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CERTAIN QUESTIONS CONCERNING THE USE OF THE PCT

Memorandum prepared by the International Bureau

INTRODUCTION

1. The International Bureau, during various PCT Seminars, the PCT Users Meeting held in Geneva in October 1979, and on various other occasions, has heard arguments against the use of the PCT. The documents received or invited during the said Users Meeting, reproduced in document PCT/A/V/3, reflect most of those arguments. In this document, an attempt is made to indicate what seem to be the more frequent arguments that persons criticizing the PCT invoke as to what makes the use of the PCT hazardous. The Assembly should be aware of those arguments so that it can, when the arguments are unjustified, deny their validity and, when they are justified, take the necessary measures on the international level, or encourage the taking of measures on the national level, as the case may be, to render the use of the PCT more attractive.
2. This document has two Parts. Part I deals with questions concerning the international phase, while Part II deals with questions concerning the national phase.

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PART I

QUESTIONS CONCERNING THE INTERNATIONAL PHASE

Possibility of Mistakes in the Payment of Fees

3. *Present situation.* The due date for payment of the transmittal fee (collected by the receiving Office for its own benefit) is left to the discretion of the receiving Office (Rule 14.2).
4. The basic fee and the search fee are due on the date of receipt of the international application by the receiving Office (Rule 15.4(a) and 16.1(b)); the designation fee must be paid at the latest within one year from the priority date (Rule 15.4(b)); lack of receipt of the said fees may be notified to the applicant and permission to pay after the due date may be granted by the receiving Office but, however, may not go beyond one month after the date of receipt of the international application and may not be subject to any extra charge (Rule 15.4(c)).
5. In other words, there is no obligation to excuse the late payment of any of these four kinds of fees; there is a limit (of one month) to the possibility of excusing the late payment of the basic fee, the designation fee and the search fee; there is no limit to the possibility of excusing the late payment of the transmittal fee.
6. *Fears of potential users.* Some of the potential users of the PCT say that late or insufficient payment may be due to inadvertence or error on their part, or delays in the transmittal of the moneys intended for the receiving Office. They ask that the rules be more flexible and that the institution of a grace period, known in many national laws, should be made mandatory.
7. *Response to the fears.* One of the responses consists in obliging each receiving Office to excuse late payment within a certain time limit (hereinafter referred to as “the grace period”) and allow it to charge a surcharge. The proposals made in document PCT/A/V/4, page 35 would oblige each receiving Office to invite the applicant to pay any missing fee and to grant him a grace period of one month from the date of invitation. The said proposals would oblige the charging of a surcharge when the grace period is made use of. It is to be noted that these measures would apply to each and all of the four kinds of fees mentioned above.
8. Some of the receiving Offices may argue that the proposed rules would require a change in their domestic law or regulations. In response to such a possible objection, the said proposals provide for the possibility of excluding the application of the new rules by any receiving Office. Such exclusion would have to be notified to the International Bureau which would publish the notification in the PCT Gazette. Consequently, there would be clear information on the question which countries apply, and which exclude the application of, the proposed grace period solution. And, it is to be hoped that sooner or later such countries would make the required changes in their domestic law or regulations and, then, withdraw the said exclusion.

Possibility of Late Arrival of the Record Copy in the International Bureau

9. *Present situation.* Article 12 of the PCT provides that “the international application shall be considered withdrawn if the record copy has not been received by the International Bureau within the prescribed time limit.” The PCT Regulations fix that time limit at 14 or 13 months from the priority date depending on the route that the applicant chose to follow (transmittal to the International Bureau by the receiving Office or by the applicant, respectively). In the experience of the International Bureau, all the applicants choose transmittal by the receiving Office, that is, they choose the procedure under which the time limit is 14 months.

10. *Fears of potential users.* Some of the potential users of the PCT expressed the fear that the 14-month time limit might be too short.

11. *Response to the fears.* It is to be noted that so far no record copy arrived beyond the applicable time limit. Consequently, one could say that the fears are unfounded in practice. But since the possibility of missing the normal time limit exists at least in theory, responses to those fears ought to be found.

12. *Several responses are possible.* The simplest of them seems to consist in prolonging the time limit. This response is recommended in document PCT/A/V/4, page 43) prepared for the present session of the Assembly. It consists in prolonging the time limit by one month. Thus the time limit would become 15 months where it is 14 months today, and it would become 14 months where it is 13 months today. (In the following paragraph, this will be called “the normal time limit.”)

