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NOTES

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INTRODUCTION

1. The present document contains Notes on the provisions of the draft Patent Law Treaty and the draft Regulations contained in document SCP/1/3.
2. The draft Model International Forms referred to in these Notes are contained in document SCP/1/5.

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I. NOTES ON THE DRAFT TREATY

Note on Article 1 (Abbreviated Expressions)

1.01 Item (i). It is envisaged that the term “Office” would include national Offices of States party to a regional patent system, but would only include the Office of a regional organization if that organization is a Contracting Party. For example, the Treaty will only apply to the European Patent Office if the European Patent Organisation is a Contracting Party (see also Note 1.05).

1.02 Items (ii) and (iii). These items define the terms “applications” and “patents” by reference to the definitions in Article 2, since that Article defines the applications and patents to which the Treaty relates.

1.03 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. Thus the Treaty could also apply to an entity that is assimilated to a legal entity under the applicable national law, for example, an *Offene Handelsgesellschaft* under German law.

1.04 Item (v). The term “communication” includes both documents presented in paper form and, where permitted by the Contracting Party, electronically transmitted documents. Where the Treaty refers to a communication being signed, sent, or transmitted by a postal or other delivery service, as is the case under various provisions of Articles 7 to 12, 14, 15 and 16 and Rules 6 and 8, it is apparent that the term “communication” does not include oral communications (see Notes 9.03, 10.03, 11.02, 12.04, 14.06, 15.05 16.08 and 16.16), either in person or by telephone. However, in the context of a request for extension of a time limit under Article 13, the term “communication” would include an oral communication where such an oral communication was permitted by the Office, although no Office would be obliged to allow oral requests under that Article (see Note 13.06).

1.05 Item (vi). The term “records of the Office” is used in the definitions of “recordal” (item (vii)), “applicant” (item (viii)) and “owner” (item (ix)). The term refers to the collection of all information maintained by an Office in respect of applications filed with, and patents granted by, that Office or by another authority with effect for the Contracting Party concerned. An example of the latter would be information 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. 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. Information concerning both applications and patents are included, since certain changes (concerning, for example, a change in a name or address, or a change in ownership) could apply equally to pending applications and to granted patents.

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

1.07 Items (viii) and (ix). These items are intended to link the obligations of an Office concerning applicants and 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.

1.08 Where the applicable law of a Contracting Party provides that a patent must be applied for in the name of the actual inventor or inventors, the “person who is applying for the patent” is the inventor or joint inventors. Where a person is permitted under the applicable law to apply for a patent in place of an inventor who, for example, is dead, insane or legally incapacitated, or who refuses to sign or cannot be reached, that person is the “person who is applying for the patent”. “Another person entitled under the applicable law submitting the application” could, for example, be the applicant’s employer in the United States of America. Where the applicable law provides that an application may be submitted by any natural or legal person, the applicant is the person submitting the application. 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” (see item (xv)). “Another person entitled under the applicable law, who is prosecuting the application” could, in particular, be an assignee of record of the entire right, title and interest in an application where the applicable law of a Contracting Party requires the patent to be applied for in the name of the actual inventor and also provides that such an assignee is entitled to conduct the prosecution of the application to the exclusion of the named inventor.

1.09 In the case of a request for recordal of a change in the person of the applicant or owner (see Article 10), during the period of time between the actual legal transfer and recordal of the change, the transferor continues to be referred to in the Treaty as the “applicant” or “owner” (that is, the person shown in the records of the Office as the applicant or owner), and the transferee is referred to as the “new applicant” or “new owner” (see Article 10(1)). Once recordal of the change has taken place, the transferee becomes the “applicant” or “owner” (since he is now the person shown in the records of the Office as the applicant or owner).

1.10 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 which have the right to practice before the Office, for example, to registered patent agents or attorneys (see Article 7(1)(a)).

1.11 Item (xi). Three alternative definitions of the term “address for service” are presented to the Standing Committee for consideration. As regards Alternative A, Article 2(3) of the Paris Convention reads:

“(3) The provisions of the laws of each of the countries of the [Paris] Union relating to judicial and administrative procedure and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved.”

Under Alternative B, there would be a stated legal consequence, namely deeming receipt of a communication by the intended recipient (for example, the applicant or owner) as

having been effected where that communication was delivered to the address for service, whether or not the intended recipient personally received the communication. Alternative C would, in effect, equate an address for service with an address for communication.

1.12 Item (xii). The expression “a language accepted by the Office” refers to a verbal language and not, for example, to a computer language. Where no explicit language requirement exists, the matter of what constitutes “a language accepted by the Office” would be determined by the practice of the Office. The expression “any one language accepted by the Office” was approved in the fourth session of the Committee of Experts. It is possible that this definition could be deleted if it is not deemed necessary by any delegations.

1.13 Item (xiii). This item seems to be self-explanatory.

1.14 Item (xiv). The expression “procedure before the Office” covers procedures in which an applicant, owner of a patent or other interested person communicates with the Office, either to initiate such proceedings or in the course of such proceedings. Examples of such procedures are the filing of an application, the filing of a request for recordal of a licensing agreement, the payment of a fee, the furnishing of a response to a notification issued by the Office, or the furnishing of a translation of an application or patent. It also covers procedures in which the Office communicates with an applicant, owner or other interested person in the course of proceedings relating to an application or patent, for example, the issuance of a notification that an application does not comply with certain requirements, or the issuance of a receipt for a document or a fee. It does not refer to procedures which are not directly in respect of such proceedings, for example, the purchase of a copy of a published application or the payment of a bill for information services to the public provided by the Office.

1.15 Items (xv) and (xvi). These items seem to be self-explanatory.

1.16 Item (xvii). References in the Treaty or Regulations to a requirement, procedure, etc., “under the Patent Cooperation Treaty” are to be construed as references to such a requirement, procedure, etc., under the provisions of the PCT itself, the Regulations under the PCT or the Administrative Instructions under the PCT.

1.17 Item (xviii). This item and definitions of other terms used in the administrative and final provisions of the Treaty are reserved until those provisions are presented to the Standing Committee.

Note on Article 2
(Applications and Patents
to Which the Treaty Applies)

2.01 Paragraph (1)(a). The Treaty and Regulations would apply to national and regional applications filed with the Office of any State which is a Contracting Party. Thus, in the case of a Contracting Party which is a State, the Treaty and Regulations would apply to national applications filed with the national Office of that State, irrespective of the nationality of the applicant, owner or other interested person. In the case of a Contracting Party which is an intergovernmental organization, the Treaty and Regulations would apply to applications filed with the Office of that intergovernmental organization, irrespective of any designation of States in those applications and of the nationality of the applicant, owner or other interested person. Accordingly, where, for example, both the European Patent Organisation and a State (X) which is a Contracting State of that Organisation were party to the Treaty, the Treaty and Regulations would apply to European applications and to national applications filed with the Office of State X. However, if State X were party to the Treaty, but the European Patent Organisation were not, the Treaty and Regulations would apply to national applications filed with the Office of State X, but not to European applications, even if State X were designated. Conversely, if the European Patent Organisation were party to the Treaty, but State X were not, the Treaty and Regulations would apply to European applications, including those designating State X, but would not apply to national applications filed with the Office of State X.

2.02 The expression “applications for patents for invention” is to be construed in the same sense as the expression in PCT Article 2(i). Accordingly, the Treaty and Regulations would not apply to applications which are listed in that Article as alternative to “applications for patents for invention”, namely, applications for inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition. However, a Contracting Party would be free to apply some or all of the provisions of the Treaty and Regulations to such other applications, even though it would not be obliged to do so.

2.03 The types of applications for patents for invention which may be filed as international applications under the PCT are “conventional applications,” in respect of which no special treatment is requested, and applications for continuation or continuation-in-part of an earlier application, in respect of which an applicant may request an application to be treated as such under PCT Rule 4.14. The Treaty and Regulations would therefore apply to these types of applications.

2.04 Types of applications for patents which, at least at present, cannot be filed as international applications under the PCT include provisional applications, divisional applications, applications for re-issue patents, applications for conversion and applications for plant patents. The Treaty and Regulations would therefore not apply to these types of applications. However, a Contracting Party would again be free to apply some or all of the provisions of the Treaty and Regulations to such other applications although it would not be obliged to do so.

2.05 The Treaty also does not govern applications for patent term extensions, for example, in respect of patents for pharmaceutical products under Japanese and European Economic

Community law, since these are not applications for the grant of a patent. In addition, it does not govern “conversion applications” (for example, applications for the conversion of an application for a European Patent into a national application for one or more States designated in the European application) since these are requests for a different type of treatment rather than applications for the grant of a patent.

2.06 The phrase “types of applications” does not impose any limitation as to the actual contents of an application itself. For example, although it is a requirement under PCT Article 3(2) that an application filed as an international application under the PCT must contain one or more claims, the Treaty and Regulations would apply to applications which do not contain one or more claims, as well as to applications which do. In particular, there is no requirement under Article 4(1) that an application must contain one or more claims in order for a filing date to be accorded (see Note 4.02).

2.07 Paragraph (1)(b). This paragraph would only apply with respect to Contracting Parties which are also party to the PCT.

2.08 Item (i). Under this item, the Treaty and Regulations, in particular, Articles 13 to 15 and Rules 13 to 15, would apply to the time limits under PCT Articles 22 and 39(1) for the furnishing of a copy of the international application and any required translation, and the payment of any required fee, to designated Offices and elected Offices, respectively. Apart from this, the “international phase” of international applications, the time limits to enter into the “national phase” and the acts to be performed within these time limits would continue to be governed by the PCT.

2.09 Item (ii). Under this item the Treaty and Regulations would apply to international applications for patents for inventions after such applications have entered the “national phase” in a national or regional office, except that, in the event of any conflict between the PCT and the provisions of the Treaty and Regulations, the PCT would prevail.

2.10 Paragraph (2). In the case of patents, the Treaty and Regulations would apply both to patents granted by the Office of a Contracting Party and to patents granted on behalf of that Contracting Party by another Office, in particular, the Office of an intergovernmental organization, irrespective of whether that intergovernmental organization were party to the Treaty. For example, if State X referred to in Note 2.01 were party to the Treaty, the Treaty and Regulations would apply both to patents granted by the Office of State X and to patents granted by the European Patent Organisation having effect in State X, irrespective of whether the European Patent Organisation were party to the Treaty. If the European Patent Organisation were party to the Treaty, the Treaty and Regulations would apply to all European patents for the purposes of any procedures before the European Patent Office, for example, the revocation of patents in opposition proceedings, even if State X were not party to the Treaty.

2.11 It follows from both paragraph(1)(b)(ii) and paragraph (2) that the Treaty and Regulations would apply to patents for inventions granted on international applications.

Note on Article 3
(National Security)

3.01 A similar provision is contained in PCT Article 27(8).

Note on Article 4
(Filing Date)

4.01 Article 4 sets an international standard for the granting of a filing date. In that respect, Article 4 is different from other provisions of the Treaty, 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 4 guarantees that priority can be claimed on the basis of any application which fulfills the international filing date standard, and that it 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 under Article 5(6) or to comply with another requirement under Article 5 (see also Notes 4.02, 4.08, 4.11, 4.14 and 4.30). However, an Office would still be permitted to 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 4 guarantees that the applicant would meet the 12-month time limit under Article 4C(1) of the Paris Convention by filing a subsequent application which complies with the international filing date standard.

4.02 Paragraph (1)(a). Since the list of elements under this provision is exhaustive, for a filing date to be accorded it follows that a Contracting Party would not be permitted to require additional elements, for example, that the application contain one or more claims. In the case where an application as filed does not contain one or more claims, a Contracting Party may require that these be subsequently furnished as allowed under Article 5(1), (with reference to PCT Article 3(2)), within the time limit prescribed in Rule 5(2)(a), and in accordance with Article 5(9). However, the failure to furnish such claims within that time limit would not result in the subsequent loss of the filing date, even if the application were refused under Article 5(10)(a) for non-compliance with requirements allowed under Article 5(1).

4.03 The wording “date on which its Office has received all of the following elements” covers both the case in which all of the required elements are received on the same day and the case in which they are received on different days. Where an applicant initially fails to comply with all the required filing date requirements, but subsequently complies with those requirements, the question of whether the application should be granted a filing date and, if so, what that filing date should be, would be regulated under paragraph (4) and Rule 2(1) (see also Note 4.22).

4.04 As regards the receipt of applications or elements of an application after the Office has closed for the receipt of communications, or on a day when the Office is not open for the receipt of communications, reference is made to Rule 6(1) (see Note R6.01). In addition, under Rule 6(2), a Contracting Party would be free to deem, as receipt by the Office, receipt of the elements by a specified branch or sub-office of an Office, by a national Office on behalf of

an intergovernmental organization having the power to grant regional patents, by a postal service, or by a specified delivery service.

4.05 The term “filed by means permitted by the Office” would mean that a Contracting Party would be free to accord a filing date even where the required elements were filed by means which did not comply with the requirements applied by that Contracting Party under Article 5(3) to the filing of applications. For example, a Contracting Party which requires applications to be filed on paper would be permitted, but not obliged, to accord a filing date to applications filed in electronic form; the Office would then notify the applicant under Article 5(9) of the non-compliance with the requirement for filing on paper, giving the applicant an opportunity under that Article to comply with that requirement within the time limit prescribed under Rule 5(2)(a).

4.06 Item (i). In permitting either an express or an implicit indication to the effect that the elements referred to are intended to be an application, this provision is more liberal than the corresponding provision in respect of international applications under PCT Article 11(1)(iii)(a). An implicit indication would exist where the Office is satisfied that it is the applicant’s intention to apply for a patent, for example, where the documents furnished contain a statement that the applicant wishes to protect his invention.

