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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/3/2.
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 Office 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, even if patents are granted on its behalf by another Office, for example, a regional office.

1.02 Items (ii) and (iii). These items seem to be 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 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.

1.05 Item (vi). Information referred to under this item 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) to (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 contacts 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 Patent Cooperation Treaty (PCT) itself, the Regulations under the PCT or the Administrative Instructions under the PCT.

1.16 Item (xviii). Provisions on eligibility for becoming party to the Treaty are contained in Article 19.

1.17 Items (xix) to (xxi). These items seem to be self-explanatory.

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.

2.02 The expression “for the Office of a Contracting Party” covers, in particular, situations in which an application for a regional patent is filed with the Office of a State (X), which is a Contracting State of a regional Organisation, for onward transmission to the regional Office. However, a regional application which designates State X is not an application filed for the Office of State X. Accordingly, where, for example, both the European Patent Organisation and State X 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.

2.03 The terms “applications for patents for invention, and applications for patents of addition,” are to be construed in the same sense as these terms 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, 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 plants which are the result of genetic engineering.

2.04 Item (i). The types of applications for patents for invention and for patents of addition which may be filed as international applications under the PCT are “conventional applications,” in respect of which no special treatment is requested. However, in respect of applications for continuation or continuation-in-part of an earlier application, 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.

2.05 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 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.

2.06 The Treaty also does not govern applications for patent term extensions, for example, in respect of patents for pharmaceutical products under Japanese and European 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 Item (ii). Reference is made to the provisions relating to divisional applications under Article 4(8) and Rule 2(6) (see Notes 4.27, 4.28 and R2.12).

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, Article[s 10 to] 12 and Rule[s 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 under PCT Articles 23 or 40.

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 2.02 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 terms “patents for invention” and “patents of addition” are to be construed in the same sense as those expressions 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 and patents of addition, namely, inventor’s certificates, utility certificates, utility models, certificates of addition, inventor’s certificates of addition, and utility certificates of addition (see also Note 2.03). 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 paragraphs (1)(b) and (2) that the Treaty and Regulations would apply to patents for inventions and patents of addition granted on international applications.

2.13 Although they do not apply to those types of applications which cannot be filed as international applications under the PCT, such as provisional applications, applications for re-issue patents and applications for conversion (see Note 2.05), 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 prescribes the requirements for according a filing date to an application. A Contracting Party would therefore be obliged to accord a filing date to an application which

complies with the requirements applicable under Article 4. 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 may not be revoked for failure to comply with a requirement under Article 5 within the time limit prescribed in Rule 6(2), even though the application may be refused on such grounds under Article 5(8)(a). *Article 4 is subject to a reservation by the Delegation of Portugal.*

4.02 Paragraph (1). This paragraph prescribes the elements of an application to be filed 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(1), 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). *This paragraph is subject to a reservation by the Delegation of Spain.*

4.03 The wording “date on which its Office has received all of the following elements” covers both the case in which all of the required elements are received on the same day and the case in which they are received on different days. Where an applicant initially fails to comply with all the required filing date requirements, but subsequently complies with those requirements, the question of whether the application should be granted a filing date and, if so, what that filing date should be, would be regulated under paragraph (4) and Rule 2(1) (see also Note 4.20).

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 5(2) or 7(1) referred to above, the Office could require that a replacement copy of the application complying with that requirement be furnished, within the time limits prescribed in Rule 6(1) or 11(1), in accordance with Article 5(7) or 7(7), respectively. The failure to furnish a replacement copy within that time limits would not result in the subsequent loss of the filing date even if the application were refused under Articles 5(8)(a) and 7(8). 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 Without the text in square brackets, “no later than,” the filing date would, subject to the provisions of paragraphs (2) to (8), be the date on which the Office has received all of the three elements under items (i) to (iii). If the text in square brackets were included, a Contracting Party would be obliged, subject to the provisions of paragraphs (2) to (8), to accord a filing date which is no later than the date on which it has received all of the elements under items (i) to (iii). However, it would be free to accord any earlier filing date. That is, an application could be accorded, as the filing date, a date on which one or more of items (i) to (iii) had not been received. *Paragraph (1)(a) is subject to a reservation by the Delegation of Belgium.*

4.08 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. Whether, in a particular case, the 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).

4.09 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), within the time limit prescribed in Rule 6(1). 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 was refused under Article 5(8)(a).

4.10 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 questions of question that part satisfies requirements relating to the description allowed under Article 5(1), or the substantive requirements for the grant of a patent, are not relevant to this determination.

4.11 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 in place of a written description. The question 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).

4.12 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.

4.13 Paragraph (2). *This paragraph is subject to a reservation by the Delegation of Spain.*

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

4.15 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 could be required under Article 5(3), within the time limit prescribed in Rule 6(1). 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).

4.16 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).

4.17 Where the application as filed contains claims which are in a language not accepted by the Office, a Contracting Party could require that a translation of those claims be filed under Article 5(3) and (7) (see also Note 5.13). 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).

4.18 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 filed, 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 8.02 and 8.03).

4.19 Paragraph (4)(a). This provision provides the applicant with the option of correcting 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 or pay additional filing fees. 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 4.20).

4.20 Paragraph (4)(b). This provision provides that, 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 prescribed in Rule 2(1), 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 8.04).

4.21 Paragraph (5). This provision, which is modeled after PCT Article 14(2), obliges the Office to notify the applicant where, in establishing the filing date, it finds that a part of the description or a drawing appears to be missing. As it is restricted to the situation where the determination is made in establishing the filing date, this provision does not apply where that determination is made in any other procedure, in particular, in the course of substantive examination, when the procedures under paragraph (6)(a) to (c) would not be appropriate. It also does not require the Office to check whether a part of the description or drawing is missing. Reference is also made to the general provisions concerning notifications under Article 8.

4.22 Paragraph (6)(a). This provision obliges a Contracting Party to include, in the application, a missing part of the description or a missing drawing that is filed within the time limit prescribed in Rule 2(3). It applies whether or not the applicant has been notified under paragraph (5). If the text in square brackets were not included, the filing date would, subject to subparagraphs (b) and (c), be the date of receipt of the missing part of the description or missing drawings except where all of the requirements for the accordal of a filing date under paragraphs (1) and (2) were not complied with on that date. If the text in square brackets were included, a Contracting Party would be permitted, but not obliged, to accord a filing date which is earlier than the date of receipt of the missing part of the description or missing drawing, in particular, where it determines that the missing part or drawing does not contain new matter.

4.23 Paragraph (6)(b). This provision would oblige a Contracting Party to include a missing part of the description or missing drawing in the application without loss of the filing date, where that missing part or drawing is contained in an earlier application and the requirements prescribed in Rule 2(4) are complied with (see Notes R2.03 to R2.07).

4.24 Paragraph (6)(c). This provision would permit the applicant to withdraw a later furnished missing part of the description or missing drawing in order to avoid the date of receipt of that part or that drawing being accorded as the filing date under subparagraph (a).

