

# WIPO



PCT/R/WG/2/4

ORIGINAL: English

DATE: March 26, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

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

Second Session  
Geneva, April 29 to May 3, 2002

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):  
MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

*Document prepared by the International Bureau*

## BACKGROUND

1. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals designed to align the PCT with the requirements of the Patent Law Treaty (PLT), inter alia, in respect of time limits. This document<sup>1</sup> contains further proposals dealing with the question of reinstatement of rights in certain cases where the time limit for entering the national phase has been missed. As reported in the Summary of the Session prepared by the Chair (document PCT/R/WG/1/9) (“first session summary”):<sup>2</sup>

---

<sup>1</sup> This and other working documents for the present session are available on WIPO’s Internet site at [http://www.wipo.int/pct/en/meetings/reform\\_wg/reform\\_wg2.htm](http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm).

<sup>2</sup> See WIPO’s Internet site at [http://www.wipo.int/pct/en/meetings/reform\\_wg/index\\_1.htm](http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm).

“CHANGES RELATED TO THE PATENT LAW TREATY (PLT)

“20. Discussions were based on document PCT/R/WG/1/5.

“21. There was wide agreement as to the following general observations made by various delegations:

- (i) while the international phase was in general exempt from the provisions of the PLT, the principles of the PLT should so far as possible be taken up in the PCT in order to achieve the same benefits for applicants and Offices in the filing and processing of international applications as would be available for national applications; however, particular PLT-related matters should be examined on their merits to ascertain how best to deal with them in the context of the PCT;
- (ii) certain features of the PCT system differed from national and regional patent systems, and those differences needed to be borne in mind; some aspects of the PLT were less relevant than others in the context of the PCT system; factors to be taken into account included the following:
  - the PCT system is administered by a plurality of Offices and Authorities and the IB rather than by a single national or regional Office;
  - there are certain time constraints peculiar to the PCT, such as the time limit for establishing the international search report;
  - in some practical respects, the filing of a national application bears more similarity to national phase entry under the PCT than to the filing of an international application;
  - some of these differences would result in greater complexity in terms of procedures and/or drafting when considering implementation under the PCT than was the case under the PLT, for example, provisions as to language of filing and the furnishing of translations;
  - international applications were usually filed after, and claiming priority from, previously filed national applications.
- (iii) while some provisions of the PLT could be implemented readily by changing the PCT Regulations, others would require changing the Articles of the Treaty itself; some amendments to the Regulations proposed in document PCT/R/WG/1/5 raised difficulties of possible inconsistency, to varying degrees, with the Articles, for example, in providing for the according of a filing date where no claims were present in an international application;
- (iv) while changes to the Regulations could be implemented more quickly, the formulation of proposed changes to the Articles should also be addressed at an early stage;

- (v) priority should be given by the Working Group to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities; for example, priority might be given to the following:
- provisions for restoration of the priority right in certain circumstances;
  - relief when time limits were missed, especially the time limit for entering the national phase.

[...]

*“Time limit for entering the national phase*

“24. It was agreed that the International Bureau should prepare a proposal which would provide in the PCT Regulations for extensions of the time limit for entering the national phase, similarly to PLT Article 3(1)(b)(i) read in the light of PLT Articles 11 and 12.”

**PROPOSAL FOR THE REINSTATEMENT OF RIGHTS AFTER FAILURE TO COMPLY WITH REQUIREMENTS FOR ENTERING THE NATIONAL PHASE WITHIN THE TIME LIMITS UNDER ARTICLES 22 AND 39(1)**

2. A proposal for the reinstatement of rights after failure to comply with the requirements for national phase entry within the time limits under PCT Articles 22 and 39(1),<sup>3</sup> based on paragraphs 20, 21 and 24 of the first session summary, is set out in the Annex.<sup>4</sup> The key features of this proposal are outlined in the following paragraphs.

*Present situation*

3. If the applicant fails to perform the acts referred to in PCT Article 22 or 39(1) (generally, the furnishing of a translation of the international application and the payment of the national fee) before any designated or elected Office within the applicable time limit, the international application ceases to have the effect provided for in PCT Article 11(3) (that is, the effect of a regular national application) as far as that State is concerned, with the same

---

<sup>3</sup> References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO’s web site at <http://www.wipo.int/pct/eng/texts/index.htm>. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) concluded on June 2, 2000 and the Regulations under the PLT (see document PT/DC/47 on WIPO’s web site at [http://www.wipo.int/eng/document/pt\\_dc/index.htm](http://www.wipo.int/eng/document/pt_dc/index.htm)).

<sup>4</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

consequences as the withdrawal of any national application in that State (see PCT Article 24(1)(iii)).

4. As regards the possibility for the applicant to excuse any delay in meeting the time limits under PCT Article 22 and 39(1), at present, the PCT provides for such possibility only in the particular case of irregularities in the mail service (delay or loss in mail, interruption in the mail service) under PCT Article 48(1) and PCT Rule 82.

5. In all other cases (that is, not related to irregularities in the mail service), the possibility of excusing a missed time limit under PCT Article 22 or 39(1) must be pursued before each designated or elected Office individually, and only as far as that Office is concerned. For each designated or elected Office where the applicant wishes to attempt to have such a delay excused, the applicant must perform all acts required for entry into the national phase and, at the same time, request the Office to maintain the effect of the application and to excuse the delay. In determining whether a delay may be excused, each Office must apply the conditions laid down by the applicable national law in the same way and under the same conditions as they are applied to national applications, including any time limit for filing a request to excuse the delay (see PCT Article 48(2)).

