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REVISED TEXT OF PROVISIONS REFERRED TO THE
INTERNATIONAL BUREAU FOR FURTHER STUDY

prepared by the International Bureau

INTRODUCTION

1. The present document contains revised draft texts of those provisions of the draft Patent Law Treaty ("PLT") and accompanying Regulations which were referred to the International Bureau for further study by the Standing Committee on the Law of Patents at its first session, first part (June 15 to 19, 1998) as reported in the Summary by the Chair (document SCP/1/6). Differences between the text of the draft Treaty and Regulations submitted to the first session, first part (document SCP/1/3) and the revised draft texts contained in the present document have been highlighted as follows: (i) words which did not appear in document SCP/1/3 but appear in the present text are underlined, and (ii) words which appeared in document SCP/1/3 which are omitted from the present document are shown as struck through. Text from document SCP/1/3 which is merely moved to a different location without change in substance is not underlined. A brief commentary by the International Bureau on each suggested change is included in square brackets.

2. For reference, provisions of the draft PLT and accompanying Regulations which were discussed during the first session, first part, of the SCP are contained in the Annex of the present document. Provisions which have been either adopted, adopted with modifications or deleted at the first session, first part, of the SCP, and therefore, have been closed for further discussions, except at the express request of a Member of the Standing Committee or to approve consequential modifications made by the International Bureau when redrafting other provisions, are indicated within a frame. The text outside of the frames incorporates the changes suggested by the International Bureau in the present document.

3. Where there is a difference between the text of the provisional document (SCP/1/8 Prov.) which was posted on the SCP Electronic Forum and the present document, a bar has been placed in the right margin.

REVISED TEXT OF PROVISIONS REFERRED TO THE
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DRAFT TREATY

Article 1

Abbreviated Expressions

(i) “Office” means the authority of a Contracting Party entrusted with the granting of patents or with other matters covered by this Treaty;

[Commentary on suggested changes to draft Article 1(i):

Since not all Offices are entrusted with the granting of patents, it is proposed to broaden the definition of “Office” to cover procedures which are included within the scope of the draft Treaty, for example, the recordal of change in owner or the recordal of a licensing agreement. The expression “other matters covered by this Treaty” is used in, for example, Article 17(2) of the WIPO Copyright Treaty (WCT) (1996).]

...

(xi) [Deleted]

[Commentary on suggested changes to draft Article 1(xi):

To avoid the possibility of introducing a *de facto* interpretation of the term “address for service” as used in Article 2(3) of the Paris Convention, it is proposed that that term should not be defined in the Treaty. What constitutes an “address for service” would be a matter for national law. Since the provisions which refer to “address for service” are maximum requirements, a Contracting Party could apply a lesser requirement, for example, “an address for communication.”]

...

[Proposed new item defining “inventor”:

The inclusion of a new item, as suggested by the Delegation of the United States of America, stating that the determination of who is the inventor is a matter of national law, is not proposed. However, since the term “inventorship” is used in draft Articles 10(12) and 12(12), it is proposed to add to each of those Articles the following statement: “What constitutes inventorship shall be determined under the applicable law of the Contracting Party.”]

Article 1bis

Notification by the Office

(1) [If Indications Allowing Contact Were Not Submitted] Nothing in this Treaty and the Regulations shall oblige a Contracting Party to send a notification to an applicant, owner or other interested person, if indications allowing that applicant, owner or other interested person to be contacted have not been submitted to the Office.

[Commentary on suggested changes to draft Article 1bis(1):

It is proposed to include this general provision, in place of redrafting draft Article 4(3), in respect of a notification by the Office where indications allowing a person to be contacted by the Office have not been submitted.]

(2) [Failure to Notify] Where this Treaty or the Regulations require a Contracting Party to notify an applicant, owner or other interested person of failure to comply with requirements, failure to notify the applicant, owner or other interested person does not relieve that applicant, owner or other interested person of the obligation to comply with those requirements.

[Commentary on suggested changes to draft Article 1bis(2):

This general provision is added for avoidance of doubt. In accordance with draft Article 6(2), a patent may not be revoked or invalidated, without the owner being given an opportunity to make observations and to comply with the relevant requirements concerned. This paragraph clarifies that, even if the owner has not been notified of the intended revocation or invalidation, that fact does not exempt the owner from his obligation to comply with those requirements.]

[Article 1*bis*, continued]

(3) [*Address for Communication*] A Contracting Party may require that an applicant, owner or other interested person indicate the address the Office should use for the purposes of correspondence.

[Commentary on suggested changes to draft Article 1*bis*(3):

The inclusion of this new paragraph, as suggested by the Delegation of the United States of America, permits a Contracting Party to require that an address for communication be indicated. The address for communication could be the applicant's address, as indicated in the application, the representative's address, the applicant's or representative's address for service, or another address, as permitted by the Contracting Party.]

Article 3

National Security

Nothing in this Treaty and the Regulations shall limit the freedom of any Contracting Party to ~~apply measures~~ take any action deemed necessary for the preservation of its national security.

[Commentary on suggested changes to draft Article 3:

The term “take any action,” as used in Article 73 of the TRIPS Agreement, is proposed in order to encompass both “measures” and “procedures.”]

Article 4

Filing Date

...

(3) [*Notification*] ~~(a)~~ Where the application does not comply with one or more of the requirements of paragraphs (1) and (2), the Office shall promptly notify the applicant of any requirement not complied with.

~~(b)~~ [Moved to Article 4(5)(a)]

[Commentary on suggested changes to draft Article 4(3):

The proposal to delete the reference to draft paragraph (1)(a)(ii), that is, to restrict the provision to the requirements of paragraphs (1)(a)(i) and (iii), (1)(b) and (2), has not been followed. If an applicant fails to comply with the requirement of, say, paragraph (1)(a)(i) and complies with the requirement of paragraph (1)(a)(ii) by furnishing indications allowing the identity of the applicant to be established, and not by furnishing indications allowing him to be contacted, it would still not be possible for the applicant to be notified of the failure to comply with the requirement of paragraph (1)(a)(i). Instead of revising this paragraph, a general provision, namely new draft Article 1*bis*, is proposed in order to cover the cases where indications allowing a person to be contacted by the Office is not submitted.]

...

(5) [~~*Submission of Missing Description or Drawings*~~] (a) Where, for the purposes of establishing the filing date, the Office determines that a part of the description is missing from the application or that the application refers to a drawings which, in fact, are not included in its missing from the application, the Office shall, promptly after the determination has been made, notify the applicant accordingly.

[Article 4(5), continued]

[Commentary on suggested changes to draft Article 4(5):

This paragraph now regulates all of the formal procedures which apply for the purposes of determining the filing date where a part of the description is missing from the application or the application refers to a drawing which, in fact, is missing from the application. Since it is necessary for the filing date to be determined without undue delay, it is proposed that this paragraph should be restricted to those cases where the procedures concerned, namely any determination of the missing description or drawing by the Office, notification to the applicant and submission of the missing part of description or drawing by the applicant, take place within a short period from the receipt of the incomplete application. It should be noted that the corresponding provisions in respect of missing drawings under PCT Article 14(2) and Rules 20.2(a)(iii) and 26.6(b) apply where the missing drawings are received within 30 days from the date on which the incomplete papers were filed.

Where the Office makes a determination and notifies an applicant, after the expiration of the time limit prescribed in draft Rule 2(1*bis*), that a part of the description or a drawing is missing, it might still be possible, under the applicable national law, for the applicant to rectify the omission of the missing description or drawing by way of an amendment or a correction of the application. However, this would be a matter of substantive law which is not regulated under the draft Treaty.

