

STUDY REGARDING THE INTERFACE BETWEEN THE DRAFT PATENT LAW TREATY AND THE PATENT COOPERATION TREATY

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Introduction

This Study is based on the draft Patent Law Treaty and draft Regulations ("PLT") contained in document SCP/2/3, and the Patent Cooperation Treaty ("PCT") as done at Washington on June 19, 1970, amended on September 28, 1979, and modified on February 3, 1984, the Regulations under the PCT, as in force from July 1, 1998, and the Administrative Instructions under the PCT, as in force from July 1, 1998.

In accordance with paragraph (1)(a) of the Terms of Reference, this Study identifies, for each Article and Rule of the draft PLT, all provisions of the PCT (including the Regulations and Administrative Instructions) which are incorporated by reference into the draft PLT by the provision in question, or which interface in any other way with the draft PLT provision in question, and explains the implications of such incorporation by reference or other interface. In accordance with paragraphs (1)(b) and (c) of the Terms of Reference, it also considers which provisions of the draft PLT might, in light of the PCT experience, be transferred from the Articles to the Regulations and proposes any additional text, or modifications of existing text, in the draft PLT that might improve the interface between the PLT and the PCT.

Annex 1 contains a Summary of the recommendations contained in this Study. Annex 2 contains a list of provisions under the PCT that, in the opinion of the authors of this Study, are incorporated by reference into the PLT, under PLT Article 5(1)(a), to the extent that they relate to the form and contents of the application. That Annex also contains a list of provisions under the PCT in respect of which the authors raise the question whether, or the extent to which, they relate to the form and contents of the application, and whether they should therefore be considered as incorporated into the PLT by reference. Annex 3 contains draft texts, for consideration by the Standing Committee, of Articles and Rules of the draft PLT modified in accordance with these proposals are contained in this Study.

In accordance with the usage in the PLT, references in this Study to the PCT are to be construed as references to the provisions of the PCT itself, the Regulations under the PCT or the Administrative Instructions under the PCT. Similarly, references in this Study to the PLT are to be construed as references to the provisions of the PLT itself or the Regulations under the PLT.

Article 1
(Abbreviated Expressions)

1.01 *Item (i)*. This item defines the term “Office”. The difference between this definition and the definition of “national Office” under PCT Article 2(xii) reflects the following differences between the PLT and PCT:

- an intergovernmental organization may be party to the PLT but not to the PCT;
- the PLT may apply to an Office which does not grant patents itself but does administer procedures in respect of granted patents, for example, the recordal of a change of owner, although such patents are granted on its behalf by another Office (see Note 1.01 in document SCP/2/4).

1.02 *Item (ii)*. As regards the definition of the term “application” in this item, reference is made to the definition, under Article 2(1), of the applications to which the Treaty and Regulations apply (see paragraphs 2.01 to 2.04).

1.03 *Item (iii)*. As regards the definition of the term “patent” in this item, reference is made to the definition, under Article 2(2), of the patents to which the Treaty and Regulations apply (see paragraph 2.05).

1.04 *Item (iv)*. The term “person” which is defined in this item is not used in the PCT.

1.05 *Item (v)*. The term “communication” which is defined in this item is not used in the PCT. However, for greater clarity, it is recommended that the Standing Committee on the Law of Patents (the “Standing Committee”) consider whether the definition under item (v) should be modified to include references to “document” and “correspondence” (which terms are used in PCT Rule 89*bis*.2).

1.06 *Items (vi) and (vii)*. The terms “records of the Office” and “recordal” which are defined in these items are not used in the PCT.

1.07 *Item (viii)*. The definition of “applicant” in this item corresponds to the reference under PCT Rule 18.4(c) to the question of “who is qualified (inventor, owner of the invention, or other applicant) to file an application”. In contrast to PCT Rule 2.1, the term “applicant” as defined in item (viii) is not construed in the PLT as meaning also the agent or common representative of the applicant.

1.08 *Item (ix)*. The term “owner” which is defined in this item is not used in the PCT

1.09 *Item (x)*. The term “representative” as defined in this item is broader than the term “agent” as defined in PCT Rule 2.2. In particular, it includes a representative who is not registered as an agent, and a “common representative” as defined in PCT Rule 2.2*bis*.

1.10 *Item (xi)*. The definition of the term “signature” in this item is broader than the definition of that term under PCT Rule 2.3 which is restricted to the use of a seal in place of a signature.

1.11 *Item (xii)*. The term “a language accepted by the Office” which is defined in this item is analogous to the term “any language which the receiving Office accepts” in PCT Rule 12.1(a).

1.12 *Item (xiii)*. The term “translation” which is defined in this item is not defined in the PCT. Instead, the language of the translation is prescribed in each provision concerned, as, for example, under PCT Rule 49.1(ii).

1.13 *Item (xiv)*. The term “procedure before the Office” which is defined in this item is not used in the PCT.

1.14 *Item (xv)*. The PCT contains no counterpart to this item regarding the use of singular and plural words and masculine pronouns.

1.15 *Item (xvi)*. The abbreviated term “Paris Convention” is not used in the PCT (see, for example, PCT Article 8(1)).

1.16 *Item (xvii)*. The effect of this definition of the term “Patent Cooperation Treaty” is that where any provision of the PCT which applies under the PLT is amended or modified, that amendment or modification will also apply under the PLT.

1.17 *Applicable Law*. The term “applicable law” is used in PLT Article 6(1)(a)(i) and 9(2) and Rule 19(1) in an analogous sense to the term “national law” which is defined in PCT Article 2(x). However, since there would appear to be no real doubt as to what is meant, there would appear to be no need for this term to be defined. Also, since, in the case of a regional application or patent, the “applicable law” could be either regional law or national law, depending on the scope of the regional treaty concerned, any such definition would be unduly complicated.

1.18 *Priority date*. It is to be noted that a definition of the term “priority date” for the purpose of computing time limits, corresponding to the definition under PCT Rule 2(xi), is not required in PLT Article 1 since that term is not used in the PLT.

Article 2

(Applications and Patents to Which the Treaty Applies)

2.01 *Paragraph (1)(a), item (i) (as proposed by the International Bureau)*. In accordance with this item, the PLT applies to “applications for patents for invention which are filed with or for the Office of a Contracting Party and which are types of applications that can be filed as international applications under the PCT”. As explained in document SCP/2/4, Note 2.04, the term “applications for patents for invention” is to be construed in the same sense as that term in PCT Article 2(1)(i) and, therefore, does not include those titles that are listed under that Article as alternatives to “applications for patents for invention”.

2.02 *Item (ii) (as proposed by the International Bureau)*. This item is required because, at least at present, a divisional application is not a kind of application that can be filed as an international application under the PCT.

2.03 Paragraph (1)(b), item (i). This item applies the provisions of the PLT, in particular Article 12 and Rule 14, to the time limits for entry of international applications into the “national phase” under PCT Articles 22 and 39(1), except that in the event of any conflict, the PCT would prevail. The time limits concerned are the expirations of the periods referred to in PCT Articles 22(1) and 39(1)(a) and the time limits referred to in PCT Articles 22(2) and (3) and 39(1)(b) and PCT Rules 49 and 76. However, there is no apparent conflict between the PLT and any of these provisions under the PCT. It is to be noted that the provisions of PLT Article 10 and 11, which relate only to time limits fixed by the Office, will not apply to these time limits under the PCT.

2.04 Item (ii). This item applies the provisions of the PLT to international applications after the date of entry into the “national phase” following compliance with the requirements of PCT Article 22 or 39(1), except that in the case of any conflict the PCT would prevail. For greater precision, it is recommended that the Standing Committee consider whether the decisive date for the application of the PLT should be modified to “the date on which processing or examination of the international application may start in the Office under PCT Article 23 or 40”. The provisions under the PCT which apply after the commencement of the national phase are:

- the review by designated Offices under PCT Article 25 and Rule 51;
- the opportunity to correct before designated Offices under PCT Article 26;
- national requirements under PCT Article 27 and Rule 51*bis*;
- time limits and other formal requirements in respect of amendment before designated and elected Offices under PCT Articles 28 and 41 and Rules 52 and 78;
- the effects of international publication under PCT Article 29;
- the confidential nature of the international application under PCT Articles 30 and 38;
- the excuse of a delay in meeting certain time limits under PCT Article 48(2);
- the opportunity to furnish the priority document under PCT Rule 17.1(c);
- rectification of errors made by the receiving Office or by the International Bureau under Rule 82*ter*

In addition, the following provisions of the PLT would apply to international applications after the date of entry into the “national phase”:

- the extension of a time limit fixed by the Office under PLT Article 10;
- continued processing and re-instatement of rights without a finding of due care by the Office under PLT Article 11;

- re-instatement of rights after a finding of due care or unintentionality by the Office under PLT Article 12;
- re-instatement of right of priority following failure to furnish a copy of an earlier application under PLT Article 13(3);
- the request for recordal of change in name or address under PLT Rule 16;
- the request for recordal of change in applicant under PLT Rule 17;
- the request for recordal of a licensing agreement or security interest under PLT Rule 18;
- the request for recordal of correction of a mistake under PLT Rule 19.

However, there is no apparent conflict between the PLT and any of these provisions under the PCT.

2.05 Paragraph (2). In accordance with this paragraph, the PLT applies to “patents for invention which have been granted with effect for a Contracting Party”. The term “patents for invention” is used in this paragraph in the same sense as that term in PCT Article 2(ii). It therefore does not include those titles that are listed in that Article of the PCT as alternatives to “patents for invention”. It covers national and regional patents for invention, including patents for invention granted on international applications.

2.06 Further Modification of Article 2. For further consistency with the PCT, it is recommended that the Standing Committee consider whether Article 2(1) and (2) should be modified to include “applications for patents of addition” and “patents of addition,” respectively. Such modification would not necessitate consequential modification elsewhere in the Treaty or Regulations. In particular, the identification of the parent application or parent grant could be required under PLT Article 5(1), pursuant to PCT Rule 4.13.

2.07 A draft text, for consideration by the Standing Committee, of Article 2 incorporating the modifications referred to in paragraphs 2.04 and 2.06 is included in Annex 3.

Article 3 *(National Security)*

3.01 A similar provision to Article 3, in respect of measures deemed necessary for the preservation of national security, is contained in PCT Article 27(8) and Rule 22.1(a) (which in essence implements PCT Article 27(8) by stating that, for reasons of national security, an international application does not have to be treated as such, thus relieving the receiving Office of all its obligations under the PCT in relation to that international application). It is to be noted that the wording proposed in Article 3 is modeled after that in Article 73 of the TRIPS Agreement.

3.02 The further provisions contained in PCT Article 27(8) which permit a Contracting State “to limit, for the protection of the general economic interests of that State, the right of its own nationals to file international applications,” are not relevant to the PLT.

Article 4
(Filing Date)

4.01 Paragraph (1)(a), chapeau. The requirement in this provision that the Office accept the filing of applications on paper corresponds to the requirement in respect of international applications under PCT Rule 89bis 1(a). The “other means permitted by the Office” for the filing of applications referred to in this provision are prescribed, in respect of communications generally, under PLT Article 7(1) and Rule 8. PLT Rule 8 incorporates, by reference, the requirements applicable under the PCT in relation to:

- communications filed in electronic form or by electronic means;
- communications filed by telegraph, teleprinter, telefacsimile or other like means;
- copies, filed in electronic form or by electronic means, of communications filed on paper.

4.02 Item (i). The requirement under this item that, for the purposes of the filing date, the application contain “an express or implicit indication to the effect that the elements are intended to be an application” is more favorable from the viewpoint of applicants than the corresponding requirement under PCT Article 11(1)(iii)(a) that the international application contain “an indication that it is intended as an international application”. This was known to the Standing Committee when adopting this item.

4.03 Item (ii). The requirement under this item that, for the purposes of the filing date, the application contain “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office” is more favorable from the viewpoint of applicants than the corresponding requirement under PCT Article 11(1)(iii)(c) that the international application contain “the name of the applicant, as prescribed,” that is the name of the applicant is established in a way which allows his identity to be established, as prescribed in PCT Rule 20.4(b). This was known to the Standing Committee when adopting this item.

4.04 Item (iii). The requirement under this item that, for the purposes of the filing date, the application contain “a part which on the face of it appears to be a description” is the same as the requirement under PCT Article 11(1)(iii)(d).

4.05 Other Requirements for the Purposes of the Filing Date Under the PCT. A requirement corresponding to the requirement under PCT Article 11(1)(iii)(b) that the international application contain the designation of at least one Contracting State is not applicable to national applications. It has also has not been included in the PLT in respect of regional applications in the absence of any proposal to that effect in either the Standing Committee or the Committee of Experts on the Patent Law Treaty. In adopting Article 4(1)(a), the Standing

Committee expressly decided not to include, for the purposes of the filing date, a requirement, corresponding to the requirement under PCT Article 11(1)(iii)(e), that the international application contain “a part which on the face of it appears to be a claim or claims”.

4.06 Paragraph (1)(b). This provision, which permits, but does not oblige, a Contracting Party to accept, for the purposes of the filing date, a drawing as the “part which on the face of it appears to be a description,” has no counterpart under the PCT. This was known to the Standing Committee when adopting this provision.

4.07 Paragraph (2)(a). The requirement under this provision that the indications concerning the application and the applicant under paragraph (1)(a), items (i) and (ii) be in “a language accepted by the Office” is, *prima facie*, consistent with the requirement under PCT Article 11(1)(ii) that the international application is in a “prescribed language”. However, in the case of an international application, the indications concerned are contained in the request which, under PCT Rule 12.1(c), shall be filed in a language which is both a language accepted by the receiving Office and a language of publication; where the request does not comply with this requirement, the filing date is maintained if a translation is filed under PCT Rule 26.3ter(c). In contrast, under the PLT the filing date would be the date of receipt of that translation in accordance with paragraph (4)(a). Accordingly, paragraph (2)(a) is less favorable in this respect, from the viewpoint of applicants, than the PCT Regulations.

4.08 Paragraph (2)(b). The requirement under this provision that, for the purposes of the filing date, the “part which on the face of it appears to be a description” referred to in paragraph (1)(a), item (iii) may be in any language, is more favorable from the viewpoint of applicants than the requirement under PCT Rule 20.4(c) that the said part be in a language accepted by the receiving Office. This was known to the Standing Committee when adopting this provision.

4.09 Paragraph (3). The requirement under this paragraph that the Office shall [promptly] [as soon as possible] notify the applicant of any requirement under paragraphs (1) and (2) not complied with, corresponds to the requirement under PCT Rule 11(2)(a) that the receiving Office “invite the applicant to file the required correction,” which invitation, under PCT Rule 20.6, must be mailed promptly and specify the requirement not complied with. PCT Rule 20.6 further requires the receiving Office to fix a time limit (of between 10 days and one month) for filing the correction and to notify the applicant if that time limit expires after the end of any priority period. In accordance with the PCT and also with PLT Articles 5(6) and 7(5), it is recommended that the Standing Committee consider whether Article 4(3) should be modified to give the applicant the opportunity to comply with any requirement which is not complied with, and to make observations, within a time limit prescribed in the Regulations. Draft texts, for consideration by the Standing Committee, of PLT Article 4(3) modified in this respect, and of Rule 2 modified to prescribe the new time limit referred to in that Article, are included in Annex 3.

