

Patent Cooperation Treaty (PCT) Working Group

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MISCELLANEOUS PROPOSED AMENDMENTS TO THE PCT REGULATIONS

Document prepared by the International Bureau

SUMMARY

1. The present document proposes amendments to the PCT Regulations in three areas:
 - (a) Following formal consultations with all Member States and consequential on the agreement in principle to decommission the PCT-EASY software with effect from July 1, 2015, it is proposed to remove the fee reduction available to PCT-EASY filings from the Schedule of Fees.
 - (b) It is proposed to require applicants making an express request for early national phase entry to file any request for the restoration of the priority of right at the designated or elected Office within one month from the date of receipt of the express request for early national phase entry.
 - (c) It is proposed to amend Rule 90.3 by deleting the reference to paragraph (a) of Rule 90*bis*.5, consequential on the amendment of Rule 90*bis*.5 adopted by the PCT Assembly in October 2012.

DECOMMISSIONING OF PCT-EASY

BACKGROUND

2. The PCT-EASY service was introduced in 1998 "as a first step towards a future filing system which will enable applicants to create and file patent applications electronically" (PCT Gazette 8/1998). The service allowed a diskette (or now CD-R) containing bibliographic data to be provided alongside a printout of the request form and an application body in paper form at a time when it was not yet possible to submit the request form and application body in fully electronic form. A fee reduction was also accorded to PCT-EASY filings as an incentive to provide the International Bureau with the bibliographic data in electronic form.

3. The service was quickly very popular and by 2003 was used for 45 per cent of all international applications. However, that year fully electronic applications became possible at several receiving Offices and the use of PCT-EASY began to decline. The service is now used for less than 2.5 per cent of international applications. By comparison, nearly 90 per cent of international applications are filed in fully electronic format. Moreover, the International Bureau is now able to offer a hosted ePCT e-filing service for any receiving Office which wishes to provide electronic filing to its applicants but is unable or does not wish to maintain the necessary costly IT infrastructure itself.

4. Consequently, by way of Circular C. PCT 1376, dated April 5, 2013, the International Bureau consulted receiving Offices and non-governmental organizations representing users of the PCT system on the decommissioning of PCT-EASY. The Circular proposed that PCT-EASY should cease to be a recognized mode for filing international applications under the PCT as of July 1, 2015. The responses received by the International Bureau in reply to Circular C. PCT 1376 indicated agreement in principle to the proposed decommissioning of PCT-EASY as of July 1, 2015. Member States were subsequently informed, by way of Circular C. PCT 1408, dated March 13, 2014, that the International Bureau would take the necessary steps towards implementing the agreement in principle to decommission PCT-EASY as of that date.

PROPOSAL

5. It is thus proposed to remove the relevant fee reduction for PCT-EASY filings from the Schedule of Fees under the PCT Regulations with effect from July 1, 2015 and to amend the Schedule of Fees accordingly, as set out in the Annex to the present document. It is further proposed that these amendments to the PCT Schedule of Fees should enter into force on July 1, 2015, and should apply to all international applications filed on or after that date.

6. The International Bureau will consult by way of PCT Circulars on consequential modifications required to the PCT Administrative Instructions and the Receiving Office Guidelines, following adoption of these proposed amendments. While the PCT-EASY functionality will thus formally be removed from the PCT-SAFE e-filing software as of July 1, 2015, it is to be noted that Offices may, of course, choose to cease to accept filings for international applications using PCT-EASY at any time prior to the official decommissioning date. If PCT-EASY diskettes are received after that date (created by versions of PCT-SAFE prior to the change), the international application will still be accepted and the diskette may be forwarded to the International Bureau, but the international application will be treated as a paper filing and no filing fee discount will be given.

RESTORATION OF RIGHT OF PRIORITY BY DESIGNATED OFFICES AFTER EARLY NATIONAL PHASE ENTRY

BACKGROUND

7. Since April 1, 2007, it has been possible for applicants to request restoration of the right of priority where an international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date.

This is consistent with the provisions for restoration of the priority of right under the Patent Law Treaty. A request for the restoration of the right of priority can be made to the receiving Office (Rule 26*bis*.3) or a designated/elected Office (Rules 49*ter*.2 and 76.5).

8. The time limit specified under Rule 49*ter*.2(b)(i) for filing a request for the restoration of the right of priority at a designated Office was set at one month from the applicable time limit for national phase entry under Article 22, since it was considered reasonable to give the applicant at least one month from the applicable time limit for national phase entry to request restoration before the designated Office (see page 15 of Annex I to document PCT/R/WG/5/7).

