

November 2006

## Basic Features to the Patent Law Treaty (PLT)

*Document prepared by the Secretariat*

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## INTRODUCTION

1. This document serves as an introduction to the basic features of the Patent Law Treaty (PLT), which was adopted at the Diplomatic Conference for the Adoption of the Patent Law Treaty on June 1, 2000<sup>1</sup>. The PLT entered into force on April 28, 2005, that is, three months after ten States have deposited their instruments of ratification or accession with the Director General of WIPO.

2. The PLT is designed to streamline and harmonize formal requirements set by national and regional patent Offices for the filing and processing of national and regional patent applications, the maintenance of patents and certain additional requirements related to patents or patent applications (for example, the requirements concerning electronic filing, representatives and recordation with the patent Office).

3. Except for Article 5 (filing date requirements), the PLT regulates the maximum set of requirements that an Office of a Contracting Party may apply: the Office may not require any other formal requirements in respect of the matters dealt with by this Treaty. In other words, this Treaty does not establish a completely uniform procedure for all Contracting Parties, but a Contracting Party is free to require fewer, or more user-friendly, requirements than those prescribed in the Treaty. Therefore, applicants and owners are assured that, for example, an application that complies with the maximum set of requirements under this Treaty will comply with the formal requirements applied by any Contracting Party. In this sense, the phrase “deregulation of the national and regional patent laws concerning formality requirements” may well explain the emphasis of the PLT.

4. In order to identify features and advantages of the Treaty, six modules are provided in this document. Rather than explaining the Treaty Article by Article, each module is distinguished by an “objective” that the Treaty is trying to achieve, and explains how that objective is accomplished. References to Articles and Rules are those under the PLT and its Regulations, unless otherwise specified. As this document is prepared for the purpose of information, where a conflict exists between the explanations in this document and the provisions of the Treaty and the Regulations, the latter shall prevail. In addition, explanations concerning the final and administrative clauses of the Treaty are omitted from this document. It is therefore recommended that this document should be read in conjunction with the text of the Treaty and the Regulations for a complete and accurate understanding of the PLT.

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<sup>1</sup> The entire text of the PLT, the Regulations under the PLT and the Agreed Statements are contained in WIPO publication No. 258. Further, those texts as well as a list of Contracting Parties to the PLT can be found on the WIPO web site at: <http://www.wipo.int/treaties/en/ip/plt/index.html>.

## Module 1: Filing Date Requirements

*The PLT sets up requirements for obtaining a filing date and procedures to avoid a loss of the filing date because of a failure to comply with other formality requirements.*

5. The filing date plays a key role in determining prior art and patentability of the invention. It is also relevant to deciding who has a priority to obtain a patent in each country. Where an applicant wishes to file patent applications for the same invention in foreign countries, the filing date of the first application is significantly important. For example, in accordance with Article 4 of the Paris Convention, where an applicant files a regular application in one of the member countries and, within 12 months from the filing date of the first application, files an application for the same invention in the other member countries, the later applications will be regarded as if they had been filed on the same day as the earliest application (the right of priority). Further, according to Article 33 of the TRIPS Agreement, the minimum term of patent protection is calculated from the filing date. In this respect, it is particularly important to harmonize the determination of the filing date in the international level.

6. Under Article 5, the PLT requires that the Office of any Contracting Party shall accord a filing date to an application on the basis of three simple elements. First, an indication that the elements received on a specific date are intended to be an application for a patent for an invention shall be provided (Article 5(1)(a)(i)). Second, the Office must be provided with indications which identify the applicant, and/or allow the applicant to be contacted (Article 5(1)(a)(ii) and (1)(c)). Third, the Office must have received a part which on the face of it appears to be a description (Article 5(1)(a)(iii)). No additional elements can be required for a filing date to be accorded, although the Office may accept evidence allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office, as the second element referred to above.

7. In particular, a Contracting Party cannot require one or more claims as a filing date requirement. Instead, if an application as filed does not contain one or more claims, a Contracting Party must accord a filing date, and may require that these be subsequently furnished (Article 6(1)). The failure to furnish such claims within a certain time limit would not result in the subsequent loss of the filing date, although the application may be refused (Article 6(8)(a)). Similar considerations apply in respect of any filing fee that may be payable. The simple filing date requirement would be particularly helpful for an applicant in the case of establishing a filing date of a first filing on which a priority claim is based.