4.25 Paragraph (7). This paragraph 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. Reference is also made to Notes R2.09 and R2.10. *This paragraph is subject to a reservation by the Delegation of China.*

4.26 Subparagraph (a). The requirements prescribed under this provision in Rule 2(5) 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(5). 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(1) 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 (8), item (i). This item seems to be self-explanatory.

4.29 Item (ii). The types of application prescribed in Rule 2(6) under this item are a divisional application and an application for a continuation or continuation-in-part (see Note R2.12).

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 of America 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 a reservation as regards the applicability of the requirements of PCT Rule 13 (Unity of Invention) under this paragraph is included in Article 22(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, 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). 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 the mandatory contents of the request in a modified PCT request Form. This would enable an applicant to file applications for the same invention in the Offices of different Contracting Parties using the same request Form. The modifications which are permitted in order to adapt the PCT request Form into a national or regional request Form are to be established by the Assembly under Article 14(1)(c) and Rule 21(1)(b) and (c)(ii).

5.10 The effect of the phrase “and subject to Article 7(1)” is that if Rule 8(1) under that Article is amended to allow a Contracting Party not to permit the filing of communications on paper, that Contracting Party would still be obliged, under Article 4(1), to accept the indications required under items (i) and (ii) of that Article if they are filed on paper in a request Form. However, the Contracting Party could require, under Article 7(7) and (8), that, for the

application to proceed, the applicant re-file the contents of that request Form in accordance with the requirements applied by that Contracting Party under Article 7(1).

5.11 Paragraph (2)(c). This provision would oblige a Contracting Party to accept the filing of the mandatory contents of the request in a format that corresponds to the Model International Request Format established by the Assembly under Article 14(1)(c) and Rule 21(2). As regards the term “format”, reference is made to Note 7.02.

5.12 The effect of the phrase “and subject to Article 7(1)” is that a Contracting Party which, as permitted under Article 7(1)(b), does not accept the filing of communications other than on paper (in particular, filing in electronic form or by electronic means) would not be obliged to accept the filing of a request in an International Request Format other than on paper. As regards a Contracting Party that does not permit the filing of communications on paper, reference is made to the explanation of that phrase under paragraph (2)(b) (see Note 5.10).

5.13 Paragraph (3). This paragraph would permit a Contracting Party to require, after the filing date, the filing of a translation of the “part which on the face of its appears to be a description” referred to in Article 4(1)(iii), where that part is not in a language accepted by the Office (as permitted for the purposes of the filing date under Article 4(2)(b)). It would also permit a Contracting Party to require that the applicant file a translation of the other parts of the application that are not in an accepted language, or a transliteration of, for example, a name or address which is not in an accepted alphabet. As regards the term “translation,” reference is made to the definition in Article 1(xiii).

5.14 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 require, for example, in the case of applications filed electronically, that fees be paid 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 Rule 3.3(a)(ii).

5.15 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 an “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).

5.16 Paragraph (5). Regulations under this paragraph are prescribed in Rule 4. 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.

5.17 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. 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 5.16.

5.18 Paragraph (7). The time limit under this paragraph is prescribed in Rule 6(1). Reference is also made to the provisions on notification under Articles 7(7) (see Note 7.17) and 8(1) and (2) (see Notes 8.02 and 8.03).

5.19 Paragraph (8). The time limits under this provision are prescribed in Rule 6(2). *This paragraph is subject to a reservation by the Delegation of Egypt.*

5.20 Paragraph (8)(a). Except in the situations under paragraph (8)(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(8) (see Note 7.18).

5.21 Paragraph (8)(b). In accordance with Article 4D(4) of the Paris Convention, the consequences of failure to comply with the formality requirements in respect of a priority claim within the time limit prescribed under Rule 6(2) is generally the loss of the priority right. However, where the description and drawings of a later application are replaced by a reference to a previously filed application under Article 4(7)(a), and the requirements under that Article, as prescribed in Rule 2(5), are not complied with within the time limit applicable under that Rule, the Contracting Party may refuse that later application under Article 4(7)(b), even though the same requirements are applicable in respect of a priority claim in respect of the same earlier application.

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 on a territory 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 be on its own territory. It could also require that the address be on any of two or more territories, for example, a Contracting Party that is a Member of a regional grouping, such as the European Union, could require that the address be on the territory of any Member State of that regional grouping. This item is without prejudice to the right of a Contracting Party to require an address for correspondence and/or legal service on its own territory under Article 7(6) and Rule 10(2) and (4).

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. The situation is the same where an owner or other interested person is represented. For example, where a communication is required to be signed by the applicant, the communication could be signed by the representative on behalf of the applicant. Where the Office is required to notify an applicant under Article 4(3) or 5(7), the notification would normally be sent to the applicant’s representative. However, a Contracting Party may provide that correspondence be sent to the person who is represented, where that person provides his own address as the address for correspondence and/or legal service under Article 7(6).

6.06 Paragraph (1)(c). This provision seems to be self-explanatory.

6.07 Paragraph (2). This paragraph 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 (vi).

6.08 The effect of the exceptions would be that an applicant, owner or other interested person would be permitted to represent himself before the Office in respect of any of the procedures included in items (i) to (vi). This would be of particular benefit for a private person or a small enterprise who wishes to file an application or pay maintenance fees, in his or its own country without the services of a representative. Although an applicant would also be permitted to file an application or translation, and an owner would be permitted to pay maintenance fees, in a

foreign country without representation, that applicant or owner could nevertheless be required, under Article 7(6) and Rule 10(2), to provide an address for correspondence and/or legal service in that country.

6.09 Items (i) to (vi) would not prevent an applicant, owner or other interested person from appointing a representative for any of the procedures concerned. However, such a representative would have to comply with the requirements applicable under paragraph (1). In particular, it would not be permissible for an applicant to appoint a representative from his own country to represent him in a foreign country, unless that representative was entitled to practice in that foreign country, which would not normally be the case.

6.10 Paragraph (2) 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. This limitation 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 example, for the filing of claims or a translation 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(6) (see Notes 1.07 to 1.09, 1.13 and 7.14). *This paragraph is subject to reservations by the Delegations of Belgium, China, Cuba, Ireland, Japan, Kenya, Portugal, Tunisia and Zimbabwe.*

6.11 Item (i). This item seems to be self-explanatory.

6.12 Item (ii). This item would permit an applicant to undertake, without representation, any procedure in respect of the filing date under Article 4, after the filing date. Such procedures are, in particular, those in respect of a missing part of the description or missing drawing under Article 4(6), and compliance with the requirements applicable under Article 4(7) where the description and drawings are replaced by a reference to a previously filed application.

6.13 Items (iii) and (iv). These items seem to be self-explanatory.

6.14 Item (v). This item would provide for further procedures, in respect of which the appointment of a representative may not be required, to be prescribed in the Regulations. The Regulations under this item are prescribed in Rule 7(1).

6.15 Item (vi). The requirement to appoint a representative is expressly excluded for the issue of a receipt or a notification by the Office in respect of any of the procedures referred to in items (i) to (v), 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 required to be represented for the purposes of the issuing of a receipt or notification in respect of such procedures.

