

# WIPO



SCP/2/7

ORIGINAL: English

DATE: March 11, 1999

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

E

## STANDING COMMITTEE ON THE LAW OF PATENTS

### Second Session

Geneva, April 12 to 23, 1999

#### SUMMARY OF RECOMMENDATIONS OF THE STUDY REGARDING THE INTERFACE BETWEEN THE DRAFT PATENT LAW TREATY AND THE PATENT COOPERATION TREATY

*prepared by the International Bureau*

#### Introduction

1. During the first session, second part of the Standing Committee on the Law of Patents (SCP), held in Geneva from November 16 to 20, 1998, the Standing Committee emphasized the importance of the interface of the Patent Cooperation Treaty (PCT) and the draft Patent Law Treaty (PLT). In order to avoid unforeseen problems and difficulties, the International Bureau suggested that it should conduct a detailed study regarding the interface between the draft PLT and the PCT. The Standing Committee supported this initiative of the International Bureau and further requested that this opportunity be taken to consider, in the light of the PCT experience, which matters under the draft PLT might be better dealt with in the Regulations.

In accordance with the conclusions by the Standing Committee, a study was prepared, at the request of the International Bureau, by Mr. Leslie Lewis, Consultant, and Mr. Busso Bartels, PCT Advisor. The present document is a summary of recommendations for modifications of Articles and Rules of the draft PLT contained in the study, as well as a list of

the provisions of the PCT which are considered to be incorporated by reference under Article 5(1) of the PLT. The full study will be circulated separately as an informal document.

### Summary of Recommendations for Modifications of Articles and Rules of the draft PLT

2. The following is a summary of recommendations contained in the study. Specific drafting recommendations are included in the Annexes to the Study. Amendments to be made consequential to other amendments are not mentioned here.

(a) To modify the Articles in the following ways:

(i) Article 1(v). Add the words “document, correspondence” to the definition of “communication”;

(ii) Article 2(1)(b)(ii). Change the date to “the date on which processing or examination of the international application may start under [PCT] Article 23 or 40”;

(iii) Article 2(1) and (2). Add references to “applications for patents of addition” and “patents of addition”, respectively, to include patents of addition within the scope of the Treaty (see Study paragraph 2.06);

(iv) Article 4(3) and (4)(b). Provide for the applicant to be given an opportunity to comply with requirements and to make observations, and to be notified where the application is regarded as not having been filed (see Study paragraphs 4.09 and 4.11);

(v) Article 4(7). Provide for special filing date requirements in the case of additional types of applications to be prescribed in the Regulations (see paragraph 4.18);

(vi) Article 5(1). Provide for exceptions prescribed in the Regulations to requirements relating to the form and contents of the application (see paragraph 5.03);

(vii) Article 5(6). Make this paragraph applicable to the translation of any part of the application, and not only priority documents (see paragraphs 5.06 and 5.11);

(viii) Article 7(3). Add requirements relating to indications of the application or patent number to which the communication relates and of the reference number of an “other interested person” (see paragraphs 7.07 to 7.08 and (c) below);

(ix) Article 7. Add a new requirement in respect of the language of communications (see paragraph 7.13), and delete the corresponding requirements in respect of the language of the request in:

- Article 5(3), and substitute an express requirement in respect of translations and transliterations (see paragraphs 5.05 and 5.06);
- Article 10(3) (see paragraph 10.03);
- Article 11(4) (see paragraph 11.04).
- Article 12(4) (see paragraph 12.02);
- Article 13(5) (see paragraph 13.06);

- Rule 16 (3) (see paragraph R16.04);
- Rule 17(4) (see paragraph R17.02);
- Rule 18(4) (see paragraph R18.02);
- Rule 19 (3) (see paragraph R19.06);

(x) Article 13(1). Delete this paragraph on the grounds that requirements relating to the addition of a priority claim are requirements relating to the form and contents of the application under Article 5(1) (see paragraph 13.01).