8. Similarly, for the purpose of obtaining a filing date, an applicant could file a description in any language (Article 5(2)(b)), or replace the description and/or drawings by a reference to another application (Article 5(7)). Although the applicant would need to file a translation, or copy, of the description within a period of not less than two months (Article 6(3) and (7) and Rule 6(1)), the right to file an application in an original language for the purpose of obtaining a filing date would be of particular benefit where applications are filed in foreign countries.

9. In view of the continuing developments of information technology, it is probable that more and more countries will introduce an electronic filing system for filing patent applications in the future. Without impeding the development of technology, however, a

balance must be found so that an applicant who does not have access to the requisite technology is not prevented from filing a patent application. Therefore, the Treaty obliges the Office to accept, for the purposes of establishing a filing date, the filing of applications on paper even if, in the future, the Office only accepts electronic filing (Article 5(1)(a)). In such a case, the Office may subsequently require that the application be filed by means of filing permitted by the Office in the accepted form and format, for example, by electronic filing in a specific form and format (Article 8(1) and Rule 8(2)). However, failure to furnish an application by a permitted means within a certain time limit would not result in the subsequent loss of the filing date, although the application may be refused (Article 8(8)). A detailed explanation concerning paper and electronic filing is found in Module 6.

10. The PLT also provides the rules to establish a filing date where a part of the description or drawing is missing from the initially filed application. In principle, a filing date shall be accorded on the date on which the missing part of the description or drawing is subsequently filed, within a certain period (Article 5(6)(a)). This period is not less than two months from the date of notification by the Office of the fact that a part of the description or drawing is missing, or, where there is no such notification, not less than two months from the date on which the application is initially submitted to the Office (Rule 2(3)). It should be noted that the notification to the applicant concerning the missing part of the description or drawing is obligatory for the Offices only if the Office in fact discovers that some part is missing in establishing the filing date (Article 5(5)(a)).

11. However, there are three cases where a filing date is accorded on the date on which the filing date requirements under Article 5(1) and (2) are complied with, rather than on the date that the missing part is filed. Those are:

(a) the case where the date on which the filing date requirements under Article 5(1) and (2) are complied with is later than the date on which the missing part of the description or drawing is submitted (Article 5(6)(a));

(b) the case where the priority of an earlier application is claimed and the missing part is contained in the earlier application. The applicant shall make a request within a time limit under Rule 2(3) in a manner that meets the requirements under Rule 2(4) (Article 5(6)(b)). For example, a Contracting Party may require that the missing part of the description or drawing be completely contained in the earlier application and that a copy of the earlier application and the translation thereof be filed (Rule 2(4)); and

(c) the case where the subsequently filed missing part of the description or drawing is withdrawn within a time limit fixed by the Contracting Party (Article 5(6)(c)).

12. In summary, the PLT establishes an international standard to determine the filing date of a patent application, which is one of the most important dates throughout the life of a patent. Although a filing date is accorded based on the receipt of the three elements, the processing, examination and the validity of the patent will continue to be determined on the basis of the content of the application as a whole that has been submitted as of the filing date.

## Module 2: Standardized Applications

*The PLT establishes a single internationally standardized set of formal requirements for national and regional applications, based on the requirements for international applications under the PCT.*

13. A main feature of the PLT is that it provides standardized formality requirements for a patent application which is filed with a national or regional patent Office. In other words, it specifies the elements that may be required with respect to an application in an exhaustive manner. Whereas a filing date is accorded based on a very simple set of requirements, Contracting Parties may need to require additional elements which are necessary to complete the processing of patent applications.

14. Since the Patent Cooperation Treaty (PCT) already regulates in detail the formality requirements with respect to patent applications, the question may arise as to why a new Treaty is needed. The answer is that the PCT harmonizes formalities only with respect to international applications. The requirements applied by Offices to national and regional applications, as well as to international applications that have entered the national phase, still vary considerably. Nevertheless, creating new internationally-applicable standards different from the PCT should be avoided as much as possible, since more than 100 countries that are members of the PCT already apply the standards under the PCT to international applications. The PLT responds to this challenge by adopting the provisions of the PCT and its Regulations, wherever appropriate.

