

05/10/99

**PRELIMINARY DRAFT OF THE BASIC PROPOSAL FOR THE
REGULATIONS UNDER THE PATENT LAW TREATY**

INCORPORATING THE RESULTS OF THE THIRD SESSION OF THE SCP
AND FURTHER AUTHORIZED CHANGES BY THE INTERNATIONAL BUREAU

prepared by the International Bureau

Distributed on the SCP Electronic Forum for comment, prior to the preparation of the basic proposal, pursuant to the decision of the SCP (see Report; document SCP/3/11, paragraphs 86 and 217).

A list of provisions in this document containing further authorized changes by the International Bureau has been posted on the SCP Electronic Forum.

DRAFT REGULATIONS

List of the Rules of the Draft Regulations

		<u>Page</u>
Rule 1	Abbreviated Expressions	4
Rule 2	Details Concerning Filing Date Under Article 5	5
Rule 3	Details Concerning the Application Under Article 6(1) and (2)	9
Rule 4	Availability of Earlier Application Under Article 6(5) and Rule 2(4) and (5)(b)	11
Rule 5	Evidence Under Articles 6(6) and 8(4)(c) and Rules 7(4), 15(4), 16(6), 17(6) and 18(4)	14
Rule 6	Time Limits Concerning the Application Under Article 6(7) and (8)	15
Rule 7	Details Concerning Representation Under Article 7	16
Rule 8	Filing of Communications Under Article 8(1)	17
Rule 9	Details Concerning the Signature Under Article 8(4)	19
Rule 10	Details Concerning Indications Under Article 8(5), (6) and (8)	22
Rule 11	Time Limits Concerning Communications Under Article 8(7) and (8)	24
Rule 12	Details Concerning Relief in Respect of Time Limits Under Article 11	25
Rule 13	Details Concerning Re-instatement of Rights After a Finding of Due Care or Unintentionality by the Office Under Article 12	28
Rule 14	Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13	30

		<u>Page</u>
Rule 15	Request for Recordation of Change in Name or Address	33
Rule 16	Request for Recordation of Change in Applicant or Owner	36
Rule 17	Request for Recordation of a Licensing Agreement or Security Interest	42
Rule 18	Request for Correction of a Mistake	47
Rule 19	Manner of Identification of an Application Without Its Application Number	50
Rule 20	Establishment of Model International Forms and Formats	51
Rule 21	Requirement of Unanimity for Amending Certain Rules Under Article 14(3)	53

DRAFT REGULATIONS

Rule 1

Abbreviated Expressions

(1) [*Treaty*; *Article*] (a) In these Regulations, the word “Treaty” means the Patent Law Treaty.

(b) In these Regulations, the word “Article” refers to the specified Article of the Treaty.

(2) [*Abbreviated Expressions Defined in the Treaty*] The abbreviated expressions defined in Article 1 for the purposes of the Treaty shall have the same meaning for the purposes of the Regulations.

Rule 2

Details Concerning Filing Date Under Article 5

(1) [*Time Limit Under Article 5(3)*] The time limit referred to in Article 5(3) shall be not less than two months from the date of the notification referred to in that Article.

(2) [*Time Limit Under Article 5(4)(b)*] The time limit referred to in Article 5(4)(b) shall be:

(i) subject to item (ii), the time limit applied under paragraph (1);

(ii) where a notification under Article 5(3) has not been made because indications allowing the applicant to be contacted by the Office have not been filed, not less than two months from the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office.

(3) [*Time Limits Under Article 5(6)(a) and (b)*] The time limits referred to in Article 5(6)(a) and (b) shall be:

(i) where a notification has been made under Article 5(5), not less than two months from the date of the notification;

(ii) where a notification has not been made, not less than two months from the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office.

[Rule 2, continued]

(4) [*Requirements Under Article 5(6)(b)*] Any Contracting Party may, subject to Rule 4, require that, for the filing date to be determined under Article 5(6)(b):

(i) a copy of the earlier application be filed within the time limit applicable under paragraph (3);

(ii) a copy of the earlier application, and the date of filing of the earlier application, certified as correct by the Office with which the earlier application was filed, be filed upon invitation by the Office, within a time limit which shall be not less than four months from the date of that invitation, or the time limit applicable under Rule 4(1), whichever expires earlier;

(iii) where the earlier application is not in a language accepted by the Office, a translation of the earlier application be filed within the time limit applicable under paragraph (3);

(iv) the missing part of the description or missing drawing be completely contained in the earlier application;

(v) the application, at the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office, contained an indication that the contents of the earlier application were incorporated by reference in the application;

(vi) an indication be filed within the time limit applicable under paragraph (3) as to where, in the earlier application or in the translation referred to in item (iii), the missing part of the description or the missing drawing is contained.

