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DIPLOMATIC CONFERENCE FOR THE ADOPTION OF THE PATENT LAW TREATY

Geneva, May 11 to June 2, 2000

RESULTS OF THE TWENTY-EIGHTH (16TH EXTRAORDINARY) SESSION OF THE
PCT ASSEMBLY, MARCH 13 TO 17, 2000; ISSUES FOR POSSIBLE DISCUSSION AT
THE DIPLOMATIC CONFERENCE

document prepared by the International Bureau

INTRODUCTION

1. At its third session, held from September 6 to 14, 1999, the Standing Committee on the Law of Patents (SCP) discussed the interface between the draft Patent Law Treaty (PLT) and the Patent Cooperation Treaty (PCT). During that meeting, the International Bureau indicated that it would follow the ongoing discussions on possible amendments to the Regulations under the PCT and take appropriate action as to their possible repercussions for the forthcoming Diplomatic Conference (see paragraph 123 of document SCP/3/11). The present document reports the results of the twenty-eighth (16th extraordinary) session of the PCT Union Assembly, held in Geneva from March 13 to 17, 2000, and identifies some issues for possible discussion at the Diplomatic Conference, including suggested provisional draft text.

RESULTS OF THE PCT ASSEMBLY

2. The twenty-eighth (16th extraordinary) session of the PCT Union Assembly was held in Geneva from March 13 to 17, 2000. The two following issues which had relevance to the draft Patent Law Treaty (PLT) were discussed: proposed amendments to the PCT Regulations and proposed modifications of the PCT Administrative Instructions relating to the draft PLT; and the implementation of electronic filing and processing of international applications (see the Assembly's report in document PCT/A/28/5).

Amendments of the PCT Regulations and proposed modifications of the PCT Administrative Instructions relating to the draft Patent Law Treaty

3. The Assembly considered and adopted amendments of the Regulations under the PCT relevant to the link between the PLT and the PCT (see documents PCT/A/28/2, 2 Add. 1 and 2 Add. 2). The amendments permit applicants to file with the international application certain declarations using standardized wording, as prescribed in the PCT Administrative Instructions, in fulfillment of national phase requirements. The amendments also permit applicants to correct or add to the international application any such declaration until the expiration of 16 months from the priority date, or at the latest until technical preparations for international publication have been completed by the International Bureau. If such a declaration is filed, a designated Office of or acting for a PCT Contracting State could not, during the national phase of processing, require further documents or evidence regarding the issue with which the declaration is concerned unless the designated Office may reasonably doubt the veracity of the declaration.

4. The Assembly unanimously adopted the amendments to the Regulations as set out in Annex II of the report (see document PCT/A/28/5) and decided that the amendments would enter into force on March 1, 2001.

5. The Assembly also adopted certain transitional provisions. In general, if the law of a PCT Contracting State is not compatible with certain amendments on March 17, 2000, those amendments shall not apply to that Contracting State for as long as the amendments continue not to be compatible with that law, provided that the Contracting State informs the International Bureau accordingly by November 30, 2000.

6. Proposed modifications of the Administrative Instructions regarding the standardized wording for the declarations which may be filed with the international application were also discussed. Administrative Instructions are not adopted by the PCT Assembly, but promulgated by the Director General after consultation with the PCT Contracting States. Accordingly, the International Bureau will take into account the comments made by the Contracting States when revising the draft revised standardized wording of the declarations.

Implementation of electronic filing and processing of international applications

7. The PCT Assembly discussed electronic filing and processing of international applications (see document PCT/A/28/3 and 3 Add. 1 to Add. 5). The Assembly agreed that extensive redrafting of the draft technical standard ("Annex F") and proposed new Part 7 of the Administrative Instructions was required, and that such redraft should be made available

by the International Bureau at a later stage (see paragraphs 24 and 37 of document PCT/A/28/5).

8. With respect to the draft PLT, the Assembly noted that draft PLT Rule 8(2) would have the effect that any Office which accepted electronic filing of international applications under the PCT would have to also accept electronic filing of national applications, applying the same requirements. The International Bureau further noted that the provisions in the draft PLT concerning electronic filing contained the maximum which Offices could require, but that the latter would be free to accept communications desired by applicants and requiring a different level of technical capability (see paragraph 31 of document PCT/A/28/5).

9. A detailed description of the discussion is contained in the report of the PCT Assembly (document PCT/A/28/5).

SUGGESTIONS FOR DISCUSSION AT THE DIPLOMATIC CONFERENCE RELATING TO THE INTERFACE BETWEEN THE DRAFT PLT AND THE PCT

10. The discussions at the PCT Assembly raised a number of issues relating to the interface between the draft PLT and the PCT, and to provisions relating to electronic filing, including the filing date for applications filed electronically. During the meeting, a number of questions were identified by the International Bureau as requiring discussion at the Diplomatic Conference.

