



C. PCT 892
- 21.1

December 9, 2002

Madam,
Sir,

1. This circular is addressed to your Office in its capacity as designated and/or elected Office under the Patent Cooperation Treaty (PCT). It concerns new Rule 49.6 of the Regulations Under the PCT, as adopted by the PCT Assembly at its thirty-first (18th extraordinary) session held from September 23 to October 1, 2002.
2. Reference is made to Circular C. PCT 876, dated October 25, 2002, concerning the transitional reservation provision under Rule 49.6(f). A copy of Circular C. PCT 876 is enclosed. Following the issuance of Circular C. PCT 876, the International Bureau has received several requests from designated Offices for clarification with regard to the need to make use of the transitional reservation provision under Rule 49.6(f). This Circular is intended to provide the requested clarification and to remind designated Offices that any notification under that provision must be received by the International Bureau by January 1, 2003.
3. At the outset, it is to be noted that it is up to each Contracting State to assess whether its national law is compatible with Rule 49.6(a) to (e) and, if not, to inform the International Bureau accordingly. However, it would appear that a transitional reservation under Rule 49.6(f) need not be made where the national law applied by the designated Office does not expressly provide for the “reinstatement of rights” after failure to perform the acts referred to in Article 22 but, more generally, provides for the “excusing of delays” of meeting a time limit with the same effect of the international application being treated as if the time limit had not been missed, provided that the requirements under the national law

/...

for excusing the delay are, from the viewpoint of the applicant, as favorable as, or more favorable than, the requirements provided for by Rule 49.6(a) to (e). In this regard, particular attention should be paid to the criterion applied by the designated Office for excusing the delay (see Rule 49.6(a)) and to the time limit within which a request for excusing the delay must be made (see Rule 49.6(b)). Examples of such provisions are those that allow restoration, *restitutio in integrum*, revival of abandoned applications, further processing, continuation of proceedings, extension of time limits and the like.

4. For any inquiry concerning this Circular or Circular C. PCT 876, we would be grateful if you could contact us directly, using the address or numbers indicated in paragraph 7 of Circular C. PCT 876.

Yours sincerely,



Francis Gurry
Assistant Director General

Enclosure: Circular C. PCT 876



C.PCT 876
21.1

October 25, 2002

Madam,
Sir,

1. This circular is addressed to your Office in its capacity as designated and/or elected Office under the Patent Cooperation Treaty (PCT). It concerns new Rule 49.6 of the Regulations Under the PCT, as adopted by the PCT Assembly at its thirty-first (18th extraordinary) session held from September 23 to October 1, 2002. The new Rule is set out in Annex I to this Circular.
./.
2. The decisions of the Assembly relating to entry into force and transitional arrangements in connection with the amendment of Rule 49 are reproduced in Annex II to this Circular.
./.
3. Designated Offices are reminded that any notification referred to in paragraph (f) of Rule 49.6, set out in Annex I, must be submitted to the International Bureau at the latest by January 1, 2003 (see paragraph 7 below); should that not be the case, amended Rule 49 will apply as of January 1, 2003, in respect of the designated Office in question.
4. It is recommended that any Contracting State the national law of which is not compatible with new Rule 49.6 take action to amend its law to make it compatible so that if a notification must be given under Rule 49.6(f), it can be withdrawn as soon as possible thereafter.
5. Moreover, designated Offices are kindly asked to inform the International Bureau about if and, if so, by way of which procedure under the applicable national law, an applicant who failed to perform the acts referred to in Article 22 within the applicable time limit can currently obtain reinstatement of rights with respect to new Rule 49.6.

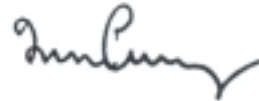
/...

6. Any notification received shall be promptly published by the International Bureau in Section IV of the *PCT Gazette*, if possible before January 1, 2003, or as soon as possible after receipt.

7. For any inquiry concerning this Circular, we would be grateful if you could contact us direct, using the following address or numbers:

Mr. Patrick Genin
Senior Legal Officer
PCT Legal Affairs and Seminar Coordination Section
PCT Legal Division
Telephone: (+41 22) 338 86 67
Facsimile machine: (+41 22) 910 00 30
E-mail: patrick.genin@wipo.int

Yours sincerely,



Francis Gurry
Assistant Director General

Enclosures: Annex I–Text of Rule 49 (Copy, Translation and Fee Under Article 22)
 Annex II–Excerpt from Annex VI to the report of the PCT Assembly (document PCT/A/31/10)

TEXT OF RULE 49
(as in force from January 1, 2003)

Rule 49
Copy, Translation and Fee Under Article 22

49.1 to 49.5 [No change]

49.6 Reinstatement of Rights After Failure to Perform the Acts Referred to in Article 22

(a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, and subject to paragraphs (b) to (e) of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit occurred in spite of due care required by the circumstances having been taken.

(b) The request under paragraph (a) shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within whichever of the following periods expires first:

- (i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or
- (ii) 12 months from the date of the expiration of the applicable time limit under Article 22;

provided that the applicant may submit the request at any later time if so permitted by the national law applicable by the designated Office.

(c) The request under paragraph (a) shall state the reasons for the failure to comply with the applicable time limit under Article 22.

(d) The national law applicable by the designated Office may require:

- (i) that a fee be paid in respect of a request under paragraph (a);
- (ii) that a declaration or other evidence in support of the reasons referred to in paragraph (a) be filed.

(e) The designated Office shall not refuse a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

(f) If, on October 1, 2002, paragraphs (a) to (e) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that designated Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by January 1, 2003. The information received shall be promptly published by the International Bureau in the Gazette.

[Annex II follows]

Annex II to Circular C.PCT 876

Excerpt from Annex VI to the report of the PCT Assembly
(document PCT/A/31/10)

“The amendments set out in [Annex I to this Circular]:

(a) shall enter into force on January 1, 2003, and shall apply to any international application whose international filing date is on or after January 1, 2003;

(b) shall not apply to any international application whose international filing date is before January 1, 2003, provided that:

(i) new Rule 49.6(a) to (e) shall, subject to item (iii), apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 22 expires on or after January 1, 2003;

(ii) to the extent that new Rule 49.6(a) to (e) is applicable by virtue of Rule 76.5, the latter Rule shall, subject to item (iii), apply to any international application whose international filing date is before January 1, 2003, and in respect of which the applicable time limit under Article 39(1) expires on or after January 1, 2003;

(iii) where a designated Office informs the International Bureau under paragraph (f) of Rule 49.6 that paragraphs (a) to (e) of that Rule are not compatible with the national law applied by that Office, items (i) and (ii) of this paragraph shall apply in respect of that Office except that each reference in those items to the date January 1, 2003, shall be read as a reference to the date of entry into force of Rule 49.6(a) to (e) in respect of that Office.”

[End of Annexes and of Circular]