(5) [*Requirements Under Article 5(7)(a)*] (a) The reference to the previously filed application referred to in Article 5(7)(a) shall indicate that, for the purposes of the filing date, the description and any drawings are replaced by the reference to the previously filed application, the number of that application, and the Office with which that application was filed. A Contracting Party may require that the reference also indicate the filing date of the previously filed application.

(b) Any Contracting Party may, subject to Rule 4(3), require that:

(i) a copy of the previously filed application and, where the previously filed application is not in a language accepted by the Office, a translation of that previously filed application, be filed with the Office within a time limit which shall be not less than two months from the date on which the application containing the reference referred to in Article 5(7)(a) was received by the Office;

(ii) a certified copy of the previously filed application be filed with the Office within a time limit which shall be not less than four months from the date of the receipt of the application containing the reference referred to in Article 5(7)(a).

[Rule 2, continued]

(6) [*Exceptions Under Article 5(8)(ii)*] The types of applications referred to in Article 5(8)(ii) shall be:

- (i) divisional applications;
- (ii) applications for continuation or continuation-in-part;
- (iii) applications by new applicants determined to be entitled to an invention contained in an earlier application.

Rule 3

Details Concerning the Application Under Article 6(1) and (2)

(1) [*Further Requirements Under Article 6(1)(iii)*] (a) A Contracting Party may require that an applicant who wishes an application to be treated as a divisional application under Rule 2(6)(i) indicate:

(i) that he wishes the application to be so treated;

(ii) the number and filing date of the application from which the application is divided.

(b) A Contracting Party may require that an applicant who wishes an application to be treated as an application under Rule 2(6)(iii) indicate:

(i) that he wishes the application to be so treated;

(ii) the number and filing date of the earlier application.

(2) [*Request Form or Format Under Article 6(2)(b)*] A Contracting Party shall accept the presentation of the contents referred to in Article 6(2)(a):

(i) on a request Form, if that request Form corresponds to the Patent Cooperation Treaty request Form with any modifications under Rule 20(1)(b);

[Rule 3(2), continued]

(ii) on a Patent Cooperation Treaty request Form, if that request Form is accompanied by an indication to the effect that the applicant wishes the application to be treated as a national or regional application, in which case the request Form shall be deemed to incorporate the modifications referred to in item (i);

(iii) on a Patent Cooperation Treaty request Form which contains an indication to the effect that the applicant wishes the application to be treated as a national or regional application, if such a request Form is available under the Patent Cooperation Treaty;

(iv) in a format, if that format corresponds to the Model International request Format under Rule 20(2).

Rule 4

Availability of Earlier Application Under Article 6(5) and Rule 2(4) and (5)(b)

(1) [*Copy of Earlier Application Under Article 6(5)*] Subject to paragraph (3), a Contracting Party may require that a copy of the earlier application referred to in Article 6(5) be filed with the Office within a time limit which shall be not less than 16 months from the filing date of that earlier application or, where there is more than one such earlier application, from the earliest filing date of those earlier applications.

(2) [*Certification*] Subject to paragraph (3), a Contracting Party may require that the copy referred to in paragraph (1) and the date of filing of the earlier application be certified as correct by the Office with which the earlier application was filed.

(3) [*Availability of Earlier Application*] No Contracting Party shall require the filing of a copy or a certified copy of the earlier application or a certification of the filing date, as referred to in paragraphs (1) and (2), and Rule 2(4) and (5)(b), where the earlier application was filed with its Office, or is available to that Office in a legally accepted electronic format from a digital library which is accepted by that Office.

(4) [*Translation*] Where the earlier application is not in a language accepted by the Office and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the Contracting Party may require that a translation of the earlier application referred to in paragraph (1) be filed by the applicant, upon invitation by the Office, within a time limit which shall be not less than two months from the date of that invitation, and not less than the time limit, if any, applied under that paragraph.

Rule 5

*Evidence Under Articles 6(6) and 8(4)(c) and
Rules 7(4), 15(4), 16(6), 17(6) and 18(4)*

Where the Office notifies the applicant, owner or other person that evidence is required under Article 6(6) or 8(4)(c), or Rule 7(4), 15(4), 16(6), 17(6) or 18(4), the notification shall state the reason of the Office for doubting the veracity of the matter, indication or signature or other means of self-identification, or the accuracy of the translation, as the case may be.

Rule 6

Time Limits Concerning the Application Under Article 6(7) and (8)

(1) [*Time Limit Under Article 6(7)*] The time limit referred to in Article 6(7) shall be not less than two months from the date of the notification referred to in Article 6(7).