11. These issues include:

- (1) Incorporation-by-reference of future changes to the PCT;
- (2) Incorporation under the PLT of reservations contained in the present PCT Regulations;
- (3) Definitions of “form”, “Form”, “format”, “means” and “form or contents”;
- (4) Filing date.

These issues, and a number of suggested solutions, are outlined below. Preliminary suggested draft text to implement those solutions is presented in the Annexes, to clarify the issues raised and the possible solutions posed, and to facilitate consideration by the delegations.

*1. Incorporation-by-reference of future changes to the PCT**

12. Note 6.08 to the basic proposal for the PLT (document PT/DC/5) states:

“6.08 It is implicit in items (i) and (ii) [of Article 6] 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.”

* Any reference to the “PCT” is to be construed as a reference to the Patent Cooperation Treaty, together with the Regulations and the Administrative Instructions under the Patent Cooperation Treaty, unless otherwise specified.

13. This principle, which is not explicitly incorporated into the provisions of the basic proposal, is implicitly assumed in order to make the interface between the PLT and the PCT viable over time. However, there has been no discussion in the context of the SCP of the international treaty law implications of such automatic incorporation by reference of future changes to another treaty.

14. The International Bureau has been unable to identify any identical or analogous provisions in other treaties. The closest examples in the intellectual property field appear to be the following:

- Article 62(3) of the PCT states that Article 24 of the Paris Convention shall apply. It is to be noted, however, that the membership to PCT is limited to countries party to the Paris Convention.
- Article 14(7) of the Madrid Agreement Concerning the International Registration of Marks states that Article 24 of the Paris Convention shall apply. Membership to the Madrid Agreement is limited to countries party to the Paris Convention.
- Article 2.1 of the TRIPS Agreement incorporates Articles 1 to 12 and 19 of the Stockholm Act of the Paris Convention by reference. The TRIPS Agreement does not, however, incorporate future changes to the Paris Convention.
- Article 15 of the Trademark Law Treaty provides for an obligation to comply with the provisions of the Paris Convention, as revised and amended, which concern marks. In this case, membership is not limited to being a Contracting Party to the Paris Convention.
- Article 1(4) of the WIPO Copyright Treaty requires Contracting Parties to comply with Articles 1 to 21, and the Appendix, of the Paris Act of the Berne Convention. Membership is not limited to being a Contracting Party to the Berne Convention.

15. The incorporation by reference of PCT requirements into the PLT poses special difficulties, most especially for countries which are not Contracting States of the PCT and which are therefore not represented in the PCT Assembly, as they would have no voice in future changes to the PCT Regulations. Further, future changes to the PCT Administrative Instructions are automatically incorporated into the PLT, even though these changes are promulgated by the Director General of WIPO after consultation with Offices or Authorities which have a direct interest in the proposed modifications, but without express approval by the PCT Assembly (noting, however, that the Director General is required to consult interested Offices and Authorities before modifying the PCT Administrative Instructions, and that the contents of those Administrative Instructions are under the ultimate control of the PCT Assembly, since PCT Rule 89.2(c) provides that “the Assembly may invite the Director General to modify the Administrative Instructions, and the Director General shall proceed accordingly.”).

16. The International Bureau considers that this issue is essential to the long-term viability of the PLT, and would therefore suggest that it be discussed fully at the Diplomatic Conference. In order to facilitate that discussion, a number of possible solutions, along with suggested amended text, are presented below. These possible solutions have been based on the premise that membership in the PLT should be as open as possible, as has been decided by the SCP.

Option (1): Require PLT Assembly to Ratify Future PCT Changes

17. This option would require that the PLT Assembly explicitly ratify any future changes to the PCT before those changes have effect under the PLT.

18. An advantage of this option is that it would be sound under international law, since the incorporated PCT changes would have the same status as changes to the PLT Regulations which are adopted by the PLT Assembly. For convenience, future changes to the PCT Regulations could be adopted by a joint session of the PCT and PLT Assemblies. A disadvantage is that this option would require that the PLT Assembly meet to ratify each future PCT change, even if the change only involved the PCT Administrative Instructions.

Option (2): Automatic Incorporation of Future PCT Changes with Possibility for the PLT Assembly to Reject

19. This option would give the possibility to the PLT Assembly to reject future PCT changes within a certain time period. If the changes were not rejected by the PLT Assembly, they would have automatic effect under the PLT.