13. Another solution would consist not only in prolonging the time limit but also allowing the International Bureau to appreciate the reasons for any missing of the normal time limit and excuse it. If this suggestion is followed, limits to the resulting discretionary power of the International Bureau would have to be set. For example, one could provide that if the missing of the normal time limit is due to an oversight of the receiving Office or the applicant, the limit would consist of one additional month, whereas if it is due to postal strike or other vis major that started prior to the expiration of the normal time limit, the limit would be extended for a month after the postal strike or other vis major ceased but not beyond, say, three months from the expiration of the normal time limit. Should this proposal be adopted, Rule 22.3(b) would have to be repealed, as already suggested in document PCT/A/V/S, page 6.

Communication of a Copy of the International Application to Each Designated Office

14. *Present situation.* Each designated Office has the right to a copy of the international application (in its original language) (PCT, Article 20(1) (a)). It may waive this right (*ibidem*). Several countries have done so initially, but only one Luxembourg has maintained its waiver.

15. The communication of such a copy is to be effected by the International Bureau which, itself, prepares the copy needed for the communication (Rule 47.1(a) and 47.2(a)). (The copy normally is a copy of the published pamphlet.) The communication has to be effected within certain time limits (Rule 47.1(b)). On the same day on which the communication is made, the

International Bureau sends a notice to the applicant indicating that the communication has been effected (Rule 47.1 (c)).

16. Should the International Bureau fail to communicate the copy of the international application, the obligation is on the applicant to furnish the copy by the expiration of the 20th month from the priority date (PCT Article 22(1)).

17. *Problems and proposed solutions.* There are at least three problems in connection with this matter.

18. The first problem is that the waiver, by Luxembourg, of communication by the International Bureau of a copy of the international application, causes difficulties both for the International Bureau (because it has to make an exception to the routine which is followed in respect of all other designated States) and the applicant (who must transmit the copy himself to the Luxembourg Office and cannot rely on the non-existent communication by the International Bureau). The International Bureau, therefore, would welcome it if Luxembourg could renounce on its waiver.

19. The second problem is that one country Austria requires the applicant to furnish a copy of the international application to the Austrian Patent Office even where that Office has already received a copy from the International Bureau. Doubts have been expressed as to the compatibility of such a requirement with PCT Article 22(1) which provides that the applicant must furnish a copy of the international application to the designated Office "unless the communication provided for in Article 20 has already taken place." It is much hoped that Austria will abandon this requirement which is both burdensome (one more operation to monitor and effectuate by the applicant) and confusing for the applicant (since he does not have to do it in respect of other designated Offices).

20. The third problem is that at least the United States Patent and Trademark Office requires that ultimately the applicant himself shall ensure that it receives a copy of the international application. This requirement is understood to apply even where the applicant received the notice from the International Bureau informing him about the communication of the copy, if the copy did not reach the United States Patent and Trademark Office as designated Office or if the copy which reached the United States Patent and Trademark Office as designated Office was not complete. How does the applicant know whether the designated Office received a complete copy? Is an applicant who received the said notice obliged to check with the designated Office as to whether a complete copy of his international application has been received by the designated Office? What happens if the designated Office indicates mistakenly that a complete copy has "been received? The International Bureau believes that the applicant is not responsible for (since he has no possibility of checking and the PCT cannot be read as making the applicant responsible for actions which are entrusted to an international authority over which he has no control) :

(a) The adequacy of the communication (if it is defective in any way, the designated Office must look to the International Bureau to remedy the defect);

(b) Whether the communication has, in fact, taken place. The answer and solution to this question can only be that any applicant who received the said notice should rely on the notice. In the case of the European Patent Office (in which the provisions of the PCT itself are applied), the applicant again is required to provide a copy "unless the communication provided for in Article 20 has already taken place." It is understood that no difficulty arises in

the case where the copy which is communicated by the International Bureau is not complete-- because Article 22 can be interpreted as referring only to the fact of communication. Moreover, the chapter of the PCT Applicant's Guide dealing with the European Patent Office as designated or elected Office states that upon receiving the notice from the International Bureau (that it has effected communication) "the applicant may assume that the copy has been received by the European Patent Office." But, of course, the position of the applicant before the European Patent Office would be more certain if the PCT dealt with these questions more directly. With all of the above-mentioned considerations in mind, it has been proposed by the International Bureau that Rule 47.1(c) be amended by adding after the second sentence "Each designated Office shall be informed about the sending of the notice. The notice shall be accepted by all designated Offices as conclusive evidence that the communication has duly taken place." See document PCT/A/V/4 pages 54 and 55.

Which Claims have to be translated?

21. *Present situation.* In certain cases, the applicant has to furnish a translation of the international application to the designated Office (Article 22).