(2) [*Time Limit Under Article 6(8)*] The time limit referred to in Article 6(8) shall be:

(i) subject to item (ii), the time limit applied under paragraph (1);

(ii) where a notification under Article 6(7) has not been made because indications allowing the applicant to be contacted by the Office have not been filed, not less than three months from the date on which one or more of the elements referred to in Article 5(1)(a) were first received by the Office.

Rule 7

Details Concerning Representation Under Article 7

[(1) [*Other Procedures Under Article 7(2)(v)*] The other procedures referred to in Article 7(2)(v) for which a Contracting Party may not require appointment of a representative are:

(i) the filing of a copy of an earlier application under Rule 2(4);

(ii) the filing of a copy of a previously filed application under Rule 2(5)(b).]

(2) [*Appointment of Representative Under Article 7(3)*] (a) A Contracting Party shall accept that the appointment of a representative be filed with the Office in:

(i) a separate communication (hereinafter referred to as a “power of attorney”) signed by the applicant, owner or other interested person and indicating the name and address of the representative; or, at the applicant’s option,

(ii) the request Form or format referred to in Article 6(2), signed by the applicant.

(b) A single power of attorney shall be sufficient even where it relates to more than one application or patent of the same person, or to one or more applications and one or more patents of the same person, provided that all applications and patents concerned are identified in the single power of attorney. A single power of attorney shall also be sufficient even where it relates, subject to any exception indicated by the appointing person, to all existing and future applications or patents of that person. The Office may require that, where that single power of attorney is filed on paper or by other means permitted by the Office, a separate copy thereof be filed for each application and patent to which it relates.

(3) [*Translation of Power of Attorney*] A Contracting Party may require that, if the power of attorney is not in a language accepted by the Office, it be accompanied by a translation.

(4) [*Evidence*] A Contracting Party may require that evidence be filed with the Office where the Office may reasonably doubt the veracity of any indication contained in any communication referred to in paragraph (2)(a)(i).

(5) [*Time Limit Under Article 7(5)*] The time limit referred to in Article 7(5) shall be not less than two months from the date of the notification under that Article.

[Rule 7, continued]

(6) [*Time Limit Under Article 7(6)*] The time limit referred to in Article 7(6) shall be:

(i) subject to item (ii), the time limit applied under paragraph (5);

(ii) where a notification referred to in Article 7(5) has not been made because indications allowing the applicant, owner or other interested person to be contacted by the Office have not been filed, the time limit to comply with the requirements and to make observations under that Article shall be not less than three months from the date on which the procedure referred to in that Article was commenced.

Rule 8

Filing of Communications Under Article 8(1)

(1) [*Communications Filed on Paper*] (a) During a period of 10 years from the date of the entry into force of this Treaty, a Contracting Party shall permit the filing of communications on paper. After that period has expired, any Contracting Party may, subject to Articles 5(1) and 8(1)(d), exclude the filing of communications on paper.

(b) Subject to Article 8(3), a Contracting Party may require that a communication on paper be filed on a form, or in a format, prescribed by that Contracting Party.

(2) [*Communications Filed in Electronic Form or by Electronic Means*] (a) Where a Contracting Party permits the filing of communications in electronic form or by electronic means with its Office in a particular language, including the filing of communications by telegraph, teleprinter, telefacsimile or other like means, and there are requirements applicable to that Contracting Party under the Patent Cooperation Treaty in relation to communications filed in electronic form or by electronic means in that language, the Office shall permit the filing of communications in electronic form or by electronic means in the said language in accordance with those requirements.

(b) Any Contracting Party which permits the filing of communications in electronic form or by electronic means with its Office shall notify the International Bureau of the requirements under its applicable law relating to such filing. Any such notification shall

[Rule 8(2)(b), continued]

be published by the International Bureau in the language in which it is notified and in the languages in which authentic and official texts of the Treaty are established under Article 25.

(c) Where a Contracting Party permits the filing of communications by telegraph, teleprinter, telefacsimile or other like means under subparagraph (a), it may require that the original of any document which was transmitted by such means, accompanied by a letter identifying that earlier transmission, be filed on paper with the Office within a time limit which shall be not less than one month from the date of the transmission.

(3) [*Copies, Filed in Electronic Form or by Electronic Means, of Communications Filed on Paper*] (a) Where a Contracting Party permits the filing of a copy, in electronic form or by electronic means, of a communication filed on paper in a language accepted by the Office, and there are requirements applicable to that Contracting Party under the Patent Cooperation Treaty in relation to the filing of such copies of communications, the Office shall permit the filing of copies of communications in electronic form or by electronic means, in accordance with those requirements.

