oftheDatabaseDirectivedefinesadatabaseas“a collectionofindependentworks,d ataorothermaterialarrangedinasystematicormethodical

⁵ Foranextensiveanalysisofthebackgroundtothisprovisionanditsrelationshipwiththe interactive,on -demandtransmissionsofworksindigitalnetworks,seeMihályFicsor,*The Law ofCopyrightandtheInternet*(OxfordUniversityPress, 2002),pages145through254.For a broaddiscussionofcopyrightinthedigitalenvironment,seeWIPO,*IntellectualPropertyonthe Internet:ASurveyofIssues*(December2002),pages29through63,availableat <http://ecommerce.wipo.int/survey/index.html>.

⁶ ThatDirectiveenteredintoforceonJanuary1,1998,andhassincebeenimplementedinthe nationallegislationofallEuropeanUnionMemberStates.

way and individually accessible by electronic or other means.” Article 7(1) of the Directive stipulates that “Member States shall provide for a right for the maker of a database which shows that there has been a qualitative and/or quantitative substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of the database.” Article 7(5) further states that “[t]he repeated and systematic extraction and/or re-utilization of insubstantial parts of the contents of the database implying acts which conflict with a normal exploitation of that database or which unreasonably prejudice the legitimate interests of the maker of the database shall not be permitted.”

19. At the international level, there does not exist a present comparable “*suigeneris*” right in databases, such as the one provided for in Article 7 of the Database Directive, although the possible creation of international protection for databases which by their nature do not benefit from copyright protection (namely, non-original databases), has been the subject of discussion for several years in WIPO’s Standing Committee on the Law of Copyright and Related Rights.

Exceptions: General

20. The copyright system has traditionally maintained a balance between protecting creators’ property rights through exclusive rights to control the use of their works, and the public interest in having access to and reasonable possibilities to use such materials. Copyright laws permit exceptions and limitations to copyright, in order to maintain this balance. In the United States of America, for example, this balance has been enshrined in the principle of “fair use” limitations on the rights of authors, while in other countries such as Australia and the United Kingdom, the concept is recognized by way of statutory exceptions to copyright infringement for “fair dealing.” In other countries, such as France, there exists no broad doctrine governing exceptions (such as “fair use” or “fair dealing”), but specifically enumerated exemptions are expressly foreseen in the copyright legislation.⁷

21. The scope of permissible exceptions is to a large degree a matter of national law, although a number of overarching general principles exist at the international level. With respect to the right of reproduction, Article 9 of the Berne Convention states as follows:

“It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.”

22. Article 10 of the WCT similarly foresees that Contracting Parties may provide for exceptions to the right of distribution and right of making available to the public, subject to their meeting the same “three step test” laid down in Article 9 of the Berne Convention. The agreed statement concerning Article 10 of the WCT furthermore adds the following:

⁷ See Paul Edward Geller, *International Copyright Law and Practice*, Volume I, Release No. 14 (LexisNexis, 2002), para. 8[2].

“It is understood that the provisions of Article 10 permit Contracting Parties to carry forward and appropriately extend into the digital environment limitations and exceptions in their national laws which have been considered acceptable under the Berne Convention. Similarly, these provisions should be understood to permit Contracting Parties to devise new exceptions and limitations that are appropriate in the digital network environment.”

23. The law of copyright, like patent law, is territorial and this characteristic happens nowhere felt more acutely than in the area of exceptions and limitations. Which use would fall under the scope of an exception varies significantly from one jurisdiction to another, and the analysis of whether certain cross-border uses of works may benefit from an exception therefore, will often require finding the applicable law. If use of the work is made on the Internet, finding the applicable law becomes an exceptionally difficult exercise, in the light of the ubiquitous and global nature of that medium.⁸

24. Article 9 of the Database Directive also foresees a number of exceptions to the database “*suigeneris*” right which it creates. These exceptions present certain similarities to those that are found in the copyright system.

Exceptions: Government Use

25. Several countries have provided for copyright exceptions relating to certain government use of protected works. For example, Section 45 of United Kingdom Copyright, Designs and Patents Act states that “(1) [c]opyright is not infringed by anything done for the purposes of parliamentary or judicial proceedings and (2) [c]opyright is not infringed by anything done for the purposes of reporting such proceedings, but this shall not be construed as authorising the copying of a work which is itself a published report of the proceedings.”⁹ In certain countries, the exceptions for government use are more broadly crafted. The French Intellectual Property Code, for instance, states in its Article L.331-4 that “[copyright] may not prevent actions which are necessary for the accomplishment of a judicial or administrative procedure provided for by law, or which are undertaken for the purposes of public security.” As regards United States of America law, in an opinion of April 30, 1999 addressed to the General Counsel of the United States Department of Commerce, the Acting Assistant Attorney General concluded as follows on the question of whether government reproduction of copyrighted materials is invariably a “fair use”:

“There is no ‘per se’ rule that government reproduction of copyrighted material – including, in particular, government photocopying of copyrighted materials for internal government use – automatically qualifies as a fair use under section 107 of the Copyright Act of 1976. However, government photocopying would in many contexts be non-infringing because it would be a ‘fair use’; and there are good reasons that, if an agency decides to negotiate photocopying licensing agreements, it should seek to limit

⁸ For an introductory discussion of the interplay between private international law, intellectual property and the Internet, see WIPO, Intellectual Property on the Internet: A Survey of Issues (December 2002), pages 113 through 131, available at <http://ecommerce.wipo.int/survey/index.html>.

⁹ Similar provisions exist in the legislation of, for instance, Australia, Greece, India, Ireland, Spain and Singapore.

thescopeof anysucharrangementtocoveronlythosegovernmentphotocopying practices that otherwise would, in fact, be infringing.”¹⁰

26. With respect to the situation in Japan, a commentator from the Japan Patent Office (JPO) has stated the following:

“Article 42 of the Copyright Law of Japan stipulates that the right of reproduction shall not extend to (i) cases necessary for court procedures and (ii) those necessary for legislative and administrative internal use purposes, provided that the interests of the author are not unduly injured in light of the number and mode of the reproduction.”¹¹

27. The subsequent section of this document considers each of the Scenarios identified in paragraph 7, above, in light of the aforementioned legal principles.

APPLICATION OF LEGAL PRINCIPLES TO SCENARIOS

Scenarios A and B

28. Several actions taken in Scenarios A and B may be viewed as implicating the right of reproduction and the right of distribution. In Scenario A, this is the case for the physical or digital reproduction of the copies of the prior art source materials by the Office (right of reproduction) and their transmission to the staff members of the Office (right of distribution). In Scenario B, the right of reproduction is implicated, at the very least, by the scanning of the works in question and their uploading into the database. Furthermore, the making available of the works through the database to the examiners of the Office may also implicate the right of communication to the public, notwithstanding the fact that these works may be accessible only by staff members of the Office and not the general public.

29. However, as observed above, certain countries recognize exceptions for government use and the actions taken by Offices in Scenarios A and B may, in a number of countries, fall under such exceptions. For instance, with respect to the situation in Japan concerning Scenario B, the Japan Patent Office has noted that:

“Understanding that the digitization of documents for [insertion into a database made available to the examiners of the Japan Patent Office (JPO)] is a permissible reproduction under Article 42 [of the Copyright Law of Japan], the JPO are continuing to digitize relevant documents for internal use only, without license agreement with the rightsholders.”¹²

30. It may be concluded that, in a number of countries, Scenarios A and B are problematic from a copyright perspective, unless appropriate licenses have been secured from the rightsholders, or unless they benefit from exceptions provided for under the applicable national law.

¹⁰ The full text of the Opinion is available at <http://www.cybercrime.gov/fairuse.htm>.

¹¹ See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).

¹² See paper by Shigeo Takakura (Japan Patent Office), Non-Patent Document Database for Examination of Software-Related Inventions (November 21, 2002).

Scenarios C and D

31. Scenario C is based on Article 20(3) of the PCT, which reads as follows:

“At the request of the designated Office or the applicant, the International Searching Authority shall send to the said Office or the applicant, respectively, copies of the documents cited in the international search report, as provided in the Regulations.”¹³

With respect to the international preliminary examination report, Article 36(4) of the PCT furthermore states that:

“The provisions of Article 20(3) shall apply, *mutatis mutandis*, to copies of any document which is cited in the international preliminary examination report and which was not cited in the international search report.”

Copies of cited documents sent under Article 20(3) by relevant Authorities might be in paper or in electronic form (that is, scanned versions of the source material).

32. Scenario D reflects how the practice provided for in Article 20(3) might transform itself in the digital environment. Instead of sending physical or electronic copies of the documents, Authorities would simply provide hyperlinks, embedded in electronic versions of the search and examination reports, permitting recipients to access online the prior art source materials, which themselves would be hosted on third-party Internet resources.

33. In terms of the rights affected, Scenario C implicates the right of reproduction, the right of distribution, as well as the right of making available to the public.

34. With respect to Scenario D, the question is whether providing a hyperlink which resolves to a protected work may be infringing. No internationally harmonized rules govern specifically the liability for linking online content exist and, at the national level, the matter is mostly left for the courts to resolve. The case law which can be observed to date is far from settled and it is therefore hard to draw any general conclusions, apart from the following:¹⁴

(i) Linking to the homepage of a website normally raises less concern than “deep-linking,” which connects a user directly to secondary material on another site, bypassing that site’s homepage. Links that might be provided in Scenario D would most likely qualify as deep links, as they would presumably resolve to a particular work (for example, a specific article in a technical magazine) hosted on the site of an online publisher, rather than its homepage.

(ii) The use of deep links to retrieve pages from the targeted site’s database may, in some jurisdictions, amount to an infringement of rights in the database that contains the secondary information. As explained above, in the European Union, Article 7 of the Database

¹³ Rule 44.3 provides for modalities for the copying and transmission of the documents cited in the international search report.

¹⁴ For a more detailed discussion of linking online content, see WIPO, Intellectual Property on the Internet: A Survey of Issues (December 2002), pages 51 through 53, available at <http://ecommerce.wipo.int/survey/index.html>.

Directives require Member States to provide protection against the extraction and/or re-utilization of the “whole or of a substantial part of the contents of a database,” as well as against “the repeated and systematic extraction and/or re-utilization of insubstantial parts of the contents of the database implying acts which conflict with a normal exploitation of that database or which unreasonably prejudice the legitimate interests of the maker of the database.”

35. While it is clear that Scenarios C and D raise important rights issues, a proper assessment of the legal appropriateness of these Scenarios should also take into account the following:

(i) The action taken by Offices in Scenario C (and, *mutatis mutandis*, perhaps also those in Scenario D) are mandated by treaty provision, namely Article 20(3) of the PCT. While this provision does not explicitly exempt Offices from complying with their copyright obligations, the fact that the practice at issue finds support in a rule of international law is not an irrelevant consideration. The relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law, and the impact this may have on the rights and obligations of relevant Authorities with respect to the reproduction and making available of non-patent literature to other Offices and applicants under the PCT merits further consideration.

(ii) Under Article 20(3) only the designated Office and the applicant would receive copies of (or hyperlinks permitting access to) the materials in question. As those materials thus would be made available only to a limited number of persons or entities (not the general public), such practice may benefit from an exception in a number of countries. A definitive answer to this question requires further analysis of the applicable national law by each Office concerned. To the extent the applicant and/or designated office is located in a jurisdiction other than that of the International Searching Authority or the International Preliminary Examination Authority, such analysis may require the consideration of more than one national law.

Scenarios E and F

36. Scenarios E and F, implicating the right of reproduction, as well as the right of making available to the public, raise even more serious concerns from a copyright and database protection perspective, as any exceptions for government use that may be provided for under the applicable national law would not apply to them, since the general public would be the primary beneficiaries of the databases in question.

POSSIBLE APPROACHES

37. The preceding paragraphs indicate that, to varying degrees, all Scenarios envisaged in this document raised delicate issues of copyright and similar rights. With respect to the question of how to address these issues, the following observations are offered for consideration by the Working Group:

(i) As noted above, the relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law merits further consideration. Such further consideration could occur in the context of the

Study to be performed by the International Bureau, in cooperation with the Delegation of Canada and other Authorities, as envisaged by the Chair's Summary of the third session of the Working Group (see paragraph 1, above).

(ii) Certain of the Scenarios envisaged in this document may benefit from exceptions under national laws. Offices concerned thereto should review the legal position in their jurisdiction, taking into account also considerations of private international law to the extent the materials in question would be made available in other jurisdictions, possibly through the Internet.

(iii) A more global, systematic and comprehensive solution may require the conclusion of licensing agreements with the rightsholders of the principal sources of non-patent literature by Offices, International Search Authorities and International Preliminary Examining Authorities, as well as the International Bureau. The principle and the modalities of such license agreements might also usefully be further considered in the Study referred to in (i) above.

38. The Members of the Working Group are invited to consider the contents of this document and to decide whether the International Bureau, in cooperation with the Delegation of Canada and other Authorities, should:

(i) further consider the relationship between Article 20(3) of the PCT, the relevant provisions of the Berne Convention and the WCT, as well as any applicable national law; and

(ii) further consider the principle and possible modalities of the licensing agreements referred to in paragraph 35(iii), above.

[End of document]

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PCT/R/WG/5/6

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**WORKING GROUP ON REF ORMOF THE PATENT
COOPERATION TREATY (PCT)**

Fifth Session

Geneva, November 17 to 21, 2003

DIVISIONAL APPLICATIONS UNDER THE PCT

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified above [in document PCT/A/32/2], on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will thence cease to be provisional in nature.

E

BACKGROUND

3. The present document reproduces the contents of document PCT/R/WG/4/9, which was submitted to the fourth session of the Working Group, held in Geneva from May 19 to 23, 2003. Having regard to the time available, discussions on that document were deferred until this session (see the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraph 104).

4. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group was a proposal to allow for divisional applications to be filed under the PCT.

5. The Working Group's discussions on this proposal are summarized in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 50 and 51, as follows:

“Divisional Applications

“50. Several delegations supported the proposal that further considerations should be given to providing under the PCT for the filing of international applications as divisional applications of earlier international applications, with a view to taking the greatest possible advantage of the centralized processing offered by the international phase, particularly in cases where there had been a finding of lack of unity of invention. However, while there was no objection in principle to such a possibility, it was recalled that problems had been identified when such a proposal had been made in the past, in particular with regard to the added complexity involved, to the difficulty in according an international filing date in accordance with both Article 11 and the Paris Convention, and to the need for compliance with time limits for international search and international preliminary examination.

“51. It was agreed that the International Bureau, in cooperation with the Delegation of the Netherlands, should further consider the matter and that any proposal which emerged would be considered by the Working Group at a future session.”

6. The International Bureau and the Delegation of the Netherlands have consulted on the matter since the third session of the Working Group. The present document was prepared by the International Bureau in the light of those consultations, but it does not reflect an agreed position.

Divisional applications under the Paris Convention

7. Article 4 G of the Paris Convention for the Protection of Industrial Property (“Paris Convention”) requires countries of the International Union for the Protection of Industrial Property (“Paris Union”) to provide for the filing of divisional applications, as follows:

“[4G](1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

“(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such divisions shall be authorized.”

Divisional applications under the 1968 – 1970 drafts of the PCT

8. While, at present, the PCT¹ does not provide for the filing, during the international phase, of divisional applications, it is to be noted that the 1968 draft of the PCT contained provisions in both the draft Treaty and the draft Regulations under the Treaty which would have allowed the applicant, in the case of lack of unity of invention, at his option, to either (i) restrict the claims, or (ii) to pay additional fees, or divide the application, or both (see document PCT/III/5 (Draft Treaty), Articles 17 (Procedure Before the Searching Authority) and 34 (Procedure Before the Preliminary Examining Authority), and document PCT/III/6 (Draft Regulations under the PCT), Rules 37 (Lack of Unity of Invention (Search)) and 62 (Lack of Unity of Invention (Preliminary Examination)). Excerpts of the 1968 draft of Articles 11 (Filing Date and Effects of the International Application), 17 and 34, as well as the 1968 draft of Rules 37 and 62, are reproduced for ease of reference in Annex IV to this document.

9. However, in the 1969 draft of the PCT those provisions were deleted, and the final text of the PCT assigned at the Washington Diplomatic Conference in June 1970 does not contain any provisions concerning the division of international application during the international phase. The records of the Washington Diplomatic Conference on the PCT (1970) do not state any reasons for the deletion in the 1969 draft of the provisions concerning divisional applications as contained in the 1968 draft. Document PCT/DC/3 (Main Differences between the 1968 and 1969 Drafts), paragraph 31, simply states the following:

“31. *Division of the international application*. As opposed to the 1968 Draft (Articles 17(3)(a)(ii) and 34(3), Rules 37.5, 37.7 and 62), the International Searching Authority and the International Preliminary Examining Authority cannot request, nor can the applicant volunteer, under the 1969 Draft, division of the international application in the international phase. Of course, the designated or elected Offices may require division if the international application does not comply, in their opinion, with the requirement of unity of invention as defined in Rule 13. Furthermore, the applicant may voluntarily divide his application before any national Office to the extent permitted by the national law of that Office.”

10. Thus, as indicated above, there is at present no provision in the PCT which would allow for the filing, during the international phase, of divisional application based on an “initial international application.” If the international application does not, in the view of a designated/elected Office, comply with the requirement of unity of invention as defined in Rule 13 in that it contains more than one inventions (compare Article 4G(1) of the Paris

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.

