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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Twentieth Session (12th Extraordinary)*
Geneva, September 20 to 29, 1992

AMENDMENT TO RULE 91
OF THE REGULATIONS UNDER THE PCT

Proposal by the United Kingdom

1. The Annex to the present document contains a proposal for amendment of Rule 91 of the Regulations under the Patent Cooperation Treaty (PCT), submitted by the United Kingdom.

2. It is proposed that the amended Rule 91, if adopted by the Assembly, enter into force on January 1, 1993.

3. *The Assembly is invited*

(i) to adopt the amendments to Rule 91 of the Regulations under the PCT which are proposed in the Annex to the present document, and

(ii) to decide that those amendments will enter into force on January 1, 1993.

[Annex follows]

* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

ANNEX

The
**Patent
Office**

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Date : 2 July 1992

Dear Director-General

RE: RULE 91 PATENT COOPERATION TREATY

As reported at paragraph 64 of the Report of the Eighteenth Session of the Assembly of the International Patent Cooperation Union (PCT Union) held in Geneva on 8 to 12 July 1991, the amendments to Rule 91.1(b) proposed in documents PCT/A/XVIII/2 and 6 Rev ("document 2" and "document 6 Rev") were very much welcomed by all representatives of the non-governmental organisations and met with favour from several delegations, because they would make the PCT safer for applicants.

However, in view of the hesitation expressed by other delegations, particularly as document 6 Rev had not been distributed until the beginning of the Assembly, the proposals in documents 2 and 6 Rev were not adopted.

Accordingly, rectification of an obvious error under Rule 91.1 is still only possible if, in accordance with paragraph (b), the rectification itself is obvious in the sense that anyone would realise that nothing else could have been intended than what is offered as rectification.

Experience in the United Kingdom has been, and continues to be, that this requirement bears unduly harshly on applicants who have made an obvious error in the request or demand. This is because, in nearly all cases, it is not possible to say with the appropriate degree of certainty, on the basis of the limited papers able to be taken into account, that nothing else could have been intended than what is offered as rectification. Accordingly, the competent authority has no option but to refuse the rectification. As a result, the applicant either loses the application for all States or the designation for one or more States, or is obliged to enter the national phase without the benefits of an international preliminary examination. Not surprisingly, applicants and their attorneys who have previously made an obvious error and been refused rectification are hesitant to use the PCT again.

The Patent Office

Against this background, the United Kingdom - along with the representatives of the users of the PCT system - welcomed the proposal by the International Bureau in document 2 for a new provision, included as Rule 91.1(b)(ii), which would permit receiving offices, international authorities and the International Bureau to take account of a priority document or other paper relating to the international application filed by the applicant with the receiving Office before or on the international filing date.


However, in many cases the papers which would establish that what is offered as rectification is what was intended (eg the applicant's instructions to his attorney) will not have been filed by the applicant with the receiving Office before or on the international filing date even though they were in existence at that time.

In order to permit the competent authority to take such papers into consideration, the United Kingdom proposed in paper 6 Rev that a further provision should be added to allow, in the case of rectification of an error in the request or the demand, a comparison of that request or demand with any paper relating to the international application existing at the time of making the request or demand, including any such paper filed in evidence in support of the rectification subsequent to the making of the request or demand. As noted above this proposal received a broad measure of support at the Assembly.

In the view of the United Kingdom, amendment of Rule 91 along the lines of the proposals in documents 2 and 6 Rev is still desirable to make the PCT safer for applicants while taking account of the hesitations of delegations. A particular concern was that the texts proposed in those documents could be interpreted as requiring the competent authority always to authorise a rectification on the basis of later filed evidence. In order to meet this concern, the United Kingdom would propose that it should be stated expressly in Rule 91 that the rectification should only be regarded as obvious if the authority is satisfied from a comparison with the priority application or other paper that what is offered as rectification is what was intended.

In accordance with the above, the United Kingdom wishes to propose to the next meeting of the Assembly a new Rule 91.1(b-bis), with consequential amendment of Rule 91.1(c), as set out in the accompanying Annex.

Yours faithfully



B G HARDEN
Superintending Examiner
Legal Division (Patents and Designs Branch)

PROPOSAL BY THE UNITED KINGDOM

Rule 91

Obvious Errors in Documents

91.1 Rectification

(a) [No change]

(b) [No change]

(b-bis) The requirements of paragraph (b) shall be considered to be complied with if the authority competent under paragraph (e) is satisfied that what is offered as rectification is what was intended and that the rectification

(i) in the case of a rectification of any part of the international application including the request, is obvious from a comparison with an earlier application, the priority of which is claimed in the international application, or with any other paper relating to the international application, provided that such other paper was filed with the receiving Office before or on the international filing date; or

(ii) in the case of a rectification of the request or the demand, is obvious from a comparison with any paper relating to the international application existing at the time of filing the request or the demand, respectively, including any such paper subsequently filed in evidence in support of the rectification.

(c) Except where paragraph (b-bis) applies, omissions of entire elements or sheets of the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.

(d) to (g-quater) [No change]