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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/2/3.
2. Text in italics is not intended to remain in the notes that will be presented to the Diplomatic Conference.

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I. NOTES ON THE DRAFT TREATY

Note on Article 1
(Abbreviated Expressions)

1.01 Item (i). The term “Office” includes both the national Office of any State which is a Contracting Party to the Treaty and also the Offices of any regional organization which is a Contracting Party. For example, the Treaty will apply to the European Patent Office if, and only if, the European Patent Organisation is a Contracting Party. The reference to “other matters covered by this Treaty” would cover the situation in which the Office of a Contracting Party administers procedures in respect of patents, for example, the recordal of change of owner, although such patents are granted on its behalf by another Office, for example, a Regional Office.

1.02 Items (ii) and (iii). These items appear self-explanatory.

1.03 Item (iv). The question of what constitutes a legal entity, for example, a German *Offene Handelsgesellschaft*, is not regulated by the Treaty and remains a matter for 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.

1.04 Item (v). The term “communication” is used in the Treaty and Regulations to refer only to matter which is submitted or transmitted to the Office. Accordingly, a notification or other correspondence sent by the Office to an applicant, owner or other interested person does not constitute a “communication” as defined under this item. Provisions relating to communications are contained in Article 7. Where the Treaty refers to a communication being signed, as is the case under various provisions of Articles 6, 11 to 13 and Rules 16 to 19, it is apparent that the term “communication” does not include oral communications, either in person or by telephone. However, in the context of a request for extension of a time limit under Article 10, 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 10.09).

1.05 Item (vi). Information under this item also includes the contents of applications and patents, in particular the description, claims, abstract and drawings, as well as changes or correction referred to in Article 14(1)(b). An example of information maintained by an Office in respect of applications filed with, and patents granted by, another authority with effect for the Contracting Party concerned 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.

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 provide that, for the purposes of the provisions of the Treaty, the terms “applicant” and “owner” refer only to the person who is indicated as such in the records of the Office. Any other person who might have, or purports to have, a legal claim of ownership or other rights is not considered an applicant or owner for the purposes of this Treaty. In the case of a request for recordal of a change in the person of the applicant or owner (see Rule 17), 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 Rule 17(1)). Once recordal of the change has taken place, the transferee becomes the “applicant” or “owner” (since that person is now the person shown in the records of the Office as the applicant or owner).

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 who, pursuant to the applicable law, is 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 who, pursuant to the applicable law, 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 Item (x). The term “representative” refers to any attorney, agent, lawyer or other person, or to any firm or partnership, that can be a representative under the law applicable to the Office. Under Article 6(1)(a), a Contracting Party may require that any representative who is appointed shall have the right to practice before the Office (see Note 6.01).

1.10 Item (xi). A “signature” as defined under this item could be, for example, a form of signature expressly referred to under Rule 9(3) or (5), namely a hand-written, printed or stamped signature, a seal, a bar-coded label, or an electronic signature.

1.11 Item (xii). The expression “a language accepted by the Office” refers to a verbal language and not, for example, to a computer language. What constitutes “a language accepted by the Office” is a matter to be determined by the Contracting Party. The expression “for the relevant procedure before the Office” provides for the situation in which the Office may have different language requirements for different procedures, as will normally be the case in view of the obligation on Contracting Parties under Article 4(2)(b) to accept a description in any language for the purposes of according a filing date. This item is subject to reservations by the Delegations of Finland and Belgium.

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

1.13 Item (xiv). The expression “procedure before the Office” covers any procedure in which an applicant, owner or other interested person communicates with the Office, either to initiate such proceedings or in the course of such proceedings. It covers all procedures before the Office and is therefore not restricted to those procedures which are referred to in express terms under Articles 4 to 14 of the draft Treaty. 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 cover 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.

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

1.15 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.

1.16 Item (xviii). This item and definitions of other terms used in the administrative and final provisions of the Treaty are presented in document SCP/2/5.

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 or for 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. Similarly, the Treaty and Regulations would not apply to applications for “plant patents” which are not patents for inventions, although it would apply to applications for patents in respect of plants which are inventions, for example which are the result of genetic engineering.

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 for invention which, at least at present, cannot be filed as international applications under the PCT include provisional applications, divisional applications, applications for re-issue patents and applications for conversion. 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 *As regards a divisional application, in accordance with the decision reported in document SCP/1/7, paragraph 108, the International Bureau recommends that this provision be modified to include divisional applications.*

2.06 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.

2.07 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).

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

2.09 Item (i). Under this item, the Treaty and Regulations, in particular, Articles 10 to 12 and Rules 12 to 14, 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.

2.10 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.

2.11 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.

2.12 The term “patents for invention” is to be construed in the same sense as the expression in PCT Article 2(ii). Accordingly, the Treaty and Regulations would not apply to patents which are listed in that Article as alternative to “patents for invention,” namely, inventor’s certificates, utility certificates, utility models, patents or certificates of addition, inventor’s certificates of addition, and utility certificates of addition (see also Note 2.02). However, a Contracting Party would be free to apply some or all of the provisions of the Treaty and Regulations, to such other patents, even though it would not be obliged to do so. Also, in accordance with the definition in PCT Article 2(ix), the term “patent” applies to national and regional patents. In addition, 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.

2.13 Although they do not apply to those types of applications which are not applications for patents for inventions that can be filed as international applications under the PCT, such as provisional applications, applications for re-issue patents and applications for conversion (see Note 2.04), the Treaty and Regulations do apply to patents granted in respect of such types of applications. For example, the Treaty and Regulations apply to granted re-issue patents, although they do not apply to applications for such patents.

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 is subject to a reservation by the Delegation of Portugal. In contrast to other provisions of the Treaty, which establish a maximum list of allowed requirements, the items presented in Article 4(1) constitute an absolute, that is both a maximum and minimum, requirement. A Contracting Party would therefore be precluded from according a filing date to an application which did not contain all of the elements prescribed under paragraph (1). It would also be precluded from requiring any additional elements for the accordal of a filing date. Furthermore, a Contracting Party would not be permitted to revoke the filing date accorded to an application which complied with the requirements of Article 4. For example, the filing date should not be revoked for failure to comply with a requirement under Article 5 within the time limit prescribed in Rule 6(2)(b), although it would be permitted to refuse an application on such grounds under Article 5(8)(a) (see also Notes 4.02, 4.08, 4.13, 4.15 and 4.27).

4.02 Paragraph (1). This paragraph prescribes the elements of an application required by the Office for the purpose of according a filing date. First, the Office needs to be satisfied that the elements that it has received on that date are intended to be an application for a patent for an invention. Second, the Office must be provided with indications which identify the applicant, or at least allow the applicant to be contacted. Third, the Office must have received a disclosure of the invention, either in the form of a part which on the face of it appears to be a description or, where permitted by the Contracting Party under subparagraph (b), a drawing in place of that description. Since the list of elements under paragraph (1) is exhaustive, a Contracting Party would not be permitted to require any additional elements, for a filing date to be accorded, in particular, that the application contain one or more claims. 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 6(2)(a), and in accordance with Article 5(7). 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(8)(a). The same considerations apply where an application is not accompanied by a filing fee required under Article 5(4). Paragraph (1)(a) is subject to reservations by the Delegations of Belgium and Portugal.

4.03 Paragraph (1)(a), chapeau. 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 4.19).

4.04 Each Contracting Party would be free to decide for itself what constitutes the date on which its Office has received all of the elements where an application, or element of an application, is received 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. In addition, although not expressly provided for in the Treaty or Regulations, 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 A Contracting Party would always be obliged to accord a filing date to an application filed on paper which complied with the requirements under Article 4, even if that application did not comply with the requirements applied by that Contracting Party in respect of the form, format and means of filing communications under Article 7(1) and the request Form or format of an application under Article 5(2). In accordance with Article 5(1), with reference to PCT Rule 11.9, a Contracting Party could require that an application on paper be typed or printed. However, the filing date of an application which did not comply with that requirement, in particular a handwritten application, could not be revoked on that ground. Where the application as filed does not comply with that requirement or any requirement under Article 7(1) or 5(2) referred to above, the Office could require that a replacement copy of the application complying with that requirement be furnished, within the time limit prescribed in Rule 11(1) or 6(2)(a), in accordance with Articles 7(5) or 5(7), respectively. The failure to furnish such replacement copy within that time limit would not result in the subsequent loss of filing date even if the application were refused under Articles 7(6) and 5(8)(a). Similar considerations apply where an application filed on paper did not comply with the requirements as to the format of the application under Article 7(1) or presentation of the contents of the request on a prescribed request Form or format under Article 5(2).

4.06 The term “by means permitted by the Office” relates, in particular, to the case where the required elements are filed by electronic means permitted by that Contracting Party under Article 7(1).