Commentary on subparagraph (a):

The contents of former paragraph (3)(b) have been transferred to this subparagraph with the incorporation of a reference to a missing part of the description. In addition, it is now made clear that the notification by the Office shall be made promptly after the determination that a part of the description or drawing is missing.]

~~(ab)~~ Subject to subparagraphs ~~(bc)~~ and ~~to (cc)~~ and ~~paragraph (6)~~, where a missing part of the description or a missing drawings referred to in the application, but in fact not included, are furnished to the Office within the time limit prescribed in the Regulations, that part of the description or drawing shall be included in the application, and the filing date shall be the date on which the Office has received that part of the description or those drawings, or the date on which all of the requirements referred to in paragraphs (1) and (2) are complied

[Article 4(5)(b), continued]

with, whichever is later. ~~Otherwise~~ Where the missing drawing is not furnished to the Office within that time limit, for the purposes of establishing the filing date, any reference to the said drawings shall be considered non-existent.

[Commentary on subparagraph (b):

The contents of former paragraph (5)(a) have been transferred to this subparagraph with the incorporation of a reference to a missing part of the description. The first sentence has been modified to provide a positive requirement that the missing part of the description or drawing be included in the application if it is furnished within the applicable time limit. This subparagraph is not restricted to the case in which the missing description or drawing is furnished in response to a notification under subparagraph (a). It, therefore, also regulates the procedure in which the applicant himself realizes that part of the description or the drawing has been omitted and furnishes the missing description or drawing in the absence of, or prior to, such notification.]

~~(b)~~ Notwithstanding subparagraph (b) and subject to subparagraph (d), A Contracting Party ~~[may]~~[shall] provide that, where the Office determines, within a time limit prescribed by the Contracting Party, if any, that the all missing parts of the description and all missing drawings furnished under subparagraph ~~(a)~~ do not contain new matter, the filing date shall be the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with.

[Commentary on subparagraph (c):

The contents of former paragraph (5)(b) have been transferred to this subparagraph with the incorporation of a reference to a missing part of the description. As in the case of former paragraph (5)(b), no Contracting Party would be required to make a determination under this subparagraph. Where there is more than one missing part of the description or drawing, none of those parts may contain new matter for this subparagraph to apply.

[Article 4(5)(c), continued]

If there is more than one missing part of the description or drawing and the Office determines that a part of the missing description or drawing contains new matter, subparagraph (c) would apply if the part which contains new matter is withdrawn under subparagraph (e).

In response to the concerns expressed at the first session, first part, of the SCP regarding the applicability of this provision where the determination that a part of the description or drawing is missing is not made until after the publication of the application, for example, during substantive examination, it is proposed that the provision should be restricted to those cases where that determination is made within a time limit prescribed by the Contracting Party, if any; for example, before the completion of the technical preparations for publication.]

(d) Where ~~a~~ the missing part of the description or missing drawing is furnished ~~after the filing date under subparagraph (b)~~ to rectify its unintentional omission from ~~the an~~ application ~~on the filing date, and the application which~~ claims the priority of an earlier application, the Office shall, upon the request of the applicant and subject to the requirements prescribed in the Regulations, consider the contents of that earlier application as having been contained in the application claiming priority in determining, for the purposes of ~~the filing date~~ subparagraph (c), whether that part of the description or that drawing contains new matter.

[Commentary on subparagraph (d):

The contents of former paragraph (6) have been transferred to this subparagraph with the incorporation of a reference to a missing part of the description. In addition, this subparagraph now refers expressly to the determination referred to in subparagraph (c) for the purposes of the filing date. Any provisions applicable to the determination of the allowability of incorporating a missing part of the description or drawing by way of amendment or correction would not be regulated by the draft Treaty and would remain a matter for national law. The Notes will reflect that a Contracting party may require the applicant to submit an express statement of incorporation by reference of the earlier application.]

(~~ee~~) Where all or part of the missing part of the description and missing drawings furnished under subparagraph (a~~b~~) are withdrawn within a time limit fixed by the Contracting Party, and a determination under subparagraph (c) has been made that any remaining part of the missing description and missing drawings furnished under subparagraph (b) does not contain new matter, the filing date shall be the date on which the requirements referred to in paragraphs (1) and (2) are complied with, ~~and any reference to the said drawings shall be considered non-existent.~~

[Commentary on subparagraph (e):

The contents of former paragraph (5)(c) have been transferred to this subparagraph with the incorporation of references to a missing part of the description and to the determination under subparagraph (c). This provision would enable an applicant to preserve, as the filing date, the date (the “original filing date”) on which the requirements of paragraphs (1) and (2) were complied with by withdrawing all or part of the missing description and drawings furnished under subparagraph (b) in respect of which the determination referred to in subparagraph (c) has been made. An example would be where, after the original filing date, the applicant furnished three missing drawings which were unintentionally omitted from an application claiming the priority of an earlier application, only two of which were included in the earlier application. In the case of an Office which applies subparagraph (c), the applicant would only be required to withdraw the drawing which was not in the earlier application in order to retain the original filing date, provided that he requested that the contents of the earlier application be considered under that subparagraph.]

(6) [*Consideration of Contents of Earlier’s Application*] [Moved to Article 4(5)(d)]

...

[Article 4, continued]

{(8) [*Divisional Applications*;]*Continuation and Continuation-in-Part Applications*]

Nothing in this Article shall limit:

(i) the right of an applicant under Article 4G(1) or (2) of the Paris Convention to preserve, as the date of a divisional application referred to in that Article, the date of the initial application referred to in that Article and the benefit of the right of priority, if any;]

(ii) the freedom of any Contracting Party to apply any requirements necessary to accord the benefit of the filing date of an application for a continuation or a continuation-in-part of an earlier application.]

[Commentary on suggested changes to draft Article 4(8):

New item (ii) would permit a Contracting Party to apply different filing date requirements in the case of an application for continuation or continuation-in-part of an application, each of which is a type of application to which the draft Treaty applies under Article 2(1)(a). The reference to “divisional applications” in the title and item (i) are presented in square brackets pending a decision on the inclusion in the PCT Regulations of a provision permitting a divisional application to be filed as an international application (see Note 4.30 in document SCP/1/4).]

Article 7

Representation; Address for Service

...

(3) [*Address Where No Representative Is Appointed*] (a) Where no representative is appointed, a Contracting Party may require, for the purposes of any procedure before the Office other than a procedure referred to in paragraph (2)(i) to (iv), that an applicant, owner or other interested person:

~~(i) indicate, as his address, the address of a 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 the territory of the Contracting Party.~~

(b) Where an applicant, owner or other interested person has a domicile or real and effective industrial or commercial establishment on the territory of the Contracting Party and has provided the address of that domicile or establishment, that address shall be considered to be the address for service for the purposes of subparagraph (a) unless that applicant, owner or other interested person expressly indicates another address as the address for service on the territory of the Contracting Party.

[Commentary on suggested changes to draft Article 7(3):

The proposed amendment of this paragraph is intended to clarify the requirement for address for service where the applicant has provided the address of a domicile or business on the territory of the Contracting Party concerned.]

[Article 7, continued]

(4) [*Power of Attorney*] (a) A Contracting Party shall accept that the appointment of the representative be furnished to the Office in:

(i) a separate communication (hereinafter referred to as a “power of attorney”) ~~indicating the name of, and signed by,~~ the applicant, owner or other interested person and indicating the name of the person making the appointment and the name and address of the representative; or, at his option,

(ii) the request Form referred to in Article 5(2), signed by the applicant.

