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EXPLANATORY NOTES ON THE BASIC PROPOSAL
FOR THE PATENT LAW TREATY AND
THE REGULATIONS UNDER THE PATENT LAW TREATY

prepared by the International Bureau

INTRODUCTION

1. The present document contains the explanatory notes on the basic proposal for the Patent Law Treaty and the Regulations under the Patent Law Treaty, which appears in documents PT/DC/3 and 4. Where a provision appears not to require explanation, no note has been provided.
2. The explanatory notes contained in this document are prepared by the International Bureau, but are neither adopted by the Standing Committee on the Law of Patents, nor intended to be adopted by the Diplomatic Conference. Therefore, where a conflict exists between the notes and the provisions of the Treaty and the Regulations, the latter prevail.
3. Text which appears in italics reflects the current positions of certain delegations, and will not appear in the final version of the explanatory notes which would be published with the adopted Treaty.

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I. EXPLANATORY NOTES ON THE BASIC PROPOSAL FOR THE PATENT LAW 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 intergovernmental 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” covers the situation in which the Office of a Contracting Party administers procedures in respect of patents, for example, the recordation of change of owner, even if patents are granted on its behalf by another Office, for example, a regional Office.

1.02 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 applies to an entity that is assimilated to a legal entity under the applicable national law.

1.03 Item (v). The term “communication” is used in the Treaty and Regulations to refer only to matter which is filed with 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. The limitation of this item to filings by “means

permitted by the Office” allows a Contracting Party to disregard any communication that is filed by means which that Office does not permit. Reference is also made to the provisions of Article 8(1) and Rule 8 (see Notes 8.02 to 8.04 and R8.01 to R8.05).

1.04 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 corrections of mistakes referred to in Rule 18(1). 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 (EPO) is a Contracting Party.

1.05 Item (vii). The term “recordation” 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.

1.06 Items (viii) and (ix). The terms “applicant” and “owner” are used in the Treaty and Regulations to refer only to the person who is indicated as such in the records of the Office. Accordingly, 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 the Treaty or the Regulations. In the case of a request for recordation of a change in the person of the applicant or owner (see Rule 16), during the period of time between the actual legal transfer and recordation 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 16(1)). Once recordation 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).

1.07 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” would be 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, 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 filing the application” could, for example, be the inventor’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” are to 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.

1.08 Item (x). The term “representative” refers to any attorney, agent or other person, or to any firm or partnership, that can be a representative under the applicable law. Under Article 7(1)(a), a Contracting Party may require that any representative who is appointed shall have the right to practice before the Office, and that any such representative shall provide, as his address, an address on a territory prescribed by that Contracting Party (see Notes 7.02 to 7.04).

1.09 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 a signature filed in electronic form or by electronic means.

1.10 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 has different language requirements for different procedures, as will normally be the case in view of the obligation on Contracting Parties under Article 5(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.*

1.11 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 proceedings before the Office or in the course of such proceedings. It covers all procedures in

proceedings before the Office and is therefore not restricted to those procedures which are referred to in express terms under Articles 5 to 14. Examples of such procedures are the filing of an application, the filing of a request for recordation of a licensing agreement, the payment of a fee, the filing of a response to a notification issued by the Office, or the filing 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, for legal purposes, do not constitute a part of the proceedings before the Office with respect to an application or patent, 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.

1.12 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.

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

Note on Article 2

(General Principles)

2.01 Paragraph (1). This paragraph is included for the avoidance of doubt. It states, in express terms, a principle which applies to all of the provisions of the Treaty other than Article 5. It recognizes that the Treaty does not establish a completely uniform procedure for all Contracting Parties, but provides assurance for applicants and owners that, for example, an application that complies with the maximum requirements permitted under the Treaty and Regulations will comply with formal requirements applied by any Contracting Party. A similar provision is contained in PCT Article 27(4).

2.02 Paragraph (2). This paragraph is included for the avoidance of doubt. A similar provision is contained in PCT Article 27(5), first sentence.

Note on Article 3

(Applications and Patents to Which the Treaty Applies)

3.01 Paragraph (1)(a). Under this provision, the Treaty and Regulations apply to certain 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 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 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.

3.02 The expression “applications...which are filed ... for the Office of a Contracting Party” covers, in particular, applications for a regional patent that are filed with the Office of a State (X), which is a Contracting State of a regional organization, for onward transmission to the Office of that organization. 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 EPO 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 EPO 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 EPO 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.

3.03 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 do not apply to applications which are listed in that Article as alternative to applications for patents for invention and applications for patents of

addition, 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 is free to apply some or all of the provisions of the Treaty and Regulations to such other applications, even though it is not obliged to do so. Similarly, the Treaty and Regulations do not apply to applications for "plant patents" which are not patents for invention, although they do apply to applications for patents in respect of plants which are inventions, for example plants which are the result of genetic engineering.

3.04 Item (i). Under this item, the Treaty and Regulations apply to those types of applications for patents for invention and for patents of addition which can be filed as international applications under the PCT. In addition to "conventional applications," in respect of which no special treatment is requested, the Treaty and Regulations also apply to applications for continuation or continuation-in-part of an earlier application, in accordance with PCT Rule 4.14. Since it is possible to convert, in the "national phase," an international application in the name of a sole inventor to an application in the name of joint inventors, as in the case of a "conversion application" under the law of the United States of America, the Treaty and Regulations also apply to such conversion applications, even though they do not regulate the substantive requirements for such conversion.

3.05 The Treaty and Regulations do not apply to types of applications for patents for invention which cannot be filed as international applications under the PCT, such as provisional applications and applications for re-issue patents. The Treaty and Regulations also do not apply to applications for patent term extension, 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, they do not apply to an application for the

conversion of an application for a European Patent into a national application for one or more designated States since this is a request for a different type of treatment rather than an application for the grant of a patent. However, a Contracting Party is free to apply some or all of the provisions of the Treaty and Regulations to any type of applications not covered by paragraph (1), although it is not obliged to do so. As regards divisional applications, reference is made to the explanation under item (ii) (see Note 3.06).

3.06 Item (ii). This item is included since a divisional application is not a type of application that can be filed under the PCT referred to in item (i). Reference is also made to the provisions relating to the filing date of divisional applications under Article 5(8) and Rule 2(6)(i).

3.07 Paragraph (1)(b). This paragraph would only apply with respect to Contracting Parties which are also party to the PCT. The phrase “Subject to the provisions of the Patent Cooperation Treaty” is included to ensure that the provisions of the PCT continue to apply to international applications in the “national phase.” For example, a filing date accorded under PCT Article 11(2)(b) to an international application could not be challenged by the applicant, once that application has entered the national phase, on the grounds that the application is entitled to an earlier filing date under Article 5(1)(a) of the Patent Law Treaty.

3.08 Item (i). Under this item, the Treaty and Regulations, in particular, the provisions in respect of time limits under Articles 11 and 12 and Rules 12 and 13, apply in relation to the time limits under PCT Articles 22 and 39(1), namely the time limits 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. However, those provisions do not

apply in respect of time limits in the “international phase” of an international application, which are governed by the PCT.

3.09 Item (ii). Under this item, the Treaty and Regulations apply to international applications for patents for invention and for patents of addition after such applications have entered the “national phase” in a national or regional Office under the PCT.

3.10 Paragraph (2). The Treaty and Regulations 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 is party to the Treaty. For example, if State X referred to in Note 3.02 were party to the Treaty, the Treaty would apply both to patents granted by the Office of State X and to patents granted by the EPO having effect in State X, irrespective of whether the EPO were party to the Treaty. If the EPO were party to the Treaty, the Treaty and Regulations would apply to all European patents for the purposes of any procedures before the EPO, for example, the revocation of patents in opposition proceedings, even if State X were not party to the Treaty.

3.11 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 do 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 3.03). However, a Contracting Party is free to apply some or all of the

provisions of the Treaty and Regulations to such other patents, even though it is not 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 apply to patents for inventions and patents of addition granted on international applications.

3.12 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 3.05), 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 4

(National Security)

4.01 A similar provision is contained in PCT Article 27(8).

Note on Article 5

(Filing Date)

5.01 A Contracting Party is obliged to accord a filing date to an application which complies with the requirements applicable under this Article. Furthermore, a Contracting Party is not permitted to revoke the filing date accorded to an application which complies with those requirements. In particular, the filing date of an application may not be revoked for failure to comply with a requirement under Article 6, 7 or 8 within the applicable time limit, even if that application is subsequently refused on the grounds of such non-compliance (see also Note 5.02). *Article 5 is subject to a reservation by the Delegation of Portugal.*

5.02 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 are intended to be an application for a patent. 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 is not 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 which may be required under Article 6(1)(i) (with reference to PCT Article 3(2)), a Contracting Party may require that these be subsequently filed under Article 6(7), within the time limit prescribed in Rule 6(1). However, the failure to file 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 6(8)(a). Another example may be that, in accordance with Article 6(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. The same considerations apply where an application does not comply with any other requirement under Article 6, 7 or 8, for example, it is not accompanied by a filing fee required under Article 6(4). *This paragraph is subject to a reservation by the Delegation of Spain.*

5.03 Paragraph (1)(a), introductory words. 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 as provided for under paragraph (4).

5.04 Each Contracting Party is free to decide for itself what constitutes the date on which its Office has received all of the elements. This would apply where, for example, 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, a Contracting Party is free to deem, as receipt by the Office, receipt of an application 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.

