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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

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AMENDMENT OF RULE 91 OF THE PCT REGULATIONS; INTERPRETATION OF ARTICLE 9 OF THE PCT

Memorandum prepared by the International Bureau

1. Amendment of Rule 91. It is proposed to amend Rule 91 of the PCT Regulations so that it reads as follows:

RULE 91
ERRORS IN DOCUMENTS

91.1 Rectification

(a) Subject to paragraphs (b) to (g), linguistic errors, errors of transcription and mistakes in the international application or other papers submitted by the applicant may be rectified.

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(b) If an error concerns the description, claims or drawings, it may be rectified only if the error was obvious in the sense that anyone would immediately recognize that nothing else could have been intended than what is offered as rectification.

(c) [No change]

(d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be a linguistic error, error of transcription or mistake, may invite the applicant to present a request for rectification as provided in paragraphs (e) to (g).

(e) to (h) [No change]

91.2 Manner of Carrying Out Rectifications

The Administrative Instructions prescribe the manner in which rectifications of linguistic errors, errors of transcription or mistakes shall be made and the manner in which they shall be entered in the file of the international application.

2. The reasons for the proposed amendment are the following:

(i) The present text of Rule 91 allows the rectification of what are referred to as "obvious errors of transcription" in the international application. Unlike, for example, the corresponding provision (Rule 88) of the Implementing Regulations of the European Patent Convention (the "EPC Implementing Regulations"), the present Rule 91, limits the changing of the request part of the international application or other papers submitted by the applicant according to the same rule as applies for making changes to the description, claims and drawings. The "rule" as to what may be changed is enunciated in terms of the occurrence of errors "which are due to the fact that something other than what was obviously intended was written" and of the rectification itself being "obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification."

(ii) In Rule 88 of EPC Implementing Regulations, the "rule" mentioned in the preceding paragraph applies only in the case of linguistic errors, errors of transcription and mistakes in the description, claims or drawings. As far as other papers submitted by the applicant are concerned (including the request), it is simply stated that linguistic errors, errors of transcription and mistakes may be corrected upon request.

(iii) To apply, in the case of the request, the more limited and more stringent formulation in terms of errors of transcription that are obvious, rather than simply to permit the correction of what can be demonstrated as mistakes, seems less appropriate than so to apply it in the case of those elements which contain the disclosure of the international application. In the request, mistakes will frequently occur that are not obvious in the strict terms of present Rule 91.1 (b) literally applied. Indeed, this was recognized at least implicitly by the Interim Advisory Committee for Administrative Questions (see the Report of its Eighth Session, held in Geneva from October 10 to 17, 1977, document PCT/AAQ/VIII/21, paragraph 84) when it agreed that, in determining whether an obvious error of transcription has occurred in the filing date of an earlier application indicated in the priority claim, reference may be had to the priority document if it is in the possession of the receiving Office (to show that the error is obvious even though it would not be obvious in the request). It was also recognized by implication by the Assembly at its fifth session held in Geneva from June 9 to 16, 1980, when it adopted the amendment to Rule 4.10 (b) (ii) which enables the receiving Office to correct, as obvious errors of transcription in the priority claim, mistakes in or the omission of the identity of the country in which the priority application was filed or the date on which it was filed having regard to the priority application if it is in the possession of the receiving Office.

(iv) The request by its very nature (it contains a number of items of data which are mostly isolated items) is likely to contain mistakes which will not always be “obvious” in the limited and strict sense provided in Rule 91.1(b) at present, except where they are misspellings of names or addresses or perhaps where they are incorrect but well-known terms. Nevertheless, it is believed that the correction of demonstrable mistakes therein (occurring as at the time of filing) should be permitted.

(v) Under Rule 88 of the EPC Implementing Regulations, for example, correction has been allowed (by a decision of a Legal Board of Appeal)[*] of a mistake consisting of the omission of a designation which the applicant had instructed to be made but which was omitted due to a mistake on the part of his professional representative. With the PCT, not only this kind of mistake but mistakes in failing to indicate (or properly indicate) the desire to obtain a European patent are sometimes known to be made. It would be in the interest of the users of the PCT that the possibility of correcting mistakes in the request of the international application were to be clearly established. It should be emphasized that a “later designation” would not be permitted by such means; in the case cited above, the decision of the Legal Board of Appeal took into consideration the fact that under the European Patent Convention it is necessary to make designations in the application at the time of filing (in this respect the European Patent Convention is the same as the PCT) but did not regard this as preventing the correction of the request. The International Bureau is of the opinion that, so far as the PCT is concerned, a similar position would obtain if a more flexible criterion for permitting the correction of mistakes in the request were to be included in the PCT. This is what the proposed amendment is intended to achieve.

3. It is suggested that the amendment, if adopted, should enter into force on October 1, 1981. It is to be noted that the proposed amendment does not affect any substantive principle and does not seem to require the change of any national law or regulation. Consequently, its introduction at the proposed date should cause no difficulty to any Contracting State or international authority.

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[*] See Official Journal EPO 9/1980 at page 293

4. The Assembly is invited to amend, with October 1, 1981, as effective date, Rule 91 as proposed in paragraph 1, above.

5. *Interpretation of Article 9*. It is provided in Article 9 that any resident or national of a Contracting State may file an international application.

6. From time to time, the question arises as to the application of this provision when the international application is filed by a person acting in a representative capacity (e.g., a person who is administering the estate of a deceased person). A similar situation could, of course, arise in case the law vests in a person, in a particular situation (for example, due to the insanity of the person properly entitled), property and/or rights which the first-mentioned person holds and/or exercises but not for his own benefit.

7. The view of the International Bureau is that Article 9 is not concerned with the capacity in which a person who as applicant files an international application is acting when filing the application. In other words, even if, in fact, the applicant is acting in a representative capacity, it is not for the receiving Office to attempt to go behind the person who is the applicant and to treat some other person as being the applicant when it is determining the right to file the international application (Article 9 and Rules 4.8 and 18.4) or the competent receiving Office (Articles 10 and 11(1) (i) and Rule 19.1(a) by reference to the nationality or residence of the applicant.

8. Of course, it is the receiving Office which must determine what are the country of residence and the nationality of the applicant (see Rules 18.1 and 19.1). And it is by the application of its own national law that it will determine the country of residence and the nationality of the applicant. While that law is not precluded from taking into account the status of the applicant (e.g., as a person administering the estate of deceased person) for this purpose (if that should be provided by the national law), this is altogether different from treating another person .as the being applicant when the applicant is acting in a representative capacity.

9. The Assembly is invited to consider the above interpretation and if it agrees, to adopt it.

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