

INFORMAL COMMENTARY CONCERNING THE REVISED TEXT OF PROVISIONS  
REFERRED TO THE INTERNATIONAL BUREAU FOR FUTURE STUDY  
(DOCUMENT SCP/1/8 PROV.)

Commentary on draft Article 1(i):

Since not all Offices are entrusted with the granting of patents, it is proposed to broaden the definition of "Office" to cover procedures which are included within the scope of the draft Treaty, for example, the recordal of change in owner or the recordal of a licensing agreement. The expression "other matters covered by this Treaty" is used in, for example, Article 17(2) of the WIPO Copyright Treaty (WCT) (1996).

Commentary on draft Article 1(xi):

To avoid the possibility of introducing a *de facto* interpretation of the term "address for service" as used in Article 2(3) of the Paris Convention, it is proposed that that term should not be defined in the Treaty. What constitutes an "address for service" would be a matter for national law. Since the provisions which refer to "address for service" are maximum requirements, a Contracting Party could apply a lesser requirement, for example, "an address for communication."

Proposed new item defining "inventor":

The inclusion of a new item, as suggested by the Delegation of the United States of America, stating that the determination of who is the inventor is a matter of national law, is not proposed. However, since the term "inventorship" is used in draft Articles 10(12) and 12(12), it is proposed to add to each of those Articles the following statement: "What constitutes inventorship shall be determined under the applicable law of the Contracting Party."

Commentary on draft Article 1*bis*(1):

It is proposed to include this general provision, in place of redrafting draft Article 4(3), in respect of a notification by the Office where indications allowing a person to be contacted by the Office have not been submitted.

Commentary on draft Article 1*bis*(2):

This general provision is added for avoidance of doubt.

Commentary on draft Article 3:

The term "take any action," as used in Article 73 of the TRIPS Agreement, is proposed in order to encompass both "measures" and "procedures."

#### Commentary on draft Article 4(3):

The proposal to delete the reference to draft item (1)(a)(ii), that is, to restrict the provision to the requirements of paragraphs (1)(a)(i) and (iii), (1)(b) and (2), has not been followed. If an applicant fails to comply with the requirement of, say, paragraph (1)(a)(i) and complies with the requirement of paragraph (1)(a)(ii) by furnishing indications allowing the identity of the applicant to be established, and not by furnishing indications allowing him to be contacted, it would still not be possible for the applicant to be notified of the failure to comply with the requirement of paragraph (1)(a)(i). Instead of revising this paragraph, a general provision, namely new draft Article *1bis*, is proposed in order to cover the cases where indications allowing a person to be contacted by the Office is not submitted.

#### Commentary on draft Article 4(5):

This paragraph now regulates all of the formal procedures which apply for the purposes of determining the filing date where a part of the description is missing from the application or the application refers to a drawing which, in fact, is missing from the application. Since it is necessary for the filing date to be determined without undue delay, it is proposed that this paragraph should be restricted to those cases where the procedures concerned, namely any determination of the missing description or drawing by the Office, notification to the applicant and submission of missing part of description or drawing by the applicant, take place within a short period from the receipt of the incomplete application. It should be noted that the corresponding provisions in respect of missing drawings under PCT Article 14(2) and Rules 20.2(a)(iii) and 26.6(b), after which this paragraph is modeled in part, apply where the missing drawings are received within 30 days from the date on which the incomplete papers were filed.

Where the Office makes a determination and notifies an applicant, after the expiration of the time limit prescribed in draft Rule 2(*1bis*), that a part of the description or a drawing is missing, it might still be possible, under the applicable national law, for the applicant to rectify the omission of the missing description or drawing by way of an amendment or a correction of the application. However, this would be a matter of substantive law which is not regulated under the draft Treaty.

#### *Subparagraph (a):*

The contents of former paragraph (3)(b) have been transferred to this subparagraph with the incorporation of a reference to a missing part of the description. In addition, it is now made clear that the notification by the Office shall be made promptly after the determination that a part of the description or drawing is missing.