5.05 The introductory words also obliges a Contracting Party to accept, for the purposes of the filing date, the filing of items (i) to (iii) “on paper or by other means permitted by the

Office.” This obligation to accept filing on paper, for the purpose of the filing date, will continue to apply even where a Contracting Party is permitted to exclude the filing of communications on paper after the expiration of the 10 year period prescribed in Rule 8(1). The term “by other means permitted by the Office” relates, in particular, to the case where the required elements are filed in electronic form or by electronic means permitted by the Contracting Party concerned under Rule 8(2). The restriction to “means permitted by the Office” is necessary since an Office may not have the technical capability to accept filings in all electronic forms or by all electronic means. Where an application that complies with the filing date requirements under paragraph (1) does not comply with the requirements in respect of the form, format and means of filing of communications applied by the Contracting Party concerned under Article 8(1) and Rule 8, that Contracting Party is permitted to require, under Article 8(7), that, for the application to proceed, the applicant comply with those requirements within the time limit prescribed in Rule 11(1). However, failure to do so would not result in the subsequent loss of the filing date, even if the application were refused under Article 8(8).

5.06 Without the text in square brackets, “no later than,” the filing date would, subject to the provisions of paragraphs (1)(b) and (2) to (8), be the date on which the Office has received all of the three elements under items (i) to (iii). If that text were included without surrounding square brackets, a Contracting Party would be free, but not obliged, to accord an earlier filing date. For example, in the case of a delay in the mail or other means of filing, the Office may be able to establish the contents of the application on the date on which that application would have been received if there had been no such delay. *Paragraph (1)(a) is subject to a reservation by the Delegation of Belgium.*

5.07 Item (i). It follows from the definition of the term “application” in Article 1(ii) and the provisions of Article 3(1)(a), that this item requires an express or an implicit indication to the effect that the elements referred to are intended to be a national or regional application to which the Treaty and Regulations apply. 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 such an application, is 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).

5.08 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,” is a matter to be determined by the Office in the circumstances of that case. Where an application complies with the requirements of paragraph (1), but does not indicate the name and address of the applicant required under Article 6(1)(i) (with reference to PCT Rule 4.4 and 4.5), a Contracting Party may require that these indications be subsequently filed under Article 6(7), within the time limit prescribed in Rule 6(1). However, the failure to file such indications within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 6(8)(a).

5.09 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 only needs to establish whether, in its opinion, the application contains a part that on the face of it appears to constitute a description. The questions whether that part satisfies requirements relating to the description allowed under Article 6(1), or the substantive requirements for the grant of a patent, are not relevant to this determination.

5.10 Paragraph (1)(b). This provision permits, but does 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 whether, for example, a photograph is considered a drawing for the purposes of this provision is a matter for the Contracting Party concerned. Where the Office of a Contracting Party which does not apply this provision receives an application in which the invention is disclosed only in one or more drawings that incorporate textual matter, it is for that Office to determine whether, in the circumstances of the case, such textual matter fulfills the requirement under paragraph (1)(a)(iii).

5.11 It is to be noted that a country of the Paris Union is, at present, 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, gives rise to a right of priority under Article 4A(2) of the Paris Convention.

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

5.13 Paragraph (2)(b). This provision requires a Contracting Party to accept, for the purpose of establishing a filing date, a “part which on the face of it appears to be a description” which is filed in any language. Where that part is filed in a language which is not a language accepted by the Office, the Contracting Party may require that a translation of the description referred to in Article 6(3) be filed, under Article 6(7), within the time limit prescribed in Rule 6(1). However, 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 6(8)(a).

5.14 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).

5.15 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 referred to in Article 6(3) be filed, under Article 6(7), within the time limit prescribed in Rule 6(1) (see also Note 6.13). 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 6(8)(a).

5.16 Paragraph (3). Reference is made to the general provisions concerning notifications under Article 9 (see Notes 9.01 to 9.05).

5.17 Paragraph (4)(a). This provision permits an applicant to subsequently remedy any non-compliance with the requirements under paragraphs (1) and (2). It applies whether or not the applicant has been notified of such non-compliance under paragraph (3). This provision gives

the applicant the possibility of proceeding with the application on the basis of the elements which have been filed and any fees already paid, without the need to refile the application or pay additional filing fees. However, for the proper conduct of business before the Office, a Contracting Party may provide that this possibility be subject to the time limit applicable under paragraph (4)(b) (see Note 5.18). The text in square brackets, “no later than,” is consequential to the same text in square brackets in paragraph (1) (see Note 5.06).

5.18 Paragraph (4)(b). This provision permits, but does not oblige, a Contracting Party to regard an application as not having been filed, where the requirements referred to in paragraphs (1) and (2) that were not complied with when the application was first received by the Office are not complied with within the time limit prescribed in Rule 2(2). An applicant who wishes to proceed with an application that has been regarded as not having been filed under this provision, would have 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.

5.19 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 is to be noted that this provision does not require the Office to check, in establishing the filing date, whether a part of the description or drawing is missing. Reference is also made to the general provisions concerning notifications under Article 9 (see Notes 9.01 to 9.05).

5.20 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). The text in square brackets “no later than,” would be included only if the same text in square brackets is adopted in paragraph (1). Without the text in square brackets, 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, provided that all of the requirements for the accordal of a filing date under paragraphs (1) and (2) are complied with on that date. If that text were included without surrounding square brackets, 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.

5.21 Paragraph (6)(b). This provision obliges 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 missing drawing is contained in an earlier application and the requirements prescribed in Rule 2(4) are complied with (see Notes R2.03 and R2.04). The text in square brackets, “no later than,” would be included only if that text is adopted in paragraph (1).

5.22 Paragraph (6)(c). This provision permits the applicant to withdraw a later filed 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). The text in square

brackets, “no later than,” would be included consequently only if that text is adopted in paragraph (1).

5.23 Paragraph (7). *This paragraph is subject to a reservation by the Delegation of China.*

5.24 Paragraph (7)(a). This provision obliges a Contracting Party to accept, at the time of filing, the replacement of the description and any drawings in an application by a reference to a previously filed application, subject to compliance with the requirements of Rule 2(5) (see Notes R2.05 to R2.08). A Contracting Party may require, in accordance with Article 6(1)(i) (with reference to PCT Article 3(2)), that the replaced description and drawings be filed under Article 6(7) within the time limit prescribed in Rule 6(1). The failure to file that description or drawings within that time limit would not result in the subsequent loss of the filing date, even if the application were refused under Article 6(8)(a). *This provision is subject to a reservation by the Delegation of Japan.*

5.25 Paragraph (7)(b). Under this provision, an application may be considered as not having been filed where the applicant fails to comply with the requirements under Rule 2(5). In accordance with the phrase “a reference, made upon the filing of the application” in paragraph (7)(a), it is implicit that the requirements applied under Rule 2(5)(a) must be complied with on the filing date of the application. Any requirements applied under Rule 2(5)(b) must be complied with within the time limit applied under that Rule (see also Note 6.22).

5.26 Paragraph (8), item (ii). The types of application under this item are prescribed in Rule 2(6).

Note on Article 6

(Application)

6.01 Paragraph (1). The purpose of this paragraph is to apply the requirements relating to the form or contents of international applications under the PCT, to the extent possible, to national and regional applications. The wording of this provision is modeled after PCT Article 27(1).

6.02 It is implicit that 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.”

6.03 In accordance with the general principle contained in Article 2(2), paragraph (1) is similarly not intended to be construed as prescribing any requirements of substantive law (see Note 2.02). The requirement, allowed under Article 29.2 of the Agreement on Trade-Related Aspects of Industrial Property Rights (TRIPS Agreement), 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 relating to an invention that was, or is still being, 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."

6.04 *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).

6.05 Paragraph (1), introductory words. The requirements referred to in this introductory words which are "otherwise provided for by this Treaty or prescribed in the Regulations" are, in particular, those under paragraphs (2) to (6), Articles 7 and 8 and Rules 7 to 10.

6.06 Item (i). This item prohibits a Contracting Party from imposing requirements in respect of the form or contents of a national or regional application that are more strict than those applicable to international applications under the PCT, except where otherwise provided for in accordance with the introductory words or item (iii) of this paragraph (see Notes 6.05

and 6.09). As in the case of PCT Article 27(4), a Contracting Party is free, under Article 2(1), to provide for requirements in respect of the form or contents of national and regional applications which, from the viewpoint of applicants, are more favorable than the requirements provided for under the PCT.

6.07 Item (ii). This item permits a Contracting Party to require that a national or regional application comply with any requirements relating to the “form or contents” that any PCT Contracting State is allowed to apply in the “national phase” of an international application, in particular the requirements under PCT Rule 51*bis*.1 that are allowed under PCT Article 27(2). This item is not restricted to the particular “national phase” requirements under the PCT that the Contracting Party concerned applies, but rather applies to any “national phase” requirements allowed under the PCT.

6.08 It is implicit in items (i) and (ii) that any relevant amendments or modifications to the PCT, or to the Regulations or Administrative Instructions under the PCT, will automatically have effect under the present Treaty.

6.09 Item (iii). This item provides authority for the further requirements under Rule 3(1) in respect of divisional applications and applications by new applicants determined to be entitled to an invention contained in an earlier application.

6.10 Paragraph (2)(a). This provision permits, but does not oblige, a Contracting Party to require the use of a request Form or format prescribed by that Contracting Party. As regards the term “format”, reference is made to Note 8.02. It also allows a Contracting Party to

require that the contents of the request which are provided for in respect of international applications under PCT Rule 4.1, as well as any contents under Rule 3(1), be contained in the request.

6.11 Paragraph (2)(b). This provision obliges a Contracting Party to accept the presentation of the formal contents of a request on a request Form, or in a format, as prescribed in Rule 3(2) (see Notes R3.02 to R3.04).

6.12 The effect of the phrase “and subject to Article 8(1)” is that a Contracting Party may require that a request Form or format provided for in Rule 3(2) comply with the requirements in respect of the form, format and means of filing communications, including applications, applied by that Contracting Party under that Article and Rule 8. However, where, after the expiration of the 10 year period prescribed in Rule 8(1)(a), a Contracting Party excludes the filing of communications on paper, that Contracting Party will still be obliged, under Article 5(1), to accept, for the purposes of the filing date, the filing on paper of a request Form or format containing the indications required under Article 5(1)(a)(i) to (iii) (see Note 5.05).