20. An advantage of this option is that it would not require the PLT Assembly to meet for every future PCT change, including changes in the Administrative Instructions. A disadvantage is that a special procedure would be required to convene the PLT Assembly in special session in order to decide not to incorporate the change.

Option (3): Consultation Procedure for Ratification/Rejection of Future PCT Administrative Instructions Changes

21. This option would allow the PLT Assembly to adopt or reject future PCT Administrative Instruction changes without convening in session. This procedure could be used in conjunction with either of the above options. It would solve the problem of having to convene the PLT Assembly each time the PCT Administrative Instructions were modified. The PCT contains provisions for such a consultation procedure in the case of modifications to the Administrative Instructions (PCT Article 58(4) and Rule 89). Under the PCT, this consultation procedure may be either a written procedure, or an oral procedure at a PCT Assembly meeting. In the future, a common written procedure for both PCT Contracting States and PLT Contracting Parties may be envisaged. As under the PCT, if the PLT Assembly meets, an oral consultation may also be appropriate in certain cases.

Option (4): Availability of General or Individual Reservations to Future PCT Changes by PLT Contracting Parties

22. The PCT Assembly has on occasion decided, when adopting amendments to the Regulations under the PCT, to include provisions to the effect that certain amended Rules would not apply to any State (or Office) which informs the International Bureau, within a certain period, of incompatibility with the national (or regional) law as in force at the time of the adoption of the amendments; the amended Rules concerned would then not apply to that

State (or Office) for as long as the incompatibility continues. Such provisions allowing for "transitional reservations" have been necessary in order to give PCT Contracting States time to bring their national law into conformity with amended Rules, even though the principles underlying the amendments have been unanimously agreed by the PCT Assembly. This possibility could be incorporated into the PLT with respect to future PCT changes, whereby Contracting Parties to the PLT could enter a reservation to PCT changes as they are applied under the PLT. These could be adopted by the PLT Assembly as general reservations, which would cover all Contracting Parties (for example, with respect to PCT Regulations which do not pertain to national filings), or as individual reservations, which would allow a period of time for PLT Contracting Parties to enter reservations with respect to the application, under the PLT, of specific PCT changes.

23. Suggested draft text concerning certain combinations of the above options is contained in Annexes I to III.

2. Incorporation under the PLT of transitional reservations contained in the present PCT Regulations

24. According to the present text of the draft PLT, transitional reservations made by PCT Contracting States to provisions of the PCT Regulations would be incorporated into the PLT. Current reservations are contained in PCT Rules 4.10(d), 20.4(d), 26.3ter(b), 26.3ter(d), 49.5(l), 51bis.1(f), 51bis.2(c), 51bis.3(c) and 76.6. It has been suggested that existing transitional reservations contained in the PCT Regulations not be carried over into the PLT, but that future transitional reservations be carried over, to allow sufficient time for implementation in national laws. This could be accomplished by a new provision as suggested in Annex IV.

3. Definitions of "form", "Form", "format", "means" and "form or contents"

25. The terms "form", "format", "means" and "form or contents" are used in both the draft PLT and the PCT, but in some cases they are used in different ways. For example, "format" in the PLT is used to refer to the order and arrangement of data in a communication, while it is used in the draft PCT Administrative Instructions to refer to the way in which data is presented in electronic documents.

26. In order to ensure harmonized use of these terms in both treaties, it is suggested that a discussion at the Diplomatic Conference take place in order to consider either removing or defining those terms.

27. One option would be to delete the word "format" from the draft PLT, and to subsume it in the definition of the term "form". That definition could be included according to the following suggested draft text for draft PLT Article 1:

“(ivbis) The word “form” means the physical medium which contains the information, including the physical requirements or electronic protocol in which the information is fixed, as well as the presentation and arrangement of the information, on that medium, except where the context indicates otherwise.”

28. Taking into account the rapid changes in the technical field related to the definition of “form”, it may be appropriate to include that definition into Rule 1 of the Regulations, and to provide for the legal basis in the Treaty. It has, however, to be noted that the definition would define a term used both in the Treaty and the Regulations. Another option is to include the definition in the Treaty, and to make it subject to amendment by the PLT Assembly, pursuant to draft PLT Article 18(2). Corresponding modifications of draft PLT Article 18(2) and (3) would be required.

29. The term “Form”, which is used only in the PLT, would not require a definition, as it only appears along with the qualifiers “request” or “Model International”.

30. It is suggested, in draft PLT Article 5(1) and Rules 7(2)(b), 15(3)(b) and 16(5), to replace “means” with a mention of “as otherwise permitted by the Office”, and to replace “means” and “means of filing” with “means of transmittal” in Articles 1(v) and 8(1) and Rules 8(2) to (4) and 9(4).