6.16. Paragraph (3). The Regulations under this paragraph are prescribed in Rule 7(2) to (5).

6.17 Paragraph (4). This paragraph establishes the exhaustive character of the list of formal requirements permitted under paragraphs (1) to (3) with respect to the matter of representation.

6.18 Paragraph (5). The time limit under this paragraph is prescribed under Rule 7(6). Reference is also made to the provisions on notification under Article 7(7) (see Note 7.14) and 8(1) and (2) (see Notes 8.02 and 8.03).

6.19 Where an applicant, owner or other interested person is represented, the notification under paragraph (5) 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 (6). The relevant time limit under this paragraph is prescribed under Rule 7(7). Reference is also made to the explanations under Article 7(8) (see Note 7.18).

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, document, correspondence 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 requirements 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 paper 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, initiated 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 (1)(d). This provision would ensure that the filing of communications on paper would continue to be sufficient for meeting a time limit, even if, under Rule 8(1), a

Contracting Party becomes entitled to exclude the filing of communications on paper. While applicants would not fail to meet a time limit merely as a consequence of their filing communications on paper, where a communication is filed on paper with an Office that requires electronic communications, that Office would be permitted to require the electronic conversion as a correction of formal requirements under Article 5(2) or 7(1) or (3).

7.05 Paragraph (2). This paragraph provides generally, that a Contracting Party may require that any communication be in a language accepted by the Office as defined in Article 1(xiii) (see Note 1.11). However, Article 4(2)(b) expressly provides that, for the purposes of the filing date, the part of the application which on the face of it appears to be a description may be in any language. In that case, the Office may require a translation to be filed under Article 5(3) (see also Note 5.13). The draft Treaty and Regulations also expressly provide for the filing of a translation of: (i) a copy of an earlier application (Article 5(5) and Rule 4(4)); (ii) a copy of a previously filed application under Rule 2(4); (iii) a power or attorney under Rule 7(4); and (iv) documentation of the basis of a change in applicant or owner under Rule 17(4) or of the basis of a licensing agreement under Rule 18(4).

7.06 It is also apparent that, since Article 7 prescribes the maximum requirements that a Contracting Party may apply, a Contracting Party would be permitted, but not obliged, to allow other communications to be filed in a language not accepted by the Office. In such a case, a Contracting Party may require the filing of a translation within a time limit fixed by the Office.

7.07 Paragraph (3). This paragraph would require a Contracting Party to accept communications corresponding to a Model International Form or a Model International Format. The establishment of such Forms and Formats is prescribed in Article 14(1)(c) and Rule 21. The effect of the phrase “subject to paragraph (1)(b)” is that a Contracting Party that does not accept the filing of communications other than on paper (in particular, filing in electronic form or by electronic means) would not be obliged to accept the filing of a request in an International Request Format that applies only to electronic communications. As regards a Contracting Party that does not permit the filing on paper, reference is made to the explanation under Article 5(2)(b) (see Note 5.10).

7.08 Paragraph (4). In accordance with the definition under Article 1(xi), the term “signature” means any means of self-identification (see also Note 1.10).

7.09 Paragraph (4)(a). Regulations concerning the signature of communications transmitted to the Office on paper, in electronic form or by electronic means are prescribed under Rule 9.

7.10 Paragraph (4)(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.

7.11 However, in accordance with the exceptions prescribed under Rule 9(6), a Contracting Party may require that a signature in electronic form of communications filed in electronic form or by electronic means not resulting in graphic representation be confirmed by a means for certifying such a signature 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 7.12).

7.12 Paragraph (4)(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, at the option of the applicant, owner or other interested person, by furnishing a certification). The Office would be obliged under Rule 5 to inform the applicant of the reason for its doubt.

7.13 Paragraph (5). The indications that a Contracting Party may require under this paragraph are prescribed in Rule 10(1).

7.14 Paragraph (6), 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.

7.15 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 and R10.06 to R10.08). As regards the sanction for failure to comply with the requirements under paragraph (6), reference is made to paragraph (8) (see Note 7.18).

7.16 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, an e-mail address for the purposes of electronic commerce. At present, no provision for such other address is included in the Regulations.

7.17 Paragraph (7). 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 8.02 and 8.03).

7.18 Paragraph (8). The time limit under this paragraph is prescribed under Rule 11(2). 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 that filing date, and cannot revoke the filing date for failure to comply with requirements under Article 7, even where the communication is subsequently refused under this paragraph. 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). Reference is also made to Rule 10(5).

Note on Article 8
(Notifications)

8.01 Article 8 does not regulate the means of notification, for example, by mail or registered mail, or what constitutes the date of a notification for the purposes of determining the expiration of a time limit calculated from that date. These matters are therefore left to the Contracting Party concerned.

8.02 Paragraph (1). Where both an address for correspondence and an address for legal service have been indicated under Article 7(6), the question to which of those addresses a notification should be sent would be a matter for the Contracting Party concerned. There is, at present, no other address for this purpose provided for in the Regulations.

8.03 Paragraph (2). This provision is 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.

8.05 It is also to be noted that this paragraph does not relieve the Office of any obligation under the Treaty to notify an applicant, owner or other interested person. Except where indications allowing the applicant, owner or other interested person to be contacted by the Office have not been filed, the effect of non-notification of non-compliance would be that the time limit for compliance would not start to run. If a patent were granted despite non-compliance with a requirement because the Office did not send a notification, the safeguard under Article 9(1) would apply.

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 5(7) or 7(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 the patent itself, 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 also 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 a translation of any part of the application required by Article 5(3), or evidence required under Article 5(6), had not been furnished.

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 the relevant law of the Contracting Party. 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
(Relief in Respect of the Non-Compliance With a Time Limit)

10.01 *In view of the discussions on former Articles 10 and 11 of the draft Treaty (see paragraphs 90 to 102 of document SCP/2/13) the present draft of Article 10 provides for procedures for relief in respect of the non-compliance with a time limit fixed by the Office with regard to an application or a patent, without specifying the form of relief. It is limited to the extension of time limits fixed by the Office for an action in a procedure before the Office (see Note 10.04) and is subject only to the filing of a request and the payment of a fee. Accordingly, for example, the applicant or owner concerned could not be required to state the grounds on which the request under Article 10 is based.*

10.02 Article 10 does not distinguish between extensions of time limits filed after the expiration of the unextended time limit and remedies like continued processing, which have the effect to reinstate the rights of the applicant or owner. It only obliges Contracting Parties to provide for at least one relief for applicants or owners in the case of a missed time limit, subject only to a request and the payment of a fee.

10.03 Article 10 sets the maximum standard which a Contracting Party may apply. A Contracting Party would be permitted, but not obliged, to dispense with any requirement permitted 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 this Article and associated Rule 12. Contracting Parties would remain free to provide for the grant of an extension of time limits which is requested before the expiration of the unextended time limit.