4.07 Item (ii). As regards the meaning of the term “applicant,” reference is made to Article 1(viii) (see Note 1.07).

4.08 This provision is more liberal than the corresponding provision in respect of international applications under PCT Article 11(1)(iii)(c) which requires the name of the applicant to be indicated. Whether, in a particular case, indications which have been given are sufficient for “allowing the applicant to be contacted by the Office,” or for “allowing the identity of the applicant to be established,” will be a matter to be determined by the Office in the circumstances of that case. Where the name and address of the applicant is not given, a Contracting Party may require that these indications be subsequently furnished as allowed under Article 5(1), with reference to PCT Rule 4.1(a)(iii) and 4.5(a), within the time limit prescribed in Rule 5(2)(a), in accordance with Article 5(9). However, the failure to furnish such indications within that time limit would not result in the subsequent loss of the filing date (provided that the requirement of Article 4(1)(a)(ii) has been complied with) even if the application were refused under Article 5(10)(a) for non-compliance with requirements allowed under Article 5(1).

4.09 Item (iii). This provision is the same as the requirement in respect of international applications under PCT Article 11(1)(iii)(d). For the purpose of determining whether a filing date should be accorded, the Office will only establish whether, in its opinion, the application contains a part that, on the face of it, appears to constitute a description. The question of whether that part satisfies requirements relating to the description allowed under Article 5(1) with reference to PCT Article 5 and PCT Rule 5, or the substantive requirements for the grant of a patent, is not relevant to this determination. Where the Office determines that the application does not contain a part which on the face of it appears to be a description, no filing date may be accorded.

4.10 Paragraph (1)(b). This provision would permit, but not oblige, a Contracting Party to accord a filing date on the basis of one or more drawings only. Where the Office of a

Contracting Party which does not apply this provision receives an application which contains only drawings which incorporate textual matter, it would be for the Office to determine whether, in the circumstances of the case, such textual matter fulfills the requirement under paragraph (1)(a)(iii).

4.11 Paragraph (2)(a). A Contracting Party may require that, for the granting of a filing date, it is necessary for the elements referred to in paragraph (1)(a)(i) and (ii) to be in a language accepted by the Office. As regards the meaning of the expression “a language accepted by the Office,” reference is made to Article 1(xii) (see Note 1.12).

4.12 Paragraph (2)(b). This provision would permit the part which on the face of it appears to be the description to be filed in any language. However, where that part is filed in a language which is not a language accepted by the Office, the application must also contain an indication, in a language accepted by the Office, to the effect that the application contains a description. This indication could, for example, consist of the words “Description of the Invention.” In such case, a translation of the description would need to be furnished under Article 5(5), within the time limit prescribed in Rule 5(2)(b), in accordance with Article 5(9) (see also Note 5.18). However, the failure to furnish such translation within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 5(10)(a) for non-compliance with the requirements under Article 5(5).

4.13 Where, under paragraph (1)(b), a drawing replaces the part which on the face of it appears to be the description, any textual matter incorporated in that drawing may also be in any language. However, since it will be immediately apparent that the application contains a drawing, an indication to that effect would serve no useful purpose.

4.14 Where the application as filed contains claims which are in a language not accepted by the Office, a translation of those claims would need to be furnished under Article 5(5) within the time limit prescribed in Rule 5(2)(b) in accordance with Article 5(9) (see also Note 5.18). The failure to file such translation within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 5(10)(a) for non-compliance with the requirements under Article 5(5).

4.15 Paragraph (3)(a). Where the application does not comply with one or more of the requirements referred to in paragraphs (1) and (2), the notification by the Office gives the applicant the option of correcting the deficiencies and proceeding with the application on the basis of the elements which have been submitted and any fees already paid. That is, the applicant would not need to resubmit the application. However, for the proper conduct of business before the Office, a Contracting Party may provide that this option should apply only up until the expiration of the time limit applicable under paragraph (4)(b) (see Note 4.22).

4.16 In order to ensure that the applicant is promptly notified of any non-compliance with one or more of the requirements of paragraphs (1) and (2), the Office should check the application without undue delay and issue any required notification as soon as possible after any such non-compliance has been discovered.

4.17 A Contracting Party would not be obliged to send a notification where the indications in the application do not allow the applicant to be contacted by the Office. As regards the

expression “indications allowing the applicant to be contacted by the Office,” reference is made to the explanation under paragraph (1)(a)(ii) (see Note 4.08).

4.18 If necessary for the avoidance of doubt, an Agreed Statement to that effect could be adopted by the Diplomatic Conference.

4.19 Where the applicant discovers any non-compliance with the requirements of paragraphs (1) and (2) without having received a notification from the Office, he may immediately file the elements required for such compliance without waiting to receive such notification.

4.20 Paragraph (3)(b). This provision, modeled after PCT Article 14(2), does not oblige the Office to check whether the application refers to drawings which, in fact, are not included in the application. However, where the Office determines, as the result of such a check or otherwise, that such drawings are not included, the Office must notify the applicant, in which case the explanations given in Notes 4.17 to 4.19 apply. The subsequent procedure is regulated by paragraph (5) (see Notes 4.23 to 4.25). As regards the obligation of a Contracting Party to send a notification where the indications in the application do not allow the applicant to be contacted by the Office, reference is made to the explanation under paragraph (3)(a) (see, in particular, Note 4.17).

4.21 Paragraph (4)(a). This provision seems to be self-explanatory.

4.22 Paragraph (4)(b). The relevant time limit is prescribed in Rule 2(1). Where one or more of the requirements referred to in paragraphs (1) and (2) were not complied with when the application was first received by the Office, and are still not complied with within the time limit, the application would be treated as not having been filed; if the applicant then wished to proceed, it would be necessary to re-file the application in its entirety and, if the Office does not permit the transfer of fees from the initially filed application, to pay new fees.

4.23 Paragraph (5)(a). The relevant time limit, which is the same as that which applies under paragraph (4)(b), is prescribed under Rule 2(1). Where the missing drawings are furnished within that time limit, the filing date shall, except as provided under subparagraphs (b) and (c) and paragraph (6), be the date on which the Office receives those drawings or the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with, whichever date is later.

4.24 Paragraph (5)(b). Under this provision, where the Office determines that later furnished drawings do not contain new matter, the Office is free, but not obliged, to accord as the filing date the date on which the requirements referred to in paragraphs (1) and (2) are complied with. This provision is not mandatory because, for example, non-examining offices would not be able to determine whether or not the later furnished drawings contain new matter.

4.25 Paragraph (5)(c). This provision would permit the applicant to withdraw the later furnished drawings within a time limit fixed by the Contracting Party, for example, following a determination by the Office that the drawings contained new matter. This would enable the applicant to retain an earlier filing date where, in his view, the elements initially furnished

provide an adequate description of the invention without the missing drawings and any reference to the said drawings.

4.26 Paragraph (6). Where the priority of an earlier application is claimed, this provision would require a Contracting Party, at the applicant's request, to take into account the contents of that earlier application in establishing whether correction by way of furnishing a missing sheet or drawing should be allowed without loss of filing date. This would apply, in particular, where a sheet of description or drawings is unintentionally omitted from an application filed on paper. It would also apply, for example, in the case of the unintentional omission of a part of the description filed electronically in a "pageless" format. Requirements regarding the furnishing of a copy and translation of the earlier application are prescribed in Rule 2(2). However, this Rule does not prescribe a time limit within which the applicant must make a request since the omission may not be noticed until, for example, substantive examination.

4.27 Paragraph (7). This provision, which is modeled after Article 8(4) of the basic proposal submitted to the 1991 Diplomatic Conference at The Hague (see documents PLT/DC/3 and 69), would permit the applicant to replace the description and any drawings in an application by a reference to a previously filed application in respect of the same invention. However, the requirements under subparagraph (a), as prescribed in Rule 2(3), are such that it would cover references to any previously filed application by the same applicant or his predecessor in title and would not be restricted, as was the case under the basic proposal referred to above, to references to an application of which priority is claimed.

4.28 Failure to comply with the requirements prescribed under Rule 2(3) would result in the loss of the filing date under subparagraph (b).

4.29 The applicant would, for the application to proceed, subsequently need to furnish a description pursuant to the requirements allowed with reference to Article 5(1). However, the failure to furnish such a description within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 5(10)(a) for non-compliance with requirements allowed under Article 5(1).

4.30 Paragraph (8). This paragraph is shown in square brackets since it will only be required if PCT Rule 4.13 is amended to permit the applicant to indicate that he wishes his international application to be treated, in any designated State, as a divisional application. Under that amendment, divisional applications would then be a type of application which could be filed as international applications under the PCT, and to which the Treaty and Regulations would apply under Article 2(1)(a) (see Note 2.01). It would consequently be necessary to provide expressly in this Treaty for the filing date of the initial or "parent" application to be treated as the filing date of the divisional application, for example, for the purposes of priority claim, prior art and patent term.

Note on Article 5 (Application)

5.01 Paragraph (1). The provision that no Contracting Party may require compliance with any requirement relating to the form or contents of an application different from or additional to those which are provided for in respect of international applications under the PCT, which is

modeled after PCT Article 27(1), would mean that a Contracting Party could not impose stricter requirements in such respects than those under the PCT. The understanding that a Contracting Party would be free to provide for requirements which, from the viewpoint of applicants, are more favorable than the requirements under the PCT, is modeled after PCT Article 27(4).

5.02 The application requirements which are “otherwise provided for” under the present Treaty include those under Article 5(2) to (8), Article 7 and Article 8, and under the Regulations pertaining to those Articles.

5.03 The expression “form or contents of an application” is to be construed in the same way as the expression in PCT Article 27(1). The Note to that Article in the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty, at page 35 of the Final Text of the Treaty and Notes, contains the following explanation:

“The words ‘form or contents’ are used merely to emphasize something that could go without saying, namely that requirements of substantive patent law (criteria of patentability, etc.) are not meant.”

5.04 The requirement, allowed under Article 29.2 of the Agreement on Trade-Related Aspects of Industrial Property Rights (TRIPS), that an applicant for a patent provide information concerning the applicant’s foreign applications and grants, is not a requirement as to the “form and contents of an application” under this provision. Similarly, requirements under the law of the United States of America in respect of duty of disclosure and indications that an invention was produced under a United States of America government contract, and requirements under the law of India in relation to the disclosure of search results on related applications and patents, are also not requirements as to the “form and contents of an application.”

5.05 Since at least one delegation is of the view that unity of invention is a matter of substantive law, not a formalities matter, it is proposed that the final provisions of this Treaty should provide for the possibility of a reservation by a Contracting Party as regards the applicability of the requirements of PCT Rule 13 (Unity of Invention) under this provision.

5.06 Any relevant amendments or modifications to the PCT, or to the Regulations or Administrative Instructions under the PCT, would automatically have effect under the present Treaty.

5.07 Paragraph (2)(a). This provision would permit a Contracting Party to require that any of the mandatory contents of the request of an international application under the PCT which are required by a Contracting Party under paragraph (1), be presented on a request Form prescribed by that Contracting Party. The mandatory contents of the request in the case of an international application are prescribed in PCT Rule 4.1(a) and (b). The Rules read:

“(a) The request shall contain:

- (i) a petition,
- (ii) the title of the invention,

(iii) indications concerning the applicant and the agent, if there is an agent,

(iv) the designation of States,

(v) indications concerning the inventor where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.

(b) The request shall, where applicable, contain:

(i) a priority claim,

(ii) a reference to any earlier international, international-type or other search,

(iii) choices of kinds of protection,

(iv) an indication that the applicant wishes to obtain a regional patent,

(v) a reference to a parent application or parent patent,

(vi) an indication of the applicant's choice of competent International Searching Authority.”

A Contracting Party may also require, under paragraph (1), that the request Form be signed, with reference to PCT Rule 4.1(d). No provision is made for the inclusion in the request Form of the optional requirements of the request of an international application under PCT Rule 4.1(c) since those requirements are relevant only to international applications.

5.08 Paragraph (2)(b). This provision would oblige a Contracting Party to accept the filing, on paper, of request Forms which correspond to the request Form provided for in the Regulations (unless that Contracting Party excludes the filing of applications with its Office on paper under Regulations referred to in paragraph (3)(iii)). This would enable an applicant to file applications, on paper, for the same invention in the Offices of different Contracting Parties using the same form, namely the Model International Request Form (Form N° 1), translated where necessary into an accepted language (see also Note 5.10). A Contracting Party may use the request Form referred to in subparagraph (b) as a model for preparing its own request Form under subparagraph (a).

5.09 The draft Model International Request Form (Form N° 1) is based, to the extent possible, on the PCT request form (Form PCT/RO/101). This Model International Form will be established in the languages of the Treaty (namely, English, Arabic, Chinese, French, Russian and Spanish).

5.10 The relevant language version of the Model International Form may be used as such (where a Contracting Party accepts one of the languages of the Treaty), or the Model Form

may be translated into an accepted language. The reference to a request Form which “corresponds to the request Form provided for in the Regulations” would include such a translation of the Model International Form.

5.11 Paragraph (3). The requirements which a Contracting Party would be permitted to apply as regards the filing of applications on paper or in electronic form or by other means, for example, by telegraph, teleprinter or telefacsimile, are set out in the Regulations, namely in Rule 3, rather than in the Treaty itself, in order to facilitate amendment of these requirements in the light of future technological developments.

5.12 The expression “filed on paper” is to be interpreted in the light of the requirements under PCT Rule 11.9, which, as allowed under Article 5(1) of the draft Treaty, would apply to applications filed under this Treaty. In accordance with that Rule, a Contracting Party could require that applications be typed or printed. Since the provisions of that Rule do not permit applications to be handwritten, a Contracting Party would not be obliged to receive applications in that form, although it would be permitted to do so.

5.13 As regards the meaning of the term “filing of applications ... in electronic form or by other means,” reference is made to the explanation under Rule 3(2) to (4) (see Notes R3.02 to R3.07).

5.14 Items (i) and (ii). These items would ensure that no Contracting Party would be obliged, against its wishes, to accept the electronic filing of applications or to exclude the filing of applications on paper.

5.15 Item (iii). This item would ensure that the right of applicants to file applications on paper with any particular Office would not be excluded without the unanimous agreement of all Contracting Parties.

5.16 As regards the non-applicability of paragraph (2)(b), reference is made to the explanation under that paragraph (see Note 5.08).