15. First, the requirements relating to the form or contents of international applications under the PCT, both concerning the international phase and the national phase, are incorporated by reference into the PLT, with minor exceptions (Article 6(1)). Thus, with respect to national and regional applications, no Contracting Party of the PLT may apply requirements relating to form or contents different from, or additional to, those of international applications under the PCT. The expression “form or contents of an application” are to be construed in the same way as the corresponding expression in PCT Article 27(1). Thus, the words “form or contents” are intended to emphasize that requirements of substantive patent law are not meant.

16. Second, the contents of the “request” of an international application under the PCT are also incorporated by reference into the PLT (Article 6(2)(a)). This will include various declarations as provided in proposed PCT Rule 4.17, as amended by the PCT Assembly, which was held from March 13 to 17, 2000. A Contracting Party may require that a request Form of a national or regional application contain: (i) the contents of the request of a PCT application (see PCT Rule 4.1); (ii) the contents of the PCT application which may be required at the national phase; and (iii) other contents prescribed in Rule 3(1). Item (iii) is within the scope of the PLT but is not relevant to the PCT, for example, the indications relating to divisional applications and to applications by new applicants entitled to an invention contained in an earlier application.

17. Third, the Treaty provides that a Contracting Party shall accept three types of request Forms based on the PCT request Form. Those types of Forms are:

(i) a request Form, to be established by the Assembly with the assistance of the International Bureau, which corresponds to the PCT request Form with modifications. Such modifications would be, for example, the addition of other contents under item (iii) of the preceding paragraph (Rule 3(2)(i)). This request Form closely relates to the Model International Forms explained in Module 3;

(ii) a PCT request Form itself accompanied by an indication that the applicant wishes the application to be treated as a national or regional application (Rule 3(2)(ii));

(iii) in the future, if a PCT request Form is modified in a way that the indication referred to in (ii) above is incorporated in the PCT request Form itself, using that type of PCT request Form to national or regional applications shall also be accepted (Rule (2)(iii)).

Types (ii) and (iii) will permit the same request Form to be used for the purposes of filing national, regional and PCT applications, so that an applicant could avoid filling in various request Forms in order to file such applications.

18. The PLT also allows a Contracting Party to require: (i) translation of an application (Article 6(3)); (ii) fees (Article (4)); and/or (iii) copy, or a certified copy, of the earlier application and a translation thereof under certain circumstances where the priority of an earlier application is claimed (Article (5)).

19. In summary, the PLT provides formality requirements for national and regional patent applications, which are, in principle, harmonized with the formality requirements for international applications under the PCT.

## Module 3: Standardized Forms

*The PLT establishes standardized Forms which shall be accepted by all Offices.*

20. In addition to the request Form referred to in Module 2, the PLT provides for several additional Model International Forms. The effect of such Forms is that a Contracting Party will be obliged to accept a communication which is presented in a form corresponding to these Model International Forms (Article 8(3)). These Forms, which are being established by the Assembly with the assistance of the International Bureau, relate to the following communications (Article 14(1)(c) and Rule 20(1) and (2)):

- (a) a power of attorney

Where a representative is appointed, the appointment may be communicated to the Office by a power of attorney (see Rule 7(2));

- (b) a request for recordation of change in name or address

Where an applicant, owner or representative's name or address has changed without any change in the person (for example, a change of name because of a marriage or a change in company name), a request to record that effect may be made in accordance with the requirements prescribed in Rule 15;

- (c) a request for recordation of change in applicant or owner

Where there is a change in the person of the applicant or owner (for example, a change of owner by way of assignment), a request to record that effect may be made in accordance with the requirements prescribed in Rule 16;

- (d) an uncertified certificate of transfer

Where the change in applicant or owner results from a contract, a request for recordation of such a change may be accompanied by an uncertified certificate of transfer of ownership by contract as prescribed in Rule 16(2)(a)(iii);