4.10 Paragraph (4)(a). This provision, which regulates the filing date in the case of the subsequent compliance with the requirements referred to in paragraphs (1) and (2), corresponds to PCT Article 11(2)(b) which provides that the receiving Office shall accord, as the international filing date, the date of receipt of the required correction.

4.11 Paragraph (4)(b). The sanction under this provision that, in the case of non-compliance with the requirements referred to in paragraphs (1) and (2), “the application shall be regarded

as not having been filed,” corresponds to the sanction under PCT Rule 20.7 that the “application is not and will not be treated as an international application”. PCT Rule 20.7 also requires that the receiving Office promptly notify the applicant of that sanction and indicate the reasons therefor. It is recommended that, for consistency with that Rule and for the avoidance of doubt on the part of the applicant as to the sanction applied, the Standing Committee consider whether paragraph (4)(b) should be modified to provide for such notification. A draft text, for consideration by the Standing Committee, of paragraph (4)(b) modified in this respect is included in Annex 3.

4.12 It is to be noted that the PLT contains no provisions corresponding to PCT Article 14(4) and Rule 29.4 which provide for an international application to be considered withdrawn where, after having accorded a filing date, the receiving Office finds that any of the requirements for according a filing date under PCT Article 11(1) are not complied with. Instead, the applicant would be notified under PLT Article 4(3) of the non-compliance with the filing date requirement(s) concerned, and given the opportunity to comply subsequently under PLT Article 4(4).

4.13 *Paragraph (5)(a).* This paragraph provides for the applicant to be notified where the Office determines that a part of the description or a drawing is missing from the application. As far as it relates to missing drawings, this corresponds to the provisions in respect of missing drawings under PCT Article 14(2). However the PCT contains no corresponding provision for notification in respect of a missing part of the description (that is where part, but not all, of the “part which on the face of it appears to be a description” is missing).

4.14 *Paragraph (5)(b), first sentence.* This sentence provides for a missing part of the description or a missing drawing to be included in the application if it is filed within the time limit prescribed in the Regulations. This corresponds to the provisions in respect of missing drawings under PCT Article 14(2) and in respect of sheets filed on different days under PCT Rule 20.2.

4.15 *Paragraph (5)(b), second sentence.* This sentence provides for a reference to a missing drawing to be considered non-existent if it is not filed within the time limit prescribed in the Regulations. This corresponds to the provisions in respect of missing drawings under PCT Article 14(2).

4.16 *Paragraph (5)(c) to (e).* The PCT contains no provisions corresponding to these paragraphs which provide, in certain situations, for the original date of receipt of elements of the application to be accorded as the filing date where a missing drawing or missing part of the description is furnished after that date. It is recommended that the Standing Committee consider whether these provisions should be transferred to the Regulations, with consequential modification of Rule 2. Draft texts, for consideration by the Standing Committee, of PLT Rule 2 modified in this respect, and of paragraph (5)(b) modified to provide authority for that modified Rule, are included in Annex 3.

4.17 *Paragraph (6).* The PCT contains no provisions corresponding to the provision in this paragraph for the description and drawings of an application to be replaced by a reference to a previously filed application for the purposes of the filing date.

4.18 *Paragraph (7).* Since the PCT does not, at least at present, provide for an international application to be treated as a divisional application, it contains no provision corresponding to

paragraph (7), item (i). In addition, although PCT Rule 4.14 provides for an international application to be treated as an application for a continuation or continuation-in-part of an earlier application, the PCT contains no express provisions on the filing date of such applications corresponding to item (ii). It is recommended that the Standing Committee consider whether this paragraph should be modified to accommodate the possibility of providing, in the Regulations, for any further types of applications having special filing date requirements that may be filed as international applications, following any future amendment of the PCT or PCT regulations. A draft text, for consideration by the Standing Committee, of paragraph (7) modified to provide authority for such Regulations is included in Annex 3.

Article 5
(Application)

5.01 Paragraph (1). This paragraph provides that, except where otherwise provided for by the PLT, the maximum requirements which may be prescribed as to the form or contents of an application are the requirements as to the form and contents of an international application applicable under the PCT. As explained in document SCP/2/4, Note 5.01:

“The provision that no Contracting Party may require compliance with any requirement relating to the form or contents of an application different from or additional to those which are provided for in respect of international applications under the PCT, which is modeled after PCT Article 27(1), would mean that a Contracting Party could not impose stricter requirements in such respects than those under the PCT. The understanding that a Contracting Party would be free to provide for requirements which, from the viewpoint of applicants, are more favorable than the requirements under the PCT, is modeled after PCT Article 27(4).”

Also, as explained in document SCP/2/4, Note 5.03:

“The expression “form or contents of an application” is to be construed in the same way as the expression in PCT Article 27(1).”

PCT Article 27(1) reads:

“(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.”

The requirements relating to the form or contents of an application which are “otherwise provided for” under the PLT are those under PLT Articles 5(2) to (6), 6, 7 and 13(1), and the Regulations under those Articles.

5.02 Annex 2 contains a list of provisions under the PCT that, in the opinion of the authors of this Study, are incorporated by reference into the PLT, under PLT Article 5(1)(a), to the extent that they relate to the form and contents of the application; that is a list of the requirements under the PCT in respect of which, under PLT Article 5(1), a Contracting Party may not apply different or additional requirements that are less favorable from the viewpoint

of the applicant. That Annex also contains a list of certain provisions under the PCT that, in the opinion of those authors, are not incorporated into the PLT by reference under PLT Article 5(1); that is a list of certain requirements under the PCT in respect of which a Contracting Party may apply different or additional requirements that are less favorable from the viewpoint of the applicant.

5.03 Note 5.04 in document SCP/2/4 sets out certain information, indications, etc., that are stated in that Note not to be requirements as to the “form and contents of the application” for the purposes of paragraph (1). It is recommended that the Standing Committee consider whether, for the avoidance of doubt in this matter, a new Rule should be included in the Regulations expressly permitting such information, indications, etc. It is also recommended that the Standing Committee consider whether that new Rule should additionally provide for a Contracting Party to require that the application contain:

- in the case of a divisional application, the number of the parent application;
- an oath or declaration by the inventor (as required by the Delegation of the United States of America);
- where the application was prepared with the assistance of an invention marketing company, a statement to that effect, accompanied by the name and address of that company (as proposed by the Delegation of the United States of America.- see document SCP/1/11 at paragraph 86);
- requirements as far as the spacing of the typing and the size of the characters of text matter are concerned in respect of languages to which the requirements in these respects under PCT Rule 11.9 do not apply.

Draft texts, for consideration by the Standing Committee, of a new Rule *2bis*, and of Article 5(1) modified to provide authority for that new Rule, are included in Annex 3.

5.04 Paragraph (2). This paragraph provides that the contents of an application which correspond to “the mandatory contents of the request of an international application” under the PCT be presented on a prescribed request Form or format or on a request Form which corresponds to the PCT request Form. The “mandatory contents of the request of an international application,” as prescribed in PCT Rule 4.1(a) and (b), are listed in document SCP/2/4, paragraph 5.07. Reference is also made to the recommendation in respect of the modifications of the PCT request Form proposed in paragraph R3.01 below.

5.05 Paragraph (3). The requirement in this paragraph that the application be in “a language accepted by the Office” corresponds to the requirement under PCT Article 3(4)(i) that the international application shall “be in a prescribed language,” namely that prescribed in PCT Rule 12.1. However, if, pursuant to the recommendation under paragraph 7.13 below, PLT Article 7 is modified to include a requirement as to the language of communications, that requirement would not need to be repeated in Article 5(3) since the term “communications,” as defined in PLT Article 1(v), includes “applications”. PLT Article 7 would then also cover the language of changes in an application or patent, as in the case of changes to the international application under PCT Rule 12.2.

5.06 PCT Rule 26.3~~ter~~(a) and (c) provide for the translation of the text matter of drawings and the request where they are not in the required language. Under the PLT, as explained in document SCP/2/4, Notes 4.13 to 4.15, where the “part which on the face of it appears to be a description”, any textual matter incorporated in the drawings or the claims are not in a language accepted by the Office, it is necessary that a translation be filed. This requirement for a translation is not clearly covered by paragraph (3) and would not be covered by the modification of PLT Article 7 referred to in paragraph 5.05 above. It is therefore recommended that the Standing Committee should consider whether Article 5(3) should be modified to provide expressly for the filing of a translation of any part of the application that is not in a language accepted by the Office. It is also recommended that, for consistency with the existing requirement in respect of translations of priority documents under paragraph (6), a Contracting Party should only be permitted to require verification of that translation of part of an application where the Office may reasonably doubt the veracity of that translation. This contrasts with PCT Rule 51~~bis~~.1(d) which permits the verification of translations in all cases. In addition, it is recommended that the Standing Committee consider whether paragraph (3) should be further modified to provide for the transliteration of any word or words that are not in the alphabet of a language accepted by the Office, for example, the name and address of an applicant or the name of a country, as provided under PCT Rule 4.16. A draft text, for consideration by the Standing Committee, of a Article 5(3) modified in this respect is included in Annex 3.

5.07 Paragraph (4). The provision for fees under this paragraph corresponds to the requirement under PCT Article 3(4)(iv) that the international application shall “be subject to the required fees”.

5.08 Paragraph (5). The requirements in respect of the furnishing of priority documents under paragraph (5)(a) and (b) correspond generally to the requirements under PCT Article 8 and Rule 17.1. However, whereas paragraph (5)(a) and (b) permits any Contracting Party which so wishes to dispense with the requirement for certification of the copy of the earlier application, certification is required in all cases under PCT Rule 17.1. In addition, PCT Rule 17.1 contains no express requirement for certification of the filing date which may be required under paragraph (5)(b) in accordance with Article 4D(3) of the Paris Convention.

5.09 There is no counterpart under PCT Article 8(2)(a) and Rule 17 to the provisions under paragraph (5)(c) and (d) which prescribe situations in which a copy, translation or the certification of the filing date, of an earlier application cannot be required by a Contracting Party. These provisions are, therefore, more favorable, from the viewpoint of applicants, than the requirements under the PCT. This was known to the Standing Committee when adopting those provisions.

5.10 For consistency with the PCT, it is recommended that the Standing Committee consider whether the specific requirements under paragraph (5)(a) to (d) should be transferred to the Regulations. Draft texts, for consideration by the Standing Committee, of Rule 4 modified in this respect and including the provisions of Rule 6(1), and of paragraph (5) modified to provide authority for that Rule, are included in Annex 3.

5.11 Paragraph (6). The requirements under this paragraph, which restrict the situations in which evidence may be required, are more favorable, from the viewpoint of applicants, than the national requirements allowed, at present, under PCT Article 27(2)(ii) and Rule 51~~bis~~.1 which permit proof of allegations or statements in the international application to be required

irrespective of whether or not the Office may reasonably doubt the veracity of such allegations or statements. However, amendments to align PCT Rules 4 and 51*bis*.1 with the draft PLT in this respect are under consideration. A draft text, for consideration by the Standing Committee, of paragraph (6), modified in consequence of the modification to paragraph (3) proposed in paragraph 5.06 above, is included in Annex 3.

5.12 Paragraph (7). This paragraph, which provides for notification in the case of non-compliance with requirements under Article 5, corresponds to the provisions under PCT Article 14(1)(b) and Rules 16*bis*.1(a) and (b) and 26.1(a) in respect of an international application.

5.13 Paragraph (8)(a). This provision, which prescribes the sanctions that may be applied in the case of non-compliance with requirements under Article 5, corresponds to the provisions under PCT Article 14(1)(b) and Rules 16*bis*.1(c) and 26.5.

5.14 Paragraph (8)(b). This provision, which prescribes the sanctions that may be applied in the case of non-compliance with requirements in respect of a priority claim and is required for consistency with Article 4D(4) of the Paris Convention, is also consistent with PCT Rule 17.1(c).

Article 6 *(Representation)*

6.01 Paragraph (1)(a). This provision, which permits a Contracting Party to require that an appointed representative have the right to practice before the Office and/or provide an address on its territory, corresponds to the provisions under PCT Article 27(7) and Rules 51*bis*.1(b) and 90.1(a) to (c). It is to be noted that, under the PLT, the right to appoint a sub-agent or to appoint one of two or more applicants as a common representative, as under PCT Rules 90.1(d) and 90.2 respectively, would be matters to be determined under the applicable law in accordance with paragraph (1)(a), item (i).

6.02 Paragraph (1)(b). This provision, which provides that an act by or in relation to a representative shall have the effect of an act by or in relation to the applicant, corresponds to the provisions in respect of international applications under PCT Rule 90.3(a) and (c). The matter of whether any one of two or more agents could act independently (as provided for in PCT Rule 90.3(b)) would depend on the terms of the appointment of that agent under PLT Article 6(3).

6.03 Paragraph (1)(c). This provision permits a Contracting Party to provide that a representative may not sign on behalf of an inventor. The PCT is silent as to whether a declaration or oath by the inventor referred to in PCT Rule 51*bis*.1(a)(iii) may be signed by an agent. The International Bureau has already proposed to the Standing Committee that paragraph (1)(c) be replaced by a reservation to the same effect in the final provisions.

6.04 Paragraph (2). The general provision under this paragraph that “A Contracting Party may require that an applicant, owner or other interested party appoint a representative for the purposes of any procedure before the Office” corresponds to the provision under

PCT Article 27(7) and Rule 51*bis*.1(b) that the designated Office may apply the national law as far as it relates to any requirement that the applicant be represented by an agent. The PCT does not regulate the payment of maintenance fees referred to in item (i), and contains no exceptions as provided for under items (ii) and (iii).

6.05 Paragraph (3)(a). The provision under this paragraph for the appointment of a representative in either a separate communication (a “power of attorney”) or the application request Form or format, corresponds to the provisions under PCT Rule 90.4. For consistency with that Rule, it is recommended that the Standing Committee consider whether this paragraph, together with paragraphs (3)(b) and (4) to (6), should be transferred to the Regulations. Draft texts, for consideration by the Standing Committee, of Rule 7 modified in this respect, and of Article 6(3) modified to provide authority for that modification, are included in Annex 3.

6.06 Paragraph (3)(b). The provision under this paragraph for a power of attorney relating to more than one application or patent corresponds to the provisions in respect of a “general power of attorney” under PCT Rule 90.5. Reference is made to the recommendation in respect of this paragraph in paragraph 6.05 above.