(b) Paragraph (2)(b) shall apply, *mutatis mutandis*, to copies, in electronic form or by electronic means, of communications filed on paper.

Rule 9

Details Concerning the Signature Under Article 8(4)

(1) [*Indications Accompanying Signature*] A Contracting Party may require that the signature of the natural person who signs be accompanied by:

(i) an indication in letters of the family or principal name and the given or secondary name or names of that person or, at the option of that person, of the name or names customarily used by the said person;

(ii) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.

(2) [*Date of Signing*] A Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required but is not supplied, the date on which the signing is deemed to have been effected shall be the date on which the communication bearing the signature was received by the Office or, if the Contracting Party so permits, a date earlier than the latter date.

(3) [*Signature of Communication on Paper*] Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party:

[Rule 9(3), continued]

(i) shall, subject to item (iii), accept a handwritten signature;

(ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;

(iii) may, where the natural person who signs the communication is a national of the Contracting Party and such person's address is on its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment on its territory, require that a seal be used instead of a handwritten signature.

(4) [*Signature of Communications Filed in Electronic Form or by Electronic Means Resulting in Graphic Representation*] Where a Contracting Party permits the filing of communications in electronic form or by electronic means, it shall consider such a communication signed if a graphic representation of a signature accepted by that Contracting Party under paragraph (3) appears on that communication as received by the Office of that Contracting Party.

(5) [*Signature of Communications Filed in Electronic Form Not Resulting in Graphic Representation of Signature*] (a) Where a Contracting Party permits the filing of communications in electronic form, and a graphic representation of a signature accepted by that Contracting Party under paragraph (3) does not appear on such a communication as received by the Office of that Contracting Party, the Contracting Party may require that the communication be signed using a signature in electronic form as prescribed by that Contracting Party.

(b) Notwithstanding subparagraph (a), where a Contracting Party permits the filing of communications in electronic form in a particular language, and there are requirements applicable to that Contracting Party under the Patent Cooperation Treaty in relation to signatures in electronic form of communications filed in electronic form in that language which do not result in a graphic representation of the signature, the Office of that Contracting Party shall accept a signature in electronic form in accordance with those requirements.

(c) Rule 8(2)(b) shall apply *mutatis mutandis*.

(6) [*Exception to Certification of Signature Under Article 8(4)(b)*] A Contracting Party may require that any signature referred to in paragraph (5) be confirmed by a process for certifying signatures in electronic form specified by that Contracting Party.

Rule 10

Details Concerning Indications Under Article 8(5), (6) and (8)

(1) [*Indications Under Article 8(5)*] (a) A Contracting Party may require that any communication:

(i) indicate the name and address of the applicant, owner or other interested person;

(ii) indicate the number of the application or patent to which it relates;

(iii) contain, where the applicant, owner or other interested person is registered with the Office, the number or other indication under which he is so registered.

(b) A Contracting Party may require that any communication by a representative for the purposes of a procedure before the Office contain:

(i) the name and address of the representative;

(ii) a reference to the power of attorney, or other communication in which the appointment of that representative is or was effected, on the basis of which the said representative acts;

(iii) where the representative is registered with the Office, the number or other indication under which he is registered.

[Rule 10, continued]

(2) [*Address for Correspondence and Address for Legal Service*] A Contracting Party may require that the address for correspondence referred to in Article 8(6)(i) and the address for legal service referred to in Article 8(6)(ii) be on a territory prescribed by that Contracting Party.

(3) [*Address Where No Representative Is Appointed*] Where no representative is appointed and an applicant, owner or other interested person has provided, as his address, an address on a territory prescribed by the Contracting Party under paragraph (2), that Contracting Party shall consider that address to be the address for correspondence referred to in Article 8(6)(i) or the address for legal service referred to in Article 8(6)(ii), as required by the Contracting Party, unless that applicant, owner or other interested person expressly indicates another such address under Article 8(6).

(4) [*Address Where Representative Is Appointed*] Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for correspondence referred to in Article 8(6)(i) or the address for legal service referred to in Article 8(6)(ii), as required by the Contracting Party, unless that applicant, owner or other interested person expressly indicates another such address under Article 8(6).

(5) [*Sanctions for Non-Compliance With Requirements Under Article 8(8)*] No Contracting Party may provide for the refusal of an application for failure to comply with any requirement to file a registration number or other indication under paragraph (1).

Rule 11

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

(1) [*Time Limit Under Article 8(7)*] The time limit referred to in Article 8(7) shall be not less than two months from the date of the notification referred to in that Article.

