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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):

OTHER PLT-RELATED CHANGES

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).¹ As reported in the Summary of the Session prepared by the Chair (paragraphs 20 and 21 of document PCT/R/WG/1/9) (“first session summary”):

“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

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

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 [International Bureau] 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.”

2. During the time available for discussion on PLT-related matters, the first session discussed in detail proposals to align PCT and PLT requirements in relation to several matters. Documents prepared for the second session of the Working Group deal with the following matters:

(i) *right of priority and priority claims*: see paragraphs 22 and 23 of the first session summary and document PCT/R/WG/2/3;

(ii) *missed time limit for entering the national phase*: see paragraph 24 of the first session summary and document PCT/R/WG/2/4;

(iii) *absence of substantive claims*: see paragraphs 25 and 26 of the first session summary; a further document is, at the date of the present document, still in preparation for the second session.

3. The question of *reference filings* was also discussed at the first session. As suggested in paragraph 28 of the first session summary, the International Bureau has reconsidered the question of reference filings in substance and in terms of its priority among the other proposals before the Working Group. As this matter appears to be of relatively low priority, it is proposed that a revised proposal not be submitted to the Working Group until a future session.

4. Certain PLT-related proposals contained in document PCT/R/WG/1/5 were not discussed during the first session of the Working Group. The Working Group desired to give priority “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” (see paragraph 21(v) of the first session summary. In addition, the International Bureau indicated, in paragraph 18 of document PCT/R/WG/1/5, that it would prepare, for the second session of the Working Group, a document “identifying and addressing the further changes necessary or desirable to bring the PCT in line with the letter and spirit of the PLT.”

5. The present document² outlines possible further PLT-related changes to the PCT. in general, the International Bureau suggests that most of those matters do not need to be addressed as matters of high priority.

PROPOSED PLT-RELATED CHANGES SET OUT IN DOCUMENT PCT/R/WG/1/5 NOT YET DISCUSSED BY THE WORKING GROUP

6. Due to time constraints, the Working Group did not discuss the following matters during its first session:

² 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.

(i) *drawing as description*: see Annex I of document PCT/R/WG/1/5 and paragraph 7, below);

(ii) *missing part requirements*: see Annex I of document PCT/R/WG/1/5 and paragraphs 8 and 9, below;

(iii) *language of the international application and translations*: see Annex II of document PCT/R/WG/1/5 and paragraph 10, below).

“Drawing as description”

7. Under the PLT, a Contracting Party may, for the purposes of the filing date, accept a drawing as the “part which on the face of it appears to be a description” (see PLT Article 5(1)(b)).³ There is no equivalent provision in the PCT. Annex I of document PCT/R/WG/1/5 contained a proposal to amend Rule 20.4 so as to provide that, for the purposes of Article 11(1)(iii)(d), a drawing shall be accepted as the part which appears to be a description. In light of the discussions at the first session of the Working Group, this proposal is considered to have a relatively low priority and would not be resubmitted for consideration by the Working Group until a later date.

“Missing part” requirements

8. Under the PLT, missing part requirements (missing part of the description and missing drawing) are contained in PLT Article 5(5) and (6) and PLT Rule 2(3) and (4). “Missing part” requirements under the PCT are contained in PCT Article 14(2) and PCT Rule 20.2. The main difference between the requirements of the PLT and those of the PCT is that, under the PLT, the applicant can rectify the omission of a part of the description or of a drawing without loss of the filing date if the application claims the priority of an earlier application and the missing part of the description or the missing drawing is completely contained in that earlier application (see PLT Article 5(6) and PLT Rule 2(3) and (4)). Under the PCT, later submission of a missing part of the description or of a missing drawing results in the loss of the originally accorded international filing date (except in the case of an authorized rectification of an obvious error under PCT Rule 91), and in the according of a new international filing date (being the date on which the papers completing the international application were received or the date on which all international filing date requirements were fulfilled, whichever is later) (see PCT Article 14(2) and PCT Rule 20.2).

³ 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).

9. Annex I of document PCT/R/WG/1/5 contained proposals to amend the PCT Regulations (see, in particular, proposed new Rule 20*bis*) with the aim of aligning PCT requirements with those of the PLT. In light of the discussions at the first session of the Working Group, this proposal is considered to have a relatively low priority and will not be resubmitted for consideration by the Working Group until a later date.