(b) To modify the text of the following Articles and Rules to avoid the use of the phrase "*mutatis mutandis*":

- (i) Article 10(4) (see paragraph 10.04);
- (ii) Article 12(5) (see paragraph 12.02);
- (iii) Article 13(6) (see paragraph 13.07);
- (iv) Rule 16(4) (see paragraph R16.05);
- (v) Rule 17(5) (see paragraph R17.02);
- (vi) Rule 18(5) (see paragraph R18.02).

(c) To transfer provisions from the following Articles to the Regulations:

(i) Article 4(5). Specific requirements in respect of a missing part of the description or drawings (see paragraph 4.16);

(ii) Article 5(5). Specific requirements in respect of priority documents (see paragraph 5.10);

(iii) Article 6(3) to (6). Specific requirements in respect of the appointment of representatives (see paragraphs 6.05 to 6.09);

(iv) Article 7(3). Specific indications that may be required in a communication (see paragraph 7.09);

(v) Article 7(6)(b). Specific sanctions in respect of the non-compliance with requirements relating to the appointment of a representative (see paragraph 7.12);

(vi) Article 8. The entire Article (see paragraph 8.04);

(vii) Article 11(1), (3), (5) and (6). Specific requirements in respect of the signature of the request, the use of a prescribed request Form or format, fees, and evidence (see paragraphs 11.03, 11.05 and 11.06);

(viii) Article 12(1), (3) and (6). Specific requirements in respect of the signature of the request, the statement of grounds in the request, the use of a prescribed request Form or format, and evidence (see paragraphs 12.02 and 12.03);

(ix) Article 13(2) to (4). Specific requirements in respect of requests, including the use of a prescribed request Form or format (see paragraphs 13.02 to 13.04).

(d) To modify the Regulations in the following ways:

(i) Rule 3. Delete this Rule and provide for permitted modifications of the request Form and format to be established by the Assembly under Rule 21 (see paragraph R3.01);

(ii) Rule 6(1). Transfer to Rule 4 the time limit for furnishing a copy of a priority document (see paragraphs 5.10 and R6.02);

(iii) Rule 9(2). Delete the requirement for the date of signature (see paragraph R9.03);

(iv) Rule 15(1). Transfer to Rule 6(2)(c) the time limit for the addition of a priority claim (see paragraphs 13.01 and R15.01);

(v) Rule 19. Combine paragraphs (4) and (9) (see paragraph R19.07).

List of Provisions of the PCT which are considered to be Incorporated by Reference under Article 5(1) of the PLT

3. In the opinion of the authors of the Study, Article 5(1) incorporates by reference the following provisions of the PCT to the extent that they relate to the form and contents of the application. A commentary on this list may be found in Annex 2 of the Study:

(a) the contents of the application under PCT Article 3(2);

(b) the physical requirements under PCT Article 3(4)(ii) and Rule 11 (other than Rule 11.9(e));

(c) the contents of the request under PCT Article 4, Rules 3.3, 4.1 to 4.8, 4.9(a)(ii), 4.11, [4.13], 4.14, 4.15 and 4.17(a) and Section 203 of the Administrative Instructions;

(d) claiming priority under PCT Article 8 and Rules 4.10 and *26bis*;

(e) furnishing the application, a translation thereof, and any document relating thereto, in more than one copy under PCT Rule *51bis.1(c)*;

(f) unity of invention under Article 3(4)(iii), Rule 13, and Section 206 of the Administrative Instructions;

(g) the contents and form of the abstract under PCT Rule 8;

(h) expressions not to be used under PCT Rule 9;

- (i) terminology and signs under PCT Rule 10;
- (j) inventions relating to biological material under PCT Rule 13*bis*, and Section 209 of the Administrative Instructions;
- (k) nucleotide and/or amino acid sequence listings under PCT Rule 13*ter*, and Section 208 of the Administrative Instructions.

4. As regards the following provisions of the PCT, the authors of the Study raise the question whether, or the extent to which, they relate to the form and contents of the application, and whether they should therefore be considered as incorporated by reference under Article 5(1) of the PLT:

- (a) the description under Article 5, Rule 5, and Section 204 of the Administrative Instructions;
- (b) the claims under Article 6, Rule 6, and Section 205 of the Administrative Instructions;
- (c) the drawings under Article 7, Rule 7, and Section 207 of the Administrative Instructions.

[End of document]