*Subparagraph (b):*

The contents of former paragraph (5)(a) have been transferred to this subparagraph with the incorporation of a reference to a missing part of the description. In addition, the former last sentence regarding any reference to the drawing being considered non-existent has been replaced by a positive requirement that the missing part of the description or drawing be included in the application if it is furnished within the applicable time limit. This subparagraph is not restricted to the case in which the missing description or drawing is furnished in response to a notification under subparagraph (a). It, therefore, also regulates the procedure in which the applicant himself realizes that part of the description or the drawing has been omitted and furnishes the missing description or drawing in the absence of, or prior to, such notification.

*Subparagraph (c):*

The contents of former paragraph (5)(b) have been transferred to this subparagraph with the incorporation of a reference to a missing part of the description. As in the case of former paragraph (5)(b), no Contracting Party would be required to make a determination under this subparagraph. Where there is more than one missing part of the description or drawing, none of those parts may contain new matter for this subparagraph to apply. If there is more than one missing part of the description or drawing and the Office determines that a part of the missing description or drawing contains new matter, subparagraph (c) would apply if the part which contains new matter is withdrawn under subparagraph (e).

In response to the concerns expressed at the first session, first part of the SCP regarding the applicability of this provision where the determination that a part of the description or drawing is missing is not made until after the publication of the application, for example, during substantive examination, it is proposed that the provision should be restricted to those cases where that determination is made within a time limit prescribed by the Contracting Party, if any; for example, before the completion of the technical preparations for publication.

*Subparagraph (d):*

The contents of former paragraph (6) have been transferred to this subparagraph with the incorporation of a reference to a missing part of the description. In addition, this subparagraph now refers expressly to the determination referred to in subparagraph (c) for the purposes of the filing date. Any provisions applicable to the determination of the allowability of incorporating a missing part of the description or drawing by way of amendment or correction would not be regulated by the draft Treaty and would remain a matter for national law.

*Subparagraph (e):*

The contents of former paragraph (5)(c) have been transferred to this subparagraph with the incorporation of references to a missing part of the description and to the determination under subparagraph (c). This provision would enable an applicant to preserve, as the filing date, the date (the "original filing date") on which the requirements of paragraphs (1) and (2) were complied with by withdrawing all or part of the missing description and drawings

furnished under subparagraph (b) in respect of which the determination referred to in subparagraph (c) has been made. An example would be where, after the original filing date, the applicant furnished three missing drawings which were unintentionally omitted from an application claiming the priority of an earlier application, only two of which were included in the earlier application. In the case of an Office which applies subparagraph (c), the applicant would only be required to withdraw the drawing which was not in the earlier application in order to retain the original filing date, provided that he requested that the contents of the earlier application be considered under that paragraph.

Commentary on draft Article 4(8):

New item (ii) would permit a Contracting Party to apply different filing date requirements in the case of an application for continuation or continuation-in-part of an application, each of which is a type of application to which the draft Treaty applies under Article 2(1)(a). The reference to “divisional applications” in the title and item (i) are presented in square brackets pending a decision on the inclusion in the PCT Regulations of a provision permitting a divisional application to be filed as an international application (see Note 4.30 in document SCP/1/4).

Commentary on draft Article 7(3):

The proposed amendment of this paragraph is intended to clarify the requirement for address for service where the applicant has provided the address of a domicile or business on the territory of the Contracting Party concerned.

Commentary on draft Article 7(4):

This provision has been modified to conform with the contents of Model International Form No.2 and to avoid the need to include a requirement for the name and address of the representative under Rules 9 to 12.

Commentary on draft Article 9(1):

It is proposed to transfer the indications required in the request for recordal of change in name or address under this Article to the Regulations, namely, Rule 9(1).

Commentary on draft Article 10(1):

It is proposed to transfer the indications required in the request for recordal of change in applicant or owner under this Article to the Regulations, namely, Rule 10(1).

Commentary on draft Article 10(12):

Reference is made to the explanation under Article 1 on the proposed new item defining “inventor.”

Commentary on draft Article 11(1):

It is proposed to transfer the indications required in the request for recordal of a licensing agreement or security interest under this Article to the Regulations, namely, Rule 11(1).