10.04 Paragraph (1). This paragraph regulates only requests for obtaining relief with respect to 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 10.05). A Contracting Party would be free to prescribe the same or other requirements, or to make no provision for relief, in respect of time limits not regulated by this paragraph.

10.05 Examples of time limits fixed by the Office for an action in a procedure before the Office may 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 (5), 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.

10.06 The conditions required for obtaining relief as referred to in paragraph (1) are the filing of a request according to the requirements prescribed in Rule 12 within a time limit for filing the request, which must, pursuant to Rule 12, expire not earlier than two months after the expiration of the unextended time limit. In addition, a fee could be required according to paragraph (3). In particular, a Contracting Party would not be permitted to require that the applicant or owner give reasons in support of the request.

10.07 Paragraph (2). This provision does not stipulate a specific form of relief which a Contracting Party would have to provide. It rather focuses on the consequences: at the option of the Contracting Party, either the time limit shall be considered to have been met or there shall be continued processing with regard to the application or patent, or reinstatement of rights, or both.

10.08 Paragraph (3). The exceptions under this paragraph are prescribed in Rule 12(3).

10.09 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 5.14).

10.10 Paragraph (5). This provision prohibits a Contracting Party from imposing requirements additional to those provided under paragraphs (1) to (4). In particular, the applicant or owner concerned could not be required to state the grounds on which the request is based or to furnish evidence to the Office. Nevertheless, a Contracting Party may impose any requirements otherwise provided for by the Treaty and the Regulations, for instance requirements with respect to communications under Article 7.

10.11 Paragraph (6). 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.

10.12 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 11

(Continued Processing and Re-Instatement of Rights Without
a Finding of Due Care by the Office)

[Reserved]

Note on Article 12

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

12.01 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).

12.02 Item (i). The Regulations under this item are prescribed in Rule 14(1).

12.03 Item (ii). The time limit under this item is prescribed in Rule 14(2).

12.04 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).

12.05 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 (4) to furnish a declaration or other evidence in support of those grounds within a time limit fixed by the Office.

12.06 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 a loss in the mail or an interruption in the mail service, as provided for under PCT Rule 82.

12.07 Paragraph (2). The exceptions under this paragraph are prescribed in Rule 14(3).

12.08 Paragraph (3). Reference is made to the explanations given under Article 5(4) (see, in particular, Note 5.14).

12.09 Paragraph (4). Reference is made to the explanations given under paragraph (1)(iv) (see Note 12.05).

12.10 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 (3) 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 must be given an opportunity to make (see Note 9.05).

12.11 Intervening Rights. The Treaty and Regulations do not regulate the rights, if any, 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. These are left to the relevant law of the Contracting Party.

Note on Article 13
(Correction, Addition or Restoration of Priority Claim)

13.01 Paragraph (1). This provision, modeled after a portion of PCT Rule 26*bis*.1, would permit the applicant to correct or 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.

13.02 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).

13.03 Item (i). The requirements referred to in this item are prescribed in Rule 15(1).

13.04 Item (ii). The time limit referred to in this item is prescribed in Rule 15(2).

13.05 Item (iii). 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 13.09).

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 the expiration of the priority period, but within the time limit referred to in Rule 15(3)(a), i.e., 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 Item (i). The requirements under this item are prescribed in Rule 15(4).

13.08 Item (ii). The time limit referred to in this item is prescribed in Rule 15(3)(b).

13.09 Items (iii) and (iv). Reference is made to the explanation given under Article 12(1)(iv) and (v) (see Notes 12.05 and 12.06).

13.10 Paragraph (3). 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 Rule 4(1) pursuant to Article 5(5), 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).]

13.11 Item (i). The requirements under this item are prescribed in Rule 15(5).

13.12 Item (ii). The time limit for making a request under this item is prescribed in Rule 15(6) (see Note R15.9). 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 Rule 4(1).

13.13 Paragraph (4). Reference is made to the explanations given under Article 5(4) (see, in particular, Note 5.14).

13.14 Paragraph (5). Reference is made to the explanations given under Article 12(5) (see Note 12.10).

13.15 Intervening Rights. Reference is made to the explanations regarding intervening rights under Article 12 (see Note 12.11).

Note on Article 14 (Regulations)

14.01 Paragraph (1)(a). This provision seems to be self-explanatory.

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

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

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

14.05 Paragraph (3). It is proposed that amendment of draft Rule 8(1) should require unanimity under this provision (see draft Rule 22).

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

Note on Article 15 (Relation to the Paris Convention)

15.01 Paragraph (1). This paragraph is modeled after Article 15 of the Trademark Law Treaty (“TLT”).

15.02 Paragraph (2)(a). This provision is modeled after Article 1(2) of the WIPO Copyright Treaty (“WCT”) and Article 1(1) of the WIPO Performances and Phonograms Treaty

(WPPT). It maintains the existing obligations that Contracting Parties have to each other under the Paris Convention.

15.03 Paragraph (2)(b). This provision, which is for the avoidance of doubt, maintains the rights of applicants and owners under the Paris Convention.

Note on Article 16
(Assembly)

16.01 Paragraph (1). This paragraph is the same as WCT Article 15(1) and WPPT Article 24(1).

16.02 It is to be noted that, except as provided under paragraph (1)(c), the Treaty would not establish any financial obligations: Contracting Parties would not have to pay any contribution to WIPO, neither would the Assembly adopt a program and budget. Any activity concerning the Treaty that would cause an expense to the International Bureau would be borne by WIPO, as is already the case, for example, for the WCT, the WPPT, the Rome Convention, the Phonograms Convention, the Budapest Treaty, the TLT, and among the older treaties, the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods. The effect of the second sentence of paragraph (1)(c) is that it would enable the Assembly to request that a share of WIPO funds be spent on activities relating to the Treaty.

16.03 Paragraph (2). This paragraph, which corresponds to WCT Article 15(2) and WPPT Article 24(2), seems to be self-explanatory.

16.04 Paragraph (3)(a). This paragraph, which is the same as WCT Article 15(3)(a) and WPPT Article 24(3)(a), seems to be self-explanatory.

16.05 Paragraph (3)(b). The first two sentences of this provision, which are based on WCT Article 15(3)(b) and WPPT Article 24(3)(b), contain special rules in respect of voting by intergovernmental and regional patent organizations that are party to the Treaty. The third sentence, which is not present in WCT Article 15(3)(b) or WPPT Article 24(3)(b), would ensure that two intergovernmental organizations with one or more States in common, for example, the European Community and the European Patent Organisation, could not both participate in the same vote in place of their Member States. A requirement that an intergovernmental organization may only exercise the right to vote of a Member State which is present has not been included in view of the decision not to include such requirement in the WCT and WPPT. The question of whether an intergovernmental organization or its Member States should vote would be a matter to be decided by that organization and those States.

16.06 Paragraphs (4) and (5). These paragraphs are the same as WCT Article 15(4) and (5) and WPPT Article 24(4) and (5).

Note on Article 17
(International Bureau)

17.01 This Article is the same as WCT Article 16 and WPPT Article 25 and follows a tradition established in several other WIPO-administered treaties.

