

WIPO



SCP/1/8 Prov.

ORIGINAL: English

DATE: August 5, 1998

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

***PRELIMINARY DRAFT FOR
THE SCP ELECTRONIC FORUM***

STANDING COMMITTEE ON THE LAW OF PATENTS

**First Session, Second Part
Geneva, November 16 to 20, 1998**

REVISED TEXT OF PROVISIONS REFERRED TO THE
INTERNATIONAL BUREAU FOR FURTHER STUDY

prepared by the International Bureau

INTRODUCTION

1. The present document contains revised draft texts of those provisions of the draft Patent Law Treaty ("PLT") and accompanying Regulations which were referred to the International Bureau for further study by the Standing Committee on the Law of Patents at its first session, first part (June 15 to 19, 1998) as reported in the Summary by the Chair (document SCP/1/6). Differences between the text of the draft Treaty and Regulations submitted to the first session, first part (document SCP/1/3) and the revised draft texts contained in the present document have been highlighted as follows: (i) words which did not appear in document SCP/1/3 but appear in the present text are underlined, and (ii) words which appeared in document SCP/1/3 which are omitted from the present document are shown as struck through. Text from document SCP/1/3 which is merely moved to a different location without change in substance is not underlined.

REVISED TEXT OF PROVISIONS REFERRED TO THE
INTERNATIONAL BUREAU FOR FURTHER STUDY

TABLE OF CONTENTS

Revised Provisions of the Draft Treaty

Article 1	4
Abbreviated Expressions.....	4
<u>Article 1bis</u>	5
<u>Notification by the Office</u>	5
Article 3	6
National Security	6
Article 4	7
Filing Date.....	7
Article 7	10
Representation; Address for Service.....	10
Article 9	12
Request for Recordal of Change in Name or Address.....	12
Article 10	13
Request for Recordal of Change in Applicant or Owner.....	13
Article 11	14
Request for Recordal of a Licensing Agreement or Security Interest	14
Article 12	15
Request for Correction of Mistake	15
Article 13	16
Extension of a Time Limit Fixed by the Office.....	16
Article 14	17
Further Processing or Revival of Application	17
<u>Re-instatement of Application [or Patent] Without a Finding of Due Care by the Office</u>	17
.....	18
Article 15	19
Restoration of Rights <u>Re-instatement of Application or Patent After a Finding of Due Care by the Office</u>	19
Article 16	21
Addition and Restoration of Priority Claim	21
DRAFT REGULATIONS	22
Rule 2.....	22
Details Concerning Filing Date Under Article 4.....	22
Rule 9.....	24
Details Concerning Request for Recordal of Change in Name or Address Under Article 9.....	24
Rule 10.....	25

Details Concerning Request for Recordal of Change in Applicant or Owner Under Article 10.....	25
Rule 11.....	27
Details Concerning Request for Recorded of a Licensing Agreement.....	27
or Security Interest Under Article 11	27
Rule 12.....	28
Details Concerning Request for Correction of a Mistake Under Article 1228	
Rule 13.....	29
Details Concerning Extension of a Time Limit Fixed by the Office Under Article 13	29
Rule 14.....	31
Details Concerning Further Processing or Revival of Application <u>Re-instatement of Application [or Patent] Without a Finding of Due Care by the Office Under Article 14</u>	31
Rule 15.....	33
Details Concerning Restoration of Rights <u>Re-instatement of Application or Patent</u>	33
<u>After a Finding of Due Care by the Office Under Article 15</u>	33

DRAFT TREATY

Article 1

Abbreviated Expressions

(i) “Office” means the authority of a Contracting Party entrusted with the granting of patents or with other matters covered by this Treaty;

(xi) [Deleted]

Article Ibis

Notification by the Office

(1) [If Indications Allowing Contact Were Not Submitted] Nothing in this Treaty and the Regulations shall oblige a Contracting Party to send a notification to an applicant, owner or other interested person, if indications allowing that applicant, owner or other interested person to be contacted have not been submitted to the Office.

(2) [If Applicant Was Not Notified] Where this Treaty or the Regulations requires a Contracting Party to notify an applicant, owner or other interested person of failure to comply with requirements, failure to notify the applicant, owner or other interested person does not relieve that applicant, owner or other interested person of the obligation to subsequently comply with those requirements.

Article 3

National Security

Nothing in this Treaty and the Regulations shall limit the freedom of any Contracting Party to ~~apply measures~~ take any action deemed necessary for the preservation of its national security.

