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NOTES

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INTRODUCTION

1. The present document contains Notes on the provisions of the draft Treaty and the draft Regulations contained in document PLT/CE/V/2.

2. The Notes sometimes refer to Model International Forms as being part of the Regulations. As explained in paragraph 4 of the Introduction to document PLT/CE/V/2, revised drafts of those Forms will be presented to a future session of the Committee of Experts. Consequently, any reference in the Notes to the Model International Forms has to be construed as a reference to a future version of the documents to be submitted in due course to the Committee of Experts.

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I. NOTES ON THE DRAFT TREATY

Note on Article 1

(Abbreviated Expressions)

1.01 Item (i). It is envisaged that the term “Office” would include national Offices of States party to a regional patent system, but would only include a regional Office if the organization to which that Office belongs is a Contracting Party. For example, the Treaty will only apply to the European Patent Office once the European Patent Organisation has become a Contracting Party (see also Note 1.05).

1.02 Items (ii) and (iii). As regards the applicability of the Treaty to special titles of protection and to international applications under the Patent Cooperation Treaty (PCT), reference is made to Article 2(1)(b) and (2) respectively (see Notes 2.03 and 2.04). The Treaty also does not govern applications for patent term extensions, for example, in respect of patents for pharmaceutical products under Japanese and European Economic Community law since these are not applications for the grant of a patent. In addition, it does not govern “conversion applications” (for example, applications for the conversion of an application for a European Patent into a national application for one or more States designated in the European application) since these are requests for a different type of treatment rather than applications for the grant of a patent.

1.03 Item (iv). Neither the Treaty nor the Regulations contains a definition of what constitutes a legal entity. This is left to the applicable law of the Contracting Party where patent protection is sought. Thus the Treaty could also apply to an entity that is assimilated to a legal entity under the applicable national law, for example, an *Offene Handelsgesellschaft* under German law.

1.04 Item (v). The term “communication” includes both documents presented in paper form and, where permitted by the Contracting Party, electronically transmitted documents. Where the Treaty refers to a communication being signed, sent, or transmitted by a postal or other delivery service, as is the case under various provisions of Articles 7 to 12, 14 and 15 and

Rules 6, 7 and 9, it is apparent that the term “communication” does not include oral communications (see Notes 9.02, 10.03, 11.01, 12.04, 14.04, 14.11, 15.09 and 15.15), either in person or by telephone. However, in the context of a request for the extension of a time limit under Article 13, the term “communication” would include an oral communication where such an oral communication was permitted by the Office. However, no Office would be obliged to allow oral requests under that Article (see Note 13.06). In addition, any Contracting Party could apply the requirements under Article 7(5), to provide a reference to a power of attorney or indication under which a representative is registered, to any oral communications to the Office which it may, but would not be obliged to, allow.

1.05 Item (vi). The term “records of the Office” is used in the definitions of “recordal” (item (vii)), “applicant” (item (viii)) and “owner” (item (ix)), and in defining mistakes for the purposes of requesting correction (Article 12(1)(a)). The term refers to the collection of all information maintained or recorded by an Office in respect of applications filed with, and patents granted by, that Office or by another authority with effect for the Contracting Party concerned, for example, information maintained by a Contracting State to the European Patent Convention in respect of European patents granted by the European Patent Office designating that Contracting State, irrespective of whether the European Patent Organisation is a Contracting Party. This provision is important for Articles 9 and 10. The term “records of the Office” also includes the texts of such applications (description, claims, abstract, drawings, etc.), as well as any amendments or corrections requested or made. Information concerning both applications and patents are included, since certain changes (concerning, for example, a change in a name or address, a change in ownership or the correction of a mistake) could apply equally to pending applications and to granted patents.

1.06 Item (vii). The term “recordal” refers to any act of including information in the records of the Office, regardless of the means used for including such information or the medium in which the data are recorded or stored.

1.07 Items (viii) and (ix). These items are intended to link the obligations concerning applicants and patent owners to the persons that are indicated as such in the records of the Office, rather than to the persons that might have legal claims of ownership or other rights outside of the context of those records. This is because the Office cannot reasonably be

expected to undertake actions concerning persons which are not listed in its records, nor to act on the basis of legal claims and titles outside of its knowledge. Where the applicable law of a Contracting Party provides that a patent must be applied for in the name of the actual inventor or inventors, the applicant is the inventor or joint inventors who are applying for the patent. Where the applicable law permits a person to apply for a patent in place of an inventor who is, for example, dead, insane, legally incapacitated, refuses to sign or cannot be reached, the applicant is that person who is applying for the patent in the place of the inventor. Where the applicable law provides that an application may be filed by any national or legal person, the applicant is the person who is applying for the patent. Where the applicable law of a Contracting Party provides that several persons may jointly be applicants or owners, the words “applicant” and “owner” must be construed as including “applicants” and “owners.”

1.08 In the case of a request for recordal of a change in ownership which involves a change of applicant or owner (see Article 10), during the period of time between the actual legal transfer and recordal of the change in ownership, the transferor continues to be referred to in the Treaty as the “applicant” or “owner” (that is, the person shown in the records of the Office as the applicant or owner), and the transferee is referred to as the “new applicant” or “new owner” (see Article 10(1)). Once recordal of the change in ownership has taken place, the transferee becomes the “applicant” or “owner” (since he is now the person shown in the records of the Office as the applicant or owner).

1.09 Item (x). The term “representative” refers to any lawyer, agent or other person, or to any firm or partnership, that can be a representative under the law applicable to the Office. Each Office is free to restrict representation to representatives admitted to practice before it, for example, to registered patent attorneys (see Article 7(1)). Questions regarding the name of the representative are regulated by Rule 7(1)(b).

1.10 Item (xi). This item seems to be self-explanatory.

1.11 Item (xii). References in the Treaty or Regulations to a requirement, procedure, etc., “under the Patent Cooperation Treaty” are to be construed as references to such a

requirement, procedure, etc., under the provisions of the PCT itself, the Regulations under the PCT or the Administrative Instructions under the PCT.

1.12 Item (xiii). This item and definitions of other terms used in the administrative and final provisions of the Treaty are reserved because those provisions have not yet been drafted.

Note on Article 2

(Applications and Patents to Which the Treaty Applies)

2.01 Paragraph (1)(a). The Treaty and Regulations would apply to applications filed with the Office of any State which is a Contracting Party. Thus, in the case of a Contracting Party which is a State, the Treaty and Regulations would apply to national applications filed with the national Office of that State. In case of a Contracting Party which is an intergovernmental organization, the Treaty and Regulations would apply to applications filed with the Office of that intergovernmental organization, irrespective of the States designated in those applications. Accordingly, where, for example, the European Patent Organisation and a State X which is a Contracting State of that Organisation were both party to the Treaty, the Treaty and Regulations would apply both to European applications and to national applications filed with the Office of State X. However, if State X were, but the European Patent Organisation were not, party to the Treaty, the Treaty and Regulations would apply to national applications filed with the Office of State X, but not to European applications, even if State X were designated. Conversely, if the European Patent Organisation were, but State X were not, party to the Treaty, the Treaty and Regulations would apply to European applications, including those designating State X, but would not apply to national applications filed with the Office of State X.

2.02 In the case of patents, the Treaty and Regulations would apply both to patents granted by the Office of a Contracting Party and to patents granted on behalf of that Contracting Party by another Office, in particular, the Office of an intergovernmental organization, irrespective of whether or not that intergovernmental organization were party to the Treaty. For example, if State X referred to in Note 2.01 were party to the Treaty, the Treaty and Regulations would

apply both to patents granted by the Office of State X and to patents granted by the European Patent Organisation having effect in State X, irrespective of whether or not the European Patent Organisation were party to the Treaty.

2.03 Paragraph (1)(b). This provision excludes from the scope of the Treaty and Regulations those titles of protection, other than applications for patents of invention and patents for inventions referred to under Article 1, items (ii) and (iii) of the Treaty, which are listed in the definitions of “application” and “patent” under PCT Article 2(i) and (ii). However, a Contracting Party would be free to apply some or all of the provisions of the Treaty and Regulations to any such other titles of invention, although it would not be obliged to do so.

2.04 Paragraph (2). Under this paragraph, the “international phase” of international applications would continue to be governed exclusively by the PCT. However, Article 14(2) to (5) of the Treaty and the relevant Regulations contained in Rule 15 would apply to the time limits in Articles 22 and 39(1) of the PCT (which concern the furnishing of a copy of the international application and any required translation and the payment of any required fee to designated Offices and elected Offices), if item (i) in paragraph (2) is maintained without brackets. Moreover, the Treaty and Regulations would apply to international applications for patents for inventions after such applications have entered the “national phase” before a national or regional office, except that, in the event of any conflict between the PCT and the provisions of the Treaty and Regulations, the PCT would prevail. The Treaty and Regulations would also apply to patents for inventions granted on international applications.

2.05 Paragraph (3). This paragraph recognizes that additional or different requirements may need to be applied to certain types of applications which cannot be filed as international applications under the PCT, such as provisional applications, applications for re-issue patents and applications for plant patents, as well as to any patents resulting from such types of applications. For example, in the case of a provisional application, a Contracting Party should be permitted to require that the application contains a statement, or is accompanied by a cover sheet, indicating that the application is a provisional application, to accord a filing date where the application discloses the invention in a drawing but does not contain a description as required by Article 4(1), and/or to dispense with the requirement under Article 5(7) to notify the applicant, or other person submitting the application, of any non-compliance with

requirements relating to provisional applications. In addition, a Contracting Party would be permitted to apply special requirements for “conversion applications,” since these are also not applications for the grant of a patent (see Note 1.02). However, since the PCT provides for international applications to be treated as applications for a continuation or a continuation-in-part of an earlier application (PCT Rule 4.14), and it is proposed to make provision for divisional applications in PCT Rule 4.13 (see also Note 4.29), the requirements regarding such types of applications would be governed fully by the present Treaty.

Note on Article 3

(National Security)

3.01 A similar provision is contained in PCT Article 27(8).

Note on Article 4

(Filing Date)

4.01 Article 4 sets an international standard for the granting of a filing date (“international” standard means a standard fixed by this Treaty). In that respect, Article 4 is different from other provisions of the Treaty, which establish a maximum list of allowed requirements. The international filing date standard is useful, in particular, for two situations, namely for an application whose priority is claimed under Article 4 of the Paris Convention and for an application in respect of which such priority is claimed. In respect of the first situation (first filing), Article 4 guarantees that priority can be claimed on the basis of any application which fulfills the international filing date standard and can only be claimed on the basis of such an application. It also guarantees that the filing date of such an application (and therefore the priority date) would not be subsequently lost, for example, by failure to pay fees under Article 5(4) or to comply with another requirement under Article 5 (see also Notes 4.02, 4.09, 4.13, 4.14 and 4.27). However, an Office would still be permitted to require payment of a fee for the furnishing of a certified copy of the application to serve as a priority document. In respect of the second situation (subsequent filing), Article 4 guarantees that the applicant will

be able to meet the 12-month time limit under Article 4C(1) of the Paris Convention by filing an application which complies with the international filing date standard.

4.02 Paragraph (1)(a). Since the list of items under this provision is exhaustive, it follows that a Contracting Party would not be permitted to require that the application contain a claim or claims for a filing date to be accorded. Where the application as filed does not contain claims, a Contracting Party may require that these be subsequently furnished as allowed under Article 5(1)(a), pursuant to PCT Article 3(2), within the time limit prescribed in Rule 5(2)(a) in accordance with Article 5(7). However, the failure to furnish such claims within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 5(8)(a) for non-compliance with requirements allowed under Article 5(1)(a).

4.03 The wording “date on which its Office has received all of the following elements” covers both the case in which all of the required elements are received on the same day and the case in which they are received on different days. Where an applicant initially fails to comply with all the required filing date requirements, but subsequently complies with those requirements, the matter of whether the application should be granted a filing date and, if so, the date of that filing date, would be regulated under paragraph (3) and Rule 2(1) (see also Note 4.06).

4.04 The term “otherwise permitted by the Office” would mean that any Office would be free to accord a filing date to applications submitted by means which are not permitted by Article 5(1)(b). For example, an Office which requires applications to be filed in paper form would be permitted, but not obliged, to accord a filing date to applications filed in electronic form; the applicant would then be notified under Article 5(7) of the non-compliance with the requirement for filing in paper form and given an opportunity under that Article to comply with that requirement within the time limit prescribed under Rule 5(2)(a).

4.05 Under Rule 6, a Contracting Party would be free to deem, as receipt by the Office, receipt of the elements by a specified branch or sub-office of an Office, by a national Office on behalf of an intergovernmental organization having the power to grant regional patents, by a postal service, or by a specified delivery service.

