

# WIPO



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## STANDING COMMITTEE ON THE LAW OF PATENTS

Second Session  
Geneva, April 12 to 23, 1999

DRAFT ARTICLES 10 TO 12  
AND DRAFT RULES 12 TO 14

*Proposal by the Delegation of the United States of America*

1. The following proposal was submitted by the Delegation of the United States of America:

*Article 10*

*Extension of a Time Limit Fixed by the Office*

(1) [*Request*] Where an applicant or owner requests an extension of a time limit fixed by the Office for an action in a procedure before the Office as prescribed in the Regulations, in

a communication received by the Office prior to the expiration of that time limit, such time limit shall be extended, ~~subject to paragraph (2),~~ by a period prescribed in the Regulations.

~~(2) [Exceptions] [Moved to Rule 12(2)(b).]~~

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

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

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

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

### Article 11

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

(1) [Request] Where an applicant [or owner] has failed to comply with a time limit fixed by the Office, that is less than a time limit fixed by national law or for which no time limit is fixed by national law, for an action in a procedure before the Office, the Office shall, consider that time limit to have been complied with and, if necessary, ~~re-instate the rights of the applicant [or owner] with respect to the application [or patent] concerned,~~ if:

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

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

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

(3) [*Request Form or Format*] A Contracting Party may require that the request referred to in paragraph (1) be presented on a Form or in a format prescribed by that Contracting Party.

(4) [*Language*] Article 5(3) shall apply, *mutatis mutandis*, to requests for continued processing ~~and re-instatement of rights~~ without a finding of due care by the Office.

(5) [*Fees*] ~~(a)~~ Article 5(4) shall apply, *mutatis mutandis*, to requests for continued processing ~~and re-instatement of rights~~ without a finding of due care by the Office.

~~(b) Notwithstanding subparagraph (a), no Contracting Party may require the payment of a fee where the non-compliance with the time limit for action before the Office referred to in paragraph (1) occurred:~~

~~(i) as a result of the loss of a communication by a postal service or another delivery service specified by the Contracting Party;~~

~~(ii) as a result of a failure by the Office.~~

(6) [*Evidence*] A Contracting Party which requires a statement prescribed in the Regulation may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of that statement.

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

## *Article 12*

### *Re-instatement of Rights After a Finding of Due Care or Unintentionality by the Office*

(1) [*Request*] Where an applicant or owner has failed to comply with a time limit fixed by national law or for which processing under Articles 10 and 11 has been exhausted for an action in a procedure before the Office, the Office shall re-instate the rights of the applicant or owner with respect to the application or patent, if:

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

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

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

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

(v) the Office finds that the delay in complying ~~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, that the delay was unintentional.

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

(3) [*Request Form or Format*] Article 11(3) shall apply, *mutatis mutandis*, to requests for re-instatement of rights after a finding of due care or unintentionality by the Office.

(4) [*Language*] Article 5(3) shall apply, *mutatis mutandis*, to requests for re-instatement of rights after a finding of due care or unintentionality by the Office.

(5) [*Fees*] Article 5(4) shall apply, *mutatis mutandis*, to requests for re-instatement of rights after a finding of due care or unintentionality by the Office.

(6) [*Evidence*] A Contracting Party may require that a declaration or other evidence in support of the grounds referred to in paragraph (1)(iv) be furnished to the Office within a time limit fixed by the Office.

(7) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraph (1) may not be refused, totally or in part, without the requesting party being given at

least one opportunity to make observations on the intended refusal within a reasonable time limit.

*Rule 12*

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

~~(12)~~ [*Period Under Article (10)(1)*] (a) The period referred to in Article 10(1) shall be not less than two months.

(b) Where a time limit is extended under Article 10(1), the extended time limit shall be calculated from the same date as the date from which the time limit fixed by the Office referred to in that Article was calculated.

~~(12)~~ [Circumstances for which extensions under Article 10(1) are available *Exceptions Under Article 10(2)*] (a) Extensions under Article 10(2) shall be available for: ~~No Contracting Party shall be required under Article 10(1) to grant:~~

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

~~(ii) an extension of a time limit for the payment of maintenance fees;~~

~~(iii) an extension of a time limit for making a request under Articles 10(1), 11(1) or 12(1);~~

~~(iv) an extension of a time limit referred to in Article 13(1), (2) or (3)(a);~~

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

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

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

{(~~iv~~) an extension of a time limit for an action in a procedure before the Office in respect of which extensions are not available under Article 11. ~~an extension of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted.~~}

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under Article 10 ~~13~~(1) to extend a time limit for an action in a procedure before the Office in respect of any of those requirements beyond that maximum time limit.

### *Rule 13*

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

(1) [*Time Limit Under Article 11(1)*] The time limit for making a request, and for complying with the requirements, under Article 11(1), shall be not less than two months from the date on which the applicant [or owner] was notified by the Office of the failure to comply with the time limit concerned.

(2) [*Statement*] Any Contracting Party may require that a request under Article 11(1) which is filed later than two months from the date of the expiration of the time limit for the action referred to in that paragraph be accompanied by a statement that the failure to comply with the time limit was unintentional.

(3) [*Exceptions Under Article 11(2)*] (a) No Contracting Party shall be required to consider the time limit to have been complied with, ~~or to re-instate the rights of the applicant for owner~~ with respect to the application [or patent] under Article 11(1) where the applicant [or owner] fails to comply with a time limit:

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

(ii) for the payment of maintenance fees;

(iii) for making a request under Article 10(1), 11(1) or 12(1);

~~(iv) for which an extension has already been granted under Article 10;~~

(iv) referred to in Article 13(1), (2) or (3)(a);

(v) for filing a request for search or examination;

(vi) for filing a translation of a regional patent[;];

(vii) for an action in proceedings in respect of an opposition to the grant of a patent;

(ix) for an action in interference proceedings;



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

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under Article 11(1) to consider the time limit to have been complied with, ~~or to re-instate the rights of the applicant~~ with respect to the application after the expiration of that maximum time limit or to consider the time limit to have been complied with, with respect to the application after a time limit fixed by a national law has expired.

#### *Rule 14*

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

(1) [*Time Limit Under Article 12(1)(ii)*] The time limits for making a request, and for complying with the requirements, under Article 12(1)(ii), shall be the shorter of the following:

(i) not less than two months from the date of the removal of the cause of the failure to comply with the time limit for the action in question;

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

(2) [*Exceptions Under Article 12(2)*] No Contracting Party shall be required to consider the time limit to have been complied with, or to re-instate the rights of the applicant or owner with respect to the application or patent under Article 12(1) where the applicant or owner fails to comply with a time limit:

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

~~(ii) for the payment of maintenance fees;~~

(iii) for making a request under Article 10(1), 11(1) or 12(1);

(iv) referred to in Article 13(1), (2) or (3)(a);

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

~~(vi) for filing a translation of a regional patent[;~~

(vii) for an action by third parties in proceedings in respect of an opposition to the grant of a patent;

~~(viii) for an action in interference proceedings;~~

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

[End of document]