Convention), the applicant may, before each designated/elected Office, be required, under the national law applicable by that Office, to restrict the claims to a single invention or to file a separate divisional application in respect of each additional invention contained in the international application.

11. Obviously, the introduction of a procedure allowing the applicant to file an international application as a divisional application of an initial international application (“divisional international application”) would greatly simplify, from the applicant’s perspective, the processing of the international application where the International Searching Authority or the International Preliminary Examining Authority makes a finding of lack of unity of invention, replacing the need to individually file, after national phase entry, divisional (national) applications with each designated or elected Office concerned. Similar considerations apply where applicants wish to file one or more divisional international applications on their own initiative (as provided for under Article 4G(2) of the Paris Convention).

12. On the other hand, it needs to be remembered that the present system already provides for a procedure which enables the applicant, in the case of a finding of lack of unity of invention by the International Searching and Preliminary Examining Authority, to obtain an international search report and an international preliminary examination report in respect of all parts of the international application, no matter how many inventions are contained in it, against the payment of additional (search and preliminary examination) fees. The introduction of a further procedure which would allow the applicant to divide the initial international application, during the international phase, by filing divisional international applications, would not necessarily be desirable if the result was to add further complexity to the overall system, as might be the case if complicated amendments to the Regulations were needed.

DIVISION OF INTERNATIONAL APPLICATIONS DURING THE INTERNATIONAL PHASE

13. The Annex to this document set out three separate possibilities in the form of preliminary proposals, each of which is designed to permit the division of international applications by taking steps during the international phase of the PCT procedure. It is hoped that consideration of those proposals will facilitate discussion of possible future work on the matter. The possibilities are the following:

(i) *possible revision of the PCT (Treaty)* in order to provide expressly for the filing of divisional international applications;

(ii) *amendments of the Regulations* in order to provide expressly for the filing of divisional international applications;

(iii) *amendments of the Regulations* to provide a new procedure allowing for the “internal” division of international applications during the international phase, to be followed by a simplified way of proceeding with the divided parts of the international application as separate divisional applications in the national phase.

POSSIBLE REVISION OF THE PCT (TREATY)

14. Annex I contains a proposal for a new Article 17 *bis* of the Treaty which would expressly provide for the filing of divisional international applications. Consequential amendments of other Articles would also be required, such as Articles 2 (Definitions), 8 (Claiming Priority) and 11 (Filing Date and Effects of International Application), as well as other Articles concerning the international search procedure, international publication and communication to designated Offices, the international preliminary examination procedure, and national phase entry.

DIVISIONAL INTERNATIONAL APPLICATIONS

15. Annex II contains proposals for an amendment of the Regulations which would allow the applicant to divide an initial international application into separated divisional international applications during the international phase. Those proposals are based on the premise that the Treaty as currently worded would permit the Regulations to be amended by the Assembly to provide for the division of international applications in order to comply with Article 4 G of the Paris Convention, noting that, under PCT Article 62(1), any PCT Contracting State must be a member of the Paris Union and thus must apply all of the mandatory provisions of the Paris Convention, including the obligation under Article 4 G of that Convention. On that view, an amendment of the PCT Regulations to provide for the division of international applications, including the preservation of the (filing) date of the initial international application as the (filing) date of a divisional international application, would appear to be possible under Article 58(1)(iii) in that it would provide Rules concerning “details useful in the implementation of the Treaty” including Article 62(1). If, contrary to that premise, the Working Group considers that the Treaty as currently worded would not permit such an amendment of the Regulations, it would not appear possible to provide for the filing of divisional international applications until the Treaty itself is revised in this respect.

Filing of Divisional International Applications

16. *Possibility of filing divisional international applications:* Proposed Rule 30 *bis.1* would give effect to the general provision of Article 4 G(2) of the Paris Convention relating to the filing of divisional international applications. It is proposed that divisional international applications be able to be filed either where there has been a finding of lack of unity of invention by the International Searching Authority or where the applicant acts on his own initiative.

17. While certain special requirements would apply for divisional international applications with regard to filing, international search and international preliminary examination (see below), every divisional international application would be treated as a “regular” international application (separate and distinct from the initial international application from which it was divided) in respect of which fees would have to be paid, an international search report would be established, international publication would take place and, if so requested by the applicant by making a demand, international preliminary examination would be carried out.

18. *International filing date and right of priority:* In accordance with Article 4 G(2) of the Paris Convention, every divisional international application would preserve as its international filing date the international filing date of the initial international application and its right of priority, if any, provided that the conditions set out in subparagraphs (a) and (b) are met.

(a) *Subject matter and disclosure:* It is implicit in Article 4 of the Paris Convention, in order for a divisional international application to preserve as its international filing date the international filing date of the initial international application, that the subject matter contained in the divisional international application must have been wholly contained within the initial international application as filed. In other words, using the terminology of PCT Rule 66.2(a)(iv), the disclosure in the divisional international application may not go beyond the disclosure in the initial international application on its international filing date. Note that the approach suggested here is different from the approach chosen in the 1968 draft Regulations under the PCT (see draft Rule 37.5(a) in Annex IV to this document).

(b) *Time limit:* Since divisional international applications will mainly (although not necessarily) be filed in response to a finding by the International Searching Authority of lack of unity of invention and the invitation to pay additional (search) fees, it appears necessary to allow the applicants sufficient time to consider (i) the results of the international search, particularly if one or more additional fees referred to in Article 17(3)(a) had been paid, and (ii) the result of any protest procedure under Rule 40.2(c), before deciding whether to file divisional international applications. Since these considerations are also relevant to making a demand, it is proposed that the time limit for filing a divisional international application should be the same as the time limit for making a demand under Rule 54bis.1 in respect of the initial application, that is, three months from the date of receipt of the international search report on, or 22 months from the priority date of, the initial international application, whichever expires earlier.

19. In addition to the matters just outlined, which are dealt with in proposed Rule 30bis, a number of other matters would need to be dealt with in amendments of the Regulations if it is decided to proceed further in this direction. Some of those other matters are outlined in the following paragraphs.

Status of Initial International Application

20. It may be desirable to clarify expressly that the initial international application must be pending when a divisional international application is filed.

Priority claims

21. Any time limit which is computed from the priority date (see Article 2(xi)) would be computed from the priority date of the divisional international application. A divisional international application would retain the right of priority of the initial international application, without the need to formally claim it in the divisional international application. The making of priority claims may, however, need to be regulated in the specific context of the PCT procedure, for example:

(i) by expressly providing that priority claims in the initial international application would be considered to be made in the divisional international application;

(ii) to deal with cases where priority claims are added or corrected under Rule 26bis.1 or withdrawn under Rule 90bis.3.

Competent receiving Office

22. Some specific provision may be needed as to the Offices which would be competent to receive divisional international applications. For example, should the matter be left to existing Rule 19, as for any international application, to govern the matter according to the nationality and residence of the applicant(s), or would it be preferable to somehow provide for filing of divisional international applications with the International Searching Authority or International Preliminary Examining Authority which had made a finding of lack of novelty of invention?

Designations

23. The filing of a request in respect of a divisional international application should presumably constitute the designation of all Contracting States that are designated in the initial international application on the date of receipt of the divisional international application by the receiving Office. It should not be possible, by filing a divisional international application, to add the designation of a Contracting State which was not designated in the initial international application at the time of filing the divisional international application.

Request Form

24. The request form would need to indicate the divisional international application as such and identify the initial international application from which the divisional international application derives (see Rules 4.1 and 4.11).

Language

25. It may be desirable to require that a divisional international application be filed in a language in which international search can be carried out and in which international publication can take place.

International Search

26. A number of specific provisions may need to be made in connection with the international search procedure for divisional international applications, including the matters outlined in subparagraphs (a) to (c).

(a) *Competent International Searching Authority*: In order to minimize duplication of work, it may be desirable to provide that the International Searching Authority which is to carry out, or has carried out, the international search on the initial international application should also be the sole competent International Searching Authority for any divisional international application.

(b) *Refund of search fees*: Rule 16.3 provides for the (partial) refund of international search fee where an international application claims the priority of an earlier international application which has been the subject of an international search. For consistency with this provision, the international search fee paid in connection with a divisional international application should be partially refunded where the international search report on that divisional international application can be wholly or partly based on the results of the international search carried out on the initial international application, due account being taken of any payment by the applicant of additional fees referred to in Article 17(3)(a)).

(c) *Remarksonpossible“doublepatenting”*: Inordertotoassistdesignatedand electedOfficesaswellasapplicant s,thewrittenopinionbytheInternationalSearching Authority(andhencetheinternationalpreliminaryreportonpatentabilityunderChapterI) couldincludeappropriateobservationswheretheclaimsofadivisionalinternational applicationoverlapwiththeclaimsintheinitialinternationalapplicationoranotherdivisional internationalapplicationderivingtherefrom.

InternationalPublication

27. ThegeneralruleunderPCTArticle 21isthataninternationalapplicationisp ublished promptlyaftertheexpirationof18monthsfromtheprioritydate.Thatwouldnotbepossible foradivisionalinternationalapplicationincaseswhereitisfiledafterthatperiod(see paragraph 18(b),above).ItwouldappeartobeconsistentwithArticle 21(2)(a)toprovidefor adivisionalinternationalapplicationtobepublishedpromptlyafterithadbeenfiled,butnot beforetheexpirationof18monthsfromtheprioritydate(asimilarapproachistakenunder somenationalandregionallaws,suchastheEuropeanPatentConvention).

InternationalPreliminaryExamination

28. Anumberofspecificprovisionsmayneedtobemadeinconnectionwiththe internationalpreliminaryexaminationprocedurefordivisionalinternationalapplications, dealing,forexample,withthematterssetoutinsubparagraphs (a)to (c).

(a) *Timelimitformakingademand*: Ademandinrespect ofadivisional internationalapplicationwould,ingeneral,havetobesubmittedwithintheapplicabletime limitunderRule 54bis.1inrespectoftheinitial internationalapplicationifthedeadlinefor theinternationalpreliminaryexaminationreportof28monthsfromtheprioritydateistobe met.Thatis,inpractice,thedemandwouldgenerallyneedtobefiledatthesametimeasthe divisionalinternationalapplication.Specialconsiderationmightbegiventocaseswherethe initialinternational applicationissubsequentlywithdrawn.

(b) *CompetentInternationalPreliminaryExaminingAuthority*: Inordertominimize duplicationofwork,itmaybedesirabletoprovidethattheInternationalPreliminary Examining Authoritywhichistocarryout,orhascarriedout,theinternationalsearchonthe initialinternationalapplicationshouldalsobethesolecompetentInternationalPreliminary ExaminingAuthorityforanydivisionalinternationalapplication.

(c) *Remarkson“doublepatenting”*: InordertotoassistdesignatedandelectedOffices aswellasapplicants,theinternationalpreliminaryreportonpatentabilityunderChapterII couldincludeappropriateobservationswheretheclaimsofadivisio nalinternational applicationoverlapwiththeclaimsintheinitialinternationalapplicationoranotherdivisional internationalapplicationderivingtherefrom.

“INTERNAL”DIVISIONOFINTERNATIONALAPPLICATIONSDURINGTHE INTERNATIONALPHASE

29. AnnexIIIcontainsaproposalwhichwouldgiveeffecttoaprocedurethatcouldbe introducedbywayofamendmentoftheRegulations,pendingafuturerevisionoftheTreaty asproposedinAnnexI,allowingforthe“internal”divisionofi nternationalapplications

during the international phase under Chapter II, to be followed by a simplified way of proceeding with the divided parts of the international application as separated divisional applications in the national phase.

30. The proposal is based on the fact that the present system enables the applicant, in the case of a finding of lack of unity of invention by the International Searching Authority or International Preliminary Examining Authority, to obtain an international search report or international preliminary examination report in respect of all parts of the international application, no matter how many inventions are contained in it, provided that additional (search and preliminary examination) fees are paid.

31. Under the proposal, instead of filing one or more divisional international applications during the international phase, the applicant would be permitted, after having made a demand for international preliminary examination, to amend the claims, the description and the drawings of an international application under Article 34(2)(b) by dividing the corpus of the international application internally into two or more separate parts, each containing the description, claims and drawings of the international application corresponding to a divisional application which would proceed as such into the national phase.

32. Following such an internal division of the international application, the international preliminary report on patentability under Chapter II would also be "internally" divided into corresponding different parts, provided that all additional search and preliminary examination fees have been paid.

33. Following such an internal division during the international preliminary examination procedure, the applicant would have "ready-made" divisional applications with which to proceed into the national phase. While that result could be achieved by proceeding into the national phase with the internally divided initial international application, to be followed by its division separately during the procedure before each national Office, it would be simpler to enable the initial international application to proceed into the national phase, from the outset, as separated divisional applications. Each such divisional application would be associated with the "divided" international preliminary report on patentability under Chapter II.

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

[Annexes follow]

ANNEXI

POSSIBLE REVISION OF THE PCT (TREATY): ²
DIVISIONAL INTERNATIONAL APPLICATIONS

Article 17 bis

Divisional International Applications

An international application (“initial international application”) may, as provided in the Regulations, be divided into one or more divisional applications (“divisional international applications”) in accordance with Article 4 G of the Paris Convention for the Protection of Industrial Property. A divisional international application shall, notwithstanding Article 11, preserve as its international filing date the international filing date of the initial international application and the benefit of the right of priority, if any.

[COMMENT: See paragraph 14 of the Introduction to this document. Modeled after Article 4 G of the Paris Convention. Consequential amendments of other Articles may be required, such as Articles 2 (Definitions), 8 (Claiming Priority) and 11 (Filing Date and Effect of International Application), and Articles concerning the international search procedure, international publication and communication to designated Offices, the international preliminary examination procedure and national phase entry.]

[Annex II follows]

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.

ANNEXII

POSSIBLE AMENDMENTS OF THE REGULATIONS: ³

DIVISIONAL INTERNATIONAL APPLICATIONS

Rule 30 bis

Divisional International Applications

30bis.1 Filing of Divisional International Applications

(a) The applicant may, subject to these Regulations, divide the international application (“initial international application”) by filing with the competent receiving Office one or more divisional applications as international applications (“divisional international applications”).

(b) A divisional international application may be filed where the International Searching Authority has made a finding of lack of unity of invention in relation to the initial international application or on the initiative of the applicant.

[COMMENT: See Article 4 of the Paris Convention.]

30bis.2 International Filing Date; Right of Priority

A divisional international application shall preserve as its international filing date the international filing date of the initial international application and the benefit of the right of

³ 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 30bis.2, continued]

priority, if any, as provided in Article 4 of the Stockholm Act of the Paris Convention for the
Protection of Industrial Property, provided that:

[COMMENT: See paragraph 18 of the Introduction to this document and Article 4 G of the Paris Convention.]

(i) the divisional international application is received by the receiving Office
before the expiration of the applicable time limit under Rule 54bis.1 for making a demand in
respect of the initial international application;

[COMMENT: See paragraphs 18(b) and 22 of the Introduction to this document.]

(ii) the initial international application is pending on the date of receipt of the
divisional international application by the receiving Office;

[COMMENT: See paragraph 20 of the Introduction to this document.]

(iii) the disclosure in the divisional international application does not go beyond the
disclosure in the initial international application as filed.

[COMMENT: See paragraph 18(a) of the Introduction to this document.]

[Annex III follows]

ANNEX III

POSSIBLE AMENDMENTS OF THE REGULATIONS: ⁴“INTERNAL” DIVISION OF INTERNATIONAL APPLICATIONS
DURING THE INTERNATIONAL PHASE

TABLE OF CONTENTS

| | |
|--|---|
| Rule 66 Procedure Before the International Preliminary Examining Authority | 2 |
| 66.1 [No change] | 2 |
| 66.2 <i>First Written Opinion of the International Preliminary Examining Authority</i> | 2 |
| 66.3 to 66.9 [No change] | 3 |
| Rule 68 Lack of Unity of Invention (International Preliminary Examination) | 4 |
| 68.1 to 68.5 [No change] | 4 |
| <u>68.6 <i>Internal Division of International Application</i></u> | 4 |
| Rule 70 The International Preliminary Examination Report | 5 |
| 70.1 to 70.11 [No change] | 5 |
| 70.12 <i>Mention of Certain Defects and Other Matters</i> | 5 |
| 70.13 <i>Remarks Concerning</i> <i>Unity of Invention</i> | 6 |

⁴

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 66⁵

Procedure Before the

International Preliminary Examining Authority

66.1 [No change]

66.2 *First Written Opinion of the International Preliminary Examining Authority*

(a) If the International Preliminary Examining Authority

(i) to (v) [No change]

(vi) considers that a claim relates to an invention in respect of which no international search report has been established and has decided not to carry out the international preliminary examination in respect of that claim, ~~or~~

(vii) considers that a nucleotide and/or amino acid sequence listing is not available to it in such a form that a meaningful international preliminary examination can be carried out, or

⁵ The “present” text shows that of Rule 66 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

[Rule 66.2(a), continued]

(viii) consider that, where an amendment which internally divides the international application into two or more separate parts has been submitted in accordance with Rule 68.6, one or more of the claims contained in one of those parts defines matter for which protection is sought in another of those parts,

the said Authority shall notify the applicant accordingly in writing. Where the national law of the national Office acting as International Preliminary Examining Authority does not allow multiple dependent claims to be drafted in a manner different from that provided for in the second and third sentences of Rule 6.4(a), the International Preliminary Examining Authority may, in case of failure to use that manner of claiming, apply Article 34(4)(b). In such case, it shall notify the applicant accordingly in writing.