6.07 Paragraph (4). This paragraph permits a Contracting Party to require that the appointment of a representative in a separate communication be presented on a power of attorney Form or format, either as prescribed by the Contracting Party or as prescribed in the Regulations. The PCT does not prescribe a Form or format for the separate power of attorney referred to in PCT Rule 90.4(a). Reference is made to the recommendation in paragraph 6.05 above.

6.08 Paragraph (5). This paragraph provides for a power of attorney that is not in a language accepted by the Office to be accompanied by a translation. In as far as it permits a power of attorney to be filed in a language which is not accepted by the Office, this paragraph would, *prima facie*, appear more favorable, from the viewpoint of applicants, than the corresponding provisions under PCT Rules 90.4 and 92.2, which do not appear to provide for this possibility. Reference is made to the recommendation in paragraph 6.05 above.

6.09 Paragraph (6). There is no counterpart under the PCT to this paragraph, which permits the Office to require evidence where it may reasonably doubt the veracity of any information in the appointment of a representative. Reference is made to the recommendation in paragraph 6.05 above.

6.10 Paragraph (7). The prohibition on further requirements under this paragraph would apply, under PCT Article 27(7), to the national law relating to representatives appointed in respect of international applications.

6.11 Paragraph (8). There is no provision under the PCT corresponding to this paragraph which provides for notification in the case of non-compliance with the requirements under Article 6.

6.12 Paragraph (9). This paragraph provides for the application of such sanction as is provided for in the national law in the case of non-compliance with the requirements under PLT Article 6. PCT Rule 90.4(c) provides specifically for a power of attorney to be considered non-existent if it contains a defect that is not corrected. However, that Rule does

not expressly provide for the receiving Office to prescribe a time limit for correction of the defect.

Article 7
(Communications)

7.01 Paragraph (1). The PCT itself contains no provision corresponding to the general provision under this paragraph for Regulations in respect of the form, format and means of filing of communications. However, PCT Rules 82, 89*bis*, 89*ter*, 92.1, 92.3 and 92.4 prescribe specific requirements in respect of the filing and transmission of international applications and other documents, which requirements are incorporated into the PLT by reference under PLT Rule 8.

7.02 Paragraph (2)(a). The PCT itself contains no provision corresponding to the provision under this paragraph for Regulations in respect of the signature of communications. However, PCT Rule 2.3 expressly permits the use of a seal instead of a signature. Paragraph (2)(a) does not prescribe when a signature is required and is, therefore, in the case of letters, more favorable from the viewpoint of applicants than the requirement in this respect under PCT Rule 92.1(a).

7.03 Paragraph (2)(b) and (c). These provisions, which are intended to reduce the burden on applicants, owners and other interested persons in respect of the certification and other proof of signatures, have no counterpart in the PCT.

7.04 Paragraph (3)(a) and (b)(iii). There is, at present, no counterpart in the PCT to the requirement under these provisions for the indication, in communications, of the (official) reference number of an applicant or agent. However, modification of the PCT Regulations to provide for such reference numbers to be included in the international application request is under consideration by the Ad Hoc Advisory Group on Proposed Amendments of the PCT Regulations. Reference is also made to paragraph 7.09 below.

7.05 Paragraph (3)(b), item (i). There is no provision under the PCT itself, corresponding to the requirements under this provision, that would permit a Contracting Party to require that the name and address of the representative be included in all communications. Although PCT Rule 4.7 requires that the PCT request shall state the agent's name and address, there is no such requirement under the PCT in respect of other communications. Reference is also made to paragraph 7.09 below.

7.06 Item (ii). There is no express requirement under the PCT, corresponding to the requirement under this item, that an application or other communication contain a reference to the power of attorney, or other communication in which the appointment of the representative is or was effected. Such a reference may be required in the case of, for example, a single power of attorney that relates to all existing and future applications or patents under paragraph (4)(b). Reference is also made to paragraph 7.09 below.

7.07 Number of Application or Patent. It is recommended that the Standing Committee consider whether PLT Article 7(3) (or Rule 10 as proposed in paragraph 7.09 below), should

be modified to include a further provision, corresponding to the requirement under PCT Rule 92.1(a), permitting a Contracting Party to require that a communication indicate the number of the application or patent to which it relates. Specific requirements in this respect would then not be necessary under PLT Rules 9(1) to 12(1).

7.08 Other Interested Person. It is recommended that the Standing Committee consider whether PLT Article 7(3)(a) (or Rule 10 as proposed in paragraph 7.09 below), should be modified to include a further provision, corresponding to the requirement under PCT Rule 92.1(a), permitting a Contracting Party to require that a communication indicate the number or other indication under which an “other interested person” is registered with the Office.

7.09 Transfer of Paragraph (3) to the Regulations. In order to simplify the PLT and to provide for the possibility for future modifications, it is recommended that the Standing Committee consider whether the provisions of paragraph (3) should be transferred to Rule 10 of the Regulations. Draft texts, for consideration by the Standing Committee, of Rule 10 incorporating the modifications proposed in paragraphs 7.07 and 7.08, and of paragraph (3) modified to provide authority for such new Rule, are included in Annex 3.

7.10 Paragraph (4). There are no express requirements under the PCT, corresponding to the requirements under items (i) and (ii) of this paragraph, that an application or other communication contain an express indication of an address for correspondence or an address for legal service. Instead, under the national requirements permitted under PCT Article 27(7) and Rule 51*bis*.1(b)(i), the Office may require that “the applicant be represented by an agent having the right to represent applicants before that Office and/or have an address in the designated State for the purpose of receiving notifications”. Neither the PLT Regulations nor the PCT contain requirements for any other address as provided for under item (iii).

7.11 Paragraphs (5) and (6)(a). These paragraphs, which provide for notification, and the application of a sanction, in the case of non-compliance with the requirements of PLT Article 7, correspond to specific provisions under the PCT, in particular, Article 14(1)(b) and Rules 26.1(a) and 26.2 (in respect of the international application) and Rule 92.1(b) (in respect of correspondence).

7.12 Paragraph (6)(b). This paragraph provides for notification, and the application of a sanction, where a communications does not indicate an (official) registration number or an address for correspondence or legal service required under PLT Article 7(3) or (4), respectively (see paragraphs 7.04 and 7.07 above). As there are no requirements in these respects under the PCT, there is, accordingly, no provision under the PCT corresponding to paragraph (6)(b). It is recommended that the Standing Committee consider transferring this paragraph to the Regulations together with the provisions of paragraph (3).

7.13 Language of Communications. It is also recommended that the Standing Committee consider the whether PLT Article 7 should be modified to include a further provision, corresponding to that in PCT Rule 92.2, permitting a Contracting Party to require that a communication be in a prescribed language. A draft text, for consideration by the Standing Committee, of a new paragraph (1*bis*) providing for this is included in Annex 3.

Article 8
(Notifications)

8.01 Paragraph (1). The PCT contains no provision corresponding to this paragraph which prescribes what constitutes sufficient notification for the purposes of the PLT.

8.02 Paragraph (2). The PCT contains no provisions corresponding to this paragraph which provides that the absence of a notification, by the Office, of a failure to comply with any requirement under the PLT does relieve an applicant, owner or other interested person of the obligation to comply with that requirement.

8.03 Paragraph (3). There is no express provision under the PCT corresponding to this paragraph which provides that the absence of notification, by the Office, of non-compliance with any requirement does not relieve the applicant, owner or other interested person of the obligation to comply with that requirement. However, it would appear implicit that any obligation to comply with a requirement under the PCT remains applicable in the absence of an invitation to provide the required correction. One exception to this is that expressly provided under PCT Rule 92.1(c) in respect of the requirement for the signature of any paper, other than the international application itself, under PCT Rule 92.1(a). Another exception follows from PCT Article 14(4) where the receiving Office finds that any of the international filing date requirements under PCT Article 11(1)(i) to (iii) were not complied with; where no notification is sent under PCT Rule 29.4 within the time limit prescribed in PCT Rule 30, that non-compliance becomes irrelevant for the purposes of that filing date.

8.04 Transfer of Article 8 to the Regulations. Although the PCT contains no provisions which correspond directly to Article 8, provisions for notification are contained in PCT Rule 90 and 92*bis* which derive their authority from the general provision for Regulations under PCT Article 58. It is therefore recommended that the Standing Committee consider whether Article 8 should be transferred to the Regulations as a new Rule under Article 17(1)(a)(ii). A draft text, for consideration by the Standing Committee, of a new Rule 11*bis* is included in Annex 3.

Article 9
(Validity of Patent; Revocation)

9.01 The PCT contains no provisions in relation to the validity or revocation of patents. It therefore contains no provisions corresponding to PLT Article 6.

Article 10
(*Extension of a Time Limit Fixed by the Office*)

10.01 There is no general provision under the PCT for the extension, as of right, of a time limit fixed by the Office where such extension is requested prior to the expiration of that time limit, as provided for under PLT Article 10. However, PCT Rule 26.2 does provide for a receiving Office to extend the time limit it has fixed for correction at any time before a decision is taken and PCT Rule 66.2(d) that the International Preliminary Examining Authority may extend a time limit for reply to a written opinion if the applicant so requests before its expiration. Also, the provisions of PLT Article 10 will apply to any time limit fixed by an Office in respect of an international application, in accordance with PCT Article 48(2)(a) and Rule 82*bis*.1(ii) and (iii).

10.02 Paragraphs (1), (2) and (5). Paragraph (1) prescribes the requirements that a Contracting Party may apply in respect of a request for the extension of a time limit fixed by the Office under Article 10. Paragraph (2) provides for exceptions to the time limits to which Article 10 applies to be prescribed in the Regulations. Paragraph (5) provides for the requesting party to be given at least one opportunity to make observations on the intended refusal of a request for an extension of a time limit under paragraph (1).

10.03 Paragraph (3). This paragraph prescribes the language of the request under paragraph (1). It is recommended that the Standing Committee consider whether this paragraph should be deleted if Article 7 is modified to include a requirement in respect of the language of communications (see paragraph 7.13 above) since the term “communication,” as defined in Article 1(v), includes “requests”.

10.04 Paragraph (4). It is recommended that the Standing Committee consider whether, for consistency with the recommendation in respect of Article 11(5) (see paragraph 11.05 below) as well as for simplicity, instead of applying Article 5(4), *mutatis mutandis*, this paragraph should be modified to state that a Contracting Party may require that a fee be paid in respect of a request under paragraph (1). A draft text, for consideration by the Standing Committee, of paragraph (4) modified in this respect is included in Annex 3.

Article 11

(Continued Processing and Re-instatement of Rights Without a Finding of Due Care by the Office)

11.01 There is no provision, *per se*, under the PCT for continued processing or re-instatement of rights, without a finding of due care by the Office, where the applicant has failed to comply with a time limit fixed by the Office, as provided for under PLT Article 11. However, PCT Rule 26.2 does provide for a receiving Office to extend the time it has fixed for correction at any time before a decision is taken. PCT Rule 66.4*bis* requires the International Preliminary Examining Authority to take into account amendments and arguments received after the expiration of the time limit fixed in the invitation but before the examiner has begun to draw up an opinion or report. Also, the provisions of that Article would apply to any time limit fixed by an Office in respect of an international application, in accordance with PCT Article 48(2)(a) and Rules 82.2 and 82*bis*.1(ii) and (iii).

11.02 Paragraphs (1), (2) and (7). As regards paragraph (1), which prescribes the requirements that a Contracting Party may apply in respect of a request for continued processing or re-instatement of rights under Article 11, reference is made to the recommendation in respect of paragraph (3) (see paragraph 11.03 below). Paragraph (2) provides for exceptions to the time limits to which Article 11 applies to be prescribed in the Regulations. Paragraph (7) provides that the requesting party be given at least one opportunity to make observations on the intended refusal of a request for continued processing or re-instatement of rights under paragraph (1).

11.03 Paragraph (3). This paragraph permits a Contracting Party to require that a request referred to in Article 11(1) be presented on a prescribed Form or format. To simplify Article 11, it is recommended that the Standing Committee consider whether this paragraph should be transferred to the Regulations under Rule 13. It is also recommended that the Standing Committee consider whether the requirement for a signature under paragraph (1), item (i) should also be transferred to that Rule. Draft texts, for consideration by the Standing Committee, of a new provision under Rule 13, and of Article 11(1) modified to provide authority for such new provision, are included in Annex 3.

11.04 Paragraph (4). This paragraph prescribes the language of the request under paragraph (1). It is recommended that the Standing Committee consider whether this paragraph should be deleted if Article 7 is modified to include a requirement in respect of the language of communications (see paragraph 7.13 above) since the term “communication,” as defined in Article 1(v), includes “requests”.

11.05 Paragraph (5). It is recommended that the Standing Committee consider whether the provisions of paragraph (5)(b), which prescribes two circumstances in which no fee for a request under Article 11 may be required, should be transferred to the Regulations as a new provision under Rule 13. Draft texts, for consideration by the Standing Committee, of that new provision and of paragraph (5) modified to provide authority for that provision are included in Annex 3.

11.06 Paragraph (6). This paragraph provides for evidence where the Office may reasonably doubt the veracity of a statement prescribed in the Regulations. In the absence of any other reference to such “statement” in Article 11, it is recommended that the Standing Committee consider whether this paragraph should be transferred to the Regulations. A draft text, for consideration by the Standing Committee, of that new provision is included in Annex 3.

Article 12
(Re-instatement of Rights After a Finding of Due Care
or Unintentionality by the Office)

12.01 There is no general provision under the PCT for re-instatement of rights, after a finding of due care by the Office, where the applicant has failed to comply with a time limit, as provided under PLT Article 12. However, PCT Rule 82.1 does provide for a failure to meet a time limit to be excused, in certain cases, where the applicant proves to the satisfaction of the Office or intergovernmental organization concerned that the failure was due to delay or loss in the mail or an interruption in the mail service. The provisions of Article 12 would apply to any time limit fixed, or applicable, by an Office in respect of an international application, in accordance with PCT Article 48(2)(a) and Rules 82.2 and 82*bis*.1(ii) and (iii).

12.02 Paragraphs (1) to (7). Except as provided in paragraph 12.03, it is recommended that the Standing Committee consider, *mutatis mutandis*, the same recommendations in relation to these paragraphs as those proposed in relation to PLT Article 11 (see paragraphs 11.02 to 11.07 above).

12.03 Paragraph (1). It is recommended that the Standing Committee consider whether the requirements for a signature under item (i), and a statement of the grounds for the request under item (iv), should be transferred to Rule 14. It would not appear appropriate for item (ii) which provides for a time limit for making a request and complying with the missed time limit, item (iii), which defines the rights which may be re-instated under Article 12, or item (v), which provides for the finding of due care referred to in the title of Article 12, to be transferred to the Regulations.

12.04 Draft texts, for consideration by the Standing Committee, of Rule 14 modified in accordance with paragraphs 12.02 and 12.03, and of Article 12(1) modified to provide authority for those modifications, are included in Annex 3.