(2) [*Time Limit Under Article 8(8)*] The time limit referred to in Article 8(8) shall be:

(i) subject to item (ii), the time limit applied under paragraph (1);

(ii) where a notification under Article 8(7) has not been made because indications allowing the applicant, owner or other interested person to be contacted by the Office have not been filed, not less than three months from the date on which the communication referred to in that Article was received by the Office.

Rule 12

*Details Concerning Relief in Respect of
Time Limits Under Article 11*

(1) [*Requirements Under Article 11(1)*] (a) A Contracting Party may require that a request referred to in Article 11(1):

(i) be signed by the applicant or owner;

(ii) contain an indication to the effect that extension of a time limit is requested, and an identification of the time limit in question.

(b) Where a request for extension of a time limit is filed after the expiration of the time limit, a Contracting Party may require that all of the requirements in respect of which the time limit for the action concerned applied be complied with at the same time as the request is filed.

(2) [*Period and Time Limit Under Article 11(1)*] (a) The period of extension of a time limit referred to in Article 11(1) shall be not less than two months from the date of the expiration of the unextended time limit.

(b) The time limit referred to in Article 11(1)(ii) shall expire not earlier than two months from the date of the expiration of the unextended time limit.

[Rule 12, continued]

(3) [*Requirements Under Article 11(2)(i)*] A Contracting Party may require that a request referred to in Article 11(2):

(i) be signed by the applicant or owner;

(ii) contain an indication to the effect that relief in respect of non-compliance with a time limit is requested, and an identification of the time limit in question.

(4) [*Time Limit for Filing a Request Under Article 11(2)(ii)*] The time limit referred to in Article 11(2)(ii) shall expire not earlier than two months from the date of the expiration of the time limit that was not complied with.

(5) [*Exceptions Under Article 11(3)*] (a) No Contracting Party shall be required under Article 11(1) or (2) to grant:

[(i) a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 11(1) or (2);]

(ii) relief for filing a request for relief under Article 11(1) or (2) or a request for re-instatement under Article 12(1);

(iii) relief in respect of a time limit for the payment of maintenance fees;

[Rule 12(5)(a), continued]

(iv) relief in respect of a time limit referred to in Article 13(1), (2) or (3);

[(v) relief in respect of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;]

(vi) relief in respect of a time limit for an action in *inter partes* proceedings;

[(vii) relief in respect of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted.]

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements of a procedure before the Office shall be required under Article 11(1) or (2) to grant relief in respect of a time limit for an action in that procedure in respect of any of those requirements beyond that maximum time limit.

Rule 13

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

(1) [*Requirements Under Article 12(1)(i)*] A Contracting Party may require that a request referred to in Article 12(1)(i) be signed by the applicant or owner.

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

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

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

(3) [*Exceptions Under Article 12(2)*] The exceptions referred to in Article 12(2) are failure to comply with a time limit:

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

[(ii) for the payment of maintenance fees;]

[Rule 13(3), continued]

(iii) for making a request for relief under Article 11(1) or (2) or a request for re-instatement under Article 12(1);

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

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

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

(vii) for an action in *inter partes* proceedings.

Rule 14

Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13

(1) [*Exception Under Article 13(1)*] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before any technical preparations for publication of the application have been completed.

(2) [*Requirements Under Article 13(1)(i)*] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant.

(3) [*Time Limit Under Article 13(1)(ii)*] The time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(4) [*Time Limits Under Article 13(2)*] (a) The time limit referred to in Article 13(2), introductory part, shall be not less than two months from the date on which the priority period expired.

(b) The time limit referred to in Article 13(2)(ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier.

(5) [*Requirements Under Article 13(2)(i)*] A Contracting Party may require that a request referred to in Article 13(2)(i):

(i) be signed by the applicant; and

(ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

(6) [*Requirements Under Article 13(3)*] (a) A Contracting Party may require that a request referred to in Article 13(3)(i):

(i) be signed by the applicant; and

(ii) indicate the Office to which the request for a copy of the earlier application had been made and the date of that request.

(b) A Contracting Party may require that:

[Rule 14(6)(b), continued]

(i) a declaration or other evidence in support of the request referred to in Article 13(3) be filed with the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in Article 13(3) be filed with the Office within a time limit which shall be not less than one month from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.

(7) [*Time Limit Under Article 13(3)(iii)*] The time limit referred to in Article 13(3)(iii) shall be two months before the expiration of the time limit prescribed in Rule 4(1).

Rule 15

Request for Recordation of Change in Name or Address

(1) [*Request*] Where there is no change in the person of the applicant or owner but there is a change in his name or address, a Contracting Party shall accept that a request for recordation of the change be made in a communication signed by the applicant or owner and containing the following indications:

- (i) an indication to the effect that recordation of a change in name or address is requested;
- (ii) the number of the application or patent concerned;
- (iii) the change to be recorded;
- (iv) the name and address of the applicant or the owner prior to the change.