4.07 Item (i). It follows from the definition of the term “application” in Article 1(ii) and the provisions of Article 2(1)(a), that this item requires an express or an implicit indication to the effect that the elements referred to are intended to be an application for a patent for an invention. Whether, in a particular case, indications which have been given are sufficient to be considered as an implicit indication that the elements in question are intended to be an application for a patent for an invention, will be a matter to be determined by the Office in the circumstances of that case. In permitting “implicit” indications, item (i) is more liberal than the corresponding provision in respect of international applications under PCT Article 11(1)(iii)(a).

4.08 Item (ii). 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 6(2)(a), in accordance with Article 5(7). However, the failure to furnish such indications within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 5(8)(a). As regards the meaning of the term “applicant,” reference is made to Article 1(viii) (see Note 1.07).

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, subject to paragraph (4)(a).

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. The matter of whether, for example, a photograph could be considered a drawing for the purposes of this provision would be a matter for the Contracting Party concerned. 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 It is to be noted that, even in the absence of paragraph (1)(b), a country of the Paris Union would, as at present, be free to accord a filing date to an application in which the invention is disclosed only in a drawing and that such application, as a regular national filing under the domestic legislation of a country of the Paris Union, would give rise to a right of priority under Article 4A(2) of the Paris Convention.

4.12 Paragraph (2)(a). As regards the meaning of the expression “a language accepted by the Office,” reference is made to Article 1(xii) (see Note 1.11).

4.13 Paragraph (2)(b). This provision would permit “a part which on the face of it appears to be the description” to be filed in any language. Where that part is filed in a language which is not a language accepted by the Office, a translation of the description would need to be furnished under Article 5(3), within the time limit prescribed in Rule 6(2)(b), in accordance with Article 5(7) (see also Note 5.10). 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(8)(a).

4.14 The same considerations apply to any textual matter incorporated in a drawing which, under paragraph (1)(b), is accepted as “the part which on the face of it appears to be the description” under paragraph (1)(a)(iii).

4.15 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(3) within

the time limit prescribed in Rule 6(2)(b) in accordance with Article 5(7) (see also Note 5.10). 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(8)(a).

4.16 Paragraph (3). Where the applicant discovers any non-compliance with the requirements of paragraphs (1) and (2) without having received a notification from the Office because indications allowing the applicant to be contacted by the Office have not been furnished, he may, subject to any time limit applied under Rule 2(1), immediately file the elements required for such compliance without waiting to receive such notification. Reference is also made to the provisions under Article 8(1) and (2) (see Notes 8.01 and 8.02).

4.17 *[The requirement that the notification under paragraph (3) shall be made “promptly,” which would require the Office to check the application without undue delay and to issue any required notification as soon as possible after any non-compliance has been discovered, is placed in square brackets for further consideration by the Standing Committee following objections as to the practicality of this raised by three delegations. Following the proposal by the Delegation of the United States of America to the SCP Electronic Forum, the words “as soon as practical” are also presented in square brackets for consideration by the Standing Committee.]*

4.18 Paragraph (4)(a). This provision provides the applicant with 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, without the need to resubmit the application. However, for the proper conduct of business before the Office, a Contracting Party may provide that this option should be subject to the time limit applicable under paragraph (4)(b) (see Note 4.19).

4.19 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. As regards the obligation on the applicant to comply with the requirements under paragraphs (1) and (2), reference is made to the provisions under Article 8(3) (see Note 8.03).

4.20 Paragraph (5)(a). This provision is modeled after PCT Article 14(2). As it is restricted to the situation where part of the description is missing or the application refers to drawings which, in fact, are not included in the application, and the determination is made for the purposes of establishing the filing date, it does not apply where that determination is made in any other procedure, in particular, in the course of substantive examination, when the procedures under subparagraphs (b) to (e) would not be appropriate. The provision does not require the Office to check whether a part of the description or drawing is missing. However, where the Office determines, as the result of such a check or otherwise, that a part of the description or one or more drawings are missing, the Office must notify the applicant, the subsequent procedure being regulated by subparagraphs (b) to (e) (see Notes 4.21 to 4.24). Reference is made to the general provisions concerning notifications under Article 8.

4.21 Paragraph (5)(b). The time limit for furnishing the missing part of the description or missing drawing(s) under this provision is prescribed under Rule 2(2).

4.22 Paragraph (5)(c). This provision does not oblige the Office to determine whether or not new matter is present. Indeed, most non-examining offices would not have the resources to do so, and, in the case of many examining offices, a determination that new matter is present would be made after the filing date has been accorded, for example, during substantive examination. Since this provision is permissive as regards the obligation to make a determination, any Contracting Party which applied it would be permitted to prescribe that such determination should only be made at the express request of the applicant. *[In the absence of any consensus as to whether, where the Office determines that the later filed part of the description or drawing does not contain new matter, the Contracting Party is obliged to accord as the filing date the date on which the requirements referred to in paragraphs (1) and (2) are complied with, the words “may” and “shall” are placed in square brackets as alternatives for further consideration by the Standing Committee.]*

4.23 Paragraph (5)(d). Where the priority of an earlier application is claimed, this provision would require a Contracting Party, for the purposes of subparagraph (c) and 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 part of the description or drawing should be allowed without loss of filing date. This would apply, in particular, to the case of the unintentional omission of a sheet of description or drawings from an application filed on paper or 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(3). The time limit for an applicant to make a request under this subparagraph would be a matter for the national law of the Contracting Party concerned.

4.24 Paragraph (5)(e). This provision would permit the applicant to withdraw the later furnished missing part of the description or drawings in order to avoid the date of receipt of that part of that drawing being accorded as the filing date under subparagraph (c). Where an Office which applies subparagraph (c) determines that only part of the missing description, or some of the missing drawings contain new matter, it would be sufficient for the applicant to withdraw only that part or those drawings. 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 part of the description, or drawings which have been withdrawn.

4.25 Paragraph (6). This provision would permit the applicant to replace the description and any drawings in an application by a reference to any previously filed application. This applies irrespective of whether the previously filed application is in the name of the same applicant or in respect of the same invention as the application containing the reference.

4.26 Subparagraph (a). The requirements under this provision prescribed under Rule 2(4) are that the applicant shall indicate the number of the previously filed application, the Office with which that application was filed and, if required by the Contracting Party, the filing date of that application. This provision is subject to a reservation by the Delegation of Japan.

4.27 Subparagraph (b). Under this provision the filing date would be refused where the application fails to comply with the requirements prescribed under Rule 2(4). For the

application to proceed, the applicant would also need to furnish a description, pursuant to the requirements applied under Article 5(1). However, the failure to furnish that description within the time limit prescribed under Rule 6(2)(b) would not result in the subsequent loss of the filing date, even though the application could be refused under Article 5(8)(a).

4.28 Paragraph (7), item (i). This item reflects the fact that the provisions of Article 4 could interfere with the right of an applicant to refer to a filing date and a priority date of the parent application with respect to divisional applications.

4.29 Item (ii). This item reflects the fact that the provisions of Article 4 could interfere with the right of an applicant to refer to a filing date of the earlier application in the case of continuation or continuation-in-part applications.

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 paragraphs (2) to (6) and Articles 6 and 7, 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, indications that an invention was produced under a United States of America government contract, indications as to whether an application was prepared with the assistance of an invention marketing company, and if so, indications of the name and address of that company, 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 The Delegation of the United States has reserved its position as regards the applicability of the requirements of PCT Rule 13 (Unity of Invention) under this paragraph, on the grounds that unity of invention is a matter of substantive law, not a formalities matter. Provision for such a reservation is included in Article 26(1).

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 contents of the request which are required by a Contracting Party under paragraph (1), be presented on a request Form prescribed by that Contracting Party, as is normally the case at present, and/or to require that those contents be presented in a required format. As regards the term “format”, reference is made to Note 7.02.

5.08 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 be signed, with reference to PCT Rule 4.1(d). No provision is made for the inclusion in the request 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.

5.09 Paragraph (2)(b). This provision would oblige a Contracting Party to accept the filing, on paper, of request Forms which correspond to the PCT request Form, except where the Contracting Party excludes the filing of applications on paper if any provision in the Regulations allowing that Contracting Party to exclude the filing of applications on paper is unanimously adopted. The modifications which are permitted in order to adapt the PCT request Form into a national or regional request Form are prescribed under Rule 3. This would enable an applicant to file applications for the same invention in the Offices of different Contracting Parties using the same request Form, based on the PCT request Form. The same considerations might apply following the adoption of a format for the PCT request. As regards a requirement that an application on paper be typed or printed, and not handwritten, reference is made to the explanation under Article 4(1) (see Note 4.05).

5.10 Paragraph (3). This paragraph would allow a Contracting Party to require that an application be presented in a language accepted by the Office, as defined in Article 1(xii) (see Note 1.11). Where the description and/or claims of an application which satisfies the filing date requirements under Article 4 are not in a language accepted by the Office, the Office would notify the applicant that the requirements of this paragraph are not complied with giving an opportunity under paragraph (7) to comply with those requirements.

