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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

DIPLOMATIC CONFERENCE FOR THE ADOPTION OF THE PATENT LAW TREATY

Geneva, May 11 to June 2, 2000

ARTICLES 1 TO 3, 5 TO 8, 11 TO 13, 17, 19, 21 AND 24
AND RULES 7, 8, 12, 13, 16 AND 18

Comment and Proposal by the Delegation of the United States of America

The following comments are made, and modifications are suggested, by the Delegation of the United States of America.

(1) *Article 1(v)*. Comment and proposal: In item (v), the use of the phrase “means permitted by the Office” in this definition, and in the chapeau to Article 5(1)(a), may conflict with Article 8(1)(a) which states that the establishment of a filing date is not subject to the requirements which a Contracting Party shall be permitted to apply as regards the “form, format and means of filing of communications.” The statement in Note 1.03 that the limited nature of this definition “allows a Contracting Party to disregard any communication that is filed by means which that Office does not permit, except as otherwise prescribed in the Treaty” does not suffice for making the intended distinction. The phrase “except as otherwise prescribed in the Treaty” should be included in the definition, as follows:

“(v) “communication” means any application, or any request, declaration, document, correspondence or other information relating to an application or patent, whether relating to a procedure under this Treaty or not, which is filed with the Office by means, except as otherwise prescribed in the Treaty, permitted by the Office;”

(2) *Article 1(viii)*. Comment and proposal: The “person ... applying for the patent” should be subject to the same “applicable law” limitation to which the “another person ... filing or prosecuting the application” is subject. Accordingly, the United States proposes the insertion of the phrase “, pursuant to the applicable law,” after “who” in the second line of this provision, as follows:

“(viii) “applicant” means the person whom the records of the Office show as the person who, pursuant to the applicable law, is applying for the patent, or whom the records of the Office show as another person who, pursuant to the applicable law, is filing or prosecuting the application;”

(3) *Article 2(1)*. Comment and proposal: The comments herein are dependent upon the fate of Article 5. The United States has consistently regarded the requirements of Article 5 to be maximum requirements similar to the requirements throughout the rest of the treaty. As such, the United States proposes the deletion of the phrase “other than Article 5,” as presented in the Basic Proposal. We have also consistently supported the retention of the phrase “no later than” throughout Article 5. However, if Article 5 is changed to: (1) limit paragraph (1)(a) to item (iii) (a description), alone, and (2) accommodate electronic filing, the United States may be able to support this provision with the phrase “other than Article 5,” as presented in the Basic Proposal. It is worth noting that if “no later than” is adopted throughout Article 5, the retention of the phrase “other than Article 5” here in Article 2 appears meaningless.

(4) *Article 3(1)(a)*. Comments and proposal: In item (i), the United States proposes that the phrase “that can” be changed to “permitted to.” This change would provide Contracting Parties with the assurance that current freedoms to control the types of applications that are permitted, by applicable law, to be filed as international applications will be maintained. The phrase “that can” may introduce ambiguities in this regard.

In item (ii), the United States proposes the addition of the phrase “of the types of applications in (i)” after “applications” to more clearly exclude plant and design applications, which, in some Contracting Parties, may be regarded as applications for inventions.

(5) *Article 3(1)(b)*. Comment and proposal: The United States supports the addition of a comma after “applications” to clarify that “international applications” applies to both “patents for invention” and “patents of addition.”

(6) *Article 5*. Comment and proposal: As noted with regard to Article 2, the position below is dependent upon whether certain changes to Article 5 to: (1) limit paragraph (1)(a) to item (iii) (a description), alone, and (2) accommodate the electronic filing issue are, in fact, adopted at the Diplomatic Conference. If those proposals are not offered by another delegation, the United States hereby proposes them. If those proposals are adopted, we may be able to accept paragraph (1) of this Article as so amended.

Otherwise, the United States proposes the insertion of the phrase “no later than” throughout Article 5 in those locations where it is included in brackets in the Basic Proposal. If “no later than” is not accepted, then, to preserve flexibilities on this issue, the United States will seek the deletion of the phrase “other than Article 5” in Article 2(1).