4.06 Item (i). An implicit indication to the effect that the elements referred to are intended to be an application would exist where the Office is satisfied that it is the applicant's intention to apply for a patent, for example, where the documents furnished contain a statement that the applicant wishes to protect his invention. Where the elements referred to in paragraph (1)(a) are received on different days, the Office would need to be satisfied both that those elements are intended to be parts of an application for a patent and that they are in respect of the same application (see also Note 4.03).

4.07 Item (ii). The applicant is the person in whose name the application is filed, or the person to whom the application is assigned and is authorized to file the application on behalf of the inventor, as the case may be (see also Note 1.07).

4.08 The "other person submitting the application" could, for example, be the applicant's employer in the United States of America. It could also be a representative, even if the representative has not yet been appointed.

4.09 Whether, in a particular case, indications which have been given are sufficient for "allowing the applicant or other person submitting the application to be contacted by the Office," as an alternative to "indications allowing the identity of the applicant or other person submitting the application to be established," will be a matter of fact to be determined by the Office in the circumstances of that case. For example, where the application indicates the address without any name and there is only one resident at that address, the requirement of item (ii) could be regarded as having been complied with. Where an application is submitted by a person other than the applicant, the indications provided for the purpose of establishing a filing date may relate to that person instead of the applicant. Where the name and address of the applicant is not given, a Contracting Party may require that these indications be subsequently furnished as allowed under Article 5(1)(a), pursuant to PCT Rule 4.1(a)(iii) and 4.5(a) within the time limit prescribed in Rule 5(2)(a) in accordance with Article 5(7). However, the failure to furnish such indications within that time limit would not result in the subsequent loss of the filing date (provided, naturally, that the requirement of Article 4(1)(a)(ii) has been complied with) even if the application were refused under Article 5(8)(a) for non-compliance with requirements allowed under Article 5(1)(a).

4.10 Item (iii). For the purpose of determining whether a filing date should be accorded, the Office will only establish whether the communication contains a part that, on the face of it, appears to constitute a description. The question of whether that part satisfies requirements relating to the description allowed under Article 5(1)(a) pursuant to PCT Article 5 and PCT Rule 5, or the substantive requirements for the grant of a patent, is not relevant to this determination.

4.11 Where an application does not contain a description on separate sheets but discloses the invention in drawings accompanied by textual matter, it would be a matter for the Office to determine whether, in the circumstances of the case, such textual matter constitutes “a part which on the face of it appears to be a description” as required by this item, but no Office is obliged to generally consider a disclosure in drawings as a description for the purposes of this item. Where the Office determines that the application does not contain a part which on the face of it which appears to be a description, no filing date may be accorded.

4.12 Item (iv). This indication could, for example, consist of the words “Description of the Invention.” It may be required under paragraph (1)(b) to be in any one language accepted by the Office (see Note 4.13).

4.13 Paragraph (1)(b). A Contracting Party may require that, for the granting of a filing date, it is necessary for the elements referred to in paragraph (1)(a), items (i) and (ii), to be in one language only which must be a language accepted by the Office. However, the description may be in a different language, provided that, where the Contracting Party so requires, the applicant furnishes an indication referred to in item (iv), which may be required to be in any one language accepted by the Office, to the effect that the application contains a description. In such case, a translation of the description in such language would need to be furnished under Article 5(3) within the time limit prescribed in Rule 5(2)(b) in accordance with Article 5(7) (see also Note 5.14). However, the failure to furnish such translation within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 5(8)(a) for non-compliance with the requirements under Article 5(3).

4.14 Where the application is filed with claims in a language which is not accepted by the Office, a translation of those claims, as well as that of the description, would need to be furnished under Article 5(3) within the time limit prescribed in Rule 5(2)(b) in accordance with Article 5(7) (see also Note 5.14). As in the case of a description which is not in any one language accepted by the Office, the failure to file such translation within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 5(8)(a) for non-compliance with the requirements under Article 5(3). The same procedure would apply where, for example, the description and claims were in different languages, and therefore not in one language admitted by the Office, as required by Article 5(3).

4.15 The term “any one language accepted by the Office” refers, where no explicit language requirement exists, to the practice of the Office.

4.16 Paragraph (2)(a). Where the application does not comply with one or more of the requirements referred to in paragraph (1), the notification by the Office gives the applicant or other person submitting the application the option of proceeding with the application on the basis of the elements which have been submitted and any fees already paid. That is, the applicant or other person would not need to resubmit the application. However, for the proper conduct of business before the Office, this option applies only up until the expiration of the time limit applicable under paragraph (3)(a) (see Note 4.21).

4.17 In order to ensure that the applicant is promptly notified of any non-compliance with one or more of the requirements of paragraph (1), the Office should check the application without undue delay and issue any required notification as soon as possible after any such non-compliance has been discovered. Where the applicant files the application in person, he could even immediately be given any notification if the Office is able to carry out an immediate check.

4.18 As regards the expression “indications allowing the applicant or other person submitting the application to be contacted by the Office,” reference is made to the explanation under paragraph (1)(a), item (ii) (see Note 4.09).

4.19 Where the applicant discovers any non-compliance with the requirements of paragraph (1) without having received a notification from the Office, he may immediately file the elements required for such compliance without waiting to receive such notification.

4.20 Paragraph (2)(b). This provision is modeled after PCT Article 14(2). In order to establish whether a notification under this provision is required, the check referred to in Note 4.17 should also establish whether the application refers to drawings which, in fact, are not included in the application. Where such drawings are not included, the explanations given in Notes 4.17 to 4.19 apply. The subsequent procedure is regulated by paragraph (3)(b) (see Note 4.22).

4.21 Paragraph (3)(a). The relevant time limit which a Contracting Party may, but is not obliged to, apply is prescribed in Rule 2(1). Where the requirements of paragraph (1) are not complied with within that time limit, the application will be treated as not having been filed; if the applicant then wished to proceed, it would be necessary to re-file the application in its entirety and, if the Office does not permit the transfer of fees from the initially filed application, to pay new fees.

4.22 Paragraph (3)(b). The relevant time limit, which is the same as that which applies under subparagraph (a), is prescribed under Rule 2(1). Where the missing drawings are furnished within that time limit, the filing date shall be the date on which the Office receives those drawings, as provided in the first sentence. However, this is subject to two exceptions, contained in the third and fourth sentences respectively, as follows. First, where the later furnished drawings do not contain new matter, the Office is free, but not obliged, to accord as the filing date the date of receipt of the elements referred to in paragraph (1)(a) or, where applicable, the date on which all of the requirements referred to in paragraph (1) are subsequently complied with. This provision is not mandatory because non-examining offices would not be able to determine whether or not the later furnished drawings contain new matter. The second exception, which is mandatory, is to permit the applicant to withdraw the later furnished drawings within a time limit fixed by the Contracting Party. This provision would enable the applicant to retain an earlier filing date necessary for a valid priority claim

where, in his view, the elements initially furnished provide an adequate description of the invention without the missing drawings.

4.23 Paragraph (3)(c). This provision has been included in square brackets following the agreement at the fourth session of the Committee of Experts, as reported in document PLT/CE/IV/4 at paragraph 69, “that the International Bureau should draft, for consideration by the fifth session of the Committee of Experts, a provision according to which, where priority is claimed in the application, the contents of the priority document would have to be taken into account in establishing whether correction by way of furnishing a missing sheet or drawing should be allowed without loss of filing date.” The provision as proposed is not restricted to missing sheets but is drafted more broadly in order to include, in particular, the unintentional omission of a part of the description filed electronically in a “pageless” format.

4.24 Paragraph (4). This paragraph is modeled after Article 8(4) of the basic proposal submitted to the 1991 Diplomatic Conference at The Hague (see documents PLT/DC/3 and 69). However, the proposed paragraph now covers references to any earlier application by the same applicant or his predecessor in title and is not restricted, as was the case under the basic proposal, to references to an application of which priority is claimed.

4.25 Paragraph (4)(a), chapeau. Identifications of the applicant and any predecessor in title are required under this chapeau to enable the Office to establish that the earlier application was filed by the same applicant or his predecessor in title. Indications regarding the earlier application which must be provided in the reference are prescribed under Rule 2(2).

4.26 Items (i) and (ii). The relevant time limit under item (i) is prescribed under Rule 2(3)(a). Where the priority of the earlier application is claimed, the time limit for furnishing a certified copy under item (ii) in accordance with Article 5(5)(a) is prescribed under Rule 5(1)(a). As is apparent, the same certified copy would serve for the purposes of both this item and Article 5(5)(a). Similarly, where the copy furnished under item (i) is a certified copy, that certified copy would also serve for the purposes both of item (ii) and of Article 5(5)(a). Where the priority of the earlier application is not claimed, the relevant time limit is prescribed under Rule 2(3)(b). The time limit under item (i) is shorter than either time limit applicable under item (ii) in view of the need of the Office to have a copy of the earlier application, and,

where appropriate, a translation of that earlier application, in order to proceed with the processing and publication of the application containing the reference. The copy of the earlier application could be furnished by the applicant or his representative to the Office in paper form or, where permitted, by electronic means. It could also be furnished by electronic exchange between the Office with which the earlier application was filed and the Office with which the later application was filed, where the Offices provided for such exchange.

4.27 Although not a requirement for a filing date, the applicant would, for the application to proceed, subsequently need to furnish a description pursuant to the requirements allowed under Article 5(1)(a). If that description and any text matter in the drawings are not in any one language accepted by the Office, a translation of that description and text matter would also be required under Article 5(3) within the time limit prescribed in Rule 5(2)(c) in accordance with Article 5(7). However, in this case, the failure to furnish such description within that time limit would not result in the subsequent loss of the filing date even if the application were refused under Article 5(8)(a) for non-compliance with requirements allowed under Article 5(1)(a).

4.28 Paragraph (4)(b). This provision makes it clear that if the requirements of subparagraph (a) are not complied with within the applicable time limit(s), the Office should treat the application as not having been filed.

4.29 Paragraph (5). This paragraph is shown in square brackets since it will only be required if PCT Rule 4.13 is amended to permit the applicant to indicate that he wishes his international application to be treated, in any designated State, as a divisional application. With such amendment, divisional applications would not be a certain type of application under Article 2 (see Note 2.01) and it would be necessary to provide expressly for the filing date of the initial or “parent” application to be treated as the filing date of the divisional application, for example, for the purposes of priority claim, prior art and patent term.

Note on Article 5

(Application)

5.01 Paragraph (1)(a). The reference to the term “form or contents of an application” is to be construed in the same way as the reference to that term in PCT Article 27(1). The Note to that Article in the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty, at page 35 of the Final Text of the Treaty and Notes, contains the following explanation:

“The words ‘form or contents’ are used merely to emphasize something that could go without saying, namely that requirements of substantive patent law (criteria of patentability, etc.) are not meant.”

5.02 The requirement, allowed under Article 29.2 of the Agreement on Trade-Related Aspects of Industrial Property Rights (TRIPS), that an applicant for a patent provide information concerning the applicant’s foreign applications and grants, is not a requirement as to the “form and contents of an application” under this provision. Similarly, requirements under the law of the United States of America in respect of duty of disclosure and indications that an invention was produced under a United States of America government contract, and requirements under the law of India in relation to the disclosure of search results on related applications and patents, are also not requirements as to the “form and contents of an application.”

5.03 Since at least one delegation is of the view that unity of invention is a matter of substantive law, not a formalities matter, it is proposed that the final provisions of this Treaty should provide for the possibility of a reservation by a Contracting Party as regards the applicability of the requirements of PCT Rule 13 (Unity of Invention) under this provision.

5.04 The provision that no Contracting Party may require compliance with any requirement relating to the form or contents of an application which is different from or additional to any requirement applicable under the PCT to an international application, which is modeled after PCT Article 27(1), would mean that a Contracting Party could not impose stricter requirements in such respects than those provided under the PCT. The understanding that a

Contracting Party would be free to provide for requirements which, from the viewpoint of applicants, are more favourable than the requirements under the PCT, is modeled after PCT Article 27(4).

5.05 It follows from Note 1.10 that any relevant amendments or modifications to the PCT, or to the Regulations or Administrative Instructions under the PCT, would automatically have effect for the present Treaty.

5.06 The application requirements which may be otherwise provided for by a Contracting Party under the present Treaty are those under Articles 5(1)(b) to (6), 7 and 8, and under the Regulations pertaining to those Articles.

5.07 Paragraph (1)(b). As agreed at the fourth session of the Committee of Experts, part of the second sentence of this provision has been placed in square brackets for further consideration. The Regulations under this paragraph are prescribed under Rule 3. As regards the meaning of the term “filing of applications in electronic form” reference is made to the explanations given under that Rule (see Note R3.02)

5.08 The term “in paper form” is to be interpreted in the light of PCT Rule 11.9, which, as allowed under Article 5(1)(a) of the draft Treaty, would apply to applications filed under the present Treaty. In accordance with that Rule, a Contracting Party could require that applications be typed or printed. However, since the provisions of that Rule do not permit applications to be handwritten, a Contracting Party would not be obliged to receive applications in that form, although it would be permitted to do so.