[Commentary on suggested changes to draft Article 7(4):

This provision has been modified to conform with the contents of Model International Form No. 2 and to avoid the need to include a requirement for the name and address of the representative under Rules 9 to 12.]

...

Article 9

Request for Recordal of Change in Name or Address

(1) [Request] ~~(a)~~ Where there is no change in the person of the applicant or owner but there is a change in his name or address, a Contracting Party shall accept that a request for recordal of the change be made in a communication signed by the applicant or owner and ~~indicating the number of the application or patent concerned and the change to be recorded.~~

~~(b) — A Contracting Party may require that the request containing~~ the indications prescribed in the Regulations.

[Commentary on suggested changes to draft Article 9(1):

It is proposed to transfer the indications required in the request for recordal of change in name or address under this Article to the Regulations, namely, Rule 9(1).]

...

Article 10

Request for Recordal of Change in Applicant or Owner

(1) [*Request for Recordal of a Change in Applicant or Owner*] ~~(a)~~ Where there is a change in the person of the applicant or owner, a Contracting Party shall accept that a request for recordal of the change be made in a communication signed by the applicant or owner, or by the new applicant or owner, and ~~indicating the number of the application or patent concerned and the change to be recorded.~~

~~(b) A Contracting Party may require that the request containing the indications prescribed in the Regulations.~~

[Commentary on suggested changes to draft Article 10(1):

It is proposed to transfer the indications required in the request for recordal of change in applicant or owner under this Article to the Regulations, namely, Rule 10(1).]

...

(12) [*Exclusion with Respect to Inventorship of Application of Article 10*] A Contracting Party may exclude the application of this Article in respect of changes in inventorship. What constitutes inventorship shall be determined under the applicable law of the Contracting Party.

[Commentary on suggested changes to draft Article 10(12):

Reference is made to the explanation under Article 1 on the proposed new item defining “inventor.”]

Article 11

Request for Recordal of a Licensing Agreement or Security Interest

(1) [*Request for Recordal of a Licensing Agreement*] ~~(a)~~ Where a licensing agreement in respect of an application or patent may be recorded under the applicable law, the Contracting Party shall accept that a request for recordal of that licensing agreement be made in a communication signed by the licensor or the licensee and ~~indicating the number of the application or patent concerned.~~

~~(b) A Contracting Party may require that the request containing the indications prescribed in the Regulations.~~

[Commentary on suggested changes to draft Article 11(1):

It is proposed to transfer the indications required in the request for recordal of a licensing agreement or security interest under this Article to the Regulations, namely, Rule 11(1).]

...

Article 12

Request for Correction of Mistake

(1) [*Request*] ~~(a)~~ Where an application, a patent or any request communicated to the Office in respect of an application or a patent contains a mistake which is correctable under the applicable law, the Contracting Party shall accept that a request for correction of that mistake in the records and publications of the Office be made in a communication signed by the applicant or owner and ~~indicating the number of the application or patent concerned, the mistake to be corrected and the correction to be made.~~

~~(b)~~ A Contracting Party may require that the request containing the indications prescribed in the Regulations.

[Commentary on suggested changes to draft Article 12(1):

It is proposed to transfer the indications required in the request for correction of mistake under this Article to the Regulations, namely, Rule 12(1).]

...

(12) [*Exclusion With Respect to Inventorship of Application of Article 12*] A Contracting Party may exclude the application of this Article in respect of ~~corrections~~ changes in inventorship. What constitutes inventorship shall be determined under the applicable law of the Contracting Party.

[Article 12(12), continued]

[Commentary on suggested changes to draft Article 12(12):

Reference is made to the explanation under Article 1 on the proposed new item defining “inventor.”]

Article 13

Extension of a Time Limit Fixed by the Office

...

(2) [*Exceptions*] ~~(a) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under paragraph (1) to extend a time limit for an action in a procedure before the Office in respect of any of those requirements beyond that maximum time limit.~~

~~(b) No Contracting Party shall be required to grant an extension under paragraph (1) with respect to the time limits prescribed in the Regulations~~

~~(i) a second, or any subsequent, extension of a time limit in respect of which an extension has already been granted under that paragraph;~~

~~(ii) an extension of a time limit for filing a request for an extension of a time limit.~~

[Commentary on suggested changes to draft Article 13(2):

It is proposed to transfer the exceptions under this Article to the Regulations (new draft Rule 13(1*bis*)). This would both simplify the Treaty and facilitate the adoption of any future changes which may be required.]

...

[Article 13, continued]

(4) [*Language*] Article 5(~~3~~5) shall apply, *mutatis mutandis*, to requests under paragraph (1).

[Commentary on suggested changes to draft Article 13(4):

The reference to Article 5(5) has been corrected.]

Article 14

Further Processing or Revival of Application
Continued Processing and/or Re-instatement of Application [or Patent]
Without a Finding of Due Care by the Office

[Commentary on suggested changes to draft Article 14; Title:

The title has been amended in consequence of the proposed changes to paragraph (1).]

(1) [~~Request for Further Processing or Revival of Application~~] ~~(a)~~—Where an application has been, or is to be, refused or considered withdrawn or abandoned following failure ~~applicant [or owner] has failed~~ to comply with a time limit {fixed by the Office} for an action in a procedure before the Office, the Office shall, ~~subject to subparagraph (b), at the option of the Contracting Party,~~

~~(i)~~—~~consider proceed with the further processing of the application as if that time limit to have had been complied with, or and~~

~~(ii)~~—~~if necessary, re-instate revive the said application [or patent] concerned, if:~~

~~upon~~ (i) a request to that effect made in a communication to the Office signed by ~~that~~ the applicant [or owner]; ~~if the request is made, and~~

(ii) all of the requirements in respect of which the time limit for the said

[Article 14(1)(ii), continued]

action ~~in a procedure before the Office~~ applied are complied with, within the time limit prescribed in the Regulations.

~~(b) A Contracting Party may provide that a request for revival under subparagraph (a) be accompanied by a statement that the failure to comply with the time limit was unintentional.~~

[Commentary on suggested changes to draft Article 14(1):

In order to clearly distinguish between draft Articles 14 and 15, it is highlighted that draft Article 14 is restricted to the cases where a finding by the Office that the non-compliance with the time limit occurred in spite of all due care is not required.

It is proposed to move former draft Article 14(1)(b) to new Rule 14(1*bis*), and to provide that a Contracting Party may require that the request under this paragraph be accompanied by a statement that the failure to comply with the time limit was unintentional, if that request is made, and all the requirements are complied with, later than two months from the date of the expiration of the time limit for an action in a procedure before the Office, following the statement by the Delegation of the United States of America that if draft Rule 14(1) were to be limited to a very short period, for example no more than two months from the date of the expiration of the time limit for an action in a procedure before the Office, there may be no need for a statement, and the comment by the Delegation of Germany that draft Article 14 should be restricted to a procedure where relief is subject only to the payment of a fee.

In accordance with the views expressed by a majority of these delegations, this paragraph refers to any situation where an applicant [or owner] fails to comply with a time limit fixed by the Office.

Following suggestions regarding the terminology used, this paragraph now provides for the Office to “continue processing” and/or “re-instate” an application or patent. In the absence of any clear consensus as to whether re-instatement should be provided under this paragraph in the case of a patent, the term “or patent” is placed in square brackets for further consideration. The manner in which a Contracting Party provides for such re-instatement would be a matter for national law. For example, in the case of an application, it could be by way of so-called “further processing” as under Swiss law and the European Patent Convention, or by way of “revival” as under the law of the United States of America.]