(7) *Article 5(1)(a)*. Comments and proposal: The United States proposes that the phrase “permitted by the Office” in the chapeau to paragraph (1)(a) be deleted. From the understanding of this provision achieved during the last meeting of the SCP, a filing date must be granted even if an application does not comply with Article 8(1) and Rule 8 requirements. This understanding is reflected in Note 5.05. This is also expressed in Article 8(1)(a) which states “[e]xcept for the establishment of a filing date under Article 5(1).” We have consistently supported the grant of a filing date for anything received by and comprehensible to an Office of a Contracting Party.

(8) *Article 6(1) and Article 1*. Comment and proposal: With regard to Article 6(1)(ii), a definition for “Contracting State” should be provided in Article 1. It is defined in PCT Article 1(1) as “States party to the Patent Cooperation Treaty.”

(9) *Article 7(2)* Comment and proposal: With regard to Article 7(2), the United States has consistently supported maximizing the exceptions to mandatory representation. Accordingly, the United States proposes the retention of the bracketed language in this provision.

(10) *Article 8 and Rule 8*. Comment and proposal: With regard to Article 8, Rule 8 and other provisions, on the issue of reconciling the use of the terms “form, format and means,” throughout the articles and rules, discussed in PT/DC/6, the United States has reviewed the recommendations in that document. The United States prefers the use of the terms “media,” “format” and “means of delivery,” respectively, and cannot, without further explanation by the IB, support the IB’s recommendation to merge the terms “form” and “format” into “form.” See attached chart for an elaboration on the use of the three terms and the basis for our recommendation.

(11) *Article 8 and Rule 8*. Comment and proposal: The rate at which electronic filing technology is evolving is so great, even greatly accelerating within the last year, that the 10-year period in Rule 8(1)(a) will be counter-productive. This 10-year period will also have a pronounced effect of discouraging the adoption of electronic filing throughout the world. It is not only the pace of electronic filing development that mandates a different solution in Rule 8(1)(a), it is also the nature of recently received patent applications that dictates a different solution. For example, the United States Patent and Trademark Office recently received a patent application that is 400,000 pages in length. We are absolutely incapable of handling and processing this patent application on paper. We do not have the luxury of being able to wait 10 years to mandate that such an application be filed electronically. We have similar concerns with the need to provide some of our applicants with enhanced publication mechanisms, in which amendments may be permitted up to a very late stage if submitted in an electronic, ready-to-publish, form; to accommodate the submission of genetic sequence information; to process other “jumbo” or “mega” applications; and to accommodate microfiche-only submissions for computer program listings. As Rule 8(1)(a) will, in general, discourage the adoption of electronic filing, it will also have the effect of precluding offices from accommodating the needs of these patent applicants which may be best served by the submission of certain communications in electronic form, alone, or accompanied by paper. To address these issues, the United States proposes the following:

(a) To the extent that some of the above issues are currently addressed in the PCT, the United States proposes that Article 8(1)(a) of the PLT be amended to make reference to PLT Article 6(1), which reference would thereby incorporate the relevant PCT provisions. Accordingly, the United States proposes that the phrase “, and subject to Article 6(1),” be added to Article 8(1)(a) after the reference to “Article 5(1).”

(b) In Rule 8(1)(a), the United States proposes that “10 years” be changed to “5 years.”

(c) To address the need to immediately accommodate certain types of applications, the United States proposes the following new paragraph for Rule 8(1):

“Rule 8(1)(c) Where the filing or processing of communications on paper is deemed not practicable, Contracting Parties may, notwithstanding paragraph (1)(a) and as prescribed in the Regulations, require the filing of communications in another [form] [medium] or by other means of [transmittal] [delivery] for those communications.”

(12) *Articles 11, 12 and 13.* Comment and proposals: In Articles 11(6), 12(5), and 13(5), the United States proposes the deletion of the term “intended.” The term “intended” implies that a Contracting Party would have to give an applicant a notification to show cause why a request should not be denied, rather than merely denying a request and giving an applicant an opportunity to request reconsideration of the denial.