- (e) a request for recordation, or cancellation of recordation, of a license

A licensor or licensee may make a request for recordation of a license (or a request for cancellation of recordation of a license) in accordance with the requirements prescribed in Rule 17;

- (f) a request for recordation, or cancellation of recordation, of a security interest

A person who acquires or provides a security interest may make a request for a recordation of a security interest (or a request for cancellation of recordation of a security interest) in accordance with the requirements prescribed in Rule 17;

- (g) a request for correction of a mistake

Where an application, a patent or any request contains a mistake which is correctable under the law of the Contracting Party, a request for correction of a mistake may be made in accordance with the requirements prescribed in Rule 18.

21. As regards the communications listed above, the PLT regulates the list of indications which may be required to be contained in those communications, in an exhaustive manner. For example, Rule 15(1) stipulates that a request for recordation of change in name or address may be required to contain all or some of the following: (i) an indication to the effect that recordation is requested; (ii) the number of the application or patent concerned; (iii) the change to be recorded; and (iv) the name and address of the applicant or the owner prior to the change. In addition, in accordance with Rule 10(1), a Contracting Party may require that the following indications also be contained in such a request (indeed, in any communications): (i) the name and address, as well as the registered number or other indication, if any, of the applicant or owner; (ii) the name and address, as well as the registered number or other indication, if any, of the representative; and (iii) a reference to a power of attorney or other communication in which the appointment of the representative is effected.

22. As all the Contracting Parties will be obliged to accept a communication presented on the appropriate Model International Form, each Form will, of necessity, contain all the requirements allowed under the PLT for the procedure in question, even though some of those requirements may not be applied by certain Contracting Parties. In this respect, a Form prepared by a Contracting Party could be modified to contain only items relating to those requirements that it does apply. However, that Contracting Party would still have to accept Model International Forms containing all items. This will permit an applicant to fill in a single Form, file it with any Contracting Party, and be assured that the communication would not be refused on the basis of non-compliance with formality requirements.

## Module 4: Simplified Procedures Before the Office

*The PLT simplifies a number of procedures before Offices, contributing to a reduction of costs for applicants as well as Offices.*

23. “Simplification” is one of the keywords for the PLT. The Treaty simplifies a number of procedures before the Office during the processing of a patent application, as well as for the maintenance of a patent. This will lead to reduced risks of formality errors, and thus will result in less frequent loss of rights as well as cost reductions. On the other hand, by eliminating the unnecessarily complicated procedures and streamlining the whole process, Offices may operate more efficiently and, therefore, cut their costs.

24. The provisions of the PLT apply to national and regional applications that are: (i) applications for patents for invention; (ii) applications for patents of addition; (iii) divisional applications for patents for invention or for patents of addition (PLT Article 3(1)(a)). The “applications for patents for invention” and the “applications for patents of addition” above are to be construed in the same sense as these terms in PCT Article (i), and are restricted to those types of applications that can be filed under the PCT. It means that the PLT does not apply to, for example, inventors’ certificates, utility certificates, utility models, certificates of addition, inventors’ certificates of addition and utility certificates of addition. A Contracting Party is, however, free to apply some or all of the provisions of the PLT to these other applications, even though it is not obliged to do so. The PLT also applies to international applications for patents for invention and for patents of addition filed under the PCT once the international applications have entered into the “national phase” (PLT Article 3(1)(b)(ii)). It also applies to the time limits for the entry of international applications into the “national phase” under PCT Articles 22 and 39(1) (Article 3(1)(b)(i)). For example, if an applicant missed a time limit to pay a national fee under PCT Article 2 because of natural calamity, such as an earthquake, and lost the effect of the international application, he may be entitled to re-instate the right with respect to that application in the designated State in accordance with PLT Article 2. Finally, the PLT applies to all patents for invention, and to patents of addition, which have been granted by the Office of a Contracting Party or by another Office on behalf of that Contracting Party (for example, by a regional Office).