5.09 Paragraph (1)(c). This provision, which deals with the presentation of the request part of the application, appears also with a similar wording in other Articles of the Treaty (in Article 7(3)(e) as regards a power of attorney, in Article 9(1)(c) in respect of a request for the recordal of a change in a name or address, in Article 10(1)(c) as regards a request for the recordal of a change in applicant, change in ownership or change in inventor, in Article 11(1)(c) as regards a request for recordal of a licensing agreement or security interest, and in Article 12(1)(c) in respect of a request for the correction of a mistake). In all cases, the provision relates only to acceptance or refusal of an application, request or other

communication on formal grounds. No obligation concerning acceptance or refusal on substantive grounds is implied. It should be noted that, while a Contracting Party is obliged to accept a form corresponding to each of the Forms contained in the Regulations, an applicant is free to use any other form acceptable to the Contracting Party.

5.10 It is envisaged that the draft Model International Form for applications (Form N° 1) to be included in the Regulations, and which will be presented to a future session of the Committee of Experts, would be based, to the extent possible, on the PCT request form (Form PCT/RO/101). This Model International Form will be established in the languages of the Treaty (namely, English, Arabic, Chinese, French, Russian and Spanish).

5.11 The phrase “corresponding to the application Form provided for in the Regulations” implies that the actual form submitted to the Office must conform to the language requirements as stated in paragraph (3). The relevant language version of the Model International Form may be used as such (where a Contracting Party accepts one of the languages of the Treaty), or in a translation into any one language accepted by a Contracting Party. In addition to the Model International Form provided for in the Regulations, each Office would be free to prepare its own “individualized Model Form,” provided that it is consistent with the Treaty and Regulations, and applicants could use either of those Forms.

5.12 Paragraph (1)(c) does not regulate the means of communicating the request. For example, it does not oblige a Contracting Party to accept filing by telex or telefacsimile. (See also paragraph (1)(b).)

5.13 Paragraph (2). A Contracting Party will be free to make no provision in respect of registration numbers or to provide for the furnishing of registration numbers or other indications on an optional basis. Where the applicant or representative, as the case may be, is not registered with the Office under a number or other indication, the Office may not require such number or other indication to be included in the application. Where an applicant or representative does not comply with a requirement under this paragraph, the Office would notify the applicant or representative under paragraph (7), giving an opportunity to comply with that requirement, and to make observations, within the time limit applicable under that paragraph (see Note 5.26). Where the said requirement was complied with within that time

limit, a Contracting Party would be free, under paragraph (8)(a), to apply such sanction for such non-compliance as is provided for in its law, even including refusal of the application if that law so provides (see Note 5.29).

5.14 Paragraph (3). This paragraph would allow a Contracting Party to require that an application be presented in any one language accepted by that Contracting Party. Where an application which satisfies the filing date requirements under Article 4 is not in any one language accepted by the Office, the Office must notify the applicant or other person submitting the application that the requirements of this paragraph are not complied with giving him an opportunity under paragraph (7) to comply with those requirements to replace any part of the application which is not in such language, for example, by furnishing a translation in the language of the remainder of the application. This would apply where the part concerned is in a language not accepted by the Office or is in a language accepted by the Office which is different from the language accepted by the Office of the remainder of the application. An Office would not need to take any action in respect of information presented both in one language accepted by the Office and in a second language, for example, where a bilingual form is used — a translation of the information in the second language which is already presented in the said one language would serve no purpose.

5.15 As regards the term “any one language accepted by the Office,” see Note 4.15.

5.16 Paragraph (4). This paragraph does not regulate to whom the fee is paid, for example, whether it is paid to the Office or to the government. It also does not regulate the method of payment, so that each Contracting Party would be free to decide whether or not to allow payments made, for example, from deposit account with the Office, or by electronic transaction, or whether to make it mandatory, for example, in the case of applications filed electronically, to pay the fees by using a deposit account with the Office.

5.17 In addition to the fee to be paid in respect of the application, there may be separate fees for the publication of the application and the granting of the patent. However, it is also possible (and compatible with the Treaty) to combine those fees and require payment of such a combined fee at the time of filing the application (which may nevertheless be called “application fee” because it is to be paid at the time of filing the application). However, it

follows from Article 4(1) that a Contracting Party cannot refuse a filing date because the application fee has not been paid (see Note 4.01).

5.18 Paragraph (5) (a). The time limit under this provision for furnishing a copy of the earlier application—which may be required to be certified as correct and accompanied by a certificate showing the date of filing of the earlier application—is prescribed under Rule 5(1)(a) as not less than 16 months from the filing date of the earlier application. This time limit, which is consistent with PCT Rule 17.1 as amended with effect from July 1, 1998, is more generous than the (minimum) period of three months from the filing of the subsequent application provided in Article 4D(3) of the Paris Convention for the Protection of Industrial Property (the “Paris Convention”). (It is to be noted that, under that Article, a Contracting Party may not require a fee for furnishing the copy, if it is filed within three months of the filing of the subsequent application.) If the time limit is not complied with because of a failure, on the part of the Office with which the earlier application was filed, to provide a copy in time, restoration of the priority right may be available under Article 15(3).

5.19 The words “or is available to the Office by other means” have been added in response to a suggestion at the fourth session of the Committee of Experts to take account of developments which would enable the Office with which the application claiming priority is filed to obtain a copy of the earlier application from, for example, the digital library of the Office with which that earlier application had been filed, so that it would no longer be necessary for the applicant to furnish such a copy.

5.20 A person “entitled to prosecute” the application could, in particular be, an assignee of record of the entire right, title and interest in an application where the applicable law of a Contracting Party requires the patent to be applied for in the name of the actual inventor and also provides that such an assignee is entitled to conduct the prosecution of the application to the exclusion of the named inventor. As regards the expression “other person submitting the application,” reference is made to the explanation under Article 4(1)(a)(ii) (see Note 4.08).

5.21 Paragraph (5)(b). Under item (i), a Contracting Party would be able to require the furnishing of a translation of the earlier application in order to determine whether the invention

claimed in the application claiming priority (the “subsequent application”) is patentable, in particular, having regard to matter published after the claimed priority date, but before the filing date, of the subsequent application.

5.22 Under item (ii), a Contracting Party would be able to require the furnishing of a translation of the earlier application in order to determine whether the application claiming priority (the “subsequent application”) is citable against another application (the “other application”), in particular, where the (priority) date of the other application is after the claimed priority date, but before the filing date, of the subsequent application.

5.23 The time limit under subparagraph (b) for furnishing a translation upon the invitation of the Office is prescribed under Rule 5(1)(b).

5.24 Where the Office may reasonably doubt the veracity of the priority claim, that Office may request that evidence in support of the priority claim be furnished under paragraph (6). For example, where the applicant claims the benefit of Article 3 of the Paris Convention, but there is doubt as to the veracity of the applicant’s allegations as to his nationality, the Office may require evidence in this matter.

5.25 Paragraph (6). This paragraph does not relate to the correction of mistakes, but to cases where the Office believes that any matter contained in the request part of the application is not true. Although it would be for each Contracting State to interpret the phrase “may reasonably doubt the veracity of any matter,” the intention is that the Office should not ask for evidence on a systematic or a “spot-check” basis, but only where there are grounds for reasonable doubt. The Office would be obliged under Rule 4 to inform the applicant of its reason for doubting the veracity of the matter in question. An example of a case in which evidence may be required is given in Note 5.24. Another example is where the authenticity of a signature in the application is in doubt, in which case the applicant may be required to furnish evidence of that authenticity (which he could do by furnishing evidence which he believes to be convincing or, if the Office is still in reasonable doubt, by furnishing certification).

5.26 Paragraph (7). This paragraph ensures that the applicant or other person submitting, or entitled to prosecute, the application is, unless indications allowing that applicant or other

person to be contacted by the Office have not been provided, always notified of any defect under paragraphs (1) to (4) and is provided with a time limit, prescribed in Rule 5(2), for complying with the requirements under those paragraphs. The defect under paragraph (1) includes the case where a priority claim does not comply with the requirements under the PCT Rule 4.10. Since the time limit to comply with the requirements in respect of the priority claim differs from those of other defects, the time limit for such case is prescribed under Rule 5(2)(d) separately. The time limit prescribed in Rule 5(2) is applicable to the furnishing of evidence required under paragraph (6).

5.27 This paragraph does not regulate the manner in which the applicant is to be notified, for example, in paper form, orally, or by electronic mail.

5.28 As in the case of Article 4(2)(a), in order to ensure prompt notification of any non-compliance with the requirements of paragraphs (1) to (4), the Office should check the application as soon as possible and issue any required notification without undue delay. As regards the expression “unless the application does not contain indications allowing the applicant or other person submitting the application to be contacted by the Office,” reference is made to the explanation under Article 4(1)(a)(ii) (see Note 4.09).

5.29 Paragraph (8)(a). The relevant time limit is prescribed in Rule 5(3)(a). The sanction which may be applied under this provision may include refusal of the application. However, the effect of the reference to Article 4 is that a Contracting Party could not consider an application as not having been filed if it complies with the requirements of that Article (see Note 4.01). It should be noted that the consequences of failure to comply with the requirements in respect of priority claim is regulated separately under paragraph (8)(b).

5.30 Paragraph (8)(b). The consequence of failure to comply with the formality requirements in respect of a priority claim within the time limit prescribed under Rule 5(3)(b) is generally the loss of the priority right. However, the effect of the reference to the Patent Cooperation Treaty is that, as under PCT Rule 26bis.2(b) which enters into force on July 1, 1998, a priority claim shall not be considered not to have been made only because the indication of the number of the earlier application referred to in PCT Rule 4.10(a)(ii) is missing or because an indication

of such number in the priority claim is not the same as the corresponding indication appearing in the priority document.

5. 31 Paragraph (8)(c). This provision complies with Article 4D(4) of the Paris Convention, which provides that the consequences of failure to comply with the formalities prescribed by Article 4 of that Convention shall in no case go beyond the loss of the right of priority. Although paragraph (8)(c) expressly provides that no other sanction may be applied, the decision of an Office to consider a priority claim as non-existent could result in the refusal of the application on substantive grounds, in particular, on the grounds of lack of novelty or inventive step in the light of intervening prior art. In addition, where, for the purposes of obtaining a filing date, the description was replaced by a reference to an earlier application under Article 4 (4), the failure to furnish, in accordance with Article 5(5)(a), a copy, translation or certified copy of that earlier application would result, under Article 4(4)(b), in the application being considered as not having been filed (see Note 4.28).

Note on Article 6

(Validity of Patent; Revocation)

6.01 Paragraph (1). This paragraph establishes that an Office, a court, a board of appeal or any other competent authority may not revoke or invalidate a patent once granted when it is subsequently discovered that the application failed to meet certain formal requirements which, although they may be needed for the processing of the application, are not essential to the content of the granted patent. This applies in the following cases:

Article 5(1)(a) - the application did not comply with one or more requirements relating to its form or contents;

Article 5(1)(b) - the application was not filed as prescribed;

Article 5(2) - the request part of the application did not contain a required number or other indication under which the applicant or representative is registered with the Office;

Article 5(4) - one or more fees required in respect of the application were not paid;

Article 5(5) - a copy or translation of an earlier application on which a priority claim is based was not furnished.

6.02 As expressly stated, this paragraph would not prevent the revocation or invalidation of a granted patent on a matter of substance or in case of fraud. It would also not prohibit the requirement under a regional treaty for the furnishing of a translation, in a language prescribed by a State party to that treaty, of a regional patent. As regards fees, it is to be noted that the paragraph would cover only those fees payable prior to the grant of a patent, such as the filing, publication and grant fees. It would not cover the lapse of a patent for the non-payment of an annual maintenance fee.

6.03 The phrase “it may not be revoked or invalidated” is intended to also cover sanctions which are of equivalent effect to revocation or invalidation, such as non-enforcement of rights.

6.04 A Contracting Party would be permitted, but not obliged, to provide for the revocation or invalidation of a granted patent when it is subsequently discovered that the application was not in any one language accepted by the Office, as required by Article 5(3), or that evidence required under Article 5(6) had not been furnished.

