

C. PCT 1350

July 20, 2012

Madam,
Sir,

Proposed modifications to the PCT Receiving Office Guidelines

This Circular is addressed to your Office in its capacity as Receiving Office (RO) for the purpose of consultation on proposed modifications to the PCT Receiving Office Guidelines (ROGLs). It is also addressed to certain non-governmental organizations representing users of the PCT system.

The proposed modifications have their origin in certain changes to the patent law of the United States of America (US) (under the America Invents Act) which in turn led to a set of amendments to the Regulations under the PCT which were proposed to the PCT Working Group at its Fifth Session in May this year (see documents PCT/WG/5/19 and 19 Corr., and paragraphs 67 to 69 of document PCT/WG/5/21). The Working Group agreed to submit these proposed amendments to the PCT Assembly at its next session in October 2012 for adoption.

Even though it is currently foreseen that the aforementioned amendments are recommended to be adopted by the PCT Assembly only with effect from January 1, 2013, the underlying changes to the US patent law will already apply as of September 16, 2012. As a result, as of that date, in an international application filed under the PCT, inventors no longer need to be indicated as applicants for the purposes of the designation of the US.

Since the change to the US patent law has immediate effect on how PCT applicants should complete the request form, consultation on the proposed modifications to the ROGLs is commenced herewith, with the aim of promulgating the modifications to the ROGLs with effect from September 16, 2012, on the assumption that the amendments to the PCT Regulations will be adopted by the Assembly, as recommended by the PCT Working Group.

Nevertheless, it should be noted that applicants will still be able to rely on the Rules as currently in force, until the date on which the amendments to the PCT Regulations enter into force.

The paragraphs of the ROGLs which are proposed to be modified are set out in the Annex to this Circular.

Further proposed measure during a transitional period

Since the underlying changes to the US patent law will enter into force on September 16, 2012, it is currently envisaged that the related modifications to the ROGLs, the Administrative Instructions and certain Forms, in particular the request form, are promulgated with effect from that date. However, the electronic filing software, especially the different variations used by the receiving Offices, may not be updated accordingly as of that date and still provide applicants with the option to indicate applicants as “applicant for the purposes of all designated States except the United States of America” and as “applicant for the purposes of the United States of America only” after September 15, 2012. In addition, some applicants might not be aware of that change and still use the paper request form as in force until September 15, 2012 after that date.

Therefore, in cases in which an applicant is indicated as applicant for all States except the US and an inventor is indicated as applicant for the US only in the request of an international application filed on or after September 16, 2012, it is proposed that ROs issue Form PCT/RO/132 with the following standardized text:

“The attention of the receiving Office is directed to the indications in Box No. II and/or III of the request form in respect of the above indicated international application.

In respect of [NAME OF APPLICANT] in Box No. [II][III] of the request, the applicant has been indicated as “applicant for the purposes of all designated States except the United States of America” and in respect of [NAME OF APPLICANT] in Box No. [II][III] of the request, the applicant/inventor has been indicated as “applicant for the purposes of the United States of America only”.

The applicant is herewith informed that, due to a change in the national law of the United States of America, as from 16 September 2012, it is no longer necessary to indicate the inventor(s) as applicant(s) for the purposes of the designation of that State. The applicant may therefore wish to consider submitting to the International Bureau within 30 months from the priority date a request under PCT Rule 92*bis* for the recording of a change, requesting that the applicant indicated in the request form as “applicant for the purposes of all designated States except the United States of America” be indicated as “applicant for the purposes of all designated States”, and that the applicant/inventor indicated in the request form as “applicant for the purposes of the United States only” be indicated as “inventor only”.

In addition, it is proposed that where, in such a case, the RO did not issue Form PCT/RO/132 with the above mentioned standardized text, the International Bureau will issue Form PCT/IB/345 with a similar wording.

Comments on the proposed modifications to ROGLs

You are invited to provide comments, if any, to the International Bureau by August 20, 2012, preferably by e-mail to: pct.legal@wipo.int.