[COMMENT: See paragraph 28(c) of the Introduction to this document.]

(b) to (e) [No change]

66.3 to 66.9 [No change]

Rule 68

Lack of Unity of Invention (International Preliminary Examination)

68.1 to 68.5 [No change]

68.6 Internal Division of International Application

[Where the International Preliminary Examining Authority finds that the requirement of
unity of invention is not complied and chooses to invite the applicant under Rule 68.2, or on
the applicant's own initiative, the applicant may internally divide the international
application by submitting, in accordance with Rule 66.1(b), an amendment under Article 34
which divides the description, claims and drawings of the international application into two or
more separate parts as follows:

(i) a main part containing the description, drawings and claims relating to the
main invention;

(ii) one or more additional parts, each containing the description, claims and
drawings relating to an invention additional to the main invention.

[COMMENT: See paragraphs 29 to 33 of the Introduction to this document.]

Rule 70⁶

The International Preliminary Examination Report

70.1 to 70.11 [No change]

70.12 *Mention of Certain Defects and Other Matters*

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

(i) [No change]

(ii) the international application calls for any of the observations referred to in Rule 66.2(a)(v) or (viii), it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;

[COMMENT: See paragraph 28(c) of the Introduction to this document and Rule 66.2 as proposed to be amended, above.]

(iii) and (iv) [No change]

⁶ The "present" text shown is that of Rule 70 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

70.13 ~~Remarks Concerning Unity of Invention~~

(a) If the applicant paid additional fees for the international preliminary examination, or if the international application or the international preliminary examination was restricted under Article 34(3), the report shall so indicate. Furthermore, where the international preliminary examination was carried out on restricted claims (Article 34(3)(a)), or on the main invention only (Article 34(3)(c)), the report shall indicate what parts of the international application were and what parts were not the subject of international preliminary examination. The report shall contain the indications provided for in Rule 68.1, where the International Preliminary Examining Authority chosen to invite the applicant to restrict the claims or to pay additional fees.

(b) Where the applicant has:

(i) submitted an amendment which divides the description, claims and drawings of the international application into a main part and one or more additional parts in accordance with Rule 68.6; and

(ii) paid additional fees for the international preliminary examination;

the report shall also be divided into a main part and as many additional parts as additional fees for the international preliminary examination have been paid; both the main part and each additional part shall comply with the requirements of Rule 70.

[COMMENT: See paragraphs 29 to 33 of the Introduction to this document.]

70.14 to 70.17 [No change]

Rule 78 bis

Internally Divided International Application to Proceed as

Separate Divisional Applications Before Elected Offices

78bis.1 Separate Divisional Applications

Where the applicant has, under Rule 68.6, internally divided the international application (“initial international application”) into two or more separate parts, the applicant may choose to proceed with [any of] those separate parts as separate applications so far as the procedure before any elected Office is concerned, specifying that those separate applications are to be considered as divisional applications of the initial international application, and the elected Offices shall proceed accordingly.

[COMMENT: See paragraph 33 of the Introduction to this document.]

[Annex IV follows]

ANNEXIV

EXCERPTS FROM THE
1968 DRAFT TREATY (PCT) AND THE
1968 DRAFT REGULATIONS UNDER THE PCT

Article 11
Filing Date and Effects of the International Application

(1) The Receiving Offices shall accord as the international filing date the date of receipt of the international application, provided that, at the time of receipt, that Office has found that:

- (i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the Receiving Office,
- (ii) the application is in the prescribed language,
- (iii) the subject of the application is not obviously outside the purview of this Treaty as defined in the Regulations, and
- (iv) at the time of receipt, the application contained at least the following elements:
 - (a) an indication that the application is intended as an international application,
 - (b) the name of the applicant,
 - (c) a part which on the face of it appears to be a description,
 - (d) a part which on the face of it appears to be a claim or claims.

(2) Any international application fulfilling the requirements of paragraph (1) shall have the effect of a regular national application in each designated State as of the international filing date.

(3) Any international application fulfilling the requirements listed in items (i) to (iv) of paragraph (1) shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property.

Article 17
Procedure Before the Searching Authority

(1) [...]

(2) [...]

(3)(a) If, in the opinion of the Searching Authority, the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant, at his option:

- (i) to restrict the claims, or
- (ii) depending on the invitation of the Searching Authority, to pay additional fees, or to divide the application, or both.

(b) [...]

Article 34 **Procedure Before the Preliminary Examining Authority**

(1) [...]

(2) [...]

(3) If, in the opinion of the Preliminary Examining Authority, the international application does not comply with the requirement of unity of invention as set forth in the Regulations, the said Authority may invite the applicant, at the latter's option, either to restrict the claims or to divide the application so as to comply with the requirement.

(4) [...]

Rule 37 **Lack of Unity of Invention (Search)**

37.1 Invitation to Restrict, Divide or Pay

(a) The invitation to restrict the claims or to divide the application provided for in Article 17(3)(a) shall specify at least one possibility of restriction or division which, in the opinion of the Searching Authority, would be in compliance with the applicable requirements.

(b) [...]

37.2 [...]

37.3 Timelimit

The timelimit provided for in Article 17(3)(b) shall be fixed, in each case, according to the circumstances of the case, by the Searching Authority; it shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

37.4 [...]

37.5 Procedure in the Case of Dividing the Application

(a) If the applicant chooses to divide the application, neither the description nor the drawings may be modified. They will remain the same for the parent application (that is, the international application as restricted) and the divisional applications.

(b) For the parent application, the applicant shall be required to specify the claims maintained or to file restricted claims, and to submit a new abstract when necessary.

(c) For each divisional application, the applicant shall be required to file a request, a claim or claims, and an abstract. The receiving Office shall, itself, attach to those papers a copy of the application in its original form, and the description and drawings (if any) thereof shall also be the description and drawings of each divisional application. The request of each divisional application shall identify the original application by its international application number and, where less than the totality of the description is relevant for the divisional application, a separate statement, submitted at the same time as the request, shall identify those portions of the description which are relevant.

(d) Each divisional application shall be treated as a new, independent international application, except that:

(i) the date of actual receipt of any divisional application by the receiving Office shall be certified by that Office on the record copy and on the search copy of such application;

(ii) the international filing date of the original application shall also be the international filing date of the divisional application, provided that the latter was filed with the receiving Office within the time limit fixed in Rule 37.3, and to the extent that it contains no new matter.

(e) If the parent application or any divisional application does not comply with the requirement of unity of invention, the Searching Authority shall proceed as provided in Article 17(3)(b).

37.6 [...]

37.7 *Voluntary Division*

(a) Subject to Rule 62.4, the applicant may divide the application on his own initiative any time before the expiration of the 16th month from the priority date. If the division takes place after the search report has been established, the communication of the search report and any publication thereof shall state that fact.

(b) The procedure provided for in Rule 37.5 shall apply also in the case of voluntary division.

Rule 62 **Lack of Unity of Invention (Preliminary Examination)**

62.1 *No Invitation to Restrict or Divide*

Where the Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses not to invite the applicant to restrict the claims or to divide the application, it shall establish the preliminary examination report, subject to Article 34(4)(b), in respect of the entire application, but shall indicate, in the said report, that, in its opinion, the requirement of unity of invention is not fulfilled and shall briefly indicate the reasons for this opinion.

62.2 *Invitation to Restrict or Divide*

Where the Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at the latter's option, to restrict the claims or to divide the application, it shall specify at least one possibility of restriction or division which, in the opinion of the Preliminary Examining Authority, would be in compliance with the applicable requirement. It shall, at the same time, fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation.

62.3 *Procedure in the Case of Division*

If the applicant chooses to divide the application, the procedure provided for in Rule 37.5 shall apply with the exception of paragraph (e) of that Rule.

62.3 *Voluntary Division*

(a) The applicant may divide the international application on his own initiative any time prior to the beginning of the preliminary examination but in no case after the expiration of the 16th month from the priority date.

(b) The procedure provided for in Rule 37.5, except paragraph (e) of that Rule, shall apply also in the case of voluntary division effected under paragraph (a).

[End of Annexes and of document]

WIPO



PCT/R/WG/5/7

ORIGINAL: English

DATE: September 10, 2003

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

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

Fifth Session

Geneva, November 17 to 21, 2003

RESTORATION OF THE RIGHT OF PRIORITY

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified [in document PCT/A/32/2] above, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."
2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will then cease to be provisional in nature.

BACKGROUND

3. The Committee on Reform of the PCT (“the Committee”), at its first and second sessions, and the Working Group, at its first, second, third and fourth sessions, considered proposals for amendment of the Regulations under the PCT¹ relating to the restoration of the right of priority. The reports of the sessions of the Committee and the summaries by the Chair of the sessions of the Working Group set out the status of the matters discussed by the Committee and the Working Group, respectively, noting the range of views expressed and areas where agreement had been reached, and identifying what future work needed to be undertaken (see documents PCT/R/1/26, paragraphs 72 to 76; PCT/R/2/9, paragraphs 111 to 123 and 125; PCT/R/WG/1/9, paragraphs 22 and 23; PCT/R/WG/2/12, paragraphs 54 to 56; PCT/R/WG/3/5, paragraphs 13 to 27; PCT/R/WG/4/14, paragraphs 35 to 44).

4. The Working Group’s discussions at its last (fourth) session (see document PCT/R/WG/4/14, paragraphs 35 to 44) are outlined in the following paragraphs:

“OPTIONS FOR RESTORATION OF THE RIGHT OF PRIORITY

“35. Discussions were based on document PCT/R/WG/4/1, which set out three options for provisions designed to allow for restoration of the priority right in the international and/or the national phase, as consistently as possible with the principle adopted in the PLT, and document PCT/R/WG/4/1 Add.1, which outlined the replies received in response to a questionnaire concerning the application of the criteria of “due care” and “unintentionality” under national practice in cases of restoration of rights. The three options covered in document PCT/R/WG/4/1 were the following:

Option A: “unintentionality” criterion (set out in Annex I of document PCT/R/WG/4/1);

Option B: “due care” criterion (also set out in Annex I of document PCT/R/WG/4/1);

Option C: retain priority claim for international phase leaving restoration for national phase (set out in Annex II of document PCT/R/WG/4/1).

“36. The question of restoration of the right of priority had been discussed at several previous meetings in the context of reform of the PCT. Although the Working Group agreed that providing for such restoration was important, there remained no consensus as to how this should be implemented in the PCT procedure.

“37. The Working Group agreed that several general principles needed to be recognized in any draft provisions allowing for restoration of the right of priority during the international phase. First, there was a need that a decision by a receiving

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. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

Office to restore a right of priority be recognized and given effect in designated Offices. Second, it needed to be clear that such a decision related only to the restoration, as such, of the right of priority and not to the ultimate validity of a priority claim in terms of substantive patent law, for example, as regards whether the subject matter of a claim was disclosed in the earlier application concerned. Third, a decision by a receiving Office refusing to restore a right of priority should not preclude the possibility that designated Offices might subsequently allow such restoration in the national phase.

“38. However, the Working Group remained divided as to whether the appropriate criterion for the restoration of a right of priority was that the failure to file the international application within the 12 month priority period was unintentional (as under Option A) or occurred in spite of due care having been taken (as under Option B), noting that those two alternatives were provided for under the PLT. A number of delegations expressed a preference for Option A and a slightly smaller number for Option B. Two delegations stated that the Offices in their countries had no experience with such restoration procedures and that they would need more time to consider the implications of the proposals in the context of their national laws. One of them requested that the possibility of making a reservation on the issue of restoration of the priority right be included.

“39. A large number of delegations stated that they could, at least by way of compromise, support provisions that would allow for a priority claim to be retained in the international application during the international phase, leaving a decision on restoration of the right of priority to be made separately by each designated Office during the national phase, as under Option C. However, several delegations opposed Option C, and some of the delegations that expressed support for it indicated that they would prefer a solution that would give greater certainty to applicants and minimize the need for restoration to be determined before separate designated Offices in the national phase. This might be achieved, for example, by combining certain elements from Options A, B and C. However, such a “combined” solution would necessarily require receiving Offices to apply one or other (or both) of the criteria referred to in Options A and B. Several delegations expressed concern at the possibility that Offices might be obliged to apply different criteria under different procedures, whether in respect of international applications (in the international phase in their capacity as receiving Offices and in the national phase in their capacity as designated Offices) and in respect of direct national filings. Some delegations queried in connection with Option C, in particular, whether a claimed priority date should be taken into account for the purposes of the international search and international preliminary examination where no decision on restoration was made during the international phase.

“40. The Working Group invited the International Bureau to prepare, for consideration at the next session, a draft proposal combining certain elements of Options A, B and C. A decision by the receiving Office to restore the right of priority would be binding on those designated Offices that applied the same or a less strict criterion. However, a designated Office that applied a stricter criterion than the receiving Office would not be bound by the receiving Office’s decision but would be permitted to decide the matter in the national phase based on its own criterion. In this connection, the Working Group noted that a decision to restore a right of priority based on the criterion of “due care” would be binding on designated Offices that applied the “unintentional” criterion. In any event, however, whatever criterion was

applied and whatever decision was made by the receiving Office, the priority claim would be retained in the application and would be used as the basis for computation of PCT time limits, as under Option C.

“41. One delegation suggested that, with a view to avoiding the need for certain Offices to apply different criteria in the international and national phases, consideration should be given to providing for the International Bureau to decide requests for restoration of the right of priority on a centralized basis. That suggestion was felt by several delegations to warrant further consideration but doubts were expressed by certain other delegations. The International Bureau noted that such a procedure could, if desired, be implemented by adapting the existing procedure under Rule 19.4, which already provided for the transmittal of international applications to the International Bureau as receiving Office in certain cases.

“42. Two delegations expressed concern that allowing for restoration of the right of priority could conflict with Article 8(2)(a), under which the conditions for, and effect of, any priority claim shall be as provided under the Paris Convention for the Protection of Industrial Property. It was noted that this concern needed to be borne in mind in the drafting of revised proposals.

“43. The Working Group noted the following suggestions made by delegations and representatives in respect of the proposals contained in Annexes I and II of document PCT/R/WG/4/1, to be taken into account by the International Bureau in preparing a revised proposal:

(a) The period for submitting a notice correcting the priority claim so as to comply with the requirements of Rule 4.10 should be subject to Rule 80.5 where that period expired on a non-working day (see Rule 26*bis*.2(b)).

(b) It should be ensured that the computation of time limits under proposed new Rule 80.8 would operate satisfactorily in relation to the time limit for performing the international search under Rule 42.1.

(c) Where the international application as filed did not claim the priority of the earlier application, the request for restoration of the right of priority should be accompanied by a notice adding the priority claim so as to comply with all the requirements of Rule 4.10 (see proposed new Rule 26*bis*.3(e)).

(d) In addition to the proposals contained in document PCT/R/WG/4/1, Rule 4 should be amended to enable the inclusion in the request form of a request for restoration of right of priority, at least where that request for restoration was on the ground of “unintentionality.”

(e) The importance of a prompt decision by the receiving Office under proposed new Rule 26*bis*.3(b) should be expressly reflected in the wording of the provisions.

(f) Information concerning a request for restoration should always be published together with the international application, that is, not only upon request made by the applicant (see proposed new Rule 26*bis*.3(g)(i)).

(g) Under Option C, a request to a designated Office for restoration of the right of priority should be made at the time of entry into the national phase or, at least, not later than the date on which the requirements under Article 22 must be complied with (see proposed new Rule 49^{ter}.1(b)).

“44. The Chair invited delegations and representatives to submit directly to the International Bureau, preferably via the PCT reform electronic forum on WIPO’s Website, any further comments or suggestions for the preparation of revised proposals concerning restoration of the right of priority.”

5. As invited by the Working Group, the International Bureau has prepared further revised proposals relating to the restoration of the right of priority. Annex I to the present document contains a draft proposal combining certain elements of the previous Option A (“unintentionality”), Option B (“due care”) and Option C (“retain priority claim for international phase leaving restoration for national phase”) as contained in document PCT/R/WG/4/1, Annexes I and II, taking account of the suggestions made by delegations and representatives of users at the fourth session (see document PCT/R/WG/4/14, paragraph 43). The main features of the draft proposal are represented in the flowchart appearing on page 6, below, and are outlined in the following paragraphs. Article 13 and Rule 14 of the PLT are reproduced, for ease of reference, in Annex II.