6.05 Paragraph (2). This paragraph relates to any proceedings for the revocation and invalidation of a patent before the Office, a court, a board of appeal or any other competent authority. It applies to proceedings on substantive grounds, such as lack of novelty, as well as formal grounds. It also includes proceedings where the sanctions are of equivalent effect to revocation or invalidation (see Note 6.03). It is to be noted that the paragraph is restricted to two formal aspects of such proceedings: first, the owner must be given at least one opportunity to make observations on the intended revocation or invalidation; second, his right to make amendments and/or corrections where permitted under the applicable law. However, it does not regulate the grounds on which a granted patent may be revoked or invalidated, nor any other aspect of such proceedings. It also does not regulate the form of observations which

an owner is given an opportunity to make. Thus, although an owner would generally be given the opportunity to submit written observations, a Contracting Party would be permitted, for example, in court proceedings, to provide only for oral observations. No Contracting Party would be required to provide at least one opportunity for amendments and/or corrections to be made if its national law did not provide for such amendments or corrections, either at all or in the circumstances of the particular proceedings.

6.06 Where the owner has a representative, the opportunity to make observations would normally be notified to the representative rather than to the owner, unless the owner requests otherwise (see also Note 7.01).

Note on Article 7

(Representation; Address for Service)

7.01 The term “representative” is defined in Article 1(x). Article 7 typically applies to patent agents and attorneys “in private practice.” This Article relates only to the appointment itself and to the possible limitation of the appointment, but does not deal with the termination of the appointment. In the latter respect, and in respect of any other matter relating to representation which is not covered by the Treaty, a Contracting Party will be free to establish whatever rules it wishes to establish. For example, a Contracting Party may provide that the appointment of a new representative terminates the appointment of all previous representatives unless otherwise indicated in the power of attorney. Or, a Contracting Party may allow sub-representation and, if that is the case, require that, where the power of a representative extends to the appointment of one or more sub-representatives, the power of attorney expressly authorize a representative to appoint such sub-representatives. In addition, although where a representative is appointed, the Office would normally send any communication to that representative, a Contracting Party may provide that a communication should be sent to the represented person where that person so requests.

7.02 Paragraph (1), chapeau. The term “for the purposes of any procedure before the Office” refers to any procedure in proceedings before the Office with respect to an application or patent. It covers procedures in which an applicant, owner of a patent or other interested person communicates with the Office, either to initiate such proceedings or in the course of

such proceedings. Examples of such procedures are the filing of an application or a request for the recordal of a licensing agreement, the payment of a fee, or the furnishing of a response to a notification issued by the Office or of a translation of an application or patent. It also covers procedures in which the Office communicates with an applicant, owner or other interested person in the course of proceedings relating to an application or patent, for example, the issue of a notification that an application does not comply with certain requirements or of a receipt for a document or fee. It does not refer to actions which are not directly in respect of such proceedings, for example, the purchase of a copy of a published application.

7.03 Item (i). The term “have the right to practice before the Office” is modeled after PCT Rule 90.1(a) to (c). Under this provision, a Contracting Party is allowed to require that the appointed representative be a person, for example, a registered patent attorney, who is admitted to practice before the Office. A Contracting Party, however, may have a less strict requirement, for example, merely require the appointed representative to have an address for service on its territory.

7.04 Item (ii). This item seems to be self-explanatory.

7.05 Paragraph (2)(a). The representation requirement may apply even where the applicant or other person submitting, or entitled to prosecute, the application or owner or other interested party, or, in the case of a transfer of the application or the patent, the new applicant or new owner, is a national of the Contracting Party concerned or has a domicile or an establishment in the territory of that Contracting Party. Thus, the effect of the Treaty in a Contracting Party is not limited to situations involving applicants or owners from other Contracting Parties but extends to all situations, in order to achieve the highest possible degree of harmonization. However, representation may not be required for the filing of a translation, the furnishing of drawings according to Article 4(3)(b) or of a translation or certified copy according to Article 4(4), the payment of any fee, or for the issue of a receipt or notification by the Office in respect of any of these procedures. For an explanation of the terms “other person submitting, or entitled to prosecute, the application” and “any procedure before the Office,” see Notes 5.20 and 7.02, respectively.

7.06 Where an applicant who is not represented filed an application with an Office which requires representation for such filing, the Office would, unless indications allowing him to be contacted by the Office have not been furnished, notify that applicant under paragraph (8)(b) giving him an opportunity to comply with that requirement within the time limit prescribed in Rule 8(4) (see Note 7.23). If the applicant complied with the requirement for representation within that time limit, the Office would then proceed to process the application and, if the requirements of Article 4(1) were complied with on the date on which the application was filed by the applicant, would accord that date as the filing date of the application. If the applicant did not comply with the requirement for representation within the applicable time limit, the Office could consider the application as not having been filed, in accordance with paragraph (9). Similar considerations would apply in respect of other procedures before the Office where an applicant, owner or other interested person was not represented as required.

7.07 Paragraph (2)(b). The laws of some countries do not require that a representative be appointed before their Offices even where the applicant or other person submitting, or entitled to prosecute, the application or owner or other interested person, or, in the case of change in ownership, the new applicant or new owner (see Article 10(1)(a)), has neither a domicile nor a real and effective industrial or commercial establishment on the territory of the country concerned. The laws of some of those countries, however, require that, unless a representative is appointed, an address for service in their territory be provided, and this is expressly permitted by the Treaty, except that such requirement may not be applied in respect of any of the procedures referred to in subparagraph (a), items (i) to (iv), since the freedom of not having to use a representative for such procedures could be undermined if the applicant, owner or other person concerned, were then required to provide an address for service in the territory of each Contracting Party in respect of which, for example, a translation is filed or fees are paid without representation.

7.08 Where the applicant or other person submitting, or entitled to prosecute, the application, owner or other interested person has a domicile or a real and effective industrial or commercial establishment in the country concerned, a Contracting Party may require him, at his option, to indicate the address of that domicile or establishment as his address or provide an address for service. This is deemed necessary since the rationale for exempting a person with a

domicile or establishment on the territory of the Contracting Party from the requirement of having an address for service on that territory would be defeated if he indicated, for example, a post office box as his address.

7.09 Where an application is filed, or another procedure before the Office carried out, and an address for service required under item (i) or (ii) has not been indicated, the procedure explained in Note 7.06 would apply *mutatis mutandis*. For an explanation of the term “any procedure before the Office,” see Note 7.02.

7.10 Paragraph (3)(a). This provision obliges a Contracting Party to accept any appointment of a representative which is effected in a separate power of attorney or by the applicant signing the request part of the application (as under PCT Rule 90.4 (a)). A Contracting Party would also be free, but not obliged, to accept the appointment of a representative in any other manner. The reference, in this provision, to “any other interested person” covers, for example, a petitioner for revocation of a patent.

7.11 Paragraph (3)(b). This provision puts an obligation on Contracting Parties to accept a single power of attorney in respect of several applications, several patents or both applications and patents of the same person. Contracting Parties must also accept what is sometimes referred to as a “general power of attorney,” that is, a power of attorney that relates to all existing and future applications and/or patents of the same person. The words “subject to any exception indicated by the appointing person” would oblige a Contracting Party to allow the person making the appointment to indicate possible exceptions in the power of attorney itself (for example, appointment only for future applications and patents), or to make exceptions at a later time. A Contracting Party may require under paragraph (5), item (i) that any communication made to the Office by a representative for the purposes of a procedure before the Office contain a reference to such a single power of attorney or general power of attorney (see also Note 7.19).

7.12 Article 7 does not regulate further details of the so-called “general power of attorney.” For example, each Contracting Party is free to allow that several representatives be appointed in such a power of attorney or that several of those powers of attorney, each relating to different representatives, be made by the same person.

7.13 Paragraph (3)(c). The person to be represented could appoint a representative in respect of certain matters (for example, filing of applications) and appoint another representative in respect of other matters (for example, treatment of objections and oppositions). To the extent that representation is required in accordance with paragraph (2)(a), any Contracting Party may provide that a limitation of the powers of a representative shall be valid only if one or more additional representatives are appointed to comply with paragraph (2)(a).

7.14 The question, raised during the fourth session of the Committee of Experts (see document PCT/CE/IV/4, paragraph 129), whether general powers of attorney should be prevented from containing limitations of the powers of the representative (in order to avoid the need for the Office to check the contents of the general power of attorney on the occasion of each action) would seem to deserve further consideration.

7.15 An action before the Office, the result of which has the same consequence as a withdrawal of an application could be, for example, the filing of a conversion application or of an application claiming internal priority. An action before the Office, the result of which has the same consequence as a surrender of a patent could be, for example, the furnishing of a communication stating that the grounds stated in an application for revocation of that patent were not contested. The possibility for a Contracting Party to require that the power of attorney should contain an express indication that the representative has the right to withdraw an application or surrender a patent, or take any action which has the same consequences as such withdrawal or surrender, is justified in view of the particularly important consequences of such acts.

7.16 Paragraph (3)(d). Reference is made to Rule 8(1) and (2) and to the explanations under Article 5(1)(b) (see Notes 5.07 and 5.08).

7.17 Paragraph (3)(e). As regards the presentation of the power of attorney, reference is made to the explanations relating to the presentation of the request part of the application under Article (5)(1)(c) (see Notes 5.09 to 5.12). The Regulations contain a Model International Form (Form N° 2) for the power of attorney.

7.18 Paragraph (4). Reference is made to the Notes under Article 5(3) (see Note 5.14).

7.19 Paragraph (5). Although item (i) of this provision would permit a Contracting Party to require that a reference be made to a power of attorney relating to more than one application or patent or to a general power of attorney, it would not permit a Contracting Party to require a copy of that power of attorney or general power of attorney to be furnished for each application or patent concerned.

7.20 Paragraph (6). This paragraph relates to the situation where the power of attorney contains an allegation the veracity of which is doubtful. The Office would be obliged under Rule 4 to inform the person who is required to furnish the evidence for doubting the veracity of the indication in question. This paragraph applies even in the case of an allegation which is not required to be made under the law of the Contracting Party concerned. For an explanation of the phrase “may reasonably doubt the veracity of,” see Note 5.25.

7.21 Paragraph (7). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (3) to (6) with respect to the matter of representation as covered by the Treaty.

7.22 Paragraph (8). This paragraph serves two purposes. The first is to ensure that the person to be represented, and, where applicable, the representative or person who refers to himself as representative, is notified where one or more of the requirements under Article 8 are not complied with. The second is to provide an opportunity to comply with those requirements within the time limit which is prescribed under Rule 8(3). The notification of the person to be represented, as well as the representative or alleged representative, is necessary to avoid any adverse consequence for that person as the result of a failure, on the part of an alleged representative who is not legally authorized to represent the said person, to comply with the requirements concerned.

7.23 Where applicant or other person submitting, or entitled to prosecute, the application, an owner or any other interested person who indicates an address outside the territory of the Contracting Party does not comply with a requirement for representation under

paragraph (2)(a) or for an address for service in the territory of the Contracting Party under paragraph (2)(b), the Office would be obliged, unless sufficient indications have not been furnished, to send the notification under paragraph (8)(b) to that address outside the territory of the Contracting Party. However, the Office would not be obliged to communicate further with that applicant, owner or other person unless the latter complied with the requirement for representation or indication of an address for service within the applicable time limit. Reference is also made to the explanations under Article 5(7) (see Notes 5.26 to 5.28) and under paragraph (2)(a) and (b) (see Notes 7.05 to 7.09).

7.24 Paragraph (9). As in the case of Article 5(8)(a), the effect of the words “subject to Article 4” would be to ensure that the filing date of an application would be retained in the event of non-compliance with the requirements referred to in this paragraph.

Note on Article 8

(Signature)

8.01 Article 8 applies whenever a signature is required, whether such requirement is mentioned in the Treaty or follows only from the national (or regional) law. Details concerning communications signed on behalf of legal entities and concerning the date of signature are prescribed under Rule 9(1) and (2), respectively.

8.02 Paragraph (1), item (i). This item seems to be self-explanatory.

8.03 Item (ii). The other form of signature permitted under this item may be, for example, a printed or stamped reproduction of the handwritten signature of the person whose signature is required.

8.04 Item (iii). The nationality of the person who signs the communication is required under this item in view of the provisions under the national law of at least one State relating to the use of seals by the nationals of that State.

8.05 Item (iv). This item seems to be self-explanatory.

8.06 Paragraph (2). Regulations on the signature of communications transmitted to the Office by telefacsimile and on electronic signature are prescribed under Rule 9(3) and (4), respectively.

8.07 Paragraph (3). This paragraph is restricted to communications in paper form under paragraph (1) since Contracting Parties would need to be able to require the notarization, authentication or certification of electronic signatures. In addition to the signature of, for example, patent applications, this paragraph also applies in case of withdrawal of an application or surrender of a patent.

8.08 Paragraph (4)(a). The Office would be obliged under Rule 4 to inform the applicant of its reason for doubting the veracity of the signature or other means of self-identification. In case of reasonable doubt as to the authenticity of the signature, the Office may require the applicant or other person submitting the communication to furnish evidence of authenticity (which he could do by furnishing evidence which he believes to be convincing or, if the Office is still in reasonable doubt, by furnishing a certification (see also Note 5.25)). For an explanation of the phrase “may reasonably doubt the veracity of,” also see Note 5.25.