(13) *Article 12 and Rule 13.* Comments and proposals: The United States supports a modification of Note 12.02 to include a statement that Contracting Parties are free to determine what constitutes a “loss of rights with respect to an application or patent.” It is important that Article 12 not apply to determinations relating to additional patent term. Accordingly, the United States also proposes the inclusion of a new exception in Rule 13(3) as follows:

“(viii) in a determination of additional patent term”

(14) *Articles 12 and 13.* Comment and proposal: The United States proposes a text for an Agreed Statement to clarify the “in spite of all due care” standard that may be applied in Articles 12 and 13. Contracting Parties should not be free to impose standards of “due care” that are so high that Article 12 and Article 13 relief becomes meaningless. For example, Contracting Parties should not be permitted to impose a “beyond the control of the applicant” standard. The draft Agreed Statement follows:

“For the purposes of Articles 12 and 13, it is understood that the “all due care required by the circumstances” standard does not require an applicant or owner to provide evidence demonstrating that the event giving rise to the failure to comply with the time limit or the failure to file the subsequent application within the priority period could not have been prevented under any circumstances, and shall not be considered to require proof of events entirely beyond the control of the applicant or owner. Instead, the standard only requires a showing by an applicant or owner that the failure occurred notwithstanding the exercise by that applicant or owner of a reasonable level of due care under the circumstances, such as reliance on trustworthy/dependable procedures and personnel.

(15) *Article 17(4)(b).* Comment and proposal: The United States proposes that the phrase “WIPO member States” be included in this provision. Otherwise, non-PLT

Contracting Parties would be excluded from consultations but international and national NGOs and IGOs would be included.

(16) *Article 19(4)*. Comment and Proposal: The United States proposes the amendment below that will clarify that States and IGOs must, obviously, satisfy the requirements of the referred to paragraphs in order to ratify or accede to this Treaty.

“(4) [*Ratification or Accession*] Any State or intergovernmental organization satisfying the requirements referred to in paragraphs (1) to (3) may deposit: [...]”

(17) *Article 20(2)*. Proposal: In items (ii), (iii) and (iv), delete the phrase “, or from any later date indicated in that instrument” in each occurrence.

(18) *Article 21(1)(a)*. Comment and proposal: In Article 21(1)(a), the United States proposes the insertion of “and related Regulations” after “Article 6(1) and (2)” for completeness and avoidance of doubt.

(19) *Article 21(1)(b)*. Comment and proposal: In Article 21(1)(b), the United States supports the retention of the bracketed provision and proposes the retention of that provision.

(20) *Article 24*. Comment and proposal: In Article 24, the United States proposes that additional language texts be established only “as designated by the Assembly.” This is consistent with Article 33 of the Geneva Act of the Hague. Further, the United States proposes that the note should include a statement as follows: “The official texts established in Article 24(2) are not equally authentic.”

(21) *Declarations Made by Contracting Parties*. A new Article addressing “Declarations Made by Contracting Parties” should be incorporated in the PLT, as the PLT allows Contracting Parties to make declarations. See, e.g., Article 22 of the PLT. See also Article 30 of the Geneva Act of the Hague Agreement for suggested language. Similarly, a corresponding Rule in the Regulations is necessary. See Rule 32 of the Geneva Act of the Hague Agreement.

(22) *Effective Date of Application*. Although Article 21 of the Treaty establishes the application of the Treaty to existing applications and patents, there is no provision with respect to applications and patents filed on or after the date on which this Treaty binds a Contracting Party under Article 20. Accordingly, a provision should be included in Article 21 to indicate that Contracting Parties must apply the provisions of this Treaty and the Regulations to all applications filed on or after the date on which this Treaty binds the Contracting Party under Article 20.

(23) *Rule 7*. Comment and proposal: With respect to Rule 7 - The United States supports the retention of paragraph (1) and items (i) and (ii) and proposes the retention of those bracketed provisions.

(24) *Rule 12(5)(a)(i)*. Comment and proposal: In Rule 12(5)(a), the United States opposes the inclusion of item (i). Contracting Parties should be required to provide either multiple two-month extensions of time or extensions for up to the maximum period permitted by law.