Commentary on draft Article 12(1):

It is proposed to transfer the indications required in the request for correction of mistake under this Article to the Regulations, namely, Rule 12(1).

Commentary on draft Article 12(12):

Reference is made to the explanation under Article 1 on the proposed new item defining “inventor.”

Commentary on draft Article 13(2):

It is proposed to transfer the exceptions under this Article to the Regulations (new draft Rule 13(1*bis*)). This would both simplify the Treaty and facilitate the adoption of any future changes which may be required.

Commentary on draft Article 13(4):

The reference to Article 5(5) has been corrected.

Commentary on draft Article 14; Title:

The title has been amended in consequence of the proposed changes to paragraph (1).

Commentary on draft Article 14(1):

In order to clearly distinguish between draft Articles 14 and 15, it is highlighted that draft Article 14 is restricted to the cases where a finding by the Office that the non-compliance with the time limit occurred in spite of all due care is not required.

It is proposed to move former draft Article 14(1)(b) to new Rule 14(1*bis*), and to provide that a Contracting Party may require that the request under this paragraph be accompanied by a statement that the failure to comply with the time limit was unintentional, if that request is made, and all the requirements are complied with, later than two months from

the date of the expiration of the time limit for an action in a procedure before the Office, following the statement by the Delegation of the United States of America that if draft Rule 14(1) were to be limited to a very short period, for example no more than two months from the date of the expiration of the time limit for an action in a procedure before the Office, there may be no need for a statement, and the comment by the Delegation of Germany that draft Article 14 should be restricted to a procedure where relief is subject only to the payment of a fee.

In accordance with the views expressed by a majority of these delegations, this paragraph refers to any situation where an applicant [or owner] fails to comply with a time limit fixed by the Office.

Following suggestions regarding the terminology used, this paragraph now provides for the Office to “re-instate” an application or patent. In the absence of any clear consensus as to whether re-instatement should be provided under this paragraph in the case of a patent, the term “or patent” is placed in square brackets for further consideration. The manner in which a Contracting Party provides for such re-instatement would be a matter for national law. For example, in the case of an application, it could be by way of so-called “further processing” as under Swiss law and the European Patent Convention, or by way of “revival” as under US law.

Commentary on draft Article 14(2):

It is proposed that the exceptions under this paragraph be transferred to the Regulations (new draft Rule 14(1*ter*)). This proposed transfer would simplify the Treaty and facilitate the adoption of any future change which may be required.

Commentary on former draft Article 14(9):

On further consideration, the International Bureau is of the opinion that provisions on intervening rights contained in former draft Article 14(9) relate to a matter of substantive patent law and should therefore not be included in the draft Treaty. The effect of the proposed deletion of this paragraph is that the provision for intervening rights would remain a matter of national law. Similar considerations apply to former draft Articles 15(9) and 16 (9).

Commentary on Article 15, title:

In order to highlight the distinction between draft Articles 14 and 15, a reference to a finding of due care by the Office has been included in the title of draft Article 15.

Commentary on draft Article 15(1):

For the reasons given in the Commentary on draft Article 14(1), it is proposed to use the term “re-instate.” This paragraph is re-drafted so that the structure of the sentence would be similar to that of draft Article 14(1).

Commentary on draft Article 15(2):

As in the case of the proposed amendment draft Article 14(2), it is proposed that the exceptions under draft Article 15(2) be transferred to the Regulations (new draft Rule 15(1*bis*)).

Commentary on former draft Article 15(9):

Reference is made to the Commentary, above, on former draft Article 14(9).

Commentary on draft Article 16(9):

Reference is made to the Commentary, above, on former draft Article 14(9).

Commentary on draft Rule 2(1*bis*)(a):

This subparagraph is modeled after PCT Rule 20.2(a)(iii). The period of “two months” is proposed in conformity with draft Rule 2(1).

Commentary on draft Rule 2(1*bis*)(b):

This subparagraph is modeled after PCT Rule 26.6(b).

Commentary on draft Rule 2(2)(a):

The proposed amendment is in consequence of the proposed amendment to former draft Article 4(6).