Note on Article 18
(Revisions)

18.01 Paragraph (1). This paragraph is modeled after Article 60(2) of the PCT.

18.02 Paragraph (2). This paragraph is modeled after PCT Article 61. It specifies the provisions which may be revised by the Assembly, without requiring a conference of the Contracting Parties. The paragraph is restricted to amendments in respect of the tasks and sessions of the Assembly under Article 16(2) and (4).

Note on Article 19
(Eligibility for Becoming Party to the Treaty)

19.01 Paragraph (1). This paragraph would permit any State which is a party to the Paris Convention or a member of WIPO to become party to the Treaty if it either maintains an Office or provides for patents to be obtained through the Office of another State or of an intergovernmental organization. This means that States which do not have Patent Offices, but for which patents are obtainable through another Office, could become parties to this Treaty.

19.02 Paragraph (2). This paragraph is inspired by WCT Article 17(2) and WPPT Article 26(2). In line with paragraph (1), it requires that all of the member States of an intergovernmental organization must be party to the Paris Convention or a member of WIPO. Such intergovernmental organizations must declare that they have been authorized, according to their internal procedures, to become party to the Treaty and, additionally, that they are competent to grant patents with effect for their member States. Following these criteria, regional patent organizations may become party to the Treaty.

19.03 Paragraph (3). This paragraph, which is modeled after WCT Article 17(3) and WPPT Article 26(3), lists, in square brackets, the intergovernmental organizations which would have a right to become party to the treaty without a decision of the Assembly, subject to their making the declaration referred to in paragraph (2) in the Diplomatic Conference. The European Community, whose Member States are all members of WIPO or the Paris Union, and which is named in WCT Article 17(3) and WPPT Article 26(3), would have the right to become a party to the Treaty when Community legislation on matters covered by this Treaty enters into force. The existing regional patent and industrial property organizations, which are named in this paragraph, would also have the right to become party to the Treaty.

Note on Article 20
(Signature of the Treaty)

20.01 This Article is modeled after WCT Article 19 and WPPT Article 28. It is customary to have treaties open for signature for approximately one year after their adoption.

20.02 It is to be noted that intergovernmental organizations other than those referred to, namely, the organizations identified in Article 19(3), would not be able to sign the Treaty, since their admission would have to be authorized by the Assembly (see Article 16(2)(iii)), and the Assembly would start functioning only after the entry into force of the Treaty, which is unlikely to be before the expiration of the time limit for signing under this Article.

Note on Article 21
(Entry into Force)

21.01 Paragraph (1). This paragraph is modeled after WCT Article 20, WPPT Article 29 and TLT Article 20(2). As in the case of those previous treaties, the Article disregards, for the purposes of the initial entry into force of the Treaty, a possible instrument of ratification or accession by any of the intergovernmental organizations identified in Article 19(3).

21.02 The requirement of the deposit of instruments of ratification or accession of ten States, which is more than the five such instruments required under TLT Article 20(2), is intended to ensure that the initial Assembly would comprise a substantial number of countries at the same time of entry into force of the Treaty. It is recalled that the TLT does not provide for an Assembly.

21.03 Paragraph (2). This paragraph is modeled after WCT Article 21, WPPT Article 30 and TLT Article 20(3).

21.04 Item (i). This item seems to be self-explanatory.

21.05 Items (ii) to (iv). The three-month period mentioned in these items is the customary one (see provisions of the previous treaties referred to in Note 21.03), and takes into account that the instrument of ratification or accession of the intergovernmental organizations referred to in Article 19(3) would not be among the ten instruments that cause the initial entry into force of the Treaty. Other intergovernmental organizations could deposit an instrument of accession only after the entry into force of the Treaty, since their request for accession would have to be decided upon by the Assembly, and the Assembly would start functioning only after the entry into force of the Treaty. The words “or from any later date indicated in that instrument” are modeled after Article 28 of the draft new Act of the Hague Agreement Concerning the International Registration of Industrial Designs (document H/DC/3).

Note on Article 22
(Reservations)

22.01 Paragraph (1). This paragraph, which is modeled after TLT Article 21(1), would permit a reservation in respect of requirements as to unity of invention, *and is introduced in response to a reservation expressed by the Delegation of the United States of America*. The inclusion of any further reservations would be a matter for the Diplomatic Conference.

22.02 Paragraphs (2) to (4). These paragraphs are modeled after TLT Article 21(2) to (4).

Note on Article 23
(Denunciation of the Treaty)

23.01 Paragraph (1). This paragraph is of the traditional kind: see, for example, WCT Article 23, first sentence, WPPT Article 31, first sentence and TLT Article 23(1).

23.02 Paragraph (2). The first sentence of this paragraph is also of the traditional kind, see, for example, WCT Article 23, second sentence, WPPT Article 31, second sentence and TLT Article 23(2), first sentence. The words “or from any later date indicated in the notifications” are modeled after Article 32 of document H/DC/3, referred to in Note 21.05. The second sentence of this paragraph is modeled after the second sentence of TLT Article 23(2).

Note on Article 24
(Languages of the Treaty)

24.01 Paragraph (2). This provision enables the Director General to initiate the establishment of official texts if he deems it necessary. The definition of “interested party” in the second sentence of paragraph (2) takes account of the different provisions for eligibility of States for becoming party to this Treaty under Article 19, compared with WCT Article 17 and WPPT Article 26.

Note on Article 25
(Depositary; Registration)

25.01 Paragraph (1). This paragraph is the same as WCT Article 25 and WPPT Article 33, and corresponds to present trends in WIPO; see also, for example, TLT Article 25.

25.02 The depositary functions include the preservation of the signed copy of the Treaty, the placing of the original copy at the disposal of those States which want to and have the right to sign it, the establishment and distribution of certified copies of the Treaty, the receipt of the deposit of instruments of ratification or accession and of notifications of denunciation, as well as the individual notification of those events to all interested parties, and the publication of all

signatures, ratifications, accessions and denunciations and the dates of entry into force of the Treaty.

25.03 Paragraph (2). This paragraph is for the purpose of clarity and corresponds to similar provisions in other treaties, for example PCT Article 68(3).

Note on Article 26

(Application of the Treaty to Existing Applications and Patents)

26.01 This provision contains the basic rules on how the Treaty covers existing patents and pending applications.

26.02 Paragraph (1). As a general rule, this paragraph provides for the provisions of the Treaty and the Regulations to apply to all patents in force and applications pending at the date on which the Treaty binds a Contracting Party.

26.03 Paragraph (2). Notwithstanding paragraph (1), a Contracting Party would be free not to apply the provisions of the Treaty and the Regulations to procedures in proceedings regarding applications and patents referred to in paragraph (1), if the procedure commenced before the date on which the Treaty binds that Contracting Party. A Contracting Party would be free to interpret the term “procedure”, and to decide whether such procedure would be considered as having commenced before or after the date on which the Treaty binds that Contracting Party. For example, if the Office of a Contracting Party had set and notified a time limit for an action before the Office, and the Treaty became binding for that Contracting Party during that time limit, the Office would not be obliged to apply a diverging time limit contained in the Treaty, if any, in that particular case.