22. *The problem and suggested solution.* The problem is that it is not clear what "international application" means where, during the international phase, that is, under PCT Article 19, the claims were amended: does it mean (i) the international application as originally filed plus the amendments or (ii) the international application as amended?

23. Logically, a designated Office should be satisfied with the international application as amended since the national procedure will relate to the international application as amended (and not as originally filed). (In any case if, for some reason, the designated Office wants to know also the claims of the international application as originally filed, all it has to do is to look at the pamphlet published by the International Bureau which contains both the international application as filed and the amendments. This, however, may not be in the language the designated Office works in.)

24. On the other hand, the fact that Rule 49.3 seems to require the translation of the statement made under Article 19. (1) that is, the statement explaining the amendments (since the said Rule considers such statement to be part of the international application), could be an argument for requiring the translation also of the claims as they were prior to amendment since the statement is of interest only if both the original and the amended claims may be looked at in the same language.

25. It is proposed to solve this problem on the basis that, in the national phase, only the amended claims are of interest and, consequently, the original claims need not be translated. It is proposed that this should be expressly stated in the Regulations and that, as a corollary, Rule 49.3 should be cancelled.

PART II

QUESTIONS CONCERNING THE NATIONAL PHASE

Verification or Certification of the Translation of the International Application

26. The national Offices of Switzerland, the United Kingdom and the United States of America, as designated Offices, require that the translation of the international application furnished under Article 22(1) be verified by the translator, and the national Office of Brazil, as designated Office, requires that the Portuguese translation of the international application filed with it as designated Office be certified.

27. Doubts have been expressed as to the compatibility of this practice with what the PCT provides for the procedure both before and after the processing of the application starts in the designated Office:

(i) before the processing starts, because Article 22(1) contains a taxative enumeration of what has to be furnished to the designated Office and that enumeration refers neither to verification nor to certification;

(ii) after the processing starts, because Article 27(1) prohibits the requirement, by any designated Office, of compliance by the applicant with requirements relating to the form or contents of the international application additional to those which are provided for in the PCT or the Regulations, and neither of them provides for verification or certification.

Use of a National Form for Entering the National Phase

28. The national Offices at Japan and the United Kingdom, as designated Offices, require that for entering the national phase not only should they receive a copy of the international application and, where required, a translation thereof, but that a completed form which, in the case of the Japanese Patent Office, in its contents is even very similar to the request part of the international application should also be furnished.

29. Doubts have been expressed as to the compatibility of this practice with the PCT because the requirements for entering the national phase are taxatively enumerated in Article 22, and a national form is not among these requirements. Furthermore, the requirement of any additional requirement is prohibited under Article 27 (1).

30. It is to be noted that, at least in Japan, failure to furnish the said form at the time of entering the national phase can be remedied by furnishing it within the time limit fixed by the Japanese Patent Office in an invitation addressed by that Office to the applicant. This, however, does not seem to remove the doubts referred to above.

From What Time Can a Designated Office Require that the Applicant Be Represented by a Local Agent?

31. Following the advice of the Japanese Patent Office, the Chapter in the PCT Applicant's Guide dealing with that Office as designated or elected Office, contains the following passage: "The Japanese Patent Office only accepts documents furnished by a representative resident in Japan."

32. Doubts have been expressed as to the compatibility of this requirement with the provisions of the PCT Article 27(7) provides that the requirement that an applicant be represented by a local agent may be applied by any designated Office only "once the processing of the international application has started," that is, not earlier than the expiration of the time limit provided for in Article 23(1) (namely, normally, 20 months after the priority date). The furnishing of the translation under Article 22 a "document" within the sense of the statement quoted above from the PCT Applicant's Guide necessarily precedes the expiration of this time limit because the translation, under Article 22(1), has to be furnished before the expiration of 20 months from the priority date.

33. It should be emphasized that the International Bureau is, and always has been, of the opinion that all foreign applicants in Japan or any other country for that matter are well advised if they engage a local attorney or agent as early as possible, preferably before entering the national phase, even though, as has been said above, an obligation to appoint a local representative may only arise after the entering of the national phase.

How Many Copies of an International Application or a Translation Thereof May Be Required by any Designated Office?

34. It would seem that the national laws or regulations of several countries party to the PCT provide that the designated Office has a right to two or more copies of the international application or, where applicable, its translation, to be furnished under Article 22(1).

35. According to the present information of the International Bureau, it would seem that none of the designated Offices insists any longer on such a requirement.

36. Such a development should be noted with satisfaction because asking for several copies would be at variance with Article 22(1) since that provision speaks of the international application and, where applicable, its translation, in the singular (Ita copy" and "a translation").

At What Time Has the Oath or Declaration of the Inventor to be furnished?