Article 13
(Addition and Restoration of Priority Claim)

13.01 Paragraph (1). This paragraph corresponds to the provisions in respect of the addition of priority claims under PCT Rule 26bis.1, which Rule also provides for the correction of priority claims. Since a priority claim is part of the contents of the application, requirements in respect of the addition and correction of a priority claim under PCT Rule 26bis.1 may be considered as requirements relating to the contents of the application under PLT Article 5(1) and are listed as such in Annex 2. It is therefore recommended that the Standing Committee consider whether paragraph (1) should be deleted since the requirements in relation to the correction and addition of a priority claim are already regulated by the incorporation by reference under PLT Article 5(1) of the requirements under PCT Rule 26bis.1. It is to be noted that PLT Rule 6(2)(c) already refers to “The time limit referred to in Article 5(5) for the correction of a priority claim”.

13.02 Paragraph (2). There is no provision under the PCT corresponding to the provision in this paragraph for the restoration of the right of priority where the failure to file the application claiming priority within the priority period occurred in spite of all due care or was unintentional. This was known to the Standing Committee when adopting this paragraph. In order to simplify Article 13, it is recommended that the Standing Committee consider whether the requirements under items (i) to (iv), together with the requirement for a signature in the chapeau of this paragraph, should be transferred to the Regulations.

13.03 Paragraph (3). There is no provision under the PCT corresponding to the provision in this paragraph for the restoration of the right of priority where a copy of the earlier application is not filed within the prescribed time limit. This was known to the Standing Committee when adopting this paragraph. Instead, PCT Rule 17.1 provides that a copy of the earlier application shall be considered to have been received on the last day of the time limit if it reaches the International Bureau after the expiration of the time limit but before the date of international publication. Also, where that copy is not furnished before the date of international publication, each national Office must give the applicant an opportunity to furnish it in the national phase. As in the case of paragraph (2), it is recommended that the Standing Committee consider whether the requirements under paragraph (3) should be transferred to the Regulations.

13.04 Paragraph (4). This paragraph permits a Contracting Party to require that a request referred to in paragraphs (1) to (3) be presented on a prescribed Form or format. As in the case of Article 11(3), (see paragraph 11.03 above), to simplify Article 13, it is recommended that the Standing Committee consider whether this paragraph should be transferred to the Regulations together with the requirements under paragraphs (2) and (3) (see paragraphs 13.02 and 13.03).

13.05 Modifications. Draft texts, for consideration by the Standing Committee, of Rule 15 incorporating the modifications proposed in paragraphs 13.02 to 13.04 above, and of Article 13 modified to provide authority for those modifications and as proposed in paragraph 13.02 above, are included in Annex 3.

13.06 Paragraph (5). This paragraph prescribes the language of the request under paragraph (1). It is recommended that the Standing Committee consider whether this

paragraph should be deleted if Article 7 is modified to include a requirement in respect of the language of communications (see paragraph 7.13 above) since the term “communication,” as defined in Article 1(v), includes “requests”.

13.07 Paragraph (6). As in the case of Article 10(4), it is recommended that the Standing Committee consider whether, for simplicity, paragraph (6) should be modified to state that a Contracting Party may require that a fee be paid in respect of a request under Article 13. A draft text, for consideration by the Standing Committee, of paragraph (6) modified in this respect is included in Annex 3.

13.08 Paragraph (7). There is no counterpart under the PCT to this paragraph, which provides for the requesting party to be given at least one opportunity to make observations on the intended refusal of a request under paragraphs (1) to (3).

Article 14 (Regulations)

14.01 Paragraph (1)(a). The Regulations provided under this provision correspond to those provided under PCT Article 58(1).

14.02 Paragraph (1)(b). The PCT itself does not expressly provide for Regulations for recordal of changes and correction of a mistake, as provided in this paragraph. Nevertheless, the PCT does contain Regulations, under the general provisions of PCT Article 58, in respect of the recording of changes in certain indications in the PCT request or the demand (PCT Rule 92*bis*) and the rectification of obvious errors (PCT Rule 91.1).

14.03 Paragraph (1)(c). The PCT itself does not expressly provide for Regulations for the establishment by the Assembly of PCT Forms and formats, corresponding to the provisions under this paragraph. Instead, PCT Forms for use by the applicant are specified in Section 102 of the PCT Administrative Instructions established under PCT Article 58(4) and Rule 89.1.

14.04 Paragraphs (2) and (3). These final provisions, which are contained in document SCP/2/5, are not included in this Study.

14.05 Paragraph (4). This provision, which provides that, in the case of conflict between the provisions of the Treaty and the Regulations, the former shall prevail, corresponds to PCT Article 58(5).

Rule 1 (Abbreviated Expressions)

R1.01 Paragraph (1). The definitions of the terms “Treaty” and “Article” in this paragraph correspond to the definitions of those terms in PCT Rule 1(1).

R1.02 Paragraph (2). There is no counterpart in the PCT Regulations to this paragraph which applies the definitions of abbreviated expressions in PLT Article 1 to the PLT Regulations.

Rule 2
(Details Concerning Filing date Under Article 4)

R2.01 Paragraph (1), item (i). This item prescribes a time limit, of not less than two months, for subsequent compliance under PLT Article 4(4)(b) with the filing date requirements under PLT Article 4(1) and (2), calculated from the date of notification of non-compliance. This time limit is more favorable, from the viewpoint of applicants, than the time limit of between 10 days and one month, prescribed under PCT Rule 20.2(a)(ii) and 20.6(b), for fulfilling the filing date requirements in respect of an international application under PCT Article 11(1).

R2.02 Item(ii). This item applies where a notification of non-compliance with the filing date requirements under PLT Article 4(1) and (2) has not been made because indications allowing the applicant to be contacted have not been furnished. It prescribes a time limit of not less than two months for subsequent compliance with those requirements under PLT Article 4(4)(b), calculated from the date on which one or more elements of the application were first received. This time limit is more favorable from the viewpoint of applicants than the corresponding time limit of 30 days under PCT Rule 20.2(a)(i) for fulfilling the filing date requirements in respect of an international application under PCT Article 11(1) where no invitation to correct was sent.

R2.03 Paragraph (2). This item prescribes a time limit of not less than two months for the filing of a missing part of the description or missing drawing under PLT Article 4(5)(b), calculated from the date of notification or, where a notification has not been made, from the date on which one or more elements of the application were first received. These time limits are more favorable, from the viewpoint of applicants, than the time limit, under PCT Rule 20.2(a)(iii) and 26.6(b), of 30 days from the date on which the incomplete papers were filed in respect of an international application. As noted in paragraph 4.12 above, the PCT contains no express provisions in respect of a missing part of the description; it therefore prescribes no time limits corresponding to the time limits under items (i) and (ii) for filing that missing part.

R2.04 Paragraph (3). As noted in paragraph 4.13 above, the PCT contains no provisions corresponding to PLT Article 4(5)(d). It therefore also contains no provisions corresponding to this paragraph.

R2.05 Paragraph (4). As noted in paragraph 4.17 above, the PCT contains no provisions corresponding to PLT Article 4(6). It therefore also contains no provisions corresponding to this paragraph.

R2.06 Modifications of Rule 2. Reference is made to the modifications of Rule 2 proposed in paragraphs 4.09, 4.16 and 4.18 above.

Rule 3
(*Modifications to the PCT Request Form*)

R3.01 The provisions of this Rule, which prescribes the modifications of the PCT request Form permitted under PLT Article 5(2)(b), are currently reserved pending this Study. The particulars of the PCT request Form are prescribed in Section 102 of the PCT Administrative Instructions under PCT Article 58(4) and Rule 89.1. For consistency with the PCT, it is recommended that the Standing Committee should consider whether instead of providing for the permitted modifications to the PCT Request Form under PLT Rule 3, such modifications should be established by the Assembly under PLT Rule 21(1), as in the case of PLT Model International Forms. Also as in the case of those Model International Forms, this would avoid the need to include the permitted modifications to the PCT Request Form in the draft Regulations presented to the Diplomatic Conference.

Rule 4
(*Availability of Priority Document Under Article 5(5)(c) and Rule 2(3) and (4)(b)*)

R4.01 Reference is made to the explanation in paragraph 5.09 above regarding the situations in which a copy of an earlier application, or the certification of its filing date, may not be required by a Contracting Party under Article 5(5)(c). As noted in paragraphs R2.04 and R2.05 above, the PCT contains no provisions corresponding to PLT Rule 2(3) and (4); it therefore also contains no provisions corresponding to the provisions in relation to that Rule contained in Rule 4. However, this matter is indirectly covered by PCT Rule 89bis.3 which provides generally for the transmittal of documents in electronic form and by electronic means by one national Office or intergovernmental organization to another. Reference is also made to the modifications of Rule 4 proposed in paragraph 5.10 above.

Rule 5
(*Evidence Under Article 5(6), 6(6), 7(2)(c) and 11(6) and
Rules 16(7), 17(8), 18(8) and 19(7)*)

R5.01 This Rule provides that, where evidence is required under any of the Articles and Rules concerned, the notification requiring that evidence shall state the reason of the Office for doubting the veracity or accuracy of the matter, *etc.* in question. As explained in relation to PLT Article 5(6), the provisions of PCT Article 27(2)(ii) and Rule 51bis.1 at present permit the requirement of proof of allegations or statements in the international application irrespective of whether or not the Office may reasonably doubt the veracity of such allegations or statements (see paragraph 5.11 above). There are no counterparts under the PCT to the other PLT Articles and Rules to which Rule 5 relates. There is therefore, at present, no counterpart to this Rule under the PCT.

Rule 6
(Time Limits Concerning the Application Under Article 5)

R6.01 Paragraph (1)(a). The time limit under this provision of not less than 16 months for furnishing a copy of the earlier application under Article 5(5)(a), calculated from the filing date of that earlier application, is consistent with the (minimum) time limit of 16 months prescribed under PCT Rule 17.1. Under PCT Rule 17.1(a) the copy may be furnished after that time limit, provided it is received by the International Bureau before the date of publication of the international application.

R6.02 Paragraph (1)(b). This paragraph prescribes a time limit of not less than two months for furnishing a translation of the earlier application under PLT Article 5(5)(d), calculated from the date of the notification. That time limit is different to the time limit of 20 months for furnishing a translation of the priority document under PCT Rule 17.2(a), calculated from the priority date. This difference reflects the different procedures under PLT Article 5(5)(d) and PCT Rule 17 (see paragraph 5.09 above). Reference is also made to the recommendation to transfer of paragraph (1) to Rule 4 proposed in paragraph 5.10 above.

R6.03 Paragraphs (2)(a) and (3)(a)(i). These paragraphs prescribe a time limit of not less than two months for compliance with the requirements in respect of applications under PLT Article 5(1) to (4) and (6), calculated from the date of notification of non-compliance. That time limit is more favorable, from the viewpoint of applicants, than the time limit of not less than one month under PCT Rule 26.2, calculated from the date of the invitation to correct a defect in the international application.

R6.04 Paragraphs (2)(b) and (3)(a)(iii) (in part). These paragraphs prescribe a time limit of not less than two months for furnishing a translation of the application or an element of the application under PLT Article 5, calculated from the date on which the document that is required to be translated was received. That time limit is more favorable, from the viewpoint of applicants, than the initial time limit of one month for furnishing a translation of the international application under PCT Rule 12.3(a). However, it corresponds to the two month time limit which is provided under PCT Rule 12.3(c)(ii) if a surcharge is paid for the late furnishing of the translation.

R6.05 Paragraphs (2)(c), (3)(a)(iii) (in part) and (3)(b). These paragraphs prescribe a time limit for the correction of a priority claim which is not less than that applicable under the PCT for the correction of a priority claim after the filing of an international application. That time limit is prescribed in PCT Rule 26bis.1 and is 16 months from the priority date or changed priority date, whichever expires first, subject to a minimum period of four months from the filing date. Reference is also made to the proposals in respect of the addition and correction of priority claims in paragraphs 13.01 and R15.01.

R6.06 Paragraph (3)(a), item (ii). There is no provision under PCT Rule 26, or elsewhere under the PCT, for a time limit, corresponding to the time limit under this item, for compliance with the requirements in respect of international applications where no invitation to correct is issued.

Rule 7

(Details Concerning Representation Under Article 6)

R7.01 Paragraph (1). Reference is made to the explanation under Article 6(2) as regards the procedures for the purposes of which a Contracting Party may not require appointment of a representative under this paragraph (see paragraph 6.04 above).

R7.02 Paragraphs (2) and (3). These paragraphs prescribe the time limits under Article 6(8) and (9), for compliance with the requirements under Article 6(1) to (6), and for making observations. As explained in respect of PLT Article 6(8) and (9), the PCT does not expressly provide for the receiving Office to notify the applicant of any defect in the power of attorney or prescribe a time limit for the correction of that defect (see paragraphs 6.11 and 6.12 above). There are therefore no counterparts to these paragraphs under the PCT.

R7.03 Modifications of Rule 7. Reference is also made to the modifications of Rule 7 proposed in paragraphs 6.05 to 6.09 above.

Rule 8

(Filing of Communications Under Article 7(1))

R8.01 Paragraph (1). This paragraph obliges a Contracting Party to accept the filing of communications on paper. This is consistent with the express provision for filing international applications on paper under PCT Rule 89*bis*.1. It is also implicit, in the absence of any provision to the contrary, that any other document submitted in the course of the international procedure could similarly be in paper form, in accordance with the provisions of PCT Rule 92.1.

R8.02 Paragraph (2)(a). This paragraph obliges a Contracting Party which permits the filing of communications in electronic form or by electronic means in a particular language to accept the filing of communications in accordance with any requirements applicable to such filing in that language under the PCT. Those requirements are prescribed in PCT Rule 89*bis*, which will enter into force at the same time as the modification of the PCT Administrative Instructions (not yet promulgated) implementing that Rule.

R8.03 Paragraph (2)(b). This paragraph obliges a Contracting Party to notify the International Bureau of the requirements under its national law relating to the filing of communications in electronic form or by electronic means, and the International Bureau to publish those requirements. This corresponds to the provisions in respect of international applications under PCT Rule 89*bis*.1(d).

R8.04 Paragraph (3)(a). This paragraph obliges a Contracting Party which permits the filing of communications by telegraph, teleprinter, telefacsimile or other like means resulting in the filing of a printed or written document, to accept the filing of communications in accordance with any requirements applicable to such filing under the PCT. Those requirements are prescribed in PCT Rule 92.4.

R8.05 Paragraph (3)(b). This provision permits a Contracting Party to require the filing of the paper original of a document which was transmitted by telegraph, teleprinter, telefacsimile or other like means. This corresponds to the requirement for furnishing the original of a document under PCT Rule 92.4(d). However, as was known to the Standing Committee when adopting this paragraph, the time limit of not less than one month prescribed in paragraph (3)(b) is more favorable from the viewpoint of applicants than the 14 day period prescribed under that PCT Rule.

