

WIPO



PCT/R/WG/6/10

ORIGINAL: English

DATE: April 15, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Sixth Session
Geneva, May 3 to 7, 2004

SINGLE REQUEST FOR THE RECORDING OF
CHANGES DURING THE NATIONAL PHASE

Document prepared by the International Bureau

BACKGROUND

1. At its fifth session, the Working Group agreed that the International Bureau should study the possibility of providing for a request, to be made in a single document submitted to the International Bureau, to record certain changes concerning the applicant, inventor, licensees or security interests in respect of two or more designated or elected Offices in which the international application had entered the national phase, similar to the procedure under Article 14(1)(b) and Rules 15, 16 and 17 of the Patent Law Treaty (PLT) (see the summary by the Chair of the fifth session of the Working Group, document PCT/R/WG/5/13, paragraph 105).¹

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

2. This document considers proposals for setting up a system, under the PCT, which would facilitate, for both applicants and Offices, the recording of certain changes in respect of an international application which has entered the national phase before several designated or elected Offices, or of a patent granted on the basis of such an international application.

DISADVANTAGES OF THE CURRENT SYSTEM

3. In general, the recording of changes in the area of patents, for example, a change in ownership or a change in name of an owner, is currently made independently by each national or regional Office before which a patent application is filed or which has granted a patent, or in which a regional patent has effect. The only exception to this general rule concerns international applications during the international phase of processing, during which the International Bureau centrally records certain changes (in the person, name, residence, nationality or address of the applicant, and in the person, name or address of the agent, common representative or inventor) with effect for all designated and elected Offices (see Rule 92*bis*).

4. Recording of certain matters is mandatory in some States to ensure effects vis-à-vis third parties. In other States, the recording is made for information purposes only; in yet others, no such recording is provided for. Where recording is possible or even required, the request for recording generally must comply with a number of formal requirements. These requirements differ from State to State; with regard to harmonization of formal requirements under the PLT, see paragraphs 5 and 6, below. They often mandate, in the case of a change in ownership, an attestation or notarization of signatures by a notary public or legalization by a consulate. Some States also require a verified translation of the documents.

HARMONIZATION OF FORMAL REQUIREMENTS UNDER THE PATENT LAW TREATY

5. The Patent Law Treaty (PLT), concluded in 2000 and yet to enter into force, provides for a certain degree of harmonization between PLT Contracting States with regard to the formal requirements related to the filing of requests for the recording of certain changes relating to patents or patent applications. PLT Article 14(1)(b) and PLT Rules 15, 16 and 17 specify the formal requirements which a PLT Contracting Party is permitted to apply in respect of requests for the recordation:

(i) of a change in the name or address of an applicant for a patent or an owner of a patent, of any change in the name or address of the applicant's or owner's representative, and of any change relating to the address for correspondence or address for legal service (PLT Rule 15);

(ii) of a change in the person of an applicant for a patent or in the person of an owner of a patent (PLT Rule 16); and

(iii) of a license in respect of an application for a patent or a patent, of a security interest in respect of an application for a patent or a patent, and the cancellation of the recordation of a license or a security interest in respect of an application for a patent or a patent (PLT Rule 17).

6. Pursuant to PLT Article 3, PLT Article 14(1)(b) and PLT Rules 15, 16 and 17 apply to national and regional applications for patents, as well as international applications on or after

the date on which national processing or examination of an international application may start under PCT Article 24 or 40, that is, after that application has entered the national phase before the designated or elected Office concerned.

SHORTCOMINGS OF THE CURRENT SYSTEM, DESPITE HARMONIZATION OF FORMAL REQUIREMENTS UNDER THE PLT

7. The fact that the PLT provides for a maximum list of formal requirements which national and regional Offices are permitted to apply will, once the PLT has entered into force, facilitate the life of applicants and Offices, reduce costs, and streamline and simplify procedures related to the recording, in PLT Contracting States, of the kind of changes outlined above (hereinafter referred to as “changes”). However, despite the achieved harmonization of formal requirements, in the absence of at least a central system for the filing of requests for such changes, the disadvantages of the current system as outlined in paragraphs 3 and 4, above, remain. In particular, it remains the case that, where a change (say, in the address of an applicant) concerns several national or regional applications, or several granted patents, the applicant will have to perform the same administrative task several times over, before each national or regional Office concerned.