RETENTION OF PRIORITY CLAIM; RESTORATION OF RIGHT OF PRIORITY

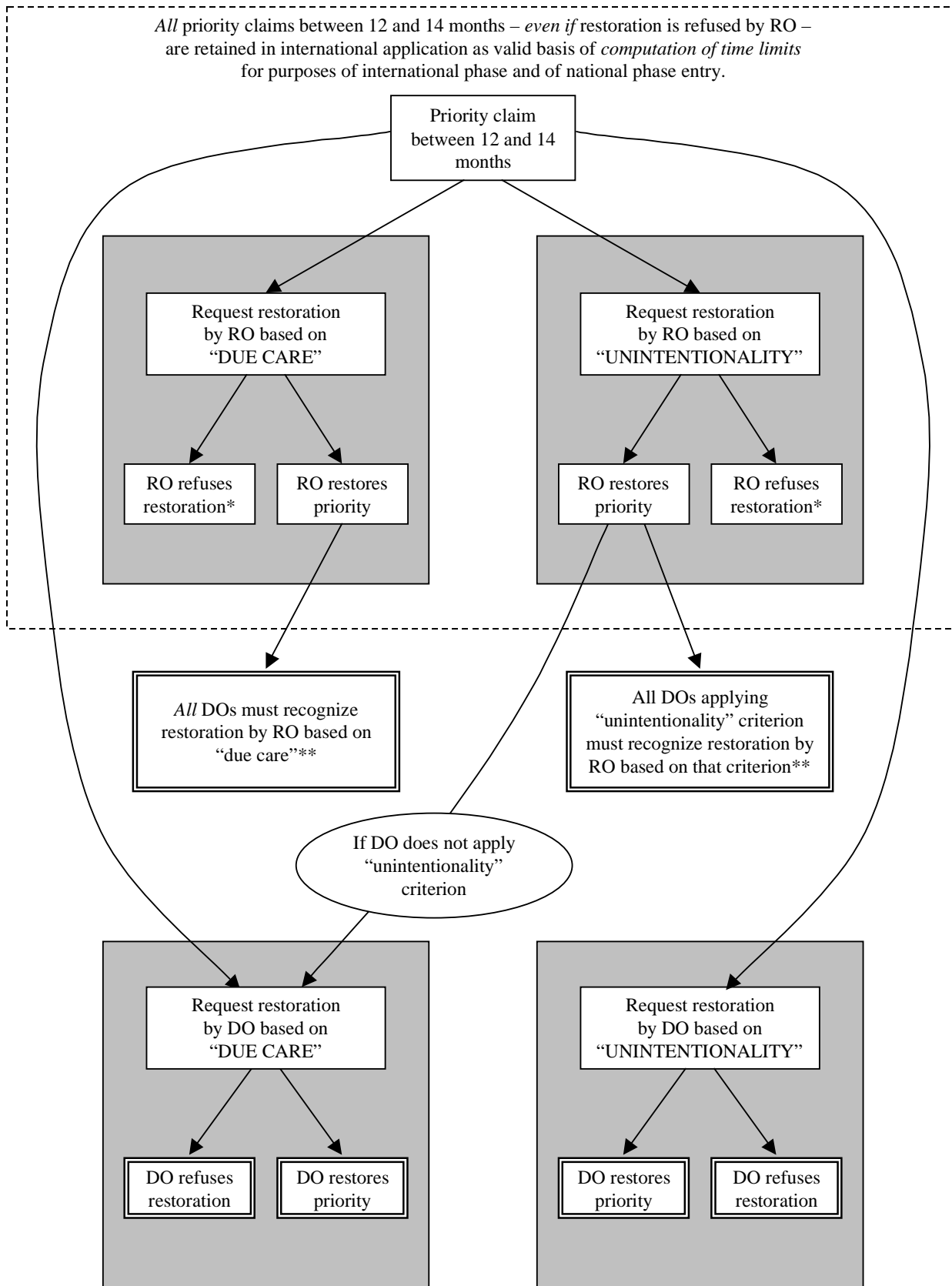
Automatic Retention of Priority Claim During International Phase

6. As under previous Option C, it is proposed to provide for the automatic retention, during the international phase, of a priority claim where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date. Such a priority claim would be retained irrespective of whether the applicant requests the receiving Office to restore the right of priority and even where such a request is made but refused by the receiving Office. In other words, such a priority claim would not be considered not to have been made (as would be the case under the present Regulations) and would therefore be taken into account during the international phase for the purposes of international search and international preliminary examination, and for the computation of time limits, including that for entry into the national phase.

Restoration of the Right of Priority by the Receiving Office during the International Phase

7. As under previous Options A and B, the applicant would have the possibility of requesting the receiving Office to restore the right of priority during the international phase. The receiving Office, when deciding on a request for restoration, would be free to apply either the more strict criterion of “due care” or the less strict criterion of “unintentionality.” Although not expressly stated in the proposed amended provisions, it is to be understood that a receiving Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a receiving Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. Those understandings could, if necessary, be expressed by the Assembly in amending the Regulations.

RESTORATION OF RIGHT OF PRIORITY



* Refusal by RO does not preclude a subsequent request to DO based on either criterion.

** Restoration by RO is subject to review by DO where reasonable doubt that requirements were met.

8. It would be advantageous for the applicant to obtain a positive finding by the receiving Office on the stricter criterion of “due care” since such a finding would be effective in all designated States, unlike a finding on the less strict “unintentionality” criterion (see paragraph 9, below).

Effect of Receiving Office Decision on Designated Offices

9. A decision by the receiving Office to restore a right of priority based on the criterion of “due care” would be effective in all designated States (subject to a transitional reservation provision). A decision by the receiving Office to restore a right of priority based on the criterion of “unintentionality” would be effective only in those designated States whose applicable national law provided for restoration of the right of priority based on that criterion.

Restoration of the Right of Priority by Designated Office during the National Phase

10. As under previous Option C, all designated Offices (including elected Offices) would be obliged to provide for the restoration of the right of priority in the national phase (subject to a transitional reservation provision). As under the PLT and the provisions applicable to the receiving Office mentioned above, the national law applicable by the designated Office would have to provide for the restoration of the right of priority either on the basis of the more strict criterion of “due care” or the less strict criterion of “unintentionality.” Although not expressly stated in the proposed amended provisions, it is to be understood that a designated Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a designated Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. Those understandings could, if necessary, be expressed by the Assembly in amending the Regulations.

11. In practice, of course, restoration of the right of priority by a designated Office during the national phase would only be necessary where the receiving Office had not already restored the right of priority with binding effect for the designated Office concerned.

12. *The Working Group is invited to consider the proposals contained in Annex I to this document.*

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

RESTORATION OF THE RIGHT OF PRIORITY

TABLE OF CONTENTS

| | | |
|---------------------|---|----|
| Rule 4 | The Request (Contents) | 2 |
| 4.1 | <i>Mandatory and Optional Contents; Signature</i> | 2 |
| 4.2 to 4.9 | [No change] | 2 |
| 4.10 | <i>Priority Claim</i> | 3 |
| 4.11 to 4.18 | [No change] | 3 |
| Rule 26bis | Correction or Addition of Priority Claim..... | 4 |
| 26bis.1 | [No change] | 4 |
| 26bis.2 | Invitation to Correct Defects in Priority Claims | 4 |
| <u>26bis.3</u> | <u>Restoration of Right of Priority by Receiving Office</u> | 7 |
| Rule 48 | International Publication..... | 10 |
| 48.1 | [No change] | 10 |
| 48.2 | <i>Contents</i> | 10 |
| 48.3 to 48.6 | [No change] | 12 |
| <u>Rule 49ter</u> | <u>Effect of Restoration of Priority Right by Receiving Office; Restoration of</u> <u>Right of Priority by Designated Office</u> | 13 |
| <u>49ter.1</u> | <u>Effect of Restoration of Priority Right by Receiving Office</u> | 13 |
| <u>49ter.2</u> | <u>Restoration of Right of Priority by Designated Office</u> | 15 |
| Rule 76 | <u>Application of Certain Rules to Procedures Before Elected Offices; Copy,</u> <u>Translation and Fee Under Article 39(1); Translation of Priority Document</u> | 18 |
| 76.1, 76.2 and 76.3 | [Remain deleted] | 18 |
| 76.4 | [No change] | 18 |
| 76.5 | Application of <u>Certain</u> Rules 22.1(g), 47.1, 49, 49bis and 51bis | 18 |
| 76.6 | [Remains deleted] | 18 |

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 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) and (ii) [No Change]

(iii) declarations as provided in Rule 4.17₂.

(iv) a request for restoration of the right of priority.

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 43(d). Upon consideration, it would not appear necessary to restrict paragraph (c)(iv) to requests for restoration on the ground of “unintentionality” but to also allow for the inclusion in the request form of a request for restoration on the ground of “due care.”]

(d) [No change]

4.2 to 4.9 [No change]

4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, ~~being a date falling within the period of 12 months preceding the international filing date;~~

[COMMENT: See Rule 26bis.2 as proposed to be amended, and the Comment thereon, below.]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 26bis

Correction or Addition of Priority Claim

26bis.1 [No change]

26bis.2 ~~Invitation to Correct~~ Defects in Priority Claims

[COMMENT: The proposed amendment of the title of Rule 26bis.2 is consequential on the proposed deletion of the reference to “invitation” in paragraph (b), below.]

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds:

(i) that a priority claim does not comply with the requirements of Rule 4.10; ~~or~~

(ii) that any indication in a priority claim is not the same as the corresponding indication appearing in the priority document; ~~or~~

(iii) that the international application has an international filing date which is later than the date on which the priority period expired;

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim or, in the case referred to in item (iii), where the international filing date is within two months from the date on which the priority period expired, to submit a request under Rule 26bis.3 for restoration of the right of priority.

[Rule 26bis.2(a), continued]

[COMMENT: The proposed amendment of Rules 4.10(a) (see above) and 26bis.2(a) is consequential on the proposed introduction into the PCT system of the possibility to request restoration of the right of priority. The wording of proposed new item (iii) is modeled on PLT Article 13(2) and PLT Rule 14(4)(a).]

(b) If, ~~in response to an invitation under paragraph (a),~~ the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim or, in the case referred to in paragraph (a)(iii), a request for restoration of the right of priority in accordance with Rule 26bis.3 ~~so as to comply with the requirements of Rule 4.10,~~ that priority claim shall, subject to paragraph (c), be canceled. Where a priority claim is canceled it shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly. ~~provided that a~~

[COMMENT: The proposed amendment of Rule 26bis.2(b) is consequential on the proposed introduction into the PCT system of the possibility to request restoration of the right of priority. See also paragraph (c) as proposed to be amended, below. With regard to the suggestion by one delegation concerning Rule 80.5 (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 43(a)), it would appear that no further amendment to paragraph (b) is needed since Rule 80.5 already applies to the expiration of the time limit under Rule 26bis.1(a).]

(c) A priority claim shall not be canceled ~~considered not to have been made~~ only because:

(i) the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing; ~~or because~~

[Rule 26bis.2(c), continued]

(ii) an indication in the priority claim is not the same as the corresponding indication appearing in the priority document; or

(iii) the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date.

[COMMENT: See paragraph 6 of the Introduction to this document.]

(d) ~~(e)~~ Where the receiving Office or the International Bureau has made a declaration under paragraph (b), the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning the priority claim which was anceled ~~considered not to have been made~~. A copy of that request shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

26bis.3 Restoration of Right of Priority by Receiving Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall restore the right of priority if:

(i) a request to that effect is submitted to the Office within a time limit of 14 months from the date on which the earlier application was filed;

(ii) the request states the reasons for the failure to file the international application within the priority period; and

(iii) the Office finds that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Office, was unintentional.

[COMMENT: See paragraph 7 of the Introduction to this document.]

(b) Where a priority claim in respect of the earlier application is not contained in the international application, the request referred to in paragraph (a)(i) shall be accompanied by a notice under Rule 26bis.1(a) adding the priority claim.

[COMMENT: See also the summary of the fourth session by the Chair, document PCT/R/WG/4/14, paragraph 43(c).]

[Rule 26bis.3, continued]

(c) The submission of a request under paragraph (a)(i) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration. The amount of that fee, if any, shall be fixed by the receiving Office.

[COMMENT: Earlier drafts provided for a fee for requesting restoration equal to 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets. Upon further reflection, and in view of the fact that the number of requests for restoration of the right of priority is likely to be small, it appears preferable to simplify the provision further by allowing the receiving Office to fix the fee, as in the case of the transmittal fee under Rule 14.1(b).]

(d) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (a)(ii) be filed with it within a time limit which shall be reasonable under the circumstances. The applicant may furnish to the International Bureau, and the International Bureau shall include in its files, a copy of any such declaration or other evidence filed with the receiving Office.

[COMMENT: See also Rule 48.2(b)(vii) as proposed to be added, below.]

(e) The receiving Office shall not refuse, totally or in part, a request under paragraph (a)(i) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[Rule 26bis.3, continued]

(f) The receiving Office shall promptly:

(i) notify the International Bureau of the receipt of a request under paragraph (a)(i):

(ii) make a decision upon the request;

[COMMENT: See the summary of the fourth session by the Chair, document PCT/R/WG/4/14, paragraph 43(e).]

(iii) notify the applicant and the International Bureau of its decision and of the criterion referred to in paragraph (a)(iii) upon which the decision was based.

(g) Each receiving Office shall inform the International Bureau as to which of the criteria referred to in paragraph (a)(iii) it is, in general, prepared to apply. The International Bureau shall promptly publish such information in the Gazette.

[COMMENT: So as to achieve a uniform approach to the question of restoration of the right of priority at least during the international phase, it is not proposed to provide for a transitional reservation provision in Rule 26bis.3 so as to permit receiving Offices to make a transitional reservation where the national law applied by the receiving Office is not compatible with other provisions of Rule 26bis.3, in particular, paragraph (a)(iii) (as was suggested in respect of a similar provision by one delegation during the third session of the Working Group; see the summary by the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraph 23).

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (ix) [No change]

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

(xi) any information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request, including information as to the criterion referred to in paragraph (a)(iii) upon which the decision was based.

[COMMENT: See the summary of the fourth session by the Chair, document PCT/R/WG/4/14, paragraph 43(f).]

[Rule 48.2, continued]

(b) Subject to paragraph (c), the front page shall include:

(i) to (iii) [No change]

(iv) where applicable, an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

[COMMENT: Clarification only.]

(v) where applicable, in connection with a request under Rule 26*bis*.3 for restoration of the right of priority, a reference to the fact that the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date;

(vi) where applicable, an indication that the pamphlet contains information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request;

[COMMENT: See Comment on proposed new Rule 48.1(a)(xi), above.]

[Rule 48.2(b), continued]

(vii) where applicable, an indication that the applicant has, under Rule 26bis.3(d), furnished copies of any declaration or other evidence to the International Bureau.

(c) to (i) [No change]

(j) If, at the time of completion of the technical preparations for international publication, a request under Rule 26bis.3 for restoration of the right of priority is still pending, the pamphlet shall contain, in place of the decision by the receiving Office upon that request, an indication to the effect that such decision was not available and that the decision (when it becomes available) will be separately published.

[COMMENT: The inclusion of a provision requiring republication would appear appropriate. The proposed wording is modeled in part on Rule 48.2(h).]

48.3 to 48.6 [No change]

Rule 49ter

Effect of Restoration of Priority Right by Receiving Office;

Restoration of Right of Priority by Designated Office

49ter.1 Effect of Restoration of Priority Right by Receiving Office

(a) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken, that restoration shall, subject to paragraph (c), be effective in each designated State.

[COMMENT: See paragraph 9 of the Introduction to this document. As regards a transitional reservation provision, see paragraph (e) and Rule 49ter.2(f), below.]

(b) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to paragraph (c), be effective in any designated State whose applicable national law provides for restoration of the right of priority based on that criterion.

[COMMENT: See paragraph 9 of the Introduction to this document. Restoration by the receiving Office would also be effective in any designated Office whose applicable national law provided for the restoration of the right of priority based on a criterion more favorable than the “unintentionality” criterion. A decision by the Assembly may be necessary to ensure that such understanding is agreed upon by all Contracting States. As regards a transitional reservation provision, see paragraph (e) and Rule 49ter.2(f), below.]

[Rule 49ter.1, continued]

(c) Where the receiving Office has restored a right of priority under Rule 26bis.3, any designated Office may review the decision of the receiving Office if it has reasonable doubts that a requirement applied by the receiving Office under that Rule was complied with. In such case, the designated Office shall notify the applicant accordingly, indicating the reasons for those doubts and giving the applicant an opportunity to make observations within a reasonable time limit.

(d) No designated Office shall be bound by a decision of the receiving Office refusing a request under Rule 26bis.3 for restoration of the right of priority.

(e) If, on [date of adoption of these modifications by the PCT Assembly], any provision of paragraphs (a) to (c) is not compatible with the national law applied by the designated Office, that provision shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: A designated Office whose applicable national law did not provide for the restoration of the right of priority at all or did provide for the restoration of the right of priority based on a more stringent criterion than the “due care” criterion would have to make use of the transitional reservation provision under paragraph (e) and also of the transitional reservation provision under Rule 49ter.2(f).]

49ter.2 Restoration of Right of Priority by Designated Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall restore the right of priority if:

(i) a request to that effect is submitted to the Office within a time limit of one month from the applicable time limit under Article 22;

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 43(g). Upon further consideration, it would appear reasonable to give the applicant at least one month from the applicable time limit under Article 22 to request restoration before the designated Office.]

(ii) the request states the reasons for the failure to file the international application within the priority period;

(iii) the Office finds that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Office, was unintentional.

[COMMENT: See paragraph 10 of the Introduction to this document.]

[Rule 49ter.2, continued]

(b) The designated Office:

(i) may require that a fee be paid in respect of a request under paragraph (a)(i);

(ii) may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (a)(ii) be filed within a time limit which shall be reasonable under the circumstances.

(c) The designated Office shall not refuse, totally or in part, a request referred to in paragraph (a)(i) for restoration of a right of priority without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

(d) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under paragraph (a), the designated Office shall, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under that paragraph.

(e) Each designated Office shall inform the International Bureau as to which of the criteria referred to in paragraph (a)(iii) it is, in general, prepared to apply or, where applicable, of the requirements of the national law applicable in accordance with paragraph (d). The International Bureau shall promptly publish such information in the Gazette.