R8.06 Notification and Publication of Requirements Under Paragraph (3). For consistency with both paragraphs (2)(b) and (4)(b) and PCT Rule 92.4(d), paragraph (3) should be subject to notification by the Contracting Party and publication by the International Bureau, as provided under the proposal of the International Bureau in respect of paragraphs (2) and (3) in document SCP/2/3.

R8.07 Paragraph (4)(a). This paragraph obliges a Contracting Party which permits the filing of a copy, in electronic form or by electronic means, of a communication filed on paper, to accept the filing of copies of communications in accordance with any requirements applicable to such filing under the PCT. Those requirements are prescribed in PCT Rule 89^{ter}.1, which will enter into force at the same time as the modification of the PCT Administrative Instructions (not yet promulgated) implementing that Rule.

R8.08 Paragraph (4)(b). There are, at present, no express provisions under PCT Rule 89^{ter}.1, or elsewhere in the PCT, corresponding to the provisions of paragraph (4)(b) which oblige the Contracting Party to notify the International Bureau of the requirements under its national law relating to the filing of a copy, in electronic form or by electronic means, of a communication filed on paper, and the International Bureau to publish those requirements. However, it may be expected that the PCT Administrative Instructions will provide for such notification and publication.

Rule 9

(Details Concerning the Signature Under Article 7(2))

R9.01 It is to be noted that, in addition to the requirements in respect of communications in general under PLT Rule 9, the requirements in relation to the signature of international applications under PCT Rule 4.15 will also apply, pursuant to PLT Article 5(1), in respect of the signature of applications under the PLT.

R9.02 Paragraph (1). The PCT contains no requirement that a signature be accompanied by an indication of the name of the person who signs and the capacity in which that person signs, as prescribed in this paragraph.

R9.03 Paragraph (2). The PCT contains no requirement that a signature be accompanied by an indication of the date on which the signature was effected, as prescribed in this paragraph. It is recommended that the Standing Committee consider whether this requirement could be deleted.

R9.04 Paragraph (3), item (i). This item obliges a Contracting Party to accept the handwritten signature of communications on paper. Although not expressly stated, it is implicit that this is also the case under the PCT.

R9.05 Items (ii) and (iii). Item (ii) permits a Contracting Party to accept other forms of signature, including a seal, in place of a handwritten signature. Item (iii) permits a Contracting Party to require the use of a seal by its own nationals and own legal entities. PCT Rule 2.3 provides that the term “signature” shall be understood to mean “seal” where the use of a seal is required by the national law. The provisions of item (iii) will therefore apply, under this PCT Rule, to the use of seals in procedures in respect of international applications. There is, however, no provision under the PCT for the use of forms of signature other than handwritten signatures and seals, as provided for under item (ii).

R9.06 Paragraph (4). This paragraph obliges a Contracting Party to accept the graphic representation of a signature on a communication filed in electronic form or by electronic means. PCT Rule 92.4(b) provides for the recognition, as a proper signature, of a “signature appearing on a document transmitted by facsimile machine” but does not provide for such recognition of other graphic representations.

R9.07 Paragraphs (5) and (6). Paragraph (5)(a) permits a Contracting Party to require that a communication filed in electronic form or by electronic means be signed using a prescribed electronic signature. Paragraph (5)(b) obliges a Contracting Party which permits the filing of communications in electronic form or by electronic means in a particular language to accept an electronic signature in accordance with any requirements applicable to the electronic signature of such communications in that language under the PCT. Paragraph (6) permits a Contracting Party to require confirmation of electronic signatures by a certificate issued by a specified certification authority. At present the PCT contains no provisions in respect of electronic signatures. However, such provisions are currently under consideration by the Ad Hoc Advisory Group on Proposed Amendments of the PCT Regulations and will be prescribed, in due course, in the PCT Administrative Instructions under PCT Rule 89*bis*.1 and 89*bis*.2.

Rule 10

(Details Concerning the Indication of Addresses Under Article 7(4)(i) and (ii))

R10.01 Reference is made to the explanation in paragraph 7.10 above regarding the requirements for the indication of an address for correspondence and an address for legal service under Article 7(4), items (i) and (ii). Reference is also made to the modifications of Rule 10 proposed in paragraphs 7.06 to 7.09 and 7.12 above.

Rule 11

(Time Limits Concerning Communications Under Article 7(5) and (6))

R11.01 Paragraphs (1) and (2), item (i). These paragraphs prescribe a time limit of not less than two months for compliance with the requirements in respect of communications under PLT Article 7(1) to (4), calculated from the date of notification of non-compliance. That time limit is more favorable, from the viewpoint of applicants, than both the time limit of not less than one month from the date of the invitation to correct a defect in the international application under PCT Rule 26.2, and the time limit of between 10 days and one month for compliance with the requirements in respect of any paper other than the international application under PCT Rule 92.1(b).

R11.02 Paragraph (2), item (ii). There are no provisions in respect of international applications under PCT Rules 26 or 92, or elsewhere under the PCT, for a time limit, corresponding to the time limit under this item for compliance with the requirements in respect of communications under PLT Article 7 (1) to (4) where no invitation to correct is issued.

Rule 12

(Details Concerning Extension of a Time Limit Fixed by the Office Under Article 10)

R12.01 Since the PCT contains no provisions corresponding to PLT Article 10(1) and (2) (see paragraph 10.01 above), it follows that it also contains no provisions corresponding to paragraphs (1) and (2) under that Article. However, PCT Rules 26.2 and 60.1(a), last sentence both provide for an extension of time by the Office.

Rule 13

(Details Concerning Continued Processing and Re-instatement of Rights Without a Finding of Due Care by the Office Under Article 11)

R13.01 As the PCT contains no provisions corresponding to PLT Article 11(1) and (2) (see paragraph 11.01 above), it follows that it also contains no provisions corresponding to Rule 13(1) to (3) under that Article. Reference is also made to the modifications of Rule 13 proposed in paragraphs 11.03, 11.05 and 11.06 above.

Rule 14

(Details Concerning Re-instatement of Rights After a Finding of Due Care or Unintentionality by the Office Under Article 12)

R14.01 Paragraph (1), item (i). The time limit, under this item, for making a request and for complying with the requirements under PLT Article 12(1)(ii) of not less than two months, calculated from the date of the removal of the cause of the failure to comply with the time limit concerned, is different from the time limit, under PCT Rules 82.1(c) and 82.2(b), of one month for submitting evidence in respect of a delay or loss in the mail or interruption of the mail service, calculated from the date on which the applicant noticed, or should have noticed, that delay, loss or interruption. Thus, if the failure to meet a time limit is the result of delay or loss in the mail, the PCT provides for a remedy in all cases, without exception for certain acts.

R14.02 Item (ii). It is still to be decided whether the time limit under this item, which has the effect of imposing a limitation on the time limit under item (i), shall be not less than six months, or not less than 12 months, from the date of the time for the action in question. The corresponding time limit under PCT Rules 82.1(c) and 82.2(b) is six months after the expiration of the applicable time limit.

R14.03 Paragraph (2). This paragraph prescribes the time limits in respect of which a Contracting Party is not required to provide for re-instatement of rights. There are no corresponding exceptions in respect of the relief available under PCT Rule 82.

R14.04 Modifications of Rule 14. Reference is also made to the modifications of Rule 14 proposed in paragraphs 12.03 and 12.04 above.

Rule 15

(Details Concerning Addition and Restoration of Priority Claim Under Article 13)

R15.01 Paragraph (1). This paragraph prescribes a time limit for the addition of a priority claim under PLT Article 13(1) which is not less than that applicable under the PCT for the addition of a priority claim after the filing of an international application. That time limit is prescribed in PCT Rule 26bis.1 and is 16 months from the priority date or changed priority date, whichever expires first, subject to a minimum period of four months from the filing date. It is recommended that the Standing Committee consider whether the provisions of paragraph (1) should be incorporated into Rule 6(2)(c) if Article 13(1) is deleted (see paragraph 13.01 above).

R15.02 Paragraphs (2) to (4). As the PCT contains no provisions corresponding to PLT Article 16(2) and (3) (see paragraphs 16.02 and 16.03 above), it follows that it also contains no provisions corresponding to Rule 15(2) to (4) under that Article.

R15.03 Modifications of Rule 15. Reference is also made to the modifications of Rule 15 proposed in paragraphs 13.02 to 13.05 above.

Rule 16
(Request for Recordal of Change in Name or Address)

R16.01 Paragraph (1). This paragraph relates to requests for the recordal of a change in the name and address of the applicant or owner where there is no change in the person of that applicant or owner. PCT Rule 92bis.1(a)(i) similarly provides for the recording of a change of an indication of the “... name, residence, nationality or address of the applicant” in the PCT request or demand of an international application (which change would then be incorporated into the records of the receiving Office and the International Bureau). However, under PCT Rule 92bis.1(b), a change will only be recorded if the request for recording the change is received before the date of entry into the national phase. After that date, the provisions of national law, as regulated by PLT Rule 16, would apply in accordance with PLT Article 2(1)(b)(ii).

R16.02 The request for recording a change in name or address under PCT Rule 92bis.1(a)(i) is a “paper submitted by the applicant in the course of the international procedure” corresponding to the provisions of PCT Rule 92.1(a). In accordance with the provisions in respect of such papers under that Rule, that request must be in the form of, or accompanied by, a letter that identifies the international application to which it relates and is signed by the applicant. These requirements under the PCT correspond to the requirements under paragraph (1), chapeau and item (i) that the request for recordal of change be signed and contain an indication of the number of the application or patent concerned, respectively. It is also implicit that a request for recording a change under PCT Rule 92bis.1(a)(i) must necessarily contain an indication of the change to be recorded, as expressly required under paragraph (1), item (ii). However, there is no requirement under PCT Rule 92bis.1(a)(i) corresponding to the requirement under paragraph (1), item (iii) that the request for recordal contain an indication of the name and address of the applicant or owner prior to the change.

R16.03 Paragraph (2). There is no requirement under PCT Rule 92bis.1(a)(i) or elsewhere in the PCT corresponding to the requirement under this paragraph that a request for recordal of change in name or address be presented on a prescribed Form or format.

R16.04 Paragraph (3). This paragraph prescribes the language of the request under paragraph (1). The language of a request for recording a change in name or address under PCT Rule 92bis.1 is similarly regulated by the provisions concerning the language of correspondence under Section 104 of the PCT Administrative Instructions. It is recommended that the Standing Committee consider whether paragraph (3) is still required if Article 7 is modified to include a requirement in respect of the language of communications as proposed (see paragraph 7.13 above) since the term “communication”, as defined in Article 1(v), includes “requests”.

R16.05 Paragraph (4). It is recommended that the Standing Committee consider whether, for consistency with the recommendation in respect of Article 11(5) (see paragraph 11.05 above) as well as for simplicity, instead of applying Article 5(6), *mutatis mutandis*, this paragraph should be modified to state that a Contracting Party may require that a fee be paid in respect of a request under paragraph (1). A draft text, for consideration by the Standing Committee, of paragraph (4) modified in this respect is included in Annex 3. A similar recommendation is made in respect of Article 10(4) (see paragraph 10.04 above).

R16.06 Paragraph (5)(a). This paragraph provides that a change of both name and address may be included in a single request for recordal. It would appear implicit that a request under PCT Rule 92bis.1(a)(i) could be in respect of a change in both the name and address of the applicant.

R16.07 Paragraph (5)(b). There is no express provision under the PCT corresponding to this paragraph which provides that a single request for recordal may relate to more than one application and/or patent.

R16.08 Paragraph (6). There is no express provision under the PCT corresponding to this paragraph which applies where the number of the application to which the request for recordal relates is not known or has not been issued.

R16.09 Paragraph (7). There is no provision under the PCT corresponding to this paragraph which provides that evidence be furnished where the Office may reasonably doubt the veracity of an indication contained in the request for recordal.

R16.10 Paragraph (8). This paragraph prohibits formal requirements other than those referred to in paragraphs (1) to (7). It is implicit that no requirements other than those provided for in the PCT can be applied in respect of a request for recording a change under PCT Rule 92bis.1(a)(i).

R16.11 Paragraph (9). This paragraph provides for the applicant or owner to be notified of non-compliance with any requirement under paragraphs (1) to (7) and given an opportunity to comply with that requirement, and to make observations, within a time limit. This corresponds to the provision under PCT Rule 92.1(b) for the applicant to be informed, and invited to remedy the omission within a time limit fixed in that invitation, where “any paper submitted by the applicant in the course of the international procedure,” such as a request for recording a change under PCT Rule 92bis.1(a)(i) (see paragraph R16.02 above), does not comply with the requirements provided for in PCT Rule 92.1(a). However, the time limit under paragraph (9), of not less than two months calculated from the date of notification, is more favorable, from the viewpoint of applicants, than the time limit of between 10 days and one month under PCT Rule 92.1(b).

R16.12 Paragraph (10). The provision under this paragraph for the refusal of a request for recordal where the requirements concerned are not complied with within a prescribed time limit corresponds to the provisions under PCT Rule 92.1(b) for disregarding “any paper submitted by the applicant in the course of the international procedure,” such as a request for recording a change under PCT Rule 92bis.1(a)(i) (see paragraphs R16.02 and R16.11 above). However, the time limit under paragraph (9) of not less than two months, calculated from the date of notification, or of not less than three months where indications allowing the applicant or owner concerned to be contacted have not been furnished, is more favorable, from the viewpoint of applicants, than the time limit of between 10 days and one month under PCT Rule 92.1(b).

R16.13 Paragraph (11). This paragraph applies, *mutatis mutandis*, the provisions of paragraphs (1) to (10) to changes in the name or address of the representative or in an address for service. The recording of a change in the name or address of an agent or common representative in the PCT request or demand is provided for under PCT Rule 92bis.1(a)(ii). The recording of a change of address for service in the PCT request or demand would, *prima*

facie, appear to be covered by the provision for the change in the address of an applicant under PCT Rule 92*bis*.1(a)(i) (see paragraph R16.01 above).

R16.14 *Change in the Name or Address of the Inventor.* PCT Rule 92*bis*.1(a)(ii) provides for the recording of changes in the name or address of the inventor. However, in view of the express exclusions of changes in respect of inventorship under PLT Rules 17(11) and 19(12), it would not seem appropriate that, for consistency with the PCT in this matter, paragraph (10) be modified to include the recordal of changes in the name or address of the inventor (which is currently not regulated by the PLT).

Rule 17

(Request for Recordal of Change in Applicant or Owner)

R17.01 Rule 17 relates to requests for the recordal of a change in the person of the applicant or owner. PCT Rule 92*bis*.1(a)(i) similarly provides for the recording of a change of the indication of the “person.... of the applicant” in the PCT request or demand of an international application.