8. As far as the PCT is concerned, while Rule 92*bis* provides, as indicated above, for the central recording, with the International Bureau, of certain changes during the international phase, with effect for all designated and elected Offices, there is no such central recording of changes with regard to international applications which have entered the national phase before several designated or elected Offices. Again, the applicant will have to perform the same administrative task several times over, before each designated or elected Office concerned.

9. It would thus appear to be in the interest of applicants and owners, licensees and licensors, as well as third parties, if, at least in the context of the PCT with regard to international applications, in line with the objectives of the PCT as set out in the Preamble to the Treaty, a system could be set up which, based on the principles embodied in the PLT, would facilitate, for both applicants and Offices, the recording of certain changes in respect of an international application which has entered the national phase before several designated or elected Offices, or of a patent granted on the basis of such an international application. Possible features of such a system are discussed in the following paragraphs.

INTERNATIONAL REQUEST FOR THE RECORDING OF CERTAIN CHANGES DURING THE INTERNATIONAL PHASE AND THE NATIONAL PHASE OF PROCESSING

International Phase

10. As at present, for as long as the international application is in the *international* phase of processing (in other words, prior to the expiration of the time limit under Article 22(1) (Chapter I) or Article 39(1)(a) (Chapter II), that is, 30 months from the priority date), the International Bureau would centrally record certain changes (in the person, name, residence, nationality or address of the applicant, and in the person, name or address of the agent, common representative or inventor) with effect for all designated and elected Offices (see present Rule 92*bis*). Rule 92*bis* would be aligned to the corresponding PLT provisions (PLT Article 14(1)(b) and PLT Rules 15 and 16) with regard to the formal requirements to be complied with.

11. As at present, the International Bureau would make any changes recorded by it during the international phase available to the general public, be it in the form of access to the (paper) file held by the International Bureau (as at present) or, eventually, in electronic form, as part of an online PCT public file inspection service. The establishment of such an online PCT public file inspection service, designed to provide access to the file and up-to-date status information on international applications during both the international and the national phase, is currently being studied by the International Bureau, as part of its ongoing efforts to move from paper files and paper-based procedures to electronic dossiers and electronic processing of data.

National Phase

12. In addition to the opportunity to file a request for the recording of certain changes during the international phase (see above), the PCT Regulations would be amended so as to allow the applicant to centrally file, with the International Bureau, a request for the recording of certain changes in respect of an international application which has entered the *national* phase before one or more designated or elected Offices, or in respect of patents based on such international applications. Such a request could be made instead of filing multiple requests directly with the designated or elected Offices concerned, and could be made using an international form made available in both English and French, or in a bilingual English/French version (see present Rule 92.2(d) and (e)), preferably in electronic form.

13. An international request for the recording of certain changes could be made with respect to any designated and elected Office (subject to the usual transitional reservation provision). No designated or elected Office would be required or expected to stop receiving requests for the recording of changes concerning international applications which have entered the national phase before the Office concerned; the system of filing an international request for the recording of changes would exist in addition to, and in no way replace, the possibility for filing multiple national requests directly with the designated or elected Offices concerned.

14. So as to avoid adding further complexity and to enable a relatively quick establishment of the new system for the recording of changes, it is proposed to limit the possibility of filing an international request for the recording of changes in relation to international applications which have entered the *national* phase, at least at the outset, to those changes in respect of which, under the PLT, no further documentation, evidence, certifications or translations may be required by the Office which is requested to record the change—that is, to changes in the *name or address* of the applicant or owner of a patent, the agent or the inventor, and to changes relating to the address for correspondence (see PLT Rule 15).