[Rule 49ter.2, continued]

(f) If, on [date of adoption of these modifications by the PCT Assembly], any of the provisions of paragraph (a) is not compatible with the national law applied by the designated Office, that provision shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: Any designated Office whose national law provided for a criterion more stringent than the “due care” criterion or did not provide for restoration of the right of priority at all could make use of the transitional reservation provision under proposed new paragraph (f). Designated Offices whose applicable national law provided for the restoration of the right of priority based on requirements similar but not identical to the requirements under Rule 49ter.2(a) would not need to make use of the transitional reservation provision, provided the requirements under the applicable national law were, from the viewpoint of applicants, at least as favorable as the requirements under Rule 49ter.2(a). A decision by the Assembly may be necessary to ensure that such understanding is agreed upon by all Contracting States.]

Rule 76³

Application of Certain Rules to Procedures Before Elected Offices;

~~Copy, Translation and Fee Under Article 39(1);~~ Translation of Priority Document

[COMMENT: The proposed amendment of the title of this Rule is consequential on the proposed amendment of the subtitle of Rule 76.5 (see below).]

76.1, 76.2 and 76.3 [*Remain deleted*]

76.4 [No change]

76.5 Application of Certain Rules ~~22.1(g), 47.1, 49, 49bis and 51bis~~

[COMMENT: Clarification and simplification only.]

Rules 22.1(g), 47.1, 49, 49bis, 49ter and 51bis shall apply, provided that:

[COMMENT: The proposed amendment of Rule 76.5 is consequential on the proposed addition of new Rule 49ter.]

(i) to (v) [No change]

76.6 [*Remains deleted*]

[Annex II follows]

³ The “present” text shown is that of Rule 76 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

ANNEX II

ARTICLE 13 AND RULE 14 OF THE PATENT LAW TREATY (PLT)

Article 13

Correction or Addition of Priority Claim; Restoration of Priority Right

(1) [*Correction or Addition of Priority Claim*] Except where otherwise prescribed in the Regulations, a Contracting Party shall provide for the correction or addition of a priority claim with respect to an application (“the subsequent application”), if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations; and
- (iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

(2) [*Delayed Filing of the Subsequent Application*] Taking into consideration Article 15, a Contracting Party shall provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations;
- (iii) the request states the reasons for the failure to comply with the priority period; and
- (iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(3) [*Failure to File a Copy of Earlier Application*] A Contracting Party shall provide that, where a copy of an earlier application required under Article 6(5) is not filed with the Office within the time limit prescribed in the Regulations pursuant to Article 6, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit for filing the copy of the earlier application prescribed in the Regulations pursuant to Article 6(5);

(iii) the Office finds that the request for the copy to be provided had been filed with the Office with which the earlier application was filed, within the time limit prescribed in the Regulations; and

(iv) a copy of the earlier application is filed within the time limit prescribed in the Regulations.

(4) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) to (3).

(5) [*Evidence*] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(6) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Rule 14

Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13

(1) [*Exception Under Article 13(1)*] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed.

(2) [*Requirements Under Article 13(1)(i)*] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant.

(3) [*Time Limit Under Article 13(1)(ii)*] The time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(4) [*Time Limits Under Article 13(2)*] (a) The time limit referred to in Article 13(2), introductory part, shall expire not less than two months from the date on which the priority period expired.

(b) The time limit referred to in Article 13(2)(ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier.

(5) [*Requirements Under Article 13(2)(i)*] A Contracting Party may require that a request referred to in Article 13(2)(i):

(i) be signed by the applicant; and

(ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

(6) [*Requirements Under Article 13(3)*] (a) A Contracting Party may require that a request referred to in Article 13(3)(i):

(i) be signed by the applicant; and

(ii) indicate the Office to which the request for a copy of the earlier application had been made and the date of that request.

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the request referred to in Article 13(3) be filed with the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in Article 13(3)(iv) be filed with the Office within a time limit which shall be not less than one month from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.

(7) [*Time Limit Under Article 13(3)(iii)*] The time limit referred to in Article 13(3)(iii) shall expire two months before the expiration of the time limit prescribed in Rule 4(1).

[End of Annex II and of document]

WIPO



PCT/R/WG/5/8

ORIGINAL: English

DATE: September 10, 2003

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Fifth Session

Geneva, November 17 to 21, 2003

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

“MISSING PART” REQUIREMENTS

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), “that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified [in document PCT/A/32/2] above, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary.”

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will then cease to be provisional in nature.

BACKGROUND

3. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals designed to align the PCT with the requirements of the Patent Law Treaty (PLT), based on document PCT/R/WG/1/5.

4. Among the PLT-related proposals contained in document PCT/R/WG/1/5 were proposals to conform the PCT “missing part” requirements to those of the PLT (see document PCT/R/WG/1/5, Annex I). However, due to time constraints, a number of the proposals contained in document PCT/R/WG/1/5, including those related to “missing part” requirements, could not be discussed during the first session of the Working Group. Rather, the Working Group desired to give priority to those matters “which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities,” in particular, proposals concerning restoration of the right of priority and relief when time limits were missed, especially the time limit for entering the national phase (see the first session summary by the Chair, document PCT/R/WG/1/9, paragraph 21(v)).

5. For the second session of the Working Group, the International Bureau prepared a document outlining possible further PLT-related changes to the PCT, suggesting, in general, that those PLT-related proposals contained in document PCT/R/WG/1/5 which had not been discussed during the first session of the Working Group would not need to be addressed as matters of high priority. With regard to the proposal to conform the PCT “missing part” requirements to those of the PLT, as contained in Annex I to document PCT/R/WG/1/5, it was suggested that “[i]n light of the discussions at the first session of the Working Group, this proposal is considered to have a relatively low priority and will not be resubmitted for consideration by the Working Group until a later date” (see document PCT/R/WG/2/6, paragraph 9; the Working Group at its second session was unable in the time available to consider document PCT/R/WG/2/6 – see document PCT/R/WG/2/12, paragraph 59).

6. At its third session, the Working Group reviewed proposals for reform which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group was the proposal to conform the PCT “missing part” requirements to those of the PLT, as originally submitted to the Working Group in document PCT/R/WG/1/5. The Working Group agreed that the International Bureau should resubmit the proposals for further consideration by the Working Group (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 35 to 40, in particular, paragraph 38).

7. Further revised proposals relating to “missing part” requirements were prepared by the International Bureau for consideration by the Working Group at its fourth session (see document PCT/R/WG/4/2). The Working Group’s discussions at its fourth session (see document PCT/R/WG/4/14, paragraphs 45 to 71) are outlined in the following paragraphs:

“45. Discussions were based on document PCT/R/WG/4/2.

“*Existing Rules 20.8 and 20.9*

“46. The International Bureau explained that it was not proposed to delete existing Rules 20.8 and 20.9, which should have appeared in document PCT/R/WG/4/2 as

renumbered Rules 20.6 and 20.7, respectively. Further consequential amendments to both Rules would also be needed.

“Rule 20 – Title

“47. The proposed amendment of the title of Rule 20 was approved by the Working Group.

“Existing Rules 20.1 to 20.3

“48. The deletion of Rules 20.1 to 20.3 and the transfer of their contents to the Administrative Instructions were approved by the Working Group.

“Rule 20.1(d)

“49. The Working Group agreed that a decision of the Assembly should be sought, when the proposed amendments were submitted to it, so as to clarify that transitional reservations that had been made under existing Rule 20.4(d) would continue to be effective under that provision when renumbered as Rule 20.1(d).

“Rule 20.2(a) and (b)

“50. The deletion of Rule 20.2(a) and the transfer of its contents to the Administrative Instructions were approved by the Working Group. It was also agreed that the International Bureau should review the wording of Rule 20.2(b), consequential on such deletion.

“Rule 20.3(a)

“51. The amendment to change the reference to “Article 11(2)” to read “Article 11(2)(a)” was approved by the Working Group.

“Rule 20.3(b)

“52. The Working Group agreed that the International Bureau should review the wording of the provision in the light of a suggestion that this provision should additionally give the applicant the opportunity to make observations, consistent with existing Rule 20.8 and PLT Article 5(3).

“Rule 20.3(c)

“53. The Working Group agreed that proposed Rule 20.3(c) should be revised to provide that, where the outstanding requirement(s) under Article 11(1) were complied with after the time limit applicable under Rule 20.3(d) but before the receiving Office sent out a notification under Rule 20.4(i), the outstanding requirement(s) concerned should be considered to have been complied with before the expiration of that time limit, similarly to the provision in respect of the payment of fees under Rule 16*bis*.1(d).

“Rule 20.3(d)

“54. There was a clear division of opinion as to the time limit that should apply under this provision. Some delegations and representatives supported a two-month period in order to be consistent with the PLT. One representative also noted that a two-month period was desirable in countries in which difficulties with communications were experienced. Other delegations and representatives were in favor of a one-month period in view of the stringent time frames that governed the PCT procedure (for example, the requirement under Rule 22.1(a) that the record copy be transmitted in time for it to reach the International Bureau by the expiration of 13 months from the priority date). The Working Group noted that the amendment agreed to in respect of Rule 20.3(c) (see paragraph 53 above) would effectively extend the period under Rule 22.1(a).

“Rule 20.4

“55. One delegation suggested that this provision should also cover cases in which no observations from the applicant were received by the receiving Office within the applicable time limit. The delegation also suggested that the expression “the application is considered not to have been filed” (see Rule 20.4(i) as proposed to be amended) was inconsistent with Article 25 which provided for a review by designated Offices. One representative suggested the use of the words “is considered not to have been filed as an international application.” It was agreed that the International Bureau should review Rule 20.4 in the light of these suggestions.

“Rule 20.5(a)

“56. The Working Group agreed that, in general, proposed new Rule 20.5 should apply in cases where a missing part of the description, claims or drawings was furnished either before or after an international filing date had been accorded, so that the Rule could result in either the first according of an international filing date or the correction of an international filing date that had already been accorded, depending on the circumstances.

“57. The Working Group agreed that a restriction should be added to Rule 20.5(a) with regard to the requirement for the receiving Office to invite the applicant to furnish any missing part, similar to PLT Article 5(5), which is restricted to the situation where the Office notices the apparent omission of a part of the description or drawing “in establishing the filing date.” In this context, reference was made to Note 5.19 of the Explanatory Notes on PLT Article 5. The Working Group also discussed the possibility of including an outer time limit under this provision (which could perhaps be fixed to be consistent with the time limit for acting under Article 14(4)).

“58. The Working Group agreed that proposed new Rule 20.5(a) should be reviewed with a view to putting it beyond doubt as to the cases in which it applied, that is, in the case of a missing part of the description, a missing part of a claim or of the claims (including the case where an entire claim was missing), and a missing part of a drawing or of the drawings (including the case where an entire drawing was missing). The operation of the Rule in relation to the minimum requirements for according an international filing date under Article 11(1)(iii)(d) and (e) relating to the description and claims also needed to be clear, as well as in relation to the specific provisions of Article 14(2) concerning references in the international application to missing drawings.

“Rule 20.5(b)

“59. The Working Group noted that the reference in Rule 20.5(b) to “paragraphs (e) and (f)” should be corrected to read “paragraphs (d) and (e).”

“60. The Working Group agreed that a provision should be added, in Rule 20.5(b) or elsewhere, so as to require the receiving Office to promptly notify the applicant and the International Bureau of the international filing date accorded or corrected under Rule 20.5.

“Rule 20.5(c)

“61. The Working Group noted that, although the considerations were not exactly the same, the clear division of opinion under Rule 20.3(d) as to whether the time limit should be one or two months also existed under this provision.

“62. In response to a suggestion that the time limit under this provision should be calculated from the date of receipt of the invitation, the Working Group noted that the general regime under the PCT was that time limits in such cases were calculated from the date on which the invitation was sent and that any change in this respect would therefore need to be considered in the context of that general regime.

“63. The Working Group noted that the word “an” should be deleted in the first line of Rule 20.5(c)(ii).

“Rule 20.5(d)

“64. The Working Group agreed that, in order to ensure that the applicant had sufficient time to take advantage of this provision, the time limit for requesting that a missing part furnished under Rule 20.5(b) be disregarded should be one month from the date on which the applicant was notified of the change of international filing date under that Rule.

“Rule 20.5(e)

“65. The Working Group noted that the reference in the chapeau to “the time limit under paragraph (b)” should be changed to “the time limit under paragraph (c).” In item (iii), the word “in” should be inserted before the words “the same language.” In item (iv), the reference to “item (iv)” should be changed to “item (iii).”

“66. Two delegations and one representative expressed concern that the proposed requirement, presented in square brackets, “on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, [the international application contained an indication that the contents of the earlier application were incorporated by reference in the international application]” would impose an unnecessary (formality) requirement, limiting the situations where missing parts could be filed without loss of the international filing date. The Working Group noted that the requirement was consistent with an optional requirement under PLT Rule 2(4)(v) and that, without such a requirement, in so far as it related to missing drawings, the provision could be considered to conflict with Article 14(2) which prescribed the procedure to be applied where drawings were furnished after an

international filing date had been accorded. Although it was agreed that the inclusion in the request of a pre-printed statement that the contents of earlier application(s) the priority of which was claimed was included by reference appeared to be undesirable, it was suggested that such a pre-printed statement might be restricted to incorporation by reference *for the purposes of Rule 20.5(e)*, for example, using wording similar to that used in present Rule 4.9(b) with regard to “precautionary” designations in the request. The Working Group invited the Secretariat to review Rule 20.5(e) in the light of these considerations. The Secretariat also invited delegations and representatives to submit suggestions on the electronic forum.

“67. In response to a concern of one delegation and one representative, the Working Group invited the Secretariat to consider whether the copy of the earlier application furnished under item (ii) should be certified, taking account of the corresponding provisions under PLT Rule 2(4)(i) and (ii) which provide for the certified copy to be furnished later.

“68. In response to a concern of one delegation, the Working Group noted that the obligation was on the applicant to establish where in the earlier application(s) the “missing part” was contained and agreed that the following text should be deleted from the Comment on the item: “; it would thus appear that the receiving Office would be required to compare the missing part furnished later with the “missing part” as contained in the earlier application.”

“Rule 26

“69. The Working Group agreed that the wording of Rule 26.1 as proposed to be amended should be further amended so as to “give the applicant the opportunity” to make observations rather than “inviting” the applicant to do so.

“70. The Working Group agreed that Rule 26.5(b)(i) as proposed to be amended should be further amended so as to take into account that the time limit fixed under Rule 26.2 may be extended by the receiving Office. The Working Group agreed further that Rule 26.2(b)(ii) should be reviewed with a view to its possible deletion, noting that Article 14(2) required the sending of an invitation to correct as a condition for considering the application withdrawn where the applicant failed to correct the international application within the prescribed time limit.

“Existing Rule 20.8

“71. One delegation suggested that the provisions of existing Rule 20.8 be split into two separate provisions: one provision would cover the situation in which the receiving Office realized itself that it had made an error, and the other provision would cover the situation in which the receiving Office only realized that it had made an error after this had been pointed out to it by the applicant. The Working Group agreed that the International Bureau should consider whether the provision should be split and where in Rule 20 the provision(s) should be included.”

CONFORM PCT “MISSING PART” REQUIREMENTS TO THOSE OF THE PLT

8. The present document contains revised texts of the proposals related to “missing part” requirements contained in the Annex to document PCT/R/WG/4/2. The proposals have been further revised so as to take into account the discussions and agreements reached at the fourth session of the Working Group as summarized in paragraph 7, above. As in the case of the proposals contained in document PCT/R/WG/4/2, the further revised proposals take into account, as was suggested in document PCT/R/WG/2/6, that there is no intention to proceed, until a future session of the Working Group, with certain other PLT related proposals which were also contained in Annex I to document PCT/R/WG/1/5, such as proposals to align the PCT filing date requirements with regard to claims, “drawing as description,” and replacement of description and drawing by reference to previously filed application to those of the PLT.

Structure of Rule 20

9. In the context of “missing part” requirements, it is proposed to revise Rule 20 so as to move to the Administrative Instructions matters of detail related to the stamping of dates, etc., which are presently dealt with in Rules 20.1 to 20.3, and to leave the Rule to deal with the more significant question of the according of the international filing date. The existing provisions of the Rule would be renumbered accordingly. A new provision would be added as Rule 20.3(c) and (d) dealing with the question of subsequent compliance with Article 11(1). Rule 20.5 as amended would deal with missing parts, including the case where the missing part is completely contained in an earlier application the priority of which is claimed (see below). The proposed amendments would align the order of the provisions dealing with the according of the international filing date with the (logical) order in which a receiving Office determines whether and which date to accord as the international filing date.

International filing date where missing part is filed

10. Under PLT Article 5(6)(a), later submission (within certain time limits) of a missing part of the description or a missing drawing results in according as the filing date the date on which the Office has received the missing part of the description or the missing drawing, or the date on which all the filing date requirements are complied with, whichever is later. The same principle is applied under the PCT where sheets (description, claims, drawings) pertaining to the same application are not received on the same day. However, while the Treaty (PCT Article 14(2)) expressly deals with the case of missing drawings, neither the Treaty nor the Regulations specifically deal with the according (or correction) of an international filing date where sheets other than missing drawings are received later than the date on which papers were first received. This matter is expressly dealt with only in the Administrative Instructions (see Section 309 of the Administrative Instructions) and in the Receiving Office Guidelines (see paragraphs 200 to 207 of the Receiving Office Guidelines). In order to clarify the procedure, it is proposed to deal with this important matter in the Regulations (rather than in the Administrative Instructions and the Receiving Office Guidelines) and to amend Rule 20 accordingly (see Rule 20.5 as proposed to be amended).