6.13 Paragraph (3). This paragraph permits 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 5(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 5(2)(b) – see Note 5.13). It also permits 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 or character set. Reference is also made to the definition of the term “translation” in Article 1(xiii).

6.14 Paragraph (4). This paragraph permits, but does not oblige, a Contracting Party to charge fees in respect of applications. However, it 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 is 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 is also 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).

6.15 In addition to the fee to be paid in respect of the application, a Contracting Party may require the payment of separate fees, for example, for the publication of the application and the granting of the patent. A Contracting Party is permitted to combine those fees and require payment of such a combined fee upon the filing of the application (which may nevertheless be called an “application fee”). However, it follows from Article 5(1) that a Contracting Party may not refuse a filing date because the application fee has not been paid (see Note 5.02).

6.16 Paragraph (5). Regulations under this paragraph are prescribed in Rule 4. Where the Office reasonably doubts the veracity of the priority claim, it may request that evidence in support of the priority claim be filed 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.

6.17 Paragraph (6). The purpose of this paragraph is to reduce the burden on applicants by restricting the need for evidence in support of the formal contents of applications, declarations of priority and translations. Although it is 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 is obliged, under paragraph (7), to notify the applicant of the requirement to file evidence and, under Rule 5, to state 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 6.16.

6.18 In accordance with Article 2(2), the provisions of paragraph (6) do not apply to evidence that may be required in respect of substantive patent law. In particular, irrespective of whether or not there is reasonable doubt, a Contracting Party is permitted to require evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, as is also allowed as a national requirement in respect of international applications under PCT Rule 51*bis*.1(a)(vi).

6.19 Paragraph (7). The time limit under this paragraph is prescribed in Rule 6(1). Reference is also made to the general provisions on notifications under Articles 9 (see Notes 9.01 to 9.05).

6.20 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.*

6.21 Paragraph (8)(a). The sanction which may be applied under this provision may include refusal of the application. However, a Contracting Party could not revoke a filing date for failure to comply with requirements referred to in this provision.

6.22 Paragraph (8)(b). In accordance with Article 4D(4) of the Paris Convention, the consequence 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, the application could not be refused for failing to comply with such requirement. Nevertheless, where the description and drawings of a later application are replaced by a reference to a previously filed application under Article 5(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 5(7)(b), even though the same requirements are applicable in respect of a priority claim based on the same earlier application. The words “Subject to Article 13” are included to cover the situation in which a priority claim is corrected or added, or a priority right is restored, under that Article.

Note on Article 7

(Representation)

7.01 This Article relates only to the appointment of a representative and to the possible

limitation of the effect of such 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 is free to establish whatever provisions that 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 that allows sub-representation may require that the power of attorney expressly authorize a representative to appoint sub-representatives. Furthermore, a Contracting Party may require that, in the case of two or more co-applicants, those co-applicants be represented by a common representative.

7.02 Paragraph (1)(a), introductory words. 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 1.08 and 1.11).

7.03 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). This item permits a Contracting Party to require 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 also permits 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. This item also leaves to the applicable law the matter of whether, and what type of, a firm could be appointed as a representative.

7.04 Item (ii). This item permits a Contracting Party to require that a representative provide, as his address, an address on a territory prescribed by the Contracting Party. A Contracting Party may 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 that a communication contain the address of the representative under Rule 10(1)(b)(i) and an address for correspondence and/or legal service on its own territory under Article 8(6) and Rule 10(2) and (4).

7.05 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 1.11). 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 5(3) or 6(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 8(6).

7.06 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).

7.07 The effect of the exceptions under items (i) to (vi) is that an applicant, owner or other interested person is permitted to represent himself before the Office in respect of any of the procedures included in items (i) to (vi), provided that items (ii) to (v), which are currently in square brackets, would be included without surrounding square brackets. This is 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 8(6) and Rule 10(2), to provide an address for correspondence and/or legal service in that country.

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

7.09 Paragraph (2) is limited to procedures after the filing date for consistency with Article 5, which provides that a filing date be accorded to an application which complies with the

requirements of that Article, whether or not the applicant is represented. This limitation permits elements additional to those referred to in Article 5(1)(a), 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, if these additional elements are submitted before the filing date has been accorded. However, a Contracting Party is 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 8(6) (see Notes 1.07, 1.08, 1.13 and 8.13). *This paragraph is subject to reservations by the Delegations of Austria, Belgium, China, Cuba, Germany, Ireland, Japan, Kenya, Portugal, the Russian Federation, Spain, Tunisia and Zimbabwe.*

7.10 Item (ii). This item, which is placed in square brackets, permits an applicant to undertake, without representation, any procedure in respect of the filing date under Article 5. It includes such procedures that take place after the filing date, in particular, the filing of a missing part of the description or missing drawing under Article 5(6), and the filing of a copy of the previously filed application under Rule 2(5)(b) where the description and drawings are replaced by a reference to that application under Article 5(7).

7.11 Items (iii) and (iv). These items are placed in square brackets.

7.12 Item (v). This item, which is placed in square brackets, provides 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 contained in Rule 7(1) (see Note R7.01). *This item is subject to a reservation by the Delegation of Brazil.*

7.13 Item (vi). Under this item, 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. *This item is subject to a reservation by the Delegation of Brazil.*

7.14 Paragraph (3). The Regulations under this paragraph are prescribed in Rule 7(2) to (4).

7.15 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. The requirements referred to in this paragraph which are “otherwise provided for by this Treaty or prescribed in the Regulations” are, in particular, those under Articles 8 and Rule 7.

7.16 Paragraph (5). The time limit under this paragraph is prescribed in Rule 7(5). Reference is also made to the provisions on notification under Article 9 (see Notes 9.01 to 9.05).

7.17 Paragraph (6). The time limit under this paragraph is prescribed in Rule 7(6).

Note on Article 8

(Communications; Addresses)

8.01 As to the definition of “communication”, reference is made to Article 1(v).

8.02 Paragraph (1)(a). The requirements that a Contracting Party is permitted to apply 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 “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 “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 term “filing” refers to the submission or transmission of any communication to the Office.

8.03 Paragraph (1)(b) and (c). These provisions ensure that no Contracting Party is 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.

8.04 Paragraph (1)(d). Under this provision, a Contracting Party is obliged to continue to accept the filing of communications on paper for the purpose of complying with a time limit, even where, after the expiration of the 10 year period prescribed in Rule 8(1), that a Contracting Party chooses to exclude the filing of communications on paper. While an applicant who filed a communication on paper with an Office that requires electronic communications would not fail to comply with a time limit, the paper form would be treated as a formal defect, and the Office would be permitted to require, under paragraph (7), that the communication be re-filed in an electronic form or by electronic means complying with the requirements applied by that Contracting Party. *This paragraph is subject to a reservation by the Delegation of Japan.*

8.05 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(xii) (see Note 1.10). However, Article 5(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 that a translation be filed under Article 6(3) (see also Note 6.13). The Treaty and Regulations also expressly provide for the filing of a translation of: (i) a copy of an earlier application (Article 6(5) and Rules 2(4)(iii) and 4(4)); (ii) a copy of a previously filed application under Rule 2(5)(b)(i); (iii) a power or attorney under Rule 7(3); and (iv) documentation of the basis of a change in applicant or owner under Rule 16(3), or of the basis of a licensing agreement under Rule 17(3).

8.06 Paragraph (3). This paragraph obliges 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 20. 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 the possibility of a Contracting Party to exclude the filing of communications on paper after the expiration of the 10 year period prescribed in Rule 8(1), reference is made to the explanations under paragraph (1)(d) and Articles 5(1)(a) and 6(2)(b) (see Notes 8.04, 5.05 and 6.12).

8.07 Paragraph (4). In accordance with the definition under Article 1(xi), the term “signature” means any means of self-identification (see also Note 1.09).

8.08 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.

8.09 Paragraph (4)(b). Except in the cases referred to in Note 8.09, this provision obliges 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.

8.10 In accordance with the exception prescribed under Rule 9(6), a Contracting Party may require confirmation of a signature in electronic form which does not result in a graphic representation of the signature.

8.11 Paragraph (4)(c). In case of reasonable doubt as to the authenticity of the signature, the Office may require the applicant, owner or other person filing the communication to file evidence of authenticity. Such evidence could, at the option of the applicant, owner or other interested person, be in the form of a certification. The Office is obliged under Rule 5 to inform the applicant of the reason for its doubt. In addition, the same considerations that apply to the requirement for evidence under this provision also apply to the requirement for evidence in respect of an application under Article 6(6) (see Note 6.17).

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

8.13 Paragraph (6), introductory words. 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.

8.14 Items (i) and (ii). It is a matter for each Contracting Party to determine what constitutes an address for correspondence or an address for legal service. It is also 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 communications such address(es) shall be indicated. Since the term “address for service” may be construed, depending on the applicable law, as either of the addresses under items (i) or (ii), a Contracting Party could use the term “address for service” in place of “address for correspondence” or

“address for legal service,” or both. The Regulations under these items are prescribed in Rule 10(2) to (4) (see Notes R10.03 to R10.05). As regards the sanction for failure to comply with the requirements under paragraph (6), reference is made to paragraph (8) (see Note 8.16).

8.15 Item (iii). This item is intended to provide for any future developments which necessitate a Contracting Party requiring an address other than those under items (i) and (ii), for example, an e-mail address for the purposes of electronic communication. At present, no provision for such other address is included in the Regulations.

8.16 Paragraph (7). The time limit under this paragraph is prescribed under Rule 11(1). Reference is also made to the general provisions on notification under Article 9 (see Notes 9.01 to 9.05).

8.17 Paragraph (8). The time limit under this paragraph is prescribed in Rule 11(2). The effect of the reference to Article 5 is that, where an application complies with the requirements under that Article for according a filing date, a Contracting Party is obliged to accord that filing date, and cannot revoke the filing date for failure to comply with requirements under Article 8, even where the application is subsequently refused under this paragraph (see also Note 5.01). Reference is also made to the Regulations under this paragraph in Rule 10(5).