Yours sincerely,



James Pooley
Deputy Director General

Enclosures: Annex – Proposed modified paragraphs of the ROGLs

PCT RECEIVING OFFICE GUIDELINES

CHAPTER VI ARTICLE 14 CHECK AND OTHER FORMAL REQUIREMENTS

FORMAL REQUIREMENTS

Form of the Request

75A. Where the request is presented as a computer print-out corresponding to the format of Form PCT/RO/101, the receiving Office checks whether that print-out complies with Section 102(h). Where the request is presented as a computer print-out that appears to be in PCT-EASY format, and/or is accompanied by a PCT-EASY diskette, the receiving Office proceeds as outlined in paragraphs 165A to 165M. If neither Form PCT/RO/101 nor a computer print-out complying with the requirements under Section 102(h) is used, the receiving Office draws the applicant's attention to that fact and invites (Form PCT/RO/106) the applicant to fill in a copy (sent together with the invitation) of Form PCT/RO/101 and to return the duly filled-in copy to it within a time limit fixed in the invitation. The filled-in request form may not contain differences in relation to the request filed on the international filing date. Where certain indications concerning the applicant (paragraphs 78 to 87A and ~~94 95~~ to ~~9799~~), the inventor (paragraphs 88 to ~~9997~~), the agent or the common representative (paragraphs 117 to 121) do not correspond to indications made on the date on which the international application was filed, the procedure outlined in paragraphs 309 to 312 applies. Where two or more languages are accepted by the receiving Office for the filing of international applications, see paragraph 60. All indications which may be contained in the request are dealt with in the following paragraphs except for those relating to claiming priority and declarations relating to national requirements which are dealt with separately, in Chapters VII and VIIbis, respectively.

75B. The following paragraphs 76 to ~~128130~~ relate to Form PCT/RO/101 and to computer print-outs corresponding to that Form. As regards requests prepared using the PCT-EASY software, see paragraphs 165A to 165M.

Indications in the Request Concerning Applicant and Inventor

~~*Indications Concerning Applicant and Inventor where the United States of America Is Designated*~~

~~91. Article 27(3) provides that where the applicant, for the purposes of any designated State, is not qualified according to the national law of that State to file a national application because the applicant is not the inventor, the international application may be rejected by the designated Office concerned. At present, only the national law of the United States of America contains such a provision. Therefore, where the United States of America is one of the designated States, all of the inventors must be named as applicants (as well as inventors) for the purposes of that designation. The check-box "This person is also inventor" (in Box No. II of the request) or "applicant and inventor" (in Box No. III of the request) must be marked. For examples, see Annex B. [\[Deleted\]](#)~~

~~92. *[Deleted]*~~

~~93. *Where, for the purposes of the designation of the United States of America,*~~

- ~~————— (i) the inventor(s) is (are) named but not also indicated as applicant(s) for the purposes of that designation, and unless the inventor(s) is (are) deceased (see paragraphs 96 to 99 and 161 to 165), or~~
- ~~————— (ii) no inventor is indicated,~~

~~and the designation of the United States of America has not been withdrawn, the receiving Office notifies the applicant that the application may be rejected by the United States Patent and Trademark Office as a designated Office because only the inventor is qualified to file a national application in the United States of America (Article 27(3)). Any response by an applicant requesting that an inventor be indicated as an applicant for the United States of America will be treated as a request under PCT Rule 92bis. [\[Deleted\]](#)~~

~~94. Where a legal entity is indicated on the request as an applicant for States including the United States of America and the request also names a person who is an inventor and applicant for the purposes of the United States of America, then the receiving Office should *ex officio* correct the request to indicate the legal entity as an applicant for the purposes of “all designated States except the United States of America.” Similarly, any response to the notification referred to in paragraph 93 requesting that an inventor be indicated as an applicant for the United States of America will be considered, in the absence of instructions to the contrary, to include a request to change the indication of any legal entity indicated as an applicant for the United States to that of an applicant for “all designated States except the United States of America”. [\[Deleted\]](#)~~

Different Applicants or Inventors for Different Designated States

95. Rule 4.5(d) provides that the request may, for different designated States, indicate different applicants. Different applicants may also be indicated for different States designated for a regional patent (Section 203(a)). For the purpose of the designation of States for both a national patent and a regional patent, the same applicant or applicants must be indicated (Section 203(b)). Where different persons (natural persons or legal entities) are applicants for different designated States ~~other than the United States of America (paragraphs 91 to 93), that is, where none of the other three check-boxes in Boxes Nos. II and III of the request fits the circumstances~~, the check-box “the States indicated in the Supplemental Box” must be marked and the Supplemental Box of the request should be used. In such a case, the name of the person must be repeated in that Supplemental Box with an indication of the designated State or States for which that person is applicant (item 1(ii) in that Box). In that Supplemental Box, different persons may also be indicated as inventors for different designated States (for example, where, in this respect, the requirements of the national laws of the designated States are not the same).