International filing date where missing part is completely contained in earlier application

11. The main difference between the “missing part” requirements of the PLT and those of the PCT is that, under the PLT, the applicant can rectify the omission, at the time of filing, of a part of the description or of a drawing without loss of the filing date if the application claims the priority of an earlier application and the missing part of the description or the missing drawing is completely contained in that earlier application (see PLT Article 5(6) and PLT Rule 2(3) and (4)). There is no equivalent provision in the PCT. It is proposed to amend the PCT Regulations by adding new Rule 20.5(e) so as to align PCT requirements to those of the PLT.

Alignment of certain related requirements under the PCT with those under the PLT

12. In the context of “missing part” type requirements, it is also proposed to align certain related requirements under the PCT with those under the PLT, in particular time limits for compliance with non-filing date related requirements (see Rule 26 as proposed to be amended).

13. 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:
 “MISSING PART” REQUIREMENTS

TABLE OF CONTENTS

| | | |
|-----------------------------|---|----|
| Rule 4 | The Request (Contents) | 2 |
| 4.1 | <i>Mandatory and Optional Contents; Signature</i> | 2 |
| 4.2 to 4.17 | [No change] | 2 |
| <u>4.18</u> | <u><i>Statement for the Purposes of Rule 20.5(e)</i></u> | 3 |
| <u>4.19</u> 4.18 | <u><i>Additional Matter</i></u> | 3 |
| Rule 12 | Language of the International Application and Translation for the Purposes of International Search and International Publication | 4 |
| 12.1 and 12.2 | [No change] | 4 |
| 12.3 | <i>Translation for the Purposes of International Search</i> | 4 |
| Rule 20 | <u>International Filing Date</u> Receipt of the International Application | 5 |
| 20.1 | <i>Date and Number</i> | 5 |
| 20.2 | <i>Receipt on Different Days</i> | 5 |
| 20.3 | <i>Corrected International Application</i> | 6 |
| <u>20.1</u> 20.4 | <u><i>Determination Under Article 11(1)</i></u> | 6 |
| <u>20.2</u> 20.5 | <u><i>Positive Determination Under Article 11(1)</i></u> | 7 |
| <u>20.3</u> 20.6 | <u><i>Correction Under Article 11(2)</i></u> <i>Invitation to Correct</i> | 8 |
| <u>20.4</u> 20.7 | <u><i>Negative Determination Under Article 11(1)</i></u> | 11 |
| <u>20.5</u> | <u><i>Missing Part of Description, Claims or Drawings</i></u> | 12 |
| <u>20.6</u> 20.8 | <u><i>Error by the Receiving Office</i></u> | 17 |
| <u>20.7</u> 20.9 | <u><i>Certified Copy for the Applicant</i></u> | 18 |
| Rule 22 | Transmittal of the Record Copy and Translation | 19 |
| 22.1 | <i>Procedure</i> | 19 |
| 22.2 and 22.3 | [No change] | 19 |
| Rule 26 | Checking by, and Correcting Before, the Receiving Office of Certain Elements of the International Application | 20 |
| 26.1 | <u><i>Invitation Under Article 14(1)(b) to Correct</i></u> <i>Time limit for Check</i> | 20 |
| 26.2 | <i>Time Limit for Correction</i> | 20 |
| 26.2bis to 26.3bis | [No change] | 21 |
| 26.3ter | <i>Invitation to Correct Defects Under Article 3(4)(i)</i> | 21 |
| 26.5 | <i>Decision of the Receiving Office</i> | 22 |
| 26.6 | <i>Missing Drawings</i> | 23 |
| Rule 51 | Review by Designated Offices | 24 |
| 51.1 | <i>Time Limit for Presenting the Request to Send Copies</i> | 24 |
| 51.2 | <i>Copy of the Notice</i> | 24 |
| 51.3 | [No change] | 24 |

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) and (ii) [No change]

(iii) declarations as provided in Rule 4.17.

(iv) a statement as provided in Rule 4.18.

[COMMENT: The proposed addition of item (iv) is consequential on the proposed addition of new Rule 4.18, below. See also Comment on proposed new Rule 20.5(e), below.]

(d) [No change]

4.2 to 4.17 [No change]

4.18 Statement for the Purposes of Rule 20.5(e)

The request may contain a statement, for the purposes of Rule 20.5(e), that the contents of any earlier application whose priority is claimed in the international application are incorporated by reference in the international application, subject to confirmation by a written notice submitted to the receiving Office before the expiration of the applicable time limit under Rule 20.5(c), and that any statement which is not so confirmed before the expiration of that time limit is to be considered as if it had not been made.

[COMMENT: See Comment on Rule 20.5(e) below). New Rule 4.18 is modeled in part on paragraph (b) of present Rule 4.9.]

4.19 ~~4.18~~ *Additional Matter*

(a) The request shall contain no matter other than that specified in Rules 4.1 to 4.18 ~~4.17~~, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.

(b) If the request contains matter other than that specified in Rules 4.1 to 4.18 ~~4.17~~ or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall *ex officio* delete the additional matter.

[COMMENT: The renumbering is consequential on the proposed addition of new Rule 4.18 (see above). See also Comment on proposed Rule 20.5(e), below.]

Rule 12

**Language of the International Application and Translation
for the Purposes of International Search and International Publication**

12.1 and 12.2 [No change]

12.3 *Translation for the Purposes of International Search*

(a) and (b) [No change]

(c) Where, by the time the receiving Office sends to the applicant the notification under Rule [20.2\(c\)](#) ~~20.5(e)~~, the applicant has not furnished a translation required under paragraph (a), the receiving Office shall, preferably together with that notification, invite the applicant:

[COMMENT: The renumbering is consequential on the proposed renumbering of present Rule 20.5, below.]

(i) and (ii) [No change]

(d) and (e) [No change]

12.4 [No change]

Rule 20

International Filing Date

Receipt of the International Application

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraphs 47 and 48.]

~~20.1—Date and Number~~

~~(a) Upon receipt of papers purporting to be an international application, the receiving Office shall indelibly mark the date of actual receipt on the request of each copy received and the international application number on each sheet of each copy received.~~

~~(b) The place on each sheet where the date or number shall be marked, and other details, shall be specified in the Administrative Instructions.~~

~~20.2—Receipt on Different Days~~

~~(a) In cases where all the sheets pertaining to the same purported international application are not received on the same day by the receiving Office, that Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the papers completing the international application were received, provided~~

~~(i) where no invitation under Article 11(2)(a) to correct was sent to the applicant, the said papers are received within 30 days from the date on which sheets were first received;~~

~~(ii) where an invitation under Article 11(2)(a) to correct was sent to the applicant, the said papers are received within the applicable time limit under Rule 20.6;~~

~~(iii) in the case of Article 14(2), the missing drawings are received within 30 days from the date on which the incomplete papers were filed;~~

~~(iv) the absence or later receipt of any sheet containing the abstract or part thereof shall not, in itself, require any correction of the date marked on the request.~~

~~(b) Any sheet received on a date later than the date on which sheets were first received shall be marked by the receiving Office with the date on which it was received.~~

~~20.3 *Corrected International Application*~~

~~In the case referred to in Article 11(2)(b), the receiving Office shall correct the date marked on the request (still leaving legible, however, the earlier date or dates already marked) so that it indicates the day on which the last required correction was received.~~

20.1 ~~20.4~~ *Determination Under Article 11(1)*

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 49. Apart from the renumbering, no change is proposed to the present Rule, but the text is reproduced below for convenient reference.]

(a) [No change] Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers comply with the requirements of Article 11(1).

[Rule 20.1, continued]

(b) [No change] For the purposes of Article 11(1)(iii)(c), it shall be sufficient to indicate the name of the applicant in a way which allows his identity to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

(c) [No change] For the purposes of Article 11(1)(ii), it shall be sufficient that the part which appears to be a description (other than any sequence listing part thereof) and the part which appears to be a claim or claims be in a language accepted by the receiving Office under Rule 12.1(a).

(d) [No change] If, on October 1, 1997, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.

20.2 ~~20.5~~ *Positive Determination* *Under Article 11(1)*

[COMMENT: Renumbering and clarification of the title only.]

(a) If the determination under Article 11(1) is positive, the receiving Office shall stamp ~~on~~ the request as prescribed by the Administrative Instructions. ~~the name of the receiving Office and the words “PCT International Application,” or “Demande internationale PCT.”~~ If

[Rule 20.2(a), continued]

~~the official language of the receiving Office is neither English nor French, the words “International Application” or “Demande internationale” may be accompanied by a translation of these words in the official language of the receiving Office.~~

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 50. Paragraphs (b) and (c) are not proposed to be amended but the text is reproduced below for convenient reference.]

(b) [No change] The copy whose request has been so stamped shall be the record copy of the international application.

(c) [No change] The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

20.3 ~~20.6~~ *Correction Under Article 11(2) Invitation to Correct*

(a) The invitation to correct under Article 11(2)(a) shall specify the requirement provided for under Article 11(1) which, in the opinion of the receiving Office, has not been fulfilled.

[Rule 20.3(a), continued]

[COMMENT: Renumbering and clarification only. See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 51.]

(b) The receiving Office shall send the invitation referred to in paragraph (a) promptly. In the invitation, the receiving Office shall invite ~~shall mail the invitation to~~ the applicant to furnish the required correction, and to make observations, if any, within the time limit under paragraph (d)(i) ~~and shall fix a time limit, reasonable under the circumstances of the case, for filing the correction. The time limit shall not be less than 10 days, and shall not exceed one month, from the date of the invitation.~~ If that ~~such~~ time limit expires after the expiration of 12 months ~~one year~~ from the filing date of any application whose priority is claimed, the receiving Office shall ~~may~~ call this circumstance to the attention of the applicant.

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 52. It is also proposed to change the term “one year” to “12 months” for consistency with Rule 4.10(a)(i) and Article 4(C)(1) of the Paris Convention.]

(c) Where one or more of the requirements under Article 11(1) are not complied with at the time of receipt of the purported international application but are complied with on a later date falling within the applicable time limit under paragraph (d), the international filing date shall, subject to Rule 20.5, be that later date and the receiving Office shall proceed as provided in Rule 20.2.

[Rule 20.3(c), continued]

[COMMENT: See PLT Article 5(4). It is proposed to add new paragraphs (c) and (d) so as to clarify the procedure with regard to the according of the international filing date in case of subsequent compliance with Article 11(1) requirements, in particular in view of proposed new Rule 20.5 (according of the international filing date in case a missing part or missing drawing is filed, including the case that a missing part or missing drawing is completely contained in the earlier application the priority of which is claimed; see below).]

(d) The time limit referred to in paragraphs (b) and (c) shall be:

(i) where an invitation referred to in paragraph (a) was sent to the applicant, [one month] [two months] from the date of the invitation;

[COMMENT: See PLT Article 5(3) and PLT Rule 2(1). The time limit has been retained in square brackets for further consideration by the Working Group (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 54).]

(ii) where no invitation referred to in paragraph (a) was sent to the applicant, [one month] [two months] from the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office.

[COMMENT: See PLT Article 5(4) and PLT Rule 2(2). While the PLT provides for the time limit under item (ii) only in cases where no invitation was sent to the applicant “because indications allowing the applicant to be contacted by the Office have not been filed”, it is proposed to apply that time limit to all cases where no invitation has been sent to the applicant. The time limit has been retained in square brackets for further consideration by the Working Group (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 54).]

20.4 ~~20.7~~ *Negative Determination* Under Article 11(1)

(a) If the receiving Office does not ~~;~~ receive a correction under Article 11(2) within the applicable ~~prescribed~~ time limit under Rule 20.3(d), ~~receive a reply to its invitation to correct,~~ or if ~~a~~ the correction is furnished ~~offered~~ by the applicant but the application still does not fulfill the requirements provided for under Article 11(1), the receiving Office ~~it~~ shall:

[COMMENT: Consequential on the proposed amendment of present Rule 20.6 (renumbered Rule 20.3) and the proposed addition of new Rule 20.3(c) and (d). At the fourth session of the Working Group, one delegation suggested that this provision should also cover cases in which no observations from the applicant were received by the receiving Office within the applicable time limit (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 55). However, it is not proposed to follow this suggestion since Article 11(2) refers only to the filing and the receipt of the “required correction.” Rule 20.8 (renumbered 20.6, see below) would apply should the receiving Office, on the basis of the applicant’s “observations,” realize that it has erred in issuing an invitation to correct since the requirements under Article 11(1) were fulfilled when the papers were first received.]

(i) promptly notify the applicant that the ~~his~~ application is not and will not be treated as an international application and shall indicate the reasons therefor,

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 55. Upon further consideration, it is not any longer proposed to amend item (i) so as to align the terminology with that used in PLT Article 5(4)(b). Items (ii) to (iv) are not proposed to be amended but are reproduced below for convenient reference.]

(ii) [No change] notify the International Bureau that the number it has marked on the papers will not be used as an international application number,

[Rule 20.4(a), continued]

(iii) [No change] keep the papers constituting the purported international application and any correspondence relating thereto as provided in Rule 93.1, and

(iv) [No change] send a copy of the said papers to the International Bureau where, pursuant to a request by the applicant under Article 25(1), the International Bureau needs such a copy and specially asks for it.

(b) Any correction under Article 11(2) received by the receiving Office after the expiration of the applicable time limit under Rule 20.3(d) but before that Office sends a notification to the applicant under paragraph (a)(i) shall be taken into account in determining whether the papers purporting to be an international application comply with the requirements under Article 11(1).

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 53. Note that the date of actual receipt of the required correction would be accorded as the international filing date even if the required correction was received after the expiration of the applicable time limit under Rule 20.3(d).]

20.5 Missing Part of Description, Claims or Drawings

(a) Where, in determining whether the papers purporting to be an international application comply with the requirements under Article 11(1), the receiving Office finds that any of the following parts of the application appears to be missing from the international application (“missing part”):

[Rule 20.5(a), continued]

(i) a part of the description;

(ii) a part of the claim where there is only one claim;

(iii) a part of a claim or claims where there are several claims, including the case where an entire claim or entire claims appear to be missing;

(iv) a part of a drawing or of the drawings, including the case where an entire drawing or entire drawings appear to be missing;

that Office shall promptly invite the applicant to furnish the missing part (if any), and to make observations, if any, within the time limit under paragraph (c)(i). If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call this circumstance to the attention of the applicant.

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraphs 57 and 58. It does not appear necessary, as discussed by the Working Group at its fourth session, additionally to include an outer time limit under this provision.]

[Rule 20.5, continued]

(b) Where the applicant furnishes a missing part to the receiving Office within the applicable time limit under paragraph (c), that part shall be included in the international application and, subject to paragraphs (d) and (e), the international filing date shall be the date on which the receiving Office received that missing part or the date on which all of the requirements of Article 11(1) are complied with, whichever is later.

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 56.]

(c) The time limit referred to in paragraphs (a) and (b) shall be:

(i) where an invitation referred to in paragraph (a) was sent to the applicant, [one month] [two months] from the date of the invitation;

(ii) where no invitation referred to in paragraph (a) was sent to the applicant, [one month] [two months] from the date on which one or more elements referred to in Article 11(1) were first received by the receiving Office.

[COMMENT: With regard to the applicable time limit, see PLT Article 5(6) and PLT Rule 2(3)(i) and (ii). The time limits have been retained in square brackets for further consideration by the Working Group (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 61).]

(d) Where, in accordance with paragraph (b), the receiving Office has accorded as the international filing date, or has corrected the international filing date to, the date on which the receiving Office received the missing part and has notified the applicant accordingly under

[Rule 20.5(d), continued]

paragraph (f), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (f), request that the missing part be disregarded, in which case the missing part shall be considered not to have been furnished and the international filing date shall be the date on which all of the requirements of Article 11(1) are complied with.

[COMMENT: See PLT Article 5(6)(c). See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 64. The proposed wording (“request to disregard”) differs from that used in the PLT (“withdraw”) so as to avoid confusion with withdrawals under Rule 90bis.)]

(e) Where the international application, on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, claims the priority of an earlier application and the applicant furnishes a missing part under paragraph (b), the international filing date shall, upon request of the applicant submitted to the receiving Office within the applicable time limit under paragraph (c), be the date on which all the requirements of Article 11(1) are complied with, provided that:

[COMMENT: See the summary of the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 66.]

(i) a copy of the earlier application is furnished to the receiving Office within the applicable time limit under paragraph (c);

[COMMENT: See PLT Rule 2(4)(i). Upon further review by the International Bureau, as invited by the Working Group (see the summary of the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 67), the present draft retains the proposal, as was contained in document PCT/R/WG/4/2, not to include in paragraph (b) a requirement, as permitted under PLT Rule 2(4)(ii), that the applicant, upon invitation by the

[Rule 20.5(e)(i), continued]

Office, must file a certified copy of the earlier application (the “priority document”), in addition to the “simple” copy of the earlier application required to be furnished. The furnishing of a “simple” copy of the earlier application would appear sufficient for the purposes of the international phase; the consequences in case of any discrepancies between the “simple” copy and the certified copy of the earlier application would have to be dealt with in the national phase.]

(ii) where the earlier application is not in the same language accepted by the receiving Office under Rule 12.1(a) as the international application, a translation of the earlier application into that language is furnished to the receiving Office within the applicable time limit under paragraph (c);

[COMMENT: See PLT Rule 2(4)(iii).]