II. NOTES ON THE DRAFT REGULATIONS

Note on Rule 1 (Abbreviated Expressions)

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

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

R2.01 Paragraph (1) and item (i) of paragraphs (2) and (3). The time limits of not less than two months from the date of the notification, prescribed by these provisions for subsequent compliance with the filing date requirements of Articles 4(1) and (2), is more favorable, from the viewpoint of applicants, than the corresponding time limit under the PCT. PCT Rules 20.2(a)(ii) and 20.6(b) prescribe a time limit of between 10 days and one month for fulfilling the filing date requirements in respect of an international application under PCT Article 11(1). This takes account of the situation that international applications are usually filed with the applicant's national office as a receiving office for the PCT, whereas many applications filed under the national/regional patent laws would be filed from foreign countries.

R2.02 Paragraphs (2) and (3). Where indications allowing the applicant to be contacted have been filed, the time limit under item (i) of these paragraphs would not start until the Office has notified the applicant under Article 4(3).

R2.03 Paragraph (4), chapeau and item (i). These provisions seem to be self-explanatory.

R2.04 Item (ii). This provision would permit a Contracting Party to require that the copy of the earlier application, and certification of its date of filing, is filed not later than four months calculated from the date of the invitation, or not later than the period of 16 months, calculated from the priority date, for filing that copy for the purposes of the priority claim, whichever expires earlier.

R2.05 Item (iii). As regards the expression "a language accepted by the Office," reference is made to the explanation under Article 1(xii) (see Note 1.11). As regards the term "translation," reference is made to the definition in Article 1(xiii).

R2.06 Items (iv) and (vi). The check under item (iv) that the missing part of the description or missing drawing is completely contained in the earlier application could be carried out as a clerical check, based on the indication provided by the applicant under item (vi) as to where that missing part or missing drawing is contained in the earlier application or translation of the earlier application.

R2.07 Item (v). This item has been included at the express request of the Delegation of the United States of America to provide for an indication, in all cases, that the contents of the earlier application are included by reference.

R2.08 Paragraph (5). It is to be noted that the applicant who was not the same as, or the predecessor in title to, the applicant identified in the application containing the reference may be required to file a certified copy of the earlier application under paragraph (5)(b)(ii). In addition, since there could be reasonable doubt as to the applicant's entitlement, evidence as to such entitlement could be required under Article 5(6). *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.*

R2.09 Paragraph (5)(a). In accordance with this subparagraph, the indication that the description and any drawings are replaced by the reference to the previously filed application, as well as the number of that application and the Office with which that application was filed, shall be indicated in the application. This provision does not require that the reference identify any claims of the previously filed application that are incorporated by reference, since claims are not required for the purposes of the filing date.

R2.10 References to the previously filed application filed by a person who was neither the applicant of that application nor his successor in title would occur only in rare cases. However, for example, in the case of entitlement disputes which may occur at the joint research project, a reference to the previously filed application filed by another person may be necessary, if such a dispute exists at the time of filing an application.

R2.11 Paragraph (5)(b). In order to incorporate the content of the replaced description and drawings, a Contracting Party may require a copy, or a certified copy, of the previously filed application. A certified copy of the previously filed application referred to in item (ii) may provide a safeguard against fraudulent references explained in Note R2.10.

R2.12 Paragraph (6). A Contracting Party may require that, where the applicant request that an application be treated as a type of application referred to in this paragraph, he indicate the number and filing date of the parent application.

Note on Rule 3
(Additional Permitted Requirements Under Article 5(1))

[Reserved]

Note on Rule 4

(Availability of Application Under Article 5(5) and Rule 2(4) and (5)(b))

R4.01 Paragraph (1). The time limit under this provision for furnishing a copy of the earlier application is 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. 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).

R4.02 Paragraph (2). This paragraph 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.

R4.03 Paragraph (3). 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 the 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.

R4.04 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.

R4.05 Paragraph (4). 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 high cost of preparing different translations for the different countries in which priority is claimed may impose 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 (4) 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 which shall be not less than two months from the date of the invitation and not less than the time limit, if any, applied under paragraph (1). *This provision is subject to reservations by the Delegations of Belgium, China, Greece, Ireland, Spain and Uruguay.*

Note on Rule 5

(Evidence Under Articles 5(6), 7(4)(c) [and 11(6)]
and Rules 7(5), 16(5), 17(7), 18(7) and 19(5))

R5.01 This provision seems to be self-explanatory.

Note on Rule 6

(Time Limits Concerning the Application Under Article 5)

R6.01 Paragraph (1). This provision seems to be self-explanatory.

R6.02 Paragraph (2). Where the filing date of an application is not earlier than the date on which the elements referred to in Article 4(1)(a) were first received by the Office, a Contracting Party would be permitted to calculate the time limit under item (ii) from the filing date. However, this would not be possible in the case of applications, for example, divisional applications, which are entitled to an earlier filing date. Reference is also made to the explanation given under Rule 2(2) and (3) (see Notes R2.01 and R2.02).

Note on Rule 7

(Details Concerning Representation Under Article 6)

R7.01 Paragraph (1). If this paragraph is maintained, it would permit an applicant to file a copy of an earlier application and of a previously filed application, under Article 4, without appointing a representative. However, if this paragraph is deleted, a Contracting Party may require that a copy of an earlier application and of a previously filed application could only be filed by a professional representative, and refuse to accept the filing of such copy by the applicant himself.

R7.02 Paragraph (2)(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 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 7.05 and 7.06).

R7.03 Paragraph (2)(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, Rule 7 does not regulate further details of the so-called “general power of attorney.”

R7.04 A Contracting Party would be permitted to require that a separate copy of the single power of attorney be filed for each application and patent to which it relates. It would also be permitted to require, under Rule 10(1)(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.

R7.05 Paragraph (3). 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 5.12). Rule 21(1)(a)(i) provides for the establishment of a Model International Form for the power of attorney.

R7.06 Paragraph (4). 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).

R7.07 Paragraph (5). 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 submitted voluntarily by the applicant, without any requirements 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 5.17).

R7.08 Paragraph (6). This provision seems to be self-explanatory.

R7.09 Paragraph (7). Reference is made to the explanation given under Rule 6(2) (see Note R6.02).

Note on Rule 8

(Filing of Communications Under Article 7(1))

R8.01 Paragraph (1). Under this provision, after the period of [10] years from the date of the entry into force of the Treaty expires, any Contracting Party would be permitted, but not required (see Article 7(1)(c)) to exclude the filing of communications on paper. However, even for Contracting Parties which exclude the filing of communications on paper, communications filed on paper would be sufficient for meeting a time limit, as prescribed in Article 7(1)(d) (see Note 7.04). As regards the expression “communications on paper,” reference is made to the explanation under Article 4(1)(a) (see, in particular, Note 4.05). Concerning amendment of this paragraph, reference is made to the explanation under Rule 22 (see Notes R22.01 and R22.02).