Indications in the Case of a Deceased Applicant or Inventor

96. If the applicant dies, the successor to the rights of that applicant (for example, heir or legal representative) should request to be recorded as the new applicant under Rule 92bis (paragraphs 309 to 312). The reason for the requested recording of a change must be indicated. Where no replacement sheet of the corresponding sheet(s) of the request and/or additional sheet, as the case may be, was filed, the receiving Office transfers the change to the record copy (which may imply adding a sheet to the request form). If the deceased applicant had appointed an agent or common representative and the successor to the rights of that deceased applicant intends to be represented by that same agent or common representative, the successor to the rights of the deceased applicant must appoint that agent and submit a corresponding power of attorney.

97. If the inventor died before the international application was filed, the request must indicate only the name of the inventor with an indication that the inventor is deceased, for example:

JONES, Bernard (deceased). ~~For the case of a designation for which the inventor must be the applicant, see paragraph 98.~~

~~98. For the purpose of the designation of the United States of America, if the deceased applicant was the inventor, the successor to the rights of the deceased applicant/inventor must be indicated in the request as the new applicant (but not inventor) for the United States of America. Where there is a successor to the rights of the deceased inventor, this indication should be made as follows:~~

~~SMITH, Alfred, legal representative of JONES, Bernard (deceased) or
JONES, Helen, sole heiress of JONES, Bernard (deceased)~~

~~followed by indications of the address, nationality and residence of the legal representative or heir, as the case may be. The nationality and residence of the successor to the rights of the deceased inventor must be indicated. [\[Deleted\]](#)~~

~~99. The same applies where the inventor dies during the international phase and a request for the recording of a change in the person of the applicant is made (paragraphs 309 to 312). Where no replacement sheet of the corresponding sheet(s) of the request and/or additional sheet, as the case may be, was filed, the receiving Office transfers the change to the record copy (which may imply adding a sheet to the request form). If the deceased applicant/inventor had appointed an agent or common representative and the successor to the rights of that deceased applicant/inventor intends to be represented by that same agent or common representative, the successor to the rights of the deceased applicant/inventor must appoint that agent and submit a corresponding power of attorney. [\[Deleted\]](#)~~

Agent, Common Representative and Address for Correspondence

121. Further references to agents and common representatives are made in these Guidelines, in particular, in the following paragraphs: paragraph 9 (meaning of “applicant”), paragraphs 23 to 26 (correspondence intended for the applicant), paragraph 75A (form of the request), paragraph 81 (address), paragraph ~~99-96~~ (deceased applicant), paragraphs 122 to 125A (signature), paragraphs 126 to 128 (signature for legal entity); paragraph 192C (declarations), paragraphs 309 to 312 (recording of changes).

Signature

122A. In case the request is signed by an agent and where the receiving Office has waived the requirement of a separate power of attorney or of a copy of a general power of attorney, it does not check further the signature requirements in this case. The same applies in respect of the appointment of a common representative. If that agent also signs in Box X the signature requirements under Article 14(1) have been fulfilled since he signed the application on behalf of the applicants. A notice of withdrawal, however, has to be signed by or on behalf of all applicants (Rule 90bis.5(a), paragraphs 117C and 314).

123. Where the signature requirement is not fulfilled to the extent indicated in paragraph 122, the receiving Office invites (Form PCT/RO/106) the applicant, under Article 14(1)(b) and Rule 26, to correct the defect by sending, together with the invitation to correct, a copy of the relevant sheet of the request, to be returned by the applicant after affixing thereto the prescribed signature(s) (Section 316). Where not all requirements relating to the signature of the international application as outlined in paragraphs 124 to ~~128~~~~130~~ are complied with, see paragraphs 153 to 159.