(iii) the missing part is completely contained in the earlier application;

[COMMENT: See PLT Rule 2(4)(iv).]

(iv) the international application, on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, contained a statement under Rule 4.18 which subsequently was confirmed in accordance with that Rule;

[COMMENT: See PLT Rule 2(4)(v). See also proposed new Rule 4.18, above, and the summary of the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 66.]

[Rule 20.5(e), continued]

(v) an indication is furnished to the receiving Office within the applicable time limit under paragraph (c) as to where, in the earlier application or in the translation referred to in item (iii), the missing part is contained.

[COMMENT: See PLT Rule 2(4)(vi).]

(f) In the cases referred to in paragraphs (b) and (d), the receiving Office shall promptly notify the applicant of the international filing date accorded or corrected under those paragraphs. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 60. The second sentence is modeled on Rule 20.2(b), second sentence.]

20.6 ~~20.8~~ *Error by the Receiving Office*

[No change] If the receiving Office later discovers, or on the basis of the applicant's reply realizes, that it has erred in issuing an invitation to correct since the requirements provided for under Article 11(1) were fulfilled when the papers were received, it shall proceed as provided in Rule 20.2 ~~20.5~~.

[Rule 20.6, continued]

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraphs 46 and 71. Since the provisions under proposed Rule 20.5 concerning the time limits for furnishing a missing part and concerning the according of the international filing date are the same in both situations (that is, the situation where the receiving Office realized itself that it had made an error and the situation where the error had been pointed out to the receiving Office by the applicant), a split into two separate provisions, as suggested by one delegation at the fourth session of the Working Group, would appear to provide no benefit.]

20.7 ~~20.9~~ *Certified Copy for the Applicant*

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 46. No change is otherwise proposed to the present Rule but the text is reproduced below for convenient reference.]

[No change] Against payment of a fee, the receiving Office shall furnish to the applicant, on request, certified copies of the international application as filed and of any corrections thereto.

Rule 22

Transmittal of the Record Copy and Translation

22.1 *Procedure*

(a) [No change]

(b) If the International Bureau has received a copy of the notification under Rule [20.2\(c\)](#) ~~20.5(e)~~ but is not, by the expiration of 13 months from the priority date, in possession of the record copy, it shall remind the receiving Office that it should transmit the record copy to the International Bureau promptly.

(c) If the International Bureau has received a copy of the notification under Rule [20.2\(c\)](#) ~~20.5(e)~~ but is not, by the expiration of 14 months from the priority date, in possession of the record copy, it shall notify the applicant and the receiving Office accordingly.

[COMMENT: The proposed renumbering is consequential to the proposed renumbering of present Rule 20.5 above.]

(d) to (h) [No change]

22.2 and 22.3 [No change]

Rule 26

Checking by, and Correcting Before, the Receiving Office of Certain Elements of the International Application

26.1 Invitation Under Article 14(1)(b) to Correct ~~Time limit for Check~~

(a) The receiving Office shall, ~~issue the invitation to correct provided for in Article 14(1)(b)~~ as soon as possible, preferably within one month from the receipt of the international application, invite the applicant, under Article 14(1)(b), to furnish the required correction, and give the applicant the opportunity to make observations, within the time limit under Rule 26.2.

[COMMENT: The title is proposed to be amended so as to correctly cover the subject matter of paragraph (a). See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 69; see also PLT Article 6(7).]

(b) ~~[Deleted] If the receiving Office issues an invitation to correct the defect referred to in Article 14(1)(a)(iii) or (iv) (missing title or missing abstract), it shall notify the International Searching Authority accordingly.~~

[COMMENT: It is proposed to move the content of present paragraph (b) to the Administrative Instructions.]

26.2 *Time Limit for Correction*

The time limit referred to in Rule 26.1 Article 14(1)(b) ~~shall be reasonable under the circumstances and~~ shall be [one month] [two months] ~~fixed in each case by the receiving Office. It shall not be less than one month~~ from the date of the invitation to correct. It may be extended by the receiving Office at any time before a decision is taken.

[Rule 26.2, continued]

[COMMENT: See PLT Article 6(7) and PLT Rule 6(1). The time limits have been retained in square brackets for further consideration by the Working Group (see also the Comments on the time limits under proposed Rules 20.3(d) and 20.5(c), above).]

26.2*bis* to 26.3*bis* [No change]

26.3*ter* *Invitation to Correct Defects Under Article 3(4)(i)*

(a) Where the abstract or any text matter of the drawings is filed in a language which is different from the language of the description and the claims, the receiving Office shall, unless

(i) and (ii) [No change]

invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published. Rules 26.1~~(a)~~, 26.2, 26.3, 26.3*bis*, 26.5 and 29.1 shall apply *mutatis mutandis*.

[COMMENT: The proposed renumbering is consequential to the proposed renumbering of present Rule 26.1(a), above.]

(b) [No change]

[Rule 26.3ter, continued]

(c) Where the request does not comply with Rule 12.1(c), the receiving Office shall invite the applicant to file a translation so as to comply with that Rule. Rules 3, 26.1(~~a~~), 26.2, 26.5 and 29.1 shall apply *mutatis mutandis*.

[COMMENT: The proposed renumbering is consequential to the proposed renumbering of present Rule 26.1(a) above.]

(d) [No change]

26.4 [No change]

26.5 *Decision of the Receiving Office*

The receiving Office shall decide whether the applicant has submitted the correction within the time limit [applicable](#) under Rule 26.2, and, if the correction has been submitted within that time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 70.]

~~26.6 Missing Drawings~~

~~(a) If, as provided in Article 14(2), the international application refers to drawings which in fact are not included in that application, the receiving Office shall so indicate in the said application.~~

[COMMENT: It is proposed to move the content of paragraph (a) to the Administrative Instructions.]

~~(b) The date on which the applicant receives the notification provided for in Article 14(2) shall have no effect on the time limit fixed under Rule 20.2(a)(iii).~~

[COMMENT: The proposed deletion of present paragraph (b) is consequential on the proposed amendment of Rule 20 (see above).]

Rule 51

Review by Designated Offices

51.1 Time Limit for Presenting the Request to Send Copies

The time limit referred to in Article 25(1)(c) shall be two months computed from the date of the notification sent to the applicant under Rule [20.4\(i\)](#) ~~20.7(i)~~, 24.2(c) or 29.1(ii).

[COMMENT: The proposed renumbering is consequential to the proposed renumbering of present Rule 20.7 above.]

51.2 Copy of the Notice

Where the applicant, after having received a negative determination under Article 11(1), requests the International Bureau, under Article 25(1), to send copies of the file of the purported international application to any of the named Offices he has attempted to designate, he shall attach to his request a copy of the notice referred to in Rule [20.4\(i\)](#) ~~20.7(i)~~.

[COMMENT: The proposed renumbering is consequential to the proposed renumbering of present Rule 20.7 above.]

51.3 [No change]

[End of Annex and of document]

WIPO



PCT/R/WG/5/9

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Fifth Session

Geneva, November 17 to 21, 2003

OPTIONS FOR FUTURE DEVELOPMENT OF
INTERNATIONAL SEARCH AND EXAMINATION:
MAKING GREATER USE OF INTERNATIONAL REPORTS

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified [in document PCT/A/32/2] above, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will then cease to be provisional in nature.

BACKGROUND

3. At its fourth session, the Working Group gave preliminary consideration to options for future development of international search and examination (see document PCT/R/WG/4/7). The Chair, in his summary of the session, noted that, in the course of the discussions of document PCT/R/WG/4/7, some delegations had emphasized their view that it would be premature and inappropriate to consider more specific or even general proposals for changing the PCT¹ system in isolation from the resolution of broader issues, but that others had expressed interest in having further discussion of possible optional features of the system. The Chair concluded that document PCT/R/WG/4/7 should remain on the agenda for further discussion at a later session. In addition, the International Bureau would explore options which might be available to States that wished to make greater use of international search and examination, such as through optional protocols to the Treaty, for discussion at the next session of the Working Group. (See the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 82 to 91.) This document considers some of those options, without prejudice to other matters covered in document PCT/R/WG/4/7, which the Working Group may wish to consider further at a later stage.

ASSESSMENT OF VALIDITY OF PATENTS AND PATENT APPLICATIONS

4. An appropriate patent system can offer many benefits to a State, including the encouragement of local innovation as well as the incentive for investment and technology transfer from other States. The features of the most appropriate patent system for any particular State will, of course, depend on its circumstances and wider economic strategy. Consideration needs to be given to many factors, including the means for enforcement of rights and the means by which patents are tested for validity and registered, granted or, if later found to be invalid, revoked. This document considers primarily the means for granting of patents, but also considers some aspects of testing validity at a later stage, with a view to identifying how the PCT system might provide greater benefits to:

(a) States which do not currently have a searching and examining Office, but would like patent applications to be searched and examined prior to grant;

(b) States which have (or are considering setting up) a searching and examining Office, but wish to reduce the amount of search and examination work done which duplicates what is done in other Offices; and

(c) States which do not require routine search and examination of patent applications, but need a system for determining the validity of patents efficiently when required in particular cases.

5. In this respect, it should be emphasized that the term “States” should not limit discussion to the needs of the Offices administering the system, but should include the needs

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.

of innovators, investors and a wide range of third parties, including researchers, academics, competing businesses and the community at large.

Some Advantages of Examination Systems

6. Since patent applications in general need all the technical information to be included from the outset, a patent system requiring all applications to be searched and examined makes little difference to the disclosure aspect of published patent applications, except that more detailed consideration allows more accurate classification so that the information in the document can be retrieved more easily by researchers. However, many States require search and examination of all applications before a patent is granted with the result that both the patent owner and competitors know that there is a high presumption that the rights defined by the claims are valid but that competitors are free to act outside of those boundaries. This relative certainty in the scope of protection may give confidence both to patentees and their (actual and potential) investors, and to competitors wishing to enter the field.

Some Disadvantages of Examination Systems

7. On the other hand, setting up and maintaining a national Office capable of searching and examining all patent applications is a significant investment for a State in terms of both financial and human resources, the costs of which are generally borne by industry (in the fees payable) and society at large (through the reduction in scientists and engineers available to the creative community). Furthermore, the benefit to local industry of a centralized physical collection of technical documents is gradually being eroded as more of these become available online, the majority of patent documents being available freely using the Internet. In most examining Offices, there is limited (if any) provision for local industry to call upon examiners' skill in retrieving technical information, other than through requesting search of a patent application. Consequently, States, particularly those where there is a shortage of skilled scientists and engineers, would need to consider carefully whether the benefits to the State of a searching and examining Office would justify the cost before setting out to create one and whether other possibilities exist to assist the relevant policy aims. Furthermore, many States in which an examining Office already exists are already considering the extent to which the work done by their examiners is duplicated elsewhere and the extent to which this can be reduced.

Factors Relevant to an International Patent System

8. Administratively, any international patent system would be most efficient if all States applied harmonized criteria for patentability, since it would be impractical to provide search and examination reports which specifically catered for the different laws of individual States. However, some States consider that their different social and economic needs and level of technological development mean that fully harmonized criteria may not be a desirable goal for the foreseeable future. Nevertheless, it may be possible to focus on areas of common agreement, where the PCT system might make a greater contribution, and to recognize the areas where significant differences may lie, so that cases where such factors may exist can be dealt with more effectively.

Approaches Not Requiring a Full Searching and Examining Office

9. Various approaches to some of the issues above have been considered or used by States which do not wish to establish or maintain a full searching and examining Office. These include:

(a) No search or substantive examination may be required at all and a patent may be registered in the form in which the application is made (possibly subject to formalities examination). The validity of individual patents may be considered during proceedings at a later stage before a court or the Office, on application by a third party.

(b) Search and examination reports may be required from a recognized source (most probably a regional Office or the Office of another State, either by bilateral/multilateral arrangement or else in the form of reports under the PCT, following international search and preliminary examination or an international-type search). Such reports may be established either before grant of a patent (so that the report is available for inspection at the Office or as part of a published patent specification, so that third parties may assess for themselves the extent of validity of the claims) or else as a requirement prior to any decision to enforce the patent (so that the alleged infringer and, if necessary, the court are able to assess its validity).

(c) The patent may simply be registered, but with a general requirement of disclosure of grants, refusals or invalidations, together with the relevant reasons, of patents for the same invention in other States, so that third parties may draw conclusions about the validity of the patent based on the degree of similarity of the relevant laws.

(d) A patent may be granted based on the grant of an equivalent patent by an examining Office which is considered to operate under sufficiently similar patent laws, or else on the basis of an international preliminary report on patentability under the PCT.

(e) A patent may be granted following a limited examination, which does not consider novelty and inventive step, but allows an Office to refuse a patent on other grounds, such as for reasons of national security, *ordre public* or morality, or else where the applicant has filed two or more applications for the same invention having the same priority date.

10. In all these cases, the individual State retains the right to decide whether or not a patent should be granted, but chooses in practice not to test for itself routinely whether all the criteria for grant or validity of a patent have been met, instead relying on the search and examination carried out by other Offices or else leaving such matters to be decided only in the event that the validity of the patent is specifically challenged, for example as a defense during infringement proceedings. Many variations are of course possible within these general categories, depending on the matters which are of significant concern to a State. Some selected examples of States offering registration of patents without full search and examination by the national Office are set out below.

11. The fact that the approach in paragraph 9(d), above, is used, where a State wishes routine testing of validity but is prepared to accept the results of examining Offices in at least some other States for this purpose, bears witness to the fact that in fact there is little practical difference in the standards for patentability in most States, except in certain specialized fields (most notably in respect of computer software and business methods and where exclusions exist related to diagnostic, therapeutic and surgical methods for the treatment of humans or

animals or else to plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals).

Selected Examples of States Offering Registration of Patents Without Full Search and Examination by the National Office

Australia: As an alternative to full local search and examination, the applicant may request “modified examination,” where the application is amended to have the same description and claims as a patent which has been granted in English in a prescribed other country. A local examination is then performed only for limited matters and does not usually include a new search for prior art being made.

Belize: The Registrar may require the applicant to give details of the date and number of any application filed in another State relating to the same invention as in the application and may also require copies of any communication concerning the result of search and examination in another State, a copy of any granted patent, a copy of any final decision rejecting an application or a copy of any final decision invalidating a patent.

France: Applications are subject to a formalities examination and a search report is established. This is published with the application (including any amendments to the claims). Third parties then have three months to comment on patentability and the applicant may respond. A final report is then drawn up and attached to the registered patent.

Singapore: A patent is granted only after search and examination reports have been established, but this may be done in any of the following ways: (i) both search and substantive examination may be requested specifically for the national application (this work is contracted out to cooperating Offices); (ii) a search done under the PCT or on a corresponding application by a prescribed Office, followed by substantive examination specifically for the national application; or (iii) both search and substantive examination reports established under the PCT or on a corresponding application by a prescribed Office. The reports are made available, but the application is only refused by the Office on limited grounds (for example that the publication or exploitation of the invention would be expected to encourage offensive, immoral or anti-social behavior).

South Africa: The application is subject to a formalities examination only and then published. Provided that no objections are made within three months, the patent is registered.

Switzerland: Applications are subject to a formalities examination and a substantive examination, but no mandatory search is made. The substantive examination does not include determination of novelty and inventive step, but the application may be refused on any other ground of patentability.

Matters Explored in This Paper

12. This paper explores some possible ways in which the PCT might be extended to provide a more beneficial service to States currently registering patents without full prior search and examination, as well as to those with examining Offices.

A. REGISTRATION FOLLOWING INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

13. As noted in paragraph 9(b), above, certain States at present register a patent without requiring amendment to overcome deficiencies as long as it is accompanied by a suitable search and examination report (for example, an international search report and international preliminary report on patentability), allowing interested third parties to assess the extent to which the patent may be valid. Clearly this can be done unilaterally by the State adopting an appropriate law. On the other hand, States with such laws, or interested in this approach, may wish to consider the possibility of formalizing the arrangement, for example, by the adoption of an optional protocol to the PCT concerning the grant of patents in this way.

14. Such a protocol might help stimulate interest in pursuing patents into the national phase in the participating States, both by clarifying to international applicants the type of procedures involved in the national phase for these States and by easing the application process by encouraging common practice with regard to further steps (such as provision of translations and payment of fees) which might be necessary. This could be of benefit, as a tool within a wider commercial policy, in encouraging foreign investment and technology transfer.

B. ENCOURAGING POSITIVE INTERNATIONAL PRELIMINARY REPORTS ON PATENTABILITY

15. Clearly there would be advantages if patents were only granted when the criteria for validity were, as far as could reasonably be tested, met, even though in many States the time and expense involved in examination of each patent application is not considered justified. As noted above, the standards for patentability are in fact very similar for most States and in practice, if the PCT standards for novelty, inventive step and industrial applicability are met, then, in the great majority of cases, so too will all national standards. Consequently, it would be highly desirable if a greater proportion of international patent applications entered the national phase with a positive international preliminary report on patentability. It is noted that this would also reduce the burden on designated or elected Offices where applications are subject to substantive examination, since they would need to perform significantly less examination of applications during the national phase.