37. Following the advice of the United States Patent and Trademark Office, as a designated Office, the chapter in the PCT Applicant's Guide dealing with that Office mentions that one of the requirements which the applicant must fulfill within the 20-month time limit prescribed in Article 22 of the PCT is "to file an oath or declaration of the inventor."

38. Doubts have been expressed as to the compatibility of this requirement with the PCT because Article 22(1) enumerates taxatively the acts that any applicant is required to perform in order to enter the national phase before the expiration of the 20-month time limit, and, among those acts, the furnishing of an oath or declaration of the inventor is not mentioned.

39. The requirement of such an oath or declaration is permitted by Article 27(2) of the PCT, but only “once the processing of the international application has started in the designated Office.”

40. In any case, the said practice particularly in view of the fact that the United States Patent and Trademark Office does not seem to allow the furnishing of the oath or declaration during (but only before) the national phase can cause real practical problems in the situation in which a few days or weeks, after the entry into the national phase, are necessary in order to obtain the signature or signatures certifying the oath or declaration.

At What Time Must Privileged Disclosures Be Alleged?

41. Under the Japanese Patent Law, the disclosure of an invention prior to the filing of an application in an exhibition or under certain other circumstances, if effected not earlier than six months prior to the filing of the application, does not destroy the novelty of the invention so disclosed. However, in order to be able to benefit from this provision of the Japanese Law, the Japanese Patent Office seems to require that the benefit of the said provision be claimed in a declaration filed with the application itself.

42. It would seem that an applicant filing an international application and wishing to benefit by the said provision would have to file the said declaration, together with the international application, in the receiving Office and that the declaration would have to be in the Japanese language, even if the receiving Office was not the Japanese Patent Office and even if the language of the international application was a language other than Japanese.

43. Doubts have been expressed as to the compatibility of this practice with the PCT because the elements of an international application are taxatively enumerated in Article 3, and a declaration of the said kind does not appear among them.

44. In the opinion of the International Bureau, however, this does not mean that, if the Japanese Patent Office is about to deny the granting of a Japanese patent because of a disclosure of the kind referred to above, the applicant cannot allege that the disclosure was of the said kind. Neither does it mean that the Japanese Patent Office cannot then but only then ask for a statement, in the Japanese language, to be filed with it as designated Office.

Late Payment of Fees (Federal Republic of Germany)

45. It would seem that, in the Federal Republic of Germany, the national laws provide that, where the fees relating to an application have not been paid (or have not been paid in their totality), the national Office invites the applicant to pay the missing fee and, if the applicant does so, the application is considered as filed not on the day on which the missing amount has been paid, but on the earlier day when the application has been received by the Office.

46. However, it would also seem that, when an international application reaching the German Patent Office within the time limit prescribed by Article 22(1) is not accompanied by (the totality of) the fees, the Office does “not invite the applicant to pay the missing amount, and, consequently, the designation of the Federal Republic of Germany is lost.

47. Doubts have been expressed as to the compatibility of this practice with Article 48(2) (a) which says that “any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit.” Indeed, it would seem that the provisions of the national law of the Federal Republic of Germany referred to above, in their essence, excuse delays in meeting certain time limits since, under those provisions, the late payment of (part of the) fees does not affect the filing date of the application.

Delay in Meeting a Time Limit for Entering the National Phase

48. The provisions of Article 48(2) (a), requiring delay in meeting a time limit specified in the PCT to be excused by a contracting State “for reasons admitted under its national law” have already been noted (see paragraph 47, above).

49. It would seem that in the United Kingdom the national law provides the possibility (by the exercise of an administrative discretion) of excusing the applicant’s failure to meet certain time limits by extending the time for meeting time limits (even where the time limit has already expired). However, the possibility of excusing failure to meet the time limit referred to in Article 22 (or Article 39(1)) is excluded since the provisions of the national implementing regulations which give national effect to that time limit are (amongst other provisions) expressly excluded from the purview of the said provision enabling time limits to be extended. Doubts have been expressed whether, in view of the requirements of Article 48(2) (a), this exclusion is compatible with the PCT.

Can the Designated Office Refuse Amendments Which Do Not Go Beyond Disclosure?

50. It would seem that the national Office of the Soviet Union, as designated Office, does not allow the amendments of claims in a patent application unless the amendments restrict the scope of the original claims.

51. Doubts have been expressed as to the compatibility of this practice with Article 28(2) which expressly provides that, in the procedure before the national Offices, applicants may amend the claims, provided that the amendments do not go “beyond disclosure in the international application as filed.” In other words, the only limit to the scope of the amendments of the claims that any country may provide for, is the scope of the original disclosure and not the scope of the original claims.