R17.02 *Paragraphs (1), (2) and (4) to (10).* The explanations and recommendations under Rule 16(1) to (10) apply, *mutatis mutandis*, to these paragraphs (see paragraphs R16.01 to R16.12 above).

R17.03 *Paragraph (3).* There is no provision under the PCT corresponding to this paragraph which prescribes the documentation of the basis of the change in applicant or owner which a Contracting Party may require to accompany the request for recordal.

R17.04 *Paragraph (11).* This paragraph provides that a Contracting Party may exclude the application of Rule 17 in respect of changes in inventorship. It also provides that what constitutes inventorship shall be determined under the applicable law of the Contracting Party. The PCT similarly does not prescribe what constitutes inventorship. However, in contrast to PLT Rule 17, PCT Rule 92*bis*.1(a)(ii) expressly provides for the recording of a change of the indication of the “person.... of the inventor” in the PCT request or demand of an international application.

R17.05 *Change in the Person of the Representative.* It is to be noted that the PLT contains no provision corresponding to the provision, under PCT Rule 90.6, dealing with the revocation or renunciation of appointment of agents. In addition, the PLT contains no provision corresponding to the provision, under PCT Rule 92*bis*.1(a)(ii), for the recording of a change of the indication of the “person.... of the agent [or] common representative” in the PCT request or demand of an international application. Also, the rescinding of the appointment of the previous representative is not regulated under the PLT; however, the appointment of the new representative is regulated by PLT Article 6(3).

Rule 18

(Request for Recordal of a Licensing Agreement or Security Interest Under Article 14(1)(b)(iii))

R18.01 The PCT does not provide for the recordal of a licensing agreement or security interest.

R18.02 Paragraphs (3) and (4). The explanations and recommendations under Rule 16(3) and (4) apply, *mutatis mutandis*, to these paragraphs (see paragraphs R16.04 and R16.05 above.

Rule 19

(Request for Correction of a Mistake)

R19.01 Paragraph (1)(a). As provided in the chapeau, this paragraph is restricted to the correction of “a mistake which is correctable under the applicable law” of the Contracting Party concerned. Accordingly, it does not prescribe the types of mistake that may corrected under the applicable law. PCT Rule 91.1. provides for the rectification of obvious errors in the international application, other than the omission of entire elements or sheets, in accordance with PCT Rule 91.1(a) and (c). In accordance with PLT Article 2(1)(b)(ii), the provisions of PLT Rule 19 would apply to the correction of mistakes in the international application after the commencement of the “national phase”. (Since the PCT makes no provision for the correction of errors after the entry into the national phase, any provision for such correction under national law, as regulated by PLT Rule 19, would necessarily be more favorable from the viewpoint of applicants, and therefore permitted under PCT Article 27(4).)

R19.02 The request for rectification under PCT Rule 91.1(d) is a “paper submitted by the applicant in the course of the international procedure” under PCT Rule 92.1(a). In accordance with the provisions in respect of such papers under that Rule, that request must be in the form of, or accompanied by, a letter that identifies the international application to which it relates and is signed by the applicant. These requirements under the PCT correspond to the requirements under paragraph (1), chapeau and item (ii), that the request for correction of a mistake be signed and contain an indication of the number of the application or patent concerned, respectively. It is also implicit that a request for rectification under PCT Rule 91.1(a) must necessarily contain an indication to the effect that a correction of error is requested, similarly to paragraph (1), item (i), together with indications of the error to be corrected and the rectification to be made, similarly to items (iii) and (iv), respectively. There is, however, no requirement under PCT Rule 91.1 corresponding to the requirement under item (v) that the request for correction contain an indication of the name and address of the requesting party.

R19.03 Paragraph (1)(b). This paragraph provides that a Contracting Party may require that the request for correction of a mistake be accompanied by a replacement sheet incorporating that correction. In the case of rectification of an error under PCT Rule 91.1, replacement sheets are required in the same way as for the correction of defects in the international application under PCT Rule 26.4.

R19.04 Paragraph (1)(c). This paragraph permits a Contracting Party to require that a request for the correction of a mistake be subject to a declaration that the mistake was made in good faith. PCT Rule 91.1 contains no corresponding requirement but is, in any case, limited to the rectification of obvious errors, in respect of which the submission of evidence is not necessary because the rectification itself must be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.

R19.05 Paragraph (1)(d). This paragraph permits a Contracting Party to require that a request for the correction of a mistake be subject to the condition that the request for correction was made without undue delay or, at the option of the Contracting Party, was made without intentional delay. There is no corresponding requirement under PCT Rule 91.1.

R19.06 Paragraphs (2) to (8) and (10). The explanations and recommendations under Rule 16(2) to (10) apply, *mutatis mutandis*, to these paragraphs (see paragraphs R16.03 to R16.12 above).

R19.07 Paragraph (9). This paragraph provides that a Contracting Party shall correct its own mistakes for no fee. In order to present the provisions on fees in a single paragraph, it is recommended that the Standing Committee consider whether paragraph (9) should be incorporated in paragraph (4). A draft text, for consideration by the Standing Committee, of paragraph (4) modified in this respect and incorporating, *mutatis mutandis*, the modification proposed in respect of Rule 16(4) in paragraph R16.04, is included in Annex 3.

R19.08 Paragraph (11). This paragraph provides that a Contracting Party may exclude the application of Rule 19 in respect of changes in inventorship. It also provides that what constitutes inventorship shall be determined under the applicable law of the Contracting Party. As explained in paragraph 17.04 above, the PCT similarly does not prescribe what constitutes inventorship. However, in contrast to PLT Rule 19, PCT Rule 91.1 does not exclude the rectification of obvious errors in respect of the inventor under PCT Rules 4.1(v), 4.4 and 4.6.

Rule 20

(Manner of Identification of an Application Without its Application Number)

R20.01 The PCT contains no provisions corresponding to this Rule which prescribes acceptable ways of identifying an application where the number of that application is not known or has not been issued.

Rule 21

(Establishment of Model International Forms and Formats Under Article 14(1)(b))

R21.01 Paragraph (1). This paragraph provides for the establishment of Model International Forms by the Assembly on the proposal of the International Bureau. This differs from the

procedure under PCT Rule 89.2(a) and (b) which provides for the Administrative Instructions, which include the PCT Forms, to be drawn up and promulgated, and modified, by the Director General after consultation with the interested Offices and Authorities. Reference is also made to the explanation under Article 14(1)(b) (see paragraph 14.03 above).

R21.02 Modification of Paragraph (1). A draft text, for consideration by the Standing Committee, of paragraph (1) modified in as proposed in paragraph R3.01 above, is included in Annex 3.

R21.03 Paragraph (2). This paragraph is currently reserved, in the absence of any provisions in respect of formats under the PCT.

[Annexes follow]

ANNEX 1

SUMMARY OF RECOMMENDATIONS

- Article 1: to add “document, correspondence” to the definition of “communication” in item (v) (see paragraph 1.05).
- Article 2: to change the date in paragraph (1)(b)(ii) to “the date on which processing or examination of the international application may start under [PCT]Article 23 or 40” (see paragraph 2.04);
- to add references to “applications for patents of addition” and “patents of addition” to paragraphs (1) and (2), respectively (see paragraph 2.06).
- Article 4: to provide, in paragraph (3), for the applicant to be given an opportunity to comply with requirements and to make observations (see paragraph 4.09);
- to provide, in paragraph (4)(b), for the applicant to be notified where the application is regarded as not having been filed (see paragraph 4.11);
- to transfer to the Regulations, from paragraph (5), specific requirements in respect of a missing part of the description or drawings (see paragraph 4.16);
- to provide, in paragraph (7), for special filing date requirements in the case of types of applications prescribed in the Regulations (see paragraph 4.18).
- Article 5: to provide, in paragraph (1), for exceptions prescribed in the Regulations to requirements relating to the form and contents of the application (see paragraph 5.03);
- to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (3) in respect of the language of applications, and to substitute an express requirement in respect of translations or, where appropriate, a transliteration (see paragraphs 5.05 and 5.06);
- to transfer to the Regulations, from paragraph (5), specific requirements in respect of priority documents (see paragraph 5.10);
- to provide, in paragraph (6), for verification of the translation of any part of the application (see paragraphs 5.06 and 5.11).

- Article 6: to transfer to the Regulations, from paragraphs (3) to (6), specific requirements in respect of the appointment of representatives (see paragraphs 6.05 to 6.09).
- Article 7: to transfer to the Regulations, from paragraph (3), specific indications that may be required in a communication, and to add requirements relating to indications of the application or patent number to which the communication relates and of the reference number of an “other interested person” (see paragraphs 7.07 to 7.08);
- to transfer to the Regulations, from paragraph (6)(b), specific sanctions in respect of the non-compliance with requirements relating to the appointment of a representative (see paragraph 7.12);
- to add a new requirement in respect of the language of communications (see paragraph 7.13).
- Article 8: to transfer the provisions of this Article to the Regulations (see paragraph 8.04).
- Article 10: to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (3) in respect of the language of the request (see paragraph 10.03);
- to modify paragraph (4) to avoid the use of the term “mutatis mutandis” (see paragraph 10.04).
- Article 11: to transfer to the Regulations, from paragraphs (1), (3), (5) and (6), specific requirements in respect of the signature of the request, the use of a prescribed request Form or format, fees, and evidence (see paragraphs 11.03, 11.05 and 11.06);
- to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (4) in respect of the language of the request (see paragraph 11.04).
- Article 12: to transfer to the Regulations, from paragraphs (1), (3) and (6), specific requirements in respect of the signature of the request, the statement of grounds in the request, the use of a prescribed request Form or format, and evidence (see paragraphs 12.02 and 12.03);
- to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (4) in respect of the language of the request (see paragraph 12.02);
- to modify paragraph (5) to avoid the use of the term “mutatis mutandis” (see paragraph 12.02).

Article 13: to delete paragraph (1) on the basis that requirements relating to the addition of a priority claim are requirements relating to the form and contents of the application under Article 5(1) (see paragraph 13.01);

to transfer to the Regulations, from paragraphs (2) to (4), specific requirements in respect of requests, including the use of a prescribed request Form or format (see paragraphs 13.02 to 13.04);

to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (5) in respect of the language of the request (see paragraph 13.06);

to modify paragraph (6) to avoid the use of the term “mutatis mutandis” (see paragraph 13.07).

Rule 3: to delete this Rule and, instead provide for permitted modifications of the request Form and format to be established by the Assembly under Rule 21 (see paragraph R3.01).

Rule 6: to transfer to Rule 4, from paragraph (1), the time limit for furnishing a copy of a priority document (see paragraphs 5.10 and R6.02).

Rule 9: to delete the requirement for the date of signature under paragraph (2) (see paragraph R9.03).

Rule 15: to transfer to Rule 6(2)(c), from paragraph (1), the time limit for the addition of a priority claim (see paragraphs R13.01 and R15.01).

Rule 16: to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (3) in respect of the language of the request (see paragraph 16.04);

to modify paragraph (4) to avoid the use of the term “mutatis mutandis” (see paragraph 16.05).

Rule 17: to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (4) in respect of the language of the request (see paragraph 17.02);

to modify paragraph (5) to avoid the use of the term “mutatis mutandis” (see paragraph 17.02).

Rule 18: to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (4) in respect of the language of the request (see paragraph 18.02);

to modify paragraph (5) to avoid the use of the term “mutatis mutandis” (see paragraph 18.02).

Rule 19: to delete, in consequence of the addition to Article 7 of a new requirement in respect of the language of communications, the requirement in paragraph (3) in respect of the language of the request (see paragraph 13.06);

to combine paragraphs (4) and (9) (see paragraph 19.07).

[Annex 2 follows]

ANNEX 2

FORM AND CONTENTS OF APPLICATION UNDER ARTICLE 5(1)

1. In the opinion of the authors, Article 5(1) incorporates by reference the following provisions of the PCT to the extent that they relate to the form and contents of the application:

- (i) the contents of the application under PCT Article 3(2);
- (ii) the physical requirements under PCT Article 3(4)(ii) and Rule 11 (other than Rule 11.9(e));
- (iii) the contents of the request under PCT Article 4, Rules 3.3, 4.1 to 4.8, 4.9(a)(ii), 4.11, [4.13], 4.14, 4.15 and 4.17(a) and Section 203 of the Administrative Instructions;
- (iv) claiming priority under PCT Article 8 and Rules 4.10 and 26*bis*;
- (v) furnishing the application, a translation thereof, and any document relating thereto, in more than one copy under PCT Rule 51*bis*.1(c);
- (vi) unity of invention under Article 3(4)(iii), Rule 13 and Section 206 of the Administrative Instructions;
- (vii) the contents and form of the abstract under PCT Rule 8;
- (viii) expressions not to be used under PCT Rule 9;
- (ix) terminology and signs under PCT Rule 10;
- (x) inventions relating to biological material under PCT Rule 13*bis* and Section 209 of the Administrative Instructions;
- (xi) nucleotide and/or amino acid sequence listings under PCT Rule 13*ter* and Section 208 of the Administrative Instructions.

[Commentary:

The requirement under PCT Rule 3.1 (Form of Request) is regulated by PLT Article 5(2).

*The requirements under PCT Rules 3.2, 4.9(a)(i), (b) and (c), 4.14*bis* and 4.17(b) are relevant only to international applications.*

The requirements under PCT Rule 4.12 (Choice of Certain Kinds of Protection) and Section 202 of the Administrative Instructions are not applicable since the PLT does not apply to kinds of protection other than patents.

The requirement under PCT Rule 4.13 (Identification of Parent Application or Parent Grant) is placed in square brackets since it will be applicable only if PLT Article 2(1) is modified to include applications for patents of addition, as proposed in paragraph 2.06.

The language requirements under PCT Rules 12 and 4.16 and Section 201 of the Administrative Instructions are not mentioned in the list above since the requirements in respect of the language of the application are prescribed under PLT Article 5(3) (or the proposed new Article 7(1bis) – see paragraph 7.13).

As regards the inclusion of PCT Rule 26bis (Correction or Addition of Priority Claim), reference is made to the recommendation in paragraph 13.01 in respect of PLT Article 13(1).

As regards unity of invention, reference is made to the reservation by the Delegation of the United States of America as regards the applicability of PCT Rule 13 under PLT Article 5(1) (see Note 5.05 in document SCP/2/4.)]

2. As regards the following provisions of the PCT, the authors of the Study raise the question whether, or the extent to which, they relate to the form and contents of the application, and whether they should therefore be considered as incorporated by reference under Article 5(1) of the PLT:

(i) the description under Article 5, Rule 5 and Section 204 of the Administrative Instructions;

(ii) the claims under Article 6, Rule 6 and Section 205 of the Administrative Instructions;

(iii) the drawings under Article 7, Rule 7 and Section 207 of the Administrative Instructions.

