
International Patent Cooperation Union (PCT Union)

Assembly

**Forty-Third (25th Extraordinary) Session
Geneva, October 1 to 9, 2012**

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

Document prepared by the International Bureau

SUMMARY

1. This document contains proposals for amendment of the Regulations under the Patent Cooperation Treaty (PCT)¹, as recommended by the PCT Working Group (“the Working Group”). The effect of the proposals is a simplification of procedures for applicants from all Contracting States, made possible by the enactment of the America Invents Act (AIA) by the Government of the United States of America.

¹ References in this document to “Articles” and “Rules” are to those of the PCT and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be. References to “national laws”, “national applications”, “the national phase”, etc., include references to regional laws, regional applications, the regional phase, etc.

PROPOSAL

2. The AIA was signed into law on September 16, 2011. Consequential on the provisions of the AIA, it is no longer necessary for an inventor to be named as an applicant for the designation of the United States of America, allowing significant simplifications to be made in the PCT procedure. This change will benefit PCT applicants from all Contracting States by removing the need for inventors to sign the international application (or power of attorney) in their capacity as applicants. In addition, the special procedure which at present applies in cases where it is not possible to obtain the signature of an inventor who had been named as an applicant only for the purpose of the designation of the United States of America (see Rules 4.15(b), 53.8(b) and 90*bis*.5(b)) will be eliminated. This change will also simplify withdrawals, since inventors (who will no longer be required to be named as applicants) will no longer need to sign the notice of withdrawal.
3. An inventor's oath or declaration will still be required by the United States Patent and Trademark Office (USPTO) as designated Office (in the national phase) though the applicant may choose to comply with this requirement during the international phase (see PCT Rule 4.17).
4. Annex I contains proposed amendments:
 - (a) to Rules 4.15, 53.8 and 90*bis*.5 in relation to the matter of signatures; and
 - (b) to Rule 51*bis*, simplifying the provisions which permit documents containing oaths or declarations of inventorship to be required by the designated Office in certain circumstances, and limiting the extent to which the designated Office may require further documents or evidence relating to such oaths and declarations furnished during the international phase.
5. The proposed amendments were considered by the Working Group during its fifth session, held in June 2012, at which the Working Group agreed on proposed amendments to be submitted to the Assembly for adoption at the present session (see the Summary by the Chair, document PCT/WG/5/21, reproduced in Annex I to document PCT/A/43/1).

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

6. The relevant provisions of the AIA will enter into force on September 16, 2012 and apply to any patent application filed on or after September 16, 2012. In view of the benefits that those provisions will bring to applicants from all Contracting States seeking to obtain patent protection in the United States of America by way of an international application, it appears desirable to have the amendments to the PCT Regulations enter into force as soon as possible. It is thus proposed that those amendments should enter into force on January 1, 2013, and should apply to any international application whose international filing date is on or after that date. While this would only leave relatively little time for the necessary update to the PCT Receiving Office Guidelines and the necessary modifications to various PCT forms and IT systems, the International Bureau will make every effort to ensure a timely implementation of the necessary updates and modifications.
7. It is thus proposed that the Assembly adopt the following decision concerning entry into force and transitional arrangements in respect of the proposed amendments of the Regulations set out in Annex I:

"The amendments of Rules 4.15, 51*bis*.1, 51*bis*.2, 53.8 and 90*bis*.5 set out in Annex I shall enter into force on January 1, 2013, and shall apply to any international application whose international filing date is on or after that date."

8. A “clean” text of all of the proposed amended provisions (without underlining or striking through) appears in Annex II.

9. *The Assembly of the PCT Union is invited:*

(i) to adopt the proposed amendments of the Regulations under the PCT set out in Annex I; and

(ii) to adopt the proposed decision set out in paragraph 7, above, relating to entry into force and transitional arrangements.

[Annexes follow]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS²

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. A “clean” copy of the proposed amended provisions (without underlining or striking through) appears in Annex II.