8.09 Paragraph (4)(b). This provision would prevent the provisions of paragraph (3) being circumvented by a requirement for evidence under subparagraph (a). As is the case of paragraph (3), this provision is restricted to evidence in paper form since Contracting Parties would need to be able to require the notarization, authentication or certification of electronically filed evidence in order to confirm the identity of the sender and integrity of the communication.

8.10 Paragraph (5). The time limit under this paragraph is prescribed under Rule 9(5). Reference is made to the explanations given under Article 5(7) (see Notes 5.26 to 5.28).

8.11 Paragraph (6). The time limit under this paragraph is prescribed under Rule 9(6).

Note on Article 9

(Request for Recordal of Change in Name or Address)

9.01 The procedure concerning requests for recordal of changes in names or addresses under Article 9 is standardized for applicants, other person submitting, or entitled to prosecute, the application and owners. In accordance with Article 1(vii), the term “recordal” means recordal in the records of the Office. As regards the expression “other person submitting, or entitled to prosecute, the application,” reference is made to the explanation given under Article 5(5)(a) (see Note 5.20).

9.02 Paragraph (1)(a). It follows from the wording of this provision that a Contracting Party may refuse a request made by oral communication. It is also clear that this Article applies to changes in names, changes in addresses and changes in both names and addresses.

9.03 Paragraph (1)(b). The Regulations under this provision are prescribed under Rule 10(1) and (2). Reference is also made to the explanations under Article 5(1)(b) (see Notes 5.07 and 5.08). It should be noted that these Regulations apply only to the request *per se* and therefore do not apply to evidence furnished under paragraph (4).

9.04 Paragraph (1)(c). As regards the presentation of the request, reference is made to the explanations under Article 5(1)(c) (see Notes 5.09 to 5.12). The Regulations contain a Model International Form (Form N° 3) for the request for recordal of a change in name or address.

9.05 Paragraph (1)(d), item (i). The name and address referred to in this item must be that which is reflected in the records of the Office concerned. If that is not the case, the Office can require either the furnishing of evidence under paragraph (4) or that another change be recorded beforehand. For example, where the residence of the applicant or owner appears in the records of the Office as being “City X” and the request for the recordal of the change in the name indicates “City Y” as the applicant’s or owner’s residence, the Office concerned may refuse the request as long as a separate request for recordal of a change in address from “City X” to “City Y” has not been submitted.

9.06 Items (ii) and (iii). These items seem to be self-explanatory.

9.07 Paragraph (1)(e). Reference is made to the Note under Article 5(3) (see Note 5.14). Where the request is not filed in any one language accepted by the Office, a Contracting Party is permitted to reject the request, but it is understood that the request could be re-filed in an accepted language with no loss of rights.

9.08 Paragraph (1)(f). The amount of the fee could differ depending on the number of the patents or applications involved (see Note 9.09).

9.09 Paragraph (1)(g). The procedure under this provision is the same whether the requested change concerns one or more applications, one or more patents, or a combination of one or more applications and one or more patents, provided that all of the relevant application and patent numbers are provided. Where a single request relates to both patents and applications, and a Contracting Party treats changes concerning patents and changes concerning applications in a different manner from the computerization or administrative viewpoint, that Contracting Party could meet its requirements by making copies of the request, optionally on the payment of an additional fee for each copy (see Note 9.08).

9.10 Paragraph (2). Rule 17 of the Regulations contains the details for identifying an application whose application number is not known, as referred to in this paragraph.

9.11 Paragraph (3). While Model International Forms are not provided for requests for recordal of a change in the name or address of a representative or of a change in the address for service, the Model International Form (Form N° 3) for the request for recordal of a change in name or address may be used with appropriate alterations.

9.12 Paragraph (4). This paragraph would enable Contracting Parties to require evidence, for example, in the case of a change in both name and address where there is a doubt as to whether such change is not in fact a disguised change in ownership. The Office would be obliged under Rule 4 to inform the applicant of its reason for doubting the veracity of the

indication concerned. For an explanation of the phrase “may reasonably doubt the veracity of,” see Note 5.25.

9.13 Paragraph (5) establishes the exhaustive character of the list of requirements under paragraphs (1) to (4). One of the requirements which would be prohibited is the requirement of the furnishing of a certified copy of the recordal of the change in the register of companies as a condition for the recordal of the change in the records of the Office.

9.14 Paragraph (6). The time limit under this paragraph is prescribed under Rule 10(3). Reference is made to the explanations given under Article 5(7) (see Notes 5.26 to 5.28).

9.15 Paragraph (7). The time limit under this paragraph is prescribed under Rule 10(4).

Note on Article 10

(Request for Recordal of Change in Ownership)

10.01 The procedure concerning requests for recordal of changes in ownership under Article 10 is standardized for applicants and owners. It is to be noted that this Article deals with the procedures which should be fulfilled before a Patent Office and not before any other authorities of a country, for example, the fiscal authorities. In accordance with Article 1(vii), the term “recordal” means recordal in the records of the Office.

10.02 It is also to be noted that, where an applicant or owner intends to request the recordal of a change in ownership by one of the means provided for in this Article, no Contracting Party may require more than what is provided in Article 10. On the other hand, if a person intends to request the recordal of a change in ownership in a Contracting Party by means other than those covered by Article 10 but admitted by that Contracting Party, the latter is entitled to require that the request comply with all the requirements applicable under its law to such means (which requirements may be stricter than those provided for in Article 10).

10.03 Paragraph (1)(a). This provision relates to the recordal of change of ownership where there is a change in the person of the applicant or owner.

10.04 As in the case of Article 9(1)(a), it follows from the wording of this provision that a Contracting Party may refuse a request made by oral communication.

10.05 Paragraph (1)(b). The Regulations under this provision are contained in Rule 11(1) and (2). Reference is also made to the explanations under Article 5(1)(b) (see Notes 5.07 and 5.08). It should be noted that these Regulations apply only to the request *per se* and therefore do not apply to any documents furnished under paragraph (1)(d) to (g) or to evidence furnished under paragraph (4).

10.06 Paragraph (1)(c). As regards the presentation of the request, reference is made to the explanations under Article 5(1)(c) (see Notes 5.09 to 5.12). The Regulations contain a Model International Form (Form N° 4) for the request for recordal of a change in ownership.

10.07 Paragraph (1)(d) to (g). These provisions distinguish between a change in ownership which results from a contract (assignment, etc.), a change in ownership which results from a merger, and a change in ownership which results from operation of law or from a court decision (inheritance, bankruptcy, etc.).

10.08 Paragraph (1)(d) relates to any change in ownership which results from a contract. Where recordal of the change in ownership is requested by the new applicant or the new owner, any Contracting Party may require that the request indicate the fact that the change in ownership results from a contract and that the request be accompanied by a document evidencing the change in ownership. However, where recordal is requested by the applicant or owner himself, that indication and such a document may not be required. It is presumed, in such a case of voluntary transfer, that the applicant or owner would not request recordal of a change in ownership which had not in fact occurred, since that would be against his own interest.

10.09 Items (i) to (iii). These items list three different documents which, alternatively, may serve as evidence of a transfer of ownership resulting from a contract. Where a Contracting Party requires that the request be accompanied by one of these documents, it must accept any one of the three documents listed. It is up to the requesting party to choose one of them to

accompany his request. However, since this provision sets a maximum requirement, a Contracting Party could, for example, under item (ii) accept a transcription of an extract of the contract, instead of the extract itself, if this were permitted under its law.

10.10 Items (i) and (ii). Where the requesting party chooses to furnish a copy of the contract or an extract of the contract as provided in these items, a Contracting Party is free to require that the copy or the extract be certified, including by any representative admitted before the Office. It shall be the choice of the applicant as to who (a representative, a notary public or another competent public authority) certifies the relevant document.

10.11 Item (iii). Where the requesting party chooses to furnish a certificate of transfer as provided in this item, a Contracting Party may not require that this certificate be the subject of any form of certification. One of the important points in respect of a certificate of transfer is that a Contracting Party would be entitled, but not obliged, to require that such a certificate must be signed by both the applicant and the new applicant, or both the owner and the new owner, and cannot be signed by representatives. The Regulations contain a Model International Form (Form N° 5) for a certificate of transfer.

10.12 Paragraph (1)(e) relates to any change in ownership which results from a merger, or from the reorganization or division of a legal entity. Any Contracting Party may require that the request indicate the fact that the change in ownership results from a merger, or from the reorganization or division of a legal entity and that the request be accompanied by a copy of a document evidencing that fact and any attribution of rights involved. This document must originate from the competent authority. It may, for example, be an extract from a register of commerce. It need not be signed by the applicant and the new applicant, or the owner and the new owner. The Contracting Party may only require that a copy of the document be furnished; it may not require the original of the document. On the other hand, it may require that the copy be certified, including by any representative admitted before the Office, at the option of the applicant.

10.13 Paragraph (1)(f). Where a co-applicant or co-owner transfers his share in an application or patent, he may, under the applicable law, need the consent of any other co-applicant or co-owner to obtain recordal of the change in ownership. The Treaty allows

Contracting Parties to require the furnishing of a document in which the said consent is given. However, the use of the words “any Contracting Party may require” makes it clear that a Contracting Party could, for example, be satisfied if the request for the recordal of the change in ownership is signed by a representative of the co-applicants or co-owners if the latter had appointed him to represent them.

10.14 Paragraph (1)(g) relates to any change in ownership which does not result from a contract, from a merger, or from the reorganization or division of a legal entity. In such a case, the Contracting Party may require that the request indicate the actual ground for the change in ownership, and that the request be accompanied by a copy of any document which it deems appropriate to evidence the change. Although the Contracting Party may not require that the original of such a document be furnished, it may, however, require that the copy emanate from the authority which issued the document or that it be certified, including by any representative admitted before the Office, at the option of the applicant.

10.15 It follows from Article 8(3) that no Contracting Party may require that any signature appearing in the request (paragraph (1)(a)) or in any document accompanying the request (paragraphs (1)(d) to (g)) be the subject of any kind of certification where that request or that document is in paper form.

10.16 Paragraph (1)(h). This provision seems to be self-explanatory.

10.17 Paragraph (1)(i). Reference is made to the explanations given under Article 9(1)(f) (see Note 9.08).

10.18 Paragraph (1)(j). Reference is made to the explanations given under Article 9(1)(g) (see Note 9.09).

10.19 Paragraph (2). Reference is made to the explanations given under Article 5(3) (see Note 5.14). A Contracting Party may require that the documentary evidence submitted in support of recordal of a change in ownership be translated into any one language accepted by the Office.

10.20 Paragraph (3). Rule 17 of the Regulations contains the details for identifying an application whose application number is not known, as referred to in this paragraph.

10.21 Paragraph (4). Reference is made to the explanations given under Article 9(4) (see Note 9.12).

10.22 Paragraph (5). This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (4) with respect to a request for the recordal of a change in ownership. An example of a prohibited requirement could be making the admissibility of the request dependent on an advertisement of the change in ownership in one or several newspapers. Since the Treaty does not regulate the substantive requirements relating to the validity of a change in ownership, a Contracting Party may require the fulfillment of additional conditions, for example, in situations concerning inheritance, bankruptcy or tutelage.

10.23 Paragraph (6). The time limit under this paragraph is prescribed under Rule 11(3). Reference is made to the explanations under Article 5(7) (see Notes 5.26 to 5.28).

10.24 Paragraph (7). The time limit under this paragraph is prescribed under Rule 11(4).

10.25 Paragraph (8). This paragraph would permit any Contracting Party, in particular, a Contracting Party the applicable law of which provides that a patent must be applied for in the name of the actual inventor, to apply, where the applicant or owner is the inventor, provisions in respect of the recordal of a change in the person of the applicant or owner which are different from, or additional to, provisions under Article 10(1) to (7). The manner in which a Contracting Party may exclude the application of this Article where the applicant or owner is the inventor will be regulated in the administrative and final provisions of the Treaty.

Note on Article 11

(Request for Recordal of a Licensing Agreement or Security Interest)

11.01 Paragraph (1)(a). As in the case of Article 9(1)(a), it also follows from the wording of this provision that a Contracting Party may refuse a request made by oral communication. In accordance with Article 1(vii), the term “recordal” means recordal in the records of the Office.

11.02 Paragraph (1)(b). The Regulations under this paragraph are prescribed under Rule 12(1) and (2). Reference is also made to the explanations under Article 5(1)(b) (see Notes 5.07 and 5.08). It should be noted that these Regulations apply only to the request *per se* and therefore do not apply to any documents furnished under paragraph (1)(d) or to evidence furnished under paragraph (4).

