

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
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## DIPLOMATIC CONFERENCE FOR THE ADOPTION OF THE PATENT LAW TREATY

Geneva, May 11 to June 2, 2000

### RULE 4(4)

*Proposal by the Delegation of the Russian Federation*

The following amendments are proposed by the Delegation of the Russian Federation in order to maintain the balance of rights and interests of the applicant on the one hand, and those of third parties on the other hand.

Version a):

~~(4) [Translation] Where the earlier application is not in a language accepted by the Office and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the Contracting Party may require that a translation of the earlier application referred to in paragraph (1) be filed by the applicant, upon invitation by the Office, within a time limit which shall be not less than two months from the date of that invitation, and not less than the time limit, if any, applied under that paragraph.~~

Version b):

*Rule 4(4)*

(4) [Translation] (a) Where the earlier application is not in a language accepted by the Office and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, a Contracting Party may require that a translation of the earlier application be filed within the time limit applicable under paragraph (1), allowing the

applicant a possibility to file, in place of the translation, a declaration to the effect that he authorizes the Office to open the earlier application for inspection by the person wishing to verify the validity of the priority claim.

(b) Where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable and the applicant has filed the declaration referred to in subparagraph (a), the Contracting Party may require that a translation of the earlier application referred to in paragraph (1) [or relevant parts thereof] be filed by the applicant, upon invitation by the Office, within a time limit which shall be not less than two months from the date of that invitation, and not less than the time limit, if any, applied under that paragraph (1).

*Note*

Article 6(5) and Rule 4(4) relieve the applicant of the need to file a translation of the earlier application, except where such a translation is required for verification of the validity of the priority claim in determining whether the invention concerned is patentable (Rule 4(4)). These provisions indeed provide some relief for the applicant. But at the same time this approach would, in fact, mean that the Office would abandon verification of the validity of the priority claim in all cases, except as provided for in Rule 4(4).

There also exist at least two cases where, in order to observe legitimate interests of third parties, verification of the validity of the priority claim might be required.

*First case*

The legislation of the majority of countries does not allow recognition of the novelty of an invention disclosed in the application, but not necessarily included in the claims, filed by another person with the Office of a given country and having an earlier filing date or enjoying the right of priority.

An example of such an application might be an application claiming the priority of the earlier application filed with another Office. It might happen that the earlier application has not been published (because, for example, the applicable law of that Office's country does not provide for the publication of applications or because the application has been withdrawn by the applicant). Consequently, the person whose application is opposed by the application having an earlier priority date is not in a position to verify the validity of the priority claim independently, for he cannot inspect the unpublished earlier application. The Office likewise cannot arrange to familiarize him with the earlier application because it is not included in the prior art.

Therefore it should be provided either that the Office may verify the validity of the priority claim (for which purpose it might need a translation of the earlier application) or that the interested person may familiarize himself with the earlier application or the relevant parts thereof.

*Second case*

The legislation of the majority of countries provides for the right of prior use.

Where a patent has been granted on an application claiming the priority of the earlier application, then, in a case of commencement of use that is earlier than the filing date of that application but later than the date of the priority claimed, an interested user has, as in the previous case, the right to expect the Office to verify the validity of the priority claim, or he must have the opportunity to acquaint himself with the priority document.

Apparently, problems arising in the above two cases are not relevant for all Offices. Consequently all Offices may be satisfied with the proposed version (a), whereby the PLT allows each Contracting Party to decide, at its own discretion, whether it should make use of the provision in the Paris Convention on the right to require a translation.

In case version (a) is not acceptable, version (b) is proposed, which is preferable for applicants and contains within itself an alternative proposal given in square brackets. In this version, when filing an application, the applicant enjoys the right to choose: to submit a translation of the earlier application or a declaration to the effect that he authorizes the Office to disclose the contents of the earlier application to a person interested in the verification of the validity of the priority claim. In so doing, the Office reserves the right to require a translation if the latter is necessary for the verification of the validity of the priority claimed when determining the patentability of the invention concerned (similar to what Rule 4(4) provides).

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