5.11 Paragraph (4). 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.

5.12 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 4.02).

5.13 Paragraph (5)(a). The time limit under this provision for furnishing a copy of the earlier application is prescribed under Rule 6(1)(a) as not less than 16 months from the filing date of the earlier application. This time limit, which is the same as that under PCT Rule 17.1, 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 13(3).

5.14 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 (6). 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.

5.15 Paragraph (5)(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.

5.16 Paragraph (5)(c). The purpose of this provision is to relieve the applicant of the burden of furnishing a copy of the earlier application, and certification of the filing date, where the earlier application is conveniently available to the Office concerned, as provided for under Rule 4.

5.17 Paragraph (5)(d). Under Article 4D(3) of the Paris Convention, any country of the Paris Union may require that a copy of an earlier application be accompanied by a translation. However, the cost of preparing different translations for the different countries in which priority is claimed is high and imposes a significant burden. In addition, it is generally accepted that, in a majority of cases, no use is made of such translations because the determination of priority date is not put in issue. Also, a translation of an earlier application can be made at any time after the copy of the earlier application has been filed should the need arise. Accordingly, in order significantly to reduce the burden on applicants, paragraph (5)(d) proposes that Contracting Parties should waive their right under the Paris Convention to require a translation of an earlier application in every case, but should instead require such translation only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable. Where that matter is to be determined, the Office would invite the applicant to file the translation within the time limit prescribed under Rule 6(1)(b). This provision is subject to reservations by the Delegations of Switzerland, Ireland, Spain, Greece, Uruguay, Belgium and China.

5.18 Paragraph (6). The purpose of this paragraph is to reduce the burden on applicants by restricting the need for evidence in support of the contents of the request Form or format, declarations of priority and translations of priority documents. Although it would be for each Contracting Party 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 paragraph (7), to notify the applicant of the requirement to file evidence and, under Rule 5 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 5.14.

5.19 Paragraph (7). The time limit under this paragraph is prescribed in Rule 6(2). Reference is also made to the provisions on notification under Articles 7(5) (see Note 7.13) and 8(1) and (2) (see Notes 8.01 and 8.02).

5.20 Paragraph (8). This paragraph is subject to a reservation by the Delegation of Egypt.

5.21 Subparagraph (a). The relevant time limit is prescribed in Rule 6(3)(a). Except in the situations under subparagraph (b), the sanction which may be applied under this provision may include refusal of the application. Reference is also made to the explanations under Article 7(6) (see Notes 7.14 to 7.16).

5.22 Subparagraph (b). The effect of the reference to Article 4(6)(b) in this subparagraph is to permit a Contracting Party to consider, under Article 4(6)(b), an application to file a copy of a previously filed application required under Rule 2(4), where the priority of the previously filed application is claimed, although consequence of failure to comply with the formality requirements in respect of a priority claim within the time limit prescribed under Rule 6(3)(b) is generally the loss of the priority right.

Note on Article 6
(Representation)

6.01 This Article relates only to the appointment of a representative 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.

6.02 Paragraph (1)(a), chapeau. As regards the terms “representative” and “procedure before the Office,” reference is made to the definitions under Article 1(x) and (xiv) respectively (see Notes 1.09 and 1.13).

6.03 Item (i). The phrase “have the right to practice before the Office” is modeled after the terminology in PCT Rule 90.1(a) to (c). Item (i) would permit a Contracting Party to require, under its national law, 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. It would also permit a Contracting Party to have a less strict requirement, for example, that any person may be appointed as representative unless debarred from acting as a representative on the grounds of misconduct. Item (i) would also leave to national law the matter of whether or not a firm could be appointed as a representative.

6.04 Item (ii). This item permits a Contracting Party to require that a representative provide an address for service on one or more territories prescribed by the Contracting Party. A Contracting Party could apply this requirement instead of, or in addition to, the requirement that the applicant have the right to practice before the Office under item (i). A Contracting Party could require under item (ii) that the address for service be on its own territory. However, where, for example, a Contracting Party is a Member of a regional grouping, such as the European Union, it could require that the address for service be on the territory of any Member State of that regional grouping.

6.05 Paragraph (1)(b). This provision is modeled after PCT Rule 90.3(a). The term “procedure before the Office” is defined under Article 1(xiv) (see Note 1.13). 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 a communication is required to be signed by the applicant under Article 11(1), the communication should be signed by the representative on behalf of the applicant. Where representation is mandatory, the representative’s signature on behalf of the applicant would also be mandatory. Where the Office is required to notify an applicant under Articles 4(3) or 5(7), the notification would normally be sent to the applicant’s representative. The situation is the same where an owner or other interested person is represented. For example, a representative would have an opportunity under Article 9(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 notifications or other correspondence to an appointed representative, a Contracting Party may provide that any correspondence should be sent to the represented person where that person provides his own address as the address for correspondence and/or legal service under Article 7(4).

6.06 Paragraph (1)(c). This subparagraph is intended to cover the case where the signature of an applicant, owner or other interested person is required on an oath or declaration or a revocation of a power of attorney.

6.07 Paragraph (2). This paragraph, which is subject to reservations by the Delegations of Japan, Portugal and China, permits a Contracting Party to require representation for the purposes of any procedure before the Office after the filing date, except as provided under items (i) to (vii). *In response to comments submitted to the SCP Electronic Forum, the International Bureau has restored items (ii) to (v) in the Treaty in square brackets, and further recommends that items (iii) and (v) be subsumed into a new item (iii) which would read: “any procedure referred to in Article 4;”*. This paragraph is limited to procedures after the filing date for consistency with Article 4(1) which provides that a filing date be accorded to an application, filed by the applicant, which complies with the requirements of that Article, even if a Contracting Party requires mandatory representation. Before the filing date is established, paragraph (2) would permit other elements, in particular, one or more claims, to be included in the application as filed, and the application as filed to be accompanied by a translation and the filing fee, without the requirement for representation. However, a Contracting Party would be permitted to require a representative to be appointed for the filing of claims or a translation which occurs after the filing date. As regards the terms “applicant,” “owner,” “procedure before the Office,” and “other interested person,” reference is made to the definitions under Article 1(viii), (ix) and (xiv) and the explanations under Article 7(4) (see Notes 1.07 to 1.09, 1.13 and 7.10).

6.08 Item (i). This item is included since the payment of a maintenance fee does not *per se* require professional expertise. However, in the light of the experience in States which do not require representation for payment of maintenance fees, such as the United Kingdom and Australia, it can be expected that, in most cases, foreign owners will continue to use a representative for payment of such fees, even though such representation is not mandatory.

6.09 Item (ii). Under this item, any procedures, other than those referred to in item (i), 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. *[The item is placed in square brackets for further consideration by the Standing Committee in the absence of any consensus as to whether there should be provision for any further exceptions.]*

6.10 Item (iii). 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) and (ii), 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.

6.11 Paragraph (3)(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 or format 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. As regards the requirements concerning the signature of communications, reference is made to Article 7(2) (see Notes 7.04 to 7.08).

6.12 Paragraph (3)(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 6 does not regulate further details of the so-called “general power of attorney.”

6.13 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 Article 7(3)(b)(ii), 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.

6.14 Paragraph (4). As regards the presentation of the power of attorney, reference is made to the explanations relating to the presentation of the request Form or format of the application under Article 5(2) (see Notes 5.07 to 5.09). Rule 21(1)(a)(i) provides for a Model International Form for the power of attorney.

6.15 Paragraph (5). As regards the terms “a language accepted by the Office” and “translation,” reference is made to Article 1(xii) and (xiii) (see Notes 1.11 and 1.12).

6.16 Paragraph (6). This paragraph relates to the situation where the power of attorney, or the part of the request Form or format in which the representative is appointed, contains an indication the veracity of which is doubtful. The Office would be obliged under Rule 5 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 “where the Office may reasonably doubt the veracity of,” reference is made to the explanation under Article 5(6) (see Note 5.18).

6.17 Paragraph (7). This paragraph establishes the exhaustive character of the list of formal requirements permitted under paragraphs (1) to (6) with respect to the matter of representation.

6.18 Paragraph (8). The time limit under this paragraph is prescribed under Rule 7(2). Reference is also made to the provisions on notification under Article 7(5) (see Note 7.13) and 8(1) and (2) (see Notes 8.01 and 8.02).

6.19 Where an applicant, owner or other interested person is represented, the notification under paragraph (8) would normally be sent to the representative (see also the explanation under paragraph (1)(b) in Note 6.05). 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.

6.20 Paragraph (9). The relevant time limit under this paragraph is prescribed under Rule 7(3). Reference is also made to the explanations under Article 7(6) (see Notes 7.14 to 7.16).

Note on Article 7
(Communications; Addresses)

7.01 In accordance with the definition under Article 1(v), the term “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 (see also Note 1.04).