Note on Article 9

(Notifications)

9.01 This Article 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 applicable law of the Contracting Party concerned.

9.02 Paragraph (1). This paragraph prescribes the addresses that a Contracting Party is obliged to regard as sufficient for the purpose of notifications under the Treaty and Regulations. The reference to “any other address provided for in the Regulations for the purpose of this provision” is to provide for the possibility of permitting a Contracting Party to utilize other addresses, for example particular types of e-mail addresses, for the purpose of notifications in the future. However, no such other addresses are provided for in the Regulations at present. A Contracting Party may, but is not obliged to, additionally provide that a notification has legal effect even if it is sent to an address that is not referred to in this paragraph.

9.03 Paragraph (2). This provision is included for avoidance of doubt. It applies, in particular, where, as permitted for the purposes of the filing date under Article 5(1)(a)(ii), an application contains indications allowing the identity of the applicant to be established but not indications allowing the applicant to be contacted by the Office.

9.04 Paragraph (3). This paragraph is 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 6 and 8 are subject, under

Article 10(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.

9.05 It is also to be noted that this paragraph does not relieve the Office of any obligation under the Treaty and Regulations 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 (see Note 9.02), or where Rule 2(3)(ii) applies (see Note R2.02), the effect of non-notification of non-compliance is that the time limit for compliance does not start to run. If a patent is granted despite non-compliance with a formal requirement referred to in Article 10(1) because the Office did not send a notification, the safeguard under that Article would apply.

Note on Article 10

(Validity of Patent; Revocation)

10.01 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 where it is subsequently discovered that the application failed to comply with 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 6(7) or 8(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 9(3) (see Notes 9.04 and 9.05). 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.

10.02 Since paragraph (1) is restricted to requirements in respect of applications, it does 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 filing of a translation of a regional patent. Similarly, it covers only those fees payable prior to the grant of a patent, such as the filing, publication and grant fees. It does not cover the lapse of a patent for the non-payment of a maintenance fee. This paragraph is also not applicable where there has been a voluntary surrender of a patent for the purpose of re-issue.

10.03 A Contracting Party is 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 6(3), or evidence required under Article 6(6), had not been filed.

10.04 The exception for the situation in which the non-compliance occurred as a result of fraudulent intention is included to prevent the applicant benefiting from such fraud. What constitutes “fraudulent intention” is a matter for the relevant law of the Contracting Party. In particular, it may be interpreted to cover inequitable conduct. Alternatively, it may be restricted to the situation in which civil or criminal liability is established.

10.05 Paragraph (2). This 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, this paragraph 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 may be given the opportunity to file written observations prior to a decision in court proceedings. However, a Contracting Party may, alternatively, provide only for oral observations in such proceedings. No Contracting Party is required to provide an opportunity for amendments and corrections to be made where its national law does not provide for such amendments or corrections, either at all or in the circumstances of the particular proceedings. As in the case of paragraph (1), the phrase “A patent 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 (see Note 10.01).

Note on Article 11

(Relief in Respect of Time Limits)

11.01 This Article obliges a Contracting Party to provide relief in respect of time limits. Such relief may be in the form of an extension of a time limit under paragraph (1) and/or continued processing under paragraph (2). Such relief is subject only to the filing of a request in accordance with the requirements of paragraph (1) or (2) and Rule 12 (see Note 11.08), and the payment of any fee required under paragraph (4). Accordingly, the applicant or owner cannot be required to state the grounds on which the request is based. In addition, in contrast to the re-instatement of rights under Article 12, a Contracting Party is not permitted to make the grant of relief under Article 11 conditional on a finding of due care or unintentionality by the Office.

11.02 The relief that a Contracting Party is obliged to provide under paragraphs (1) and (2) is restricted to time limits “fixed by the Office for an action in a procedure before the Office.” It is further subject to certain exceptions under paragraph (3) and Rule 12(5) (see Notes R12.04 to R12.09). The term “procedure before the Office” is defined in Article 1(xiv) (see Note 1.11). It is for each Contracting Party to decide which time limits, if any, are fixed by the Office. An example of a time limit that is fixed by some Offices is the time limit for response to an examiner’s substantive examination report. It follows that Article 11 does not apply to time limits that are not fixed by the Office, in particular 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 that are not before the Office, for example, actions before a court. Accordingly, although a Contracting Party is free to apply the same requirements in respect of such other time limits, it is also free to apply other requirements, or to make no provision for relief (other than re-instatement of rights under Article 12), in respect of those other time limits.

11.03 Paragraph (1). This paragraph provides for relief in the form of the extension of a time limit fixed by the Office. Under item (i), a Contracting Party may require that the request for extension be filed before the expiration of that time limit. Under item (ii), a Contracting Party may require that the request be filed after that expiration and within the time limit prescribed in Rule 12(2)(a). The requirements in respect of the request, the period of the extension, and the time limit for making a request referred to in item (ii) are prescribed in Rule 12(1) and (2). In particular, a Contracting Party may, under Rule 12(2)(b), require that all of the requirements in respect of which the time limit to be extended applied be complied with at the same time as the request under item (ii) is filed

11.04 Paragraph (1) does not oblige a Contracting Party to provide for the extension of a time limit fixed by the Office under either item (i) or (ii). However, a Contracting Party that does not provide for extension after expiration of the time limit under item (ii) must provide for continued processing under paragraph (2).

11.05 Paragraph (2). This paragraph obliges a Contracting Party to provide for relief in the form of continued processing, after the applicant or owner has failed to comply with a time limit fixed by the Office, where that Contracting Party does not provide for the extension of time limits under paragraph (1)(ii). The effect of such continued processing is that the Office continues with the procedure concerned as if that time limit had been complied with. Also, the Office must, if necessary, re-instate the rights of the applicant or owner with respect to the application or patent concerned. The requirements in respect of the request referred to in item (i) are prescribed in Rule 12(3). The time limit for making a request, and complying with

all of the requirements in respect of which the time limit concerned applied, referred to in item (ii), is prescribed in Rule 12(4). *This paragraph is subject to a reservation by the Delegation of France, with respect to the lack of a requirement for notification.*

11.06 Paragraph (3). The exceptions under this paragraph are prescribed in Rule 12(5).

11.07 Paragraph (4). Although a Contracting Party is permitted to charge a fee under this paragraph, it is not obliged to do so. Reference is also made to the explanation given under Article 6(4) (see, in particular, Note 6.14).

11.08 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 cannot be required to state the grounds on which the request is based or to file evidence to the Office. The requirements referred to in this paragraph which are “otherwise provided for by this Treaty or prescribed in the Regulations” are, in particular, those under Articles 7 and 8 and Rules 7 to 10.

11.09 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 under Article 11 or Rule 12 that was not complied with in making the request.

Note on Article 12

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

12.01 This Article obliges a Contracting Party to provide for the re-instatement of rights with respect to an application or patent following failure to comply with a time limit for an action in a procedure before the Office. In contrast to Article 11, such re-instatement is subject to a finding by the Office that the failure occurred in spite of all due care required by the circumstances or, at the option of the Contracting Party, was unintentional. Also in contrast to Article 11, Article 12 is not restricted to time limits fixed by the Office, although it is subject to certain exceptions under paragraph (2) and Rule 13(3). *Article 12 is subject to a reservation by the Delegation of Argentina.*

12.02 Paragraph (1), introductory words. The condition that “that failure has the direct consequence of causing a loss of rights with respect to an application or patent” is intended to avoid circumventing the exclusions provided under Rule 13(3). For example, where failure to comply with a time limit under Article 13(1), (2) or (3) in respect of a priority claim or priority right has the direct consequence of loss of that priority claim or priority right which, in turn, has the indirect consequence of the refusal of the application on the grounds of prior publication, a Contracting Party would not be obliged to provide, under paragraph (1), for re-instatement of the loss of rights resulting from that refusal. As regards the term “procedure before the Office,” reference is made to the definition in Article 1(xiv) (see Note 1.117).

12.03 Item (i). The Regulations under this item are prescribed in Rule 13(1).

12.04 Item (ii). The time limit under this item is prescribed in Rule 13(2).

12.05 Item (iii). The applicant or owner may be required under paragraph (4) to file a declaration or other evidence in support of the grounds provided under this item.

12.06 Item (iv). 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 its 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. *This item is subject to a reservation by the Delegation of the United Kingdom.*

12.07 Paragraph (2). The exceptions under this paragraph are prescribed in Rule 13(3).

12.08 Paragraph (3). Reference is made to the explanations given under Article 6(4) (see, in particular, Note 6.14).

12.09 Paragraph (5). This paragraph provides the right to make observations on the intended refusal of a request under paragraph (1). It does not, however, 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 10(2), this paragraph does not regulate the form of observations which an applicant or owner must be given an opportunity to make (see Note 10.05).

12.10 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 or Addition of Priority Claim; Restoration of Priority Right)

13.01 Paragraph (1). This provision, which is modeled after PCT Rule 26*bis*.1, permits 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. It applies both where the application as filed contains no priority claim and where the application already claims the priority of one or more 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 Item (i). The requirements referred to in this item are prescribed in Rule 14(2).

13.03 Item (ii). The time limit referred to in this item is prescribed in Rule 14(3).

13.04 Item (iii). It is to be noted that, 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).

13.05 Paragraph (2). This provision provides for the restoration of the priority right where a subsequent application is filed after the expiration of the priority period, but within the time limit referred to in Rule 14(4)(a). It applies only where the failure to file the 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. A priority claim may be restored under this paragraph even if it was not included in the subsequent application as filed, provided that it accompanies the request for restoration (see Rule 14(5)(ii)). *This paragraph is subject to reservations by the Delegations of Argentina, Belgium, China, the Netherlands, India and Spain.*

13.06 Item (i). The requirements under this item are prescribed in Rule 14(5).

13.07 Item (ii). The time limit referred to in this item is prescribed in Rule 14(4)(b).

13.08 Paragraph (3). This paragraph provides a remedy for the applicant where a 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 to comply with the time limit applicable under Article 6, 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 extension of time limit or continued processing under Article 11.