(2) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request referred to in paragraph (1).

(3) [*Single Request*] (a) A single request shall be sufficient even where the change relates to both the name and address of the applicant or the owner.

[Rule 15(3), continued]

(b) A single request shall be sufficient even where the change relates to more than one application or patent of the same person, or to one or more applications and one or more patents of the same person, provided that the numbers of all applications and patents concerned are indicated in the request. A Contracting Party may require that, where that single request is filed on paper or by other means permitted by the Office, a separate copy thereof be filed for each application and patent to which it relates.

(4) [*Evidence*] A Contracting Party may require that evidence be filed with the Office where the Office may reasonably doubt the veracity of any indication contained in the request.

(5) [*Prohibition of Other Requirements*] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the request referred to in paragraph (1), except where otherwise provided for by the Treaty or prescribed in these Regulations. In particular, the filing of any certificate concerning the change may not be required.

(6) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (3) are not complied with, or where evidence is required under paragraph (4), the Office shall notify the applicant or owner, giving an opportunity to comply with any such requirement, and to make observations, within not less than two months from the date of the notification.

(7) [*Non-Compliance with Requirements*] (a) Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (4) are not complied with within the time limit under subparagraph (b), the Contracting Party may provide that the request shall be refused, but no more severe sanction may be applied.

(b) The time limit referred to in subparagraph (a) shall be:

(i) subject to item (ii), not less than two months from the date of the notification;

(ii) where indications allowing the Office to contact the person who made the request referred to in paragraph (1) have not been filed, not less than three months from the date on which that request was received by the Office.

(8) [*Change in the Name or Address of the Representative, or in the Address for Correspondence or Address for Legal Service*] Paragraphs (1) to (7) shall apply, *mutatis mutandis*, to any change in the name or address of the representative, and to any change relating to the address for correspondence or address for legal service.

Rule 16

Request for Recordation of Change in Applicant or Owner

(1) [*Request for Recordation of a Change in Applicant or Owner*] (a) Where there is a change in the person of the applicant or owner, a Contracting Party shall accept that a request for recordation of the change be made in a communication signed by the applicant or owner, or by the new applicant or new owner, and containing the following indications:

(i) an indication to the effect that a recordation of change in applicant or owner is requested;

(ii) the number of the application or patent concerned;

(iii) the name and address of the applicant or owner;

(iv) the name and address of the new applicant or new owner;

(v) the date of the change in the person of the applicant or owner;

(vi) the name of a State of which the new applicant or new owner is a national if he is the national of any State, the name of a State in which the new applicant or new owner has his domicile, if any, and the name of a State in which the new applicant or new owner has a real and effective industrial or commercial establishment, if any;

(vii) the basis for the change requested.

(b) A Contracting Party may require that the request contain:

(i) a statement that the information contained in the request is true and correct;

(ii) information relating to any government interest by that Contracting Party.

(2) [*Documentation of the Basis of the Change in Applicant or Owner*] (a) Where the recordation of a change in applicant or owner results from a contract, a Contracting Party may require that the request include information relating to the registration of the contract, where registration is compulsory under the applicable law of the Contracting Party, and [, where the recordation is requested by the new applicant or the new owner, rather than by the applicant or owner,] that it be accompanied, at the option of the requesting party, by one of the following:

(i) a copy of the contract, which copy may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original contract;

[Rule 16(2)(a), continued]

(ii) an extract of the contract showing the change, which extract may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being a true extract of the contract;

(iii) an uncertified certificate of transfer of ownership by contract drawn up with the content as prescribed in the Model International Form or Model International Format in respect of a certificate of transfer and signed by both the applicant and the new applicant, or by both the owner and the new owner.

(b) Where the change in applicant or owner results from a merger, or from the reorganization or division of a legal entity, a Contracting Party may require that the request be accompanied by a copy of a document, which document originates from a competent authority and evidences the merger, or the reorganization or division of the legal entity, and any attribution of rights involved, such as a copy of an extract from a register of commerce. A Contracting Party may also require that the copy be certified, at the option of the requesting party, by the authority which issued the document or by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original document.

(c) Where the change in applicant or owner does not result from a contract, a merger, or the reorganization or division of a legal entity, but results from another ground, for example, by operation of law or a court decision, a Contracting Party may require that the request be accompanied by a copy of a document evidencing the change. A Contracting Party may also require that the copy be certified as being in conformity with the original document, at the option of the requesting party, by the authority which issued the document or by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office.

(d) Where the change is in the person of one or more but not all of several co-applicants or co-owners, a Contracting Party may require that evidence of the consent to the change of any co-applicant or co-owner in respect of whom there is no change be provided to the Office.