[Article 14, continued]

(2) [*Exceptions*] ~~(a)~~—No Contracting Party shall be required to provide for the re-instatement of an application [or patent] under paragraph (1) with respect to the exceptions prescribed in the Regulations which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required to grant further processing or revival under paragraph (1)(a) after the expiration of that time limit.

~~(b)—The law of any Contracting Party may specify certain time limits in respect of which further processing or revival under paragraph (1)(a) shall be excluded.~~

[Commentary on suggested changes to draft Article 14(2):

It is proposed that the exceptions under this paragraph be transferred to the Regulations (new draft Rule 14(1*ter*)). This proposed transfer would simplify the Treaty and facilitate the adoption of any future change which may be required.]

...

~~(9) [*Intervening Rights*] [Text Deleted]~~

[Commentary on former draft Article 14(9):

On further consideration, the International Bureau is of the opinion that provisions on intervening rights contained in former draft Article 14(9) relate to a matter of substantive patent law and should therefore not be included in the draft Treaty. The effect of the proposed deletion of this paragraph is that the provision for intervening rights would remain a matter of national law. Similar considerations apply to former draft Articles 15(9) and 16(9).]

Article 15

Restoration of Rights
Re-instatement of Application or Patent
After a Finding of Due Care by the Office

[Commentary on suggested changes to draft Article 15, title:

In order to highlight the distinction between draft Articles 14 and 15, a reference to a finding of due care by the Office has been included in the title of draft Article 15.]

(1) [*Request for Restoration of Rights*] ~~Where the failure to comply with a time limit for an action in a procedure before the Office has the direct consequence of causing an application to be refused or considered withdrawn or abandoned, or causing a patent to be revoked, invalidated or considered lapsed or terminated~~ an applicant or owner has failed to comply with a time limit for an action in a procedure before the Office, the Office shall ~~restore~~ re-instate the rights of the applicant or owner, ~~upon~~ if:

(i) a request to that effect is made in a communication to the Office signed by the applicant or owner, ~~if~~;

(ii) ~~the request is made, and~~ all of the requirements in respect of which the said time limit for the said ~~an~~ action applied ~~in a procedure before the Office~~ are complied with, within the time limit prescribed in the Regulations;

(iii) the failure to comply with the time limit for the said action applied has the direct consequence of causing a loss of rights with respect to the application or patent;

(iv) the request states the grounds on which it is based; and

[Article 15(1), continued]

(~~iii~~v) the Office finds that the failure to comply with the time limit occurred in spite of all due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

[Commentary on suggested changes to draft Article 15(1):

For the reasons given in the Commentary on suggested changes to draft Article 14(1), it is proposed to use the term “re-instate.” This paragraph is re-drafted so that the structure of the sentence would be similar to that of draft Article 14(1).]

(2) [~~Exclusions~~Exceptions] No Contracting Party shall be required to provide for the re-instatement ~~restoration~~ of rights under paragraph (1) ~~in the case of failure to comply with a time limit for~~ with respect to the exceptions prescribed in the Regulations:

(i) ~~an action before a board of appeal or other review body constituted in the framework of the Office;~~

(ii) ~~the payment of maintenance fees, where such fees are not paid within the period of grace referred to in Article 5bis(1) of the Paris Convention;~~

(iii) ~~making a request under paragraph (1) or Article 13(1) or 14(1)(a);~~

(iv) ~~filing a request for search or examination;~~

(v) ~~filing a translation of a regional patent.~~

[Article 15(2), continued]

[Commentary on suggested changes to draft Article 15(2):

As in the case of the proposed amendment of draft Article 14(2), it is proposed that the exceptions under draft Article 15(2) be transferred to the Regulations (new draft Rule 15(1*bis*)).]

...

(9)—~~[*Intervening Rights*]~~ [Text Deleted]

[Commentary on former draft Article 15(9):

Reference is made to the Commentary, above, on former draft Article 14(9).]

Article 16

Addition and Restoration of Priority Claim

...

~~{(9) [*Intervening Rights*] [Text Deleted]}~~

[Commentary on suggested changes to draft Article 16(9):

Reference is made to the Commentary, above, on former draft Article 14(9).]

DRAFT REGULATIONS

Rule 2

Details Concerning Filing Date Under Article 4

...

(1bis) [Time Limit Under Article 4(5)(b)] (a) The time limit referred to in Article 4(5)(b) shall be not less than two months from the date on which one or more elements referred to in Article 4(1)(a) were first received by the Office.

[Commentary on suggested changes to draft Rule 2(1bis)(a):

This subparagraph is modeled after PCT Rule 20.2(a)(iii). The period of “two months” is proposed in conformity with draft Rule 2(1).]

(b) The date on which the applicant receives the notification provided for in Article 4(5)(a) shall have no effect on the time limit fixed under subparagraph (a).

[Commentary on suggested changes to draft Rule 2(1bis)(b):

This subparagraph is modeled after PCT Rule 26.6(b).]

(2) [Requirements Under Article 4(65)(d)] (a) Any Contracting Party may require that, for the contents of an earlier application to be considered under Article 4(65)(d):

(i) to (v) [Unchanged]

[Rule 2(2)(a), continued]

[Commentary on suggested changes to draft Rule 2(2)(a):

The proposed amendment is in consequence of the proposed amendment to former draft Article 4(6).]

(b) No Contracting Party shall require the furnishing of a copy or a certified copy of the earlier application, or a certification of the filing date, as referred to in subparagraph (a), where the earlier application was filed with its Office, or is available to that Office in a legally accepted electronic format, from a digital library which is accepted by the Office, ~~in an official form, to that Office by electronic means.~~

[Commentary on suggested changes to draft Rule 2(2)(b):

In response to the concerns raised at the first session, first part, of the SCP, the phrase “in official form ... by electronic means” has been replaced by a reference to “a legally accepted electronic format, from a digital library accepted by the Office.”]

(3) [*Requirements Under Article 4(7)(a)*] (a) The reference to the previously filed application under Article 4(7)(a) shall indicate the number of that application and the Office with which the previously filed that application was filed, ~~the filing date, the number, the name of the applicant[, the title] and the language of the previously filed application.~~ A Contracting Party may require that the reference also indicate the filing date of the previously filed application.

[Commentary on suggested changes to draft Rule 2(3)(a):

The proposed amendment is based on the proposal by the International Bureau at the first session, first part, of the SCP.]

[Rule 2(3), continued]

...

(e) No Contracting Party shall require the furnishing of a copy or a certified copy referred to in subparagraph (d), where the previously filed application was filed with its Office or is available to that Office in a legally accepted electronic format, from a digital library which is accepted by the Office, ~~in an official form, to that Office by electronic means.~~

[Commentary on suggested changes to draft Rule 2(3)(e):

Reference is made to the commentary on suggested changes to draft Rule 2(2)(b).]

Rule 9

Details Concerning Request for Recordal of Change in Name or Address Under Article 9

(1) [*Request*] A Contracting Party may require that the request for recordal of a change in name or address indicate:

(i) the number of the application or patent concerned;

(ii) the change to be recorded;

(iii)(+) the name and address of the applicant or the owner prior to the change;

~~(ii) where the applicant or the owner has a representative, the name and address of that representative;~~

~~(iii) where the applicant or the owner has an address for service, such address.~~

[Commentary on suggested changes to draft Rule 9(1):

Items (i) and (ii) are transferred from Article 9(1).

It is proposed that former items (ii) and (iii) be deleted, and that draft Article 7(8) allow a Contracting Party to require that indications concerning the name and address of the representative be included in a communication made to the Office by a representative, if no power of attorney has been furnished or if those indications have not been indicated in a power of attorney. Former item (i), which is re-numbered as item (iii), is retained since it may be required by the Office as a check that the change is requested in respect of an application or patent in the name of the person whose name and address is indicated.]