5.17 Paragraph (4). This paragraph is placed in square brackets since it will not be required if the proposed inclusion in the PCT Regulations of a provision to the same effect is adopted. A Contracting Party would be free to make no provision in respect of registration numbers or other indications, or to provide for the furnishing of registration numbers or other indications on an optional basis. Where the applicant or representative is not registered with the Office under a number or other indication, the Office may not require a number or other indication to be included in the application. Where an applicant or representative does not comply with a requirement under this paragraph, the Office could add the registration number or other indication *ex officio*. Alternatively, it could notify the applicant or representative under paragraph (9), giving an opportunity to comply with that requirement, and to make observations, within the time limit applicable under that paragraph (see Note 5.29). Where the said requirement was not complied with within that time limit, a Contracting Party would be free, under paragraph (10)(a) and (d), to apply any sanction for such non-compliance as is provided for in its law, other than refusal of the application.

5.18 Paragraph (5). This paragraph would allow a Contracting Party to require that an application be presented in a language accepted by the Office of that Contracting Party. Where

an application which satisfies the filing date requirements under Article 4 is not in a language accepted by the Office, the Office must notify the applicant or other person submitting the application that the requirements of this paragraph are not complied with giving him an opportunity under paragraph (9) to comply with those requirements. An Office would not need to take any action in respect of information presented both in a language accepted by the Office and in a second language, for example, where a bilingual form is used — a translation of the information in the second language would serve no purpose, since that information is already presented in a language accepted by the Office.

5.19 As regards the term “a language accepted by the Office,” reference is made to Article 1(xii) (see Note 1.12).

5.20 Paragraph (6). This paragraph does not regulate to whom the fee is paid, for example, whether it is paid to the Office or to another agency of the government. It also does not regulate the method of payment, so that each Contracting Party would be free to decide whether to allow payments made, for example, from a deposit account with the Office, or by electronic transaction, or whether to make it mandatory, for example, in the case of applications filed electronically, to pay the fees by using a deposit account. A Contracting Party would also be permitted to require the amount of the fee and/or its method of payment to be indicated, for example, on a fee sheet as prescribed under the PCT Administrative Instructions.

5.21 In addition to the fee to be paid in respect of the application, a Contracting Party could require the payment of separate fees, for example, for the publication of the application and the granting of the patent. A Contracting Party would be permitted 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). However, it follows from Article 4(1) that a Contracting Party could not refuse a filing date because the application fee has not been paid (see Note 4.01).

5.22 Paragraph (7)(a). The time limit under this provision for furnishing a copy of the earlier application is prescribed under Rule 5(1)(a) as not less than 16 months from the filing date of the earlier application. This time limit, which is consistent with PCT Rule 17.1 as amended with effect from July 1, 1998, is more generous than the (minimum) period of three months from the filing of the subsequent application provided in Article 4D(3) of the Paris Convention for the Protection of Industrial Property (the “Paris Convention”). (It is to be noted that, under that Article of the Paris Convention, a Contracting Party may not require a fee for the filing of the copy, if it is filed within three months of the filing of the subsequent application.) If the time limit is not complied with because of a failure, on the part of the Office with which the earlier application was filed, to provide a copy in time, restoration of the priority right may be available under Article 16(3).

5.23 Where the Office may reasonably doubt the veracity of the priority claim, that Office may request that evidence in support of the priority claim be furnished under paragraph (8). 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 nationality, the Office may require evidence in this matter.

5.24 Paragraph (7)(b). This provision would maintain the right of a Contracting Party, under Article 4D(3) of the Paris Convention, to require certification of the copy of the earlier application and of the date of filing of that application.

5.25 Paragraph (7)(c). The expression “or is available, in an official form, to the Office by electronic means” is included to take account of developments which would enable the Office with which the application claiming priority is filed to obtain a copy of the earlier application from a convenient source, for example, the digital library of the Office with which that earlier application had been filed, so that it would no longer be necessary for the applicant to furnish such a copy, or to furnish certification of its date of filing.

5.26 Paragraph (7)(d). Under this provision, the applicant could be required to furnish a translation of the earlier application in order to determine whether the invention claimed in the application claiming priority (the “subsequent application”) is patentable, in particular, having regard to matter published after the claimed priority date, but before the filing date, of the subsequent application. The time limit for furnishing the translation is prescribed under Rule 5(1)(b).

5.27 There are cases in which an Office may need a translation of an earlier (priority) application for the purposes of examination of an application filed by a third party. For example, where the application filed by the third party is filed after the filing date of the earlier (priority) application but prior to the filing date of the subsequent application (the application claiming the priority of the earlier application), the contents of the earlier application would form part of the prior art for the third party’s application, and the Office would therefore need a translation. While there is some benefit for the applicant who claimed the priority of the earlier application to provide such a translation, in that the application filed by the third party may be rejected based on the contents of the earlier application, the approach taken by the draft Treaty is that the burden of the cost of translation of the earlier application, in such a case, should not fall on the applicant who claimed the priority of the earlier application. Thus, in such a case, the result of the wording of subparagraph (d) would be that the Office could only require that the applicant who claimed the priority of the earlier application furnish a translation if the translation were also required to determine whether the invention claimed in his subsequent application (the application claiming the priority of the earlier application) is patentable (see Note 5.26). If that were not the case, the Office could still request that the applicant who claimed the priority of the earlier application provide the translation; however, it could not apply any sanction if that applicant did not comply with the request.

5.28 Paragraph (8). This paragraph relates to cases where the Office believes that any matter contained in the request Form referred to in paragraph (2), or in a separate declaration of priority, may not be true. It does not relate to the correction of mistakes, which would fall under Article 12. Although it would be for each Contracting State to interpret the phrase “may reasonably doubt the veracity of any matter,” the intention is that the Office may not ask for evidence on a systematic or a “spot-check” basis, but only where there are grounds for reasonable doubt. The Office would be obliged under Rule 4 to inform the applicant of its reason for doubting the veracity of the matter in question. An example of a case in which evidence may be required is given in Note 5.23. Another example is where the authenticity of a signature in the application is in doubt, in which case 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).

5.29 Paragraph (9). This paragraph ensures that the applicant is, unless indications allowing that applicant to be contacted by the Office have not been provided, always notified of any defect under paragraphs (1) to (6), and is provided with a period prescribed in Rule 5(2) for complying with the requirements under those paragraphs. Defects under paragraph (1) would include the case where a priority claim does not comply with the requirements under PCT Rule 4.10. Since the time limit to comply with the requirements in respect of the priority claim differs from those relating to other defects, the time limit for that case is prescribed separately under Rule 5(2)(d). The time limits prescribed in Rule 5(2) are applicable to the furnishing of evidence required under paragraph (8).

5.30 This paragraph does not regulate the manner in which the applicant is to be notified, for example, in paper form, orally, or by electronic mail.

5.31 As regards the Contracting Party's obligation to send a notification, reference is made to the explanations under Article 4(1)(a)(ii) and (3)(a) (see Notes 4.08 and 4.17).

5.32 Paragraph (10)(a). The relevant time limit is prescribed in Rule 5(3)(a). Except in the situations under subparagraphs (b) to (d), the sanction which may be applied under this provision may include refusal of the application. However, the effect of the reference to Article 4 is that a Contracting Party could not consider an application as not having been filed if it complies with the requirements of that Article (see Note 4.01).

5.33 Paragraph (10)(b). The consequence of failure to comply with the formality requirements in respect of a priority claim within the time limit prescribed under Rule 5(3)(b) is generally the loss of the priority right. However, the effect of the reference to the Patent Cooperation Treaty is that, as under PCT Rule 26bis.2(b) which enters into force on July 1, 1998, a priority claim shall not be considered not to have been made only because the indication of the number of the earlier application referred to in PCT Rule 4.10(a)(iii) is missing or because an indication of such number in the priority claim is not the same as the corresponding indication appearing in the priority document.

5.34 Paragraph (10)(c). This provision is required for conformity with Article 4D(4) of the Paris Convention, which provides that the consequences of failure to comply with the formalities prescribed by Article 4 of that Convention shall in no case go beyond the loss of the right of priority. Although paragraph (10)(c) expressly provides that no other sanction may be applied, the decision of an Office to consider a priority claim as non-existent could result in the refusal of the application on substantive grounds, in particular, on the grounds of lack of novelty or inventive step in the light of intervening prior art. In addition, where, for the purposes of obtaining a filing date, the description was replaced by a reference to an earlier application under Article 4(7), the failure to furnish, in accordance with Article 4(7)(a), a copy, translation or certified copy of that earlier application would result, under Article 4(7)(b), in the application being considered as not having been filed (see Note 4.28).

5.35 Paragraph (10)(d). This provision has been introduced in response to an observation by the Delegation of Switzerland at the fifth session of the Committee of Experts that it should not be permissible for an application to be refused for failure to furnish a registration number or other indication under paragraph (4). It is placed in square brackets since paragraph (4) is placed in square brackets.

Note on Article 6
(Validity of Patent; Revocation)

6.01 Paragraph (1). This paragraph establishes that an Office, a court, a board of appeal or any other competent authority may not revoke or invalidate, either totally or in part, a patent once granted when it is subsequently discovered that the application failed to meet one or more specified formal requirements which, although they may be needed for the processing of the application, are not essential to the content of the granted patent, except where the non-compliance occurred as a result of fraudulent intention. The specified formal requirements are:

Article 5(1) - the application did not comply with one or more requirements relating to its form or contents;

Article 5(2) - the relevant contents of the application were not presented on a request Form corresponding to the request Form provided for in the Regulations or on another prescribed request Form;

Article 5(3) - the application was not filed in compliance with the prescribed requirements;

[Article 5(4) - the request Form did not contain a required number or other indication under which the applicant or representative is registered with the Office;]

Article 5(6) - one or more fees required in respect of the application were not paid;

Article 5(7) - a copy or translation of an earlier application on which a priority claim is based was not furnished.

6.02 Paragraph (1) would apply irrespective of whether the Office failed to notify the applicant under Article 5(9) of the failure to comply with the requirement(s) concerned or whether the applicant had failed to comply with the requirement(s) in response to a notification under that Article.

6.03 Since paragraph (1) is expressly restricted to the formal requirements referred to in Article 5(1) to (3), [(4)], (6) and (7), the express provision formerly contained in paragraph (1)(b) in document PLT/CE/V/3 that “nothing in subparagraph (a) shall limit the freedom of the Office, a court, a board of appeal or any other competent authority to revoke or invalidate a granted patent on a matter of substance” does not appear to be strictly required. If necessary for the avoidance of doubt, an Agreed Statement to this effect could be adopted by the Diplomatic Conference. Examples of such matters of substance would be lack of novelty, lack of entitlement of the owner to the patent, and that the description does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

6.04 Since all of the provisions referred to in paragraph (1) concern formal requirements in respect of applications, that paragraph would not prevent the revocation or invalidation of a

granted patent for failure to comply with formal requirements in respect of that patent, for example, the requirement under a regional treaty for the furnishing of a translation of a regional patent. As regards fees, it is to be noted that the paragraph would cover only those fees payable prior to the grant of a patent, such as the filing, publication and grant fees. It would not cover the lapse of a patent for the non-payment of an annual maintenance fee.

6.05 The phrase “it may not be revoked or invalidated” is intended to also cover sanctions which are of equivalent effect to revocation or invalidation, such as non-enforceability of rights.

6.06 A Contracting Party would be permitted, but not obliged, to provide for the revocation or invalidation of a granted patent when it is subsequently discovered that the application was not in a language accepted by the Office, as required by Article 5(5), or that evidence required under Article 5(8) had not been furnished.

6.07 Paragraph (2). This paragraph relates to any proceedings for the revocation and invalidation of a patent before the Office, a court, a board of appeal or any other competent authority. It applies to proceedings on substantive grounds, such as lack of novelty, as well as formal grounds. It also includes proceedings where the sanctions are of equivalent effect to revocation or invalidation (see Note 6.05). It is to be noted that the paragraph is restricted to two formal aspects of such proceedings: first, the owner must be given at least one opportunity to make observations on the intended revocation or invalidation; second, he must have at least one opportunity to make amendments and corrections where permitted under the applicable law. However, this paragraph does not regulate the grounds on which a granted patent may be revoked or invalidated, nor any other aspect of such proceedings. It also does not regulate the form of observations which an owner may make. Thus, although an owner would generally be given the opportunity to submit written observations, a Contracting Party would be permitted, for example, in court proceedings, to provide only for oral observations. No Contracting Party would be required to provide an opportunity for amendments and/or corrections to be made if its national law did not provide for such amendments or corrections, either at all or in the circumstances of the particular proceedings.

Note on Article 7
(Representation; Address for Service)

7.01 The term “representative” is defined in Article 1(x). Article 7 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 would be free to establish whatever rules it wishes. 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.

7.02 Paragraph (1)(a), chapeau. As regards the term “procedure before the Office,” reference is made to the explanation under Article 1(xiv) (see Note 1.14).

7.03 Item (i). This item would permit a Contracting Party to require that the appointed representative be a person, for example, a registered patent attorney, who is admitted to practice before the Office in respect of applications and patents. A Contracting Party, however, may have a less strict requirement, for example, it may merely require that the appointed representative shall not be debarred from acting as a representative on the grounds of misconduct. The term “have the right to practice before the Office” is modeled after the terminology in PCT Rule 90.1(a) to (c).

7.04 Item (ii). This item is intended to cover the case where a Contracting Party, whether or not it requires a representative to be registered to practice before the Office, requires that the representative have an address for service on its territory. As in the case of item (i), a Contracting Party may have a less strict requirement than that provided for under item (ii). For example, a Contracting Party which is a Member State of the European Union would be able to require that a representative have an address for service on the territory of any Member State of the European Union.