Commentary on draft Rule 2(2)(b):

In response to the concerns raised at the first session, first part, of the SCP, the phrase “in official form ... by electronic means” has been replaced by a reference to “a digital library accepted by the Office.”

Commentary on draft Rule 2(3)(a):

The proposed amendment is based on the proposal by the International Bureau at the first session, first part, of the SCP.

Commentary on draft Rule 2(3)(e):

Reference is made to the commentary on draft Rule 2(2)(b).

Commentary on draft Rule 9(1):

Items (i) and (ii) are transferred from Article 9(1).

It is proposed to delete former items (ii) and (iii) since draft Article 7(4) provides for a Contracting Party to require the indications concerned to be indicated in the power of attorney, or request Form referred to in draft Article 5(2), in which the representative is appointed. Former item (i), which is re-numbered as item (iii), is retained since it may be required by the Office as a check that the change is requested in respect of an application or patent in the name of the person whose name and address is indicated.

Commentary on draft Rule 10(1):

Reference is made to the Commentary on draft Rule 9(1).

Commentary on draft Rule 11(1):

Reference is made to the Commentary on draft Rule 9(1).

Commentary on draft Rule 12(1):

Reference is made to the Commentary on draft Rule 9(1).

Commentary on draft Rule 13(1*bis*)(a):

Items (i) and (ii) correspond to items (i) and (ii) of draft Article 13(2)(b) as proposed in document SCP/1/3. In response to a proposal by the Delegation of the United States of America that further exceptions be provided in respect of the extension of a time limit as of right in the case of expedited or specialized procedures, appeals, interferences and oppositions, the following new items have been added.

item (iii): this provides for an exception in the case of appeals and other reviews before the Office, using the same language as that in former Article 15(2)(i);

item (iv): this provides for an exception in the case of opposition proceedings;

item (v): this provides an exception which would apply to interferences under US law, in particular 35 U.S.C.A. §135, where an application is made for a patent which would interfere with any pending application or with any unexpired patent.



item (vi): this provides for an exception where a request for expedited processing has been granted. This item is placed in square brackets since it is not clear whether it is needed since, as in the case of practice before the European Patent Office, the Office could simply withdraw expedited processing if a request for extension of time is made.

Commentary on draft Rule 13(1*bis*)(b):

This provision corresponds to draft Article 13(2)(a) as proposed in document SCP/1/3.

Commentary on draft Rule 14(1):

It is proposed that the time limit for making the request, and for complying with the requirements, under draft Article 14(1) should be maintained as proposed in former draft Rule 14(1). However, for the reasons explained in the Commentary on draft Article 14(1), inclusion of new draft Rule 14(1*bis*) is proposed.

Commentary on draft Rule 14(1*bis*):

Reference is made to the Commentary on draft Article 14(1).

Commentary on draft Rule 14(1*ter*)(a):

This provision, which replaces the general provision for excluding certain time limits in former draft Article 14(2)(b), is modeled after the exceptions listed in former draft Article 15(2) in document SCP/1/3. With respect to item (ii), it is proposed to protect all rights of applicants under the Paris Convention, including the grace period referred to in Article 5*bis*(1) of that Convention, under the Final Clauses, as suggested at the first session, first part, of the SCP.

Commentary on the draft Rule 14(1*ter*)(b):

This provision corresponds to former draft Article 14(2)(a) in document SCP/1/3.

Commentary on draft Rule 14(2):

The proposed amendment is in consequence of the proposed changes to draft Article 14(1).

Commentary on draft Rule 15(1):

In response to the comment made at the first session, first part, of the SCP, it is proposed that the time limit for making a request under draft Article 15(1) should be calculated from the date of the removal of the cause of the failure to comply with the time limit concerned, as under the current Swiss Patent Law and the European Patent Convention, rather than from the date on which the requesting party is notified.

Commentary on draft Rule 15(1bis):

In the absence of any agreement on proposed changes to the exceptions listed in former draft Article 15(2) in document SCP/1/3, this list is retained by reference, *mutatis mutandis*, to new draft Rule 14(1ter)(b).

Commentary on draft Rule 15(2):

The proposed amendment is in consequence of the proposed changes to draft Article 15(1).

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