7.02 Paragraph (1)(a). The Regulations under this provision are prescribed in Rule 8. The “form” of communication refers to the physical form of the medium which contains the information, for example, paper sheets, a floppy disk or an electronic file. The “means” refer to the manner in which the form was delivered or transmitted to the Office. For example, a communication mailed to the Office would represent paper form and physical means, while a floppy disk mailed to the Office would represent electronic form and physical means. A

telefacsimile transmission resulting in a paper copy would represent a paper form transmitted by electronic means, and an electronic transmission from computer to computer would represent an electronic form transmitted by electronic means. The “format” refers to the presentation or arrangement of the information or data in a communication, for example, the International Standard Application Format, developed by the United States Patent and Trademark Office, which uses standard data identifier tags to facilitate automatic data capture. The term “filing” refers to the submission or transmission of any communication to the Office.

7.03 Paragraph (1)(b) and (c). These provisions would ensure that no Contracting Party would be obliged, against its wishes, to accept the filing of applications in electronic form or by electronic means or to exclude the filing of applications on paper.

7.04 Paragraph (2). In accordance with the definition under Article 1(xi), the term “signature” means any means of self-identification (see also Note 1.10).

7.05 Paragraph (2)(a). Regulations on the signature of communications transmitted to the Office on paper and in electronic form or by electronic means are prescribed under Rule 9(1) to (5).

7.06 Paragraph (2)(b). This provision would, in general, oblige a Contracting Party to accept a signature of the person concerned as sufficient authentication of a communication without the need for further authentication by way of, for example, attestation or notarization of that signature, thereby reducing the burden on applicants, owners and other interested persons.

7.07 However, in accordance with the exceptions prescribed under Rule 9(6), a Contracting Party may require that an electronic signature be confirmed by a certificate issued by a certification authority specified by the Contracting Party. Also, where an Office is of the opinion that there is reasonable doubt as to the authenticity of a signature, it could require evidence under subparagraph (c), which evidence could, at the option of the applicant, owner or other interested person, be in the form of certification (see Note 7.08).

7.08 Paragraph (2)(c). In case of reasonable doubt as to the authenticity of the signature, 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). The Office would be obliged under Rule 5 to inform the applicant of the reason for its doubt.

7.09 Paragraph (3). The registration number or other indication referred to in this paragraph may be required for data capture. In the case of electronic communications, it could be a personal identification number (PIN) or a digital certificate containing a registration number. As regards the sanction for failure to comply with a requirement under subparagraphs (a) and (b)(iii) within the time limit prescribed under paragraph (6)(a), reference is made to paragraph (6)(b)(i).

7.10 Paragraph (4), chapeau. As regards the terms “applicant” and “owner,” reference is made to the definitions under Article 1(viii) and (ix), 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 owner.

7.11 Items (i) and (ii). It would be a matter for each Contracting Party to determine what constitutes an address for correspondence or an address for legal service. It would also be a matter for each Contracting Party to determine whether, and in what circumstances, it requires an address for correspondence or an address for legal service, or both, and in what communication such address(es) should be indicated. Since it appears that the term “address for service” could be construed, depending on national law, as either of the addresses under items (i) and (ii), a Contracting Party would be permitted to use the term “address for service” in place of “address for correspondence” and/or “address for legal service.” The Regulations under these items are prescribed in Rule 10 (see Notes R10.01 to R10.04). As regards the sanction for failure to comply with the requirements under paragraph (4), reference is made to paragraph (6)(b)(ii) (see Note 7.17).

7.12 Item (iii). This item is included in order to take account of any future developments which would necessitate any address other than those under items (i) and (ii) being communicated, for example, for the purposes of electronic commerce. At present, no provision for such other address is included in the Regulations.

7.13 Paragraph (5). The time limit under this paragraph is prescribed under Rule 11(1). Reference is also made to the provisions on notification under Article 8(1) and (2) (see Notes 8.01 and 8.02).

7.14 Paragraph (6). The time limit under this paragraph is prescribed under Rule 11(2). As regards the obligation on the applicant, owner or other interested party to comply with the requirements under Article 7, reference is made to the provisions under Article 8(3).

7.15 Paragraph (6)(a). The effect of the reference to Article 4 is that, where the requirements for according a filing date to an application under that Article have been complied, a Contracting Party is obliged to accord such filing date and cannot revoke that filing date for failure to comply with requirements under Article 7, even where the application is subsequently refused under this paragraph.

7.16 Paragraph (6)(b), item (i). This item would seem to be self-explanatory.

7.17 Item (ii). Reference is made to the requirements under Rule 10. The effect of these requirements is that where the applicant has given, as his address, an address on a territory prescribed by the Contracting Party, or has appointed a representative who complies with the requirements applied by that Contracting Party under Article 6(1) and the address of that representative has been given, that Contracting Party shall not refuse the application for failure to comply with requirements under paragraph (4).

Note on Article 8 (Notifications)

8.01 Article 8 does not regulate the date of a notification for the purposes of determining the expiration of a time limit calculated from that date *following agreement by first session, first part, of the Standing Committee that this should be left to be determined under national*

law (see document SCP/1/7, paragraph 136). Similarly, it does not regulate the means of notification, for example, by mail or registered mail.

8.02 Paragraph (1). Where both an address for correspondence and an address for legal service have been indicated under Article 7(4), the question to which of those addresses a notification should be sent would be a matter for the Contracting Party concerned or its Office.

8.03 Paragraphs (2) and (3). These provisions are included for avoidance of doubt. It is to be noted that an application may be accorded a filing date even though indications allowing the applicant to be contacted by the Office have not been furnished, provided that indications allowing the identity of the applicant to be established have been furnished under Article 4(1)(a)(ii).

8.04 Paragraph (3). This paragraph is also included for the avoidance of doubt. Although the applicant, owner or other interested person is not relieved of the obligation to comply with the requirements concerned in the absence of a notification, the obligations concerning certain requirements in respect of an application under Articles 5 and 7 are subject, under Article 9(1), to what is, in effect, a statute of limitation on the sanctions which may be applied where a patent is granted despite non-compliance with one or more of those requirements.

Note on Article 9
(Validity of Patent; Revocation)

9.01 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 of the 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. This would apply irrespective of whether the Office failed to notify the applicant under Article 7(5) or 5(7) 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. Reference is also made to the explanation under Article 8 (see Note 8.04). 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.

9.02 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. This provision is not applicable where there has been a voluntary surrender of a patent for the purpose of re-issue.

9.03 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(3), or that evidence required under Article 5(6) had not been furnished. *In addition, if the modifications to paragraph (1) proposed by the International Bureau are not adopted, a Contracting Party would be permitted to provide for the revocation or invalidation of a patent, where it is subsequently determined that the application was not signed as required under Article 7(2), or that the applicant had not indicated an address for correspondence and/or an address for legal service required under Article 7(4).*

9.04 The exception for the situation in which the non-compliance occurred as a result of fraudulent intention is needed to prevent the applicant benefiting from such fraud. What constitutes “fraudulent intention” would be a matter for national law. In particular, it could be interpreted to cover inequitable conduct. Alternatively, it could be restricted to the situation in which civil or criminal liability is established.

9.05 Paragraph (2). This paragraph covers proceedings where the sanctions are of equivalent effect to revocation or invalidation (see Note 9.01). The paragraph is restricted to two formal aspects of 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. Accordingly, it does not regulate the grounds on which a granted patent may be revoked or invalidated, such as lack of novelty, nor any other aspect of such proceedings. It also does not regulate the form of observations which an owner may make. For example, an owner would generally be given the opportunity to submit written observations prior to a decision in court proceedings. However, a Contracting Party would be permitted to provide only for oral observations in such proceedings. No Contracting Party would be required to provide an opportunity for amendments and corrections to be made where 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 10
(Extension of a Time Limit Fixed by the Office)

10.01 Distinctions Between Articles 10, 11, 12 and 13. Article 10 provides for the extension of a time limit as of right, where the request for such extension is made before the expiration of that time limit. It is limited to the extension of time limits fixed by the Office for an action in a procedure before the Office (see Notes 10.06 and 10.07) and is subject only to the payment of a fee. Accordingly, the applicant or owner concerned could not be required to state the grounds on which the request under Article 10 is based.

10.02 In contrast, Articles 11 and 12 apply where the request for relief is made after the expiration of the time limit concerned. Article 11 provides for the Office to consider the time limit to have been complied with, and to continue processing and re-instate any rights with respect to the application [or patent], subject only to the payment of a fee, provided that the request is filed, and the requirements in respect of which the time limit applied are complied with, within the time limit for making the request, prescribed in Rule 13(1), namely not less than two months. Where the request is filed within two months, no statement or evidence as to the reason for the failure to comply with the time limit may be required. However, a

Contracting Party which prescribes a time limit of more than two months for making a request may require, under Rule 13(2), that any request for relief under Article 11 which is made after two months be accompanied by a statement that the failure to comply with the original time limit was unintentional, as is already provided for in the law of the United States of America under 37 CFR, paragraph 1.137(b); evidence in support of that statement may be required under Article 11(6) only where the Office may reasonably doubt the veracity of that statement (see Note 11.23). As in the case of Article 10, Article 11 is limited to the extension of time limits fixed by the Office for an action in a procedure before the Office. [In addition, it is further limited to procedures in respect of applications and therefore does not cover procedures in respect of patents.]