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 to a computer terminal. Paragraph (2)(a) does not prevent a Contracting Party from allowing electronic filing in accordance with its own requirements. It only obliges a Contracting Party, which permits the electronic filing of communications under the PCT concerning international applications, to accept the electronic filing of communications concerning national applications in accordance with the PCT requirements.

R8.03 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 (2)(c). A similar provision is contained in PCT Rule 92.4(d). Where a document is prepared on a computer and directly transmitted by telefax, a printout of that document from the computer would constitute the original.

R8.06 Paragraph (3)(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.

R8.07 Paragraph (3)(b). This provision seems to be self-explanatory.

Note on Rule 9

(Details Concerning the Signature Under Article 7(4))

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). This paragraph applies to the cases, for example, where communications are filed by telefacsimile resulting in the filing of communications on paper on which the graphic representation of the handwritten signature appears. It also applies to communications filed by telefacsimile transmission to a computer terminal on which the graphic representation of the handwritten signature appears. In these cases, in accordance with Rule 8(2)(c), a Contracting Party may require that the original of the transmitted document be filed on paper, on which the original signature would appear. 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)(a) (see Note R8.02).

R9.07 Paragraph (5). This paragraph applies to signatures on communications filed in electronic form or by electronic means that are not covered by the provisions under paragraph (4), because the signature does not appear as a graphic representation.

R9.08 Subparagraph (a). A “signature in electronic form as prescribed by that Contracting Party” may be a signature in electronic or digital 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. It also could be a means of self-identification using an ID number and a password.

R9.09 Subparagraph (b). At present there are no requirements under the PCT in relation to signatures in electronic form of communications filed in electronic form or by electronic means which do not result in a graphic representation of a signature. However, the matter is under consideration by the Ad Hoc Advisory Group on PCT Legal Matters with respect to legal issues and by the Standing Committee on Information Technologies (SCIT) with respect to technical issues.

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. A Contracting Party is permitted to require, under its applicable law, any means for certifying signatures in electronic form referred to in paragraph (5).

Note on Rule 10

(Details Concerning Indications Under Article 7(5) and (6))

R10.01 Reference is made to the applicability of the requirements under this Rule to Article 7(5) and (6) (see Notes 7.13 and 7.15).

R10.02 Paragraph (1)(a), item (i). This item seems to be self-explanatory.

R10.03 Item (ii). 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.

R10.04 Paragraph (1)(b), items (i) and (ii). These items seem to be self-explanatory.

R10.05 Item (iii). Reference is made to the explanation under paragraph (1)(a), item (ii) (see Note R10.03).

R10.06 Paragraph (2). As regards the requirement that an address be “on a territory prescribed by the Contracting Party,” reference is made to the explanation under Article 6(1)(a)(ii) (see Note 6.04).

R10.07 Paragraph (3). This provision would oblige a Contracting Party 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(6)(i) and (ii). As regards the requirement that an address be “on a territory prescribed by that Contracting Party,” reference is made to the explanation under Article 6(1)(a)(ii) (see Note 6.04).

R10.08 Paragraph (4). This provision would oblige a Contracting Party to treat the address of a representative as the address for correspondence and the address for legal service under Article 7(6)(i) and (ii), in the absence of an indication to the contrary. In addition, if that address is not on the territory of a Contracting Party, a Contracting Party could require, under Article 6(1)(a)(ii), that the representative provide an address on the territory of the Contracting Party (see Note 6.04).

R10.09 Paragraph (5). This paragraph seems to be self-explanatory.

Note on Rule 11

(Time Limits Concerning Communications Under Article 7(7) and (8))

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

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

Note on Rule 12

(Details Concerning Relief in Respect of the Non-Compliance
With a Time Limit Under Article 10)

R12.01 Paragraph (1)(a). This provision sets out the requirements which may be imposed by a Contracting Party with respect to a request under Article 10. Items (i) to (iv) seem to be self-explanatory. Whether all of these requirements will be needed in this provision will depend on the final text of other provisions, as for example Article 7 on communications.

R12.02 Paragraph (1)(b). This provision has been added at the express request of the Delegation of the United States of America.

R12.03 Paragraph (2). The applicable time limit for filing a request under Article 10 shall be at least two months from the date of the expiration of the unextended time limit. A Contracting Party would of course be free to provide a time limit which would be more favorable to applicants and owners.

R12.04 Paragraph (3)(a). *The list of exceptions to grant relief under Article 10 is taken from former Rules 12 and 13 (see document SCP/2/3). In the present Rule, the exceptions are placed within square brackets pending the outcome of the discussion on Article 10 by the Standing Committee.*

R12.05 Paragraph (3)(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 Article 10(1) to (4).

R12.06 Items (ii) 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.

R12.07 Item (iii). This item seems to be self-explanatory.

R12.08 Items (v) and (vi). These items have been included following suggestions of the Standing Committee and seem to be self-explanatory.

R12.09 Items (vii) and (viii). These items may be required to avoid undue delay of prosecution of the application.

R12.10 Item (ix). This item seems to be self-explanatory.

R12.11 Paragraph (3)(b). This provision would ensure that the provisions of the applicable national law 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)

[Reserved]

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), item (i). As regards the requirements concerning the signature of communications, including requests, reference is made to Article 7(4) (see Notes 7.08 to 7.12).

R14.02 Item (ii). This item would permit a Contracting Party to require that a request under Article 12(1) be presented in 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 Model International Format for such requests.

R14.03 Paragraph (2). 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.

R14.04 Paragraph (3), item (i). This item seems to be self-explanatory.

R14.05 Item (ii). If this item were to be retained, 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. A Contracting Party would be obliged to provide a period of grace for the payment of such fees under Article 5*bis*(1) of the Paris Convention.

R14.06 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.

R14.07 Items (v) to (vii). These items seem to be self-explanatory.

Note on Rule 15

(Details Concerning Correction, Addition or Restoration of Priority Claim Under Article 13)

R15.01 Paragraph (1). Reference is made to the explanation under Rule 14(1) (see Notes R14.01 and R14.02).

R15.02 Paragraph (2). The applicable time limit for the submission of a priority claim after the filing of an international application under PCT Rule 26*bis*.1(a) is 16 months from the priority date or, where the correction or 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 four months from the filing date of the application.

R15.03 Paragraph (3). This paragraph seems to be self-explanatory.

R15.04 Paragraph (4), items (i) and (ii). Reference is made to the explanation under Rule 14(1) (see Notes R14.01 and R14.02).

R15.05 Item (iii). 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.

R15.06 Paragraph (5)(a), items (i) and (ii). Reference is made to the explanation under Rule 14(1) (see Notes R14.01 and R14.02).

R15.07 Paragraph (5)(a), item (iii) and paragraph (5)(b), item (i). In order that the Office may determine whether the requirement under Article 13(3)(ii) 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.

R15.08 Paragraph (5)(b), item (ii). This item seems to be self-explanatory.

