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NOTES

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INTRODUCTION

The present document contains Notes on the draft Treaty and the draft Regulations contained in document PLT/CE/II/2.

CONTENTS

	<u>Pages</u>
I. NOTES ON THE DRAFT TREATY	
Note on Article 1 (Abbreviated Expressions)	5
Note on Article 2 (Application)	6
Note on Article 3 (Filing Date)	11
Note on Article 4 (Representation; Address for Service)	12
Note on Article 5 (Signature)	14
Note on Article 6 (Unity of Invention)	14
Note on Article 7 (Request for Recordal of Change in Name or Address)	15
Note on Article 8 (Request for Recordal of Change in Ownership or Change in Inventorship)	17
Note on Article 9 (Request for Correction of a Mistake)	24
Note on Article 10 (Opportunity to Make Observations, Amendments and Corrections in Case of Intended Refusal)	25
Note on Article 11 (Regulations)	25

[Contents, continued]

	<u>Pages</u>
II. NOTES ON THE DRAFT REGULATIONS	
Note on Rule 1 (Abbreviated Expressions)	26
Note on Rule 2 (Details Concerning Names and Addresses)	26
Note on Rule 3 (Receipt of Communications)	27
Note on Rule 4 (Details Concerning Representation)	27
Note on Rule 5 (Details Concerning the Signature)	27
Note on Rule 6 (Details Concerning the Requirement of Unity of Invention)	27
Note on Rule 7 (Divisional Applications)	32
Note on Rule 8 (Manner of Identification of an Application Without Its Application Number)	32

I. NOTES ON THE DRAFT TREATY

Note on Article 1
(Abbreviated Expressions)

1.01 Items (i) to (iii). These items seem to be self-explanatory.

1.02 Item (iv). Neither the Treaty nor the Regulations contains a definition of what constitutes a legal entity. This is left to the applicable law of the Contracting Party where patent protection is sought.

1.03 Item (v). The term “communication” refers to both written and electronically transmitted documents. It excludes oral statements, either in person or telephonically.

1.04 Item (vi). The term “records of the Office” is used in the definitions of “recordal” (item (vii)), “applicant” (item (viii)) and “owner” (item (ix)), and in defining mistakes for the purposes of requesting correction (Article 9(1)(a)). The term refers to the collection of all data maintained or recorded by an Office in respect of applications filed and patents granted by that Office or by another authority with effect for the Contracting Party concerned, for example, data maintained by a Contracting State to the European Patent Convention in respect of European patents granted by the European Patent Office designating that Contracting State, irrespective of whether the European Patent Organisation is a Contracting Party. This provision is important for Articles 7 and 8. The term “records of the Office” also includes the texts of such applications (description, claims, abstract, drawings, etc.), as well as any amendments or corrections requested or made. Data concerning both applications and patents are included, since certain changes (concerning, for example, a change in a name or address, a change in ownership or the correction of a mistake) could apply equally to pending applications and to granted patents.

1.05 Item (vii). The term “recordal” refers to any act of including data in the records of the Office, regardless of the means used for including such data or the medium in which the data are recorded or stored.

1.06 Items (viii) and (ix). Where the applicable law of a Contracting Party provides that several persons may jointly be applicants or owners, the words “applicant” and “owner” must be construed as including “applicants” and “owners.” These items are intended to link the obligations concerning applicants and patent owners to the persons that are indicated as such in the records of the Office, rather than to the persons that might have legal claims of ownership or other rights outside of the context of those records. This is because the Office cannot reasonably be expected to undertake actions concerning persons which are not listed in its records, nor to act on the basis of legal claims and titles outside of its knowledge. In the case of transfer of ownership (see Article 8), during the period of time between the actual legal transfer and recordal of the change in ownership, the transferor continues to be referred to in the Treaty as the “applicant” or “owner” (that is, the person whom the records of the Office show as the applicant or owner), and the transferee is referred to as the “new applicant” or “new owner” (see Article 8(1)). Once recordal of the change in ownership has taken place, the transferee becomes the “applicant” or “owner” (since he is now the person whom the records of the Office show as the applicant or owner).

1.07 Item (x). The term “representative” refers to any lawyer, agent or other person, or to any firm or partnership, that can be a representative under the law applicable to the Office. Each Office is free to restrict representation to representatives admitted to practice before it, for example, to registered patent attorneys (see Article 4(1)). Questions regarding the name of the representative are regulated by Rule 2(1)(b).

1.08 Items (xi) to (xviii). These items seem to be self-explanatory.

Note on Article 2
(Application)

2.01 Paragraph (1). This paragraph contains a list of elements which may be required in respect of an application. This list, as follows from paragraph (9), is exhaustive.

2.02 Item (i). It is intended that the form and content of the request part of the application, which is the portion of the application which addresses formalities rather than substantive disclosure, be harmonized as far as possible under the Treaty. A draft Model International Form (Form N° 1) for the request part of an application is included in the draft Regulations, and a maximum list of allowable indications or elements is defined in paragraph (2).

2.03 Item (ii). Requirements concerning the adequacy of the disclosure are not included in this item. Genetic sequence listings, references to deposits of microorganisms, computer program listings, as well as an indication of the best mode for carrying out the invention, may be included in the description and may even be required to be included, but this would be a substantive and not a formal requirement.

2.04 Item (iii). Requirements concerning the form and interpretation of the claims are not included in this item. A requirement concerning an indication of the number of claims is also not included as the sanction for failure to provide such an indication, namely the rejection of the application, would be too severe.

2.05 Item (iv). The maximum allowable formal requirement concerning drawings would, under this item, be that, where they are referred to in the description or in the claims, the Office may require that they be included in the application. It is understood that an applicant could, at his discretion, file drawings where they are not referred to in the description or in the claims, . Where drawings would be necessary for the understanding of the invention but the application does not contain drawings, the Office may require the furnishing of such drawings, but this would be a substantive--and not a formal--requirement.

2.06 Item (v). Requirements concerning the form of the abstract are not included in this item.

2.07 Paragraph (2). This paragraph contains a list of indications and elements which may be required in respect of the request part of the application. This list, as follows from paragraph (9), is exhaustive.

2.08 Item (i). The wording of this item means that an Office can consider that an application which does not contain an express petition for the granting of a patent is defective. Such a case could not occur where the application is made on a Form prepared in accordance with the Regulations since such a Form contains an express petition for the granting of a patent.

2.09 Item (ii). Where a title is required by a Contracting Party, the title should be the title of the invention that the applicant would wish to appear on the issued patent, and should, if possible, be the same for corresponding applications (for example, in a priority application and the later application claiming its priority, if the applications are identical).