### Restriction on Mandatory Representation

25. At present, many countries require an appointment of a representative for all procedures before the Office, in particular in the case of a foreign applicant. Although the representation by a qualified professional representative helps applicants to effectively protect their rights, related costs are substantial for applicants, and may be particularly burdensome for small and medium enterprises and private inventors. The PLT provides that a Contracting Party may require mandatory representation for the purposes of any procedure except for certain limited procedures (Article 7(2)). With respect to the following exceptional procedures, an assignee of an application, an applicant, owner or other interested person may act himself before the Office:

- (i) the filing of an application for the purposes of the filing date;
- (ii) the mere payment of a fee;

(iii) the filing of a copy of an earlier application for the purpose of establishing a filing date where a part of the description or a drawing has been missing from the initial filing;

(iv) the filing of a copy of a previously filed application for the purpose of establishing a filing date where the description and any drawings have been replaced by a reference;

(v) the issue of a receipt or notification by the Office in respect of any procedure under (i) to (iv).

In addition, a maintenance fee may be paid by any person.

26. Although an applicant or owner could carry out these permitted procedures vis-à-vis patent Offices in foreign countries without engaging any representative, in accordance with Article 8(6) and Rule 10(2), a Contracting Party may require that the applicant or owner nevertheless provide an address for correspondence and/or address for legal service on the territory of that country.

#### Restriction on requiring evidence

27. During the processing of an application, the Office may require evidence in support of formal contents of an application, declarations of priority or the authentication of translations. In order to reduce any unnecessary burden on applicants, the PLT provides that such evidence may only be required where the Office has a reasonable doubt as to the veracity of the indications or the accuracy of the translation submitted by the applicant (Article 6(6)). For example, a Contracting Party is not permitted to ask for evidence on a systematic or a “spot check” basis. Where various standardized declarations are submitted with the request, a Contracting Party may require evidence in addition to the declaration only if the Office has a reasonable doubt as to the indication of such declarations. Such a limitation with respect to evidence is also applicable to the indications contained in the power of attorney (Rule 7(4)), a request for recordation of change in name or address (Rule 15(4)), a request for recordation of change in applicant or owner (Rule 16(6)), a request for recordation, or cancellation of recordation, of a license or security interest (Rule 17(6)) and a request for correction of a mistake (Rule 18(4)).

28. However, in certain cases, the PLT expressly allows a Contracting Party to require supporting documentation. Concerning a request for recordation of change in applicant or owner, a Contracting Party may require that, in support of such a change, the request be accompanied by the documentation which is exhaustively listed in Rule 16(2). The choice of a document from the alternatives listed in that Rule lies with the requesting party. Similarly, a Contracting Party may require the documentation that could accompany a request for recordation, or cancellation of recordation, of a license or security interest (Rule 17(2)).

29. As regards a signature, a Contracting Party may require evidence only where the Office has a reasonable doubt as to its authenticity (Article 8(4)(c)). Otherwise, the Office cannot require any attestation, notarization, authentication, legalization or other certification of a signature (Article 8(4)(b)). However, in the case of so called “digital signatures,” a Contracting Party may require that the authenticity and veracity of such signatures be confirmed by a certification procedure (Rule 9(6)).

30. It is to be noted that, in accordance with Article 2(2), the provisions under the PLT do not apply to any evidence with respect to substantive patent law. Therefore, for example, evidence concerning non-prejudicial disclosures or exceptions to lack of novelty may be required in all cases.

#### Restriction on requirements to submit a copy of earlier application and translation thereof

31. The PLT allows a Contracting Party to require the filing of a copy or a certified copy of the earlier application or a certification of the filing date where a priority is claimed (Article 6(5) and Rules 2(4) and 4(1) and (2)). Further, a copy or a certified copy of the previously filed application may be required where a reference to the previously filed application has been made for the purposes of the filing date (Article 5(7) and Rule 2(5)(b)). However, if the earlier application or previously filed application has been filed with the Office of that Contracting Party, it is not necessary to require the applicant to request, and then submit, a copy of such an application to the same Office. Similarly, certification of the filing date would not serve any useful purpose. Therefore, Rule 4(3) prohibits a Contracting Party to require the copy or the certification in these circumstances as well as the cases where the Office could obtain the copy or the certification from other Offices through a digital library that is accepted by that Office. With the development of new technologies, the latter could be possibly realized in the future.