11.03 Paragraph (1)(c). As regards the presentation of the request, reference is made to the explanations under Article 5(1)(c) (see Notes 5.09 to 5.12). The Regulations will contain a Model International Form for the request for recordal of a licensing agreement or security interest.

11.04 Paragraph (1)(d). The considerations which apply under this provision are essentially the same as those which apply in the case of a change of ownership which results from a contract (see Note 10.08). Thus, where recordal of a licensing agreement is requested by the licensee, any Contracting Party may require that the request be accompanied by a document evidencing that licensing agreement. However, where the recordal is requested by the licensor, such a document may not be required. It is presumed, in such a case of a voluntary licensing agreement, that the licensor would not request recordal of a licensing agreement which had not in fact occurred, since that would be against his own interest.

11.05 Paragraph (1)(e). Where a co-applicant or co-owner licenses his share in an application or patent, he may, under the applicable law, need the consent of any other co-applicant or co-owner to obtain recordal of the licensing agreement. The Treaty allows Contracting Parties to require the furnishing of a document in which the said consent is given. However, the use of the words “any Contracting Party may require” makes it clear that a Contracting Party could, for example, be satisfied if the request for the recordal of the licensing agreement is signed by a representative of the co-applicants or co-owners if the latter had appointed him to represent them.

11.06 Paragraph (1)(f). This provision seems to be self-explanatory.

11.07 Paragraph (1)(g) and (h). Reference is made to the explanations given under Article 9(1)(f) and (g), respectively (see Notes 9.08 and 9.09).

11.08 Paragraph (2) to (5). Reference is made to the explanations given under Article 10(2) to (5) (see Notes 10.19 to 10.22).

11.09 Paragraph (6). The time limit under this paragraph is prescribed under Rule 12(3). Reference is made to the explanations given under Article 5(7) (see Notes 5.26 to 5.28).

11.10 Paragraph (7). The time limit under this is prescribed under Rule 12(4).

11.11 Paragraph (8). This paragraph provides for the recordal of a security interest, such as an interest in a patent or application, acquired by contract for the purpose of securing payment or performance of an obligation or indemnifying against loss or liability, for example, where the rights in an application or patent have been pledged as a security for a loan. However, no Contracting Party would be obliged to provide for the recordal of security interests, and any Contracting Party which did allow for such recordal would be free to decide which security interests could be recorded.

Note on Article 12

(Request for Correction of a Mistake)

12.01 Article 12 regulates the formal requirements and procedures concerning the request for correction of a mistake. However, it does not regulate the substantive requirements which a Contracting Party may apply in determining the allowability of a correction; for example, a Contracting Party may require that the correction be obvious in the sense that it is immediately obvious that nothing else would have been intended other than what is offered as the correction. It also does not regulate corrections of mistakes in the application which are not the subject of a request for correction, in particular, the correction of the description, claims

drawings by way of amendment at the application's volition following the receipt of the search report or amendment in the course of substantive examination.

12.02 Paragraph (1)(a). A “mistake which is reflected in the records of the Office and/or any of its publications” may be a mistake in the bibliographic data or in the description, claims or drawings of the application or patent concerned. It follows from the wording “which is correctable under the applicable law” that the question of which mistakes are correctable is not regulated by the Treaty.

12.03 As regards the expression “other person submitting, or entitled to prosecute, the application,” reference is made to the explanation given under Article 5(5)(a) (see Note 5.20).

12.04 As in the case of Article 9(1)(a), it also follows from the wording of this provision that a Contracting Party may refuse a request made by oral communication.

12.05 Paragraph (1)(b). The Regulations under this paragraph are prescribed under Rule 13(1) and (2). Reference is also made to the explanations under Article 5(1)(b) (see Notes 5.07 and 5.08). It should be noted that these Regulations apply only to the request *per se* and therefore do not apply to any documents furnished under paragraph (1)(h) and (i) or to evidence furnished under paragraph (3).

12.06 Paragraph (1)(c). As regards the presentation of the request, reference is made to the explanations under Article 5(1)(c) (see Notes 5.09 to 5.12). The Regulations contain a Model International Form (Form N° 6) for the request for correction of a mistake.

12.07 Paragraph (1)(d). Reference is made to the explanations given under Article 9(1)(d) (see Notes 9.05 and 9.06).

12.08 Paragraph (1)(e). Reference is made to the explanations given under Article 5(3) (see Note 5.14).

12.09 Paragraph (1)(f). Reference is made to the explanations given under Article 9(1)(f) (see Note 9.08).

12.10 Paragraph (1)(g). Reference is made to the explanations given under Article 9(1)(g) (see Note 9.09).

12.11 Paragraph (1)(h). This provision allows a Contracting Party to require that a replacement page be submitted with a request for the correction of a mistake. In the case where the request applies to more than one application and/or patent, a single request may still be used; however, an Office may require that a separate replacement page be submitted for each application or patent, to facilitate the work of the Office.

12.12 Paragraph (1)(i). This provision would permit a Contracting Party to refuse a request for the correction of a mistake where the requesting party was unable to furnish a declaration that the said mistake was made in good faith, for example, where the mistake was made with deceptive intentions. It would be a matter for the Contracting Party concerned to decide what constitutes good faith.

12.13 Paragraph (1)(j). This provision would permit a Contracting Party to refuse a request for the correction of a mistake where there was undue delay in making the request after the discovery of the mistake. It would be a matter for the Contracting Party concerned to decide what constitutes undue delay; for example, it could consider that there is undue delay where the request is not diligently made.

12.14 Paragraph (2). Rule 17 of the Regulations contains the details for identifying an application whose application number is not known, as referred to in this paragraph.

12.15 Paragraph (3). This item would enable a Contracting Party to require evidence in the case of any request for correction where, for example, notwithstanding the declaration referred to in paragraph (1)(i), there was doubt as to whether the mistake was made in good faith, or where there was doubt as to whether the request was made without delay following the discovery of the mistake in accordance with paragraph (1)(j) (see also Notes 12.12 and 12.13). Reference is also made to the explanations given under Article 9(4) (see Note 9.12).

12.16 Paragraph (4). Reference is made to the explanations given under Article 9(5) (see Note 9.13) As regards the restriction to formal requirements, reference is also made to the explanation in Note 12.01.

12.17 Paragraph (5). In the case of mistakes attributable to an Office, the latter may adopt a different procedure such as *ex officio* correction or, where the mistake is noticed by the applicant or owner, or by his representative, correction following a request made in a simple letter. In any case, the Office cannot subject the correction of such a mistake to the payment of a fee.

12.18 Paragraph (6). The time limit under this provision is prescribed under Rule 13(3). Reference is also made to the explanations given under Article 5(7) (see Notes 5.26 to 5.28).

12.19 Paragraph (7). The time limit under this provision is prescribed under Rule 13(4).

12.20 Paragraph (8). This paragraph would present a Contracting Party, in particular, a Contracting Party the applicable law of which provides that a patent must be applied for in the name of the actual inventor, to apply, where the applicant or owner is the inventor, provisions in respect of corrections concerning the inventor which are different from, or additional to, provisions under Article 12(1) to (7). The manner in which a Contracting Party may exclude the application of this Article where the applicant or owner is the inventor will be regulated in the administrative and final provisions of the Treaty.

Note on Article 13

(Extension of a Time Limit Fixed by the Office)

13.01 This Article 13 sets a minimum of rights a Contracting Party must extend to an applicant or other person submitting, or entitled to prosecute, the application or owner who requests the extension of a time limit fixed by the Office for an action before the Office before that time limit has expired. However, any Contracting Party would be free to be more liberal in granting such an extension.

13.02 Paragraph (1)(a). This provision regulates only requests for time limits fixed by the Office for an action before the Office. It therefore does not apply to time limits established by national legislation or under a treaty providing for the grant of regional patents. It also does not apply to time limits for actions not before the Office, for example, actions before a court (see also Note 13.03). Any Contracting Party would be free to prescribe the same or other requirements, or to make no provision for extension, in respect of time limits not regulated by this paragraph, for example, requests for the extension of time limits established by national legislation or under a treaty providing for the grant of regional patents.

13.03 The term “action before the Office” includes, for example, the subsequent compliance under Article 4(3) with all of the requirements of Article 4(1) for the granting of a filing date, and the subsequent compliance under Article 5(7) with all of the requirements of Articles 5(1) to (4) and, if applicable, (6), but is not limited to actions in respect of requirements under the Treaty. However, the term does not include actions which are not directly relevant to the proceedings before the Office in respect of a particular application or patent, for example, a payment of a bill for information services to the public provided by the Office.

13.04 This provision also does not regulate the extension of a time limit at the request of a party who is not an applicant or owner, for example, at the request of a “new applicant” or “new owner” in proceedings under Article 10, a licensee in proceedings under Article 11, or a third party to any proceedings. However, any Contracting Party would be free to provide for the extension of time limits at the request of such other parties concerned, or a third party, although it would not be obliged to do so.

13.05 This provision is also limited to the case in which the request for the extension of a time limit is made before the expiration of that time limit. Where that time limit has expired, relief in the form of “further processing” or restoration of rights may be available under Article 14(1) or (2), respectively. This provision also does not apply to the delayed submission of priority claims or the restoration of the priority right, which are regulated by Article 15.

13.06 The communication under this provision may, in accordance with the definition under Article 1, item (v), be transmitted or submitted by any means permitted by the Office. Accordingly, a Contracting Party would be free, but not obliged, to allow oral requests for extension of time limit.

13.07 As regards the expression “other person submitting, or entitled to prosecute, the application, “reference is made to the explanation under Article 5(5)(a) (see Note 5.20).

13.08 The minimum period of an extension under this provision, subject to any maximum time limit established by law for the fixing of the time limit by the Office, is prescribed under Rule 14.

13.09 Paragraph (1)(b). Under this provision, no Contracting Party would be obliged to grant more than one extension of a time limit under subparagraph (a), although it would be permitted to do so. Any Contracting Party which did grant more than one extension under subparagraph (a) would be permitted to grant a shorter extension, and/or to apply requirements which are additional to or different from those under that subparagraph.

13.10 Paragraph (2). Since the request for extension of the time limit under paragraph (1)(a) must be made before the expiration of that time limit, this provision does not apply where there has been a failure to comply with the time limit, even where that failure is caused by the failure of the Office or is unintentional.

13.11 Paragraph (3). The possibility of making observations on the intended refusal of a request under paragraph (1)(a) would be accorded to the requesting party even if the refusal is

based on non-payment or insufficient payment of fees, for example, to make the case that the fee had in fact been paid.

13.12 This paragraph does not regulate the form of observations which a requesting party is given an opportunity to make (see Note 6.05). Also, where the requesting party has a representative, the opportunity to make observations normally would be notified to the representative rather than to that requesting party, unless the Office is requested otherwise (see also Note 7.01).

Note on Article 14

(Further Processing; Restoration of Rights)

14.01 Paragraph (1)(a). This provision has been introduced following the approval by the fourth session of the Committee of Experts that a proposal providing for “further processing” should generally be permitted on the mere basis of a request and the payment of a fee.

14.02 Further processing under this provision is restricted to the cases in which an application is to be, or has been, refused or considered withdrawn or abandoned following failure to comply with a time limit fixed by the Office for an action before the Office. For an explanation of the term “action before the Office,” see Note 13.03. This provision therefore does not apply where the time limit which was not complied with is established by national legislation or under a treaty providing for the grant of regional patents. It also does not apply where the failure to comply with the time limit does not result directly in the loss of the application. For example, it does not apply to the period for making a priority claim, which is regulated by Article 15. It also does not apply in the case of a granted patent, in which case relief may be available by way of restoration of rights under paragraph (2), or where any maximum time limit established by law for the fixing of the time limit by the Office has expired. This provision, in contrast to paragraph (2), applies irrespective of whether or not the failure to comply with the time limit occurred in spite of all due care required by the circumstances having been taken or was unintentional.

14.03 This paragraph is limited to requests made in a communication signed by the applicant, or his representative, although any Contracting Party may be more liberal in this respect if it so wishes, in particular, by dispensing with the requirement for a signature and/or admitting a request from a “new applicant” (see also Note 13.04).

14.04 As in the case of Article 9(1)(a), it also follows from the wording of this provision that a Contracting Party may refuse a request under this paragraph made by oral communication.

14.05 Where the request under this provision is granted, the refusal, withdrawal or abandonment of the application is not to be proceeded with (if it has not taken place) or is to be retracted (if it has taken place). The further processing of the application by the Office is then resumed as if the time limit concerned had been complied with.

14.06 As regards the expression “other person submitting, or entitled to prosecute, the application,” reference is made to the explanation under Article 5(5)(a) (see Note 5.20).

14.07 The time limit for making a request under this provision is prescribed in Rule 15(1).

14.08 Paragraph (1)(b). This provision would permit, but not oblige, a Contracting Party to exclude further processing under subparagraph (a) in the case of specific time limits fixed by the Office. However, where the failure to comply with such an excluded time limit occurred in spite of all due care required by the circumstances or was unintentional, as the case may be (see Note 14.13), the applicant may be entitled to request restoration of rights under paragraph (2).