2.10 Item (iii). The details concerning the indication of the name and address of the applicant are specified in the Regulations (see Rule 2(1)(a) and (2)).

2.11 Item (iv). The indication of a State of nationality, of a State of domicile and of a State of real and effective industrial or commercial establishment may be relevant for the application of international treaties (see, for example, Articles 2 and 3 of the Paris Convention). It follows from the introductory phrase of paragraph (2) that a Contracting Party need not require the indication of all three such States (even if their indication would be possible); a Contracting Party may require two, one, or even none. As regards the term “domicile” in respect of legal entities, its interpretation is left to the Contracting Parties; that term could mean, for example, the place of the legal headquarters of the entity, or the principal place of business of the entity.

2.12 Item (v). Where, in a State, a legal entity may be constituted under the particular law of a territorial unit existing within such State, the name of that territorial unit may be required. Thus, a Contracting Party may require the indication of both the name of the State and, where applicable, the name of the territorial unit within that State (for example, “United States of America, California”).

2.13 Item (vi). The details concerning the indication of the name and address of the inventor are specified in the Regulations (see Rule 2(1)(a) and (2)). The last part of this item is inspired by Rule 4.6(b) of the Regulations under the Patent Cooperation Treaty (PCT).

2.14 Item (vii). The basis of the applicant’s entitlement to receive the patent could be, for example, the fact that the applicant is the inventor’s employer, the inventor’s assignee or the inventor’s heir.

2.15 Item (viii). The details concerning the indication of the name and address of the representative are specified in the Regulations (see Rule 2(1) and (2)). The representative can be a natural person, a legal entity, firm or a partnership (see Article 1(x)).

2.16 Item (ix). The details concerning the indication of an address for service are specified in the Regulations (see Rule 2(2)(b), (c) and (d)).

2.17 Item (x) and (xi). These provisions are self-explanatory.

2.18 Item (xii). This item does not affect the rules concerning the case where the priority is claimed subsequent to the filing of the application, a possibility which is allowed under

Article 4D(1) of the Paris Convention. Paragraph (7)(a) allows for the possibility in certain cases of asking, subsequent to the filing of the application, for proof under Article 4D(3) and (5) of the Paris Convention.

2.19 Item (xiii). This provision would apply, for example, to applications filed under the European Patent Convention.

2.20 Item (xiv). This item would apply, for example, where a Contracting Party provides a grace period for disclosures of the inventor and requires, as part of the application, a declaration enumerating the disclosures that had been made, or where the temporary protection referred to in Article 11 of the Paris Convention is to be invoked in the application. Its inclusion in Article 2(2) does not mean, however, that a Contracting Party is prevented from allowing the benefit of such protection to be invoked at a later stage. Paragraph (7)(b) allows for the possibility of requiring, in either of these circumstances (see, in particular, Article 11(3) of the Paris Convention), the submission of documentary evidence. This provision also enables an applicant to take advantage of temporary protection resulting from the presentation of goods in an exhibition other than an official or officially recognized international exhibition (such as a national exhibition) if the law of the Contracting Party provides for such a possibility. It should be noted that only some countries provide for a grace period for all kinds of pre-filing-date disclosures, and that only a few countries require a declaration of such disclosures in the application.

[2.20bis Item (xivbis). This provision is presented in brackets because it is hoped that it will not be necessary to include this provision into the Treaty.]

2.21 Item (xv). This provision permits a Contracting Party to require an applicant to state all prior art references of which the applicant is aware.

2.22 Item (xvi). The “person specified in paragraph (6)” is the applicant or his representative.

2.23 Paragraph (3). This provision, which deals with the presentation of the request part of the application, appears also with a similar wording in other Articles of the Treaty (in Article 4(3)(e) as regards a power of attorney, in Article 7(1)(a) in respect of a request for the recordal of a change in a name or address, in Article 8(1)(a) as regards a request for the recordal of a change in ownership, in Article 9(1)(a) in respect of a request for the correction of a mistake). In all cases, the provision relates only to acceptance or refusal of an application, request or other communication on formal grounds. No obligation concerning acceptance or refusal on substantive grounds is implied. It should be noted that, while a Contracting Party is obliged to accept a form corresponding to each of the Forms contained in the Regulations, an applicant is free to use any other form acceptable to the Contracting Party.

2.24 Paragraph (3)(i). The phrase “corresponding to the application Form provided for in the Regulations” implies that the actual form submitted to the Office must conform to the language requirements as stated in paragraph (5). The Model International Form contained in the Regulations (Form N° 1) will be prepared in the languages of the Treaty (namely, English, Arabic, Chinese, French, Russian and Spanish). The relevant language version of the Model International Form may be used as such (where a Contracting Party allows one of the

languages of the Treaty), or in a translation into the language or into one of the languages of or admitted by a Contracting Party.

2.25 Paragraph (3)(ii). As regards signature of communications by telefacsimile and by other electronic means, see Article 5(2) and (3). This provision will be completed after further study.

2.26 Paragraph (4). The Regulations under the Patent Cooperation Treaty define the physical requirements which must be accepted by the Office of a Contracting Party. In particular, Rules 11.2 to 11.13 concern fitness for reproduction, material to be used, separate sheets, size of sheets, margins, numbering of sheets, numbering of lines, writing of text matter, drawings, formulae and tables in text matter, words in drawings and alterations. Item (ii) will be completed after further study.

2.27 Paragraph (5). This provision does not allow a Contracting Party to refuse a bilingual application Form where one of the languages used on the Form is a language of or admitted by that Contracting Party. However, in such a situation, the applicant would not be able to rely on the data presented in the language of the Form which is not a language of or admitted by the Contracting Party. The term “language or one of the languages of or admitted by the Office” refers, where no explicit language requirement exists, to the practice of an Office.

2.28 Paragraph (6)[(a)]. The brackets around the “(a)” are required because of the brackets around subparagraph (b). Paragraph (2)(xvi) allows a Contracting Party to require that the application be signed, whereas paragraph (6)[(a)] specifies that, where the Contracting Party requires a signature, the applicant may, if he has a representative, choose either to sign the application himself or to have his representative sign it. It should be understood that, where the applicant is a legal entity, the application, if it is not signed by a representative, will be signed on behalf of, rather than by, the applicant (see Rule 5(1)). The question as to whether a person is lawfully authorized or empowered to sign on behalf of a legal entity is to be determined in accordance with the national (or regional) law applicable to that entity.

[2.28*bis* Paragraph (6)(b). This subparagraph is in brackets because of the brackets around item (xiv*bis*) of paragraph (2). If a Contracting Party requires that an oath or declaration be signed, it may not require certification of the signature (see Article 5(4).]