10.03 As in the case of Article 11, Article 12 provides for the re-instatement of rights where the request is made after the expiration of the time limits concerned. In contrast to Article 11, Article 12 is not restricted to time limits fixed by the Office but, under Article 12(1)(iii), applies to any time limit in respect of which failure to comply has the direct consequence of causing a loss of rights with respect to the application or patent concerned. In addition, the time limit applied under Rule 14(1) for making the request under Article 12, would normally be longer than that applied under Rule 13(1) for making a request under Article 11. However, also in contrast to Article 11, a request under Article 12 is subject, under Article 12(1)(v), to a finding by the Office that the failure to comply with the time limit occurred in spite of all due care required by the circumstances having been taken, or, at the option of the Contracting Party, was unintentional. It is apparent, that in view of this requirement for a finding of due care or unintentionality by the Office, the procedure under Article 12 is considerably more burdensome, both for the applicant or owner concerned and the Office, than the procedure under Article 11 which provides for continued processing and re-instatement of rights without such finding. Accordingly, where an applicant [or owner] is entitled to request relief under both Articles 11 and 12, it is to be expected that the request would typically be made under Article 11.

10.04 Article 13 provides for the addition of a priority claim (Article 13(1)). It also provides for the restoration of a priority claim in the case of the delayed filing of the subsequent application (Article 13(2)) or the failure to furnish a copy of the earlier application within the prescribed time limit (Article 13(3)). In order to avoid the possibility of double relief, the time limits referred to in Article 13(1), (2) and (3)(a) are expressly excluded in the exceptions under Articles 10 to 12 under Rules 12(2)(a)(iv), 13(3)(a)(v) and 14(2)(iv).

10.05 Each of Articles 10 to 13 sets the maximum standard which a Contracting Party may apply. A Contracting Party would be permitted, but not obliged, to dispense with any requirement under these Articles, or to apply any requirement or provide any relief which, from the viewpoint of applicants, owners or other interested persons, is more favorable than the requirements or relief prescribed in these Articles and associated Regulations (Rules 12 to 15) (see, for example, Note 11.05).

10.06 Paragraph (1). This paragraph 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 1.13). 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 10.07). 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.

10.07 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(7) with all of the requirements of Article 5(1) to (4), for furnishing evidence under Article 5(6), and for response to an examiner's substantive examination report. However, which time limits, if any, are fixed by the Office and which are fixed by statute or other instrument, such as a treaty, is a matter for the Contracting Party concerned.

10.08 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 Rule 17, a licensee in proceedings under Rule 18, 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.

10.09 As regards the term "communication", reference is made to the definition under Article 1(v) (see Note 1.04). Reference is also made to the requirements in respect of communications under Article 7. It is to be noted that paragraph (1) contains no provisions in respect of the contents of the request, although it is implicit that it 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. However, a Contracting Party would not be permitted to require that the applicant or owner give reasons in support of the request. The period of an extension which a Contracting Party is required to grant under this provision is prescribed under Rule 12(1).

10.10 Paragraph (2). The exceptions under this paragraph are prescribed in Rule 12(2).

10.11 Paragraph (3). 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. As regards the expression "a language accepted by the Office," reference is made to the explanation given under Article 1(xii) (see Note 1.11).

10.12 Paragraph (4). 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(4) (see, in particular, Note 5.11).

10.13 Paragraph (5). This paragraph provides only the right to make observations on the intended refusal of a request under paragraph (1), for example, to assert that a fee required under paragraph (4) had in fact been paid. It does not provide an additional time limit to comply with any requirement which was not complied with in making the request. As in the case of Article 9(2), this paragraph does not regulate the form of observations which an applicant or owner is given an opportunity to make (see Note 9.05).

Note on Article 11
(Continued Processing and Re-instatement of Rights
Without a Finding of Due Care by the Office)

11.01 As regards the relationship between Article 11 and Articles 10, 12 and 13, reference is made to the explanation under Article 10 (see Notes 10.01 to 10.05).

11.02 Paragraph (1). As regards the expression “a time limit fixed by the Office for an action in a procedure before the Office,” reference is made to the explanations under Article 10(1) (see, in particular, Notes 10.02 and 10.03).

11.03 As regards the terms “applicant” and “owner,” reference is made to the explanations under Article 1(viii) and (ix). *[In the absence of any consensus as to whether Article 11 should be restricted to procedures in respect of applications, or whether it should apply additionally to procedures in respect of patents, the references to “patent” and “owner” are placed in square brackets for consideration by the Standing Committee.]*

11.04 Where the request under this paragraph is granted, the refusal, withdrawal or other loss of rights with respect to the application [or patent] concerned 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 continue as if the time limit concerned had been complied with.

11.05 Item (i). As regards the term “communication,” reference is made to the explanation under Article 1(v) (see Note 1.04). Reference is also made to the requirements in respect of communications under Article 7. Since Article 11 prescribes the maximum requirements which a Contracting Party may apply, any Contracting Party which so wishes could dispense with the requirement that the “communication” be signed.

11.06 Item (ii). The time limit referred to in this item is prescribed in Rule 13(1).

11.07 Paragraph (2). The exceptions referred to in this paragraph are prescribed in Rule 13(3).

11.08 Paragraph (3). This provision would permit a Contracting Party to require that a request under paragraph (1)(a) be presented on a prescribed Form or in a prescribed format. In the absence of any clear need, Rule 21 does not provide for the establishment of a Model International Form or format for such requests. Reference is also made to the explanation under Article 5(2)(a) (see, in particular, Note 5.07).

11.09 Paragraph (4). Reference is made to the explanations given under Article 10(3) (see Note 10.11).

11.10 Paragraph (5)(a). Reference is made to the explanations given under Article 5(4) (see, in particular, Note 5.11).

11.11 Paragraph (5)(b), item (i). Postal services and other delivery services have been placed on the same footing in view of modern developments.

11.12 Item (ii). What constitutes “a failure by the Office” would be a matter to be determined under national law.

11.13 Paragraph (6). Evidence may only be required under this paragraph in respect of a statement, under Rule 13(2) that the failure to comply with the time limit was unintentional. Since such a statement can only be required where the request under paragraph (1) is filed later than two months from the date of the expiration of the time limit concerned, it follows that evidence can never be requested under Article 11 where a request is filed within that two month period. As regards the expression “where the Office may reasonably doubt the veracity,” reference is made to the explanation given under Article 5(6) (see Note 5.18).

11.14 Paragraph (7). Reference is made to the explanations given under Article 10(5) (see Note 10.13).

11.15 Intervening Rights. The Treaty and Regulations do not regulate the rights, if any, under national law, acquired by 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 the loss of rights resulting from the failure to comply with the time limit concerned and the date for which those rights are re-instated.

Note on Article 12

(Re-instatement of Rights After a Finding of Due Care or Unintentionality by the Office)

12.01 As regards the relationship between Article 12 and Articles 10, 11 and 13, reference is made to the explanations under Article 10 (see Notes 10.01 to 10.05).

12.02 Paragraph (1), chapeau. As regards the term “procedure before the Office,” reference is made to the definition in Article 1(xiv) (see Note 1.13).

12.03 Item (i). Reference is made to the explanations under Article 11(1)(i) (see Note 11.05).

12.04 Item (ii). The time limit under this item is prescribed in Rule 14(1).

12.05 Item (iii). This item is required to avoid circumventing the exclusions provided under Rule 14(2). For example, where failure to comply with a time limit under Article 13(1), (2) or (3) in respect of a priority claim has the direct consequence of loss of that priority claim which, in turn, has the indirect consequence of the refusal of the application on the grounds of prior publication, restitution of loss of rights resulting from that refusal would not be possible under paragraph (1).

12.06 Item (iv). 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 (6) to furnish a

declaration or other evidence in support of those grounds within a time limit fixed by the Office.

12.07 Item (v). 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.

12.08 Paragraph (2). The exceptions under this paragraph are prescribed in Rule 14(2).

12.09 Paragraph (3). Reference is made to the explanation under Article 11(3) (see Note 11.08).

12.10 Paragraph (4). Reference is made to the explanations given under Article 10(3) (see Note 10.11).

12.11 Paragraph (5). Reference is made to the explanations given under Article 5(4) (see, in particular, Note 5.11).

12.12 Paragraph (6). Reference is made to the explanations given under paragraph (1)(iv) (see Note 12.06).

12.13 Paragraph (7). Reference is made to the explanation given under Article 10(5) (see Note 10.13).

12.14 Intervening Rights. Reference is made to the explanations regarding intervening rights under Article 11 (see Note 11.15).