7.05 Paragraph (1)(b). This provision is modeled after PCT Rule 90.3(a). Where any provision of the Treaty or Regulations refers to an act by, or in relation to, an applicant, that act may be performed by, or in relation to, the applicant’s representative. For example, where the Office is required to notify an applicant under Article 4(3) or 5(9), the notification would normally be sent to the applicant’s representative. The position is the same where an owner or other interested person is represented. For example, a representative would have an opportunity under Article 6(2) to make observations, on behalf of the owner, on the intended revocation or invalidation of a patent. Although an Office would normally send any communications to an appointed representative, a Contracting Party may provide that a communication should be sent to the represented person where that person so requests.

7.06 As regards the term “procedure before the Office,” reference is made to the explanation under Article 1(xiv) (see Note 1.14).

7.07 Paragraph (2). A Contracting Party may require representation under this paragraph even where the applicant, owner or other interested party 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.

7.08 As regards the terms “applicant,” “owner” and “procedure before the Office,” see Notes 1.07 to 1.09 and 1.14, respectively. An “other interested person” could be, for example, a petitioner for the revocation of a patent or, in the case of a transfer of an application or patent, the new applicant or new owner.

7.09 Item (i). This item would seem to be self-explanatory.

7.10 Item (ii). This item is placed in square brackets for further consideration by the Standing Committee. If this item were not included, it would still be possible for an applicant who is not

represented to file an application with an Office which requires representation for such filing, since appointment of a representative is not a filing date requirement under Article 4. The Office would then, unless indications allowing him to be contacted by the Office had not been furnished, notify that applicant under paragraph (11) giving him an opportunity to comply with that requirement within the time limit prescribed in Rule 7(2)(a) (see also Note 7.32). If the applicant complied with the requirement for representation within that time limit, the Office would then proceed to process the application and, if the requirements of Article 4(1) and (2) were complied with on the date on which the application was filed by the applicant, would accord that date as the filing date of the application. If the applicant did not comply with the requirement for representation within the applicable time limit, the Office could refuse the application.

7.11 It is to be noted that this provision would not prevent an applicant, owner or other interested party who so wishes from being represented in the listed procedures before the Office, even though representation may not be required by the Contracting Party concerned.

7.12 Alternative A. In this Alternative, items (iii) and (iii*bis*) are placed in square brackets for consideration by the Standing Committee, in the absence of any agreement at the fifth session of the Committee of Experts as to whether they should be included or omitted. Item (iii*bis*) no longer refers to the furnishing of a translation or certified copy according to Article 4(7) (formerly Article 4(4)) in consequence of the amendments to that Article.

7.13 Alternative B. Under this Alternative, any procedures, other than those referred to in items (i) and (ii), in respect of which representation would not be required would be prescribed in the Regulations. This would make it easier to amend the list of such procedures in the light of experience.

7.14 Item (iv). The requirement to appoint a representative is expressly excluded for the issue of a receipt or a notification by the Office in respect of any of the procedures referred to in items (i) to [(iii*bis*)] [(iii)], since the freedom of not having to appoint a representative for such procedures could be undermined if the applicant, owner or other person concerned were then required to be represented for the purposes of the issuing of a receipt of notification in respect of such procedures.

7.15 Paragraph (3). The laws of some States do not require that a representative be appointed before their Offices, even where the applicant, owner or other interested person has neither a domicile nor a real and effective industrial or commercial establishment on the territory of the State concerned. The laws of some of those States, however, require that, unless a representative is appointed, an address on their territory be provided. Under this paragraph, a Contracting Party could require that, where no representative is appointed, the applicant, owner, or other interested person either (i) indicate, as his address, the address of domicile or real and effective industrial or commercial establishment, if any, which he has on the territory of the Contracting Party, or, at his option, (ii) provide an address for service on that territory.

7.16 As under paragraph (1)(a)(ii), a Contracting Party could be more liberal than paragraph (3) in respect of the territory of the address or the address for service (see Note 7.04). As regards the terms “address for service” and “procedure before the Office”,

reference is made to the explanations under Article 1(xi) and (xiv), respectively (see Notes 1.11 and 1.14).

7.17 The requirement to provide an address on the territory of the Contracting Party concerned is expressly excluded in respect of any of the procedures referred to in paragraph (2)(i) to (iv), since the freedom not to appoint a representative for such procedures could be undermined if the applicant, owner or other person concerned were required to provide an address for service in the territory of each Contracting Party in respect of which, for example, fees are paid without representation.

7.18 Where an application is filed, or another procedure before the Office carried out, and an address required under item (i) or (ii) has not been indicated, the procedure explained in Note 7.10 would apply, *mutatis mutandis*.

7.19 Paragraph (4)(a). This provision obliges a Contracting Party to accept the appointment of a representative either in a separate power of attorney or in the request Form signed by the applicant (as under PCT Rule 90.4 (a)). A Contracting Party would also be free, but not obliged, to accept the appointment of a representative in any other manner.

7.20 Paragraph (4)(b). This provision would oblige a Contracting Party to accept a single power of attorney in respect of one or more applications and/or patents of the same person. Contracting Parties would also be obliged to 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. The words “subject to any exception indicated by the appointing person” would oblige a Contracting Party to 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. Apart from this, Article 7 does not regulate further details of the so-called “general power of attorney.” For example, each Contracting Party would be free to allow that several representatives be appointed in such a power of attorney, or that several of those powers of attorney, relating to different representatives, be furnished by the same person.

7.21 A Contracting Party would be permitted to require that a separate copy of the single power of attorney filed on paper be furnished for each application and patent to which it relates. It would also be permitted to require, under paragraph (8)(i), that any communication made to the Office by a representative for the purposes of a procedure before the Office contain a reference to the power of attorney or general power of attorney (see also Note 7.25).

7.22 Paragraph (5). As regards the presentation of the power of attorney, reference is made to the explanations relating to the presentation of the request Form of the application under Article 5(2) (see Notes 5.07 to 5.10). The Regulations contain a Model International Form (Form N° 2) for the power of attorney.

7.23 Paragraph (6). Reference is made to Rule 7(1) and to the explanations under Article 5(3) (see Notes 5.11 to 5.16).

7.24 Paragraph (7). As regards the term “a language accepted by the Office,” reference is made to Article 1(xii) (see Note 1.12).

7.25 Paragraph (8). A Contracting Party would be permitted, but not obliged, to require either item (i) or (ii), or both items (i) and (ii). Any Contracting Party which allows oral communications to the Office could require that such communications include a reference to a power of attorney or indication under which a representative is registered.

7.26 Item (i). This item, in particular, would permit a Contracting Party to require that a reference be made to a power of attorney relating to more than one application or patent, or to a general power of attorney.

7.27 Item (ii). Reference is made to the explanation under Article 5(4) (see Note 5.17), except that there is no proposal for the inclusion in the PCT Regulations of a provision corresponding to this item.

7.28 Paragraph (9). This paragraph relates to the situation where the power of attorney contains an indication the veracity of which is doubtful. The Office would be obliged under Rule 4 to inform the person who is required to furnish the evidence of the reason for doubting the veracity of the indication in question. This paragraph applies even in the case of an indication which is not required to be made under the law of the Contracting Party concerned. As regards the phrase “may reasonably doubt the veracity of,” reference is made to the explanation under Article 5(8) (see Note 5.28).

7.29 Paragraph (10). This paragraph establishes the exhaustive character of the list of formal requirements permitted under paragraphs (1) to (9) with respect to the matter of representation.

7.30 Paragraph (11). In applying, *mutatis mutandis*, the provisions of Article 5(9), this paragraph would ensure that the person to be represented, or, where applicable, the representative or person who refers to himself as representative, is notified where one or more of the requirements under paragraph (1) to (8) are not complied with or where evidence is required under paragraph (9). In addition, in applying, *mutatis mutandis*, the provisions of Article 5(10), this provision would provide an opportunity to comply with those requirements within the time limit which is prescribed under Rule 7(2).

7.31 Where an applicant, owner or other interested person is represented, the notification under paragraph (11) would normally be sent to the representative (see also the explanation under paragraph (1)(b) in Note 7.05). However, where there is doubt as to whether an alleged representative has in fact been appointed, or whether an alleged representative complies with all of the requirements under the applicable law permitted under paragraph (1)(a), the Office may send the notification to the applicant, owner or other interested person instead of, or in addition to, sending it to that representative.

7.32 Where an applicant, owner or other interested person who indicates an address outside the territory of the Contracting Party does not comply with a requirement for representation under paragraph (2) or an address for service on the territory of the Contracting Party under paragraph (3)(ii), the Office would be obliged, unless sufficient indications have not been furnished, to send the notification under paragraph (11) to that address outside the territory of the Contracting Party. However, the Office would not be obliged to communicate further with that applicant, owner or other interested person unless he complied with the requirement for representation, or for the provision of an address for service on the territory of the Contracting

Party, within the time limit prescribed in Rule 7(2). Reference is also made to the explanations under Article 5(9) and (10) (see Notes 5.29 to 5.35) and under paragraphs (2) and (3) (see Notes 7.07 to 7.18).

Note on Article 8
(Signature)

8.01 Article 8 applies whenever a signature is required, whether such requirement is mentioned in the Treaty or follows only from the national (or regional) law. Details concerning indications accompanying the signature of a natural person and concerning the date of signature are prescribed under Rule 8(1) and (2), respectively.

8.02 Paragraph (1). Regulations on the signature of communications transmitted to the Office on paper, by telefacsimile and in electronic form are prescribed under Rule 8(3) to (5), respectively.

8.03 Paragraph (2). This paragraph is restricted to communications on paper since the Office may require the notarization, authentication or certification of electronic signatures. As regards the term “communication,” reference is made to the explanation under Article 1(v) (see Note 1.04).

8.04 Although a Contracting Party would not be permitted to require certification of a signature or other means of self-identification, for example, a sealed impression, where an Office is of the opinion that there is reasonable doubt as to the authenticity of that signature or other means of self-identification, it could require evidence under paragraph (3)(a), which evidence could be in the form of certification (see Note 8.05).

8.05 Paragraph (3)(a). In case of reasonable doubt as to the authenticity of the signature or other means of self-identification, the Office may require the applicant or other person submitting the communication to furnish evidence of 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 a certification (see also Note 5.28)). The Office would be obliged under Rule 4 to inform the applicant of the reason for its doubt. As regards the phrase “may reasonably doubt the veracity of,” reference is made to the explanation under Article 5(8) (see Note 5.28).

8.06 Paragraph (3)(b). This provision would prevent the provisions of paragraph (2) being circumvented by a requirement for evidence under subparagraph (a). As in the case of paragraph (2), this provision is restricted to evidence on paper since Contracting Parties would need to be able to require the authentication of electronically filed evidence in order to confirm the identity of the sender and integrity of the communication.

8.07 Paragraph (4). The time limits under this paragraph are prescribed in Rule 8(6). Reference is also made to the explanations given under Article 5(9) and (10) (see Notes 5.29 to 5.35).

Note on Article 9
(Request for Recordal of Change in Name or Address)

9.01 Article 9 standardizes the procedure concerning requests for recordal of a change in the name or address of an applicant or owner where there is no change in the person of that applicant or owner. Where there is a change in the person of the applicant or owner, Article 10 would apply.

9.02 Paragraph (1)(a). In accordance with Article 1(vii), the term “recordal” means recordal in the records of the Office. As regards the terms “applicant” and “owner,” reference is made to the explanations under Article 1(viii) and (ix) (see Notes 1.07 to 1.09).

9.03 As explained with reference to the definition of “communication” under Article 1(v) (see Note 1.04), it follows from the wording of this provision that a Contracting Party may refuse a request made by oral communication.

9.04 Paragraph (1)(b). The Regulations under this provision are prescribed in Rule 9(1).

9.05 Paragraph (2)(a). This paragraph would seem to be self-explanatory.

9.06 Paragraph (2)(b). The Regulations contain a Model International Form (Form N° 3) for the request for recordal of a change in name or address. Reference is also made to the explanations under Article 5(2)(b) (see Notes 5.08 to 5.10).

9.07 Paragraph (3). Reference is made to the explanations under Article 5(3) (see Notes 5.11 to 5.16). The Regulations under this provision are prescribed under Rule 9(2). It should be noted that these Regulations apply only to the request *per se* and therefore do not apply to evidence furnished under paragraph (8).

9.08 Paragraph (4). Reference is made to the explanations under Article 5(5) (see Notes 5.18 and 5.19). Where the request is not filed in a language accepted by the Office and a translation is not furnished within the time limit prescribed in Rule 9(3), a Contracting Party would be permitted to reject the request, but it is understood that the request could be re-filed in an accepted language with no loss of rights.

9.09 Paragraph (5). The amount of the fee could differ depending on the number of the patents or applications involved (see Note 9.10). Reference is also made to the explanations under Article 5(6) (see, in particular, Note 5.20).

9.10 Paragraph (6). Under this paragraph, a Contracting Party would be obliged to allow a change in both name and address, and a change in respect of more than one patent and/or application of the same person, to be included in a single request. This paragraph expressly provides that a Contracting Party may require that a separate copy of a single request filed on paper be furnished for each application and patent to which it relates. However, any Contracting Party which so wished could itself make copies of the request, optionally on the payment of an additional fee for each copy (see Note 9.09).

9.11 Paragraph (7). The manner of identifying an application whose application number is not known is prescribed in Rule 17.

9.12 Paragraph (8). This paragraph would permit a Contracting Party 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. The Office would be obliged under Rule 4 to inform the applicant of its reason for doubting the veracity of the indication concerned. As regards the phrase “may reasonably doubt the veracity of,” reference is made to the explanation under Article 5(8) (see Note 5.28).

9.13 Paragraph (9) establishes the exhaustive character of the list of requirements under paragraphs (1) to (8). One requirement which would be prohibited is 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.

9.14 Paragraph (10). The time limits under this paragraph are prescribed under Rule 9(3). Reference is also made to the explanations given under Article 5(9) and (10) (see Notes 5.29 to 5.35).

9.15 Paragraph (11). While Model International Forms are not provided for requests for recordal of a change in the name and/or address of a representative or of a change in the address for service, a Contracting Party would be obliged to accept such a request presented on a form, with appropriate alterations, corresponding to the Model International Form provided in the Regulations under paragraph (2)(b) (see Note 9.06).