2.29 As regards the case where the application is signed by a representative, Article 4(3)(d) allows the Contracting Party concerned to require that the document appointing the representative be submitted to its Office within the time limit fixed by the Contracting Party, subject to the minimum time limit fixed in Rule 4.

2.30 Paragraph (7)(a) and (b). Where an application contains a declaration claiming the priority of an earlier application, or the non-prejudicial nature of a prior disclosure, as provided for by paragraph (2)(xii) or (xiv), respectively, a Contracting Party may require that evidence in support of those declarations be furnished to the Office. This paragraph is not controlling as to whether such evidence can or must be submitted at the time of filing. It should be noted that, in the case of a claim for priority, Article 4D(3) of the Paris Convention provides that the certified copy of the application previously filed may be furnished, without

fee, at any time within three months of filing the subsequent application, and that it may be furnished even later if allowed by national law. Paragraph (7)(a), in conjunction with paragraph (9), is intended to prohibit a Contracting Party from requiring submission of a copy or a certified copy of a priority application where the priority application had been filed with the same Office in which the later application is filed, that is, where the priority application already exists in the files of the Office.

2.31 Paragraph (8). In addition to the fee to be paid in respect of the application, there may be separate fees for the publication of the application and the granting of the patent. However, it is also possible (and compatible with the Treaty) to combine those fees and require payment of such a combined fee at the time of filing the application (which may nevertheless be called “application fee” because it is to be paid at the time of filing the application).

2.32 Paragraph (9). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (8), not only at the time of filing of the application, but also throughout the application stage (ending with the grant or refusal of the patent), always subject, naturally, to the possibility of requiring the furnishing of evidence under paragraph (10). It should, however, be understood that paragraph (9) does not preclude a Contracting Party from allowing the inclusion of additional optional information in an application, such as an internal file number of the applicant or representative, a request for a possible refund of fees and an address for the refund or an indication of which drawing to publish with the abstract, or from requiring, where necessary, during the examination of an application, documents concerning the ability of a certain person (such as a minor or a person under tutelage) to file the application.

2.33 Examples of requirements that would be prohibited under paragraph (9) could be, for example, further requirements concerning the identification of the applicant such as his fiscal identification number, or a requirement to furnish, where the applicant is a legal entity, a document evidencing that the person signing on behalf of that legal entity is a duly authorized officer thereof (such evidence could, however, be required in case of doubt, pursuant to paragraph (10)).

2.34 Paragraph (10). This provision does not relate to the correction of mistakes, but to cases where the Office believes that an indication or an element under any of paragraphs (1) to (8) is not true. Evidence may be required whenever the application contains an allegation the veracity of which is doubtful. This applies even in the case of an allegation which is not required to be made under the law of the Contracting Party concerned. In the case of an allegation which is required to be made under that law, the provision of paragraph (10) constitutes an exception to the prohibition contained in paragraph (9). Such would be the case, for example, where the applicant claims the benefit of Article 3 of the Paris Convention but there is doubt as to the veracity of the applicant’s allegations as to his domicile, etc. Concerning the case where the authenticity of a signature in the application is in doubt, the applicant may be required to furnish evidence of that authenticity (which he could do by furnishing evidence which he believes to be convincing or, if the Office is still in reasonable doubt, by furnishing certification (see also Note 5.06)).

(Filing Date)

3.01 Article 3 sets an international standard for the granting of a filing date. In that respect, Article 3 is different from other provisions of the Treaty, such as Article 2, which establish a maximum list of allowed requirements. The international filing date standard is useful, in particular, for two situations, namely for an application whose priority is claimed under Article 4 of the Paris Convention and for an application in respect of which such priority is claimed. In respect of the first situation (first filing), Article 3 guarantees that priority can be claimed on the basis of any application which fulfills the international filing date standard and can only be claimed on the basis of such an application. It also guarantees that the filing date of such an application (and therefore the priority date) would not be subsequently lost, for example, by failure to pay fees; however, an Office may still require payment of a fee for the furnishing of a certified copy of the application to serve as a priority document. In respect of the second situation (subsequent filing), Article 3 guarantees that the applicant will be able to meet the 12-month time limit under Article 4C(1) of the Paris Convention by filing an application which complies with the international filing date standard.

3.02 Paragraph (1)(a)(iii). For the purpose of determining whether a filing date should be accorded, the Office will only establish whether the communication contains something that, on the face of it, appears to constitute a description. The question of whether the description satisfies the substantive requirements for the grant of a patent is not relevant to this determination.

3.03 Paragraph (1)(a)(iv). This indication could, for example, consist of the words “Description of the Invention.”

3.04 Paragraph (1)(b). As regards the term “language or one of the languages of or admitted by the Office,” see Note 2.27.

3.05 Paragraph (2). This paragraph seems to be self-explanatory.

Note on Article 4

(Representation; Address for Service)

4.01 The term “representative” is defined in Article 1(x). Article 4 typically applies to patent agents and attorneys “in private practice.” This Article relates only to the appointment itself and to the possible limitation of the appointment, but does not deal with the termination of the appointment. In the latter respect, and in respect of any other matter relating to representation which is not covered by the Treaty, a Contracting Party will be free to establish whatever rules it wishes to establish. For example, a Contracting Party may provide that the appointment of a new representative terminates the appointment of all previous representatives unless otherwise indicated in the power of attorney. Or, a Contracting Party may allow sub-representation and, if that is the case, require that, where the power of a representative extends to the appointment of one or more sub-representatives, the power of attorney expressly authorize a representative to appoint such sub-representatives.

4.02 Paragraph (1). Under this provision, a Contracting Party is allowed to require that the appointed representative be a person, for example, a registered patent attorney, who is admitted to practice before the Office. A Contracting Party, however, may have a less strict requirement and may, for example, merely require the appointed representative to have a permanent address on its territory.

4.03 Paragraph (2)(a). This requirement may apply even where the applicant or owner, or, in the case of a transfer of the application or the patent, the new applicant or new owner, is a national of the Contracting Party concerned or has a domicile or an establishment in the territory of that Contracting Party. Thus, the effect of the Treaty in a Contracting Party is not limited to situations involving applicants or owners from other Contracting Parties but extends to all situations, in order to achieve the highest possible degree of harmonization. However, representation may not be required for the filing of an application or the payment of any fee.