...

Rule 10

Details Concerning Request for Recordal of Change in Applicant or Owner Under Article 10

(1) [*Request*] A Contracting Party may require that the request for recordal of a change in applicant or owner indicate:

(i) the number of the application or patent concerned;

(ii) the name and address of the applicant or owner;

(iii) the name and address of the new applicant or new owner;

(iv) the date of the change in the person of the applicant or owner;

(v) the name of a State of which the new applicant or new owner is a national if he is the national of any State, the name of a State in which the new applicant or new owner has his domicile, if any, and the name of a State in which the new applicant or new owner has a real and effective industrial or commercial establishment, if any;

~~(v) where the applicant or owner has a representative, the name and address of that representative;~~

[Rule 10(1), continued]

~~(vi) where the applicant or owner has an address for service, such address;~~

~~(vii) where the new applicant or new owner has a representative, the name and address of that representative;~~

~~(viii) where the new applicant or new owner has an address for service, that address;~~

~~(ixvi)~~ the basis for the change requested.

[Commentary on suggested changes to draft Rule 10(1):

Reference is made to the Commentary on suggested changes to draft Rule 9(1).]

...

Rule 11
Details Concerning Request for Recorded of a Licensing Agreement
or Security Interest Under Article 11

(1) [*Request*] A Contracting Party may require that the request for recordal of a licensing agreement indicate:

- (i) the number of the application or patent concerned;
- (ii) the name and address of the licensor;
- (iii) the name and address of the licensee;
- ~~(iii) where the licensor has a representative, the name and address of that representative;~~
- ~~(iv) where the licensor has an address for service, such address;~~
- ~~(v) where the licensee has a representative, the name and address of that representative;~~
- ~~(vi) where the licensee has an address for service, such address.~~

[Rule 11(1), continued]

[Commentary on suggested changes to draft Rule 11(1):

Reference is made to the Commentary on suggested changes to draft Rule 9(1).]

...

Rule 12

Details Concerning Request for Correction of a Mistake Under Article 12

(1) [*Request*] A Contracting Party may require that the request for correction of a mistake indicate:

(i) the number of the application or patent concerned;

(ii) the mistake to be corrected;

(iii) the correction to be made;

(iv)(i) the name and address of the requesting party;

~~(ii) where the requesting party has a representative, the name and address of that representative;~~

~~(iii) where the requesting party has an address for service, such address.~~

[Commentary on suggested changes to draft Rule 12(1):

Reference is made to the Commentary on suggested changes to draft Rule 9(1).]

...

Rule 13

Details Concerning Extension of a Time Limit Fixed by the Office Under Article 13

...

(1bis) [Exceptions Under Article 13(2)] (a) No Contracting Party shall be required under Article 13(1) to grant:

(i) a second, or any subsequent, extension of a time limit in respect of which an extension has already been granted under that ~~paragraph~~ Article;

(ii) an extension of a time limit for filing a request for an extension of a time limit;

(iii) an extension of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;

(iv) an extension of a time limit for an action in proceedings in respect of an opposition to the grant of a patent;

(v) an extension of a time limit for an action in interference proceedings;

[(vi) an extension of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted.]

[Commentary on suggested changes to draft Rule 13(1*bis*)(a):

Items (i) and (ii) correspond to items (i) and (ii) of draft Article 13(2)(b) as proposed in document SCP/1/3. In response to a proposal by the Delegation of the United States of America that further exceptions be provided in respect of the extension of a time limit as of right in the case of expedited or specialized procedures, appeals, interferences and oppositions, the following new items have been added.

Item (iii): this provides for an exception in the case of appeals and other reviews before the Office, using the same language as that in former Article 15(2)(i);

Item (iv): this provides for an exception in the case of opposition proceedings;

Item (v): this provides an exception which would apply to interferences under the law of the United States of America, in particular 35 U.S.C.A. §135, where an application is made for a patent which would interfere with any pending application or with any unexpired patent.

Item (vi): this provides for an exception where a request for expedited processing has been granted. This item is placed in square brackets since it is not clear whether it is needed since, as in the case of practice before the European Patent Office, the Office could simply withdraw expedited processing if a request for extension of time is made.]

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under ~~paragraph (1)~~ Article 13(1) to extend a time limit for an action in a procedure before the Office in respect of any of those requirements beyond that maximum time limit.

[Commentary on suggested changes to draft Rule 13(1*bis*)(b):

This provision corresponds to draft Article 13(2)(a) as proposed in document SCP/1/3.]

...

Rule 14

Details Concerning ~~Further Processing or Revival of Application~~ Continued Processing and/or Re-instatement of Application [or Patent] Without a Finding of Due Care by the Office Under Article 14

(1) [*Time Limit Under Article 14(1)(a)*] The time limit for making a request, and for complying with the requirements, under Article 14(1)(a), shall be not less than two months from the date on which the applicant [or owner] was notified by the Office ~~that the application had been, or was to be, refused or considered withdrawn or abandoned following~~ of failure to comply with the time limit concerned.

[Commentary on suggested changes to draft Rule 14(1):

It is proposed that the time limit for making the request, and for complying with the requirements, under draft Article 14(1) should be maintained as proposed in former draft Rule 14(1). However, for the reasons explained in the Commentary on suggested changes to draft Article 14(1), inclusion of new draft Rule 14(1*bis*) is proposed.]

(1*bis*) [*Statement*] Any Contracting Party may require that a request ~~for revival~~ under subparagraph (a) Article 14(1) which is filed later than two months from the date of the expiration of the time limit for the action referred to in that paragraph be accompanied by a statement that the failure to comply with the time limit was unintentional.

[Commentary on suggested changes to draft Rule 14(1*bis*):

This provision corresponds to former draft Article 14(1)(b) in document SCP/1/3. Reference is made to the Commentary on suggested changes to draft Article 14(1).]

(1ter) [Exceptions Under Article 14(2)] (a) No Contracting Party shall be required to re-instate a procedure under Article 14(1) where the applicant or owner fails to comply with a time limit for:

(i) an action before a board of appeal or other review body constituted in the framework of the Office;

(ii) the payment of maintenance fees;

(iii) making a request under Article 13(1), 14(1) or 15(1);

(iv) filing a request for search or examination;

(v) filing a translation of a regional patent[;

(vi) an extension of a time limit for an action in proceedings in respect of an opposition to the grant of a patent;

(vii) an extension of a time limit for an action in interference proceedings;

(viii) an extension of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted].

[Rule 14(1ter)(a), continued]

[Commentary on suggested changes to draft Rule 14(1ter)(a):

This provision, which replaces the general provision for excluding certain time limits in former draft Article 14(2)(b), is modeled after the exceptions listed in former draft Article 15(2) in document SCP/1/3. With respect to item (ii), it is proposed to

protect all rights of applicants under the Paris Convention, including the grace period referred to in Article 5bis(1) of that Convention, under the Final Clauses, as suggested at the first session, first part, of the SCP.]

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under Article 14(1) to grant further processing or revival under paragraph (1)(a) re-instate the application after the expiration of that maximum time limit.

[Commentary on the draft Rule 14(1ter)(b):

This provision corresponds to former draft Article 14(2)(a) in document SCP/1/3.]

(2) [*Requests Filed on Paper or in Electronic Form or by Other Means*] Rule 3(1) to (4) shall apply, *mutatis mutandis*, where the request concerns the re-instatement of an application [or patent] without a finding of due care by the Office ~~further processing or revival of an application.~~

[Commentary on suggested changes to draft Rule 14(2):

The proposed amendment is in consequence of the proposed changes to draft Article 14(1).]