14.09 Paragraph (2)(a). This provision is restricted to the restoration of rights in respect of an application or patent which has been refused, revoked, invalidated or considered withdrawn, abandoned, lapsed or terminated, following failure to comply with a time limit. However, Contracting Parties will be free to provide for restoration also in other cases, for example, in respect of requests to the Office, as provided for in Article 122 of the European Patent Convention. As in the case of Article 6(1), this provision is intended to also cover sanctions which are of equivalent effect to revocation or invalidation, such as non-enforcement of rights (see Note 6.03). It does not apply to the right to request the addition of a priority claim under Article 15(1) since the failure to comply with the time limit under Rule 16(1) for such addition would not have the direct consequence of causing the application to be refused or considered abandoned, lapsed or terminated for failure to comply with that time limit. For the same reason, it does not apply to a request for restoration of right of priority under Article 15(2)(a) for failure to comply period with the period of two months for making a request prescribed in that Article where the subsequent application has a filing date which is later than the date on which the priority period expired, or under Article 15(3) for failure to comply with the time limit for making a request under that Article or for requiring a copy of the earlier application

within the time limit under Rule 16(2). In addition, Article 15(2)(b) expressly provides that the time limit under Article 15(2)(a) cannot be extended.

14.10 Paragraph (2)(a) is limited to requests for restoration made in a communication signed by the applicant or other person submitting, or entitled to prosecute, the application or the owner, or his representative, although any Contracting Party may be more liberal in this respect if it so wishes (see Note 14.03). As regards the expression “other person submitting, or entitled to prosecute, the application,” reference is made to the explanation under Article 5(5)(a) (see Note 5.20).

14.11 As in the case of paragraph (1)(a), it also follows from the wording of paragraph (2)(a) that a Contracting Party may refuse a request for restoration made by oral communication.

14.12 In contrast to Article 13(1) and paragraph (1)(a), paragraph (2)(a) applies both to time limits fixed by the Office and to time limits or periods for action established by national legislation or under a treaty providing for the grant of regional patents. Time limits in respect of which a Contracting Party is not obliged to provide for restoration of rights, but is nevertheless permitted to do so, are listed in the exceptions under paragraph (2)(b) (see Notes 14.16 to 14.21).

14.13 Also in contrast to Article 13(1) and paragraph (1)(a), paragraph (2)(a) applies only where the failure to comply with the time limit occurred in spite of all due care required by the circumstances, or, at the option of the Contracting Party, was unintentional, for example, in either case, where there had been an excessive delay or a loss in the mail or an interruption in the mail service, as provided for under PCT Rule 82.

14.14 In order that the Office may determine whether the failure to comply with the former time limit occurred in spite of all due care required by the circumstances or was unintentional, as the case may be, the request for restoration must state the grounds on which it is based. The requesting party may also be required to furnish a declaration or evidence within a time limit fixed by the Office.

14.15 The time limit under paragraph (2)(a) for making a request for an extension of a time limit for restoration of rights is prescribed under Rule 15(2). It takes into account the fact that Contracting Parties have an option between allowing restoration where failure to comply with the time limit concerned occurred in spite of all due care required by the circumstances having been taken and allowing restoration where such failure was unintentional (see Note 15.02). All requirements in respect of which the former time limit applied must also be complied with within that time limit.

14.16 Paragraph (2)(b). A Contracting Party would not be obliged to provide for the restoration of rights under paragraph (2)(a) in case of failure to comply with a time limit referred to in paragraph (2)(b).

14.17 Item (i). This item is for the avoidance of doubt.

14.18 Item (ii). Article 5*bis*(1) of the Paris Convention provides that

“(1) A period of grace of not less than six months shall be allowed for the payment of the fees prescribed for the maintenance of industrial property rights, subject, if the domestic legislation so provides, to the payment of a surcharge.”

14.19 Item (iii). The purpose of the item is to prevent an applicant or owner from obtaining what would be, in effect, double relief in respect of the procedure concerned.

14.20 Item (iv). This item, which deals with the time limit for filing a request for search or examination, may be required to avoid undue delay of prosecution of an application.

14.21 Item (v). This item seems to be self-explanatory.

14.22 Paragraph (3). This provision seems to be self-explanatory.

14.23 Paragraph (4). Reference is made to the explanations given under Article 13(3) (see Notes 13.11 and 13.11).

14.24 Paragraph (5). This paragraph would provide that a third party who, in good faith used, or made effective and serious preparations for using, the invention during the period between the expiration of the time limit and the date on which further processing was allowed or the restoration of rights was made could not be sued for infringement for any such use during that period. In addition, that third party would be entitled to use the invention after that period, subject to the payment of reasonable compensation under subparagraph (b).

Note on Article 15

(Addition and Restoration of Priority Claim)

15.01 This Article is an adapted version of Article 7 of the 1991 basic proposal (document PLT/DC/3).

15.02 It should be noted that, in contrast to Article 14, Article 15 contains no provision on intervening rights. Such a provision would appear superfluous for two reasons. First, the time limits under Article 15 are such that it is unlikely that the application or granted patent would be published without the priority claim, or at least before the request for belated priority claim had been filed. Second, there would be no period in which the provisional protection under the published application, or actual protection under the granted patent, would be lost, and it would not be reasonable for a third party to proceed to exploit the invention on the assumption that, in the absence of a priority claim, either no patent would be granted, the granted patent would be invalid or the protection conferred by the granted patent would be more restricted than that claimed in the published application.

15.03 Paragraph (1)(a). This provision addresses the situation in which an application which could claim the priority of an earlier application does not, when filed, contain such a claim. The paragraph allows a priority claim to be made later than the application. As in the case of PCT Rule 26bis.1 which enters into force on July 1, 1998, this is permissible since the Paris Convention does not require that the priority claim (“the declaration” containing the priority claim, according to the terminology of Article 4D(1) of that Convention) be contained in the

subsequent application itself. The time limit under paragraph (1)(a) is prescribed under Rule 16.

15.04 As regards the expression “other person submitting, or entitled to prosecute, the application,” reference is made to the explanations under Article 5(5)(a) (see Note 5.20).

15.05 Paragraph (1)(b). This provision is placed in square brackets pending further consideration by the Committee of Experts as to whether a Contracting Party should be permitted to restrict the applicant’s right to make a delayed submission of priority claim under paragraph (a) to those situations in which the delay in submitting the priority claim was unintentional. For an explanation of the term “unintentional,” see Note 14.13.

15.06 Paragraph (2)(a). This provision provides for the restoration of the priority right where a subsequent application is filed after, but within two months, from the expiration of the priority period. However, the priority period, namely the 12-month period under Article 4C(1) of the Paris Convention, would not be extended. Also, in view of the provisions of Article 4, it would not be possible to treat the subsequent application as if it had been received before the expiration of the unextended priority period. Since the application will not have been published, there is no need to provide for the recognition of third party rights in the case of restoration.

15.07 As regards the phrase “in spite of all due care required by the circumstances” and the requirement to furnish a declaration or other evidence, reference is made to the explanation under Article 14(2)(a) (see Notes 14.13 and 14.14).

15.08 This paragraph is limited to requests made in a communication signed by the applicant, or his representative, although any Contracting Party may be more liberal in this respect if it so wishes (see Note 14.03).

15.09 As in the case of Article 14(1)(a) and (2)(a), it also follows from the wording of this paragraph that a Contracting Party may refuse a request made by oral communication.

15.10 It is to be noted that, if adopted, this provision and paragraph (1) would not be mutually exclusive. Any applicant could invoke both provisions, as implied by the words “claims or could have claimed” in the opening of this provision.

15.11 Paragraph (2)(b). This provision would prohibit a Contracting Party from extending the period of two months for filing the subsequent application and making the request for restoration of the right of priority referred to in subparagraph (a). Similarly, there could be no provision for extending the period for making that request until after any technical preparations for publication of the subsequent application have been completed.

15.12 Paragraph (3). This paragraph would provide a remedy for the applicant where his right of priority is lost because of the failure on the part of the Office with which the earlier application was filed to provide a copy of that application in time for the applicant or other person submitting, or entitled to prosecute, the application to comply with the time limit referred to in Article 5(5)(a), despite a timely request for that copy having been made. Since this time limit would normally be established by national legislation or under a regional treaty, not by the Office, a remedy in this respect would not normally be available by way of further processing under Article 14(1). In addition, no remedy is available by way of restoration of rights under Article 14(2) (see Note 14.09).

15.13 It is to be noted that this paragraph does not require the priority document to be furnished within a particular time limit, or even at all, as a condition for the restoration of priority right. Accordingly, such restoration would be available where there was a long delay in providing the requested copy, or even where the Office concerned was unable to provide that copy.

15.14 This paragraph is limited to requests made in a communication signed by the applicant, or other person submitting, or entitled to prosecute, the application or his representative, although any Contracting Party may be more liberal in this respect if it so wishes (see Note 14.03).

15.15 As in the case of Article 14(1) and (2) and paragraph (2), the requesting party may be required to furnish a declaration or other evidence in support of the request. In addition, as in the case of those provisions, it also follows from the wording of this paragraph that a Contracting Party may refuse a request made by oral communications.

15.16 The time limit for making a request under this paragraph is prescribed in Rule 16(2) (see also Note R16.02). This time limit would provide a legal certainty for the applicant in that, if he requests a copy of the earlier application within the prescribed time limit, he would be provided with an opportunity to restore his priority right in the event that the Office concerned fails to provide that copy in time for compliance with the time limit referred to in Article 5(5)(a).

15.17 Paragraph (4). Reference is made to the explanations given under Article 13(3) (see Notes 13.11 and 13.12).

15.18 Paragraph (5). This paragraph seems to be self-explanatory.

Note on Article 16

(Regulations)

16.01 Notes concerning the draft Regulations follow immediately in the present document.

16.02 As regards the Model International Forms referred to in paragraph (1)(b), see paragraph 2 of the Introduction to the present document.

II. NOTES ON THE DRAFT REGULATIONS

Note on Rule 1

(Abbreviated Expressions)

R1.01 This Rule seems to be self-explanatory.

Note on Rule 2

(Details Concerning the Filing Date Under Article 4)

R2.01 Paragraph (1). The time limits under this provision would appear self-explanatory. Reference is also made to the explanations under Article 4(3)(a) and (b) (see Notes 4.21 and 4.20).

R2.02 Paragraph (2). Indications of the Office with which the application was filed under item (i) of this provision, and of the filing date and the number of the earlier application under item (ii), are required for the identification of the earlier application.

R2.03 The requirement that the reference indicate the title of the earlier application has been included at the request of one delegation at the fourth session of the Committee of Experts which suggested that the indication of that title should be required in order to permit a national security check to be carried out.

R2.04 The requirement that the reference indicate the language of the earlier application would enable the Office to determine whether a translation of that earlier application is required without having to wait for a copy of the earlier application to be furnished under Article 4(4)(a), item (i) or (ii).

R2.05 Paragraph (3). As explained with reference to Article 4(4)(a), items (i) and (ii), the time limit under Article 4(4)(a), item (i) is shorter than either time limit applicable under

item (ii) (see Note 4.26). The four-month time limit for furnishing a certified copy of the earlier application under subparagraph (b), applicable where the priority of that earlier application is not claimed, generally corresponds to the four-month period between the expiration of the priority period and the expiration of the 16-month time limit under Rule 5(1)(a) for furnishing a copy of an application whose priority is claimed under Article 5(5)(a).

Note on Rule 3

(Filing of Applications Under Article 5(1)(b))

R3.01 Paragraph (1). This paragraph would be needed in order to require all Offices to accept applications in paper form, whether or not the whole of the second sentence of Article 5(1)(b) is retained. For an explanation of the term “in paper form,” see Note 5.08.

R3.02 Paragraph (2)(a). This provision would oblige any Contracting Party which accepts the electronic filing of international applications under the PCT to accept also the electronic filing of national applications and to apply the same requirements. The PCT Rule 89*bis* provides for the filing, processing and transmission of international applications and other documents in electronic form. A Contracting Party which does not accept the electronic filing of international applications would not be obliged to accept the electronic filing of national applications, but would be free to do so and, if it did so, to apply its own requirements. The effect of the linkage with the PCT is that the term filing of applications in electronic form would have the same meaning under this Treaty as under the PCT. For example, this provision covers where applications are filed directly from the computer of an applicant to the I/O server of the Office by using electronic transmission, e.g., facsimile (see Note R3.05).

R3.03 The restriction of the requirements to a particular language would appear necessary since the PCT may prescribe different requirements for the electronic filing of applications in different languages. Thus, the requirements for electronic filing in a language using the Latin alphabet, for example, English, may be different from the requirements for electronic filing in a language which does not use an alphabet, for example, Chinese.