4.04 Paragraph (2)(b). The laws of some countries do not require that a representative be appointed before their Offices even where the applicant or owner, or, in the case of change in ownership, the new applicant or new owner (see Article 8(1)(a)), has neither a domicile nor a real and effective industrial or commercial establishment on the territory of the country concerned. The laws of some of those countries, however, require that an address for service in their territory be provided, and this is expressly permitted by the Treaty, except that such requirement may not be applied for the filing of an application or the payment of any fee. Where the applicant, owner or other interested person has a domicile or a real and effective industrial or commercial establishment in the country concerned, a Contracting Party may require him, at his option, to indicate the address of that domicile or establishment as his address or provide an address for service. This is deemed necessary since the rationale for exempting a person with a domicile or establishment on the territory of the Contracting Party from the requirement of having an address for service on that territory would be defeated if he indicated, for example, a post office box as his address.

4.05 Paragraph (3)(a). It follows from this paragraph that a Contracting Party may refuse the appointment of a representative made by a communication other than a power of attorney, for example, a statement in the application itself or in the request itself for recordal of a change or of a correction (since the communication may be required to be separate). Under this provision, a Contracting Party is not precluded from accepting a power of attorney contained in the application, or in the request for recordal of a change or of a correction. The reference, in this provision, to “any other interested person” covers, for example, a petitioner for revocation of a patent.

4.06 Paragraph (3)(b). This provision puts an obligation on Contracting Parties to accept a single power of attorney in respect of several applications, several patents or both applications and patents of the same person. Contracting Parties must also accept what is sometimes referred to as a “general power of attorney,” that is, a power of attorney that relates to all existing and future applications and/or patents of the same person. In respect of the latter type of power of attorney, to which the words “subject to any exception indicated by the appointing person” relate, a Contracting Party must allow the person making the appointment to indicate possible exceptions in the power of attorney itself (for example, appointment only for future applications and patents), or to make exceptions at a later time.

4.07 Article 4 does not regulate further details of the so-called “general power of attorney.” For example, each Contracting Party is free to allow that several representatives be appointed in such a power of attorney or that several of those powers of attorney, each relating to different representatives, be made by the same person.

4.08 Paragraph (3)(c). An applicant or owner could appoint a representative in respect of certain matters (for example, filing of applications) and appoint another representative in respect of other matters (for example, treatment of objections and oppositions). To the extent that representation is required in accordance with paragraph (2)(a), any Contracting Party may provide that a limitation of the powers of a representative shall be valid only if one or more additional representatives are appointed to comply with paragraph (2)(a). The possibility for a Contracting Party to require that the right for a representative to withdraw an application or surrender a patent be expressly mentioned in the power of attorney is justified in view of the particularly important consequences of such acts.

4.09 Paragraph (3)(d). Rule 4 of the Regulations contains the details in respect of the period referred to in this provision.

4.10 Paragraph (3)(e). As regards the presentation of the power of attorney, reference is made to the Notes relating to the presentation of the request part of the application under Article 2(3) (Notes 2.23 to 2.25). The Regulations contain a Model International Form (Form N° 2) for the power of attorney.

4.11 Paragraph (4). Reference is made to the Notes under Article 2(5) (see Note 2.27).

4.12 Paragraph (5). This provision seems to be self-explanatory.

4.13 Paragraph (6). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (3) to (5) with respect to the matter of representation as covered by the Treaty, subject, naturally, to the possibility of requiring the furnishing of evidence under paragraph (7).

4.14 Paragraph (7). This provision relates to the situation where the power of attorney contains an allegation the veracity of which is doubtful. This applies even in the case of an allegation which is not required to be made under the law of the Contracting Party concerned. In the case of an allegation which is required to be made under that law, the provision of paragraph (7) constitutes an exception to the prohibition contained in paragraph (6).

Note on Article 5 (Signature)

5.01 Article 5 applies whenever a signature is required, whether such requirement is mentioned in the Treaty or follows only from the national (or regional) law.

5.02 Paragraph (1). This paragraph seems to be self-explanatory.

5.03 Paragraph (2)(a). The phrase “the printout produced by the telefacsimile” includes, where no actual printout is made in a given case, the printout that could have been made by the Office as a result of the transmission.

5.04 Paragraph (2)(b). Rule 5(2) of the Regulations contains the details in respect of the period referred to in this provision.

5.05 Paragraph (3). An example of “electronic means other than telefacsimile” would be direct (on-line) electronic communication between computers.

5.06 Paragraph (4). This provision also applies in case of withdrawal of an application or surrender of a patent. In case of reasonable doubt as to the authenticity of the signature, the Office may require the applicant/requestor to furnish evidence of authenticity (which the applicant/requestor could do by furnishing evidence which he believes to be convincing or, if the Office is still in reasonable doubt, by furnishing a certification (see also Note 2.34)).

Note on Article 6 (Unity of Invention)

6.01 This article is modeled after Article 5 of the basic proposal submitted to the 1991 Diplomatic Conference at The Hague (see documents PLT/DC/3 and 69), except that the said basic proposal was intended to establish a standard whereas the provisions of Article 6 only apply where a Contracting Party provides for the requirement of unity of invention. The following paragraphs reproduce the explanations on the said former Article 5 contained in document PLT/DC/5 (Note 5.01 to 5.04).

6.02 Paragraph (1). It is to be noted that Rules 6 and 7 contain further details concerning the requirement of unity of invention.

6.03 Paragraph (2). The essential purpose of the requirement of unity of invention is to facilitate the administration and the search of applications. Accordingly, paragraph (2) provides that, while paragraph (1) requires that applications must conform to the requirement of unity of invention, if a patent happens to be granted on an application that does not comply with that requirement, the failure to comply with the requirement of unity of invention cannot be the ground for the invalidation or revocation of the patent. In other words, and as already stated, since the purpose of the requirement of unity of invention is to facilitate the administration and the search of applications, failure to comply with the requirement can and needs only be redressed at the application stage. At that stage, the sanction for non-compliance is the refusal of the grant of a patent unless the application is restricted through the elimination of certain claimed subject matter. The subject matter so eliminated may then be included in one or more “divisional” applications.

6.04 An objection of lack of unity should only be made when lack of unity seriously disturbs the procedure and, if made, it should be made as soon as possible, that is, normally at the latest at the stage of the first examination based on the prior art. At a later stage of procedure, it should not be raised unless as a consequence of amendment of claims or for other clearly justified reasons.

6.05 Occasionally, in cases of lack of unity of invention, particularly if noted only after assessment of the prior art, the examiner will be able to make a complete search and examination for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. It is understood that, in those cases, the search and examination for the additional invention(s) should be completed in respect of the whole application, and no objection of lack of unity of invention should be raised.

6.06 It may have to be examined whether the principle expressed in Article 6(2) should not apply also to the formalities referred to in Article 2(1)(v), (2)(i), (ii), (iv), (v), (vi), (vii), (viii), (ix), (x), (xi), (xii), (xiv), [(xiv^{bis})], (xv) and (xvi), (3)(i) and (ii), (4)(i) and (ii), (6)[(a) and (b)], 7(a) and (b) and (8).