Note on Article 10

(Request for Recordal of Change in Applicant or Owner)

10.01 Article 10 standardizes the procedure concerning requests for recordal of changes in the person of applicants and owners, in particular, changes resulting from a change of ownership. Where there is a change in the name, but no change in the person, of the applicant or owner, Article 9 would apply. 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 Contracting Party, for example, the fiscal authorities.

10.02 Paragraph (1)(a). In accordance with Article 1(vii), the term “recordal” means recordal in the records of the Office. As regards the terms “applicant” and “owner,” reference is made to the explanations under Article 1(viii) and (ix) (see Notes 1.07 to 1.09).

10.03 As in the case of Article 9(1)(a), it follows from the wording of this provision that a Contracting Party may refuse a request made by oral communication (see Note 9.03).

10.04 Paragraph (1)(b). The Regulations under this provision are prescribed in Rule 10(1).

10.05 Paragraph (2). The Regulations contain a Model International Form (Form N° 4) for the request for recordal of a change in the person of the applicant or owner. Reference is also made to the explanations under Article 9(2) (see Notes 9.05 and 9.06).

10.06 Paragraph (3). Reference is made to the explanations under Article 5(3) (see Notes 5.11 to 5.16). The Regulations under this provision are contained in Rule 10(2). It

is to be noted that these Regulations apply only to the request *per se* and therefore do not apply to any documents furnished under paragraph (4) or to evidence furnished under paragraph (9).

10.07 Paragraph (4). It follows from Article 8(2) that no Contracting Party may require that a signature appearing in a document referred to in this paragraph be the subject of certification where that document is in paper form.

10.08 Paragraph (4)(a). This paragraph prescribes the documentation which may be required where the change in the person of the applicant or owner results from a contract. The words “recordal of the change in applicant or owner is requested by the new applicant or the new owner rather than by the applicant or the owner” are placed in square brackets for further consideration by the Standing Committee, in the absence of any agreement at the fifth session of the Committee of Experts as to whether, where the recordal is requested by the applicant or owner himself, a Contracting Party should be permitted to require that the request be accompanied by a document evidencing the change in applicant or owner which results from a contract, or whether such documentation is unnecessary since it could be presumed that the applicant or owner would not voluntarily request the recordal of a change which had not in fact occurred, since that would be against his own interest.

10.09 Items (i) to (iii). These items list three different documents which, alternatively, may serve as evidence of a change of applicant or owner 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. However, since this provision sets a maximum requirement, a Contracting Party could, for example, under item (ii) accept a transcription of an extract of the contract, instead of the extract itself, if this were permitted under its law.

10.10 It is to be noted that although items (i) to (iii) correspond to items (i) to (iii) in Article 11(1)(b) of the Trademark Law Treaty, paragraph (4)(a) contains no item corresponding to item (iv) of that Article. Accordingly, a Contracting Party would not be obliged to record a change of applicant or owner resulting from a contract where the request is accompanied by an uncertified transfer document signed by both the applicant and the new applicant or by both the owner and the new owner, although it would be permitted to do so.

10.11 Where the requesting party chooses to furnish a copy of the contract or an extract of the contract as provided in items (i) and (ii), a Contracting Party would be free to require that the copy or the extract be certified. It would be the choice of the applicant as to who (a notary public, competent public authority or, where permitted, a representative) certifies the relevant document.

10.12 Where the requesting party chooses to furnish a certificate of transfer as provided in item (iii), a Contracting Party would not be permitted to require that this certificate be the subject of any form of certification. The Regulations contain a Model International Form (Form N° 5) for a certificate of transfer.

10.13 Paragraph (4)(b). This provision applies where the change in the applicant or owner results from a merger, or from the reorganization or division of a legal entity. Any Contracting Party would be permitted to require that the request be accompanied by a copy of a document,

originating from a competent authority, evidencing that fact and any attribution of rights involved, for example, an extract from a register of commerce. The Contracting Party would only be permitted to require that a copy of the document be furnished; it could not require that the original of the document be furnished, or that the copy of the document be signed by the applicant and the new applicant or by the owner and the new owner. As regards the requirement that the copy be certified, reference is made to the explanation under subparagraph (a)(i) and (ii) (see Note 10.11).

10.14 Paragraph (4)(c). This provision applies where the change in ownership 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 would be permitted to require that the request be accompanied by a copy of any document which it deems appropriate to evidence the change. Although the Contracting Party could not require that the original of such a document be furnished, it could require that the copy of that document be certified by, at the option of the requesting party, the authority which issued the document, a notary public, a competent public authority, or, where permitted, a representative.

10.15 Paragraph (4)(d). This provision would apply where, under the applicable law, a co-applicant or co-owner who transfers his share in an application or patent needs the consent of any other co-applicant or co-owner to obtain recordal of the change. As regards the term “communication,” reference is made to the explanation under Article 1(v) (see Note 1.04).

10.16 This provision now refers to a co-applicant or co-owner in respect of whom there is no change giving his consent in a communication to the Office, whereas the former provision (paragraph (1)(f)) in document PLT/CE/V/2 referred to that co-applicant or co-owner giving his express consent in a document signed by him. Under the provision as now worded, it would be a matter for the Contracting Party to determine what would constitute consent to the change, including whether the communication containing the consent should be signed.

10.17 Paragraphs (5) to (8). Reference is made to the explanations given under Article 9(4) to (7) (see Notes 9.08 to 9.11).

10.18 Paragraph (9). Evidence could be required under this paragraph where the Office has reason to suspect that the request may be fraudulent. Reference is also made to the explanations given under Article 9(8) (see Note 9.12).

10.19 Paragraph (10). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (9) with respect to a request for recordal of a change in applicant or owner. An example of a prohibited requirement could be making the admissibility of the request dependent on an advertisement of the change in one or several newspapers. Since the Treaty does not regulate the substantive requirements relating to the validity of the change, a Contracting Party would be permitted to require the fulfillment of additional conditions of a substantive nature, for example, in situations concerning inheritance, bankruptcy or tutelage.

10.20 Paragraph (11). The time limits under this paragraph are prescribed under Rule 10(3). Reference is also made to the explanations under Article 5(9) and (10) (see Notes 5.29 to 5.35).

10.21 Paragraph (12). This paragraph would permit, but not oblige, any Contracting Party, in particular, a Contracting Party the applicable law of which provides that a patent must be applied for in the name of the actual inventor, to exclude the provisions of Article 10 in respect of changes in inventorship. The manner in which a Contracting Party may exclude the application of this Article will be regulated in the administrative and final provisions of the Treaty.

Note on Article 11

(Request for Recordal of a Licensing Agreement or Security Interest)

11.01 Paragraph (1)(a). It follows from the words “Where a licensing agreement in respect of an application or patent may be recorded under the applicable law” that no Contracting Party would be obliged to provide for recordal of such licensing agreements, and that any Contracting Party which did allow for such recordal would be free to decide which licensing agreements could be recorded.

11.02 As in the case of Article 9(1)(a), it follows from the wording of this provision that a Contracting Party may refuse a request made by oral communication. In accordance with Article 1(vii), the term “recordal” means recordal in the records of the Office.

11.03 Paragraph (1)(b). The Regulations under this provision are prescribed in Rule 11(1).

11.04 Paragraph (2). The Regulations contain Model International Forms (Forms N° 6 and 7) for a request for recordal, or for cancellation of recordal, of a licensing agreement and for a request for recordal, or for cancellation of recordal, of a security interest. Reference is also made to the explanations under Article 9(2) (see Notes 9.05 and 9.06).

11.05 Paragraph (3). Reference is made to the explanations under Article 5(3) (see Notes 5.11 to 5.16). The Regulations under this paragraph are prescribed under Rule 11(2) and (3). It should be noted that these Regulations apply only to the request *per se* and therefore do not apply to any documents furnished under paragraph (4) or to evidence furnished under paragraph (9).

11.06 Paragraph (4)(a). The considerations which apply to documentation which may be required under this provision are essentially the same as those which apply under Article 10(4)(a) in the case of a change in applicant or owner which results from a contract (see Notes 10.08 to 10.12). The words “where recordal of a licensing agreement is requested by the licensee, rather than by the licensor” are placed in square brackets for further consideration by the Standing Committee in the absence of agreement at the fifth session of the Committee of Experts as to whether, where recordal is requested by the licensor himself, a Contracting Party should be permitted to require that the request be accompanied by a document evidencing that licensing agreement, for example, to establish the existence of any previously recorded exclusive license which could conflict with the recordal of the new license, or whether such documentation was unnecessary since it could be presumed that the licensor would not voluntarily request the recordal of a licensing agreement which had not in fact occurred, since that would be against his own interest.

11.07 Paragraph (4)(b). This provision would permit a Contracting Party to require the furnishing of a document containing the consent to recordal of the licensing agreement of an applicant, owner, exclusive licensee, co-applicant, co-owner or co-exclusive licensee who is not party to that agreement. For example, where the applicant or owner has already granted an exclusive license in respect of an application or patent, a Contracting Party could require the consent of the exclusive licensee to the recordal of another licensing agreement, in respect of that application or patent, to which the exclusive licensee is not a party. Similarly, a Contracting Party may require the consent of the applicant or owner to a sub-licensing agreement by an exclusive licensee. Also, where a co-applicant or co-owner licenses his share in an application or patent, a Contracting Party could require the consent of any other co-applicant, co-owner or co-exclusive licensee to the recordal of the licensing agreement. A co-applicant, co-owner or co-exclusive licensee who represents all of the co-applicants, co-owners or co-exclusive licensees may consent to the change on behalf of the other co-applicants, co-owners or co-exclusive licensees. As regards the term “communication,” reference is made to the explanation under Article 1(v) (see Note 1.04).

11.08 This provision now refers to a co-applicant, co-owner or co-exclusive licensee who is not party to a licensing agreement giving his consent to the recordal of that licensing agreement in a communication to the Office, whereas the former provision (Article 11(1)(e)) in document PLT/CE/V/2 referred to that co-applicant, co-owner or co-exclusive licensee giving his express consent in a document signed by him. The considerations in this respect would appear to be the same as those under Article 10(4)(d) and reference is made to the explanations under that Article (see, in particular, Note 10.16).

11.09 Paragraphs (5) to (8). Reference is made to the explanations given under Article 9(4) to (7) (see Notes 9.08 to 9.11).

11.10 Paragraph (9) and (10). Reference is made to the explanations given under Article 10(9) and (10) (see Notes 10.18 and 10.19).

11.11 Paragraph (11). The time limits under this paragraph are prescribed under Rule 11(4). Reference is also made to the explanations given under Article 5(9) and (10) (see Notes 5.29 to 5.35).

11.12 Paragraph (12). Item (i) relates to the recordal of a security interest, such as an interest in a patent or application, acquired by contract for the purpose of securing payment or performance of an obligation or indemnifying against loss or liability, for example, where the rights in an application or patent have been pledged as a security for a loan. However, as in the case of recordal of licensing agreements under paragraph (1), no Contracting Party would be obliged to provide for recordal of security interests, and any Contracting Party which did allow for such recordal would be free to decide which security interests could be recorded. Similarly, under item (ii), no Contracting Party would be obliged to provide for cancellation of the recordal of a licensing agreement or security interest.

Note on Article 12
(Request for Correction of a Mistake)

12.01 Article 12 regulates the formal requirements and procedures concerning the request for correction of a mistake. However, it does not regulate the substantive requirements which a Contracting Party may apply in determining the allowability of a correction; for example, a Contracting Party may require that the correction be obvious in the sense that it is unequivocally clear that nothing else could have been intended other than what is offered as the correction. It also does not regulate corrections in the application which are not the subject of a request for correction, in particular, the amendment of the description, claims or drawings, either voluntarily following the receipt of the search report, or in the course of substantive examination.

12.02 Paragraph (1)(a). The expression “mistake in the records of the Office” is to be interpreted in light of the definition of the term “records of the Office” under Article 1(vi) (see Note 1.05). Examples of mistakes which could be the subject of a request under paragraph (1) are mistakes in the bibliographic data, in details concerning a priority claim, or in the description, claims or drawings of the application or patent concerned. It follows from the wording “which is correctable under the applicable law” that the question of which mistakes are correctable is not regulated by the Treaty.

12.03 As regards the terms “applicant” and “owner,” reference is made to the explanations given under Article 1(viii) and (ix) (see Notes 1.07 to 1.09).

12.04 As in the case of Article 9(1)(a), it follows from the wording of this provision that a Contracting Party may refuse a request made by oral communication.

12.05 Paragraph (1)(b). The Regulations under this provision are prescribed in Rule 12(1).

12.06 Paragraph (1)(c). 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 and patent, to facilitate the work of the Office.

12.07 Paragraph (1)(d). This provision would permit a Contracting Party to refuse a request for correction of a mistake where the requesting party was unable to furnish a declaration that the said mistake was made in good faith, for example, where the mistake was made with deceptive intentions. It would be a matter for the Contracting Party concerned to decide what constitutes good faith. Under Article 7(1)(b), a representative could submit the declaration on behalf of the requesting party.

12.08 Paragraph (1)(e). This provision would permit a Contracting Party to refuse a request for correction of a mistake where there was undue or intentional delay in making the request after the discovery of the mistake. It would be a matter for the Contracting Party concerned to decide what constitutes undue or intentional delay; for example, it could consider that there is undue delay where the request is not diligently made.

12.09 Paragraph (2). The Regulations contain a Model International Form (Form N° 8) for the request for correction of a mistake. Reference is also made to the explanations under Article 9(2) (see Notes 9.05 and 9.06).

12.10 Paragraph (3). Reference is made to the explanations under Article 5(3) (see Notes 5.11 to 5.16). The Regulations under this paragraph are prescribed under Rule 12(2). It should be noted that these Regulations apply only to the request *per se* and therefore do not apply to any documents furnished under paragraph (1)(c) and (d) or to evidence furnished under paragraph (8).