31. The phrase “form or contents” has the same meaning in the draft PLT as under the PCT. A specific aspect arising in conjunction with the review of this phrase concerns its use in draft PLT Article 6, and in particular the relationship of Article 6 with draft PLT Article 8 and Rule 8 on communications. Suggested draft text for consideration at the Diplomatic Conference is contained in Annex V.

4. Filing date

32. The PCT Assembly discussed the effect of electronic filing of applications on the filing date. In particular, in respect of the so-called “ticket mechanism”, numerous delegations expressed doubts concerning whether the ticket mechanism (as explained in document PCT/A/28/3 Add.1) satisfied the requirements of Article 11 of the PCT, or their respective national or regional laws for according a filing date. However, some delegations indicated their desire to utilize the ticket mechanism or an alternative mechanism to accomplish the same objectives of safeguarding international filing dates. It was agreed that the legal and technical aspects of the possible implementation of the ticket mechanism would be further reviewed.

33. It is suggested that a discussion take place at the Diplomatic Conference on the question of amending draft PLT Article 5(1), perhaps in a general way or subject to future amendments of the Regulations, in order to allow applicants to obtain a filing date using future technologies. Under these conditions, the words “no later than” may no longer be needed. Suggested draft text for consideration at the Diplomatic Conference is contained in Annex VI.

[Annexes follow]

ANNEX I

The following draft text suggests amendments related to the interface between the PLT and the PCT as explained in paragraphs 12 to 23 of document PT/DC/6, and in particular concerning draft PLT Article 1.

These amendments are applicable to both options contained in Annexes II and III and are to be used in conjunction with those two Annexes.

Article 1

Definitions

(xvi) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised ~~and amended~~ at Stockholm on July 14, 1967 and as amended on September 28, 1979;

(xvii) “Patent Cooperation Treaty” means the Patent Cooperation Treaty (“PCT”), signed on June 19, 1970, ~~as amended and modified~~ together with the Regulations and the Administrative Instructions under that Treaty, as amended and modified by June 2, 2000, and including amendments and modifications made after that date as provided for in Article 15(3);

[Annex II follows]

ANNEX II

The following draft text suggests amendments related to the interface between the PLT and the PCT as explained in paragraphs 12 to 23 of document PT/DC/6, and in particular a combination of Options 1, 3 and 4 that relates to draft PLT Articles 15 and 16.

Options 1, 3 and 4

Article 15

Relation to the Paris Convention and the Patent Cooperation Treaty

...

(3) [Future Amendments and Modifications of the Patent Cooperation Treaty] The Patent Cooperation Treaty as defined in Article 1(xviii) shall include any amendment and modification of the provisions under the Patent Cooperation Treaty made after June 2, 2000, provided that such inclusion is decided by the Assembly, as prescribed in the Regulations, and that such inclusion is compatible with the Articles of this Treaty.

Article 16

Assembly

...

(2) [Tasks] The Assembly shall:

(vbis) decide whether any future amendment and modification to the provisions under the Patent Cooperation Treaty shall be included in this Treaty pursuant to Article 15(3);

Rule 22

Details Concerning the Future Amendments and Modifications of the Patent Cooperation Treaty Under Article 15(3)

(1) Inclusion of any future modifications of the Administrative Instructions under the Patent Cooperation Treaty under Article 15(3) shall be decided by way of a written consultation procedure or of an oral consultation procedure by the Assembly.

(2) At the request of any Contracting Party, the Director General shall proceed with the written consultation procedure referred to in paragraph (1).

[(3) Where any future amendment or modification of the Regulations and the Administrative Instructions under the PCT which is included in the Treaty under Article 15(3) is not compatible with the applicable law of a Contracting Party [which is not a Contracting State of the Patent Cooperation Treaty], that amendment or modification shall not apply under the Treaty to that Contracting Party for as long as the said amendment or modification continues not to be compatible with that law, provided that the said Contracting Party informs the International Bureau accordingly within [six] months from its inclusion in the Treaty.]

(4) [The details concerning the procedure to ratify future PCT changes under Article are reserved.]

[Annex III follows]

ANNEX III

The following draft text suggests amendments related to the interface between the PLT and the PCT as explained in paragraphs 12 to 23 of document PT/DC/6, and in particular a combination of Options 2, 3 and 4 that relates to draft PLT Articles 15 and 16.

Options 2, 3 and 4

Article 15

Relation to the Paris Convention and the Patent Cooperation Treaty

...