[Annex 3 follows]

ANNEX 3

DRAFT TEXTS OF MODIFICATIONS TO THE DRAFT PATENT LAW TREATY FOR CONSIDERATION BY THE STANDING COMMITTEE ON THE LAW OF PATENTS

Article 1

Abbreviated Expressions

For the purposes of this Treaty, unless stated otherwise:

(i) to (iv) [no change]

(v) “communication” means any application, or any request, declaration , document, correspondence or information relating to an application or patent, whether relating to a procedure under this Treaty or not, which is submitted or transmitted to the Office by means permitted by the Office;

[Commentary: See paragraph 1.05]

(vi) to (xviii) [no change]

Article 2

Applications and Patents to which the Treaty Applies

(1) [Applications] (a) The provisions of this Treaty and the Regulations shall apply to:

(i) national and regional applications for patents for invention, and for patents of addition, which are filed with or for the Office of a Contracting Party, and which are types of applications that can be filed as international applications under the Patent Cooperation Treaty;

[Commentary: See paragraphs 2.06 and 2.07]

(ii) [no change]

(b) Subject to the provisions of the Patent Cooperation Treaty, the provisions of this Treaty and the Regulations shall apply to international applications for patents for invention, and for patents of addition, under the Patent Cooperation Treaty:

(i) [no change]

(ii) from the date on which processing or examination of the international application may start under the requirements of Article 22 23 or 39(1) 40 of that Treaty ~~have been complied with~~.

[Commentary: See paragraphs 2.04, 2.06 and 2.07]

(2) [Patents] The provisions of this Treaty and the Regulations shall apply to patents for invention, and to patents of addition, which have been granted with effect for a Contracting Party.

[Commentary: See paragraphs 2.05 to 2.07]

Article 3

National Security

[no change]

Article 4

Filing Date

(1) and (2) [no change]

(3) [Notification] Where the application does not comply with one or more of the requirements of paragraphs (1) and (2), the Office shall [promptly] [as soon as practicable] notify the applicant ~~of any requirement not complied with, giving an opportunity to comply with any such requirement, and to make observations, within the relevant time limit prescribed in the Regulations.~~

[Commentary: See paragraph 4.09. Modified text modeled after Article 5(7).]

(4) *[Subsequent Compliance with Requirements]* (a) [no change]

(b) A Contracting Party may provide that, where one or more of the requirements referred to in subparagraph (a) are not complied with within the time limit prescribed in the Regulations, the application shall be regarded as not having been filed. Where the application is regarded as not having been filed, the Office shall notify the applicant accordingly, indicating the reasons therefore.

[Commentary: See paragraph 4.11]

(5) *[Missing Part of Description or Drawings]* (a) [no change]

(b) Except as provided in the Regulations ~~Subject to subparagraphs (c) to (e)~~, where a missing part of the description or a missing drawing is filed with 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 that drawing, or the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with, whichever is later. Where the missing drawing is not filed with the Office within that time limit, any reference to [that] [the said] drawing[s] shall be considered non-existent for the purposes of establishing the filing date.

(c) to (e) [moved to Rule 2(3)]

[Commentary: See paragraph 4.16]

(6) [no change]

(7) [~~Divisional Applications; Continuation and Continuation-in-Part Applications~~ Exceptions] Nothing in this Article shall limit the right of an applicant, or freedom of a Contracting Party :

(i) [no change]

(ii) the freedom of any Contracting Party to apply any requirements necessary to accord the benefit of the filing date of an application for a continuation or a continuation-in-part of an earlier application, or of any other type of application prescribed in the Regulations.

[Commentary: See paragraph 4.18. At present there are no Regulations under item (ii)]

Article 5

Application

(1) [*Form or Contents of Application*] (a) No Contracting Party shall require compliance with any requirement relating to the form or contents of an application different from or additional to those which are provided for in respect of international applications under the Patent Cooperation Treaty, except where otherwise provided for by this Treaty or prescribed in the Regulations, it being understood that a Contracting Party shall be free to provide for requirements which, from the viewpoint of applicants, are more favorable than the requirements applicable under Patent Cooperation Treaty.

[*Commentary: See paragraph 5.03*]

(2) [no change]

(3) [~~Language Translation~~] A Contracting Party may require that, if any part of the application is not in a language accepted by the Office, it be accompanied by a translation or, where appropriate, a transliteration.

[*Commentary: See paragraphs 5.05 and 5.06*]

(4) [no change]

(5) [*Priority Document*] ~~(a) Subject to subparagraph (c), where~~ Where the priority date of an earlier application is claimed, a Contracting Party may require that a copy of the earlier application, and a translation where the earlier application is not in a language accepted by the Office, be furnished to the Office within the time limit prescribed in accordance with the Regulations.

(b) to (d) [moved to Rule 4]

[*Commentary: See paragraph 5.10*]

(6) [*Evidence*] A Contracting Party may require that evidence be furnished to its Office in the course of the processing of the application where that Office may reasonably doubt the veracity of any matter contained in the request Form or format referred to in paragraph (2), or in a declaration of priority, or the accuracy of any translation ~~of a priority document~~ required under paragraph (3) or (5)(d).

[Commentary: See paragraphs 5.06 and 5.11]

(7) and (8) [no change]

Article 6

Representation

(1) and (2) [no change]

(3) [~~Power of Attorney~~ Appointment of Representative] ~~(a)~~ A Contracting Party shall accept that the appointment of the representative be furnished to the Office in a manner prescribed in the Regulations:

(i) and (ii) [moved to Rule 7(1bis)]

(b) [moved to Rule 7(1bis)]

(4) [moved to Rule 7(1ter)]

(5) [moved to Rule 7(1quater)]

(6) [moved to Rule 7(1quinquies)]

[Commentary: See paragraphs 6.05 to 6.09]

(7) to (9) [no change]

Article 7

Communications; Addresses

(1) [no change]

(1bis) [Language of Communications] A Contracting Party may, except where otherwise provided for by this Treaty or the Regulations, require that a communication be in a language accepted by the Office.

[Commentary: See paragraph 7.13. The above modification would require consequential modification of the paragraphs referred to in paragraph (5)]

(2) [no change]

(3) [~~Indications References to Applicants, Owners and Representatives in Communications~~] ~~(a)~~ A Contracting Party may require that any communication contain one or more indications prescribed in the Regulations, where the applicant or owner is registered with the Office, the number or other indication under which he is so registered.

(b) [moved to Rule 10]

[Commentary: See paragraphs 7.06 to 7.09]

(4) and (5) [no change]

(6) [~~Non-compliance with Requirements~~] ~~(a)~~ Where one or more of the requirements applied under paragraphs (1) to (4) are not complied with within the time limit prescribed in the Regulations, the Contracting Party may, subject to ~~subparagraph (b) and Article 4~~ and any exceptions prescribed in the Regulations, apply such sanction as is provided for in its law.

(b) [moved to Rule 10]

[Commentary: See paragraph 7.12]

Article 8

Notification

[moved to Rule 11bis]

[Commentary: See paragraph 8.04]

Article 9

Validity of Patent; Revocation

[no change]

Article 10

Extension of a Time Limit Fixed by the Office

(1) and (2) [no change]

(3) [incorporated into Article 7(1bis)]

[Commentary: See paragraph 10.03]

(4) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request
~~Article 5(6) shall apply, mutatis mutandis, to requests under paragraph (1).~~

[Commentary: See paragraph 10.04]

(5) [no change]

Article 11

Continued Processing and Re-instatement of Rights Without a Finding of Due Care by the Office

(1) [*Request*] Where an 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 consider that time limit to have been complied with and, if necessary, re-instate the rights of the applicant [or owner] with respect to the application [or patent] concerned, if:

(i) a request to that effect is made ~~in a communication~~ to the Office in accordance with the requirements prescribed in the Regulations signed by the applicant [or owner]; and

- (ii) [no change]

[Commentary: See paragraph 11.03]

- (2) [no change]

- (3) [moved to Rule 13(1)(a)]

[Commentary: See paragraph 11.03]

- (4) [incorporated into Article 7(1bis)]

[Commentary: See paragraph 11.04]

(5) [*Fees*] ~~(a)~~ Except as provided for in the Regulations, a Contracting Party may require that a fee be paid in respect of a request ~~Article 5(6) shall apply, mutatis mutandis, to requests~~ under paragraph (1).

- (b) [moved to Rule 13(4)]

[Commentary: See paragraph 11.05]

- (6) [moved to Rule 13(1)(b)]

[Commentary: See paragraph 11.06]

- (7) [no change]

Article 12

Re-instatement of Rights After a Finding of Due Care or Unintentionality by the Office

(1) [*Request*] Where an applicant or owner has failed to comply with a time limit for an action in a procedure before the Office, the Office shall re-instate the rights of the applicant or owner with respect to the application or patent concerned, if:

(i) a request to that effect is made ~~in a communication~~ to the Office in accordance with the requirements prescribed in the Regulations ~~signed by the applicant or owner;~~ and

(ii) and (iii) [no change]

(iv) [moved to Rule 14(1bis)(a)]

(v) [no change]

[Commentary: See paragraphs 12.02 to 12.04]

(2) [no change]

(3) [moved to Rule 14(1bis)(a)]

[Commentary: See paragraph 12.02]

(4) [incorporated into Article 7(1bis)]

[Commentary: See paragraph 12.02]

(5) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request
~~Article 5(6) shall apply, mutatis mutandis, to requests under paragraph (1).~~

[Commentary: See paragraph 12.02]

(6) [moved to Rule 14 (1bis)(b)]

[Commentary: See paragraph 12.02]

(7) [no change]

Article 13

~~Addition and~~ Restoration of Priority Claim

(1) [incorporated into Article 5(1)]

[Commentary: See paragraph 13.01]

(2) [*Delayed Filing of the Subsequent Application*] (a) Where an application (the “subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit referred to in the Regulations, the Office shall restore the right of priority, upon a request made, ~~in a communication~~ to the Office in accordance with the requirements prescribed in the Regulations ~~signed by the applicant, if:~~

(i) to (iv) [moved to Rule 15(2bis)]

[Commentary: See paragraphs 13.02 and 13.05]

(3) [*Failure to Furnish a Copy of Earlier Application*] (a) Where a copy of an earlier application required under Article 5(5)(a) is not furnished to the Office within the time limit referred to in that Article, the Office shall restore the right of priority, upon a request made, ~~in a communication~~ to the Office in accordance with the requirements prescribed in the Regulations ~~signed by the applicant, within that time limit, if:~~

(i) and (ii) [moved to Rule 15(3)(a)]

(b) [moved to Rule 15(3)(b)]

[Commentary: See paragraphs 13.03 and 13.05]

(4) [moved to Rule 15(2bis)(ii) and(3)(a)(ii)]

[Commentary: See paragraph 13.04]

(5) [incorporated into Article 7(1bis)]

[Commentary: See paragraph 13.06]

(6) [*Fees*] Except as provided for in the Regulations, a Contracting Party may require that a fee be paid in respect of a request ~~Article 5(6) shall apply, *mutatis mutandis*, to requests under paragraphs (2) and (1) to (3).~~

[*Commentary: See paragraph 13.07*]

(7) [no change]

Article 14

Regulations

[no change]

Rule 1

Abbreviated Expressions

[no change]

Rule 2

Details Concerning Filing Date Under Article 4

(1) [*Time Limit Under Article 4(3)*] The time limit referred to in Article 4(3) shall be not less than two months from the date of notification under that Article.

(1**bis**) [*Time Limit Under Article 4(4)(b)*] The time limit referred to in Article 4(4)(b) shall be:

(i) subject to item (ii), the time limit applied under paragraph (1) where a notification has been made under Article 4(3), not less than two months from the date of the notification;

(ii) where a notification under Article 4(3) has not been made because indications allowing the applicant to be contacted by the Office have not been furnished, 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.

[Commentary: See paragraphs 4.09 and R2.06. New paragraph (1) and modifications to paragraph (1bis) (formerly paragraph (1) modeled after Rules 7(2) and (3)]

(2) [no change]

(3) [~~Exceptions~~ ~~Requirements~~ Under Article 4(5)(b)] (a) Subject to subparagraph (b), a Contracting Party [may] [shall] provide that, where the Office determines, within a time limit prescribed by that Contracting Party, if any, that all missing parts of the description and all missing drawings filed under Article 4(5)(b) do not contain new matter, the filing date shall be the date on which all of the requirements referred to in Article 4(1) and (2) are complied with.

(b) Where the missing part of the description or missing drawing is filed under Article 4(5)(b) to rectify its unintentional omission from an 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 subparagraph (c), consider the contents of that earlier application as having been contained in the application claiming priority in determining, for the purposes of subparagraph (a), whether that part of the description or that drawing contains new matter.

(c) Any Contracting Party may, subject to Rule 4, require that, for the contents of an earlier application to be considered under subparagraph (b) ~~Article 4(5)(d)~~:

(i) to (iii) [no change]

(d) Where all or part of the missing part of the description, and any missing drawings, filed under Article 4(5)(b) are withdrawn within a time limit fixed by the Contracting Party, and a determination under subparagraph (a) has been made that any remaining part of the missing description and missing drawings filed under that Article does not contain new matter, the filing date shall be the date on which all of the requirements referred to in Article 4(1) and (2) are complied with.

[Commentary: See paragraphs 4.16 and R2.06. Subparagraphs (a), (b) and (d) moved from Article 4(5)(c) to (e) with consequential modification]

(4) [no change]

Rule 2bis

Additional Permitted Requirements Under Article 5(1)

(1) [*Content of Application*] A Contracting Party may require that the application contain:

(i) where the applicant wishes the application to be treated as a divisional application, an indication to that effect accompanied by the number of the application from which it is divided;

(ii) an oath or declaration by the inventor;

(iii) information concerning the applicant's foreign applications and grants;

(iv) a declaration by the applicant in respect of a duty of disclosure;

(v) where the invention to which the application relates was produced under a government contract, a statement to that effect;

(vi) where a search has been carried out on any related application or patent, a disclosure of the result of that search;

(vii) where the application was prepared with the assistance of an invention marketing company, a statement to that effect accompanied by the name and address of that company;

[Commentary: See paragraph 5.03. In respect of item (ii), it is to be noted that the Ad Hoc Advisory Group on Proposed Amendments of the PCT Regulations is considering an amendment to PCT Rule 4 in respect of the inclusion with the international application of the declaration by the applicant alleging his inventorship which could permit the inclusion of an oath or a declaration by the inventor with the international application. In such case, item (ii) would not be required.]

(2) [*Form of Application*] A Contracting Party may prescribe requirements in respect of the spacing of the typing, and the size of the characters of the text matter, of an application in a language accepted by the Office, where there are no such requirements provided for under the Patent Cooperation Treaty in respect of international applications in that language.