Rule 15

*Details Concerning ~~Restoration of Rights~~ Re-instatement of Application or Patent
After a Finding of Due Care by the Office Under Article 15*

(1) [*Time Limit Under Article 15(1)(i)*] The time limits for making a request, and for complying with the requirements, under Article 15(1)(i), shall be the shorter of the following:

(i) not less than two months from the date of the removal of the cause of the ~~on~~ ~~which the requesting party was notified by the Office that the application had been refused or considered withdrawn or abandoned, or that the patent had been revoked, invalidated or considered lapsed or terminated, following~~ failure to comply with the time limit concerned;

(ii) not less than [six] [12] months from the date of expiration of the time limit for the action in question.

[Commentary on suggested changes to draft Rule 15(1):

In response to the comment made at the first session, first part, of the SCP, it is proposed that the time limit for making a request under draft Article 15(1) should be calculated from the date of the removal of the cause of the failure to comply with the time limit concerned, as under the current Swiss Patent Law and the European Patent Convention, rather than from the date on which the requesting party is notified.]

(1bis) [Exceptions Under Article 15(2)] Rule 14(1ter)(b) shall apply, *mutatis mutandis*, to requests for the restoration of rights.

[Commentary on suggested changes to draft Rule 15(1bis):

In the absence of any agreement on proposed changes to the exceptions listed in former draft Article 15(2) in document SCP/1/3, this list is retained by reference, *mutatis mutandis*, to new draft Rule 14(1ter)(b).]

[Rule 15, continued]

(2) [*Requests Filed on Paper or in Electronic Form or by Other Means*] Rule 3(1) to (4) shall apply, *mutatis mutandis*, ~~to requests for the restoration of rights~~ where the request concerns the re-instatement of an application or patent after a finding of due care by the Office.

[Commentary on suggested changes to draft Rule 15(2):

The proposed amendment is in consequence of the proposed changes to draft Article 15(1).]

[Annex follows]

PROVISIONS DISCUSSED BY THE STANDING COMMITTEE
AT ITS FIRST SESSION, FIRST PART*

DRAFT TREATY

Article 1

Abbreviated Expressions

For the purposes of this Treaty, unless expressly stated otherwise:

(i) “Office” means the authority of a Contracting Party entrusted with the granting of patents or with other matters covered by this Treaty;

(ii) “application” means an application for the grant of a patent, as referred to in Article 2;

(iii) “patent” means a patent as referred to in Article 2;

(iv) references to a “person” shall be construed as references to both a natural person and a legal entity;

(v) “communication” means any application, or any request, declaration or information relating to an application or patent, whether relating to a procedure under this Treaty or not, which is submitted or transmitted to the Office by means permitted by the Office;

(vi) “records of the Office” means the collection of information maintained by the Office, relating to and including the applications filed with, and the patents granted by, that Office or another authority with effect for the Contracting Party concerned, irrespective of the medium in which such information is maintained;

(vii) “recordal” means recordal in the records of the Office;

(viii) “applicant” means the person whom the records of the Office show as the person who is applying for the patent, or another person who, pursuant to the applicable law, is submitting or prosecuting the application;

(ix) “owner” means the person whom the records of the Office show as the owner of the patent;

(x) “representative” means any person, firm or partnership that can be a representative under the applicable law;

* Text within frames has been adopted by the SCP. Text outside of frames incorporates the changes suggested in this document.

[Article 1, continued]

(xi) [Deleted]

(xii) “a language accepted by the Office” means any one language accepted by the Office for the relevant procedure before the Office;

(xiii) “translation” means a translation into a language accepted by the Office;

(xiv) “procedure before the Office” means any procedure in proceedings before the Office with respect to an application or patent;

(xv) except where the context indicates otherwise, words in the singular include the plural, and *vice versa*, and masculine personal pronouns include the feminine;

(xvi) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised and amended;

(xvii) “Patent Cooperation Treaty” means the Patent Cooperation Treaty (“PCT”) signed on June 19, 1970, as amended and modified;

(xviii) “Contracting Party” means [reserved; definitions of other terms used in the administrative and final provisions of the Treaty are also reserved].

Article Ibis

Notification by the Office

(1) [*If Indications Allowing Contact Were Not Submitted*] Nothing in this Treaty and the Regulations shall oblige a Contracting Party to send a notification to an applicant, owner or other interested person, if indications allowing that applicant, owner or other interested person to be contacted have not been submitted to the Office.

(2) [*Failure to Notify*] Where this Treaty or the Regulations requires a Contracting Party to notify an applicant, owner or other interested person of failure to comply with requirements, failure to notify the applicant, owner or other interested person does not relieve that applicant, owner or other interested person of the obligation to subsequently comply with those requirements.

(3) [*Address for Communication*] A Contracting Party may require that an applicant, owner or other interested person indicate the address the Office should use for the purposes of correspondence.

Article 2

Applications and Patents to Which the Treaty Applies

(1) [*Applications*] (a) The provisions of this Treaty and the Regulations shall apply to national and regional applications for patents for invention which are filed with or for the Office of a Contracting Party, and which are types of applications that can be filed as international applications under the Patent Cooperation Treaty.

(b) Subject to the provisions of the Patent Cooperation Treaty, the provisions of this Treaty and the Regulations shall apply to international applications for patents for invention under the Patent Cooperation Treaty:

(i) in respect of the time limits applicable in the Office of any Contracting Party under Articles 22 and 39(1) of the Patent Cooperation Treaty;

(ii) from the date on which the requirements of Article 22 or 39(1) of that Treaty have been complied with.

(2) [*Patents*] The provisions of this Treaty and the Regulations shall apply to patents for invention which have been granted with effect for a Contracting Party.

Article 3

National Security

Nothing in this Treaty and the Regulations shall limit the freedom of any Contracting Party to take any action deemed necessary for the preservation of its national security.

Article 4

Filing Date

(1) [*Elements of Application*] (a) Subject to paragraphs (2) to (5), a Contracting Party shall provide that the filing date of an application shall be the date on which its Office has received all of the following elements, filed by means permitted by the Office:

(i) an express or implicit indication to the effect that the elements are intended to be an application;

(ii) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office;

(iii) a part which on the face of it appears to be a description.

[Article 4(1), continued]

(b) A Contracting Party may, for the purposes of the filing date, accept a drawing as the element referred to in subparagraph (a)(iii).

(2) [*Language*] (a) The indications referred to in paragraph (1)(a)(i) and (ii) may be required to be in a language accepted by the Office.

(b) The part referred to in paragraph (1)(a)(iii) may, for the purposes of the filing date, be in any language.

(3) [*Notification*] Where the application does not comply with one or more of the requirements of paragraphs (1) and (2), the Office shall promptly notify the applicant of any requirement not complied with.

(4) [*Subsequent Compliance with Requirements*] (a) Where one or more of the requirements referred to in paragraphs (1) and (2) are not complied with in the application as initially filed, the filing date shall, subject to subparagraph (b) and paragraphs (5) and (6), be the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with.

(b) A Contracting Party may provide that, where one or more of the requirements referred to in subparagraph (a) are not complied with within the time limit prescribed in the Regulations, the application shall be regarded as not having been filed.

(5) [*Missing Description or Drawing*] (a) Where, for the purposes of establishing the filing date, the Office determines that a part of the description is missing from the application or that the application refers to a drawings which, in fact, is missing from the application, the Office shall, promptly after the determination has been made, notify the applicant accordingly.