(3) [*Translation*] A Contracting Party may require a translation of any document filed under paragraph (2) that is not in a language accepted by the Office.

(4) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request referred to in paragraph (1).

[Rule 16, continued]

(5) [*Single Request*] A single request shall be sufficient even where the change relates to more than one application or patent of the same person, or to one or more applications and one or more patents of the same person, provided that the change in applicant or owner is the same for all applications and patents concerned, and the numbers of all applications and patents concerned are indicated in the request. A Contracting Party may require that, where that single request is filed on paper or by other means permitted by the Office, a separate copy thereof be filed for each application and patent to which it relates.

(6) [*Evidence*] A Contracting Party may require that evidence, or further evidence in the case of paragraph (2), be filed with the Office where that Office may reasonably doubt the veracity of any indication contained in the request or in any document referred to in the present Rule, or the accuracy of any translation referred to in paragraph (3).

(7) [*Prohibition of Other Requirements*] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (6) be complied with in respect of the request referred to in this Article, except where otherwise provided for by the Treaty or prescribed in these Regulations.

(8) [*Notification; Non-Compliance with Requirements*] Rule 15(6) and (7) shall apply, *mutatis mutandis*, where one or more of the requirements applied under paragraphs (1) to (5) are not complied with, or where evidence, or further evidence, is required under paragraph (6).

(9) [*Exclusion with Respect to Inventorship*] A Contracting Party may exclude the application of this Rule in respect of changes in inventorship. What constitutes inventorship shall be determined under the applicable law of the Contracting Party.

Rule 17

Request for Recordation of a Licensing Agreement or Security Interest

(1) [*Request for Recordation of a Licensing Agreement*] (a) Where a licensing agreement in respect of an application or patent may be recorded under the applicable law, the Contracting Party shall accept that a request for recordation of that licensing agreement be made in a communication signed by the licensor or the licensee and containing the following indications:

(i) an indication to the effect that a recordation of a licensing agreement is requested;

(ii) the number of the application or patent concerned;

(iii) the name and address of the licensor;

(iv) the name and address of the licensee;

(v) an indication of whether the license is an exclusive license or a non-exclusive license;

(vi) the name of a State of which the licensee is a national if he is the national of any State, the name of a State in which the licensee has his domicile, if any, and the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any.

(b) A Contracting Party may require that the request contain:

(i) a statement that the information contained in the request is true and correct;

(ii) information relating to any government interest by that Contracting Party;

(iii) information relating to the registration of the licensing agreement, where registration is compulsory under the applicable law of that Contracting Party.

(2) [*Documentation of the Basis of the Licensing Agreement*] (a) A Contracting Party may require that [, where the recordation is requested by the licensee, rather than by the licensor,] the request be accompanied, at the option of the requesting party, by one of the following:

[Rule 17(2)(a), continued]

(i) a copy of the licensing agreement, which copy may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original licensing agreement;

(ii) an extract of the licensing agreement consisting of those portions of that agreement which show the rights licensed and their extent, which extract may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being a true extract of the licensing agreement.

(b) A Contracting Party may require that any applicant, owner, exclusive licensee, co-applicant, co-owner or co-exclusive licensee who is not party to a licensing agreement give his consent to the recordation of that licensing agreement in a communication to the Office.

(3) [*Translation*] A Contracting Party may require a translation of any document filed under paragraph (2) that is not in a language accepted by the Office.

(4) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request referred to in paragraph (1).

[Rule 17, continued]

(5) [*Single Request*] Rule 16(5) shall apply, *mutatis mutandis*, to requests for recordation of a licensing agreement.

(6) [*Evidence*] Rule 16(6) shall apply, *mutatis mutandis*, to requests for recordation of a licensing agreement.

(7) [*Prohibition of Other Requirements*] No Contracting Party may require that requirements other than those referred to in paragraphs (1) to (6) be complied with in respect of the request referred to in paragraph (1), except where otherwise provided for by the Treaty or prescribed in these Regulations.

(8) [*Notification; Non-Compliance with Requirements*] Rule 15(6) and (7) shall apply, *mutatis mutandis*, where one or more of the requirements applied under paragraphs (1) to (5) are not complied with, or where evidence, or further evidence, is required under paragraph (6).

(9) [*Request for Recordation of a Security Interest or Cancellation of the Recordation of a Licensing Agreement or a Security Interest*] Paragraphs (1) to (8) shall apply, *mutatis mutandis*, to requests for:

- (i) recordation of a security interest in respect of an application or patent;

[Rule 17(9), continued]

(ii) cancellation of the recordation of a licensing agreement or a security interest in respect of an application or patent.

