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WORLD INTELLECTUAL PROPERTY ORGANIZATION

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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)****ASSEMBLY****Twenty-Eighth (16th Extraordinary) Session
Geneva, March 13 to 17, 2000****PROPOSED AMENDMENTS OF PCT RULE 51bis***Proposal by the Netherlands***INTRODUCTION**

With relation to document PCT/A/28/2, to be discussed by the PCT Assembly at its forthcoming session in Geneva from March 13 to 17, 2000, the Netherlands Industrial Property Office would like to make the following remarks.

Rule 51bis.1(d)

In Rule 51bis.1 the emphasis is on what the national law applicable by the designated Office may require. The proposed second sentence of Rule 51bis.1(d) therefore better could be rephrased along the lines that it is allowed to require certification, but only in certain circumstances.

As a consequence, paragraph (d) can be presented in the form of a heading with two subparagraphs.

Rule 51bis.1(e)

Requiring a translation seems a formal rather than a substantial requirement. Therefore a reference to Article 27(1) is preferred.

Specifying the language of translation does not seem to be necessary. PCT Rule 17.2(a) already mentions the possible requirement to furnish a translation, without any further specification of the language to be used.

Paragraph (e) then can concentrate on what it wants to indicate, namely that it is allowed to require a translation, provided that the validity of the priority claim is relevant to the determination of the patentability of the invention.

Rule 51bis.1(f)

This paragraph should make more clear what the subject matter of the transitional reservation has to be. The transitional reservation concerns the restriction of the circumstances in which a translation may be required, that is, the proviso in paragraph (e).

Rule 51bis.2

From the new title of this Rule, a reader not familiar with the PCT might get the impression that the Rule covers all circumstances in which documents or evidence may be required.

Consequently, in circumstances not mentioned in Rule 51bis.2 no documents or evidence would be required.

Actually, however, Rule 51bis.2 outlines particular circumstances in which documents or evidence may not be required.

It is therefore suggested to amend the proposed title of Rule 51bis.2 by inserting “Certain” at the beginning and inserting “Not” between “May” and “Be”.

Rule 51bis.3(a)

It seems helpful to indicate in Rule 51bis.3 which regime applies to the requirements specifically mentioned in Rule 51bis.1. Expanding the proposed wording of Rule 51bis.3(a) is sufficient for this purpose.

The following proposal with relation to the wording of PCT Rule 51bis reflects the remarks made above.

PROPOSED AMENDMENTS OF RULE 51bis

Rule 51bis

Certain National Requirements Allowed Under Article 27~~(1), (2), (6) and (7)~~

51bis.1 Certain National Requirements Allowed

(a) [As proposed in document PCT/A/28/2]

(b) and (c) [As proposed in document PCT/A/28/2 – that is, no change]

(d) The national law applicable by the designated Office may, in accordance with Article 27(2)(ii), require that the translation of the international application furnished by the applicant under Article 22 be:

(i) verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful;

(ii) certified by a public authority or sworn translator, but only where the designated Office reasonably doubts the accuracy of the translation.

(e) The national law applicable by the designated Office may, in accordance with Article 27(1), require that a translation of the priority document be furnished by the applicant, provided that such a translation may only be required where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

(f) If, on March 17, 2000, the proviso in paragraph (e) is not compatible with the national law applied by the designated Office, that proviso shall not apply in respect of that Office for as long as that proviso continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by June 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

51bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required

[As proposed in document PCT/A/28/2]

~~51bis.2~~ 51bis.3 *Opportunity to Comply with National Requirements*

(a) Where any of the requirements referred to in Rule 51bis.1 (a)(i) to (iv) and (vi), and (c) to (e), or any other requirement of the national law applicable by the designated Office which that Office may apply ~~under~~ in accordance with Article 27(1); or (2); ~~(6) or (7)~~; is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, ~~the applicant shall have an opportunity to comply with the requirement after the expiration of that period~~ the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for complying with national requirements in response to the invitation.

(b) [As proposed in document PCT/A/28/2]

[End of document]