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PROPOSED AMENDMENT TO RULE 91.1

Proposal by the United Kingdom

This document contains a proposal received from the United Kingdom Patent Office.

* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

PROPOSAL BY THE UNITED KINGDOM DELEGATION
FOR THE AMENDMENT OF PCT RULE 91

At the Governing Bodies meeting in September 1992, the United Kingdom submitted a proposal to amend Rule 91 of the PCT Implementing Regulations designed to make it easier to correct errors in international applications. The proposal did not meet with the approval of the PCT Assembly. The objections to the proposal seemed to stem mainly from concerns that corrections allowable under the proposal might extend the subject matter of the disclosure.

From the views expressed in the meeting, the United Kingdom considers that it would not be appropriate to pursue the proposal in its original form at the present time. It is felt, however, that there is support for all amendment which affects only those parts of an application which do not affect the disclosure. The proposal is set out in the annex to this document.

Rule 91.1(b)

The present proposal as it relates to Rule 91.1(b) is confined to errors in the request or the demand. Since these parts of the application do not affect the disclosure, there cannot be any question of corrections allowed under the proposal adding subject matter to the disclosure.

Over the years the Patent Cooperation Treaty has become widely used as a means of obtaining patents world wide. In no small measure, this has been due to the readiness of the Assembly to amend the Rules to avoid the situations which were seen by the users as dangerous or unfriendly. The present proposal would be a useful continuation of that process.

Examples illustrating the problems that the proposal is intended to solve

1. Failure to make clear a residence or nationality qualification

In several cases filed at the United Kingdom Office as Receiving Office, the applicant was a multinational organization which had ample presence in the United Kingdom to be entitled to file an application based on residence. The applications, however, quoted the address on the parent corporation in, say, the United States or Japan, so that to all appearances, the application was being filed by an applicant without the necessary residence or nationality qualifications. In another case an individual had mistakenly given his Australian address instead of his address in the UK.

Since the error and its correction were not obvious on the face of the documents filed, the receiving office was not able to allow the correction and the international application had to be regarded as not properly filed. Under the proposed amendment, it would be possible for the Receiving Office to consider evidence of residence and allow the correction if it were clear to the Office that the applicant was indeed properly entitled to file an application at that office.

Although this situation is now covered by Section 329 of the Administrative Instructions, the amendment now proposed would not only provided a clearer basis for that section in the Implementing Regulations, it would also cover situations which Section 329 does not cover. For example in a recent case filed at the UK Receiving Office, the name of the only applicant having the status to make the Receiving Office competent was omitted by mistake. An international filing date had to be refused because Section 329 did not apply.

2. Failure to Designate II State

In another case in which the United Kingdom Office acted as Receiving Office, the applicant instructed his agent to designate all PCT Contracting States. The agent made the mistake of using an out of date Request form and so, although he put a cross in all of the boxes on the form, he failed to designate two states which had become parties to the Treaty since the form had been issued.

While the omission of two states looked like all error, it was not possible for the Receiving Office to say that there was an obvious error. Rule 91.1 was therefore not satisfied and the applicant was not allowed to add the omitted countries to the list of designations. The agent was able to produce contemporaneous instructions from the applicant which showed the intention to designate all states, but the Receiving Office was not able to take this into account, taking the view that both the error and its correction had to be obvious from the document originally filed.

There have been other cases with similar facts.

Under the proposal, a receiving office would be able to take account of documents existing at the time of the application but filed later and to allow a correction to be made if, in all the circumstances, it considered it clear that an error had been made and what the correction should be. This does not mean that it has to accept every document at its face value; any reason to doubt the authenticity of a document could result in the receiving office disregarding it.

The extent of this problem has been reduced by Rule 4.9(IJ) which provides for precautionary designations. That rule is not however, a complete solution since it is possible that the error might only come to light after the 15 month time limit for confirming a precautionary designation had passed.

3. Omission of a priority claim

The United Kingdom delegation is aware of another case in which the applicant omitted to include a priority claim in Box VI of the Request. It was not possible to correct the omission in the international phase and while the European Patent office, at least, allowed correction in the regional phase under Rule 88 EPC, the corresponding correction was not allowed in some other countries.