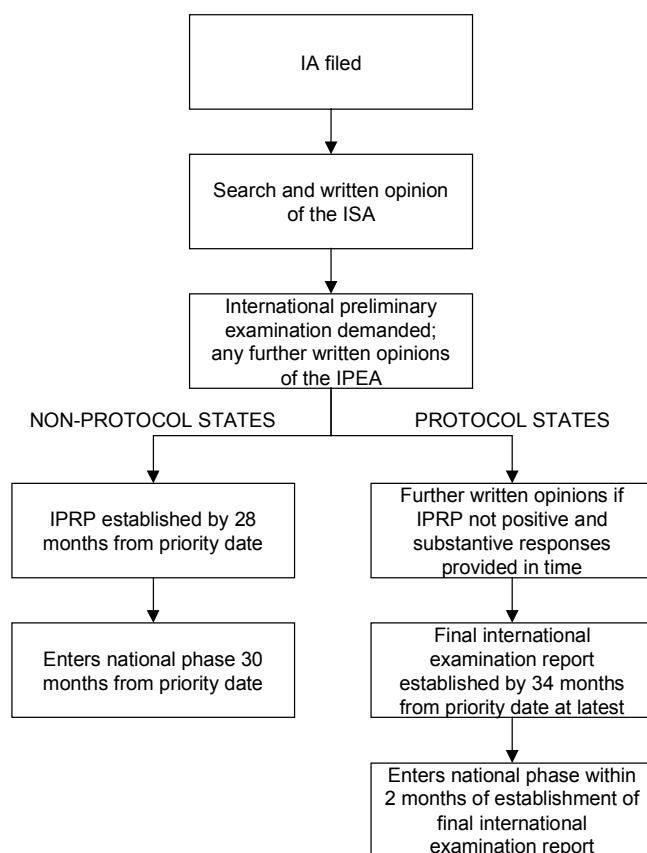
16. To achieve this, it would be necessary for the PCT to offer applicants both the opportunity and the incentive to bring their applications into a state during the international phase such that they are likely to meet the requirements of many if not all designated States during the national phase. One of the difficulties in achieving this, both for applicants and for International Authorities, is the amount of time available in the international phase for submitting and examining amendments. Some States and users have expressed concern at the idea of simply extending the time periods in the international phase since, if the time were not in practice used to bring the international application into a state where a positive international preliminary report on patentability could be issued, this would simply result in delays to grant in the national phase.

17. A flowchart illustrating a possible system with optional further international examination, based on that in Example C in the Annex to document PCT/R/WG/4/7, appears below.

Protocol Allowing for Optional Further International Examination

18. In this example, a protocol is added to the existing Treaty, allowing for further processing in the international phase. This would be optional both in respect of States, which would recognize the processing only if (and subject to any possible reservations or options) they adopt the protocol, and in respect of applicants, who would be permitted to request either normal or extended processing. If the international preliminary examination is being carried out by a participating International Authority (the International Authorities would also need to agree to perform this extra work; see also paragraph 46), the applicant can request further examination, allowing a limited extra period within which to conduct further rounds of amendment or argument, with a view to the application being brought into a state which would achieve a positive international preliminary report on patentability. If this is not complete within 28 months from the priority date, an international preliminary report on patentability is established automatically on the basis of the latest written opinion for the use of the States which are not party to the protocol. However, the international application will continue international examination and not yet enter the national phase in those States which have ratified the protocol.

SYSTEM WITH OPTIONAL FURTHER INTERNATIONAL EXAMINATION



19. Various possibilities could be envisaged with regard to the timing and content of a request for further examination. For example:

(a) the request might be required to be made at the same time as the demand for international preliminary examination; this would probably need to be the case if the system also allowed for further processing such as “top-up” searches or additional international searches by another International Authority (see paragraphs 33 to 37, below); or alternatively:

(b) the request might be permitted to be made at any time before the expiration of the time limit under Article 39; the fee for extra processing in this case would be payable only in the case that there was additional work for the International Preliminary Examining Authority, providing a further incentive to bring the international application into compliance with the requirements of novelty, inventive step and industrial applicability at an early stage (noting that a significant proportion of international applications where international preliminary examination is demanded achieve a positive international preliminary report on patentability within the current time limits).

20. Once the international application meets the requirements of novelty, inventive step and industrial applicability as defined in the Regulations, a final international examination report is issued; this might be termed a “prima facie certificate of patentability,” indicating that it has been found to meet standards which will result in it being patentable in many States. The result of this would be that a patent would normally be granted in any of the States party to the protocol simply on the payment of an appropriate fee and the provision of any necessary translation.

21. However, recognizing that variations do exist in the conditions for patentability:

(a) States with examining Offices might make grant provisional on there being no objection from the Office within a certain period (as may be the case for international marks under the Madrid Protocol) and any opposition procedures which may apply; and

(b) States where only limited examination is performed might refuse grant, or make it subject to cancellation by the national Office, if the application is found to relate to subject matter which is not patentable in that State, if the invention is contrary to *ordre public* or morality according to the national standards, or else if a relevant patent publication had been found of earlier priority date but only published after the priority date of the international application (so that it does not constitute prior art under the PCT, but may do so under the relevant national law).

22. The process outlined in paragraph 21(b), above, could be assisted if the international preliminary report on patentability included comments, noting the existence of subject matter where conditions of patentability vary considerably around the world (see paragraphs 11, above, and 38 to 40, below), so that States where the grant of such patents is a significant concern, but in which there is no desire to fully examine all applications, could develop a limited examination capability and focus it effectively on applications which are most likely to be of concern.

23. Even in States where it is desired to retain a pure registration system, membership of the system could provide benefits by encouraging international applicants only to register patents which could be seen to meet the common standards for patentability and for which the prima

facie certificate of patentability might include indications alerting third parties to other conditions which might be relevant to patentability according to the particular national standards.

24. If the application still does not meet the requirements of novelty, inventive step and industrial applicability within, say, 34 months from the priority date, a final report similar to the international preliminary report on patentability will be established and the international application will enter the national phase as usual. In order to prevent this process from being abused by simply buying time before entry to the national phase, the final report and national phase could be triggered earlier in the event of the applicant failing to provide a substantive response to a written opinion within the specified time. Further encouragement to meet the requirements of novelty, inventive step and industrial applicability might be offered by Contracting States by a differential pricing system, whereby the fees due on entry to the national phase would depend on whether the prima facie certificate of patentability has been issued or whether objections remain outstanding in the final report.

25. Such a system could allow Contracting States to reduce the number of invalid patents registered without major investment in developing an examining Office and without reducing the flexibility which they have in determining the conditions for patentability which are appropriate to their particular policy needs.

C. INTERNATIONAL EXAMINATION AFTER REGISTRATION

26. Another issue which affects, in particular, States without examining Offices is the assessment of the validity of a patent after it has been registered. This might come about in several circumstances, for example (i) as the result of a challenge to the validity of the patent by a third party who has found prior art which may be relevant but was not discovered during any search which was made prior to registration, or (ii) following a desire of a patentee to amend the patent because he has himself become aware of further prior art.

27. The PCT currently allows for “international-type searches” under Article 15(5) on national patent applications. It would be possible to extend this idea to international-type search and examination of registered patents or of proposals for amendments, either on the basis of a new international-type search or else on the basis of whatever prior art is supplied by the person or body requesting the service. Such a report could then form the initial basis of an action for invalidity or amendment before a national Office, providing a faster and cheaper system for resolving disputes than using the courts. Alternatively the report could be used as an expert opinion from a neutral body to assist a court in its deliberations.

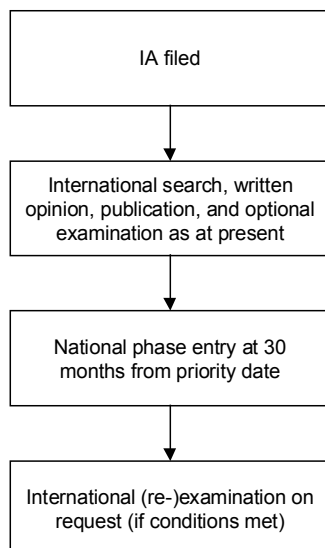
28. A flowchart illustrating a possible system allowing international examination during the national phase, based on that in Example B in the Annex to document PCT/R/WG/4/7, appears below. This system relates to a different issue to those addressed under A and B, above, and could be envisaged running in parallel to either of those systems, rather than necessarily being an alternative to them.

Protocol Allowing for International Examination During the National Phase

29. This system allows for international examination to be requested during the national phase in respect of international applications (and possibly also national applications), and of granted patents. The grounds for applying for such examination would be limited to certain cases, for example, where new prior art has been found, subsequent to any earlier

international search and examination, which may affect the novelty or inventive step of the invention. It would also be possible to allow for such requests after the patent has lapsed where infringement proceedings are still possible.

SYSTEM ALLOWING INTERNATIONAL EXAMINATION
DURING THE NATIONAL PHASE



30. Several possibilities could be envisaged with respect to who would be permitted to request such examination and how. As noted in paragraph 26, above, new prior art may have been found either by the patentee (who may wish to amend his patent to exclude subject matter which he is concerned may not be novel or inventive), or else by a third party (who may have been accused of infringing the patent, which he believes to be invalid). In either case, the request for international examination would probably need to be made by the national Office of a State party to the relevant addition to the Treaty, rather than directly by the patentee or a third party. The Office would confirm that the conditions for international examination had been met, for example that there was a current or recently-lapsed patent effective in that State and that it was to be the subject of validity proceedings or a request for amendment.

31. The patentee might, depending on the purpose for which the new examination has been requested, be permitted to file amendments, following a similar process to pre-grant examination, but with additional rules ensuring that amendments were not permitted to extend the scope of protection, and possibly with more stringent time limits for response. As with current international preliminary reports on patentability, Member States would take such a report into account for the purposes of national invalidity or amendment proceedings, but need not be bound by it.

D. CONTENT AND TIMING OF INTERNATIONAL REPORTS

32. Significant factors in the use which can be made by national Offices of international search and preliminary examination reports are the extent of the report and the degree of confidence which can be placed on its quality and completeness. The contents of the reports are, for the most part, set by the Regulations and consequently could be amended relatively easily. However, while it would be possible to implement some or all of the measures

described below in isolation, they might introduce extra work for International Authorities, and it is recalled that the Committee considered this inappropriate at the present time. Consequently they are considered here only in the context of how they might improve a system which itself allows processing beyond that which applies under the PCT at present, particularly with respect to that described under heading B, above, but also applicable to some extent to the possible systems considered under headings A and C.

Multiple Searches

33. The Committee, in its first meeting, considered the possibility of allowing applicants the option of requesting searches by several International Authorities (see document PCT/R/1/26, paragraphs 109 to 146). While there was some support, the general conclusion was that this was undesirable duplication of work and inappropriate, at least while some International Searching Authorities had difficulties with existing workloads. However, considering the longer term, a number of States pointed out that additional searches would clearly add value for applicants. For example, it may sometimes be desirable for searches performed by the European Patent Office or the United States Patent and Trademark Office to be supplemented by a “complementary search” performed by the Japan Patent Office or the Russian Agency for Patents and Trademarks of their Japanese or Russian language collections, respectively. The International Authority performing such an additional search might also include an opinion on how any new documents found, which did not have equivalents in the main search report, affected the novelty or inventive step of the application, for the better understanding of the International Authority which conducted the main search.

34. The additional search might be requested at the same time as making a demand with a request for further examination in the system described under heading B, above. Otherwise, in order to ensure that the search could be performed and considered in timely fashion, it would be necessary to request the additional search at the same time as the request for international application.

“Top-up” Searches

35. The international search at present typically takes place around 15 months from the priority date of the application. As long as the international application’s priority date is valid, this is usually adequate for determining novelty and inventive step in relation to the prior art defined by Rule 64.1, since only material published before the “relevant date” may be considered. However, in most States, patent documents published after that date may also be relevant to novelty and/or inventive step if they have an earlier priority date. This can be extremely important in many fast-moving technologies.

36. Rules 33, 64.3 and 70.10 make some allowance for inclusion of such documents within the reports. However, at the time when the international search is performed, these documents may not yet have been published, or else might otherwise not have become available to the International Authority. A “top-up” search at a later stage in the international phase may eliminate the need for this check to be made by individual States and allow relevant documents to be brought to the attention of applicants at a point where appropriate amendments can still be made and examined centrally, if so desired, making the international preliminary report on patentability more useful for both applicants and elected Offices, particularly non-examining Offices.

37. Such a service could be particularly effective as part of a system, such as that described under heading B, above, allowing extended examination in the international phase. This would allow sufficient time in the international phase for the top-up search to be established and increase the utility of the international search and examination for States which had joined a protocol indicating their intention to base the grant of a patent primarily on the basis of the international report.

Scope of Examination Reports

38. The primary function of the international preliminary report on patentability is to provide an opinion on novelty, inventive step and industrial applicability, as defined by the Treaty. While the tests for these requirements differ slightly around the world, in practice, it would appear that there is very little difference in the outcomes of these tests in any particular case. On the other hand, there are other areas where the differing tests, although relevant only to a small minority of patent applications, have very significant differences with regard to patentability in different States. Examples of this include patents for surgical methods, plants and animals, and views on what constitutes technology.

39. Clearly, greater harmonization of national patent laws would make it easier for the PCT to provide examination reports which are closely aligned with national requirements. However, in the meantime, without going into the individual laws of each State, it may be desirable for international examination reports to comment on such aspects where practice varies. At present, Rules 39 and 67 set out certain subject matter which International Authorities are not obliged to search or examine, which cover most, if not all, of the relevant areas. Where the International Authority chooses not to perform a search or examination it would of course, in the context of the system described under heading B, above, be impossible to achieve a prima facie certificate of patentability (at least in respect of the part of an application to which the non-establishment applied). Similarly in the system described under heading C, no meaningful indication of the novelty or inventive step could be given of a patent being examined after grant. However the report would provide explanations of the reasons for which no report on novelty and inventive step was established, which might be relevant for determining whether the invention would also be excluded under particular national laws (in which case the novelty and inventive step may be academic).

40. On the other hand, where the application might be considered to contain subject matter which falls within Rules 39 and 67, but the International Authority chooses to carry out search or examination, there may at present be no indication in the international preliminary report on patentability of the existence of this matter. A readily identifiable indication that the patent does, or does not, relate to potentially excluded matter need not be a great burden for the International Preliminary Examining Authority and may give States greater confidence in using the results of the international examination directly, or, where appropriate, in identifying those cases where greater scrutiny of the application in accordance with the relevant national law is likely to be necessary prior to granting a patent. This would clearly be beneficial to States where such limitations exist and which have non-examining Offices, and could also be used to reduce the burden on examining Offices.

Deferral of International Search and Examination

41. If a protocol were widely taken up permitting extended processing in the international phase, it might be beneficial both for applicants and for the workload of the International Authorities to review the times by which international search and examination need to be

requested and completed. For example, at the time of filing the international application the applicant may not yet have determined whether the technology involved is one which he is in fact interested in pursuing.

42. Extending the period within which the international search fee is payable from one month from the date of receipt of the international application to, for example, sixteen months from the priority date might allow applicants to avoid paying fees on applications which will not be pursued and reduce the unnecessary workload of International Authorities. This would have an effect where the international application would be a sort of provisional application, which would not be permitted to proceed beyond the stage of formalities checks until the international search fee had been paid. While this move would mean that the international search report would not be available for the applicant to consider prior to publication or for inclusion in the pamphlet, there would remain ample time for establishment of the international search within the normal international phase. Furthermore, the availability of publications electronically means that it is less difficult than previously for third parties to gain access to international search reports which are established too late to be included with the pamphlet as originally published. Also, even if the start of Chapter II proceedings were slightly delayed, the applicant could rely on achieving a positive international preliminary report on patentability by the end of a phase of extended processing (see under heading B, paragraphs 15 to 25, above), the results of which might still be used by the applicant in national processing even in States which were not party to the protocol, by introducing the equivalent amendments in the national phase.

MEANS OF IMPLEMENTATION AND EFFECTS ON OTHERS

43. The options set out under A (see paragraphs 13 and 14, above), B (see paragraphs 15 to 25, above) and C (see paragraphs 26 to 31, above) would require an addition to the Treaty, most probably in the form of a protocol, but need not affect the operation of the existing system insofar as it applies to States which did not wish to join the protocol. However, in the event that further international reports were to be established, they could be made publicly available and consequently could be used, on an informal basis, even by the Offices of States which are not party to the protocol.

44. The additional options set out under D (see paragraphs 32 to 42, above) might be implemented either by amendments of the Regulations, which might affect reports under Chapters I and II of the Treaty, or else as additional Regulations applying only to reports which would be issued under additional protocols. The most appropriate approach would need to be considered carefully, depending on the wishes of States which are not party to the additional protocols and on efficiency considerations for International Authorities.

45. It would be desirable for a sufficiently large number of States to join a system for further international examination (as under B, above) before it came into force that there would be a strong incentive for applicants to use this system, rather than waiting until the national phase to amend their applications. Post-grant examination (as under C, above) on the other hand might commence with a relatively small number of participating States since this would be a service rendered individually to States on request, rather than aiming to replace work which would otherwise have to be duplicated in many States.

46. At least some of the International Authorities would need to accept the additional work involved. A system with further international examination might produce significant volumes of extra work for participating International Authorities, though this would be offset to a large

extent by the corresponding reduction in work required during the national phase. International examination at a later stage, on the other hand, would be expected to involve significantly lower volumes of work, since it would only be done on individual applications where a question of validity had been raised in a participating State rather than on a significant proportion of international applications.

47. The Working Group is invited to consider the options contained in this document.

[End of document]