Note on Article 7

(Request for Recordal of Change in Name or Address)

7.01 The procedure concerning requests for recordal of changes in names or addresses under Article 7 is standardized for applicants and owners.

7.02 Paragraph (1)(a). It follows from the wording of this paragraph that a Contracting Party may refuse a request made by oral communication. It is also clear that this Article applies to changes in names, changes in addresses and changes in both names and addresses.

7.03 As regards the presentation of the request, reference is made to the Notes under Article 2(3) (Notes 2.23 to 2.25). The Regulations contain a Model International Form (Form N° 3) for the request for recordal of a change in name or address.

7.04 Paragraph (1)(b), item (i). The name and address referred to in this item must be that which is reflected in the records of the Office concerned. If that is not the case, the Office can require either the furnishing of evidence under paragraph (5) or that another change be recorded beforehand. For example, where the residence of the applicant or owner appears in the records of the Office as being "City X" and the request for the recordal of the change in the name indicates "City Y" as the applicant's or owner's residence, the Office concerned may refuse the request as long as a separate request for recordal of a change in address from "City X" to "City Y" has not been submitted.

7.05 Items (ii) and (iii). These items seem to be self-explanatory.

7.06 Paragraph (1)(c). Reference is made to the Note under Article 2(5) (see Note 2.27). Where the request is filed in a language other than that of or admitted by the Office, a Contracting Party is permitted to reject the request, but it is understood that the request could be re-filed in the proper language with no loss of rights.

7.07 Paragraph (1)(d). The amount of the fee could differ depending on the number of the patents or applications involved (see paragraph (1)(e)).

7.08 Paragraph (1)(e). The procedure under this Article is the same whether the requested change concerns one or more applications, one or more patents, or a combination of one or more applications and one or more patents, provided that all of the relevant application and patent numbers are provided. Where a single request relates to both patents and applications, and a Contracting Party treats changes concerning patents and changes concerning applications in a different manner from the computerization or administrative viewpoint, that Contracting Party could meet its requirements by making copies of the request.

7.09 Paragraph (2). Rule 8 of the Regulations contains the details for identifying an application whose application number is not known, as referred to in this paragraph.

7.10 Paragraph (3). While Model International Forms are not provided for requests for recordal of a change in the name or address of a representative or of a change in the address for service, the Model International Form (Form N° 3) for the request for recordal of a change in name or address may be used with appropriate alterations.

7.11 Paragraph (4) establishes the exhaustive character of the list of requirements under paragraphs (1) to (3). One of the requirements which would be prohibited is the requirement of the furnishing of a certified copy of the recordal of the change in the register of companies as a condition for the recordal of the change in the records of the Office.

7.12 Paragraph (5). This provision would enable Contracting Parties to require evidence, for example, in the case of a change in both name and address where there is a doubt as to whether such change is not in fact a disguised change in ownership.

Note on Article 8

(Request for Recordal of Change in Ownership or Change in Inventorship)

8.01 The procedure concerning requests for recordal of changes in ownership under Article 8 is standardized for applicants and owners. It is to be noted that this Article deals with the procedures which should be fulfilled before a Patent Office and not before any other authorities of a country, for example, the fiscal authorities.

8.02 It is also to be noted that, where an applicant or owner intends to request the recordal of a change in ownership by one of the means provided for in this Article, no Contracting Party may require more than what is provided in Article 8. On the other hand, if a person intends to request the recordal of a change in ownership in a Contracting Party by means other than those covered by Article 8 but admitted by that Contracting Party, the latter is entitled to require that the request comply with all the requirements applicable under its law to such means (which requirements may be stricter than those provided for in Article 8).

8.03 Paragraph (1)(a). It follows from the wording of this paragraph that a Contracting Party may refuse a request made by oral communication.

8.04 As regards the presentation of the request, reference is made to the Notes under Article 2(3) (Notes 2.23 to 2.25). The Regulations contain a Model International Form (Form N° 4) for the request for recordal of a change in ownership.

8.05 Paragraph (1)(b) to (e) distinguishes among a change in ownership which results from a contract (assignment, etc.), a change in ownership which results from a merger and a change in ownership which results from operation of law or from a court decision (inheritance, bankruptcy, etc.).

8.06 Paragraph (1)(b) relates to any change in ownership which results from a contract. Where recordal of the change in ownership is requested by the new applicant or the new owner, any Contracting Party may require that the request indicate the fact that the change in ownership results from a contract and that the request be accompanied by a document evidencing the change in ownership. However, where recordal is requested by the applicant or owner himself, that indication and such a document may not be required. It is presumed, in such a case of voluntary transfer, that the applicant or owner would not request recordal of a change in ownership which had not in fact occurred, since that would be against his own interest.

8.07 Items (i) to (iii). These items list three different documents which, alternatively, may serve as evidence of a transfer of ownership resulting from a contract. Where a Contracting Party requires that the request be accompanied by one of these documents, it must accept any one of the three documents listed. It is up to the requesting party to choose one of them to accompany his request.

8.08 Items (i) and (ii). Where the requesting party chooses to furnish a copy of the contract or an extract of the contract as provided in these items, a Contracting Party is free to require that the copy or the extract be certified, including by any representative admitted before the Office. It shall be the choice of the applicant as to who (a representative, a notary public or another competent public authority) certifies the relevant document.

8.09 Item (iii). Where the requesting party chooses to furnish a certificate of transfer as provided in this item, a Contracting Party may not require that this certificate be the subject of any form of certification. One of the important points in respect of a certificate of transfer is that it must be signed by both the applicant and the new applicant, or both the owner and the new owner, and cannot be signed by representatives. The Regulations contain a Model International Form (Form N° 5) for a certificate of transfer.

8.10 Paragraph (1)(c) relates to any change in ownership which results from a merger, or from the reorganization or division of a legal entity. Any Contracting Party may require that the request indicate the fact that the change in ownership results from a merger, or from the reorganization or division of a legal entity and that the request be accompanied by a copy of a document evidencing that fact. This document must originate from the competent authority. It may, for example, be an extract from a register of commerce. It need not be signed by the applicant and the new applicant, or the owner and the new owner. The Contracting Party may only require that a copy of the document be furnished; it may not require the original of the document. On the other hand, it may require that the copy be certified, including by any representative admitted before the Office, at the option of the applicant.

8.11 Paragraph (1)(d). Where a co-applicant or co-owner transfers his share in an application or patent, he may, under the applicable law, need the consent of any other co-applicant or co-owner to obtain recordal of the change in ownership. The Treaty allows Contracting Parties to require the furnishing of a document in which the said consent is given.

