

Patent Cooperation Treaty (PCT) Working Group

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DELETION OF “INCOMPATIBILITY PROVISIONS” IN THE PCT REGULATIONS

Document prepared by the International Bureau

SUMMARY

1. This document proposes the deletion of two “incompatibility provisions”, namely Rules 4.10(d) and 51bis.1(f), following the withdrawal of the last outstanding notifications of incompatibility under those Rules by designated Offices.

CLAIMING PRIORITY UNDER THE PCT

2. The PCT Assembly, at its twenty-seventh session held in September 1999, adopted amendments to Rule 4.10 to permit applicants to include, in international applications filed on or after January 1, 2000, priority claims based on an earlier application filed in a Member of the World Trade Organization (WTO) that is not a party to the Paris Convention (see document PCT/A/27/3 and paragraphs 12 to 17 of document PCT/A/27/4). These amendments included a transitional provision under which a designated Office could notify the International Bureau of the incompatibility of the amended provisions with the national law applied by it (see Rule 4.10(d)).

3. Originally, two designated Offices had notified the International Bureau of such incompatibility by the deadline of October 31, 1999, set out in Rule 4.10(d) (see *Official Notices (PCT Gazette)* – 2 December 1999). Following the withdrawal of the notification of incompatibility under Rule 4.10(d) by the European Patent Office, in its capacity as a designated Office, with effect from December 13, 2007 (see *Official Notices (PCT Gazette)* – 22 November 2007), no notifications of incompatibility under Rule 4.10(d) remain in force. It is therefore proposed to delete Rule 4.10(d), as set out in the Annex to this document.

TRANSLATIONS OF PRIORITY DOCUMENTS

4. The PCT Assembly, at its twenty-eighth session held in March 2000, adopted new Rule 51 *bis*.1(e) to limit the ability of designated Offices to require that a translation of a priority document be furnished by the applicant to those cases where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, consistent with the approach taken under the then draft Patent Law Treaty. At the same time, the Assembly adopted new Rule 51 *bis*.1(f) to enable a designated Office to notify the International Bureau of the incompatibility of that limitation under new Rule 51 *bis*.1(e) with the national law applied by it (see paragraphs 35 to 39 of document PCT/A/28/2, document PCT/A/28/2 Add. 1 and paragraphs 10 to 13 and Annex II of document PCT/A/28/5).

5. Originally, seven designated Offices had notified the International Bureau of such incompatibility by the deadline of November 30, 2000, set out in Rule 51 *bis*.1(f) (see *Official Notices (PCT Gazette)* – 1 February 2001). Following the withdrawal of the notification of incompatibility under Rule 51 *bis*.1(f) by the Spanish Patent and Trademark Office, in its capacity as a designated Office, with effect from November 6, 2013 (see *Official Notices (PCT Gazette)* – 31 October 2013), no notifications of incompatibility under Rule 51 *bis*.1(f) remain in force. It is therefore proposed to delete Rule 51 *bis*.1(f) as set out in the Annex to this document.

6. *The Working Group is invited to consider the proposed amendments to the Regulations contained in the Annex to this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

(a) to (c) [No change]

~~(d) If, on September 29, 1999, paragraphs (a) and (b) as amended with effect from January 1, 2000, are not compatible with the national law applied by a designated Office, those paragraphs as in force until December 31, 1999, shall continue to apply after that date in respect of that designated Office for as long as the said paragraphs as amended continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by October 31, 1999. The information received shall be promptly published by the International Bureau in the Gazette.~~

4.11 to 4.19 [No change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 *Certain National Requirements Allowed*

(a) to (d) [No change]

(e) *[No change]* The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required:

(i) where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable; or

(ii) where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii) or 20.5(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, for the purposes of determining under Rule 82ter.1(b) whether that element or part is completely contained in the priority document concerned, in which case the national law applicable by the designated Office may also require the applicant to furnish, in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the translation of the priority document.

~~(f) If, on March 17, 2000, the proviso in paragraph (e) is not compatible with the national law applied by the designated Office, that proviso shall not apply in respect of that Office for as long as that proviso continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.~~

51bis.2 and 51bis.3 [No change]

[End of Annex and of document]