Language of the international application and translations

10. This question is discussed further in document PCT/R/WG/2/5, which proposes a simplified approach to bringing PCT requirements into line with the PLT.

POSSIBLE FURTHER PLT-RELATED CHANGES

Extension of time limits and/or continued processing; reinstatement of rights where time limits are missed (other than the time limit for entering the national phase)

11. PLT Article 11 obliges a Contracting Party to provide relief in respect of time limits in the form of extension of that time limit after the expiration of that time limit (PLT Article 11(1)(ii)) and/or continued processing (PLT Article 11(2)). In addition, a Contracting Party may, but is not obliged to, provide for the extension of a time limit before it has expired. Relief under this Article is subject only to compliance with formal requirements; the applicant cannot be required to provide grounds in support of the extension. However, it is expressly restricted to “time limits fixed by the Office for an action in a procedure before the Office” and thus does not apply to time limits established by national law, under a treaty providing for the grant of regional patents, or under the PCT or PCT Regulations. In addition, a Contracting Party may exclude relief in the case of a limited number of prescribed time limits (PLT Article 11(3)).

12. PLT Article 12 obliges a Contracting Party to provide for the reinstatement of rights lost for failure to comply with a time limit for an action in a procedure for an action before the Office. In contrast to PLT Article 11, PLT Article 12 is not restricted to time limits fixed by the Office. It therefore applies to time limits fixed by the Office, established by national law, under a treaty providing for the grant of regional patents, or under the PCT or PCT Regulations. Also in contrast to PLT Article 11, reinstatement of rights under PLT Article 12 is subject to a finding by the Office that the failure to comply with the time limit occurred in spite of all due care required by the circumstances or, at the option of the Contracting Party, was unintentional (PLT Article 12(1)(iv)). As in the case of PLT Article 11, a Contracting Party may exclude reinstatement of rights in the case of a limited number of prescribed time limits (PLT Article 12(2)).

13. Document PCT/R/WG/2/4 includes proposals to allow for the reinstatement of rights where the time limit for entering the national phase has been missed. The International Bureau suggests that any further proposals to align PCT requirements with PLT Articles 11 and 12 in the above respects not be presented to the Working Group until a future session. While this issue appears to be a matter of relatively high priority, it requires further consideration. In particular, the inclusion into the PCT Regulations of general provisions providing for the extension (by not less than two months) of time limits fixed by the Office for an action in a procedure before the Office (see PLT Article 11) is inherently problematic noting that the proper functioning of the PCT system relies to a great extent on actions taking place in a very limited time and within strict deadlines. For example, there are reasons for certain time limits such as those under PCT Rule 13*ter*.1 (time limit for furnishing sequence

listings in electronic form), PCT Rule 26.2 (time limit to correct formality defects) and PCT Rules 60.1 and 60.2 (time limit to correct defects in the demand or later elections). Moreover, already today, many time limits fixed by the Office under the PCT are already subject to the possibility of extension, albeit that the granting of an extension is in some cases discretionary for the Office.

Correction of mistakes

14. The PLT sets out the requirements that a Contracting Party is permitted to apply as regards requests for correction by the Office of mistakes in respect of an application (see PLT Rule 18). In particular, it sets out the contents of the request that an Office may require; it also obliges the Office to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements. However, it does not regulate what mistakes may be corrected. PCT Rule 91.1 provides for rectification of obvious errors in the international application or other papers. However, it does not set out any requirements as to the contents of the request for rectification. It also does not require the receiving Office, International Searching Authority or International Preliminary Examining Authority or International Bureau, as the case may be, to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements.

15. The International Bureau suggests that any proposals to align the PCT with PLT Rule 18 in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority.