R3.04 Paragraph (2)(b) and (c). Although these provisions have been drafted on the assumption that, before the adoption of the present Treaty, there will be requirements applicable under the PCT in relation to the electronic filing of international applications, they would still be applicable even if this were not the case.

R3.05 Paragraph (3). The purpose of this provision is to make it clear that paragraph (2) deals with the filing of applications in electronic form, as distinct from the filing of applications by means of the communication which result in the filing of applications in paper form prescribed under this paragraph. Apart from telegraph, teleprinter and facsimile transmission as mentioned in the text of the Rule itself, it would also encompass, the sending of a fax from a computer. While electronic means would be invariably used to transmit documents, under this paragraph, it would be the printout in paper form at the intended destination which is legally determinative. This provision is consistent with the PCT Rule 92.4(a) as amended with effect from July 1, 1998.

R3.06 Paragraph (4). Where a Contracting Party permits the filing of applications in electronic form with its Office, it may provide that the application in paper form may copy to electronic form and such copy may also be furnished to the Office by the applicant. This would enable the Office to benefit from the maximum amount of advantages of electronic filing. A copy in electronic form may be prepared not only by the applicant himself but also by the Office for the applicant, with or without any fee. This provision is consistent with the PCT Rule 89^{ter}.1 which will enter into force from July 1, 1998.

R3.07 Paragraph (5). This provision is consistent with the PCT Rule 89^{bis}.2 which will enter into force from July 1, 1998.

Note on Rule 4

(Evidence under Articles 5(6), 7(6), 8(4)(a), 9(4), 10(4), 11(4) and 12(3))

R4.01 Reference is made to the explanations under Articles 5(6), 7(6), 8(4)(a), 9(4), 10(4), 11(4) and 12(3) (Notes 5.25, 7.20, 8.08, 9.12, 10.21, 11.08 and 12.15, respectively).

Note on Rule 5

(Time Limits Concerning the Application Under Article 5)

R5.01 Paragraph (1)(a). Reference is made to the explanation under Article 5(5)(a) (see Note 5.18).

R5.02 Paragraph (1)(b). The time limit under this provision reflects the fact that Article 5(5)(b) requires the applicant to furnish a translation of the earlier application only upon invitation by the Office.

R5.03 Paragraph (2)(a). This provision seems to be self-explanatory.

R5.04 Paragraph (2)(b). The time limit for furnishing a translation under this provision is calculated from the date of the receipt of the document to be translated in order to avoid undue delay in the receipt by the Office of that translation.

R5.05 Paragraph (2)(c) and (d). This provision seems to be self-explanatory.

R5.06 Paragraph (3)(a) and (b). This paragraph seems to be self-explanatory.

Note on Rule 6

(Receipt of Communications)

R6.01 It is recognized that, in the absence of this provision, the result would be the same. Thus, the purpose of this provision is to emphasize the flexibility maintained by each

Contracting Party regarding the permissible methods of transmission of communication. Postal services and other delivery services have been put on the same footing in view of modern developments. Reference is also made to the Notes under Article 4(1)(a) (see, in particular, Note 4.05). As an alternative, the Rule could become an agreed statement approved by the Diplomatic Conference.

Note on Rule 7

(Details Concerning Names and Addresses)

R7.01 This Rule is placed in square brackets for consideration by the Committee of Experts as to whether it should be included. In the case of applications, if this Rule were omitted, no Contracting Party could require, under Article 5(1)(a), compliance with any requirement relating to name and address which is different from or additional to any requirement under the PCT. In the case of other actions before the Office, for example, requests under Articles 9 to 12, it could be expected that, for reasons of consistency and administrative convenience, the same requirements as to name and address would apply as in the case of applications.

R7.02 Paragraph (1)(a). The words “any Contracting Party may require,” which appear in the introductory phrase, make it clear, here as well as in other provisions of this Rule (see, in particular, paragraphs (2)(a) to (c)), that any Contracting Party is entitled to require fewer indications or elements than those mentioned (and allowed) by the said provisions. For example, a Contracting Party is entitled to require under item (i) that the family or principal name must precede the given or secondary name, but is not obliged to impose such a requirement.

R7.03 Paragraph (1)(b). In order to facilitate the administrative procedure before the Office, the firm or partnership needs to indicate its name only in the manner in which such name is customarily used.

R7.04 Paragraph (2)(a). Although a Contracting Party could require the two or more representatives to provide a single address for service, it would not be obliged to do so, for example, where the representatives represented different parties in a joint action.

R7.05 Paragraph (2)(b). This provision does not intend to regulate the question of who has the right to be granted the patent. Therefore, as regards applicants, it only applies where the law of a Contracting Party allows applications to be filed by several applicants.

R7.06 Paragraph (2)(c). The “customary requirements for prompt postal delivery” will often not be known by applicants who live outside of the country in question. It is therefore recommended that these requirements be indicated on any “Individualized International Form” (see Note 5.11).

R7.07 Paragraph (2)(d). The indication of a telephone number and of a telefacsimile or an electronic mail address number may not be required by a Contracting Party. It is, however, recommended to allow such indications to be furnished so that the Office can establish contacts through the most efficient and rapid means of communication. The Model International Forms contain spaces for voluntary furnishing of these indications.

R7.08 Paragraphs (2)(e), (f) and (g). These provisions seem to be self-explanatory.

R7.09 Paragraph (3). While a translation of a name or address cannot be required (it may not even be possible), a Contracting Party may require under item (i) a transliteration of the name and address into the script (for example, Latin or Cyrillic alphabet, etc.) used by the Office. Alternatively, a Contracting Party may require under item (ii) that the name and address be given in the original script.

Note on Rule 8

(Details Concerning Representation and Address for Service Under Article 7)

R8.01 Paragraph (1). This provision would require all Offices to accept powers of attorney in paper form. As in the case of applications under Article 5(1)(b), a Contracting Party could require that powers of attorney be typed or printed. It would also not be obliged to receive handwritten powers of attorney, although it would be permitted to do so (see Notes 5.08 and R3.01).

R8.02 Paragraph (2). This provision is drafted on the assumption that, before the adoption of the present Treaty, there will be requirements applicable under the PCT in relation to the electronic filing of powers of attorney. As regards the restriction of the requirements to a particular language, reference is made to the explanation under Rule 3(2) (see Note R3.03).

R8.03 Paragraph (3). Reference is made to the explanations under Rule 5(2)(a) and (b) (see Notes R5.03 and R5.04).

R8.04 Paragraph (4). This provision seems to be self-explanatory.

Note on Rule 9

(Details Concerning the Signature Under Article 8)

R9.01 Paragraph (1). This paragraph indicates that a communication is to be signed on behalf of, rather than by, a legal entity.

R9.02 Paragraph (2). The date of signing may be important, for example, to determine the legal competence of the person who gave the signature.

R9.03 Paragraph (3). Subparagraph (a) requires a Contracting Party to accept the signature or seal on the printout of a communication transmitted by telefacsimile. However, subparagraph (b) allows any Contracting Party to require the paper original of that communication to be filed with the Office within a time limit of not less than one month from the date of receipt of the facsimile transmission. Where a paper original which is required under subparagraph (b) is not furnished within the applicable time limit, the Office may consider the communication in question as not having been signed.

R9.04 Paragraph (4). This provision is drafted on the assumption that, before the adoption of the present Treaty, there will be requirements applicable under the PCT in relation to electronic signatures. As regards the restriction of the requirements to a particular language, reference is made to the explanation under Rule 3(2) (see Note R3.03).

R9.05 Paragraphs (5) and (6). These provisions seem to be self-explanatory.

Note on Rule 10

(Details Concerning Request for Recordal of Change in
Name or Address Under Article 9)

R10.01 Paragraph (1). This provision would require all Offices to accept requests for the recordal of change in name or address in paper form. As in the case of applications under Article 5(1)(b), a Contracting Party could require that such requests be typed or printed. It would also not be obliged to receive handwritten requests, although it would be permitted to do so (see Notes 5.08 and R3.01).

R10.02 Paragraph (2). This provision is drafted on the assumption that there will be requirements applicable under the PCT in relation to the electronic filing of requests for the recordal of change in name or address. As regards the restriction of the requirements to a particular language, reference is made to the explanation under Rule 3(2) (see Note R3.03).

R10.03 Paragraphs (3) and (4). These provisions seem to be self-explanatory.

Note on Rule 11

(Details Concerning Request for Recordal of Change in Ownership
Under Article 10)

R11.01 Paragraph (1). This provision would require all Offices to accept requests for the recordal of change in ownership in paper form. As in the case of applications under Article 5(1)(b), a Contracting Party could require that such requests be typed or printed. It would also not be obliged to receive handwritten requests, although it would be permitted to do so (see Notes 5.08 and R3.01).

R11.02 Paragraph (2). This provision is drafted on the assumption that there will be requirements applicable under the PCT in relation to the electronic filing of requests for the recordal of change in ownership. As regards the restriction of the requirements for a particular language, reference is made to the explanation under Rule 3(2) (see Note R3.03).

R11.03 Paragraphs (3) and (4). These provisions seem to be self-explanatory.

Note on Rule 12

(Details Concerning Request for Recordal of a Licensing Agreement
or Security Interest Under Article 11)

R12.01 Paragraph (1). This provision would require all Offices to accept requests for the recordal of a licensing agreement or security interest in paper form. As in the case of applications under Article 5(1)(b), a Contracting Party could require that such requests be typed or printed. It would also not be obliged to receive handwritten requests, although it would be permitted to do so (see Notes 5.08 and R3.01).

R12.02 Paragraph (2). This provision is drafted on the assumption that there will be requirements applicable under the PCT in relation to the electronic filing of requests for the recordal of changes in certain indications. As regards the restriction of the requirements for a particular language, reference is made to the explanation under Rule 3(2) (see Note R3.03).

R12.03 Paragraphs (3) and (4). These provisions seem to be self-explanatory.

Note on Rule 13

(Details Concerning Request for Correction of Mistake Under Article 12)

R13.01 Paragraph (1). This provision would require all Offices to accept requests for the correction of a mistake in paper form. As in the case of applications under Article 5(1)(b), a Contracting Party could require that such requests be typed or printed. It would also not be

obliged to receive handwritten requests, although it would be permitted to do so (see Notes 5.08 and R3.01).

R13.02 Paragraph (2). This provision is drafted on the assumption that there will be requirements applicable under the PCT in relation to the electronic filing of requests for correction or rectification. As regards the restriction of the requirements for a particular language, reference is made to the explanation under Rule 3(2) (see Note R3.03).

R13.03 Paragraphs (3) and (4). These provisions seem to be self-explanatory.

Note on Rule 14

(Details Concerning Extension Under Article 13(1)(a) of a Time Limit
Fixed by the Office)

R14.01 This Rule would seem to be self explanatory.

Note on Rule 15

(Details Concerning Further Processing and Restoration of Rights Under Article 14)

R15.01 Paragraph (1). This paragraph seems to be self-explanatory.

R15.02 Paragraph (2). Where a Contracting Party provides for restoration of rights in the case where the failure to comply with the time limit concerned occurred in spite of all due care required by the circumstances having been taken, the period under item (i) is calculated from the date of the removal of the cause of such non-compliance. Where a Contracting Party provides for restoration of rights where the failure to comply with the time limit was unintentional, the period under item (i) is calculated from the date on which the requesting party noticed, or with due diligence should have noticed, that the application or patent had been refused, revoked or invalidated, or considered withdrawn, abandoned, lapsed or terminated.

Note on Rule 16

(Details Concerning Addition and Restoration of Priority Claim Under Article 15)

R16.01 Paragraph (1). The applicable time limit for the submission of a priority claim after the filing of an international application is prescribed under the PCT Rule 26*bis*.1(a) which will enter into force on July 1, 1998, and according to which that time limit is 16 months from the priority date or, where the addition would cause a change in the priority date, 16 months from the priority date so changed, whichever 16-month period expires first, provided that such a priority claim may be submitted until the expiration of 4 months from the filing date of the application.

R16.02 Paragraph (2). A two-month time limit is proposed having regard to, first, the minimum period of four months between the expiration of the 12-month priority period and the 16-month time limit under Rule 5(1), and, second, the time needed by Offices to provide copies of earlier applications.

Note on Rule 17

(Manner of Identification of an Application

Without Its Application Number)

R17.01 Paragraph (1). This paragraph deals with the indications and elements which a person, communicating with its Office, must furnish to identify an application the number of which is not known (see Articles 9(2), 10(3), 11(3) and 12(2)). Each of items (i) and (ii) constitutes a maximum requirement.

R17.02 Paragraph (2). This provision does not prohibit Contracting Parties from allowing an applicant to give less information or from accepting other means of identification.

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