[Commentary: This provision would permit a Contracting Party to prescribe requirements in respect of applications in the Chinese and Japanese languages, in respect of which the requirements as to the spacing of the typing and the size of the characters under PCT Rule 11.9(c) and (d) are disappplied under PCT Rule 11.9(e). It would similarly permit a Contracting Party to prescribe requirements in respect of applications in any language

accepted by the Office which is not a PCT language and uses a script other than the Latin or Cyrillic alphabets.]

Rule 3

Modifications to the PCT Request Form Under Article 5(2)(b)

[moved to Rule 21(1)(abis)]

[Commentary: See paragraph R3.01]

Rule 4

~~Availability of~~ Priority Document Under Article 5(5)(~~e~~) and Rule 2(3)(c) and (4)(b)

(1) [Copy of Earlier Application Under Article 5(5)] (a) Subject to paragraph (3), a Contracting Party may require that a copy of the earlier application referred to in Article 5(5) be furnished to the Office within a time limit which shall be not less than 16 months from the filing date of that earlier application or, where there is more than one such earlier application, from the earliest filing date of those earlier applications.

(2) [Certification] A Contracting Party may require that the copy referred to in paragraph (1) and the date of filing of the earlier application be certified as correct by the Office with which the earlier application was filed.

(3) [Availability of Earlier Application] 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 ~~Article 5(5)~~ paragraphs (1) and (2), and Rule 2(3)(c) and (4)(b), where the earlier application was filed with its Office or is available to that Office, in a legally accepted electronic format, from a digital library which is accepted by that Office.

(4) [Translation] Where the earlier application is not in a language accepted by the Office and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the Contracting Party may require that a translation of the earlier application referred to in paragraph (1) be furnished by the applicant, upon invitation by the Office, within a time limit which shall be not less than two months from the date of that invitation and not less than the time limit, if any, applied under that paragraph.

[Commentary: See paragraphs 5.10, 13.03 and R4.01. Paragraph (1) is based on Article 5(5)(a) and Rule 6(1)(a). Paragraph (2) is based on Article 5(5)(b). Paragraph (3) encompasses Article 5(5)(c). Paragraph (4) is based on Article 5(5)(d) and Rule 6(1)(b).]

Rule 5

Evidence Under Articles 5(6), 6(6), 7(2)(c) and 11(6) and Rules 16(7), 17(8), 18(8) and 19(7)

[no change]

Rule 6

Time Limits Concerning the Application Under Article 5

(1) [incorporated into Rule 4(1) and (4)]

[Commentary: See paragraphs 5.10 and R6.02]

(2) [*Time Limit Under Article 5(7)*] (a) and (b) [no change]

(c) The time limit referred to in Article 5(7) for the correction or addition of a priority claim shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the correction or addition of a priority claim.

[Commentary: See paragraphs 13.01, R6.05 and R15.01]

(3) [no change]

Rule 7

Details Concerning Representation Under Article 6

(1) [no change]

(1bis) [Appointment of Representative] (a) A Contracting Party shall accept that the appointment of a representative be furnished to the Office in:

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

(ii) the request Form or format referred to in Rule 2bis(3), signed by the applicant.

(b) A single power of attorney shall be sufficient even where it relates to more than one application or patent of the same person, or to one or more applications and one or more patents of the same person, provided that all applications and patents concerned are identified in the single power of attorney. A single power of attorney shall also be sufficient even where it relates, subject to any exception indicated by the appointing person, to all existing and future applications or patents of that person. The Office may require that, where that single power of attorney is filed on paper, a separate copy thereof be furnished for each application and patent to which it relates.

[Commentary: Moved from Article 6(3). See paragraphs 6.05, 6.06 and R7.03]

(1ter) [Power of Attorney Form or Format] (a) A Contracting Party may require that, where a power of attorney is in a separate communication as referred to in paragraph (1bis)(a)(i), it be presented on a power of attorney Form or in a format prescribed by that Contracting Party.

(b) Notwithstanding subparagraph (a), a Contracting Party shall accept the presentation of a power of attorney, filed on paper, if it is presented on a Form [or in a format] which corresponds to the power or attorney Form [or format] established under Rule 21(1)(a)(i).

[Commentary: Moved from Article 6(4). See paragraphs 6.05, 6.07 and R7.03. The references to "format" in subparagraph (b) are placed in square brackets since establishment of Model Formats under Rule 21(2) is currently reserved]

(1quater) [Translation of Power of Attorney] A Contracting Party may require that, if the power of attorney is not in a language accepted by the Office, it be accompanied by a translation.

[Commentary: Moved from Article 6(5). See paragraphs 6.05, 6.08 and R7.03]

(1quinquies) [Evidence] A Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in any communication referred to in paragraph (1ter).

[Commentary: Moved from Article 6(6). See paragraphs 6.05, 6.09 and R7.03]

(2) and (3) [no change]

Rule 8

Filing of Communications Under Article 7(1)

[no change]

Rule 9

Details Concerning Signature Under Article 7(2)

(1) [no change]

(2) [deleted]

[Commentary: See paragraph R9.03]

(3) to (7) [no change]

Rule 10

Details Concerning ~~the~~ Indications ~~of Addresses~~ Under Article 7(3) and (4)(i) and (ii)

(1) to (3) [no change]

(4) [Indications Under Article 7(3)(ii)] (a) A Contracting Party may require that any communication:

(i) indicate the number of the application or patent to which it relates;

(ii) contain, where an applicant, owner or other interested person is registered with the Office, the number or other indication under which he is so registered;

(b) A Contracting Party may require that any communication by a representative for the purposes of a procedure before the Office contain:

(i) the name and address of the representative;

(ii) a reference to the power of attorney, or other communication in which the appointment of that representative is or was effected, on the basis of which the said representative acts;

(iii) where the representative is registered with the Office, the number or other indication under which he is registered.

[Commentary: Moved from Article 7(3). See paragraphs 7.08, 7.09 and R10.01]

(5) [Sanctions for Non-Compliance with Requirements Under Article 7(6)] No Contracting Party may provide for the refusal of an application for:

(i) [failure to comply with any requirement to furnish a registration number or other indication under paragraph (4), or

(ii)] failure to indicate an address for correspondence under Article 7(4), if an address which complies with the requirements applied by the Contracting Party under that Article [or paragraph (4)(b)(i)] has been otherwise furnished to the Office.

[Commentary: Moved from Article 7(6)(b). See paragraphs 7.12 and R10.01]

Rule 11bis

Notifications

(1) [Sufficient Notification] Any notification under this Treaty or the Regulations which is sent by the Office to an address for correspondence or address for legal service indicated under Article 7(4) or paragraph (4)(b)(i), and which complies with the provisions with respect to that notification, shall constitute a sufficient notification for the purposes of this Treaty and the Regulations.

(2) [If Indications Allowing Contact Were Not Submitted] Nothing in this Treaty and in 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 provided to the Office.

(3) [Failure to Notify] Subject to Article 9(1), where an Office does not notify an applicant, owner or other interested person of a failure to comply with any requirement under this Treaty or the Regulations, that absence of notification does not relieve that applicant, owner or other interested person of the obligation to comply with that requirement.

[Commentary: Moved from Article 8. See paragraph 8.04]

Rule 13

Details Concerning Continued Processing and Re-instatement of Rights Without a Finding of Due Care by the Office Under Article 11

(2 1) [Requirements Under Article 11(1)(i) Statement] (a) ~~A~~ Any Contracting Party may require that a request under Article 11(1)(i) be:

(i) signed by the applicant [or owner];

(ii) presented on a Form or in a format prescribed by that Contracting Party;

(iii) accompanied, where that request which is filed later than two months from the date of expiration of the time limit for the action referred to in that Article, paragraph ~~be accompanied~~ by a statement that the failure to comply with the time limit was unintentional.

[Commentary: Items (i) and(ii) moved from Article 11(1) and (3). See paragraphs 11.03 and R13.01]

(b) A Contracting Party which requires a statement referred to in subparagraph (a), item (iii) may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of that statement.

[Commentary: Moved from Article 11(6). See paragraphs 11.06 and R13.01]

(2 4) [Time Limits Under Article 11(1) (ii)] The time limit for making a request, and for complying with the requirements, under Article 11(1)(ii), shall be not less than two months from the date on which the applicant [or owner] was notified by the Office of the failure to comply with the time limit concerned.

[Commentary: Amendment consequential on the amendment of former paragraph (2)]

(3) [no change]

(4) [Fees] No Contracting Party may require the payment of a fee where the non-compliance with the time limit for action before the Office referred to in Article 11(1) occurred:

(i) as a result of the loss of a communication by a postal service or another delivery service specified by the Contracting Party;

(ii) as a result of a failure by the Office.

[Commentary: Moved from Article 11(5)(b). See paragraphs 11.05 and R13.01]

Rule 14

*Details Concerning Re-instatement of Rights After a Finding of Due Care or Unintentionality
by the Office Under Article 12*

[no change]

(1bis) [Requirements Under Article 12(1)(i)] (a) A Contracting Party may require that a request under Article 12(1)(i):

(i) be signed by the applicant or owner;

(ii) be presented on a Form or in a format prescribed by that Contracting Party;

(iii) state the grounds on which it is based.

[Commentary: Moved from Article 12(1) and (3). See paragraphs 12.03, 12.04 and R14.04]

(b) A Contracting Party may require that a declaration or other evidence in support of the grounds referred to in subparagraph (a)(iii) be furnished to the Office within a time limit fixed by the Office.

[Commentary: Moved from Article 12(1) and (3). See paragraphs 12.03, 12.04 and R14.04]

(2) [no change]

Rule 15

Details Concerning ~~Addition and~~ Restoration of Priority Claim Under Article 13

(1) [incorporated into Rule 6(2)(c)]

[Commentary: See paragraphs 13.01 and R15.01]

(2) [no change]

(2bis) [Requirements Under Article 13(2)] A Contracting Party may require that a request under Article 13(2):

(i) be signed by the applicant;

(ii) be presented on a Form or in a format prescribed by that Contracting Party;

(iii) be made before the expiration of the time limit applicable under paragraph (2) and before any technical preparations for publication have been completed;

(iv) state the ground[s] on which it is based;

(v) be subject to a finding by the Office that the failure to furnish the subsequent application within the priority period occurred in spite of all due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional; and

(vi) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

[Commentary: Moved from Article 13(2) and (4). See paragraphs 13.02, 13.04, 13.05 and R15.03]

(3) [Requirements ~~Time Limit~~ Under Article 13(3)(a)(ii)] (a) A Contracting Party may require that a request under Article 13(3):

(i) be signed by the applicant;

(ii) be presented on a Form or in a format prescribed by that Contracting Party:

(iii) indicate the Office to which the request for a copy of [an] [the] earlier application had been made and the date of that request; and

(iv) be subject to a finding by the Office that the request for the copy to be provided had been made, to the Office with which the earlier application was filed, within a time limit of ~~The time limit referred to in Article 13(3)(a)(ii) shall be~~ two months before the expiration of the time limit prescribed in Rule 6(1) 4(1).

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the request under Article 13(3) be furnished to the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in Article 13(3) be furnished to the Office within a time limit which ~~(4) [Time Limit Under Article 13(3)(b)(ii)]~~ The time limit referred to in Article 13(3)(b)(ii) shall be not less than one month from the date on which the applicant is provided with that the copy referred to in that provision by the Office with which the ealier application was filed.

[Commentary: Moved from paragraph (4) and Article 13(3) and (4). See paragraphs 13.03 to 13.05 and R15.03]

Rule 16

Request for Recordal of Change in Name or Address

(1) and (2) [no change]

(3) [incorporated into Article 7(1bis)]

[Commentary: See paragraph R16.04]

(4) *[Fees]* A Contracting Party may require that a fee be paid in respect of a request ~~Article 5(6) shall apply, mutatis mutandis, to requests under paragraph (1).~~

[Commentary: See paragraph R16.05]

(5) to (10) [no change]

Rule 17

Request for Recordal of Change in Applicant or Owner

(1) to (3) [no change]

(4) [~~Language;~~ Translation] A Contracting Party may require that:

~~(i) — the request referred to in paragraph (1) and the certificate of transfer referred to in paragraph (3)(a)(iii) be in a language accepted by the Office;~~

(ii) — where a document submitted under paragraph (3)(a)(i) or (ii), (b), (c) or (d) is not in a language accepted by the Office, that document be accompanied by a translation.

[Commentary: See paragraph R17.02. Item (i) incorporated into Article 7(1bis)]

(5) [~~Fees~~] A Contracting Party may require that a fee be paid in respect of a request
~~Article 5(6) shall apply, mutatis mutandis, to requests under paragraph (1).~~

[Commentary: See paragraph R17.02]

(6) to (11) [no change]

Rule 18

Request for Recordal of Change in Licensing Agreement or Security Interest

(1) to (3) [no change]

(4) [~~Language;~~ Translation] A Contracting Party may require that:

~~(i) — the request referred to in paragraph (1) be in a language accepted by the Office;~~

(ii) if the document referred to in paragraph (3) is not in a language accepted by the Office, that document be accompanied by a translation.

[Commentary: See paragraph R18.02. Item (i) incorporated into Article 7(1bis)]

(5) *[Fees]* A Contracting Party may require that a fee be paid in respect of a request Article 5(6) shall apply, *mutatis mutandis*, to requests under paragraph (1).

[Commentary: See paragraph R16.05]

(6) to (11) [no change]

Rule 19

Request for Correction of a Mistake

(1) and (2) [no change]

(3) [incorporated into Article 7(1bis)]

[Commentary: See paragraph R19.06]

(4) *[Fees]* Subject to subparagraph (b), a Contracting Party may require that a fee be paid in respect of a request Article 5(6) shall apply, *mutatis mutandis*, to requests under paragraph (1).

(b) The Office [of a Contracting Party] shall correct its own mistakes, *ex officio* or upon request, for no fee.

[Commentary: Subparagraph (b) moved from paragraph (9). See paragraphs R19.06 and R19.07]

(5) to (8) [no change]

(9) [incorporated into paragraph (4)(b)]

(10) and (11) [no change]

Rule 20

Manner of Identification of an Application Without Its Application Number

[no change]

Rule 21

Establishment of Model International Forms and Formats

(1) [*Model International Forms; Request Form Under Rule 2bis(3)(b)*] (a) [no change]

(abis) The Assembly shall establish the modifications to the Patent Cooperation Treaty request Form referred to in Article 5(2)(b).

[Commentary: See paragraphs R3.01 and R21.02. Article 14(1)(a)(ii) would appear to provide sufficient authority for this provision.]

(b) The International Bureau shall present proposals to the Assembly concerning:

(i) the establishment of Model International Forms referred to in subparagraph (a);

(ii) the modifications to the Patent Cooperation Treaty request Form referred to in subparagraph (abis).

[Commentary: See paragraph R3.01 and R21.02. The general authority under Article 14(1)(a)(ii) provides vires for new subparagraphs (abis) and (b)(ii)]

(2) [no change]

[End of Annex 3 and of document]