32. As regards a translation of the earlier application, any country of the Paris Union may require such a translation in accordance with Article 4D(3) of the Paris Convention. However, preparing different translations for different countries in which priority is claimed may be a significant burden on applicants. In addition, it is generally accepted that the translation of the earlier application is not used in many cases, since in most cases the determination of the priority date is not put at issue. Thus, Rule 4(4) provides that the Office may require such translation only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

#### Single communication

33. The PLT allows an applicant or owner to consolidate a number of similar requests in one communication under certain circumstances (Rule 7(2)(b)). For example, a Contracting Party shall accept a single power of attorney if it relates to one or more applications and/or patents of the same person. A Contracting Party shall also accept a single power of attorney, a so-called “general power of attorney”, which relates to all existing and future applications and/or patents of the same person, with indications of possible exceptions of the power, if any. To minimize the administrative burden on the Office, where such a single power of attorney is submitted, the Office could require a separate copy of such power for each application and/or patent to which it relates.

34. Similarly, a single request is sufficient where the change in name or address or the change in applicant or owner relates to more than one application and/or patent (Rules 15(3)(b) and 16(5)).

## Module 5: Avoiding Loss of Rights

*The PLT avoids unintentional loss of substantive rights and reinstatement of rights as a result of failure to comply with formality requirements.*

35. As mistakes that could result in the unintentional loss of rights inevitably occur, it is important for an applicant or owner that certain mechanisms to rectify such mistakes are provided. However, in providing for such rectification, it is important that the objectives of a patent system including certainty and predictability, the administrative burden on Offices, as well as effects to third parties, should also be borne in mind.

### Notification and opportunity to correct

36. One of the user-friendly provisions under the PLT includes an obligation on Offices to notify applicants and owners of any non-compliance with procedural requirements and provisions concerning adequate time limits for subsequent compliance with such requirements (Articles 5(3), 6(7), 7(5) and 8(7) and Rules 2(1), 6(1), 7(5), 11(1), 15(6), 16(8), 17(8), and 18(6)). Provisions that assure at least one opportunity to make observations before the refusal of a request are also provided for with respect to a request for extension of time limits and continued processing (Article 11(6)), a request for reinstatement of rights (Article 12(5)) and a request for correction or addition of priority claim and restoration of priority rights (Article 13(5)). Further, where evidence is required, the notification shall contain the reason why the Office has a doubt (Rule 5).

37. The types of sanctions which could be imposed in case of non-compliance with the requirements within a time limit is up to the applicable law of the Contracting Party, in principle. However, the sanction shall be limited to the non-existence of the priority claim and its consequences, if the requirements concerning a priority claim are not complied with (Article 6(8)(b)). Further, as long as the requirements concerning a filing date are met, the filing date shall be accorded to the application even if the application is refused because of other reasons (for example, if no translation is submitted within the applicable time limit; see Article 6(8)(a)).

### Relief in respect of time limits

38. The provisions concerning relief in respect of time limits, in the form of an extension and/or continued processing, are one of the important achievements of the PLT. The Treaty provides three types of relief procedures as follows:

- (a) an extension of the time limit, for at least two months, where an applicant or owner requests the extension *prior to* the expiration of the time limit (Article 11(1)(i));
- (b) an extension of the time limit, for at least two months, where an applicant or owner requests the extension *after* the expiration of the unobserved time limit (Article 11(1)(ii));
- (c) continued processing (Article 11(2)).

39. A Contracting Party is not obliged to provide type-(1) extensions. However, it is obliged to provide either type-(2) extensions or type-(3) continued processing, in cases where the circumstances meet the prescribed requirements under the Treaty and the Regulations. Relief under these provisions is limited to non-compliance with a time limit fixed by the Office for an action in a procedure before the Office. It does not apply to a time limit fixed by legislation.

40. Where a Contracting Party chooses to provide for type-(2) extensions, that is, an extension of a time limit based on a request filed after the expiration of the unobserved time limit, the time limit shall be extended for a period of not less than two months, and the request shall be filed within this period (Rule 12(2)). Additionally, a Contracting Party may require that the relevant requirements, which have not been met, be complied with at the same time the request is filed (Rule 12(1)(b)).

