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المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

C. PCT 890

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./ The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith documents PCT/R/WG/3/2 Add.1 and 3 Add.1, prepared for the third session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which was held in Geneva from November 18 to 22, 2002.

The working documents are also available on WIPO's Web site (see <http://www.wipo.int/pct/en/meetings>).

December 5, 2002

Enclosures: documents PCT/R/WG/3/2 Add.1 and 3 Add.1

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

WORKING GROUP ON REF ORMOF THE PATENT COOPERATION TREATY (PCT)

Third Session

Geneva, November 18 to 22, 2002

EPO PROPOSAL ON THE CRITERIA FOR RESTORATION OF
RIGHT OF PRIORITY (PROPOSED NEW RULE 26 bis.3(a))

Proposals by the European Patent Office (EPO)

Comments

1. Under the proposal (see proposed Rule 26 bis.3(a) in document PCT/R/WG/3/2) the applicant may choose whether he requests restoration of the right of priority either because the failure to file the subsequent application in time was "unintentional," or that it "occurred in spite of all due care required by the circumstance having been taken." The EPO does not support this proposal. The PCT should contain one single criterion. Also the determination of a fee charged for the benefit of a receiving Office by the PCT Assembly and the inclusion of the amount of such fee in the Regulations is not customary. Finally, the procedures should be kept as simple and transparent as possible.

2. According to the European Patent Convention (EPC) and many national laws the establishment of rights is only possible if the time limit was missed "in spite of all due care." It should be avoided that patent offices would have to apply "unintentionality" as receiving Office under the PCT and "due care" as national office when receiving national patent applications, i.e. they would have to be more liberal as receiving Office than as a national office.

3. Moreover proposed Rule 26 *bis(j)* restricts the circumstances in which the designated Office could review a decision by the receiving Office to restore a priority claim during the international phase. This approach is in line with the principle that positive decisions taken in the international phase by the receiving Offices should bind the designated Office (e.g. in cases of corrections). But if the criterion applied by the receiving Office was the “unintentionality”, many designated Offices applying national laws, which have the more restrictive criterion “due care”, would have to accept restitution of priority right based on criteria that would be insufficient under their national law. On the contrary, if all receiving Offices would apply the sole and more restrictive “due care” criterion, a possibility for review of a negative decision taken in the international phase by the receiving Office could be made available before the designated Offices. Where the national law applied by the designated Office provides for requirements for the restoration of right of priority that are more favorable, that designated Office could apply these requirements (e.g. the criterion of “unintentionality”) to the international application concerned.

4. Taking into account that a considerable number of national laws do not currently provide for restoration of priority rights and the convenience of a single consistent practice in the international phase, it would be advisable to provide guidance to receiving Offices on how to apply the criterion of “due care.”

Proposals

5. It is proposed to draft Rule 26 *bis.3(a)* as follows:

“The receiving Offices shall [...] restore the right of priority where the international application which claims or could have claimed the priority of an earlier application has an international filing date which is later than the date on which the priority period referred to in paragraph (f) expired but is within two months from that date, if the receiving Office finds that the failure to comply with the priority period occurred in spite of due care required by the circumstances having been taken _____.”

6. It is furthermore proposed to include a paragraph in Rule 26 *bis.3* to the following effect:

Where the receiving Office has refused a request for the restoration of the right of priority, each designated Office may, where the national law applied by this Office provides for requirements for the restoration of the right of priority that are more favorable than those under Rule 26 *bis.3(a)*, apply those more favorable requirements where the applicant files a request for review under Rule 26 *bis.3(i)*.

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WIPO



PCT/R/WG/3/3Add.1

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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**WORKING GROUP ON REF ORM OF THE PATENT
COOPERATION TREATY (PCT)**

Third Session

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OPTIONS FOR A POSSIBLE REVISION OF THE PCT:

EPO RESPONSE TO DOCUMENT PCT/R/WG/3/3

Proposals by the European Patent Office

1. The European Patent Office (EPO) notes the comments prepared by the International Bureau concerning the possible scenarios for revision of the Patent Cooperation Treaty (PCT). It is certainly clear that consideration will have to begin to the question of modalities whenever the first stage of reform, changes which can be brought about by revision of the PCT Regulations, has completed and it is necessary to consider a amendment of the articles. However it is apparent from document PCT/R/WG/3/1 that there are many outstanding items still to be dealt with in the first stage of reform which have not been considered in any detail as yet in the Working Group. These items are likely to take some considerable time before they are satisfactorily dealt with and it is perhaps premature at this stage to devote much time to considering the potentially difficult practical problems which would be associated with a substantial revision of the Treaty.

2. The International Bureau indicates quite rightly that the early identification of the intentions of the member states with respect to the nature of possible reform is essential. However much will depend on the actual progress reached in the Working Group and in the Committee before it becomes apparent whether we shall have modifications which are

compatible with the operation of the existing PCT system or whether changes are required which would be incompatible with the current system.

3. For these reasons the EPO would suggest that while longer term objectives should be identified, the Working Group should not concern itself at this stage with the modalities of a possible PCT revision, rather should concentrate on the immediate work in hand, i.e. prioritizing those reform proposals which could be implemented in the short to medium term by way of changes to the regulations.

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