However, the use of the words “any Contracting Party may require” makes it clear that a Contracting Party could, for example, be satisfied if the request for the recordal of the change in ownership is signed by a representative of the co-applicants or co-owners if the latter had appointed him to represent them.

8.12 Paragraph (1)(e) relates to any change in ownership which does not result from a contract, from a merger, or from the reorganization or division of a legal entity. In such a case, the Contracting Party may require that the request indicate the actual ground for the change in ownership, and that the request be accompanied by a copy of any document which it deems appropriate to evidence the change. Although the Contracting Party may not require that the original of such a document be furnished, it may, however, require that the copy emanate from the authority which issued the document or that it be certified, including by any representative admitted before the Office, at the option of the applicant.

8.13 It follows from Article 5(4) that no Contracting Party may require that any signature appearing in the request (paragraph (1)(a)) or in any document accompanying the request (paragraphs (1)(b) to (e)) be the subject of any kind of certification.

8.14 Paragraph (1)(f). As regards item (iv), reference is made to the explanations given under Article 2(2)(a)(v) (see Note 2.12).

8.15 Paragraph (1)(g). Reference is made to the explanations given under Article 7(1)(d) (see Note 7.07).

8.16 Paragraph (1)(h). Reference is made to the explanations given under Article 7(1)(e) (see Note 7.08).

8.17 Paragraph (2). Reference is made to the explanations given under Article 2(5) (see Note 2.27). A Contracting Party may require that the documentary evidence submitted in support of recordal of a change in ownership be translated into one of the languages of or admitted by the Office. It may also, if the words appearing within brackets are maintained, require that the translation be accompanied by a statement signed by the person who made the translation acknowledging the completeness and faithfulness of the translation; however, it is questionable whether such a statement, called “verification” in some countries, really serves a useful purpose, for example, where the translator is not an officially recognized translator with a reputation to defend.

8.18 Paragraph (3). Rule 8 of the Regulations contains the details for identifying an application whose application number is not known, as referred to in this paragraph.

8.19 Paragraph (4). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (3) with respect to a request for the recordal of a change in ownership, always subject, naturally, to the possibility of requiring the furnishing of evidence under paragraph (5). An example of a prohibited requirement could be making the admissibility of the request dependent on an advertisement of the change in ownership in one or several newspapers. Since the Treaty does not regulate the substantive requirements relating to the validity of a change in ownership, a Contracting Party may require the fulfillment of additional conditions, for example, in situations concerning inheritance, bankruptcy or tutelage.

8.20 Paragraph (5). This paragraph corresponds to paragraph (10) of Article 2, paragraph (7) of Article 4, paragraph (5) of Article 7, paragraph (5) of Article 8 and paragraph (4) of Article 9.

8.21 Paragraph (6). This provision refers to a change in inventorship resulting, for example, from a change or a deletion of claims contained in the application. The indications to which this provision refers only relate to the inventor superseding the previously identified inventor.

8.22 During the first session of the Committee of Experts (see document PLT/CE/I/5, paragraph 138), several delegations and representatives of non-governmental organizations suggested that the International Bureau include, as an additional matter, an article to cover the request for a recordal of a licensing agreement for a patent. While it was first decided that those suggestions should be followed for the next draft of the Treaty, the Committee of Experts later approved a suggestion by the Director General that new matters should be limited to provisions on the filing date of an application and unity of invention only (see document PLT/CE/I/5, paragraphs 138 and 202). Therefore, no provisions on the recordal of a licensing agreement or of a change in such an agreement have been included in the draft Treaty contained in this document. Nevertheless, the following draft Article could be considered in respect of a request for recordal of a licensing agreement.

Article 8bis

Request for Recordal of a Licensing Agreement

(1) [*Request*] (a) Any Contracting Party which allows for recordal of licensing agreements shall accept that a request for the recordal of a licensing agreement be made in a communication signed by the applicant or owner or his representative, or by the licensee or his representative, and indicating the number of the application or patent concerned. As regards the requirements concerning the presentation of the request, no Contracting Party shall refuse the request,

(i) where the request is presented in writing on paper, if it is presented on a form corresponding to the Form provided for in the Regulations,

(ii) where the Contracting Party allows the transmittal of communications to the Office by electronic means... [reserved].

[Article 8bis(1)(b), continued]

(b) Any Contracting Party may require that, where the recordal is requested by the licensee, rather than by the licensor, the request be accompanied, at the option of the requesting party, by one of the following:

(i) a copy of the licensing agreement, which copy may be required to be certified, at the option of the requesting party, by any representative admitted to practice before the Office or by a notary public or any other competent public authority as being in conformity with the original licensing agreement;

(ii) an extract of the licensing agreement showing at least the territory, duration or any quantitative extent of the licensing agreement, which extract may be required to be certified, at the option of the requesting party, by any representative admitted to practice before the Office or by a notary public or any other competent public authority, as being a true extract of the licensing agreement.

(c) Any Contracting Party may require that the request indicate:

(i) the name and address of the applicant or owner;

(ii) the name and address of the licensee;

[Article 8*bis*(1)(b), continued]

(iii) where the applicant or the owner has a representative, the name and address of that representative;

(iv) where the applicant or owner has an address for service, such address;

(v) where the licensee has a representative, the name and address of that representative;

(vi) where the licensee has an address for service, such address.

(d) Any Contracting Party may require that, in respect of the request, a fee be paid to the Office.

(e) A single request shall be sufficient even where the licensing agreement concerns more than one application or patent, or to both applications and patents, provided that the applicant or owner and the licensee are the same for each application or patent, respectively, and that the numbers of all applications and patents concerned are indicated in the request.

[Article 8*bis*, continued]

(2) [*Language; Translation*] Any Contracting Party may require that the request referred to in paragraph (1)(a) be in the language or in one of the languages of or admitted by the Office and, if the document referred to in paragraph (1)(c) is not in the language or in one of the languages of or admitted by the Office, that the request be accompanied by a translation of that document in the language or in one of the languages of or admitted by the Office, [and that such translation be accompanied by a statement signed by the person who made the translation to the effect that, to the best of that person's knowledge, the translation is complete and faithful].

(3) [*Unknown Application Number*] Notwithstanding paragraph (1)(a) and (e), where the application number of any application concerned has not yet been issued or is not known to the applicant or his representative, the request shall identify that application as prescribed in the Regulations.

(4) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (3) be complied with in respect of the request referred to in this Article.

(5) [*Evidence*] Any Contracting Party may require that evidence be furnished to the Office where that Office may reasonably doubt the veracity of any indication contained in the request or in any document referred to in the present Article.