41. Alternatively, if a Contracting Party provides for continued processing, the request shall be made, and all the relevant requirements shall be complied with, within a time limit of not less than two months from the expired time limit (Rule 12(4)). The effect of continued processing is that the Office shall continue with the procedure concerned as if that time limit had been complied with. Further, the Office shall, if necessary, re-instate the rights of the applicant or owner with respect to the application or patent concerned.

#### Reinstatement of rights

42. The PLT also provides safeguard provisions if an applicant or owner has failed to meet a time limit and, as a consequence, has lost his rights with respect to an application or patent unintentionally or in spite of all due care required by the circumstances (Article 12). Reinstatement of rights shall be granted if a request to that effect is made, and all the relevant requirements are complied with, within a time limit of not less than two months from the date on which the reason of the non-compliance with the time limit is removed, or of not less than 12 months from the expiration of the missed time limit, whichever is shorter (Rule 13(2)).

43. A Contracting Party may require that the request state the grounds for not meeting the time limit, so that the Office could consider whether the applicant or owner had taken all due care or the delay was unintentional. In contrast to the relief in respect of time limits, reinstatement of rights is applicable to all time limits, including time limits set by legislation.

#### Correction or addition of priority claim

44. As in the case of international applications under the PCT (see PCT Rule 26*bis*), Article 13(1) and Rule 14(1) to (3) provide for a possibility of addition and correction of priority claim for national/regional applications. Thus, an applicant may correct or add a priority claim until the expiration of four months from the filing date of the application, though a longer time limit may apply in certain cases, namely, where the earliest of the following time limits would expire later than the four-month time limit:

(a) 16 months from the priority date; or

(b) where the correction or addition would cause a change in the priority date, 16 months from the priority date so changed.

The application must be filed before the expiration of the 12-month priority period, calculated from the filing date of the earliest application whose priority, as corrected or added, is claimed.

#### Restoration of priority right

45. The PLT also provides for a remedy for the loss of a priority right in two cases due to innocent non-compliance with related time limits.

46. First, where an application is filed after the expiration of the 12-month priority period, under certain circumstances, an applicant is entitled to the restoration of the priority right (Article 13(2)). The condition is that the application shall be filed within at least two months from the date on which the priority period expired, and a request shall be made within that period, but before the completion of any technical preparation for publication of the application. In addition, the Office shall provide a restoration of the priority claim if the failure to claim a priority within 12 months occurred in spite of all due care by the applicant, or was unintentional, and the request indicates the grounds of such failure.

47. The second case is where an applicant cannot submit a copy of an earlier application within 16 months from the priority date, required under Rule 4(1), because of a delay in the Office with which the earlier application was filed. In order to safeguard the applicant in such cases, Article 13(3) and Rule 14(6) and (7) provide for restoration of priority rights if the applicant has filed a request for a copy of the earlier application with the Office with which the earlier application was filed by the end of 14 months from the priority date, and makes a request for restoration within 16 months from the priority date.

#### Restrictions on the revocation and invalidation of patents

48. The PLT provides that, once a patent is granted, the Office, a board of appeal, a court or any other competent authority may not revoke or invalidate the patent, either totally or in part, on the grounds of non-compliance with certain formal requirements with respect to applications, namely the requirements under Articles 6(1), (2), (4) and (5) and 8(1) to (4) (Article 10(1)). Although the formal requirements are necessary for the processing of an application, they are not considered to be essential to the content or substance of the granted patent. However, a patent may be revoked if the non-compliance with the formal requirements occurred as a result of a fraudulent intention.

49. Further, the PLT also provides that, once a patent is granted, the Office, a board of appeal, a court or any other competent authority may not revoke or invalidate the patent, either totally or in part, without giving the owner of the patent at least one opportunity to make observations and to make amendments and corrections within a reasonable time limit, if such amendments or corrections are allowed under the applicable law (Article 10(2)).