4. Omission of details of an earlier search

A hypothetical example, which has not, as far as we know occurred, the applicant might omit to enter details of an earlier search in Box VII of the Request in order to claim a refund. In such a case, it would be reasonable to allow such an omission to be rectified later on the basis of evidence of an earlier search.

5. Request for grant of another kind of protection under Rule 4.12

Another possibility is that an agent failed to carry out the applicant's instructions to indicate in the request that he wished his international application to be treated in a particular designated State or States as all application not for a patent but for the grant of another kind of protection. In such a case, also, it would appear reasonable to allow rectification of the omission. It should be emphasized that in all cases the Receiving Office would not be obliged to allow the correction, it would have to be satisfied on the basis of all the evidence that an error had been made and that what was being put forward to correct the error accorded with the applicant's original intention.

Consistency with Article 11

Some delegations are understood to have difficulties with any proposal covering the first of these examples because they consider that Article 11 (J)(i) restricts the Receiving Office to consider only what is written on the request form and not take into account any other evidence when deciding whether or not it is competent to receive a particular application. Thus, they consider that if the applicant inadvertently enters the wrong address on the request form, the applicant is not entitled to prove subsequently that a different address, which would make the Receiving Office competent, should have been given.

The United Kingdom delegation has not been able to find anything in the Washington conference records which bears on how Article 11(1) (i) should be interpreted in this respect. It is submitted, however, from an examination of the language used that the conference did not intend it to be interpreted in this way.

Article 11(1), which lists items which the Receiving Office must check before according an international filing date, reads as follows:

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

- (i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office;
- (ii) the international application is in the prescribed language;
- (iii) the international application contains at least the following elements:
 - (a) an indication that it is intended as an international application,

- (b) the designation of at least one Contracting State,
- (c) the name of the applicant, as prescribed;
- (d) a part which Oil the face of it appears to be a description,
- (e) a part which on the face of it appears to be a claim or claims.

The first thing to notice is that item (i), unlike (ii) and (iii), is east in double negative form, "docs not obviously lack"; it docs not say "obviously has". It appears to the United Kingdom delegation that, for an international filing date to be refused under (i), the applicant must, first, lack the right to file all international application with the Receiving Office and that fact must be obvious from the request. If it had been intended otherwise then surely a direct form of words such as "obviously has" would have been used instead of the more complicated double negative.

The United Kingdom delegation believes its interpretation of Article 11(l) (i) is supported by the overall context of Article 11. The Article deals with procedure in the Receiving Office which has to be simple and efficient. Items (ii) and (iii) in Article 11 can be checked with certainty, simply by looking at the application documents, Whether or not the applicant lacks, for reasons of residence or nationality the right to file at that Receiving Office cannot be checked with certainty from the application documents alone. The applicant's nationality or address on the request form may indicate the right to file but they may be wrong. To be certain, the Receiving Office would have to call for evidence in every case. It appears that the word "obviously" is in item (i) in order to make clear that this is not necessary and that if the nationality and/or address 011 the face of it make the 'Receiving Office competent, no further investigation is needed.

The fact that a Receiving Office is not required to have proof of an apparently correct statement does not mean that it cannot look at evidence to prove that the applicant did have the necessary nationality or residence to make the Receiving Office competent. If that were the case it would mean that someone who did nut have the necessary nationality or residence but made a mistake indicating that he had would be in a better position than someone who did have it but made a mistake indicating that he did not. In the view of the United Kingdom delegation, the Washington conference could not have intended such a result.

Rule 91.1(c)

It is proposed to delete this paragraph because the other parts of Rule 91.1 impose sufficient safeguards on the corrections of errors. If a proposed amendment meets these criteria, there is no logical reason why it should be disallowed just because a whole sheet has been omitted.

[Annex follows]

ANNEX

Proposal for amendment of Rule 91.1

Rule 91

Obvious Errors in Documents

91.1 *Rectification*

(a) [No change]

(b) [No change]

(b-bis) In the case of a rectification of the request or the demand, the requirements of paragraph (b) shall be considered to be complied with if the authority competent under paragraph (e) is satisfied that what is offered as rectification is what was intended and that the rectification is obvious from a comparison with any paper relating to the international application existing at the time of filing the request or the demand, respectively, including any such paper subsequently filed in evidence in support of the rectification.

(c) [Deleted]

(d) to (g-quater) [No change]

[End of Annex and of document]