Note on Article 13
(Addition and Restoration of Priority Claim)

13.01 As regards the relationship between Article 13 and Articles 10, 11 and 12, reference is made to the explanations under Article 10 (see Notes 10.01 to 10.05).

13.02 Paragraph (1). This provision, modeled after a portion of PCT Rule 26*bis*.1, 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 whether the application as filed contained no priority claim, or 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 formal requirements concerning the correction of a priority claim could be regulated by the provisions on the correction of a mistake under Rule 19 (see Note R19.02).

13.03 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).

13.04 Item (i). The time limit referred to in this item is prescribed in Rule 15(1).

13.05 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) (see Notes 13.06 to 13.10).

13.06 Paragraph (2). This provision provides for the restoration of the priority right, and hence the priority date, 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. This paragraph is subject to reservations by the Delegations of Argentina, China, Spain and the United Kingdom.

13.07 As regards the requirements that the request be made “in a communication to the Office signed by the applicant,” reference is made to the explanations under Article 11(1)(i), (see Note 11.05).

13.08 Item (i). The time limit under this item is prescribed in Rule 15(2).

13.09 Items (ii) and (iii). Reference is made to the explanation given under Article 12(1)(iv) and (v) (see Notes 12.06 and 12.07).

13.10 Item (iv). Under this item, restoration of a priority claim would be possible under paragraph (2) 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.

13.11 Paragraph (3)(a). This paragraph provides 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(5)(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 continued processing and re-instatement of rights without a finding of due care by the Office under Article 11(1).

13.12 As regards the requirement that the request be made in “a communication to the Office signed by the applicant,” reference is made to the explanation under Article 11(1)(i) (see Note 11.05).

13.13 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.

13.14 Paragraph (3)(a), item (ii). The time limit for making a request under this item is prescribed in Rule 15(3) (see Note R15.03). This time limit provides a legal certainty for the applicant in that, if he requests a copy of the earlier application within the prescribed time limit, he is entitled 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(5)(a).

13.15 Paragraph (3)(b), item (ii). The time limit under this item is prescribed in Rule 15(4).

13.16 Paragraph (4). Reference is made to the explanation under Article 11(3) (see Note 11.08).

13.17 Paragraph (5). Reference is made to the explanations given under Article 10(3) (see Note 10.11).

13.18 Paragraph (6). Reference is made to the explanations given under Article 5(4) (see, in particular, Note 5.11).

13.19 Paragraph (7). Reference is made to the explanations given under Article 10(5) (see Note 10.13).

[13.20 Intervening Rights. Reference is made to the explanations regarding intervening rights under Article 11 (see Note 11.15).]

Note on Article 14
(Regulations)

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

14.02 Paragraph (1)(a). This provision would seem to be self-explanatory.

14.03 Paragraph (1)(b). The Regulations under this provision are prescribed in Rules 16 to 19.

14.04 Paragraph (1)(c). The Regulations under this provision are prescribed in Rule 21.

14.05 Paragraph (4). This paragraph seems to be self-explanatory.

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 Paragraphs (1). Where indications allowing the applicant to be contacted have been furnished, the time limit under these paragraphs would not start to be calculated until the Office has notified the applicant under Article 4(3).

R2.02 Paragraph (2). This paragraph is modeled after PCT Rule 20.2(a)(i) and (ii). In accordance with item (ii), an applicant may file a missing part of the description or drawing even if the Office has not made a notification under Article 4(5)(a).

R2.03 Paragraph (3). This paragraph permits a Contracting Party to require the applicant to file, upon invitation, a copy of the earlier application in order to establish the contents of that earlier application. 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(5)(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) and Article 5(5)(b). *[Since, in many cases, the previously proposed period of two months may be insufficient to obtain and file the certified copy and filing date under item (ii), a period of four months is proposed as an alternative in square brackets for consideration by the Standing Committee.]* [In addition, a four-month time limit for filing a certified copy and filing date of the earlier application under item (ii) would be the same as the period for such filing under Article 4(6)(a), as prescribed under paragraph (4)(b)(ii), which corresponds generally to the four-month period between the expiration of the priority period and the expiration of the 16-month time for furnishing a certified copy of an application and filing date under Article 5(5)(b), as prescribed in Rule 6(1)(a) with reference to Article 5(5)(a).] The time limit for furnishing a translation of the earlier application under item (iii) is the same as the time limit for furnishing a translation of the earlier application under Article 5(7)(d), as prescribed in Rule 6(1)(b). As regards the expression “subject to Rule 4,” reference is made to the explanations under that Rule (see Notes R4.01 and R4.02).

R2.04 Paragraph (4). The Delegation of the Russian Federation has reserved its position concerning the omission from this paragraph of a requirement that the applicant identified in the previously filed application shall be the same as, or the predecessor in title to, the applicant identified in the application containing the reference or, in the case of two or more applicants, at least one of those applicants is identified as an applicant in both applications.

R2.05 Paragraph (4)(a). This provision seems to be self-explanatory.

R2.06 Paragraph (4)(b). Since Article 4(6)(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(5) for the purposes of a priority claim. Reference is also made to the explanations under paragraph (3) (see Note R2.03).

Note on Rule 3

(Modifications to the PCT Request Form Under Article 5(2)(b))

[Reserved.]

Note on Rule 4

(Availability of Priority Document Under Article 5(5)(c) and Rule 2(3) and (4)(b))

R4.01 Where the earlier application was filed with the Office of the Contracting Party concerned, it would serve no useful purpose for the applicant to request a copy of that earlier application from that Office and then re-file it with the same Office. Similarly, in that circumstance, certification of the filing date would serve no purpose since it would be that Office which provides the certification.

R4.02 The expression “is available to that Office, in a legally accepted electronic format, from a digital library which is accepted by that Office” is included to take account of developments which would enable Offices to obtain copies of earlier applications from such a digital library.

Note on Rule 5

(Evidence Under Articles 5(6), 6(6), 7(2)(c) and 11(6),
and Rules 16(7), 17(8), 18(8) and 19(7))

R5.01 This provision would seem to be self-explanatory.

Note on Rule 6

(Time Limits Concerning the Application Under Article 5)

R6.01 Paragraph (1)(a). Reference is made to the explanation given under Article 5(5)(a) (see Note 5.13).

R6.02 Paragraph (1)(b). The time limit under this provision reflects the fact that Article 5(5)(b) requires the applicant to furnish a translation of the earlier application only upon invitation by the Office.

R6.03 Paragraph (2)(a) and (b). These provisions seem to be self-explanatory.

R6.04 Paragraph (2)(c). The time limit for the correction of a priority claim under the PCT is prescribed in PCT Rule 26*bis*.1(a) (see also Note R15.01).

R6.05 Paragraph (3)(a), items (i) and (ii). Since, under Article 4(1)(a), the filing date of an application to which that Article applies cannot be earlier than the date on which the elements referred to in that Article were received by the Office, a Contracting Party would be permitted to calculate the time limit under item (ii) from the filing date. However, an exception may need to be made in the case of the applications referred to in Article 4(7), in particular, divisional applications, where this would not be appropriate. Reference is also made to the explanation given under Rule 2(1) and (2) (see Notes R2.01 and R2.02).

R6.06 Item (iii). This item seems to be self-explanatory.

R6.07 Paragraph (3)(b). This paragraph seems to be self-explanatory.

Note on Rule 7

(Details Concerning Representation Under Article 6)

R7.01 Paragraph (1). *[The items under this paragraph are placed in square brackets for further consideration by the Standing Committee in the absence of any consensus as to whether or not they should be included.]*

[R7.02 This provision would enable an applicant who has filed an application under Article 4(5)(d) and (6)(a) without a representative to complete the application, for the purposes of the filing date, without appointing a representative.]

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

R7.04 Paragraph (3). Reference is made to the explanation given under Rule 6(3)(a) (see Note R6.05 and R6.06).

Note on Rule 8

(Filing of Communications Under Article 7(1))

R8.01 Paragraph (1). As regards the expression “communications on paper,” reference is made to the explanation under Article 4(1)(a) (see, in particular, Note 4.05).

R8.02 Paragraph (2)(a). The requirements under the PCT applicable under this provision are prescribed in PCT Rules 89*bis* and 92.4. As regards the terms “form” and “means”, reference is made to the explanation given under Article 7(1)(a) (see Note 7.02). The expression “filing of communications in electronic form or by electronic means” includes filing by telegraph, teleprinter, telefacsimile or other like means. This provision is also applicable to such means resulting in the filing of, not only a printed or written document, but also a form other than paper sheets, for example, telefacsimile transmission from/to a computer terminal.

Paragraph (2) does not prevent a Contracting Party which provides for the electronic filing of communications under the PCT from allowing electronic filing in accordance with its own national requirements, provided it also allows such filing in accordance with the PCT requirements. It would also not prevent a Contracting Party which does not provide for electronic filing under the PCT from providing for electronic filing in accordance with its own national requirements.