## Module 6: Paper and Electronic Communications

*The PLT facilitates the implementation of electronic filing, while securing the interests of all parties involved.*

50. The goal of the PLT concerning paper and electronic filing is to facilitate the implementation of electronic filing of applications and other communications, to the advantage of both Offices and their users, and, at the same time, not to exclude any users from the benefits of the patent system, if they are not ready to apply electronic filing.

51. Due to the recent development of communication technology, filing and processing of patent applications by electronic means will become more popular in the near future. Under the PCT system, the PCT-SAFE system has been implemented, and the establishment of further legal and technical standards for electronic filing and processing of PCT applications is underway. Further, WIPO assists automation of national/regional Offices to enhance the efficiency of IP registration activities. However, as developments in this field are proceeding more rapidly in some places than in others on the global level, the PLT guarantees the right of applicants, owners and other interested persons to file applications and other communications on paper until June 2, 2005, with an exception that, if receiving or processing of a communication is not practicable due to its size or its character, a Contracting Party may require such communication in non-paper form (Rule 8(1)(d)). So called “mega-applications” will fall under this exception.

52. After June 2, 2005, a Contracting Party may, if it so wishes, exclude paper filing (i.e., it may implement full electronic filing) with certain exceptions (Rule 8(1)). These exceptions are the obligation on all Offices to accord a filing date for a paper application (Article 5(1)), and to accept the filing of communications on paper for the purpose of respecting a time limit (Article 8(1)(d)). In these cases, however, the Office which would implement full electronic filing could treat the paper filing as having a formality defect, and may require that the application or the communication concerned be subsequently filed in electronic form for further processing in the Office (Article 8(7)). It is important to note that amendment of Rule 8(1)(a), which regulates the period for full-electronic filing, requires unanimity at the Assembly (Rule 21).

53. Whether before or after June 2, 2005, the principle under the PLT is that:

(a) no Contracting Party is obliged, against its wishes, to accept the filing of communications in electronic form or by electronic means (Article 8(1)(b));

(b) no Contracting Party is obliged, against its wishes, to exclude the filing of communications on paper (Article 8(1)(c)).

Therefore, even after June 2, 2005, a Contracting Party will be free to continue processing the application using paper, and not to accept electronic filing.

54. The detailed requirements with respect to applications and other communications filed in electronic form or by electronic means are linked to the respective requirements under the PCT. In particular, these requirements are to be provided in the Administrative Instructions

under the PCT. In principle, if a Contracting Party permits electronic filing of communications in a particular language for national/regional applications and for PCT applications, the Office of the Contracting Party shall accept the electronic filing of communications for national/regional applications that comply with the requirements under the PCT in that language (Rule 8(2)(a)). This also applies to communications by telegraph, teleprinter, telefacsimile or other like means. Any Contracting Party which permits electronic filing, including filing communications by telefacsimile etc., shall notify the International Bureau of the requirements under its law. The notification will be published by the International Bureau.

55. As the principle under Article 8(1)(b) and (c) indicates, a Contracting Party could not be forced to accept electronic filing or to abolish paper filing. The date "June 2, 2005" has been agreed upon as a compromise solution, with the expectation that, after that period, electronic filing could be an accessible technology on a global level, considering the speed of the development in the world and the continued technical cooperation activities of WIPO, including the activities under the Standing Committee on Information Technologies (SCIT) and the PCT. In this connection, an Agreed Statement was adopted at the Diplomatic Conference, according to which WIPO and industrialized market economy countries will continue to provide support to developing countries and countries in transition for the introduction of electronic filing.

## CONCLUSION

56. As has been indicated in the Modules, the PLT is beneficial for inventors and applicants, patent attorneys and national and regional Offices in many respects. From the viewpoint of inventors, applicants and patent attorneys, standardization and simplification of the formality requirements lead to a reduced risk of formality errors, and thus will result in a less frequent loss of rights as well as in cost reductions. On the other hand, by eliminating unnecessarily complicated procedures and streamlining the whole process, Offices may operate more efficiently, and therefore cut their costs.

57. In addition, the conclusion of the PLT has a significant importance for the future activities of WIPO. The simplification and harmonization of patent formalities, and their link with the PCT, will provide a firm foundation for future development of patent law and the international patent system.

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