6. Examples of national provisions for excusing delays are those that allow reinstatement of rights, restoration, *restitutio in integrum*, revival of abandoned applications, further processing, continuation of proceedings, and so on (see PCT Rule 82*bis*.2).

7. While the national laws of many designated and elected Offices contain provisions which allow for the excuse of delays in meeting time limits, including the time limits applicable under PCT Articles 22 and 39(1), this is not the case in respect of all designated and elected Offices. Where the applicant misses the applicable time limit for entry into the national phase before an Office whose national law does not contain such provisions, the international application ceases to have the effect as far as that State is concerned, with the same consequences as the withdrawal of any national application in that State, and no further remedy is generally available.

#### *Patent Law Treaty*

8. In order to provide a remedy for applicants in such situations, PLT Article 3(1)(b)(i) expressly provides that the provisions of the PLT and the Regulations under the PLT (once in force) would be applicable, subject to the provisions of the PCT, to international applications in respect of the time limits applicable under PCT Articles 22 and 39(1) in the Office of the PLT Contracting Party. In other words, under the PLT, any national Office of a State which is a Contracting Party of both the PLT and the PCT and which acts as a designated or elected Office under the PCT would be obliged to apply the provisions of the PLT, in particular PLT Article 12 (“Reinstatement of Rights After Finding of Due Care or Unintentionality by the Office”), to an international application which missed the applicable time limit for entry into the national phase before that Office.

#### *Amendments of the PCT Regulations*

9. Noting that the PLT has not yet entered into force, it is now proposed, as suggested in paragraph 24 of the first session summary, to incorporate into the PCT Regulations a provision with similar effect to PLT Article 12 and PLT Rule 13(2) so as to oblige all designated and elected Offices to provide for the reinstatement of rights of the applicant if the

applicant has missed the applicable time limit under Article 22 or 39(1) for entry into the national phase in spite of due care required by the circumstances having been taken or, at the option of the designated/elected Office, where the delay was unintentional. The Annex to this document contains specific proposals to amend the PCT Regulations accordingly.

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:  
MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

TABLE OF CONTENTS

Rule 49	Copy, Translation and Fee Under Article 22 .....	2
	49.1 to 49.5 [No change].....	2
	<u>49.6 <i>Reinstatement of Rights After Failure to Perform the Acts Referred to in</i></u> <u><i>Article 22</i></u> .....	2
Rule 76	Copy, Translation and Fee Under Article 39(1); Translation of Priority Document .....	6
	76.1 to 76.3 [ <i>Remain deleted</i> ].....	6
	76.4 to 76.6 [No change].....	6

**Rule 49**

**Copy, Translation and Fee Under Article 22**

49.1 to 49.5 [No change]

49.6 Reinstatement of Rights After Failure to Perform the Acts Referred to in Article 22

(a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, notwithstanding Rule 82 and subject to paragraphs (b) to (d) of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit occurred in spite of due care required by the circumstances having been taken.

[COMMENT: See PLT Article 12(1)(iv). As is the case in PLT Article 12(1)(iv), it is proposed to leave it at the option of the designated Office to decide which standard it wishes to apply in deciding whether or not to reinstate the rights of an applicant who failed to perform the acts referred to in Article 22 within the applicable time limit. Note that the provisions of Rule 82 would still apply as a *lex specialis*.]

*[Rule 49.6, continued]*

(b) The request referred to in paragraph (a) for reinstatement of rights shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within:

(i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or

(ii) 12 months from the date of the expiration of the applicable time limit under Article 22;

whichever expires first.

[COMMENT: See PLT Article 12(1)(ii) and PLT Rule 13(2).]

(c) The request referred to in paragraph (a) shall state the reasons for the failure to comply with the applicable time limit under Article 22.

[COMMENT: See PLT Article 12(1)(iii).]



*[Rule 49.6, continued]*

(d) The national law applicable by the designated Office may require:

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

[COMMENT: See PLT Article 12(3).]

(ii) that a declaration or other evidence in support of the reasons referred to in paragraph (a) be filed.

[COMMENT: See PLT Article 12(4).]

(e) Where any of the requirements referred to in paragraphs (c) and (d) are not already fulfilled during the same period within which the request referred to in paragraph (a) for reinstatement of rights must, under paragraph (b), be submitted, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation.

[COMMENT: Modeled after present Rule 51bis.3(a).]

*[Rule 49.6, continued]*

(f) The designated Office shall not refuse a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[COMMENT: See PLT Article 12(5).]

(g) If, on [date], paragraphs (a) to (f) are not compatible with the national law applied by the designated Office, paragraphs (a) to (f) shall not apply in that respect of that designated Office for as long as those paragraphs continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [date]. The information received shall be promptly published by the International Bureau in the Gazette.

**Rule 76**

**Copy, Translation and Fee Under Article 39(1);**

**Translation of Priority Document**

76.1 to 76.3 *[Remain deleted]*

76.4 to 76.6 [No change]

[COMMENT: No amendment of Rule 76.5 appears necessary since the current text of that Rule would ensure that proposed new Rule 49.6, including the transitional provision under Rule 49.6(g), would also apply to elected Offices.]

[End of Annex and of document]