Recording changes

16. The PLT sets out requirements that a Contracting Party is permitted to apply as regards requests for recording changes in the name or address of the applicant or agent (PLT Rule 15) and in the person of the applicant (PLT Rule 16). In particular, those Rules prescribe the indications regarding the applicant, representative or new applicant concerned that a Contracting Party may require. They also oblige the Contracting Party to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements. PCT Rule 92*bis* sets out the PCT requirements as regards recording changes in the following indications appearing in the request or demand: (i) person, name, residence, nationality or address of the applicant; (ii) person, name or address of the agent, the common representative or the inventor. However, PCT Rule 92*bis* does not set out the indications that are to be included in requests for recording of changes. It also does not require the applicant to be informed of any non-compliance with one or more applicable requirements and to be provided with an opportunity to subsequently comply with those requirements.

17. The International Bureau suggests that any proposals to align PCT requirements with PLT Rules 15 and 16 in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority.

Agents

18. The PLT sets out certain procedures in respect of which a Contracting Party is obliged to permit the applicant to act for himself without appointing an agent. These procedures are the filing of an application for the purposes of the filing date, the mere payment of a fee, the filing of a copy of an earlier application to support the filing of a missing part of the description or missing drawing, the filing of a copy of an earlier application to support a “reference filing”, and issue of a receipt or notification by the Office in respect of such procedures (see PLT Article 7(2) and Rule 7(1)). Under the PCT, the receiving Office or designated Office may apply its national law as far as it relates to any requirement that the applicant shall be represented by an agent (see Article 27(7)). In particular, the national law applicable by the designated Office may require that the applicant shall be represented by an agent (see PCT Rule 51*bis*.1(b)(i)).

19. In addition, the PLT in effect obliges a Contracting Party to accept the submission of a power of attorney in any language, provided that, if it is not in a language accepted by the Office concerned, it is accompanied by a translation (see PLT Rule 7(2) and (3)). The PCT contains no express provisions concerning the language of powers of attorney. However, under PCT Rule 92.2(a), the International Searching Authority or the International Preliminary Authority may require that certain documents, including powers of attorney, be submitted in the language of the international application or its language of translation.

20. the International Bureau suggests that any proposal to align PCT requirements with PLT Article 7(2) and Rule 7(1) to (3) in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority.

Invitations to comply with certain time limits and to make observations; time limits

21. Under the PLT, where one or more requirements in respect of the form or contents of an application are not complied with, the Office is obliged to notify the applicant, giving the opportunity to comply with any such requirement, and to make observations within a time limit of not less than two months from the date of the notification (see PLT Article 6(7) and Rule 6(1)). Exceptionally, where a notification has not been made because indications allowing the applicant to be contacted by the Office have not been filed, the time limit for compliance with any such requirement is not less than three months from the date on which one or more elements of the application were first received (see PLT Rule 6(2)). Similar provisions apply with regard to compliance with other requirements in respect of the application, as well as other procedures.

22. Under the PCT, the provisions that apply depend on which is the requirement that has not been complied with. In some cases, there is no express provision for the applicant to be given an opportunity to comply. In the case of lack of unity of invention, express provision is made for the applicant to submit observations and these must be in the form of a reasoned statement (PCT Rules 40.2(c) and 68.3(c)). Also, many of the time limits for complying with PCT requirements are shorter than the corresponding time limits applicable under the PLT.

23. Proposals to align certain provisions under the PCT with the corresponding provisions under the PLT in the above respects have already been referred to above. The International Bureau suggests that any proposals to align other provisions under the PCT, for example, certain provisions under PCT Rule 13*bis* (Inventions Relating to Biological Material), Rule 13*ter* (Nucleotide and/or Amino Acid Sequence Listings), Rule 16*bis* (Extension of

Time Limits for Payment of Fees), Rule 20 (Receipt of the International Application), Rule 26 (Checking by, and Correcting Before, the Receiving Office of Certain Elements of the International Application), Rule 40 (Lack of Unity of Invention (International Search)), Rule 49 (Copy, Translation and Fee Under Article 22), Rule 55 (Languages (International Preliminary Examination)), Rule 58*bis* (Extension of Time limits for Payment of Fees), Rule 60 (Certain Defects in the Demand or Elections), Rule 68 (Lack of Unity of Invention (International Preliminary Examination)) and Rule 92 (Correspondence), not be presented to the Working Group until a future session, as this does not appear to be a high priority.

24. The Working Group is invited to discuss the further PLT-related changes outlined in this document, including their relative priority, with a view to their possible inclusion in the work program of the Working Group.

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