15. It would thus not be possible under the new system (or at least not at the outset) to file a request for the recording of changes in respect of which the Office requested to record the change could, under the PLT, require further documentation, evidence, certifications or translations to be furnished to it—that is, any requests for the recording of a change in the *person* of an applicant for a patent or in the person of an owner of a patent (see PLT Rule 16), or any requests for the recording of a license in respect of an application for a patent or a patent, of a security interest in respect of an application for a patent or a patent, and the cancellation of the recordation of a license or a security interest in respect of an application for a patent or a patent (see PLT Rule 17). The possibility of filing such requests could, however, be added to the system at a later stage, provided agreement can be reached on the remaining optional requirements permitted under PLT Rules 16 and 17 (relating to

certifications, furnishing of further documentation and translations) and thus on a uniform set of requirements which would be acceptable to all designated or elected Offices.

16. The International Bureau would check any international request for compliance with the formal requirements under the PCT (which would be identical to those under the PLT) and decide, with effect for all designated or elected Offices concerned, whether those requirements were met. The applicant or owner would be required to furnish further evidence only where the International Bureau may reasonably doubt the veracity of an indication contained in the request (see PLT Rule 15.4).

17. If all requirements were complied with, the International Bureau would notify each designated or elected Office concerned accordingly, preferably in electronic form. Any such Office would then be required to record the change in its national register, unless the Office may reasonably doubt that a requirement applied by the International Bureau under the PCT Regulations was complied with. In turn, each designated or elected Office would notify the International Bureau of the fact that the change had been recorded in its national registry (see paragraph 20, below).

18. The international request would have to be accompanied by the payment of a fee, which could consist either of a fee whose amount would be determined by the total amount of the national fees (if any) payable to each of the designated or elected Offices concerned and an additional amount for the benefit of the International Bureau, or of a flat international fee for the benefit of all designated or elected Offices concerned and the International Bureau. Any fees paid for the benefit of designated or elected Offices would be transferred by the International Bureau to the Offices concerned.

19. In order to facilitate the processing of international requests for the recording of changes, the International Bureau proposes to further study the possibility of introducing unique identifier numbers for applicants, enabling the International Bureau and all designated or elected Offices to quickly and accurately identify the applications or patents affected by a change, in particular in cases where a request for the recording of a change relates to multiple applications or patents by the same owner.

20. As in the case of changes recorded by the International Bureau during the international phase (see paragraph 11, above), the International Bureau would make any changes recorded by the designated or elected Offices under the new system available to the general public, based on the notifications received from the Offices, once the change has been recorded (see paragraph 16, above), be it in the form of access to the (paper) file held by the International Bureau or, eventually, in electronic form, as part of an online PCT public file inspection service.

Advantages

21. Clearly, such a system of centralized filing of international requests for the recording of certain changes in respect of international applications which have entered the national phase before several designated or elected Offices, building on the achievements of the PLT, would be in line with the objectives and the spirit of the PCT. It would allow applicants and patent owners to deal with one office, with one set of requirements, to make only one fee payment, and to file one request (or a limited number of requests) for the recording of changes in respect of all affected international applications filed by the same applicant, or patents owned by the same owner. Such a system would reduce administrative work for applicants and

patent owners, minimize the difficulties of working in various languages and of meeting different legal requirements, and reduce overall fees.

22. Any designated or elected Office could, for the recording of changes, rely on the checks carried out by the International Bureau, and would thus be relieved of at least a certain amount of work in relation to the recording of changes in international applications that have entered the national phase, or in patents based on such international applications.

How to Establish Such System

23. A system of centralized filing of international requests for the recording of certain changes as outlined above could be implemented by way of amendment of the PCT Regulations and modification of the PCT Administrative Instructions and thus could become operational relatively quickly. It is expected that the International Bureau could absorb the additional work related to the processing of requests for the recording of changes without the need for additional resources.

24. The Working Group is invited to consider the proposals contained in this document.

[End of document]