13.09 Item (i). The requirements under this item are prescribed in Rule 14(6).

13.10 Item (ii). The effect of this item is to permit an applicant who is unable to file the required copy of the earlier application within the time limit referred to in Rule 4(1) to, instead, file a request for restoration of the priority right within that time limit.

13.11 Item (iii). The time limit for making a request for a copy of the earlier application under this item is prescribed in Rule 14(7) (see Note R14.06). This time limit provides a legal certainty for the applicant in that, if he requests a copy of the earlier application within that 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).

13.12 Paragraph (4). Reference is made to the explanations given under Article 6(4) (see, in particular, Note 6.14).

13.13 Paragraph (5). Reference is made to the explanations given under Article 12(5) (see Note 12.09).

13.14 Intervening Rights. Reference is made to the explanations regarding intervening rights under Article 12 (see Note 12.10).

Note on Article 14

(Regulations)

14.01 Paragraph (1)(a). This provision corresponds to Article 24(1) of the Geneva Act of the Hague Agreement Concerning the International Deposit of Industrial Designs (“the Geneva Act”).

14.02 Paragraph (1)(b). The Regulations under this provision are prescribed in Rules 15 to 18.

14.03 Paragraph (1)(c). The Regulations under this provision are prescribed in Rule 20. Reference is also made to Article 16(2)(ii).

14.04 Paragraph (2). The three-fourths majority for amending the Regulations under this paragraph is the same as that for amending the PCT Regulations under PCT Article 58(2)(b).

14.05 Paragraph (3)(a). PCT Article 58(3)(a)(i) similarly provides that the PCT Regulations specify the PCT Rules which may be amended only by unanimous consent. It is proposed that amendment of Rules 3(1) and 8(1)(a) should require unanimity under this provision (see Rule 21).

14.06 Paragraph (3)(b). PCT Article 58(3)(b) and (c) contains a similar requirement for unanimity in respect of the exclusion, or inclusion, of Rules which may be amended only by unanimous consent.

14.07 Paragraph (3)(c). This paragraph is modeled after Rule 36(1) of the WIPO General Rules of Procedure.

Note on Article 15

(Relation to the Paris Convention)

15.01 Paragraph (1). This paragraph is modeled after Article 2(2) of the Geneva Act and Article 15 of the Trademark Law Treaty (“TLT”). It obliges each Contracting Party to comply with those provisions of the Paris Convention which concern patents, namely Articles 2 to 5^{quarter}, 11 and 12. This obligation is required since Article 19 entitles States that are members of the World Intellectual Property Organization (“WIPO”), as well as certain intergovernmental organizations, to become party to the Treaty, even if they are not party to the Paris Convention.

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 included 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)(a). This provision, which is modeled after WCT Article 15(1)(a) and WPPT Article 24(1)(a), establishes an Assembly of Contracting Parties. In accordance with Article 1(xviii), the term “Contracting Party” means any State or intergovernmental organization party to this Treaty.

16.02 Paragraph (1)(b). This provision is modeled after Article 21(1)(b) of the Geneva Act.

16.03 Paragraph (1)(c). This provision is also contained in WCT Article 15(1) and WPPT Article 24(1). However, the relevant provisions of those treaties contain a further sentence, not contained in the present provision, that would enable the Assembly to request that a share of WIPO funds be spent on activities relating to the Treaty. In this context, it is to be noted that the Treaty does not establish any financial obligations: Contracting Parties do not have to pay any contribution to WIPO, neither does the Assembly adopt a program and budget. Any activity concerning the Treaty that would cause an expense to the International Bureau is 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.

16.04 Paragraph (2), item (i). This item is modeled after Article 21(2)(i) of the Geneva Act. Corresponding provisions are contained in WCT Article 15(2)(a) and WPPT Article 24(2)(a).

16.05 Item (ii). This item parallels Article 14(1)(c).

16.06 Item (iii). This item is the same as Article 21(2)(iv) of the Geneva Act.

16.07 Item (v). Similar provisions are contained in Article 21(2)(ix) of the Geneva Act, WCT Article 15(2)(b) and WPPT Article 24(2)(b).

16.08 Item (vi). A similar provision is contained in Article 21(2)(x) of the Geneva Act.

16.09 Paragraph (3). This paragraph is modeled after Article 21(3) of the Geneva Act. A provision along similar lines is contained in PCT Article 53(5)(a).

16.10 Paragraph (4)(a) and (b), item (i). These provisions are modeled after Article 21(4)(a) and (b)(i) of the Geneva Act.

16.11 Paragraph (4)(b), item (ii). The first two sentences of this item are modeled after Article 21(4)(b)(ii) of the Geneva Act. The third sentence ensures that two intergovernmental organizations with one or more States in common, for example, the European Community and

the European Patent Organisation, may not both participate in the same vote in place of their Member States. The question of whether an intergovernmental organization or its Member States should vote is a matter to be decided by that organization and those States.

16.12 Paragraph (5). This paragraph is modeled after Article 21(5) of the Geneva Act and PCT Article 53(6).

16.13 Paragraphs (6) and (7). These paragraphs are modeled after WCT Article 15(4) and (5) and WPPT Article 24(4) and (5) (except in respect of the provisions regarding a quorum and majorities which are regulated by paragraphs (3) and (5), respectively). The more detailed provisions contained in Article 21(6) and (7) of the Geneva Act, which reflect the more detailed administrative tasks of the Hague Assembly, are not needed for the purposes of the Treaty. For example, under Article 21(2)(vi) of the Geneva Act, the Hague Assembly has the task of determining the program and adopting the biennial budget of the Hague Union and approving its final accounts.

Note on Article 17

(International Bureau)

17.01 This Article is modeled after Article 22 of the Geneva Act.

Note on Article 18

(Revisions)

18.01 Paragraph (1). The first sentence of this paragraph is modeled after Article 25(1) of the Geneva Act and PCT Article 60(1). The second sentence is modeled after Article 21(2)(a)(iii) of the Geneva Act and PCT Article 60(2).

18.02 Paragraph (2). This paragraph specifies those provisions of the Treaty which may be revised by the Assembly, without requiring a revision conference of the Contracting Parties under paragraph (1). It is restricted to amendments in respect of the tasks and sessions of the Assembly under Article 16(2) and (6). Article 25(2) of the Geneva Act and PCT Article 61(1) similarly provide, *inter alia*, for amendment, by the respective Assemblies, of provisions relating to those Assemblies.

18.03 Paragraph (3)(a). This provision is modeled after Article 26(1) of the Geneva Act.

18.04 Paragraph (3)(b). This provision is modeled after Article 25(2) and 26(2) of the Geneva Act and PCT Article 61(2). However, it is to be noted that, although the adoption, by the Hague Assembly, of any amendment to certain Articles referred to in Article 25(2) of the Geneva Act generally requires a three-fourths majority, any amendment to the provisions relating to the Assembly contained in Article 21 of that Act requires a four-fifths majority, since all the provisions under that Article, including the provisions with respect to voting rights, could be amended by the Hague Assembly.

18.05 Paragraph (3)(c). This provision is modeled after Article 25(3) and 26(3) of the Geneva Act and PCT Article 61(2).

Note on Article 19

(Becoming Party to the Treaty)

19.01 Paragraph (1). This paragraph permits 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, in addition to States which grant their own patents, States which do not grant patents, but for which patents are obtainable through another Office, are eligible to become party to the Treaty.

19.02 Paragraph (2). Under this paragraph, an intergovernmental organization, subject to admission by the Assembly, is eligible to become party to the Treaty if it complies with two conditions. First, in line with the requirements for the eligibility of States under paragraph (1), at least one of its member States must be party to the Paris Convention or a member of WIPO. Second, it must make a declaration that (i) it is competent to grant patents with effect for its member States, or (ii) it is competent in respect of, and has its own legislation binding on all its member States concerning, matters covered by the Treaty. The regional organizations listed in paragraph (3) are all competent to grant patents with effect for their member States in accordance with item (i). Although it is apparent that an intergovernmental organization must also be duly authorized, in accordance with its internal procedures, to become party to the Treaty, this is a matter for that intergovernmental organization and its member States, not the

Assembly. *Item (ii) of this paragraph is subject to a reservation by the Delegation of the United States of America.*

19.03 Paragraph (3). This paragraph provides for the regional organizations listed in square brackets to become party to the Treaty without a decision of the Assembly, subject to their making a declaration referred to in paragraph (2) in the Diplomatic Conference. Any regional organization listed in this paragraph that does not make the prescribed declaration at the Diplomatic Conference will still be eligible to be admitted to become party to the Treaty under paragraph (2).

19.04 Paragraph (4). This paragraph is modeled after Article 27(2) of the Geneva Act.

19.05 Paragraph (5). This paragraph is modeled after Article 27(3)(a) of the Geneva Act. The provisions contained in Article 27(3)(b) to (e) of that Act are not applicable to this Treaty.

Note on Article 20

(Entry into Force; Effective Dates of Ratifications and Accessions)

20.01 Paragraph (1). The requirement of the deposit of ten instruments of ratification or accession for entry into force of the Treaty under this paragraph was adopted by the Standing Committee on the Law of Patents at its second session. As in the case of Article 28(2) of the Geneva Act, and other WIPO treaties including the PCT, WCT and WPPT, only instruments deposited by States are taken into consideration. These requirements are intended to ensure

that the initial Assembly comprises a substantial number of States at the time the Treaty enters into force. The period of three months between the deposit of the required number of instruments of ratification or accession and the entry into force of the Treaty is the same as that under Article 28(2) of the Geneva Act and under other WIPO treaties, including the treaties referred to above.

20.02 Paragraph (2). This paragraph is modeled after WCT Article 21, WPPT Article 30 and TLT Article 20(3), taking into account the provisions of Article 28(3) of the Geneva Act.