12.11 Paragraphs (4) to (7). Reference is made to the explanations under Article 9(4) to (7) (see Notes 9.08 to 9.11).

12.12 Paragraph (8). This item would enable a Contracting Party to require evidence in the case of any request for correction where, for example, notwithstanding the declaration referred to in paragraph (1)(d), there was doubt as to whether the mistake was made in good faith, or where there was doubt as to whether the request was made without undue or unintentional delay following the discovery of the mistake in accordance with paragraph (1)(e) (see also Notes 12.07 and 12.08). Reference is also made to the explanations given under Article 9(8) (see Note 9.12).

12.13 Paragraph (9). Reference is made to the explanations given under Article 9(9) (see Note 9.13) As regards the restriction to formal requirements, reference is made to the explanation in Note 12.01.

12.14 Paragraph (10). In the case of mistakes attributable to an Office, for example, errors in the transcription of data in the records of the 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.

12.15 Paragraph (11). The time limits under this provision are prescribed under Rule 12(3). Reference is also made to the explanations given under Article 5(9) and (10) (see Notes 5.29 to 5.35).

12.16 Paragraph (12). This paragraph would permit a Contracting Party, in particular, a Contracting Party which requires that a patent be applied for in the name of the actual inventor, to apply provisions in respect of corrections in inventorship which are different from, or additional to, provisions under paragraphs (1) to (11). The manner in which a Contracting Party may exclude the application of this Article will be regulated in the administrative and final provisions of the Treaty.

Note on Article 13
(Extension of a Time Limit Fixed by the Office)

13.01 Article 13 sets a minimum of rights a Contracting Party must extend to an applicant or owner who requests the extension of a time limit fixed by the Office for an action in a procedure before the Office prior to the expiration of that time limit. However, a Contracting Party would be free to be more liberal in granting such extensions.

13.02 Paragraph (1). This paragraph provides for the extension of a time limit as of right. In particular, the applicant or owner concerned could not be required to state the grounds on which the request is based. This provision regulates only requests for the extension of time limits fixed by the Office for an action in a “procedure before the Office” as defined in Article 1(xiv) (see Note 1.14). It therefore does not apply to time limits established by national legislation or under a treaty providing for the grant of regional patents. It also does not apply to time limits for actions not before the Office, for example, actions before a court (see also Note 13.03). A Contracting Party would be free to prescribe the same or other requirements, or to make no provision for extension, in respect of time limits not regulated by this paragraph.

13.03 Examples of time limits which may be fixed by the Office for an action in a procedure before the Office include time limits for the subsequent compliance under Article 4(4) with all of the requirements of Article 4(1) and (2) for the granting of a filing date, for the subsequent compliance under Article 5(9) with all of the requirements of Article 5(1) to (6), for furnishing evidence under Article 5(8), and for response to an examiner’s substantive examination report.

13.04 As regards the terms “applicant” and “owner”, reference is made to the definitions under Article 1(viii) and (ix) (see Notes 1.07 to 1.09). Paragraph (1) does not regulate the extension of a time limit at the request of an interested party who is not an applicant or owner, for example, at the request of a “new applicant” or “new owner” in proceedings under Article 10, a licensee in proceedings under Article 11, or a third party to any proceedings. However, a Contracting Party would be free to provide for the extension of time limits at the request of such other interested parties, or a third party, although it would not be obliged to do so.

13.05 Paragraph (1) is also limited to the case in which the request for extension of a time limit is received by the Office prior to the expiration of that time limit. Where that time limit has expired, relief in the form of further processing or revival of an application, or in the form of restoration of rights, may be available under Article 14 or 15, respectively. This paragraph also does not apply to the delayed submission of priority claims or the restoration of the priority right, which are regulated by Article 16.

13.06 The communication under this paragraph may, in accordance with the definition under Article 1(v), be transmitted or submitted by any means permitted by the Office. Accordingly, a Contracting Party would be free, but not obliged, to allow oral requests for extension of time limits (see also Note 1.04).

13.07 It is to be noted that paragraph (1) contains no provisions in respect of the contents or the presentation of the communication containing the request for an extension of a time limit. Accordingly, although it is implicit that the communication must indicate the action before the Office, including the number of the application or patent concerned, in respect of which the

extension of the time limit is requested, a Contracting Party would not be permitted to require, for example, that the applicant or owner give reasons in support of the request. A Contracting Party would also not be permitted to require that the request should be presented on a prescribed Form, since this could cause difficulties for an applicant who is obliged, at short notice, to request an extension of a time limit immediately prior to the expiration of that time limit.

13.08 The period of an extension which a Contracting Party is required to grant under this provision is, subject to paragraph (2), prescribed under Rule 13(1).

13.09 Paragraph (2)(a). This provision would ensure that the provisions of the applicable national or regional law in respect of a maximum time limit for the grant of a patent would prevail over an extension of a time limit fixed by an administrative action of the Office.

13.10 Paragraph (2)(b), item (i). Under this item, no Contracting Party would be obliged to grant more than one extension of a time limit under paragraph (1), although it would be permitted to do so. Any Contracting Party which did grant more than one extension under paragraph (1) would be permitted to grant shorter extensions than and/or to apply requirements which are additional to, or different from, those under that paragraph.

13.11 Item (ii). This provision would permit a Contracting Party to exclude the automatic extension of a time limit for filing requests for an extension of a time limit.

13.12 Paragraph (3). Reference is made to the explanations given under Article 5(3) (see Notes 5.11 to 5.16).

13.13 Paragraph (4). Where a request is not filed in a language accepted by the Office, a Contracting Party would be permitted to reject the request; the request could be re-filed in an accepted language with no loss of rights only if this were done before the expiration of the time limit concerned. Reference is also made to the explanation given under Article 5(5) (see Notes 5.18 and 5.19).

13.14 Paragraph (5). Although a Contracting Party would be permitted to charge a fee under this paragraph, it would not be obliged to do so. Reference is also made to the explanation given under Article 5(6) (see, in particular, Note 5.20).

13.15 Paragraph (6). The possibility of making observations on the intended refusal of a request under paragraph (1) would be accorded to the applicant or owner even if the refusal were based on non-payment or insufficient payment of fees required under paragraph (5), for example, to make the case that the fee had in fact been paid.

13.16 As in the case of Article 6(2), this paragraph does not regulate the form of observations which an applicant or owner is given an opportunity to make (see Note 6.07).

Note on Article 14
(Further Processing or Revival of Application)

14.01 This Article has been introduced following the approval by the fourth session of the Committee of Experts of a proposal providing that “further processing” of an application should generally be permitted on the mere basis of a request and the payment of a fee. In addition, in response to a suggestion by the Delegation of the United States of America at the fifth session of the Committee of Experts, this provision permits for revival of an application as an alternative to further processing.

14.02 Paragraph (1)(a). Further processing and revival under this provision is restricted to the cases in which an application has been, or is to be, refused or considered withdrawn or abandoned. It does not apply where the failure to comply with the time limit does not result directly in the loss of the application. For example, it does not apply to the period for making a priority claim, which is regulated by Article 16. It also does not apply in the case of a granted patent, in which case relief may be available by way of restoration of rights under Article 15.

14.03 In addition, paragraph (1)(a) regulates only requests for the further processing or revival of an application following the failure to comply with a time limit for an action in a procedure before the Office. The term “procedure before the Office” is defined in Article 1(xiv) (see Note 1.14).

14.04 The words “fixed by the Office” have been placed in square brackets for consideration by the Standing Committee as to whether paragraph (1)(a) should be restricted to time limits fixed by the Office, as under Article 121(1) of the European Patent Convention, or whether it should apply also to time limits established by national legislation or under a treaty providing for the grant of regional patents, as proposed by the representative of the European Patent Office at the fifth session of the Committee of Experts. If the words concerned were omitted, a Contracting Party would be obliged, subject to any specific exceptions under paragraph (2), to provide for further processing or revival in respect of time limits fixed by the Office and time limits prescribed by law. If the words concerned were included, a Contracting Party would only be obliged to provide for further processing or revival in respect of a time limit fixed by the Office, although any Contracting Party which so wished would still be free to apply the provisions of paragraph (1) to time limits established by national legislation or under a treaty providing for the grant of regional patents. For examples of time limits which may be fixed by the Office for an action in a procedure before the Office, see Note 13.03.

14.05 Paragraph (1)(a) is limited to requests made in a communication signed by the “applicant,” as defined in Article 1(viii) (see Notes 1.07 and 1.08). However, any Contracting Party could be more liberal in this respect if it so wished, in particular, by dispensing with the requirement for a signature and/or admitting a request from a “new applicant.”

14.06 As in the case of Article 9(1)(a), it also follows from the wording of this provision that a Contracting Party may refuse a request under this paragraph made by oral communication.

14.07 As regards the contents and presentation of the communication, reference is made to the explanation given under Article 13(1) (see, in particular, Note 13.07), except that, in the

case of a request for revival under paragraph (1)(a), a statement that the failure to comply with the time limit was unintentional may be required under subparagraph (b).

14.08 Where the request under this provision is granted, the refusal, withdrawal or abandonment of the application would not take place (if it has not already taken place), or would be retracted (if it has taken place), and processing of the application by the Office would be resumed as if the time limit concerned had been complied with.

14.09 The time limit for making a request under this provision, and for complying with all of the requirements in respect of which the time limit for the action before the Office applied, is prescribed in Rule 14(1).

14.10 Paragraph (1)(b). In accordance with the approval referred to in Note 14.01, “further processing” of an application would generally be permitted on the mere basis of a request and the payment of a fee. Accordingly, in contrast to restoration of rights under Article 15(1)(iii) (see Note 15.09), a Contracting Party would not be permitted to restrict further processing to those cases in which the failure to comply with the time limit occurred in spite of all due care or was unintentional, so that there would be no requirement for a declaration or other evidence in this respect. However, a Contracting Party which provided for revival, instead of further processing, of an application would be permitted to require a statement that failure to comply with the time limit was unintentional, as is already provided for in the law of the United States of America under 37CFR§1.137(b). Under paragraph (7), evidence in support of that statement could only be required where the Office may reasonably doubt the veracity of that statement. In the absence of such reasonable doubt, a higher standard of proof than that provided for under paragraph (1)(b) would not be permitted under Article 14, although it would be permitted in respect of restoration of rights under Article 15.

14.11 Paragraph (2)(a). This provision would ensure that the provisions of the applicable national or regional law in respect of a maximum time limit for the grant of a patent would prevail over further processing or revival of an application.

14.12 Paragraph (2)(b). This provision would permit a Contracting Party to exclude the further processing or revival of an application in the case of specific time limits. However, where the failure to comply with such an excluded time limit occurred in spite of all due care required by the circumstances or was unintentional, the applicant may be entitled to request restoration of rights under Article 15 (see, in particular, Note 15.08).

14.13 Paragraph (3). This provision would permit a Contracting Party to require that a request under paragraph (1)(a) be presented on a prescribed Form. In the absence of any clear need, the Regulations do not contain a Model International Form for such requests.

14.14 Paragraph (4). Reference is made to the explanations given under Article 5(3) (see Notes 5.11 to 5.16).

14.15 Paragraph (5). Reference is made to the explanations given under Article 13(4) (see Note 13.13).

14.16 Paragraph (6)(a). Reference is made to the explanations given under Article 5(6) (see, in particular, Note 5.20).

14.17 Paragraph (6)(b), item (i). Postal services and other delivery services have been placed on the same footing in view of modern developments.

14.18 Item (ii). This item would seem to be self-explanatory.

14.19 Paragraph (7). Reference is made to the explanation given under paragraph (1)(b) (see Note 14.10).

14.20 Paragraph (8). Reference is made to the explanations given under Article 13(6) (see Notes 13.15 and 13.16).

14.21 Paragraph (9). This paragraph would permit, but not oblige, a Contracting Party to provide that an application shall not be invoked against a third party for any acts which were started, or for which effective and serious preparations were started, in good faith, during the period between three months after the expiration of the time limit and the date on which further processing or revival of a published application was allowed. In addition, that third party would be entitled to continue the act, which would otherwise contravene the applicant's rights under the applicable law once the further processing or the revival is allowed, after that period, subject to the payment of reasonable compensation under subparagraph (b).

14.22 The restrictions of subparagraph (a) to published applications and to a period which does not commence until three months after the expiration of the time limit are for the avoidance of doubt, since it would not appear that a person could, in good faith, take action on the basis of the loss of the application where the application had not been published or where a shorter time had elapsed from the date of the expiration concerned. For similar reasons, the further requirement that the fact of the refusal, withdrawal or abandonment of the application shall have been made known to the public is suggested, and is placed in square brackets for consideration by the Standing Committee.

Note on Article 15
(Restoration of Rights)

15.01 Article 15 provides for the restoration of rights in respect of an application or patent following failure to comply with a time limit for an action before the Office. However, under paragraph (1)(iii), it would be restricted to those situations in which the failure of the time limit occurred in spite of all due care required by the circumstances or was unintentional. Also, under paragraph (7), a Contracting Party would be permitted to require evidence to be furnished in support of any request, and not merely where there was doubt, as under Article 14(7). Accordingly, as in the case of existing national and regional legislation, the standard applied in respect of restoration of rights would generally be substantially higher than the case of further processing, where no such requirements would be permitted, or in the case of revival of rights where, under Article 14(1)(b), only a statement would be required. In addition, in contrast to further processing or revival under Article 14, restoration of rights would not be restricted to time limits in respect of applications. It would also not be restricted to time limits fixed by the Office.

15.02 Paragraph (1), chapeau. Under paragraph (1), a Contracting Party would be obliged to provide for the restoration of rights only where an application or patent has been refused, revoked, invalidated or considered withdrawn, abandoned, lapsed or terminated, following failure to comply with a time limit. However, a Contracting Party would be free to provide for restoration also in other cases, for example, in respect of requests to the Office, as provided for in Article 122 of the European Patent Convention. As in the case of Article 6(1), this provision is intended to also cover sanctions which are of equivalent effect to revocation or invalidation, such as non-enforceability of rights (see Note 6.05). It does not apply to the right to request the addition of a priority claim under Article 16(1), since the failure to comply with the time limit under Rule 16(1) for such addition would not have the “direct consequence” of causing the application to be refused or considered abandoned, lapsed or terminated for failure to comply with that time limit. For the same reason, it does not apply to a request for restoration of right of priority under Article 16(2)(a) for failure to comply with the period of two months for making a request prescribed in that Article where the subsequent application has a filing date which is later than the date on which the priority period expired, or under Article 16(3) for failure to comply with the time limit for making a request under that Article or for requiring a copy of the earlier application within the time limit under Rule 16(2). In addition, Article 16(2)(b) expressly provides that the time limit under Article 16(2)(a) cannot be extended.