R15.09 Paragraph (6). 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 4(1), and, second, the time needed by Offices to provide copies of earlier applications.

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 and 1.08).

R16.03 Item (ii). 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.

R16.04 Item (iii). This item seems to be self-explanatory.

R16.05 Item (iv). 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 (5), 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)(a)(ii) and 2(a).

R16.08 Paragraph (3). The amount of the fee could differ depending on the number of the patents or applications involved (see Note R16.09). Reference is also made to the explanations under Article 5(4) (see, in particular, Note 5.14).

R16.09 Paragraph (4). 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 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 R16.08).

R16.10 Paragraph (5). 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 5.17).

R16.11 Paragraph (6) establishes the exhaustive character of the list of requirements under paragraphs (1) to (5). 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.

R16.12 Paragraphs (7) and (8). 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(7) and (8) (see Notes 7.17 and 7.18).

R16.13 Paragraph (9). 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 correspondence or address for legal 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 or Model International Format 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 seems to be self-explanatory.

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

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

R17.06 Item (vii). The basis for the change in the person of the applicant or owner could 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). A Contracting Party could require the statement referred to in this item in all cases.

R17.08 Item (ii). An example of government interest is the provision under the law of the United States of America (35 C.F. RS 267) which provides that the Commissioner may extend the time for taking action in the case of an application which is the property of the United States of America.

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 provision prescribes the documentation which may be required where the change in the person of the applicant or owner results from a contract. If the text within square brackets were to be retained, the documentation referred to could not be required where the recordal for change is requested by the applicant or owner shown in the records of the Office. However, if the text within square brackets were to be deleted, the documentation could be requested in all cases. In addition, in both cases, a Contracting Party would be permitted to require information relating to the registration of the contract where such registration is compulsory. *This provision is subject to a reservation by the Delegations of Brazil, Cuba, Mexico and Spain.*

R17.11 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.

R17.12 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 in 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.

R17.13 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, a competent public authority or, where permitted, a representative) certifies the relevant document.

R17.14 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) and (2)(a) provides for a Model International Form and Model International Format for a certificate of transfer.

R17.15 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 Note R17.13.

R17.16 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, a 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 a 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.

R17.17 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.

R17.18 Paragraph (4). As regards the expression “a language accepted by the Office,” reference is made to the explanation under Article 1(xii) (see Note 1.11). As regards the term “translation,” reference is made to the definition under Article 1(xiii).

R17.19 Paragraphs (5) and (6). Reference is made to the explanations given under Rule 16(3) and (4) (see Notes R16.08 and R16.09).

R17.20 Paragraph (7). 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(5) (see Note R16.10).

R17.21 Paragraph (8). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (7) 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 (9). Reference is made to the explanations under Rule 16(7) and (8) (see Notes R16.12).

R17.23 Paragraph (10). 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 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 seems to be self-explanatory.

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

R18.04 Items (iii) to (v). These items seem to be self-explanatory.

R18.05 Paragraph (1)(b). As regards items (i) and (ii), reference is made to the explanations given under Rule 17(1)(b) (see Notes R17.07 and R17.08). Item (iii) seems to be self-explanatory.

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 R17.14). The words “portion of that agreement” in item (ii) include, in particular, information regarding the territory and duration of the licensing agreement, and whether there is a right to sub-license. *This provision is subject to the same reservations as Rule 17(3)(a)*.

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. The situation in which the consent of a co-applicant, co-owner or co-exclusive licensee cannot be obtained, for example, because that person cannot be contacted, is not regulated by the draft Treaty or Regulations and therefore remains a matter for the applicable law of the Contracting Party. Reference is also made to the explanations under Rule 17(3)(d) (see Note R17.17).

R18.09 Paragraphs (5) and (6). Reference is made to the explanations given under Rule 16(3) and (4) (see Notes R16.08 and R16.09).

R18.10 Paragraphs (7) and (8). Reference is made to the explanations given under Rule 17(7) and (8) (see Notes R17.20 and R17.21).

R18.11 Paragraph (9). Reference is made to the explanations given under Rule 16(7) and (8) (see Note R16.12).

R18.12 Paragraph (10). 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.

R18.13 In applying the provisions of paragraphs (1) to (9), *mutatis mutandis*, to a request for recordal, or cancellation of recordal, of a security interest, reference to the term “a licensing agreement,” “licensor” or “licensee” should be read as reference to the term “a security interest,” “a person providing the security interest,” or “a person in favor of whom the security interest is established,” respectively. In addition, if the words in square brackets under paragraph (3)(a) were maintained, applying the chapeau of this paragraph, *mutatis mutandis*, to requests for cancellation of the recordal of a licensing agreement or a security interest would have the effect that the documentations referred to in paragraph (3)(a)(i) or (ii) may be required, where the cancellation of the recordal is requested by the licensor or the person in favor of whom the security interest is established, as the case may be.

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.

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 Note 1.07).

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

R19.04 Item (ii). Reference is made to the explanations given under Rule 16(1)(ii) (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 (for example, a replacement page in the case of an application filed on paper), or a part incorporating the correction (for example, an errata sheet), 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 or part incorporating the correction 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 intention. 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 Paragraph (3)(a). Reference is made to the explanation under Rule 16(3) (see Note R16.08).

R.19.11 Paragraph (3)(b). This provision seems to be self-explanatory.

R19.12 Paragraph (4). Reference is made to the explanation under Rule 16(4) (see Note R16.09).

R19.13 Paragraph (5). 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 intentional 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(5) (see Note R16.10).

R19.14 Paragraph (6). Reference is made to the explanations given under Rule 16(6) (see Note R16.11). As regards the restriction to formal requirements, reference is made to the explanation in Note R19.01.

R19.15 Paragraph (7). Reference is made to the explanations given under Rule 16(7) and (8) (see Note R16.12).

R19.16 Paragraph (8)(a). 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 (7).

R19.17 Paragraph (8)(b). This provision is for the avoidance of doubt. Under the law of the United States of America, a patentee may apply for a re-issue patent to correct a patent that is, or may be, inoperative or invalid because the claims are too narrow or too broad due to an error made without deceptive intention.

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 (for example, where the application number is required to be furnished under Rules 2(5)(a), 10(1)(a)(i), 16(1)(ii), 17(1)(a)(ii), 18(1)(a)(ii) and 19(1)(a)(ii). 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 provisions under this Rule seem to be self-explanatory.

Note on Rule 22
(Requirement of Unanimity for Amending Certain Rule Under Article 14(3))

R22.01 Paragraph (1). This paragraph would ensure that the provisions of Rule 8(1) could not be amended without unanimous agreement. This means that, in accordance with Rule 8(1), during the period of [10] years from the date of the entry into force of this Treaty, the right of applicants to file applications on paper with any particular Office could only be excluded by unanimity. After that period has expired, it will also require unanimity to amend the provisions under Rule 8(1) which will, as from the expiration of the said period, allow any Contracting Party to exclude the filing of communications on paper.

R22.02 Paragraph (2). This paragraph is modeled after Rule 36(1) of WIPO General Rules of Procedure.

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