Note on Article 9

(Request for Correction of a Mistake)

- 9.01 Article 9 is drafted along the same lines as Articles 7 and 8. In particular, the procedure concerning the request for correction of a mistake is standardized for applicants and owners.
- 9.02 Paragraph (1)(a). As regards the presentation of the request, reference is made to the Notes under Article 2(3) (Notes 2.23 to 2.25). The Regulations contain a Model International Form (Form N° 6) for the request for correction of a mistake.
- 9.03 Paragraph (1)(b). Reference is made to the explanations given under Article 7(1)(b) (see Notes 7.04 and 7.05).
- 9.04 Paragraph (1)(c). Reference is made to the explanations given under Article 2(5) (see Note 2.27).
- 9.05 Paragraph (1)(d). Reference is made to the explanations given under Article 7(1)(d) (see Note 7.07).
- 9.06 Paragraph (1)(e). Reference is made to the explanations given under Article 7(1)(e) (see Note 7.08).
- 9.07 Paragraph (1)(f). This provision allows a Contracting Party to require that a replacement page be submitted with a request for correction of a mistake. In the case where the request applies to more than one application and/or patent, a single request may still be used; however, an Office may require that a separate replacement page be submitted for each application or patent, to facilitate the work of the Office. This provision will be completed with respect to corrections made electronically following additional study.
- 9.08 Paragraph (2). Rule 8 of the Regulations contains the details for identifying an application whose application number is not known, as referred to in this paragraph.
- 9.09 Paragraph (3). Reference is made to the explanations given under Article 7(4) (see Note 7.11).
- 9.10 Paragraph (4). This paragraph corresponds to paragraph (10) of Article 2, paragraph (7) of Article 4, paragraph (5) of Article 7 and paragraph (5) of Article 8.
- 9.11 Paragraph (5). In the case of mistakes attributable to an Office, the latter may adopt a different procedure such as *ex officio* correction or, where the mistake is noticed by the applicant or owner, or by his representative, correction following a request made in a simple letter. In any case, the Office cannot subject the correction of such a mistake to the payment of a fee.
- 9.12 Paragraph (6). It would hardly be possible to define in the Treaty what kinds of mistakes can or cannot be corrected, since there are many differences among national (or regional) laws, which would make it extremely difficult to achieve harmonization in this

respect. One example, however, of a correction which is unacceptable under practically all national (and regional) laws is a correction resulting in the addition of new matter.

Note on Article 10

(Opportunity to Make Observations, Amendments and
Corrections in Case of Intended Refusal)

10.01 This Article concerns refusals in respect of applications (Article 2), powers of attorney (Article 4), requests for recordal of a change in name or address (Article 7), requests for recordal of a change in ownership or change in inventorship (Article 8), [requests for recordal of a licensing agreement (Article 8bis),] requests for correction of a mistake (Article 9), any communication bearing a signature as regulated under the Treaty (Article 5), or any other communication or indication which may be affected by the provisions of the Treaty. It is expected that this Article would cover virtually all non-frivolous communications directed to an Office. The notion of “refusal” includes the cases where those applications, requests or communications are to be “deemed to be withdrawn” or are to be “deemed not to have been filed.”

10.02 The possibility to make observations should be given to the applicant or owner even if the refusal is based on non-payment or insufficient payment of fees.

10.03 Where the applicant or owner has a representative, the opportunity to make observations normally would be notified to the representative rather than to the applicant or owner.

10.04 The term “Office” does not include an appeal board even if it is part of or is otherwise connected to the Office. Therefore, Article 10 does not allow barring the opportunity to submit observations to the Office because of possibility of appeal to such an appeal board. If the application is considered withdrawn for lack of payment of a maintenance fee or for lack of submission of a request for substantive examination, this is not a “refusal” and Article 10 does not apply.

Note on Article 11

(Regulations)

11.01 Notes concerning the draft Regulations follow immediately in the present document.

II. NOTES ON THE DRAFT REGULATIONS

Note on Rule 1

(Abbreviated Expressions)

R1.01 Rule 1. This Rule seems to be self-explanatory.

Note on Rule 2

(Details Concerning Names and Addresses)

R2.01 Paragraph (1)(a). The words “any Contracting Party may require,” which appear in the introductory phrase, make it clear, here as well as in other provisions of this Rule (see, in particular, paragraphs (2)(a) and (b)), that any Contracting Party is entitled to require fewer indications or elements than those mentioned (and allowed) by the said provisions.

R2.02 The family or principal name must precede the given or secondary name.

R2.03 Paragraph (1)(b). In order to facilitate the administrative procedure before the Office, the firm or partnership needs to indicate its name only in the manner in which such name is customarily used.

R2.04 Paragraph (2)(a). This provision does not intend to regulate the question of who has the right to be granted the patent. Therefore, as regards applicants, it only applies where the law of a Contracting Party allows applications to be filed by several applicants.

R2.05 Paragraph (2)(b). The “customary requirements for prompt postal delivery” will often not be known by applicants who live outside of the country in question. It is therefore recommended that these requirements be indicated on any “Individualized International Form” (see Notes on Model International Forms contained in document PLT/CE/II/4).

R2.06 Paragraph (2)(c). The indication of a telephone number and of a telefacsimile number may not be required by a Contracting Party. It is, however, recommended to allow such indications to be furnished so that the Office can establish contacts through the most efficient and rapid means of communication. The sufficiency of an indication of an electronic mail address or mere facsimile number as an address for correspondence will be considered after further study, along with the question of electronic communications. The Model International Forms contain spaces for voluntary furnishing of these indications.

R2.07 Paragraph (2)(d). This paragraph seems to be self-explanatory.

R2.08 Paragraph (3). Thus, while a translation of a name or address cannot be required (it may not even be possible), a Contracting Party may require a transliteration of the name and address into the script (for example, Latin characters, Cyrillic characters, etc.) used by the Office.

Note on Rule 3

(Receipt of Communications)

R3.01 It is recognized that the same result would arise in the absence of this provision. Nonetheless, this provision emphasizes the flexibility maintained by each Contracting Party regarding the permissible methods of transmission of communications.

Note on Rule 4

(Details Concerning Representation)

R4.01 The time limit of two months for persons residing abroad takes into account the fact that postal transmittal usually takes more time between two countries than inside one country. These time limits of one month and two months start from the date on which, under Article 4(3)(d), a communication is submitted to the Office of a Contracting Party without the required power of attorney. Neither the Treaty nor the Regulations provide that such Office is obliged to send a notification to the interested party reminding him that the power of attorney is missing.

Note on Rule 5

(Details Concerning the Signature)

R5.01 Paragraph (1). This paragraph indicates that a communication is to be signed on behalf of, rather than by, a legal entity (see Note 2.28, above).