Article 4

Filing Date

(3) [*Notification*] ~~(a)~~ Where the application does not comply with one or more of the requirements of paragraphs (1) and (2), the Office shall promptly notify the applicant of any requirement not complied with.

~~(b)~~ [Moved to Article 4(5)(a)]

...

(5) [~~Submission of Missing Description or Drawings~~] (a) Where, for the purposes of establishing the filing date, the Office determines that a part of the description is missing from the application or that the application refers to a drawings which, in fact, are not included in ~~is~~ missing from the application, the Office shall, promptly after the determination has been made, notify the applicant accordingly.

(ab) Subject to subparagraphs ~~(bc)~~ and to (cc) ~~and paragraph (6)~~, where a missing part of the description or a missing drawings referred to in the application, but in fact not included, are furnished to the Office within the time limit prescribed in the Regulations, that part of the description or drawing shall be included in the application, and the filing date shall be the date on which the Office has received that part of the description or those drawings, or the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with, whichever is later. Otherwise, any reference to the said drawings shall be considered non-existent.

(bc) Notwithstanding subparagraph (b) and subject to subparagraph (d), Aa Contracting Party [may][shall] provide that, where the Office determines, within a time limit prescribed by the Contracting Party, if any, that the all missing parts of the description and all missing drawings furnished under subparagraph (ab) do not contain new matter, the filing date shall be the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with.

(d) Where ~~a~~ the missing part of the description or missing drawing is furnished after the filing date under subparagraph (b) to rectify its unintentional omission from the an application on the filing date, and the application which claims the priority of an earlier application, the Office shall, upon the request of the applicant and subject to the requirements prescribed in the Regulations, consider the contents of that earlier application as having been contained in the application claiming priority in determining, for the purposes of ~~the filing date~~ subparagraph (c), whether that part of the description or that drawing contains new matter.

(ee) Where all or part of the missing part of the description and missing drawings furnished under subparagraph (ab) in respect of which the determination referred to in subparagraph (c) has been made are withdrawn within a time limit fixed by the Contracting Party, and any remaining part of the description and drawings does not contain new

matter, the filing date shall be the date on which the requirements referred to in paragraphs (1) and (2) are complied with, ~~and any reference to the said drawings shall be considered non-existent.~~

(6) [*Consideration of Contents of Earlier's Application*] [Moved to Article 4(5)(d)]

...

[(8) [*Divisional Applications; Continuation and Continuation-in-Part Applications*]]

Nothing in this Article shall limit:

[(i) the right of an applicant under Article 4G(1) or (2) of the Paris Convention to preserve, as the date of a divisional application referred to in that Article, the date of the initial application referred to in that Article and the benefit of the right of priority, if any:]

[(ii) the freedom of any Contracting Party to apply any requirements necessary to accommodate the special features in respect of the filing date of an application for a continuation or a continuation-in-part of an earlier application.]

Article 7

Representation; Address for Service

(3) [*Address Where No Representative Is Appointed*] (a) Where no representative is appointed, a Contracting Party may require, for the purposes of any procedure before the Office other than a procedure referred to in paragraph (2)(i) to (iv), that an applicant, owner or other interested person:

~~(i) indicate, as his address, the address of a domicile or real and effective industrial or commercial establishment, if any, which he has on the territory of the Contracting Party; or, at his option.~~

~~(ii) provide an address for service on the territory of the Contracting Party.~~

(b) Where an applicant, owner or other interested person has a domicile or real and effective industrial or commercial establishment on the territory of the Contracting Party and has provided the address of that domicile or establishment, that address shall be considered to be the address for service for the purposes of subparagraph (a) unless that applicant, owner or other interested party expressly indicates another address as the address for service on the territory of the Contracting Party.

(4) [*Power of Attorney*] (a) A Contracting Party shall accept that the appointment of the representative be furnished to the Office in:

(i) a separate communication (hereinafter referred to as a “power of attorney”) ~~indicating the name of, and signed by, the applicant, owner or other interested person~~ and indicating the name of the person making the appointment and the name and address of the representative; or, at his option,

(ii) the request Form referred to in Article 5(2), signed by the applicant.

...

Article 9

Request for Recordal of Change in Name or Address

(1) [Request] ~~(a)~~ Where there is no change in the person of the applicant or owner but there is a change in his name or address, a Contracting Party shall accept that a request for recordal of the change be made in a communication signed by the applicant or owner and ~~indicating the number of the application or patent concerned and the change to be recorded.~~

~~(b)~~—A Contracting Party may require that the request containing the indications prescribed in the Regulations.