(b) Subject to subparagraphs (c) to (e), where a missing part of the description or a missing drawing is furnished to the Office within the time limit prescribed in the Regulations, that part of the description or drawing shall be included in the application, and the filing date shall be the date on which the Office has received that part of the description or drawing, or the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with, whichever is later. Otherwise, any reference to the said drawings shall be considered non-existent.

(c) Notwithstanding subparagraph (b) and subject to subparagraph (d), a Contracting Party [may][shall] provide that, where the Office determines, within a time limit prescribed by the Contracting Party, if any, that all missing parts of the description and all missing drawings furnished under subparagraph (b) do not contain new matter, the filing date shall be the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with.

[Article 4(5), continued]

(d) Where ~~a~~the missing part of the description or missing drawing is furnished under subparagraph (b) to rectify its unintentional omission from an application which claims the priority of an earlier application, the Office shall, upon the request of the applicant and subject to the requirements prescribed in the Regulations, consider the contents of that earlier application as having been contained in the application claiming priority in determining, for the purposes of subparagraph (c), whether that part of the description or that drawing contains new matter.

(e) Where all or part of the missing part of the description and missing drawings furnished under subparagraph (b) are withdrawn within a time limit fixed by the Contracting Party, and any remaining part of the missing description and missing drawings furnished under subparagraph (b) in respect of which the determination referred to in subparagraph (c) has been made does not contain new matter, the filing date shall be the date on which the requirements referred to in paragraphs (1) and (2) are complied with.

(6) [*Consideration of Contents of Earlier's Application*] [Moved to Article 4(5)(d)]

(7) [*Replacing Description and Drawings by Reference to a Previously Filed Application*] (a) Subject to the requirements prescribed in the Regulations, a reference, in a language accepted by the Office, to a previously filed application shall, for the purposes of the filing date of the application, replace the description and any drawings.

(b) Where the requirements referred to in subparagraph (a) are not complied with, the application may be considered as not having been filed.

(8) [[*Divisional Applications;*] *Continuation and Continuation-in-Part Applications*] Nothing in this Article shall limit:

(i) the right of an applicant under Article 4G(1) or (2) of the Paris Convention to preserve, as the date of a divisional application referred to in that Article, the date of the initial application referred to in that Article and the benefit of the right of priority, if any;]

(ii) the freedom of any Contracting Party to apply any requirements necessary to accord the benefit of the filing date of an application for a continuation or a continuation-in-part of an earlier application.

Article 5

Application

(1) [*Form or Contents of Application*] No Contracting Party shall, except where otherwise provided for by this Treaty, 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 Patent Cooperation Treaty, it being understood that a Contracting Party shall be free to provide for requirements which, from the viewpoint of applicants, are more favorable than the requirements applicable under the Patent Cooperation Treaty.

(2) [*Request Form*] (a) A Contracting Party may require that the contents of an application which correspond to the mandatory contents of the request of an international application under the Patent Cooperation Treaty be presented on a request Form or in a format prescribed by that Contracting Party.

(b) Notwithstanding subparagraph (a), a Contracting Party shall accept the presentation of the contents referred to in that subparagraph on a request Form, filed on paper, if that request Form corresponds to the request Form provided for in the Regulations.

(3) [*Applications Filed on Paper or in Electronic Form or by Other Means*] The Regulations shall set out the requirements which a Contracting Party shall be permitted to apply as regards the filing of applications on paper or in electronic form or by other means.

However:

(i) no Contracting Party shall be obliged to accept the electronic filing of applications with its Office;

(ii) no Contracting Party shall be obliged to exclude the filing of applications on paper with its Office;

(iii) the adoption of any provision in the Regulations allowing a Contracting Party which accepts the electronic filing of applications with its Office to exclude the filing of applications on paper shall require unanimous consent. Paragraph (2)(b) shall no longer be applicable to a Contracting Party which excludes the filing of applications on paper.

[Paragraphs (4) to (10): Discussion deferred.]

Article 13

Extension of a Time Limit Fixed by the Office

(1) [*Request*] Where an applicant or owner requests an extension of a time limit fixed by the Office for an action in a procedure before the Office, in a communication received by the Office prior to the expiration of that time limit, such time limit shall be extended, subject to paragraph (2), by a period prescribed in the Regulations.

(2) [*Exceptions*] No Contracting Party shall be required to grant an extension under paragraph (1) with respect to the time limits prescribed in the Regulations

[Paragraphs (3) and (4): Discussion deferred.]

(5) [*Fees*] Article 5(6) shall apply, *mutatis mutandis*, to requests under paragraph (1).

(6) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraph (1) may not be refused, totally or in part, without the requesting party being given at least one opportunity to make observations on the intended refusal within a reasonable time limit.

Article 14

*Continued Processing and/or Re-instatement of Application [or Patent]
Without a Finding of Due Care by the Office*

(1) [*Request*] Where an applicant [or owner] has failed to comply with a time limit fixed by the Office for an action in a procedure before the Office, the Office shall consider that time limit to have been complied with, and if necessary, re-instate the application [or patent] concerned, if:

(i) a request to that effect is made in a communication to the Office signed by that applicant [or owner]; and

(ii) all of the requirements in respect of which the time limit for the said action applied are complied with, within the time limit prescribed in the Regulations.

(2) [*Exceptions*] No Contracting Party shall be required to provide for the re-instatement of an application [or patent] under paragraph (1) with respect to the exceptions prescribed in the Regulations.

[Paragraphs (3) to (8): Discussions deferred.]

(9) [*Intervening Rights*] [Deleted]

Article 15

Re-instatement of Application or Patent After a Finding of Due Care by the Office

(1) [*Request*] Where an applicant or owner has failed to comply with a time limit for an action in a procedure before the Office, the Office shall re-instate the rights of the applicant or owner, if:

(i) a request to that effect is made in a communication to the Office signed by the applicant or owner;

(ii) all of the requirements in respect of which the time limit for the said action applied are complied with, within the time limit prescribed in the Regulations;

(iii) the failure to comply with the time limit for the said action applied has the direct consequence of causing a loss of rights with respect to the application or patent;

(iv) the request states the grounds on which it is based; and

(v) the Office finds that the failure to comply with the time limit occurred in spite of all due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(2) [*Exceptions*] No Contracting Party shall be required to provide for the re-instatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

[Paragraphs (3) to (8): Discussions deferred.]

(9) [*Intervening Rights*] [Deleted]

Article 16

Addition and Restoration of Priority Claim

(1) [*Addition of Priority Claim*] The Office shall, upon a request made in a communication to the Office signed by the applicant, add a priority claim to an application (“the subsequent application”) if:

(i) the request is made within the time limit prescribed in the Regulations;
and

(ii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earlier application whose priority is claimed.

(2) [*Delayed Filing of the Subsequent Application*] Where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, upon a request made in a communication to the Office signed by the applicant, if:

(i) the request is made before the expiration of the said time limit and before any technical preparations for publication of the subsequent application have been completed;

(ii) the request states the ground on which it is based;

(iii) the Office finds that the failure to furnish the subsequent 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; and

(iv) where the application did not claim the priority of the earlier application, the request is accompanied by the priority claim.

(3) [*Failure to Furnish a Copy of Earlier Application*] (a) Where a copy of an earlier application required under Article 5(7)(a) is not furnished to the Office within the time limit referred to in that Article, the Office shall restore the right of priority, upon a request made, in a communication to the Office signed by the applicant, within that time limit, if:

(i) the request for restoration indicates the Office to which the request for a copy of an earlier application had been made and the date of that request; and

(ii) the Office finds that the request for the copy to be provided had been made, to the Office with which the earlier application was filed, within the time limit prescribed in the Regulations.