(25) *Rule 12(5)(a)(v)*. Comment and proposal: In Rule 12(5)(a), the United States supports the retention of item (v) and proposes that the bracketed language be retained. Alternatively, we could accept the requirement to provide such relief and mandate by rule those time limits for which relief would not be available, thereby removing those time limits from the umbrella of “time limits set by the Office.” The time limits affected include requests for oral hearings, requests for reconsideration and petitions for patent term adjustments.

(26) *Rule 12(5)(a)(vi)*. Comment only: In Rule 12(5)(a), the United States supports item (vi).

(27) *Rule 12(5)(a)(vii)*. Comment only: In Rule 12(5)(a), the United States does not support the retention of item (vii). Contracting Parties should be required to provide extensions of time as appropriate and revert processing of the application to normal processing.

(28) *Rule 13(3)(ii)*. Comment only: In Rule 13(3), the United States is strongly opposed to the retention of item (ii). Contracting Parties should be required to provide relief for the late payment of maintenance fees. Clearly, one of the greatest potential benefits of Article 12 will be lost if this exception is included.

(29) *Rule 13(3)(v) and (vi)*. Comment only: In Rule 13(3), the United States does not support the retention of items (v) and (vi). Contracting Parties should be required to provide Article 12 relief under these circumstances. The exclusion of these items in this provision is strongly desired by users.

(30) *Rule 13(3)(vii)*. Comment only: In Rule 13(3), the United States supports item (vii).

(31) *Rules 16(2)(a) and 17(2)(a)*. Comment only: In Rules 16(2)(a) and 17(2)(a), the United States does not support the inclusion of the bracketed provisions. In both instances, an underlying document is necessary regardless of who the requestor is.

(32) *Rule 18(1)*. Comment and proposal: In Rule 18(1), the United States agrees with the last sentence of Note 18.01 and proposes an explicit mention of the substance of that sentence in the chapeau to paragraph (1). It is important that the procedures for correcting mistakes not be available to patent applicants as an alternative to normal examining procedures.

“(1) [*Request*] (a) Where an application, a patent or any request communicated to the Office in respect of an application, not related to search or substantive examination, or a patent contains a mistake which is correctable under the applicable law, the Contracting Party shall accept that a request for correction of that mistake in the records and publications of the Office be made in a communication signed by the applicant or owner and containing the following indications: [...]”

[Annex follows]

ANNEX

DEFINITIONS OF FORM, FORMAT AND MEANS

Form: Medium upon which the message is written or resides (prefer- medium)

Format: Arrangement of the information on the medium

Means: Manner in which the form was delivered to the Office

FORM (<i>prefer Medium</i>)	FORMAT	MEANS (<i>prefer Means of Delivery</i>)
Paper	Data formats: character sets, font, color, size Display Format: Arrangement of Information Language: English, French Encoding: XML tags -ISAF	mail, hand, special carrier
Floppy disk, tapes, Zips	Data formats: ASCII, Unicode, character sets Display Format: determined by DTD Machine formats: HD Mac, HD IBM Software formats: XML, PDF, Word, WordPerfect Language: English, French Data Wrapping: PCS7, Dig. Signature, Encryption, PKI	mail, hand, special carrier
CD CD-ROM CD-RW CD-R	Data: ASCII, Unicode, character sets Display Format: determined by DTD Machine format: ISO 9660 Software: XML, PDF, Word, WordPerfect Language: English, French Data Wrapping: PCS7, Dig. Signature, Encryption, PKI	mail, hand, special carrier

FORM (*prefer Medium*)

FORMAT

MEANS (*prefer Means of Delivery*)

Electronic
(really RAM, wire, buffer etc.)

Data: ASCII, Unicode, character sets
Display Format: determined by DTD
Machine Formats: depends on storage, transmission
Software: XML, PDF, Word, WordPerfect
Language: English, French
Data Wrapping: PCS7, Dig. Signature, Encryption, PKI

wire signal, radio signal

[End of Annex and of document]