20.03 Items (ii) to (iv). The three-month period mentioned in these items is the same as that under Article 28(3) of the Geneva Act, as well as under the PCT, WCT, WPPT and TLT. It takes into account that the instrument of ratification or accession of the intergovernmental organizations referred to in Article 19(3) are not among the ten instruments that cause the initial entry into force of the Treaty. Other intergovernmental organizations may deposit an instrument of accession only after the entry into force of the Treaty, since their request for accession will have to be decided upon by the Assembly, which will 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(3)(b) of the Geneva Act .

Note on Article 21

(Application of the Treaty to Existing Applications and Patents)

21.01 Paragraph (1)(a). This provision obliges a Contracting Party to apply the provisions of the Treaty and Regulations to all patents in force and applications pending at the date on which

the Treaty and Regulations bind that Contracting Party. It is subject to two exceptions. First, a Contracting Party is not obliged to apply, to pending applications or existing patents, the provisions in respect of the filing date of an application under Article 5, the form or contents of an application under Article 6(1) or the presentation of contents of an application under Article 6(2). Second, it is subject to the provisions of paragraph (2) (see Note 21.03).

21.02 Paragraph (1)(b). This provision, which is included in square brackets, would oblige a Contracting Party to provide for re-instatement, under Article 12, of loss of rights with respect to an application or patent, after a finding of due care or unintentionality by the Office, where the applicant or owner has failed to comply with a time limit. As expressly provided, it applies even where the failure to comply with that time limit occurred prior to the date on which the Contracting Party is bound by the Treaty. Accordingly, this provision would oblige a Contracting Party that did not already do so, to provide for the re-instatement, under Article 12, of rights in applications that had lapsed or been refused or abandoned, and patents that had lapsed or been revoked or invalidated, prior to that date. In practice, this would apply only to those applications and patents in respect of which the time limit provided in Rule 13(2) for making a request under Article 12 has not expired.

21.03 Paragraph (2). Under this paragraph, a Contracting Party is not obliged to apply the provisions of the Treaty and Regulations to individual procedures in proceedings with respect to applications and patents, if that procedure commenced before the date on which the Treaty and Regulations bind that Contracting Party. A Contracting Party is free to interpret the term “procedure,” and to decide whether such procedure is considered as having commenced before or after the date on which the Treaty binds that Contracting Party. However, where, for

example, the Office of a State, which is not yet bound by the Treaty, notifies a time limit for an action in a procedure, that is less than the time limit for that action prescribed by the Regulations, and that State subsequently becomes bound by the Treaty during that time limit, the Office will not be obliged to change the notified time limit since the procedure in question commenced before the date on which that State became so bound.

Note on Article 22

(Reservations)

22.01 Paragraph (1). This paragraph, which is modeled after TLT Article 21(1), permits a reservation in respect of requirements as to unity of invention, *and is introduced in response to a reservation with respect to Article 6(1) expressed by the Delegation of the United States of America (see Note 6.04)*. The inclusion of any further reservations in this Article is a matter for the Diplomatic Conference. As provided for in paragraph (4), a Contracting Party is not permitted to make any reservation that is not provided for in this paragraph, as adopted by 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 modeled after Article 23(1) of the Geneva Act. Corresponding provisions are also contained in WCT Article 23, first sentence, WPPT Article 31, first sentence and TLT Article 23(1).

23.02 Paragraph (2). This paragraph is modeled after Article 23(2) of the Geneva Act. A corresponding provision is also contained in TLT Article 23(2).

Note on Article 24

(Languages of the Treaty)

24.01 Paragraph (1). This provision is modeled after Article 33(1)(a) of the Geneva Act.

24.02 Paragraph (2). This paragraph provides for the establishment, by the Director General, of official texts in further languages after consultation with the interested parties. The definition of “interested party” in the second sentence takes account of the provisions for eligibility of States and intergovernmental organizations under Article 19(1) to (3). Article 33(1)(b) of the Geneva Act similarly provides for the establishment of texts in further languages, but is restricted to consultation with the interested governments, even though intergovernmental organizations are eligible to become party to that Act under Article 27(1)(ii).

Note on Article 25

(Signature of the Treaty)

25.01 The provision, under this Article, that the Treaty shall remain open for signature, at the WIPO headquarters, for one year after the adoption of the Treaty is modeled after the provision under the Article 33(1) of the Geneva Act. For consistency with the provisions of Article 19(1), only those States that are eligible to become party to the Treaty may sign. Similarly, the only intergovernmental organizations that may sign are those regional organizations that are entitled to become party to the Treaty under Article 19(3) without having to await admission by the Assembly. Any eligible State or intergovernmental organization that has not signed the Treaty under Article 20 may deposit an instrument of accession under Article 19(4)(ii).

Note on Article 26

(Depositary; Registration)

26.01 Paragraph (1). This paragraph is modeled after Article 34 of the Geneva Act, and corresponds to present trends in WIPO (see also, for example, WCT Article 25, WPPT Article 33 and TLT Article 25).

26.02 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.

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

II. EXPLANATORY NOTES ON THE REGULATIONS UNDER THE BASIC
PROPOSAL FOR THE PATENT LAW TREATY

Note on Rule 2

(Details Concerning the Filing Date Under Article 5)

R2.01 Paragraphs (1), (2), item (i) and (3), item (i). 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 5(1) and (2), are more favorable, from the viewpoint of applicants, than the corresponding time limits under PCT Rules 20.2(a)(ii) and 20.6(b), which 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 difference 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 originate from foreign countries. Where indications allowing the applicant to be contacted have been filed, the time limits under paragraph (2), item (i) and paragraph (3), item (i) do not start until the Office has notified the applicant under Article 5(3) (see Notes 9.02 to 9.05).

R2.02 Paragraphs (2), item (ii) and (3), item (ii). These items are included for avoidance of doubt. They apply where, as permitted for the purposes of the filing date under Article 5(1)(a)(ii), an application contains indications allowing the identity of the applicant to be established but not indications allowing the applicant to be contacted by the Office. It is to be noted that the time limit under paragraph (3)(ii) applies in all cases where a notification has

not been made, and not just where the indications allowing the applicant to be contacted have not been filed.

R2.03 Paragraph (4), Item (iii). As regards the expression “a language accepted by the Office,” reference is made to the explanation under Article 1(xii) (see Note 1.10). As regards the term “translation,” reference is made to the definition in Article 1(xiii).

R2.04 Items (iv) and (vi). The determination 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.

R2.05 Paragraph (5). It is to be noted that this paragraph does not require that the previously filed application be in the name of the applicant of the application containing the reference or his predecessor in title. References to the previously filed application filed by a person who was neither the applicant of that application nor his successor in title can be expected to occur only in rare cases. For example, in the case of entitlement disputes which may occur in respect of an invention resulting from a 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. Where the applicant indicated in the application containing the reference is not the same as the applicant identified in the previously filed application, the Office may require documentary evidence as to the later applicant’s entitlement to file the application be filed under Article 6(1)(ii) (with reference to PCT Article 27(2)(ii) and PCT Rule 51*bis*.1(a)(ii)

to (iv)), within the time limit prescribed in Rule 6(1). *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.*

R2.06 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, must 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.

R2.07 Paragraph (5)(b), item (i). 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.

R2.08 Item (ii). The time limit of not less than four months under this item corresponds to the minimum time limit for filing a certified copy of an earlier application in respect of a priority claim under Rule 4(1) and (2).

Note on Rule 3

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

R3.01 Paragraph (1). This paragraph provides for further requirements in respect of divisional applications under Rule 2(6)(i), and applications by new applicants determined to be entitled to an invention contained in an earlier application under Rule 2(6)(iii). It does not provide for indications in respect of applications for a patent of addition, or applications for a continuation or continuation-in-part (as referred to in Rule 2(6)(ii)), since the requirements in respect of such applications under PCT Rule 4.13 and 4.14, respectively, are incorporated by reference under Article 6(1)(i). Amendment of this paragraph requires unanimity under Rule 21.

R3.02 Paragraph (2), item (i). This item obliges a Contracting Party to accept the use of a request Form corresponding to the PCT request Form with any modifications established by the Assembly under Rule 20(1)(b). Such modifications could include, for example, omission of the indication for the designation of PCT Contracting States, omission of the indication for the inclusion of the designation of States of a regional Organization, and addition of the indications for requests that the application be treated as a divisional application or an entitlement application referred to in Rule 2(6)(i) and (iii).

R3.03 Items (ii) and (iii). Item (ii) permits an applicant to use a PCT request Form for the purpose of filing a national or regional application by accompanying the Form with an indication to that effect. Item (iii) provides for the future possibility that the PCT request Form may be modified to provide for such an indication.

R3.04 Item (iv). As regards the term “format,” reference is made to the explanation under Article 8(1)(a) (see Note 8.01).

Note on Rule 4

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

R4.01 Paragraph (1). The time limit under this provision for filing 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 under paragraph (1) 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 maintains 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). The intention of this paragraph is to reduce the burden on applicants of providing copies of earlier applications and previously filed applications, and certification of filing dates. Thus, where the earlier application or previously filed 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 or previously filed 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 on applicants. 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) provides that Contracting Parties waive their right under the Paris Convention to require a translation of an earlier application in every case, but 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 question is to be determined, the Office may 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). It is for the Contracting Party to decide whether, in any particular case or circumstance, “the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.” *This provision is subject to reservations by the Delegations of Belgium, China, Greece, India, Ireland, Portugal, the Russian Federation, Spain and Uruguay.*

Note on Rule 6

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

R6.01 Paragraph (2). Where the filing date of an application is not earlier than the date on which one or more of the elements referred to in Article 5(1)(a) were first received by the Office, a Contracting Party is permitted to calculate the time limit under item (ii) from the filing date. 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 7)

R7.01 Paragraph (1). Items (i) and (ii) of this paragraph, which is placed in square brackets, relate to the filing of copies of earlier and previously filed applications, after the filing date, in the procedures referred to in Article 5(6)(b) and (7)(a), respectively. These items will therefore not be required if Article 7(2)(ii), which is placed in square brackets and applies generally in respect of “any procedure referred to in Article 5,” is adopted. If neither these items nor Article 7(2)(ii) is adopted, a Contracting Party will be permitted to require an applicant to use a representative to file a copy of an earlier application or previously filed application that is required under Article 5(6)(b) or (7)(a) for the purposes of the filing date.