R8.03 Paragraph (2). The restriction of the requirements to a particular language would cover the situation in which the PCT prescribes 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 that alphabet, for example, Chinese.

R8.04 Paragraph (2)(b). This provision seems to be self-explanatory.

R8.05 Paragraph (3)(a). *The International Bureau proposes that this provision be incorporated into paragraph (2)(a).*

R8.06 Paragraph (3)(b). This provision is modeled after PCT Rule 92.4(d) but prescribes a longer time limit to allow for the situation in which the original has to be sent by mail to an Office abroad. *If the proposal by the International Bureau is accepted and this provision is placed under paragraph (2), this provision is also applicable to the communications filed by telegraph, teleprinter, telefacsimile or other like means resulting in the filing of a form other than paper.*

R8.07 Paragraph (4)(a). The requirements under the PCT applicable under this provision are prescribed in PCT Rule 89^{ter}.1. That Rule enables a national Office or intergovernmental organization to provide that, where an international document, or other document relating to an international application, is filed on paper, a copy thereof in electronic form, in accordance with the Administrative Instructions, may be furnished by the applicant.

R8.08 Paragraph (4)(b). This provision seems to be self-explanatory.

Note on Rule 9

(Details Concerning the Signature Under Article 7(2))

R9.01 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), which corresponds to the note in box No. IX of PCT Request Form, would apply, in particular, where a person signs on behalf of a legal entity.

R9.02 Paragraph (2). The date of signing may be important, for example, to determine the legal competence of the person who gave the signature.

R9.03 Paragraph (3). As regards the term “on paper,” reference is made to the explanation under Article 4(1)(a), chapeau (see, in particular, Note 4.05).

R9.04 Items (i) and (ii). These items seem to be self-explanatory.

R9.05 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.

R9.06 Paragraph (4). As regards the term “the filing of communications in electronic form or by electronic means,” reference is made to the explanation under Rule 8(2) (see Note R8.02).

R9.07 Paragraph (5). As explained in Working Paper 4/3 presented at the Ad Hoc Advisory Group on Proposed Amendments of the PCT Regulations, November 23 to 27, 1998, an “electronic signature” is a signature in electronic form attached to or logically associated with an electronic record which may be used to identify the signer of the electronic record and indicate the signer’s approval of the information contained in the electronic record. “Electronic signature” is a broader term than “digital signature” which refers to one specific type of electronic signing procedure. “Digital signature” is a mathematical “summary” of the document which has subsequently been encrypted with an individual’s private key. The summary (often referred to as a “hash” or “message digest”) is usually created by running the text of the document through an irreversible secure algorithm.

R9.08 Subparagraph (a). This provision would seem to be self-explanatory.

R9.09 Subparagraph (b). At present there are no requirements under the PCT in relation to electronic signatures. However, the matter is under consideration by the Ad Hoc Advisory Group on Proposed Amendments of the PCT Regulations.

R9.10 Subparagraph (c). This provision seems to be self-explanatory.

R9.11 Paragraph (6). This paragraph reflects the existing practice in relation to, in particular, digital signatures.

Note on Rule 10

(Details Concerning the Indication of Addresses Under Article 7(4)(i) and (ii))

R10.01 Reference is made to the applicability of the requirements under this Rule to Article 7(6)(b)(ii) (see Note 7.17).

R10.02 Paragraph (1). As regards the requirement that an address be “on one or more territories prescribed by the Contracting Party,” reference is made to the explanation under Article 6(1)(a)(ii) (see Note 6.04).

R10.03 Paragraph (2). This provision would permit, but not oblige, any Contracting Party which so wishes to treat, in the absence of an indication to contrary, the address of an unrepresented applicant, owner or other interested person as the address for correspondence and the address for legal service under Article 7(4)(i) and (ii), in accordance with the existing practice in many Offices. As regards the requirement that an address be “on one or more

territories prescribed by that Contracting Party,” reference is made to the explanation under Article 6(1)(a)(ii) (see Note 6.04).

R10.04 Paragraph (3). This provision would permit, but not oblige, any Contracting Party which so wishes to treat the address of a representative as the address for correspondence and the address for legal service under Article 7(4)(i) and (ii), in the absence of an indication to the contrary. In addition, a Contracting Party could require, under Article 6(1)(a)(ii) that the representative provide an address for service on the territory of the Contracting Party (see Note 6.04).

Note on Rule 11

(Time Limits Concerning Communications Under Article 7(5) and (6))

R11.01 Paragraph (1). This paragraph would seem to be self-explanatory.

R11.02 Paragraph (2). Reference is made to the explanations under Rule 2(1) (see Note R2.01).

Note on Rule 12

(Details Concerning Extension of a Time Limit
Fixed by the Office Under Article 10)

R12.01 Paragraph (1)(a). This provision seems to be self explanatory.

R12.02 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.

R12.03 Paragraph (2)(a), item (i). Under this item, no Contracting Party would be obliged to grant more than one extension of a time limit under Article 10(1), although it would be permitted to do so. Any Contracting Party which did grant more than one extension under Article 10(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.

R12.04 Item (ii). This item seems to be self-explanatory.

R12.05 Items (iii) and (iv). These items would prevent an applicant or owner from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R12.06 Items (v) to (viii). *[These items are included in response to suggestions made at the first session, first part of the Standing Committee (see document SCP/1/7, paragraph 155). Item (viii) is place in square brackets for further consideration by the Standing Committee as to whether, where the extension of a time limit is requested in an expedited procedure, the appropriate remedy would be the withdrawal of the expedited treatment rather than a refusal of the request for extension.]*

R12.07 Paragraph (2)(b). 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.

Note on Rule 13

(Details Concerning Continued Processing and Re-instatement of Rights Without a Finding of Due Care by the Office Under Article 11)

R13.01 Paragraph (1). This paragraph seems to be self-explanatory.

R13.02 Paragraph (2). As regards the term “unintentional,” reference is made to the explanation under Article 12(1)(v) (see Note 12.07). Reference is also made to the explanation under Article 13 to the relationship between Articles 10, 11, 12 and 13 (see, in particular, Note 10.02).

R13.03 Paragraph (3)(a), item (i). This item is for the avoidance of doubt.

R13.04 Item (ii). Although under this item, a Contracting Party would not be obliged to provide for continued processing and re-instatement of rights for failure to comply with a time limit for the payment of maintenance fees, it would be obliged to provide a period of grace for the payment of such fees under Article 5bis(1) of the Paris Convention. *[This item would still be required even if Article 11 were restricted to procedures in respect of applications since under some laws a maintenance fee may be payable in respect of a pending application.]*

R13.05 Items (iii) to (v). These items would prevent an applicant [or owner] from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R13.06 Item (vi). This item may be required to avoid undue delay of prosecution of an application.

R13.07 Item (vii). This item seems to be self-explanatory.

R13.08 Items (viii) to (x). Reference is made to the explanations under Rule 12(2)(a)(v) to (viii) (see Note R12.06).

R13.09 Paragraph (3)(b). 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 continued processing and re-instatement of an application.

Note on Rule 14

(Details Concerning Re-instatement of Rights After a Finding of Due Care or Unintentionality by the Office Under Article 12)

R14.01 Paragraph (1). As in the case of *restitutio in integrum* under Article 122 of the European Patent Convention, the time limit under this paragraph would apply whether or not

the applicant, owner or other interested party is notified of the failure to comply with the time limit concerned. *[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.]*

R14.02 Paragraph (2). Reference is made to the explanations under Rule 13(3)(a) (see Notes R13.03 to R13.08).

Note on Rule 15

(Details Concerning Addition and Restoration of Priority Claim Under Article 13)

R15.01 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) 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.

R15.02 Paragraph (2). This paragraph seems to be self-explanatory.

R15.03 Paragraph (3). 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 6(1), and, second, the time needed by Offices to provide copies of earlier applications.

R.15.04 Paragraph (4). This paragraph seems to be self-explanatory.

Note on Rule 16

(Request for Recordal of Change in Name or Address)

R16.01 Rule 16 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, for example, a change in the name of a company or a change of name on marriage. Where there is a change in the person of the applicant or owner, Rule 17 would apply.

R16.02 Paragraph (1), chapeau. 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).

R16.03 Item (i). As regards the indication to be provided where the application number has not been issued, or is not known, the provisions of Rule 20 apply under paragraph (6).

R16.04 Item (ii). This item would seem to be self-explanatory.

R16.05 Item (iii). 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 paragraph (7), or that the change concerned be recorded beforehand or be included in the request.

R16.06 Paragraph (2)(a). This provision would permit a Contracting Party to require that the request for recordal of change be presented on a request Form, as is normally the case at present, and/or to require that the request be presented in a required format.

R16.07 Paragraph (2)(b). This provision would require all Offices to accept the filing of requests on paper, where presented on the Model International Form or Model International Format provided for under Rule 21(1).