R5.02 Paragraph (2). Only one minimum period (of one month) is proposed in this Rule, this period being identical, whether the communication is sent from a place on the territory of the Contracting Party concerned or from a place outside that territory. The Rule does not provide for a longer minimum period for communications sent from a place outside the said territory because the paper whose reproduction was transmitted by telefacsimile can be sent at the same time as the transmittal by telefacsimile and one month appears to be sufficient for mailing to all destinations. Of course, Contracting Parties are free to provide for a longer period.

R5.03 Paragraph (3). The date of signing may be important, for example, to determine the legal competence of the person who gave the signature.

Note on Rule 6

(Details Concerning the Requirement of Unity of Invention)

R6.01 This provision is modeled after Rule 4 of the basic proposal submitted to the 1991 Diplomatic Conference at The Hague (see documents PLT/DC/3 and 69). The following paragraphs reproduce the explanations on the said former Rule 4 contained in document PLT/DC/5 (Note R4.01 to R4.28).

R6.02 Paragraph (1) contains the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an application.

According to that method, unity of invention will exist only when there is a technical relationship among the inventions involving one or more of the same or corresponding special “technical features.” The expression “special technical features” is defined in paragraph (1) as meaning those technical features that define a contribution that each of the inventions, considered as a whole, makes over the prior art.

R6.03 Independent and Dependent Claims. Unity of invention has to be considered in the first place only in relation to the independent claims in an application and not the dependent claims. In the context of Rule 6, “dependent” claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression “category of claim” referring to the classification of claims according to the subject matter of the invention claimed--for example, product, process, use or apparatus or means, etc.).

R6.04 If the independent claims are patentable and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim is patentable. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim is patentable and the combination claim includes all the features of the subcombination.

R6.05 If, however, an independent claim is not patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) should be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

R6.06 It is intended that the method contained in paragraph (1) for determining whether unity of invention exists should be able to be applied without it being necessary to search the prior art. Where the Office does search the prior art, an initial determination of unity of invention, based on the assumption that the claims are not invalidated by the prior art, might be reconsidered on the basis of the results of the search of the prior art. Where the Office does not search the prior art, unity of invention would be determined on the assumption that the claims are not invalidated by the prior art, unless it is obvious to the person making the determination that the claims are invalidated by the prior art.

R6.07 Illustrations of Particular Areas. There are three particular areas of practice where the application of the method for determining unity of invention contained in paragraph (1) of Rule 6 may be illustrated: (i) combinations of different categories of claims; (ii) so-called “Markush practice”; and (iii) the case of intermediate and final products. Principles for the interpretation of the method contained in paragraph (1) in the context of each of those areas are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of paragraph (1) of Rule 6. Contracting Parties that wish to adopt, in their patent legislation, more detailed provisions on unity of invention than those contained in Article 7 and Rules 6 and 7 could include the substance of the principles of interpretation set out below.

R6.08 Combinations of Different Categories of Claims. The method for determining unity of invention contained in paragraph (1) of Rule 6 should be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same application:

- (i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or
- (ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or
- (iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

R6.09 As indicated in the last part of paragraph R6.08, above, a process should be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product. The words “specially adapted” are not intended to imply that the product could not also be manufactured by a different process. They are also not intended to imply that the same kind of process of manufacture could not also be used for the manufacture of other products.

R6.10 As also indicated in the last part of paragraph R6.08 above, an apparatus or means should be considered to be “specifically designed for carrying out” a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. On the other hand, the words “specifically designed” should not imply that the apparatus or means could not be used for carrying out another process, or that the process could not be carried out using an alternative apparatus or means.

R6.11 “Markush Practice.” The situation involving the so-called “Markush practice” wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Article 6 and Rule 6. In that special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in paragraph (1) of Rule 6 should be considered to be met when the alternatives are of a similar nature.

R6.12 When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where the following criteria are fulfilled:

- (a) all alternatives have a common property or activity, and

(b)(i) a common structure is present, i.e., a significant structural element is shared by all of the alternatives; or

(ii) in cases where the common structure cannot be the unifying criterion, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

R6.13 In (b)(i), above, the words “significant structural element is shared by all of the alternatives” refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

R6.14 In (b)(ii), above, the words “recognized class of chemical compounds” mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

R6.15 The fact that the alternatives of a Markush grouping can be differently classified should not, taken alone, be considered to be justification for a finding of a lack of unity of invention.

R6.16 When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel, unity should be reconsidered by the examiner. Reconsideration should not necessarily imply that an objection of lack of unity must be raised.

R6.17 Intermediate and Final Products. The situation involving intermediate and final products is also governed by Article 6 and Rule 6.

R6.18 The term “intermediate” is intended to mean intermediate or starting products. Such products have the ability to be used to produce patentable final products through a physical or chemical change in which the intermediate loses its identity.

R6.19 Unity of invention should be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

- (a) the intermediate and final products have the same essential structural element, i.e.,
 - (i) the basic chemical structures of the intermediate and the final products are the same, or
 - (ii) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(b) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

R6.20 Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known--for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

R6.21 It should be possible to accept in a single application different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element.

R6.22 The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new.

R6.23 If the same application claims different intermediates for different structural parts of the final product, unity should not be regarded as being present between the intermediates.

R6.24 If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent.

R6.25 As long as unity of invention can be recognized applying the above guidelines, the fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not affect the decision on unity of invention.

R6.26 Paragraph (2) requires that the determination of the existence of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

R6.27 Paragraph (2) is not intended to constitute an encouragement to the use of alternatives within a single claim, but is intended to clarify that the criterion for the determination of unity of invention (namely, the method contained in Rule 6(1)) remains the same regardless of the form of claim used.

R6.28 Paragraph (2) does not prevent an Office from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Office.

Note on Rule 7
(Divisional Applications)

R7.01 This provision is modeled after Rule 5 of the basic proposal submitted to the 1991 Diplomatic Conference at The Hague (see documents PLT/DC/3 and 69). The following paragraph reproduces the explanations on the said former Rule 5 contained in document PLT/DC/5 (Note R5.01).

R7.02 The right to file divisional applications is established in Article 4G of the Paris Convention, which reads as follows:

“(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 [Paris] Union shall have the right to determine the conditions under which such division shall be authorized.”

Note on Rule 8
(Manner of Identification of an Application
Without Its Application Number)

R8.01 Paragraph (1) deals with the indications and elements which a person, communicating with its Office, must furnish to identify an application the number of which is not known (see Articles 7(2), 8(3), [8bis(3),] and 9(2)). Each of items (i) and (ii) constitutes a maximum requirement.

R8.02 Paragraph (2). This provision does not prohibit Contracting Parties from allowing an applicant to give less information or from accepting other means of identification.

[End of document]