Rule 4

The Request (Contents)

4.1 to 4.14 [No change]

4.15 *Signature*

(a) The ~~Subject to paragraph (b), the~~ request shall be signed by the applicant or, if there is more than one applicant, by all of them.

~~(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor refused to sign the request or could not be found or reached after diligent effort, the request need not be signed by that applicant if it is signed by at least one applicant and a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of the signature concerned.~~

4.16 to 4.19 [No change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iii) [no change]

(iv) where the international application designates a State whose national law requires, on [date of the Assembly decision to amend this Rule] the furnishing of an oath or declaration of inventorship ~~that national applications be filed by the inventor~~, any document containing an oath or declaration of inventorship,

(v) to (vii) [no change]

(b) to (f) [No change]

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

(a) ~~Where the applicable national law does not require that national applications be filed by the inventor, the~~ The designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is contained in the request or is submitted directly to the designated Office;

[Rule 51bis.2(a), continued]

(ii) [no change]

(iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;

(iv) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.

~~(b) Where the applicable national law requires that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:~~

~~(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv))), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request;~~

~~(ii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;~~

[Rule 51bis.2(b), continued]

~~(iii) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.~~

~~(c) If, on March 17, 2000, paragraph (a) is not compatible, in relation to any item of that paragraph, with the national law applied by the designated Office, paragraph (a) shall not apply in respect of that Office in relation to that item for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.~~

51bis.3 [No change]

Rule 53

The Demand

53.1 to 53.7 [No change]

53.8 *Signature*

~~(a) Subject to paragraph (b), the The demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.~~

~~(b) Where two or more applicants file a demand which elects a State whose national law requires that national applications be filed by the inventor and where an applicant for that elected State who is an inventor refused to sign the demand or could not be found or reached after diligent effort, the demand need not be signed by that applicant (“the applicant concerned”) if it is signed by at least one applicant and~~

~~(i) a statement is furnished explaining, to the satisfaction of the International Preliminary Examining Authority, the lack of signature of the applicant concerned, or~~

~~(ii) the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with.~~

53.9 [No change]

Rule 90bis
Withdrawals

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

~~(a)~~ Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall, ~~subject to paragraph (b),~~ be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, ~~subject to paragraph (b),~~ not be entitled to sign such a notice on behalf of the other applicants.

~~(b) Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant ("the applicant concerned") if it is signed by at least one applicant and~~

~~(i) a statement is furnished explaining, to the satisfaction of the receiving Office, the International Bureau, the Authority carrying out the supplementary international search or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or~~

~~(ii) in the case of a notice of withdrawal referred to in Rule 90bis.1(b), 90bis.2(d), 90bis.3(c) or 90bis.3bis(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or~~

~~(iii) in the case of a notice of withdrawal referred to in Rule 90bis.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with.~~

90*bis*.6 and 90*bis*.7 [No change]

[Annex II follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

(CLEAN TEXT)

Proposed amendments of the PCT Regulations are set out in Annex I, in which additions and deletions are shown, respectively, by underlining and striking-through of the text concerned. This Annex contains, for convenient reference, a “clean” text of the relevant provisions as they would stand after amendment.

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Rule 4

The Request (Contents)

4.1 to 4.14 [No change]

4.15 *Signature*

The request shall be signed by the applicant or, if there is more than one applicant, by all of them.

4.16 to 4.19 [No change]

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Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iii) [no change]

(iv) where the international application designates a State whose national law requires, on [date of the Assembly decision to amend this Rule] the furnishing of an oath or declaration of inventorship, any document containing an oath or declaration of inventorship,

(v) to (vii) [no change]

(b) to (f) [No change]

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

(a) The designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is contained in the request or is submitted directly to the designated Office;

[Rule 51bis.2(a), continued]

(ii) [no change]

(iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;

(iv) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.

51bis.3 [No change]

Rule 53

The Demand

53.1 to 53.7 [No change]

53.8 *Signature*

The demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.

53.9 [No change]

Rule 90bis
Withdrawals

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall not be entitled to sign such a notice on behalf of the other applicants.

90bis.6 and 90bis.7 [No change]

[End of Annex II and of document]