R16.08 Paragraph (3). Reference is made to the explanations under Article 5(3) (see Note 5.10). 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 16(10), a Contracting Party would be permitted to refuse the request.

R16.09 Paragraph (4). The amount of the fee could differ depending on the number of the patents or applications involved (see Note R16.10). Reference is also made to the explanations under Article 5(4) (see, in particular, Note 5.11).

R16.10 Paragraph (5). 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 R16.09).

R16.11 Paragraph (6). The manner of identifying an application whose application number is not known is prescribed in Rule 20. The form of evidence to be furnished under this paragraph would be at the option of the requesting party.

R16.12 Paragraph (7). 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 5 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(6) (see Note 5.18).

R16.13 Paragraph (8) establishes the exhaustive character of the list of requirements under paragraphs (1) to (7). 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.

R16.14 Paragraphs (9) and (10). The prohibition of a more severe sanction would exclude the possibility of, for example, revocation of the patent for failure to comply with the requirements of this Rule. Reference is also made to the explanations given under Article 7(5) and (6) (see Notes 7.13 and 7.14).

R16.15 Paragraph (11). As regards a change in the name or address of the representative, due to the *mutatis mutandis* effect of Rule 16(1), this provision applies only where there is no change in the person of the representative (see Note R16.01). 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 referred to in paragraph (2)(b).

Note on Rule 17

(Request for Recordal of Change in Applicant or Owner)

R17.01 Rule 17 standardizes the procedure concerning requests for recordal of a change in the person of applicant and owner, 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, Rule 16 would apply. It is to be noted that this Rule 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.

R17.02 Paragraph (1)(a), chapeau. Reference is made to the explanation under Rule 16(1), chapeau (see Note R16.02).

R17.03 Item (i). This item would seem to be self-explanatory.

R17.04 Item (ii). Reference is made to the explanations given under Article 6(3) and Rule 16(1)(i) (see Note R16.03).

R17.05 Items (iii) to (vi). These items would seem to be self-explanatory.

R17.06 Item (vii). 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.

R17.07 Paragraph (1)(b), item (i). This item would seem to be self-explanatory.

R17.08 Item (ii). [*This item which has been introduced at the request of the Delegation of the United States of America, is placed in square brackets for consideration by the Standing Committee.*]

R17.09 Paragraph (2). Reference is made to the explanations given under Rule 16(2) (see Notes R16.06 and R16.07).

R17.10 Paragraph (3)(a). This paragraph is subject to a reservation by the Delegation of Spain. It 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 adopted within square brackets by the Standing Committee, in the absence of any agreement at the first session, second part, 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.

R17.11 The alternatives at the option of the “requesting party” and at the option of the “Contracting Party” are also adopted within square brackets by the Standing Committee, in the absence of any agreement as to whether the Contracting Party should be permitted to specify the documentation required, or whether the requesting party should, in particular, always have the option of furnishing an uncertified certificate of transfer of ownership under item (iii).

R17.12 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.

R17.13 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 (3)(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.

R17.14 While a Contracting Party would be free to require that a copy or extract of the contract filed under item (i) or (ii) 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.

R17.15 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. Rule 21(1)(a)(iv) provides for a Model International Form for a certificate of transfer.

R17.16 Paragraph (3)(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 R17.14).

R17.17 Paragraph (3)(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.

R17.18 Paragraph (3)(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. In particular, it would be a matter for the Contracting Party to determine what would constitute consent to the change, including whether a copy of a prior agreement of joint applicants or owners to the sale of a share would constitute sufficient evidence under this provision, and whether the communication containing the consent should be signed.

R17.19 Paragraphs (4) to (7). Reference is made to the explanations given under Rule 16(3) to (6) (see Notes R16.08 to R16.11).

R17.20 Paragraph (8). 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 Rule 16(7) (see Note R16.12).

R17.21 Paragraph (9). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (8) 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 or fiscal nature, for example, in situations concerning inheritance, bankruptcy or tutelage.

R17.22 Paragraph (10). Reference is made to the explanations under Rule 16(9) and (10) (see Notes R16.14).

R17.23 Paragraph (11). This paragraph would permit, but not oblige, any Contracting Party, in particular, a Contracting Party which requires that a patent be applied for in the name of the actual inventor, to exclude the provisions of Rule 17 in respect of changes in inventorship. The manner in which a Contracting Party may exclude the application of this Rule will be

regulated in the administrative and final provisions of the Treaty. The second sentence is for the avoidance of doubt.

Note on Rule 18

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

R18.01 Paragraph (1)(a), chapeau. 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. In accordance with Article 1(vii), the term “recordal” means recordal in the records of the Office.

R18.02 Item (i). This item would seem to be self-explanatory.

R18.03 Item (ii). Reference is made to the explanation given under Rule 16(1)(i) (see Note R16.03).

R18.04 Items (iii) and (iv). These items would seem to be self-explanatory.

R18.05 Paragraph (1)(b). Reference is made to the explanations given under Rule 17(1)(b) (see Notes R17.07 and R17.08).

R18.06 Paragraph (2). Reference is made to the explanations given under Rule 16(2) (see Notes R16.06 and R16.07).

R18.07 Paragraph (3)(a). The considerations which apply to documentation which may be required under this provision are essentially the same as those which apply under Rule 17(3)(a) (see Notes R17.10 to R17.15).

R18.08 Paragraph (3)(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. Reference is also made to the explanations under Rule 17(3)(d) (see Note R17.18).

R18.09 Paragraphs (4) to (7). Reference is made to the explanations given under Rule 16(3) to (6) (see Notes R16.08 to R16.11).

R18.10 Paragraphs (8) and (9). Reference is made to the explanations given under Rule 17(8) and (9) (see Notes R17.20 and R17.21).

R18.11 Paragraph (10). Reference is made to the explanations given under Rule 16(9) and (10) (see Note R16.14).

R18.12 Paragraph (11). 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 Rule 19
(Request for Correction of a Mistake)

R19.01 Rule 19 regulates the formal requirements and procedures concerning the request for correction of a mistake. 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. Furthermore, it does not regulate corrections by way of re-issue procedure which are not regulated by the Treaty (see Note 2.04).

R19.02 Paragraph (1)(a), chapeau. 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. As regards the terms “applicant” and “owner,” reference is made to the explanations given under Article 1(viii) and (ix) (see Notes 1.07 and 1.08).

R19.03 Item (i). This item would seem to be self-explanatory.

R19.04 Item (ii). Reference is made to the explanations given under Rule 16(1)(i) (see Note R16.03).

R19.05 Items (iii) to (v). These items seem to be self-explanatory.

R19.06 Paragraph (1)(b). This provision allows a Contracting Party to require that a replacement part, in particular a replacement page in the case of an application filed on paper, be submitted. In the case where the request applies to more than one application and/or patent, an Office may require that a separate replacement part be submitted for each application and patent, to facilitate the work of the Office.

R19.07 Paragraph (1)(c). 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 6(1)(b), a representative could submit the declaration on behalf of the requesting party.

R19.08 Paragraph (1)(d). 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.

R19.09 Paragraph (2). Reference is made to the explanations under Rule 16(2) (see Notes R16.06 and R16.07).

R19.10 Paragraphs (3) to (6). Reference is made to the explanations under Rule 16(3) to (6) (see Notes R16.08 to R16.11).

R19.11 Paragraph (7). 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)(c), 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)(d) (see also Notes R19.07 and R19.08). Reference is also made to the explanations given under Rule 16(7) (see Note R16.12).

R19.12 Paragraph (8). Reference is made to the explanations given under Rule 16(8) (see Note R16.13) As regards the restriction to formal requirements, reference is made to the explanation in Note R19.01.

R19.13 Paragraph (9). This provision seems to be self-explanatory.

R19.14 Paragraph (10). Reference is made to the explanations given under Rule 16(9) and (10) (see Note R16.14).

R19.15 Paragraph (11). 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 changes 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 Rule will be regulated in the administrative and final provisions of the Treaty.

Note on Rule 20
(Manner of Identification of an Application
Without Its Application Number)

R20.01 This paragraph is subject to a reservation by the Delegation of China.

R20.02 Paragraph (1). This paragraph deals with the indications and elements which a person communicating with an Office must furnish to identify an application, where the number of that application is not known (see Rules 16(6), 17(7), 18(7) and 19(6)). This paragraph does not prohibit a Contracting Party from allowing an applicant to give less information than that prescribed in items (i) to (iii) or from accepting other means of identification.

R20.03 Paragraph (2). This paragraph seems to be self-explanatory.

Note on Rule 21
(Establishment of Model International Forms and Formats)

R21.01 *The procedure for establishing Model International Forms proposed under this Rule would avoid the need to include those Forms in the Regulations presented to the Diplomatic Conference.*

R21.02 In the absence of any provision for prescribed formats under the PCT, no provision is included at this stage for a Model International Format in respect of any procedure.

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