129. ~~**Applicant/Inventor for the United States of America Refuses to Sign or Cannot Be Found or Reached.** Where an applicant/inventor for the United States of America refuses to sign the request (or a power of attorney) or cannot be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one other applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned. If the receiving Office considers that statement to be satisfactory, it sends a copy thereof to the International Bureau with an indication that that statement replaces the missing signature. This would also apply where all the joint applicants/inventors for the United States of America refused to sign or could not be found or reached after diligent effort, provided that at least one other applicant has signed the request or a power of attorney (Rule 4.15(b)). However, the receiving Office does not invite the applicant to furnish missing signatures where at least one applicant has signed the request (paragraphs 122 and 153). [\[Deleted\]](#)~~

130. ~~While it is the receiving Office which, under Rule 4.15(b), must be satisfied as to the explanation of the lack of signature at the time of filing the international application, the matter is ultimately one to be determined by the United States Patent and Trademark Office as a designated Office, when the application proceeds into the national phase. [\[Deleted\]](#)~~

131. ~~[\[Deleted\]](#)~~

CORRECTIONS OF DEFECTS

Corrections under Article 14(1)(b) and Rule 26

159. **Failure to Correct under Article 14(1)(b) and Rule 26.** If the receiving Office finds that defects under Article 14(1)(a) have not been corrected or have not been timely corrected, it declares the international application withdrawn and promptly notifies (Form PCT/RO/117) the applicant, the International Bureau and (if the search copy has already been transmitted) the International Searching Authority (Rule 29.1(ii) and (iii)). Since international publication can only be stopped if this notification reaches the International Bureau before completion of technical preparations for international publication (Rule 29.1(v)), it is critical that the declaration that the international application is considered withdrawn be made and notified to the International Bureau early enough to be able to have this effect. In urgent cases, it is strongly recommended that such notifications be faxed to the International Bureau. Together with the copy of Form PCT/RO/117 sent to the International Bureau, the receiving Office should enclose copies of all papers and correspondence relating to the decision declaring that the international application is considered withdrawn to facilitate any subsequent review of that decision by a designated Office under Article 25(1). ~~As to a missing signature of an applicant/inventor for the United States of America who is unavailable or refuses to sign the international application, see paragraphs 129 to 130.~~ In any event, in view of Rule 26.3, the receiving Office should, in general, not declare the international application withdrawn for failure to comply with the physical requirements under Rule 11; only in extreme cases of non-compliance with those requirements should the receiving Office make such declaration. Where the international application does not contain all the prescribed indications concerning the applicant (Article 14(1)(a)(ii) and Rules 4.4 and 4.5), the receiving Office should not issue a declaration under Rule 26.5 in a case where, for example, there is a minor error in an address (see the opening words of Rule 4.4(c)), or where the applicant's full name is misspelled or not indicated, even if the applicant fails to correct the defect, upon invitation, within the prescribed time limit. If there is more than one applicant, it is sufficient that the indications required under Rule 4.5(a)(ii) and (iii) be provided in respect of one of them who is entitled

according to Rule 19.1 to file the international application with the receiving Office (Rule 26.2*bis*(b)) (paragraph 84A). Where failure to correct a defect which would affect the reasonably uniform international publication is noticed at a late stage, it would be inappropriate for the receiving Office to declare the international application withdrawn without first issuing a reminder and extending the time limit under Rule 26.2.

CHAPTER XIII RECORD COPY, SEARCH COPY AND HOME COPY

Transmittal to the International Bureau of the Record Copy of the International Application and Other Items

285. ***Items to Accompany the Record Copy.*** Items which should accompany the record copy are listed in Section 313(a). Form PCT/RO/118 is used to transmit the record copy and items to accompany it (paragraph 22). A copy of any required power of attorney should always be transmitted. Where an international application has been received by facsimile transmission and a confirmation copy has been received subsequently, both the facsimile copy (which is the record copy) and the confirmation copy are transmitted to the International Bureau (Section 331). Where a translation of the international application is furnished under Rule 12.3 or 12.4, that translation is transmitted together with the record copy (that is, the international application in the original language) (Section 305*bis*). ~~A statement, if available, explaining the lack of signature of an inventor/applicant furnished under Rule 4.15(b) and accompanied by a communication to the effect that it satisfies the receiving Office must also be transmitted.~~ The transmittal of the record copy must also be effected if the international application is considered withdrawn by the receiving Office or has been withdrawn by the applicant, in which case the notice effecting withdrawal must also be transmitted (paragraphs 314 to 324).

[End of Annex]