15.03 The term “procedure before the Office,” is defined under Article 1(xiv) (see Note 1.14).

15.04 Paragraph (1) is limited to requests for restoration made in a communication signed by the “applicant” or “owner,” as defined in Article 1(viii) and (ix) (see Notes 1.07 to 1.09). However, as under Article 14(1)(a), any Contracting Party may be more liberal in this respect if it so wishes (see Note 14.05).

15.05 As in the case of Article 9(1)(a), it also follows from the wording of paragraph (1)(a) that a Contracting Party may refuse a request for restoration made by oral communication.

15.06 In contrast to Articles 13(1) and 14(1), paragraph (1) applies both to time limits fixed by the Office and to time limits or periods for action established by national legislation or under a treaty providing for the grant of regional patents. Time limits in respect of which a Contracting Party is not obliged to provide for restoration of rights, but is nevertheless permitted to do so, are listed in the exclusions under paragraph (2) (see Notes 15.10 to 15.15).

15.07 Item (i). The time limit under this item is prescribed in Rule 15(1).

15.08 Item (ii). In order that the Office may determine whether the failure to comply with the former time limit occurred in spite of all due care required by the circumstances or was unintentional, as the case may be, the request for restoration must state the grounds on which it is based. The applicant or owner may also be required under paragraph (7) to furnish a declaration or other evidence in support of those grounds within a time limit fixed by the Office.

15.09 Item (iii). This item restricts restoration of rights under paragraph (1) to cases where 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, for example,

where there had been an excessive delay or a loss in the mail or an interruption in the mail service, as provided for under PCT Rule 82.

15.10 Paragraph (2). A Contracting Party would not be obliged to provide for the restoration of rights under paragraph (1) in case of failure to comply with a time limit referred to in this paragraph.

15.11 Item (i). This item is for the avoidance of doubt.

15.12 Item (ii). Article 5*bis*(1) of the Paris Convention provides that

“(1) A period of grace of not less than six months shall be allowed for the payment of the fees prescribed for the maintenance of industrial property rights, subject, if the domestic legislation so provides, to the payment of a surcharge.”

15.13 Item (iii). The purpose of the item is to prevent an applicant or owner from obtaining what would be, in effect, double relief in respect of the procedure concerned.

15.14 Item (iv). This item, which deals with the time limit for filing a request for search or examination, may be required to avoid undue delay of prosecution of an application.

15.15 Item (v). This item seems to be self-explanatory.

15.16 Paragraph (3). Reference is made to the explanation under Article 14(3) (see Note 14.13).

15.17 Paragraph (4). Reference is made to the explanations given under Article 5(3) (see Notes 5.11 and 5.16).

15.18 Paragraph (5). Reference is made to the explanations given under Articles 5(5) and 13(4) (see Notes 5.18, 5.19 and 13.13).

15.19 Paragraph (6). Reference is made to the explanations given under Article 5(6) (see, in particular, Note 5.20).

15.20 Paragraph (7). Reference is made to the explanations given under paragraph (1)(ii) (see Note 15.08).

15.21 Paragraph (8). Reference is made to the explanation given under Article 13(6) (see Notes 13.15 and 13.16).

15.22 Paragraph (9). Reference is made to the explanations given under Article 14(9) (see Notes 14.21 and 14.22).

Note on Article 16
(Addition and Restoration of Priority Claim)

16.01 This Article is an adapted version of Article 7 of the 1991 basic proposal (document PLT/DC/3).

16.02 Paragraph (1). This provision, modeled after a portion of PCT Rule 26*bis*.1 (which enters into force on July 1, 1998), would permit the applicant to add a priority claim, on or after the filing date, to an application which could have claimed the priority of an earlier application but did not do so. This would apply irrespective of whether the application as filed contained no priority claim or whether it already claimed the priority of one or more other earlier applications. This provision is compatible with the Paris Convention since that Convention does not require that the priority claim (“the declaration” referred to in Article 4D(1) of that Convention) be contained in the subsequent application itself. Although PCT Rule 26*bis*.1 regulates both the correction and the addition of a priority claim, paragraph (1) is restricted to the addition of a priority claim since the correction of a priority claim is regulated by Article 12 (see Note 12.02).

16.03 Paragraph (1), chapeau. As regards the term “applicant,” reference is made to the definition in Article 1(viii) (see Notes 1.07 and 1.08).

16.04 Item (i). The time limit referred to in this item is prescribed in Rule 16(1).

16.05 Item (ii). Where the filing date of the subsequent application is later than the date of expiration of the priority period, restoration of the priority right may be possible under paragraph (2)(a) (see Notes 16.06 to 16.12).

16.06 Paragraph (2)(a), chapeau. This provision provides for the restoration of the priority right where a subsequent application is filed after, but within two months from, the expiration of the priority period if the failure to furnish that application within the priority period occurred in spite of all due care required by the circumstances having been taken, or, at the option of the Contracting Party, was unintentional. However, the priority period, namely the 12-month period under Article 4C(1) of the Paris Convention, would not be extended. Also, in view of the provisions of Article 4, it would not be possible to treat the subsequent application as if it had been received before the expiration of the unextended priority period.

16.07 This paragraph is limited to requests made in a communication signed by the applicant although, as under Article 14(1)(a), any Contracting Party may be more liberal in this respect if it so wishes (see Note 14.05).

16.08 As in the case of Article 9(1)(a), it also follows from the wording of this paragraph that a Contracting Party may refuse a request made by oral communication.

16.09 Item (i). This item would permit a priority claim to be restored only where the request is made within two months of the expiration of the priority period and there is a time to include it in the published application.

16.10 Item (ii). Reference is made to the explanation given under Article 15(1)(ii) (see Note 15.08).

16.11 Item (iii). As regards the terms “in spite of all due care required by the circumstances” and “unintentional,” reference is made to the explanation under Article 15(1)(iii) (see Note 15.09).

16.12 Item (iv). Under this item, restoration of a priority claim would be possible under paragraph (2)(a) even if that priority claim had not been included in the subsequent application on the filing date, provided that the request for restoration is accompanied by the priority claim.

16.13 Paragraph (2)(b). This provision would prohibit a Contracting Party from extending the period of two months for filing the subsequent application and making the request for restoration of the right of priority referred to in subparagraph (a). It is placed in square brackets for consideration by the Standing Committee in the absence of agreement at the fifth session of the Committee of Experts as to whether it should be included.

16.14 Paragraph (3)(a). This paragraph would provide a remedy for the applicant where his right of priority is lost because of the failure on the part of the Office with which the earlier application was filed to provide a copy of that application in time for the applicant to comply with the time limit referred to in Article 5(7)(a), despite a timely request for that copy having been made. Since this time limit would normally be established by national legislation or under a regional treaty, not by the Office, a remedy in this respect would not normally be available by way of further processing under Article 14(1). In addition, no remedy is available by way of restoration of rights under Article 15(1) (see Note 15.02).

16.15 This paragraph is limited to requests made in a communication signed by the applicant as defined in Article 1(viii) (see Notes 1.07 and 1.08). However, as under Article 14(1)(a), any Contracting Party may be more liberal in this respect if it so wishes (see Note 14.05).

16.16 As in the case of Article 9(1)(a), it follows from the wording of this paragraph that a Contracting Party may refuse a request made by oral communications.

16.17 Paragraph (3)(a), item (i) and paragraph (3)(b), item (i). In order that the Office may determine whether the requirement under subparagraph (a)(i) was complied with, the request for restoration must state the Office to which the request for a copy of the earlier application had been made and the date of that request. The applicant may also be required under subparagraph (b)(i) to furnish a declaration or other evidence in support of those statements.

16.18 Paragraph (3)(a), item (ii). The time limit for making a request under this item is prescribed in Rule 16(2) (see also Note R16.02). This time limit would provide a legal certainty for the applicant in that, if he requests a copy of the earlier application within the prescribed time limit, he would be provided with an opportunity to restore his priority right in the event that the Office concerned fails to provide that copy in time for compliance with the time limit referred to in Article 5(7)(a).

16.19 Paragraph (3)(b), item (ii). This item would seem to be self-explanatory.

16.20 Paragraph (4). Reference is made to the explanation under Article 14(3) (see Note 14.13).

16.21 Paragraph (5). Reference is made to the explanations given under Article 5(3) (see Notes 5.11 to 5.16).

16.22 Paragraph (6). Reference is made to the explanations given under Article 13(4) (see Note 13.13).

16.23 Paragraph (7). Reference is made to the explanations given under Article 5(6) (see, in particular, Note 5.20).

16.24 Paragraph (8). Reference is made to the explanations given under Article 13(6) (see Notes 13.15 and 13.16).

16.25 Paragraph (9). This paragraph is placed in square brackets for consideration by the Standing Committee in response to suggestions at the fifth session of the Committee of Experts that a provision on intervening rights may be required. This provision was not included in the draft Treaty and Regulations presented to the fifth session of the Committee of Experts (document PLT/CE/V/2) for two reasons. First, the time limits under Article 16 are such that it is unlikely that the application or granted patent would be published without the priority claim, or at least before the request for belated priority claim had been filed. Second, there would be no period in which the provisional protection under the published application, or actual protection under the granted patent, would be lost, and it would not be reasonable for a third party to proceed to exploit the invention on the assumption that, in the absence of a priority claim, either no patent would be granted, the granted patent would be invalid or the protection conferred by the granted patent would be more restricted than that claimed in the published application.

Note on Article 17 (Regulations)

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

17.02 As regards the Model International Forms referred to in paragraph (1)(b), see document SCP/1/5.

II. NOTES ON THE DRAFT REGULATIONS

Note on Rule 1 (Abbreviated Expressions)

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

Note on Rule 2
(Details Concerning the Filing Date Under Article 4)

R2.01 Paragraph (1). The time limits under item (ii) are equivalent to those under item (i) assuming that, on average, it would take the Office one month from the receipt of the elements concerned to issue the notification under Article 4(3).

R2.02 Paragraph (2)(a), items (i) and (iii). These items seem to be self-explanatory.

R2.03 Items (ii), (iv) and (v). Item (ii) would permit a Contracting Party to require the applicant to furnish, upon invitation, a copy of the earlier application in order to establish the contents of that earlier application, even though that Contracting Party does not require a copy to be furnished under Article 5(7)(a) for the purposes of the priority claim. Similarly, item (iv) would permit a Contracting Party to require the applicant to furnish certification of the copy and the filing date of the earlier application even though it does not require such certification under Article 5(7)(b). The time limits for furnishing a copy of the earlier application under item (ii) and for furnishing certification of the copy and the filing date of the earlier application under item (iv) are the same as the time limit for furnishing a translation of the earlier application under item (v). This latter time limit is, in turn, the same as the time limit for furnishing a translation of the earlier application under Article 5(7)(d), as prescribed in Rule 5(1)(b).

R2.04 Paragraph (2)(b). Reference is made to the explanation under Article 5(7)(c) (see Note 5.25).

R2.05 Paragraph (3)(a). Indications of the Office with which the application was filed, the filing date and the number of the previously filed application are required for the identification of the previously filed application.

R2.06 The requirement that the reference indicate the title of the previously filed application has been included at the request of one delegation at the fourth session of the Committee of Experts which suggested that the indication of that title should be required in order to permit a national security check to be carried out. However, the deletion of this requirement was proposed by another delegation at the fifth session of the Committee of Experts. It is therefore placed in square brackets for consideration by the Standing Committee as to whether or not it should be retained.

R2.07 The requirement that the reference indicate the language of the previously filed application would enable the Office to determine whether a translation of that previously filed application is required under subparagraph (d)(i) without having to wait for a copy of the previously filed application to be furnished under that subparagraph.

R2.08 Paragraph (3)(b). This provision corresponds to the requirements in Article 4(4)(a), as presented to the fifth session of the Committee of Experts (document PLT/CE/V/2), that the earlier application should be “an application previously filed by the same applicant or his predecessor in title.”

R2.09 Paragraph (3)(c). This provision, modeled after PCT Rule 18.3, has been added in response to a suggestion by a delegation at the fifth session of the Committee of Experts.

R2.10 Paragraph (3)(d). The requirements under this paragraph correspond to the requirements in Article 4(4)(a) as presented to the fifth session of the Committee of Experts (document PLT/CE/V/2).

R2.11 Where the priority of the previously filed application is claimed, the same copy of the previously filed application would serve for the purposes of both item (i) and Article 5(7)(a). Also, where the copy of the previously filed application furnished under item (i) is a certified copy, that certified copy would serve also for the purposes of item (ii). The time limit under item (i) is shorter than the time limits under item (ii) in view of the need of the Office to have a copy of the previously filed application and, where appropriate, a translation of that previously filed application, as soon as possible in order to proceed with the processing and publication of the application containing the reference. The four-month time limit for furnishing a certified copy of the earlier application under item (ii), applicable where the priority of that earlier application is not claimed, generally corresponds to the four-month period between the expiration of the priority period and the expiration of the 16-month time limit under Rule 5(1) for furnishing a copy of an application whose priority is claimed under Article 5(7)(a).

R2.12 Since Article 4(7)(a) would permit a reference to any previously filed application, it would not appear necessary, for the purposes of that Article, for the copy of the previously filed application to be accompanied by a certificate from the Office with which the earlier application was filed showing the date of filing, even though, in accordance with Article 4D(3) of the Paris Convention, such certificate may be required under Article 5(7) for the purposes of a priority claim.

R2.13 Paragraph (3)(e). Reference is made to the explanation under Article 5(7)(c) (see Note 5.25).