Rule 18

Request for Correction of a Mistake

(1) [Request] (a) Where an application, a patent or any request communicated to the Office in respect of an application or a patent contains a mistake which is correctable under the applicable law, the Contracting Party shall accept that a request for correction of that mistake in the records and publications of the Office be made in a communication signed by the applicant or owner and containing the following indications:

- (i) an indication to the effect that a correction of mistake is requested;
- (ii) the number of the application or patent concerned;
- (iii) the mistake to be corrected;
- (iv) the correction to be made;
- (v) the name and address of the requesting party.

(b) A Contracting Party may require that the request be accompanied by a replacement part or part incorporating the correction or, where paragraph (3) applies, by such a replacement part or part incorporating for each application and patent to which the request relates.

[Rule 18(1), continued]

(c) A Contracting Party may require that the request be subject to a declaration by the requesting party stating that the mistake was made in good faith.

(d) A Contracting Party may require that the request be subject to a declaration by the requesting party stating that the said request was made without undue delay or, at the option of the Contracting Party, that it was made without intentional delay, following the discovery of the mistake.

(2) [*Fees*] (a) Subject to subparagraph (b), a Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(b) The Office shall correct its own mistakes, *ex officio* or upon request, for no fee.

(3) [*Single Request*] Rule 16(5) shall apply, *mutatis mutandis*, to requests for correction of a mistake, provided that the mistake and the requested correction are the same for all applications and patents concerned.

(4) [*Evidence*] A Contracting Party may, where the Office may reasonably doubt that the alleged mistake is in fact a mistake, or where it may reasonably doubt the veracity of any matter contained in, or of any document filed in connection with, the request for correction of a mistake, require that evidence in support of the request be filed with the Office.

(5) [*Prohibition of Other Requirements*] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the request referred to in paragraph (1), except where otherwise provided for by the Treaty or prescribed in these Regulations.

(6) [*Notification; Non-Compliance with Requirements*] Rule 15(6) and (7) shall apply, *mutatis mutandis*, where one or more of the requirements applied under paragraphs (1) to (3) are not complied with, or where evidence is required under paragraph (4).

(7) [*Exclusions*] (a) A Contracting Party may exclude the application of this Rule in respect of changes in inventorship. What constitutes inventorship shall be determined under the applicable law of the Contracting Party.

(b) A Contracting Party may exclude the application of this Rule in respect of any mistake which must be corrected in that Contracting Party under a procedure for reissue of the patent.

Rule 19

*Manner of Identification of an Application
Without Its Application Number*

(1) [*Manner of Identification*] Where it is required that an application be identified by its application number, but such a number has not yet been issued or is not known to the person concerned or his representative, the application shall be considered identified if one of the following is supplied, at that person's option:

- (i) the provisional application number, if any, given by the Office;
- (ii) a copy of the request part of the application along with the date on which the application was sent to the Office;
- (iii) a reference number given to the application by the applicant or his representative and indicated in the application, along with the name and address of the applicant, the title of the invention and the date on which the application was sent to the Office.

(2) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraph (1) be complied with in order for an application to be identified where its application number has not yet been issued or is not known to the person concerned or his representative.

Rule 20

Establishment of Model International Forms and Formats

(1) [*Model International Forms*] (a) The Assembly shall, under Article 14(1)(c), establish Model International Forms in respect of:

- (i) a power of attorney;
- (ii) a request for recordation of change in name or address;
- (iii) a request for recordation of change in applicant or owner;
- (iv) a certificate of transfer;
- (v) a request for recordation, or cancellation of recordation, of a licensing agreement;
- (vi) a request for recordation, or cancellation of recordation, of a security interest;
- (vii) a request for correction of a mistake.

(b) The Assembly shall establish the modifications of the Patent Cooperation Treaty request Form referred to in Rule 3(2)(i).

[Rule 20(1), continued]

(c) The International Bureau shall present proposals to the Assembly concerning:

(i) the establishment of Model International Forms referred to in subparagraph (a);

(ii) the modifications of the Patent Cooperation Treaty request Form referred to in subparagraph (b).

(2) [*Model International Formats*] (a) The Assembly shall, under Article 14(1)(c), establish any Model International Formats in respect of the request Format referred to in Rule 3(2)(iv) and the items referred to in paragraph (1)(a).

(b) The International Bureau shall present proposals to the Assembly concerning the establishment of Model International Formats referred to in subparagraph (a).

Rule 21

Requirement of Unanimity for Amending Certain Rules Under Article 14(3)

Amendment of the following Rules shall require unanimity:

- (i) Rule 3(1);
- (ii) Rule 8(1)(a);
- (iii) the present Rule.

[End of document]