Article 10

Request for Recordal of Change in Applicant or Owner

(1) [*Request for Recordal of a Change in Applicant or Owner*] ~~(a)~~ Where there is a change in the person of the applicant or owner, a Contracting Party shall accept that a request for recordal of the change be made in a communication signed by the applicant or owner, or by the new applicant or owner, and ~~indicating the number of the application or patent concerned and the to be recorded.~~

~~(b) A Contracting Party may require that the request containing~~ the indications prescribed in the Regulations.

(12) [*Exclusion with Respect to Inventorship of Application of Article 10*] A Contracting Party may exclude the application of this Article in respect of changes in inventorship. What constitutes inventorship shall be determined under the applicable law of the Contracting Party.

Article 11

Request for Recordal of a Licensing Agreement or Security Interest

(1) [*Request for Recordal of a Licensing Agreement*] ~~(a)~~ Where a licensing agreement in respect of an application or patent may be recorded under the applicable law, the Contracting Party shall accept that a request for recordal of that licensing agreement be made in a communication signed by the licensor or the licensee and ~~indicating the number of the application or patent concerned.~~

~~(b)~~ ~~A Contracting Party may require that the request containing~~ the indications prescribed in the Regulations.

Article 12

Request for Correction of Mistake

(1) [*Request*] ~~(a)~~ Where an application, a patent or any request communicated to the Office in respect of an application or a patent contains a mistake which is correctable under the applicable law, the Contracting Party shall accept that a request for correction of that mistake in the records and publications of the Office be made in a communication signed by the applicant or owner and ~~indicating the number of the application or patent concerned, the mistake to be corrected and the correction to be made.~~

~~(b) A Contracting Party may require that the request containing the indications prescribed in the Regulations.~~

(12) [*Exclusion With Respect to Inventorship of Application of Article 12*] A Contracting Party may exclude the application of this Article in respect of ~~corrections~~ changes in inventorship. What constitutes inventorship shall be determined under the applicable law of the Contracting Party.

Article 13

Extension of a Time Limit Fixed by the Office

(2) [*Exceptions*]~~—(a) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under paragraph (1) to extend a time limit for an action in a procedure before the Office in respect of any of those requirements beyond that maximum time limit.~~

~~(b)~~ No Contracting Party shall be required to grant an extension under paragraph (1) with respect to the time limits prescribed in the Regulations

~~(i) — a second, or any subsequent, extension of a time limit in respect of which an extension has already been granted under that paragraph;~~

~~(ii) — an extension of a time limit for filing a request for an extension of a time limit.~~

...

(4) [*Language*] Article 5(3~~5~~) shall apply, *mutatis mutandis*, to requests under paragraph (1).

Article 14

~~Further Processing or Revival of Application~~

Re-instatement of Application [or Patent] Without a Finding of Due Care by the Office

(1) [~~Request for Further Processing or Revival of Application~~] ~~(a)~~—Where an application has been, or is to be, refused or considered withdrawn or abandoned following ~~failure~~ applicant [or owner] has failed to comply with a time limit {fixed by the Office} for an action in a procedure before the Office, the Office shall, ~~subject to subparagraph (b), at the option of the Contracting Party,~~

(i) ~~consider~~ proceed with the further processing of the application as if that time limit to have had been complied with, ~~or~~ and

(ii) ~~re-instate~~ revive the said application [or patent] concerned, if necessary,

upon a request made in a communication to the Office signed by ~~that~~ the applicant [or owner], if the request is made, and all of the requirements in respect of which the time limit for the said action ~~in a procedure before the Office~~ applied are complied with, within the time limit prescribed in the Regulations.

~~(b) — A Contracting Party may provide that a request for revival under subparagraph (a) be accompanied by a statement that the failure to comply with the time limit was unintentional.~~

(2) [*Exceptions*] ~~(a) — No Contracting Party shall be required to provide for the reinstatement of an application [or patent] under paragraph (1) with respect to the exceptions prescribed in the Regulations which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required to grant further processing or revival under paragraph (1)(a) after the expiration of that time limit.~~

~~(b) — The law of any Contracting Party may specify certain time limits in respect of which further processing or revival under paragraph (1)(a) shall be excluded....~~

(9) [*Intervening Rights*] [Deleted]

Article 15

Restoration of Rights Re-instatement of Application or Patent After a Finding of Due Care by the Office

(1) [~~Request for Restoration of Rights~~] Where ~~the failure to comply with a time limit for an action in a procedure before the Office has the direct consequence of causing an application to be refused or considered withdrawn or abandoned, or causing a patent to be revoked, invalidated or considered lapsed or terminated~~ an applicant or owner has failed to comply with a time limit for an action in a procedure before the Office, the Office shall ~~restore~~ re-instate the rights of the applicant or owner, upon a request made in a communication to the Office signed by the applicant or owner, if:

(i) the request is made, and all of the requirements in respect of which the ~~said~~ time limit for the said ~~an action applied in a procedure before the Office~~ are complied with, within the time limit prescribed in the Regulations;

(ii) the failure to comply with the time limit for the said action applied has the direct consequence of causing a loss of rights with respect to the application or patent;

(iii) the request states the grounds on which it is based; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of all due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(2) [~~Exclusions~~Exceptions] No Contracting Party shall be required to provide for the re-instatement ~~restoration~~ of rights under paragraph (1) ~~in the case of failure to comply with a time limit for~~ with respect to the exceptions prescribed in the Regulations:

(i) ~~an action before a board of appeal or other review body constituted in the framework of the Office;~~

(ii) ~~the payment of maintenance fees, where such fees are not paid within the period of grace referred to in Article 5bis(1) of the Paris Convention;~~

(iii) ~~making a request under paragraph (1) or Article 13(1) or 14(1)(a);~~

(iv) ~~filing a request for search or examination;~~

(v) ~~filing a translation of a regional patent.~~

...

(9) [*Intervening Rights*] [Deleted]

Article 16

Addition and Restoration of Priority Claim

{(9) *[Intervening Rights]*} [Deleted]

DRAFT REGULATIONS

Rule 2

Details Concerning Filing Date Under Article 4

(1bis) [Time Limits Under Article 4(5)(b)] (a) The time limits referred to in Article 4(5)(b) shall be not less than two months from the date on which one or more elements referred to in Article 4(1)(a) were first received by the Office.

(b) The date on which the applicant receives the notification provided for in Article 4(5)(a) shall have no effect on the time limit fixed under subparagraph (a).

(2) [Requirements Under Article 4(65)(d)] (a) Any Contracting Party may require that, for the contents of an earlier application to be considered under Article 4(65)(d):

(i) to (v) [Unchanged]

(b) No Contracting Party shall require the furnishing of a copy or a certified copy of the earlier application, or a certification of the filing date, as referred to in subparagraph (a), where the earlier application was filed with its Office or is available to that Office in electronic format from a digital library accepted by the Office, in an official form, to that Office by electronic means.

(3) [*Requirements Under Article 4(7)(a)*] (a) The reference to the previously filed application under Article 4(7)(a) shall indicate the number of that application and the Office with which the previously filed that application was filed, the filing date, the number, the name of the applicant[, the title] and the language of the previously filed application. A Contracting Party may require that the reference also indicate the filing date of the previously filed application.

...

(e) No Contracting Party shall require the furnishing of a copy or a certified copy referred to in subparagraph (d), where the previously filed application was filed with its Office or is available to that Office in electronic format from a digital library accepted by the Office, in an official form, to that Office by electronic means.

Rule 9

Details Concerning Request for Recordal of Change in Name or Address Under Article 9

(1) [*Request*] A Contracting Party may require that the request for recordal of a change in name or address indicate:

(i) the number of the application or patent concerned;

(ii) the change to be recorded;

(iii)(i) the name and address of the applicant or the owner prior to the change;

~~(ii) where the applicant or the owner has a representative, the name and address of that representative;~~

~~(iii) where the applicant or the owner has an address for service, such address.~~

Rule 10

Details Concerning Request for Recordal of Change in Applicant or Owner Under Article 10

(1) [*Request*] A Contracting Party may require that the request for recordal of a change in applicant or owner indicate:

(i) the number of the application or patent concerned;

(ii) the change to be recorded;

(iii) the name and address of the applicant or owner;

(~~iii~~iv) the name and address of the new applicant or new owner;

(~~iii~~v) the date of the change in the person of the applicant or owner;

(~~iv~~vi) the name of a State of which the new applicant or new owner is a national if he is the national of any State, the name of a State in which the new applicant or new owner has his domicile, if any, and the name of a State in which the new applicant or new owner has a real and effective industrial or commercial establishment, if any;

(~~v~~)—where the applicant or owner has a representative, the name and address of that representative;

~~(vi) where the applicant or owner has an address for service, such address;~~

~~(vii) where the new applicant or new owner has a representative, the name and address of that representative;~~

~~(viii) where the new applicant or new owner has an address for service, that address;~~

~~(ixvii)~~ the basis for the change requested.

