

# WIPO



PCT/A/V/6 Add.1  
ORIGINAL: English  
DATE: May 16, 1980

# E

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

ASSEMBLY

**Fifth Session (3<sup>rd</sup> Extraordinary)\***  
**Geneva, June 9 to 16, 1980**

CERTAIN QUESTIONS CONCERNING THE USE OF THE PCT

(ADDENDUM 1)

*Memorandum prepared by the International Bureau*

1. In Part II of document PCT/A/V/6 entitled “Questions concerning the National Phase,” an attempt has been made to call attention to certain provisions in the national law or regulations of certain Contracting States or of the practice of certain national Offices acting as designated Offices (“national requirements”) which have been cited by interested circles as disincentives of the use of the PCT and in which connection the question arose whether they were compatible with the PCT or the PCT Regulations.
2. Paragraphs 5 to 10 of this document set out three other “national requirements” which are even more frequently cited by interested circles as disincentives of the use of the PCT but which are clearly not at variance with the PCT or the PCT Regulations.

---

\* Editor’s Note: This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at [pct.legal@wipo.int](mailto:pct.legal@wipo.int)

3. All of these national requirements are, specified in the documents received during or after the PCT Users Meeting held in Geneva in October 1979 and reproduced in documents PCT/A/V/3; they have been cited in many arguments not only at the Users Meeting, but in various PCT Seminars and on other occasions when the advisability of the use of the PCT has been discussed.

4. It is clear that the decision whether these provisions should be maintained is entirely in the discretion of the interested States. It seems useful, nevertheless, that the Assembly as well as the interested States be aware of them. Where there is no hope to see the provisions changed by the national legislature or the national Office, 'an open discussion of these provisions should give an occasion for explaining the underlying reasons for them and to alleviate any fear that they may inspire in potential users of the PCT.

#### UNITED STATES OF AMERICA

5. Great concern has been expressed on many occasions about the implementing law of the United States of America, which provides that, for prior art purposes, a patent granted on the basis of an international application dates from the time that the applicant fulfilled the requirements for entering the national phase in respect of the international application (i.e., paid the national fee, filed the oath or declaration of the inventor (see, however, document PCT/A/V/6, paragraphs 37 to 40) and provided a copy of the international application and of amendments, if any, and any required translation). This provision of the US Law is based on Article 64(4) which allows any State to make a declaration that it shall for the said prior art purposes not be bound by the provisions of Article 11(3). This reservation, following from the so-called Hilmer doctrine, is considered by applicants as a discrimination against foreign applicants using the PCT although there is no truth in the allegation sometimes heard that in the United States of America an international application only has effect as from the date of the payment of fees, etc. It is important to note that an applicant is not prejudiced by the declaration made by the United States of America under Article 64(4) (a) in so far as he can use his international filing date (or even the filing date of the earlier ("priority") application where priority of an earlier application is claimed in the international application) for the purposes of obtaining a patent for his invention. Also, the international application will normally have a date for prior art purposes in the United States of America which is earlier than the date generally associated with the time limit for entering the national phase, namely, 20 months from the priority date. This earlier date will result either from the international publication of the international application or from the applicant having taken the steps to enter the national phase in the United States of America well before the expiry of 20 months from the priority date. Nevertheless, these arguments tend to underline certain disadvantages suffered by the PCT applicant by reason of the US declaration and the US implementing law.

6. Even if the US declaration cannot be soon withdrawn, it would be useful if the United States Patent and Trademark Office could make some public statement about the various effects of an international application and the dates at which those effects arise since the "folklore" surrounding the US declaration attributes wider effects to it than, in fact, such declaration has.

## UNITED KINGDOM

7. In the patent law of the United Kingdom, it is provided that the applicant may be required to provide an English translation of any document referred to in the international search report which is in a language other than English. It has been reported by PCT applicants that they incur substantial expenses in providing such translations, the more so as the cited documents may be both numerous and long. PCT applicants, interested in seeking a national patent in the United Kingdom, may, therefore, be hesitant about using the PCT since, if they follow the traditional Paris Convention route, the UK Patent Office has no right to ask for the translations of any documents.

8. Even if the UK Law cannot be soon amended on this point, it would be useful if the UK Patent Office could make some public statement to the effect that it intends to use the power for asking for such translations with great moderation and if it could publish statistics on the frequency of such cases.

## JAPAN

9. Where Japan is an elected State, a translation of the international application must be submitted to the Japanese Patent Office prior to the expiration of 20 months after the priority date even if the election of Japan was effected prior to the expiration of 19 months from the priority date. In all other elected States, such an election has the effect of delaying to the end of the 25<sup>th</sup> month after the priority date the performance by the applicant of the acts necessary to enter the national phase (included in which is the filing of a translation). This requirement is based on and is consistent with Article 64(2), but since it is at variance with the rules applicable in all the other elected Offices, applicants stand in danger of forgetting the particular requirement in the Japanese procedure, the more so as they seem not to understand the reasons for which the Japanese Patent Office needs a Japanese translation before it can start processing it.

10. Even if the Japanese Law cannot be soon amended to eliminate this special requirement, it would be helpful if the Japanese Office could use every appropriate occasion to remind the applicants of this requirement and explain the reasons for it.

[End of document]