R7.02 Paragraph (2)(a). This provision obliges a Contracting Party to accept the appointment of a representative either (i) in a separate power of attorney signed by the applicant or other person appointing the representative, or (ii) in the request Form or format signed by the applicant (as under PCT Rule 90.4 (a)). A Contracting Party is free, but not obliged, to accept the appointment of a representative in any other manner. As in the case of communications in general, a Contracting Party is permitted, under Article 8 and Rule 8, to apply requirements as regards the form, format and means of filing a power of attorney. Under Article 8(3), a Contracting Party is obliged to accept the presentation of a power of attorney on a Model International Form, or in a Model International Format, established under Rule 20(1)(i) or (2).

R7.03 Paragraph (2)(b). This provision obliges a Contracting Party to accept a single power of attorney in respect of one or more applications and/or patents of the same person. A

Contracting Party is also 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. In the second sentence, the words “subject to any exception indicated by the appointing person” 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 Under the third sentence of paragraph (2)(b), a Contracting Party is 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 is also 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 any power of attorney or general power of attorney.

R7.05 Paragraph (34). As regards the terms “a language accepted by the Office” and “translation,” reference is made to Article 1(xii) and (xiii) (see Notes 1.10 and 1.11).

R7.06 Paragraph (4). An Office that requires evidence under this paragraph is obliged, under Rule 5, to state its 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 6(6) (see Note 6.17).

Note on Rule 8

(Filing of Communications Under Article 8(1))

R8.01 Paragraph (1)(a). This provision guarantees the right of applicants, owners and other interested persons to file communications on paper for a period of 10 years from the date of the entry into force of the Treaty. After that period, any Contracting Party would be permitted, but not required (see Article 8(1)(c)) to exclude the filing of communications on paper, except for the purposes of a filing date under Article 5(1) and for meeting a time limit under Article 8(1)(d) (see Notes 5.05 and 8.03, respectively). Amendment of this paragraph requires unanimity under Rule 21. *This provision is subject to a reservation by the Delegation of Cameroon.*

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 8(1)(a) (see Note 8.01). 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 that do not result in the filing of a printed or written document, but, for example, telefacsimile transmission to a computer terminal. This provision 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 in respect of international applications, to accept the electronic filing of communications in respect of national applications in accordance with those 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.

R8.02 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.

R8.05 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 PCT Administrative Instructions, may be furnished by the applicant.

Note on Rule 9

(Details Concerning the Signature Under Article 8(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 the PCT request Form, would apply, in particular, where a person signs on behalf of a legal entity.

R9.02 Paragraph (3), Item (iii). The right to require the indication of the nationality of the person who signs the communication is included in this item in view of the national law of at least one State relating to the use of seals by the nationals of that State.

R9.03 Paragraph (4). This paragraph applies to 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 accordance with Rule 8(2)(c), a Contracting Party may require the filing of the original of the transmitted document on which the original signature appears. 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).

R9.04 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.

R9.05 Paragraph (5)(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. A Contracting Party may further require that such a signature in electronic form be uniquely linked to the signer, be capable of identifying the signer, be created using means that the signer

can maintain his sole control and be linked to the information contained in the electronic record in such a manner that any subsequent change of the data is detectable. It also could be a means of self-identification using an ID number and a password.

R9.06 Paragraph (5)(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.

Note on Rule 10

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

R10.01 Paragraph (1)(a), Item (iii). The registration number or other indication referred to in this item 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.

R10.02 Paragraph (1)(b), Item (iii). Reference is made to the explanation under paragraph (1)(a)(iii) (see Note R10.01).

R10.03 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 7(1)(a)(ii) (see Note 7.04).

R10.04 Paragraph (3). This provision obliges 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 8(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 7(1)(a)(ii) (see Note 7.04).

R10.05 Paragraph (4). This provision obliges a Contracting Party to treat the address of a representative as the address for correspondence and the address for legal service under Article 8(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 may require, under Article 7(1)(a)(ii), that the address provided by the representative be on a territory prescribed by that Contracting Party (see Note 7.04).

Note on Rule 12

(Details Concerning Relief in Respect of Time Limits Under Article 11)

R12.01 Paragraph (1)(a). In accordance with Article 7(2)(b), a representative may sign on behalf of the applicant or owner under item (i).

R12.02 Paragraph (1)(b). This provision is modeled after existing practice in, for example, the United States of America.

R12.03 Paragraph (3). In accordance with Article 7(2)(b), a representative may sign on behalf of the applicant or owner under item (i).

R12.04 Paragraph (5)(a). This provision lists procedures in respect of which a Contracting Party is not obliged to provide for the extension of a time limit under Article 11(1) or continued processing under Article 11(2), but is permitted to do so.

R12.05 Item (i). Under this item, which is placed in square brackets, a Contracting Party is not obliged to grant more than one instance of relief under Article 11(1) or (2), although it is permitted to do so. It is similarly not obliged to grant continued processing under Article 11(2) after an extension of the time limit concerned has been previously granted under Article 11(1). Any second or subsequent instance of relief that is granted is not regulated by Article 11(1) or (2) or Rule 12, so that a Contracting Party is permitted to grant shorter extensions than, and/or to apply requirements which are additional to, or different from, those under that Article and that Rule.

R12.06 Items (ii) and (iv). These items are intended to prevent an applicant or owner from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R12.07 Item (iii). Although, under this item, a Contracting Party is not obliged to provide for the extension of, or continued processing in respect of, a time limit fixed by the Office for the

payment of maintenance fees, it is still obliged to provide a period of grace for the payment of such fees under Article 5*bis*(1) of the Paris Convention.

R12.08 Items (v) and (vii). These items are placed in square brackets.

R12.09 Paragraph (5)(b). This provision ensures that the provisions of the applicable law in respect of a maximum time limit for the grant of a patent would prevail over relief in respect of a time limit fixed by an administrative action of the Office.

Note on Rule 13

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

R13.01 Paragraph (1). In accordance with Article 7(2)(b), a representative may sign on behalf of the applicant or owner.

R13.02 Paragraph (3). This provision lists procedures in respect of which a Contracting Party is not obliged to provide for the re-instatement of rights under Article 12(1), although it is permitted to do so.

R13.03 Item (ii). Although under this item, which is placed in square brackets, a Contracting Party is not obliged to provide for re-instatement of rights for failure to comply with a time limit for the payment of maintenance fees, a Contracting Party that is party to the Paris

Convention is still obliged to provide a period of grace for the payment of such fees under Article 5*bis*(1) of that Convention.

R13.04 Items (iii) and (iv). These items are intended to prevent an applicant or owner from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R13.05 Item (v). This item is placed in square brackets.

R13.06 Item (vi). *This provision, which is placed in square brackets, is subject to a reservation by the Delegation of Belgium as to its deletion.*

Note on Rule 14

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

R14.01 Paragraph (1). This paragraph is modeled after PCT Rule 26*bis*.1(b), and is modified to apply to requests for expedited or accelerated processing as well as requests for early publication.

R14.02 Paragraph (2). In accordance with Article 7(2)(b), a representative may sign on behalf of the applicant or owner.

R14.03 Paragraph (3). The applicable time limit for the correction or addition of a priority claim by a notice submitted to the receiving Office after the filing of an international

application, under PCT Rule 26bis.1(a), is 16 months from the priority date or, where that 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 international application.

R14.04 Paragraph (5), item (i) and paragraph (6)(a), item (i). Reference is made to the explanation under Rule 13(1) (see Note R13.01).

R14.05 Paragraph (6)(b), item (i). The declaration or other evidence referred to in this item may be required in order that the Office may determine whether the requirement under Article 13(3)(iii) is complied with.

R14.06 Paragraph (7). A two-month time limit is provided 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 15

(Request for Recordation of Change in Name or Address)

R15.01 This Rule standardizes the procedure concerning requests for recordation 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 16 applies.

R15.02 Paragraph (1), introductory words. In accordance with Article 1(vii), the term “recordation” means any act of including information 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 1.06 and 1.07).

R15.03 Item (ii). Where the application number has not been issued, or is not known, the provisions of Rule 19 apply.

R15.04 Item (iv). The name and address referred to in this item are those which are 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 filed under paragraph (5), or that the change concerned be recorded beforehand or be included in the request.

R15.05 Paragraph (2). The amount of the fee could differ depending on the number of the patents or applications involved (see Note R15.06). Reference is also made to the explanations under Article 6(4) (see, in particular, Note 6.14).

R15.06 Paragraph (3). This paragraph obliges a Contracting Party 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. However, it permits a Contracting Party to require that a separate copy of a single request be filed for each application and patent to which it relates. It is also implicit that a Contracting Party which so wished could itself make a copy of the request for each application and patent, optionally on the payment, under paragraph (2), of an additional fee for each copy.

R15.07 Paragraph (4). This paragraph permits 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 is obliged under Rule 5 to state 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 explanations under Article 6(6) (see Note 6.17).

R15.08 Paragraph (5). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (4). The requirements referred to in this paragraph which are “otherwise provided for by the Treaty or prescribed in these Regulations” are, in particular, those under Articles 7 and 8 and Rules 7 to 10. One requirement which is prohibited is the furnishing of a certified copy of the recordation of the change in the register of companies as a condition for the recordation of the change in the records of the Office, where the name of the company has changed.

R15.09 Paragraphs (6) and (7). The prohibition of a more severe sanction excludes 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 general provisions on notifications under Article 9 (see Notes to Article 9).