Rule 11

*Details Concerning Request for Recorded of a Licensing Agreement
or Security Interest Under Article 11*

(1) [*Request*] A Contracting Party may require that the request for recordal of a licensing agreement indicate:

(i) the number of the application or patent concerned;

(ii) the name and address of the licensor;

(iii) the name and address of the licensee;

~~(iii) where the licensor has a representative, the name and address of that representative;~~

~~(iv) where the licensor has an address for service, such address;~~

~~(v) where the licensee has a representative, the name and address of that representative;~~

~~(vi) where the licensee has an address for service, such address.~~

Rule 12

Details Concerning Request for Correction of a Mistake Under Article 12

(1) [*Request*] A Contracting Party may require that the request for correction of a mistake indicate:

(i) the number of the application or patent concerned;

(ii) the mistake to be corrected;

(iii) the correction to be made;

(iv)~~(i)~~ the name and address of the requesting party;

~~(ii) where the requesting party has a representative, the name and address of that representative;~~

~~(iii) where the requesting party has an address for service, such address.~~

Rule 13

Details Concerning Extension of a Time Limit Fixed by the Office Under Article 13

(1bis) [Exceptions under Article 13(2)] (a) No Contracting Party shall be required under Article 13(1) to grant:

(i) a second, or any subsequent, extension of a time limit in respect of which an extension has already been granted under that ~~paragraph~~ Article;

(ii) an extension of a time limit for filing a request for an extension of a time limit;

(iii) an extension of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;

(iv) an extension of a time limit for an action in proceedings in respect of an opposition to the grant of a patent;

(v) an extension of a time limit for an action in interference proceedings;

[(vi) an extension of a time limit for an action in a procedure before the Office in respect of which a request for expedited or accelerated processing has been granted.]

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under ~~paragraph (1)~~ Article 13(1) to extend a time limit for an action in a procedure before the Office in respect of any of those requirements beyond that maximum time limit.

Rule 14

Details Concerning ~~Further Processing or Revival of Application~~ Re-instatement of Application [or Patent] Without a Finding of Due Care by the Office Under Article 14

(1) [~~Time Limit Under Article 14(1)(a)~~] The time limit for making a request, and for complying with the requirements, under Article 14(1)(a) shall be not less than two months from the date on which the applicant [or owner] was notified by the Office ~~that the application had been, or was to be, refused or considered withdrawn or abandoned following~~ of failure to comply with the time limit concerned.

(1bis) [~~Statement~~] Any Contracting Party may require that a request for revival under ~~subparagraph (a)~~ Article 14(1) which is filed later than two months from the date of the expiration of the time limit for the action referred to in that paragraph be accompanied by a statement that the failure to comply with the time limit was unintentional.

(1ter) [~~Exceptions Under Article 14(2)~~] (a) No Contracting Party shall be required to re-instate a procedure under Article 14(1) where the applicant or owner fails to comply with a time limit for:

(i) an action before a board of appeal or other review body constituted in the framework of the Office;

(ii) the payment of maintenance fees;

(iii) making a request under Article 13(1), 14(1) or 15(1);

(iv) filing a request for search or examination;

(v) filing a translation of a regional patent.

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements for the grant of a patent shall be required under Article 14(1) to ~~grant further processing or revival under paragraph (1)(a)~~ re-instate the application after the expiration of that maximum time limit.

(2) [*Requests Filed on Paper or in Electronic Form or by Other Means*] Rule 3(1) to (4) shall apply, *mutatis mutandis*, where the request concerns the re-instatement of an application [or patent] without a finding of due care by the Office~~further processing or revival of an application.~~

Rule 15

*Details Concerning ~~Restoration of Rights~~ Re-instatement of Application or Patent
After a Finding of Due Care by the Office Under Article 15*

(1) [*Time Limit Under Article 15(1)(i)*] The time limits for making a request, and for complying with the requirements, under Article 15(1)(i) shall be the shorter of the following:

(i) not less than two months from the date of the removal of the cause of the ~~on which the requesting party was notified by the Office that the application had been refused or considered withdrawn or abandoned, or that the patent had been revoked, invalidated or considered lapsed or terminated, following failure to comply with the time limit concerned;~~

(ii) not less than [six] [12] months from the date of expiration of the time limit for the action in question.

(1bis) [Exceptions Under Article 15(2)] Rule 14(1ter)(b) shall apply, mutatis mutantis, to requests for the restoration of rights.

(2) [*Requests Filed on Paper or in Electronic Form or by Other Means*] Rule 3(1) to (4) shall apply, *mutatis mutandis*, ~~to requests for the restoration of rights~~ where the request concerns the re-instatement of an application or patent after a finding of due care by the Office.

[End of document]