

Patent Cooperation Treaty (PCT) Working Group

**Fifth Session
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CHANGES TO THE PCT REGULATIONS NECESSITATED BY THE AMERICA INVENTS ACT

Document submitted by the United States of America

1. On September 16, 2011, the United States enacted changes to its patent laws. These changes, known as the America Invents Act (AIA), constitute the most significant reform of the United States Patent Act since 1952. The AIA provides applicants greater certainty about their patent rights, while giving the USPTO, and our examining corps the resources needed to operate efficiently and to issue high-quality patents quickly. The law also cuts costs for small and medium-sized enterprises and establishes a new in-house review process for challenging patents that is faster and significantly cheaper than costly and prolonged litigation that stymies technological growth. By resolving disputes about patent rights earlier, more efficiently, and at less cost, the USPTO will be able to add greater certainty to the U.S. patent system. The new law also harmonizes aspects of the American patent process with the rest of the world to make it more efficient and predictable.
2. The AIA changes, among other things, the requirements regarding who is entitled to be the applicant in U.S. national applications, and this change will impact PCT filings. Currently, for the purposes of the designation of the United States, the inventors must be named as applicants. This generally results in the naming of one set of applicants for the purposes of the United States and a different applicant(s) for all other designations. This can create difficulties when it is necessary to take an action in the application that requires the signature of all the applicants (e.g., withdrawals) in that it is sometimes difficult to obtain all the signatures in a timely manner.

3. Under the provisions of the AIA, the United States will no longer require the inventors to be the applicants for the purposes of the designation of the U.S., thus alleviating many of the difficulties currently encountered as a result of this requirement. However, even though the United States will now accept international applications which have been filed by another party of interest (e.g., an assignee), U.S. law still requires the inventors to be involved in the U.S. national stage process through the continued requirement that a U.S. inventor's oath or declaration be submitted, as is currently provided for in PCT Rules 4.17(iv) and 51bis.1(iv).

4. Therefore, certain technical corrections to the PCT Rules are required in order to maintain this requirement while relaxing the overall filing requirements concerning applicants for the purposes of the United States. Specifically, amendments are required to PCT Rules 4.15, 51bis.1, 51bis.2, 53.8, and 90bis.5, which are set forth in the Annex to this document.

5. *The Working Group is invited to consider the proposed amendments to the Regulations contained in the Annex to this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 4

The Request (Contents)

4.1 to 4.14 [No change]

4.15 *Signature*

(a) The ~~Subject to paragraph (b), the~~ request shall be signed by the applicant or, if there is more than one applicant, by all of them.

~~(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.~~

4.16 to 4.19 [No change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iii) [no change]

(iv) where the international application designates a State whose national law requires, on [date of the Assembly decision to amend this Rule] the furnishing of an oath or declaration of inventorship ~~that national applications be filed by the inventor~~, any document containing an oath or declaration of inventorship,

(v) to (vii) [no change]

(b) to (f) [No change]

51bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required

(a) ~~Where the applicable national law does not require that national applications be filed by the inventor, the~~ The designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is contained in the request or is submitted directly to the designated Office;

[Rule 51bis.2(a), continued]

(ii) [no change] relating to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rule 51bis.1(a)(ii)), if a declaration as to that matter, in accordance with Rule 4.17(ii), is contained in the request or is submitted directly to the designated Office;

(iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;

(iv) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.

~~(b) Where the applicable national law requires that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:~~

~~(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv))), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request;~~

~~(ii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;~~

[Rule 51bis.2(b), continued]

~~(iii) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.~~

~~(c) If, on March 17, 2000, paragraph (a) is not compatible, in relation to any item of that paragraph, with the national law applied by the designated Office, paragraph (a) shall not apply in respect of that Office in relation to that item for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.~~

[COMMENT: The deletion of Rule 51bis.2(c) is not related to the changes necessitated by the America Invents Act. Rather, it is due to the fact that there are no longer any Offices which have a notice of incompatibility under this provision.]

51bis.3 [No change]

Rule 53

The Demand

53.1 to 53.7 [No change]

53.8 *Signature*

~~(a) Subject to paragraph (b), the The demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.~~

~~(b) Where two or more applicants file a demand which elects a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the demand or could not be found or reached after diligent effort, the demand need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and~~

~~(i) a statement is furnished explaining, to the satisfaction of the International Preliminary Examining Authority, the lack of signature of the applicant concerned, or~~

~~(ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with.~~

53.9 [No change]

Rule 90bis
Withdrawals

90bis.1 to 90bis.4 No change]

90bis.5 *Signature*

~~(a)~~ Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, ~~subject to paragraph (b),~~ be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, subject to paragraph (b), not be entitled to sign such a notice on behalf of the other applicants.

~~(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant ("the applicant concerned") if it is signed by at least one applicant and~~

~~(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau, the Authority carrying out the supplementary international search or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or~~

~~(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d), 90bis.3(c) or 90bis.3bis(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or~~

~~(iii) in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with.~~

90*bis*.6 and 90*bis*.7 [No change]

[End of Annex and of document]