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the request referred to in subparagraph (a) be furnished to the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in subparagraph (a) be furnished to the Office within the time prescribed in the Regulations.

[Paragraphs (4) to (8): Discussion deferred.]

(9) [*Intervening Rights*] [Deleted]

DRAFT REGULATIONS

Rule 1

Abbreviated Expressions

(1) [*“Treaty”; “Article”*] (a) In these Regulations, the word “Treaty” means the Patent Law Treaty.

(b) In these Regulations, the word “Article” refers to the specified Article of the Treaty.

(2) [*Abbreviated Expressions Defined in the Treaty*] The abbreviated expressions defined in Article 1 for the purposes of the Treaty shall have the same meaning for the purposes of the Regulations.

Rule 2

Details Concerning Filing Date Under Article 4

(1) [*Time Limit Under Article 4(4)(b)*] The time limit referred to in Article 4(4)(b) shall be:

(i) where a notification has been made under Article 4(3), not less than two months from the date of the notification;

(ii) where a notification has not been made because indications allowing the applicant to be contacted by the Office have not been furnished, not less than two months from the date on which one or more elements referred to in Article 4(1)(a) were first received by the Office.

(*Ibis*) [*Time Limit Under Article 4(5)(b)*] (a) The time limit referred to in Article 4(5)(b) shall be not less than two months from the date on which one or more elements referred to in Article 4(1)(a) were first received by the Office.

(b) The date on which the applicant receives the notification provided for in Article 4(5)(a) shall have no effect on the time limit fixed under subparagraph (a).

(2) [*Requirements Under Article 4(5)(d)*] (a) Any Contracting Party may require that, for the contents of an earlier application to be considered under Article 4(5)(d):

(i) to (v) [Unchanged]

(b) No Contracting Party shall require the furnishing of a copy or a certified copy of the earlier application, or a certification of the filing date, as referred to in subparagraph (a), where the earlier application was filed with its Office or is available to that Office in a legally accepted electronic format, from a digital library which is accepted by the Office.

(3) [*Requirements Under Article 4(7)(a)*] (a) The reference to the previously filed application under Article 4(7)(a) shall indicate the number of that application and the Office with which that application was filed. A Contracting Party may require that the reference also indicate the filing date of the previously filed application.

[Subparagraphs (b) and (c): Deleted]

(d) Any Contracting Party may, subject to subparagraph (e), require that:

(i) a copy of the previously filed application and, where the earlier application is not in a language accepted by the Office, a translation of that previously filed application, be furnished to the Office within a time limit which shall be not less than two months from the date on which the application containing the reference referred to in Article 4(7)(a) was received by the Office;

(ii) a certified copy of the previously filed application be furnished to the Office either, where the priority of the previously filed application is claimed, in accordance with Article 5(7)(b) or, where the priority of the previously filed application is not claimed, within a time limit which shall be not less than four months from the date of the receipt of the application containing the reference referred to in Article 4(7)(a).

(e) No Contracting Party shall require the furnishing of a copy or a certified copy referred to in subparagraph (d), where the previously filed application was filed with its Office or is available to that Office in a legally accepted electronic format, from a digital library which is accepted by the Office.

Rule 13

Details Concerning Extension of a Time Limit Fixed by the Office Under Article 13

(1) [*Period Under Article 13(1)*] (a) The period referred to in Article 13(1) shall be not less than two months.

(b) Where a time limit is extended under Article 13(1), the extended time limit shall be calculated from the same date as the date from which the time limit fixed by the Office referred to in that Article was calculated.

[Rule 13, continued]

(1bis) [*Exceptions under Article 13(2)*] (a) No Contracting Party shall be required under Article 13(1) to grant:

- (i) a second, or any subsequent, extension of a time limit in respect of which an extension has already been granted under that Article;
- (ii) an extension of a time limit for filing a request for an extension of a time limit;
- (iii) an extension of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;
- (iv) an extension of a time limit for an action in proceedings in respect of an opposition to the grant of a patent;
- (v) an extension of a time limit for an action in interference proceedings;
- [(vi) an extension of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted.]

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under Article 13(1) to extend a time limit for an action in a procedure before the Office in respect of any of those requirements beyond that maximum time limit.

[Paragraph (2): Discussions deferred.]

Rule 14

Details Concerning Continued processing and/or Re-instatement of Application [or Patent] Without a Finding of Due Care by the Office Under Article 14

(1) [*Time Limit Under Article 14(1)*] The time limit for making a request, and for complying with the requirements, under Article 14(1), shall be not less than two months from the date on which the applicant [or owner] was notified by the Office of failure to comply with the time limit concerned.

(1bis) [*Statement*] Any Contracting Party may require that a request under Article 14(1) which is filed later than two months from the date of the expiration of the time limit for the action referred to in that paragraph be accompanied by a statement that the failure to comply with the time limit was unintentional.

(1ter) [*Exceptions Under Article 14(2)*] (a) No Contracting Party shall be required to re-instate a procedure under Article 14(1) where the applicant or owner fails to comply with a time limit for:

[Rule 14(1bis), continued]

- (i) an action before a board of appeal or other review body constituted in the framework of the Office;
- (ii) the payment of maintenance fees;
- (iii) making a request under Article 13(1), 14(1) or 15(1);
- (iv) filing a request for search or examination;
- (v) filing a translation of a regional patent[;
- (iv) an extension of a time limit for an action in proceedings in respect of an opposition to the grant of a patent;
- (v) an extension of a time limit for an action in interference proceedings;
- (vi) an extension of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted].

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under Article 14(1) to re-instate the application after the expiration of that maximum time limit.

(2) [*Requests Filed on Paper or in Electronic Form or by Other Means*] Rule 3(1) to (4) shall apply, *mutatis mutandis*, where the request concerns the re-instatement of an application [or patent] without a finding of due care by the Office.

Rule 15

Details Concerning Re-instatement of Application or Patent After a Finding of Due Care by the Office Under Article 15

(1) [*Time Limit Under Article 15(1)(i)*] The time limits for making a request, and for complying with the requirements, under Article 15(1)(i), shall be the shorter of the following:

- (i) not less than two months from the date of the removal of the cause of the failure to comply with the time limit concerned;
- (ii) not less than [six] [12] months from the date of expiration of the time limit for the action in question.

(1bis) [*Exceptions Under Article 15(2)*] Rule 14(1ter)(b) shall apply, *mutatis mutandis*, to requests for the restoration of rights.

[Rule 15, continued]

(2) [*Requests Filed on Paper or in Electronic Form or by Other Means*] Rule 3(1) to (4) shall apply, *mutatis mutandis*, where the request concerns the re-instatement of an application or patent after a finding of due care by the Office.

Rule 16

*Details Concerning Addition and
Restoration of Priority Claim Under Article 16*

(1) [*Time Limit Under Article 16(1)*] The time limit referred to in Article 16(1) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(1bis)* [*Time Limit under Article 16(2)*] The time limit referred to in Article 16(2) shall be not less than two months from the date on which the priority period expired.

(2)* [*Time Limit Under Article 16(3)(a)(ii)*] The time limit referred to in Article 16(3)(a)(ii) shall be two months before the expiration of the time limit prescribed in Rule 5(1).

(2bis)* [*Time Limit under Article 16(3)(b)(ii)*] The time limit referred to in Article 16(3)(b)(ii) shall be not less than one month from the date on which the applicant is provided with the copy referred to in that provision by the Office with which the earlier application was filed.

[Paragraph (3): Discussion deferred.]

[End of Annex and of document]

* To be renumbered.