(3) [Future Amendments and Modifications of the Patent Cooperation Treaty] The Patent Cooperation Treaty as defined in Article 1(xviii) shall automatically include any amendment and modification of the provisions under the Patent Cooperation Treaty made after June 2, 2000, except where the Assembly decides not to include that amendment or modification, as prescribed in the Regulations, provided that such inclusion is compatible with the Articles of this Treaty.

Article 16

Assembly

...

(2) [Tasks] The Assembly shall:

(vbi) decide that any future amendment and modification to the provisions under the Patent Cooperation Treaty shall not be included in this Treaty pursuant to Article 15(3);

Rule 22

Details Concerning the Future Amendments and Modifications of the Patent Cooperation Treaty
Under Article 15(3)

(1) The decision under Article 15(3) concerning non-inclusion of any future modifications of the Administrative Instructions under the Patent Cooperation Treaty shall be made by way of a written consultation procedure or of an oral consultation procedure by the Assembly.

(2) At the request of any Contracting Party, the Director General shall proceed with the written consultation procedure referred to in paragraph (1).

[(3) Where any future amendment or modification of the Regulations and the Administrative Instructions under the PCT which is included in the Treaty under Article 15(3) is not compatible with the applicable law of a Contracting Party [which is not a Contracting State of the Patent Cooperation Treaty], that amendment or modification shall not apply under the Treaty to that Contracting Party for as long as the said amendment or modification continues not to be compatible with that law, provided that the said Contracting Party informs the International Bureau accordingly within [six] months from its inclusion in the Treaty.]

(4) [This provision shall set out the details concerning the procedure to reject future PCT changes within a certain time period by the Assembly under Article 15(3).]

[Annex IV follows]

ANNEX IV

The following draft text suggests a new draft PLT Rule 3(1)(c) according to which existing transitional reservations under the PCT would not take effect under the PLT, as explained in paragraph 24 of document PT/DC/6.

Rule 3

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

...

(1)(c) For the purpose of this Treaty and the Regulations, no Contracting Party may apply the provisions of PCT Rules 4.10(d), 20.4(d), 26.3ter(b), 26.3ter(d), 49.5(1), 51bis.1(f), 51bis.2(c), 51bis.3(c) and 76.6.

[Annex V follows]

ANNEX V

The following draft text suggests amendments concerning the relationship between the application (draft PLT Article 6) and communications (draft PLT Article 8 and related Rule 8), as referred to in paragraphs 32 and 33 of document PT/DC/6.

Article 8

Communications; Addresses

(1) [~~Form; Format and Means of Filing~~ Transmittal of Communications] (a) Except for the establishment of a filing date under Article 5(1), and subject to Article 6(1), the Regulations shall, subject to subparagraphs (b) to (d), set out the requirements which a Contracting Party shall be permitted to apply as regards the form, ~~format~~ and means of ~~filing-transmittal~~ of communications.

...

(2) [*Language of Communications*] A Contracting Party may, except where otherwise provided for by this Treaty or the Regulations, require that a communication other than an application be in a language accepted by the Office.

(3) [~~Model International Forms; Model International Formats~~] Notwithstanding paragraph (1)(a), and subject to paragraph (1)(b), a Contracting Party shall accept the presentation of the contents of a communication other than an application on a Form ~~or in a format~~ which corresponds to a Model International Form ~~or a Model International Format~~ in respect of such a communication provided for in the Regulations, if any.

Rule 8

Filing of Communications Under Article 8(1)

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

(b) Subject to Article 8(3) and paragraph (c), a Contracting Party may ~~require~~ prescribe the requirements relating to the form of that a communications on paper be filed on a form, or in a format, prescribed by that Contracting Party.

(c) Where a Contracting Party permits the filing of communications on paper, the Office shall permit the filing of communications on paper in accordance with the requirements under the Patent Cooperation Treaty relating to the form of communications on paper.

[Annex VI follows]

ANNEX VI

The following draft text suggests amendments concerning the filing date (draft PLT Article 5 and Rule 21, as explained in paragraphs 32 and 33 of document PT/DC/6.

Article 5

Filing Date

(1) [*Elements of Application*] (a) Subject to paragraphs (2) to (8) and to any requirements prescribed in the Regulations, a Contracting Party shall provide that the filing date of an application shall be ~~no later than~~ the date on which its Office has received all of the following elements, filed, at the option of the applicant, on paper or ~~by other means~~ as otherwise permitted by the Office for the purpose of according a filing date:

...

Rule 21

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

Amendment of the following Rules shall require unanimity:

...

(iibis) the Rules established under Article 5(1);

[End of Annexes and of document]