R15.10 Paragraph (8). As regards a change in the name or address of the representative, due to the *mutatis mutandis* effect of Rule 15(1), this provision applies only where there is no change in the person of the representative (see Note R15.01). While Model International Forms are not provided for requests for recordation 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 free 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 16

(Request for Recordation of Change in Applicant or Owner)

R16.01 This Rule standardizes the procedure concerning requests for recordation 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 15 applies. It is to be noted that Rule 16 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.

R16.02 Paragraph (1)(a), introductory words. Reference is made to the explanation under Rule 15(1), introductory words (see Note R15.02).

R16.03 Item (ii). Reference is made to the explanations given under Rule 15(1)(ii) (see Note R15.03).

R16.04 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.

R16.05 Paragraph (1)(b), item (i). A Contracting Party may require that the statement referred to in this item be filed in all cases.

R16.06 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.

R16.07 Paragraph (2)(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 included in the Regulations, the documentation referred to could not be required where the recordation for change is requested by the applicant or owner shown in the records of the Office. Without the text within square brackets, the

documentation could be requested in all cases. In addition, in both alternatives, 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.*

R16.08 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, in accordance with Article 2(1), 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.

R16.09 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 (2)(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.

R16.10 While a Contracting Party is free to require that a copy or extract of the contract filed under item (i) or (ii) be certified, it is the choice of the applicant as to who (a notary public, a

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

R16.11 Where the requesting party chooses to file a certificate of transfer, as provided in item (iii), a Contracting Party is not permitted to require that this certificate be the subject of any form of certification. Rule 20(1)(a)(iv) and (2)(a) provides for the establishment of a Model International Form and Model International Format for a certificate of transfer.

R16.12 Paragraph (2)(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. A Contracting Party is 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. It is only permitted to require that a copy of the document be filed; it cannot require that the original of the document be filed, 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 R16.10.

R16.13 Paragraph (2)(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 is 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 cannot require that the original of such a document be filed, it may 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.

R16.14 Paragraph (2)(d). This provision applies 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 recordation of the change. It is a matter for the Contracting Party to determine what constitutes 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.

R16.15 Paragraph (3). As regards the expression “a language accepted by the Office,” reference is made to the explanation under Article 1(xii) (see Note 1.10). As regards the term “translation,” reference is made to the definition under Article 1(xiii).

R16.16 Paragraphs (4) and (5). Reference is made to the explanations given under Rule 15(2) and (3) (see Notes R15.05 and R15.06).

R16.17 Paragraph (6). Evidence could be required under this paragraph where, for example, the Office has reason to suspect that the request may be fraudulent. Reference is also made to the explanations given under Rule 15(4) (see Note R15.07).

R16.18 Paragraph (7). This paragraph establishes the exhaustive character of the list of formal requirements under paragraphs (1) to (6) with respect to a request for recordation 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, in accordance with Article 2(2), 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. The requirements referred to in this paragraph which are “otherwise provided for by the Treaty or prescribed in these Regulations” are, in particular, those under Articles 7 and 8 and Rules 7 to 10.

R16.19 Paragraph (8). Reference is made to the explanations under Rule 15(6) and (7) (see Note R15.09).

R16.20 Paragraph (9). This paragraph permits, but does not oblige, a Contracting Party, in particular, one which requires that a patent be applied for in the name of the actual inventor, to exclude the provisions of Rule 16 in respect of changes in inventorship. The second sentence is included for the avoidance of doubt.

Note on Rule 17

(Request for Recordation of a Licensing Agreement or Security Interest)

R17.01 Paragraph (1)(a), introductory words. 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 is obliged to provide for recordation of such licensing agreements, and that any Contracting Party which allows for such recordation is free to decide which licensing agreements may be recorded. In accordance with Article 1(vii), the term “recordation” means any act of including information in the records of the Office.

R17.02 Item (ii). Reference is made to the explanation given under Rule 15(1)(ii) (see Note R15.03).

R17.03 Paragraph (1)(b). As regards items (i) and (ii), reference is made to the explanations given under Rule 16(1)(b), items (i) and (ii) (see Notes R16.05 and R16.06).

R17.04 Paragraph (2)(a). The considerations which apply to documentation which may be required under this provision are essentially the same as those which apply under Rule 16(2)(a) (see Notes R16.07 to R16.11). 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 reservations by the Delegations of Brazil, Cuba, Mexico and Spain .*

R17.05 Paragraph (2)(b). This provision permits a Contracting Party to require the filing of a document containing the consent to recordation 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 may require the consent of the exclusive licensee to the recordation 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 may require the consent of any other co-applicant, co-owner or co-exclusive licensee to the recordation 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 16(2)(d) (see Note R16.14).

R17.06 Paragraph (3). Reference is made to the explanation given under Rule 16(3) (see Note R16.15).

R17.07 Paragraphs (4) and (5). Reference is made to the explanations given under Rule 15(2) and (3) (see Notes R15.05 and R15.06).

R17.08 Paragraphs (6) and (7). Reference is made to the explanations given under Rule 16(6) and (7) (see Notes R16.17 and R16.18).

R17.09 Paragraph (8). Reference is made to the explanations given under Rule 15(6) and (7) (see Note R15.09).

R17.10 Paragraph (9). Item (i) relates to the recordation 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 recordation of licensing agreements under paragraph (1), a Contracting Party is not obliged to provide for recordation of security interests, and any Contracting Party which does allow for such recordation is free to decide which security interests may be recorded. Similarly, under item (ii), a Contracting Party is not obliged to provide for cancellation of the recordation of a licensing agreement or security interest.

R17.11 In applying the provisions of paragraphs (1) to (8), *mutatis mutandis*, to a request for recordation, or cancellation of recordation, of a security interest, reference to the term “a licensing agreement,” “licensor” or “licensee” is to 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 (2)(a) are maintained, applying the introductory words of this paragraph, *mutatis mutandis*, to requests for cancellation of the recordation of a licensing agreement or a security

interest will have the effect that the documentation referred to in paragraph (2)(a)(i) or (ii) may be required, where the cancellation of the recordation 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 18

(Request for Correction of a Mistake)

R18.01 This Rule regulates the formal requirements and procedures concerning the request for correction of a mistake. In accordance with Article 2(2), 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 a search report, or in the course of substantive examination.

R18.02 Paragraph (1)(a), introductory words. 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 1.04). 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 this Rule. As regards the terms “applicant” and “owner,” reference is made to the explanations given under Article 1(viii) and (ix) (see Notes 1.06 and 1.07).

R18.03 Item (ii). Reference is made to the explanations given under Rule 15(1)(ii) (see Note R15.03).

R18.04 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 filed. 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 filed for each application and patent, to facilitate the work of the Office.

R18.05 Paragraph (1)(c). This provision permits a Contracting Party to refuse a request for correction of a mistake where the requesting party is unable to file a declaration that the said mistake was made in good faith, for example, where the mistake was made with deceptive intention. It is a matter for the Contracting Party concerned to decide what constitutes good faith.

R18.06 Paragraph (1)(d). This provision permits 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 is a matter for the Contracting Party concerned to decide what

constitutes undue or intentional delay; for example, it may consider that there is undue delay where the request is not diligently made.

R18.07 Paragraph (2)(a). Reference is made to the explanation under Rule 15(2) (see Note R15.05).

R18.08 Paragraph (3). Reference is made to the explanation under Rule 15(3) (see Note R15.06).

R18.09 Paragraph (4). This paragraph permits 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 is reasonable doubt as to whether the mistake was made in good faith, or where there is reasonable 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 Note R18.06). Reference is also made to the explanations given under Rule 15(4) (see Note R15.07).

R18.10 Paragraph (5). Reference is made to the explanations given under Rule 15(5) (see Note R15.08). As regards the restriction to formal requirements, reference is made to the explanation in Note R18.01.

R18.11 Paragraph (6). Reference is made to the explanations given under Rule 15(6) and (7) (see Note R15.09).

R18.12 Paragraph (7)(a). This paragraph permits a Contracting Party, in particular, one 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 (6).

R18.13 Paragraph (7)(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 19

(Manner of Identification of an Application
Without Its Application Number)

R19.01 *This Rule is subject to a reservation by the Delegation of China.*

R19.02 Paragraph (1). This paragraph prescribes the indications and elements which a Contracting Party is obliged to accept where the application number is required to be filed under Rules 2(5)(a), 10(1)(a)(ii), 15(1)(ii), 16(1)(ii), 17(1)(a)(ii) and 18(1)(a)(ii), but that number has not been issued or is not known. It follows from Article 2(1) that this paragraph allows a Contracting Party to accept less information than that prescribed in items (i) to (iii) or, additionally, to accept other means of identification.

Note on Rule 20

(Establishment of Model International Forms and Formats)

R20.01 Paragraph (1)(b). The modifications of the PCT request Form referred to in this provision are the modifications for the purpose of filing national and regional applications in accordance with Article 6(2)(b) and Rule 3(2)(i) (see Note R3.02). The PCT request Form for the purposes of filing international applications under the PCT will continue to be established as part of Administrative Instructions under PCT Rule 89.

R20.02 Paragraph (2). As regards the term “format,” reference is made to the explanation under Article 8(1)(a) (see Note 8.01).

Note on Rule 21

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

R21.01 This provision lists the Rules that can only be amended with unanimous agreement.

R21.02 Item(i). Under this item, any amendment, whether by way of addition or deletion, of further requirements under Rule 3(1) relating to the form or contents of the application under Article 6(1)(iii) requires a unanimous decision of the Assembly.

R21.03 Item(ii). Under this item, during the period of 10 years from the date of the entry into force of this Treaty, the right of applicants, under Rule 8(1), to file applications on paper

with any Office can only be excluded by a unanimous decision of the Assembly. 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.

R21.04 Item (iii). This item is intended to prevent the provisions of items (i) and (ii) being circumvented without unanimity, and to prevent the addition of reference to other Rules without the unanimous consent of the Assembly.

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