9. However, in the case of early entry into the national phase, the time limit set in Rule 49*ter*.2(b)(i) to file a request for the restoration of the right of priority at a designated Office could be several months after national phase processing has started. Example: the applicable time limit under Article 22 for national phase entry before Office X is 30 months from the priority date; an applicant enters the national phase before that Office early, say, at 21 months, and requests the start of national phase processing before that Office; under present Rule 49*ter*.2(b)(i), the time limit for requesting the restoration of the right of priority before Office X only expires at 31 months from the priority date, that is, eight months after national phase processing by that Office has started. It is therefore possible for a designated or elected Office to receive a request for restoration at a very late stage in the national phase processing. Yet, there appears to be no reason, where an express request for early national phase entry is made, for an applicant not to be able to file the request for restoration at the beginning of national phase processing.

PROPOSAL

10. It is therefore proposed to amend Rule 49*ter*.2(b)(i) as set out in the Annex to the present document to require that, where an express request for early national phase entry at a designated Office is made under Article 23(2), any request for the restoration of the right of priority has to be filed within one month from the date on which the express request is received by the designated Office (though designated Offices would remain free to offer longer periods if desired). It is also proposed to amend Rule 76.5 as set out in the Annex so that this requirement would also apply to early national phase entry before an elected Office after an express request is made under Article 40(2). It is further proposed that these amendments should apply to any express request under Article 23(2) or Article 40(2) received on or after July 1, 2015.

CONSEQUENTIAL AMENDMENT TO RULE 90.3

BACKGROUND

11. The PCT Assembly, at its forty-third session in October 2012, adopted a set of amendments to the Regulations to simplify procedures for applicants, consequential on the enactment of the America Invents Act (see document PCT/A/43/4 and paragraphs 28 to 33 of document PCT/A/43/7).

12. One of these amendments related to removing the special procedure that applied where it was not possible to obtain the signature of an inventor who had been named as an applicant only for the purpose of the designation of the United States of America. *Inter alia*, with regard to withdrawals under Rule 90*bis*, paragraph (b) was deleted from Rule 90*bis*.5 and the paragraph numbering was removed from paragraph (a). However, at the time, the need for a consequential amendment to Rule 90.3 (deleting the reference to paragraph (a) of Rule 90*bis*.5) was overlooked.

PROPOSAL

13. It is thus proposed to amend Rule 90.3 by deleting the reference to paragraph (a) of Rule 90*bis*.5, as set out in the Annex to the present document, to enter into force on July 1, 2015.

14. *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. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 49ter

Effect of Restoration of Right of Priority by Receiving Office;

Restoration of Right of Priority by Designated Office

49ter.1 [No change]

49ter.2 *Restoration of Right of Priority by Designated Office*

(a) [No change] Where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period:

- (i) occurred in spite of due care required by the circumstances having been taken; or
- (ii) was unintentional.

Each designated Office shall apply at least one of those criteria and may apply both of them.

(b) A request under paragraph (a) shall:

(i) be filed with the designated Office within a time limit of one month from the applicable time limit under Article 22 or, where the applicant makes an express request to the designated Office under Article 23(2), within a time limit of one month from the date of receipt of that request by the designated Office;

(ii) and (iii) [No change]

(c) to (h) [No change]

Rule 76

Translation of Priority Document;

Application of Certain Rules to Procedures before Elected Offices

76.1 to 76.4 [No change]

76.5 *Application of Certain Rules to Procedures before Elected Offices*

Rules 13~~ter~~.3, 20.8(c), 22.1(g), 47.1, 49, 49~~ter~~ and 51~~ter~~ shall apply, provided that:

- (i) [No change];
- (ii) any reference in the said Rules to Article 22, [Article 23\(2\)](#) or Article 24(2) shall be construed as a reference to Article 39(1), [Article 40\(2\)](#) or Article 39(3), respectively;
- (iii) to (v) [No change]

Rule 90

Agents and Common Representatives

90.1 and 90.2 *[No Change]*

90.3 *Effects of Acts by or in Relation to Agents and Common Representatives*

(a) and (b) *[No change]*

(c) Subject to Rule 90*bis*.5~~(a)~~, second sentence, any act by or in relation to a common representative or his agent shall have the effect of an act by or in relation to all the applicants.

90.4 to 90.6 *[No Change]*

SCHEDULE OF FEES

Fees

- | Fees | Amounts |
|---|--------------------|
| 1. International filing fee:
(Rule 15.2) | <i>[No change]</i> |
| 2. Supplementary search handling fee:
(Rule 45bis.2) | <i>[No change]</i> |
| 3. Handling fee:
(Rule 57.2) | <i>[No change]</i> |

Reductions

4. The international filing fee is reduced by the following amount if the international application is, as provided for in the Administrative Instructions, filed:

~~(a) on paper together with a copy in electronic form, in character coded format, of the request and the abstract:~~ ~~—100 Swiss francs~~

~~(b)~~(a) in electronic form, the request not being in character coded format: *[No change]*

~~(c)~~(b) in electronic form, the request being in character coded format: *[No change]*

~~(d)~~(c) in electronic form, the request, description, claims and abstract being in character coded format: *[No change]*

5. *[No change]*

[End of Annex and of document]