Note on Rule 3

(Filing of Applications Under Article 5(3); Communication in
Electronic Form or by Other Means)

R3.01 Paragraph (1). Reference is made to the explanation under Article 5(3) (see, in particular, Note 5.12).

R3.02 Paragraph (2)(a). This provision would oblige any Contracting Party which accepts the electronic filing of international applications under the PCT to also accept the electronic filing of national applications and to apply the same requirements. PCT Rule 89*bis* which will enter into force from July 1, 1998, provides for the filing, processing and transmission of international applications and other documents in electronic form. A Contracting Party which does not accept the electronic filing of international applications would not be obliged to accept the electronic filing of national applications, but would be free to do so and, if it did so, to apply its own requirements. The effect of the linkage with the PCT is that the expression “filing of applications in electronic form” would have the same meaning under this Treaty as it has under the PCT. As an example, this provision would apply where applications are filed directly from the computer of an applicant to the I/O server of the Office by using electronic transmission, e.g., facsimile (see Note R3.05).

R3.03 The restriction of the requirements to a particular language would appear necessary since the PCT may prescribe different requirements for the electronic filing of applications in different languages. Thus, the requirements for electronic filing in a language using the Latin alphabet, for example, English, may be different from the requirements for electronic filing in a language which does not use an alphabet, for example, Chinese. It is to be noted that the requirements under paragraph (2)(a) could include requirements in respect of the computer language in which the application is filed.

R3.04 Paragraph (2)(b). Although this provision has been drafted on the assumption that, before the adoption of the present Treaty, there will be requirements applicable under the PCT in relation to the electronic filing of international applications, it would still be applicable even if this were not the case. Proposals on the authentic and official languages of the Treaty will be presented to a future session of the Standing Committee as part of the administrative and final provisions of the Treaty.

R3.05 Paragraph (3). This provision, which is consistent with PCT Rule 92.4(a) as amended with effect from July 1, 1998, deals with the filing of applications by means of a communication which results in the filing of a printed or written document. In addition to filing by telegraph, teleprinter and facsimile transmission as mentioned, it would also encompass, for example, the sending of a facsimile transmission directly from a computer.

R3.06 Paragraph (4)(a). This provision, consistent with PCT Rule 89*ter*.1 which will enter into force from July 1, 1998, would oblige a Contracting Party which provides for the filing of applications in electronic form with its Office, to permit the filing of a copy, in electronic form, of an application filed on paper. This would enable the Office to obtain the benefits of electronic filing where an application is filed on paper.

R3.07 Paragraph (4)(b). This provision seems to be self-explanatory.

R3.08 Paragraph (5). This provision is consistent with PCT Rule 89*bis*.2 which will enter into force from July 1, 1998.

Note on Rule 4

(Evidence Under Articles 5(8), 7(9), 8(3)(a), 9(8), 10(9), 11(9), 12(8) and 14(7))

R4.01 Reference is made to the explanations under Articles 5(8), 7(9), 8(3)(a), 9(8), 10(9), 11(9), 12(8) and 14(7) (Notes 5.28, 7.28, 8.05, 9.12, 10.18, 11.10, 12.12 and 14.19, respectively).

Note on Rule 5

(Time Limits Concerning the Application Under Article 5)

R5.01 Paragraph (1)(a). Reference is made to the explanation given under Article 5(7)(a) (see Note 5.22).

- R5.02 Paragraph (1)(b). The time limit under this provision reflects the fact that Article 5(7)(b) requires the applicant to furnish a translation of the earlier application only upon invitation by the Office.
- R5.03 Paragraph (2)(a). This provision seems to be self-explanatory.
- R5.04 Paragraph (2)(b). The time limit for furnishing a translation under this provision is calculated from the date of the receipt of the document to be translated in order to avoid undue delay in the receipt by the Office of that translation.
- R5.05 Paragraph (2)(c). This provision would seem to be self-explanatory.
- R5.06 Paragraph (2)(d). The time limit for the correction of a priority claim under the PCT is prescribed in PCT Rule 26*bis*.1(a) which will enter into force on July 1, 1998 (see also Note R16.01).
- R5.07 Paragraph (3)(a). As regards the relationship between the time limits under items (i) and (ii) reference is made to the explanation given under Rule 2(1) (see Note R2.01).
- R5.08 Paragraph (3)(b). This paragraph seems to be self-explanatory.

Note on Rule 6
(Receipt of Communications)

- R6.01 Paragraph (1). This paragraph, which has been added in response to an observation made by a delegation at the fifth session of the Committee of Experts, is placed in square brackets for consideration as to whether this is a matter for which express provision should be made in the Regulations, or whether it would be sufficient to deal with the matter in the Notes, for example, in the context of the date of receipt of the elements of an application under Article 4(1)(a).
- R6.02 Paragraph (2). It is recognized that, in the absence of this provision, the result would be the same. Thus, the purpose of this provision is to emphasize the flexibility maintained by each Contracting Party regarding the permissible methods of transmission of communication. Postal services and other delivery services have been put on the same footing in view of modern developments. Reference is also made to the Notes under Article 4(1)(a) (see, in particular, Note 4.04).

Note on Rule 7
(Details Concerning Representation and Address for Service Under Article 7)

- R7.01 Paragraph (1). The application, *mutatis mutandis*, of Rule 3(1) would require all Offices to accept the filing of powers of attorney in paper form. As in the case of applications under Article 5(3), a Contracting Party could require that powers of attorney filed in paper form be typed or printed; that is, it would not be obliged to receive handwritten powers of attorney, although it would be permitted to do so (see Note 5.12).

R7.02 Reference is made to the explanations given under Rule 3(2) to (4) (see Notes R3.02 to R3.07).

R7.03 Paragraph (2)(a). This provision seems to be self-explanatory.

R7.04 Paragraph (2)(b). As regards the relationship between the time limit under this provision and the time limits under subparagraph (a), reference is made to the explanations given under Rule 2(1) (see Note R2.01).

R7.05 Paragraph (2)(c). The time limit for furnishing a translation under this provision is calculated from the date of receipt of the power of attorney to be translated in order to avoid undue delay in the receipt of that translation.

Note on Rule 8
(Details Concerning the Signature Under Article 8)

R8.01 Paragraph (1). This paragraph applies to the signature of any natural person, including the case where a natural person signs on behalf of a legal entity. Item (ii) corresponds to the note in box No. IX of PCT Request Form.

R8.02 Paragraph (2). The date of signing may be important, for example, to determine the legal competence of the person who gave the signature.

R8.03 Paragraph (3), item (i). This item seems to be self-explanatory.

R8.04 Item (ii). The other form of signature permitted under this item may be, for example, a printed or stamped reproduction of the handwritten signature of the person whose signature is required.

R8.05 Item (iii). The nationality of the person who signs the communication is required under this item in view of the provisions under the national law of at least one State relating to the use of seals by the nationals of that State.

R8.06 Paragraph (4). Subparagraph (a) requires a Contracting Party to accept the signature or seal on the printout of a communication transmitted by telefacsimile. However, subparagraph (b) allows any Contracting Party to require that a paper original of that communication be filed with the Office within a time limit of not less than one month from the date of receipt of the facsimile transmission. This would also apply to a facsimile which is sent from a computer; the original would be a print-out of the computer file. Where that paper original is not furnished within the applicable time limit, the Office may consider the communication in question as not having been signed.

R8.07 Paragraph (5). Reference is made to the explanations under Rule 3(2) (see Notes R3.02 to R3.04).

R8.08 Paragraph (6)(a). This provision seems to be self-explanatory.

R8.09 Paragraph (6)(b). As regards the relationship between the time limit under this provision and that under subparagraph (a), reference is made to the explanation under Rule 2(1) (see Note R2.01).

Note on Rule 9
(Details Concerning Request for Recordal of Change in
Name or Address Under Article 9)

R.9.01 Paragraph (1), 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 could, for example, require that evidence that the indications given are correct be furnished under Article 9(8), or that the change concerned be recorded beforehand or be included in the request.

R9.02 Item (ii). This item seems to be self-explanatory.

R9.03 Item (iii). This item would apply where the applicant or owner provides an address on a voluntary basis, as well as where an address is required, before and/or after any requested change of address, under Article 7(3) (see, in particular, Notes 7.15 and 7.16.)

R9.04 Paragraph (2). The application, *mutatis mutandis*, of Rule 3(1) would require all Offices to accept the filing of requests referred to in Article 9(1)(a) on paper. As in the case of applications under Article 5(3), a Contracting Party could require that such requests filed on paper be typed or printed; that is, it would not be obliged to receive handwritten requests, although it would be permitted to do so (see Note 5.12).

R9.05 Reference is made to the explanations given under Rule 3(2) to (4) (see Notes R3.02 to R3.07).

R9.06 Paragraph (3)(a). This provision seems to be self-explanatory.

R9.07 Paragraph (3)(b). As regards the relationship between the time limit under this provision and the time limit under subparagraph (a), reference is made to the explanation given under Rule 2(1) (see Note R2.01).

Note on Rule 10
(Details Concerning Request for Recordal of Change in Applicant or Owner
Under Article 10)

R10.01 Paragraph (1), item (i). Reference is made to the explanation given under Rule 9(1)(i) (see Note R9.01).

R10.02 Items (ii) to (vii). These items would seem to be self-explanatory.

R10.03 Item (viii). Reference is made to the explanations given under Article 7(3) and Rule 9(1)(iii) (see, in particular, Notes 7.15, 7.16 and R9.03).

R10.04 Item (ix). The basis for the change in the person of the applicant or owner would be, for example, a contract assigning the ownership of the application or patent concerned, a merger, the reorganization or division of a legal entity, the operation of law, or a court decision transferring the ownership of an application or patent.

R10.05 Paragraphs (2) and (3). Reference is made to the explanations given under Rule 9(2) and (3) (see Notes R9.04 to R9.07).

Note on Rule 11

(Details Concerning Request for Recordal of a Licensing Agreement
or Security Interest Under Article 11)

R11.01 Paragraph (1), item (i). Reference is made to the explanation given under Rule 9(1)(i) (see Note R9.01).

R11.02 Items (ii) to (v). These items would seem to be self-explanatory.

R11.03 Item (vi). Reference is made to the explanations given under Article 7(3) and Rule 9(1)(iii) (see, in particular, Notes 7.15, 7.16 and R9.03).

R11.04 Paragraph (2). Reference is made to the explanation regarding the filing of requests on paper given under Rule 9(2) (see Note R9.04).

R11.05 Paragraph (3). Reference is made to the explanation under Rule 3(2) to (4) (see Notes R3.02 to 3.07).

R11.06 Paragraph (4)(a). This provision seems to be self-explanatory.

R11.07 Paragraph (4)(b). As regards the relationship between the time limit under this provision and the time limit under subparagraph (a), reference is made to the explanation given under Rule 2(1) (see Note R2.01).

R11.08 Paragraph (5). This provision seems to be self-explanatory.

Note on Rule 12

(Details Concerning Request for Correction of a Mistake Under Article 12)

R12.01 Paragraph (1), item (i). Reference is made to the explanations given under Rule 9(1)(i) (see Note R9.01).

R12.02 Item (ii). This item seems to be self-explanatory.

R12.03 Item (iii). Reference is made to the explanations given under Article 7(3) and Rule 9(1)(iii) (see, in particular, Notes 7.15, 7.16 and R9.03).

R12.04 Paragraphs (2) and (3). Reference is made to the explanations under Rule 9(2) and (3) (see Notes R9.04 to R9.07).

Note on Rule 13
(Details Concerning Extension of a Time Limit
Fixed by the Office Under Article 13)

R13.01 Paragraph (1)(a). This provision seems to be self explanatory.

R13.02 Paragraph (1)(b). This provision, which provides that the extended time limit shall be calculated from the starting date for the calculation of the original time limit for an action before the Office, is relevant, for example, where the original time limit, as calculated from that starting date, expires on a non-working day.

R13.03 Paragraph (2). Reference is made to the explanation under Rule 9(2) (see Notes R9.04 and R9.05).

Note on Rule 14
(Details Concerning Further Processing or Revival of Application Under Article 14)

R14.01 Paragraph (1). This paragraph seems to be self-explanatory.

R14.02 Paragraph (2). Reference is made to the explanations given under Rule 9(2) (see Notes R9.04 and R9.05).

Note on Rule 15
(Details Concerning Restoration of Rights Under Article 15)

R15.01 Paragraph (1), item (i). This item seems to be self-explanatory.

R15.02 Item (ii). A time limit of 12 months under this item, as suggested by the representative of a non-governmental organization at the fifth session of the Committee of Experts, is placed in square brackets as an alternative to the previously proposed time limit of six months, for consideration by the Standing Committee.

R15.03 Paragraph (2). Reference is made to the explanations under Rule 9(2) (see Notes R9.04 and R9.05).

Note on Rule 16
(Details Concerning Addition and Restoration of Priority Claim Under Article 16)

R16.01 Paragraph (1). The applicable time limit for the submission of a priority claim after the filing of an international application under PCT Rule 26bis.1(a), which will enter into force on July 1, 1998, is 16 months from the priority date or, where the addition would cause a change in the priority date, 16 months from the priority date so changed, whichever 16-month

period expires first, provided that such a priority claim may be submitted until the expiration of 4 months from the filing date of the application.

R16.02 Paragraph (2). A two-month time limit is proposed having regard to, first, the minimum period of four months between the expiration of the 12-month priority period and the 16-month time limit under Rule 5(1), and, second, the time needed by Offices to provide copies of earlier applications.

R16.03 Paragraph (3). Reference is made to the explanations given under Rule 9(2) (see Notes R9.04 and R9.05).

Note on Rule 17
(Manner of Identification of an Application
Without Its Application Number)

R17.01 Paragraph (1). This paragraph deals with the indications and elements which a person, communicating with an Office, must furnish to identify an application the number of which is not known (see Articles 9(7), 10(8), 11(8) and 12(7)). Each of items (i) and (ii) constitutes a maximum requirement.

R17.02 Paragraph (2). This provision does not prohibit Contracting Parties from allowing an applicant to give less information or from accepting other means of identification.

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