

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Twenty-Sixth Session
Cairo, February 13 to 14, 2019

SAFEGUARDS IN CASE OF OUTAGES AFFECTING OFFICES

Document prepared by the European Patent Office

SUMMARY

1. This document proposes to amend the PCT Regulations by introducing a new Rule 82^{quater.2} to provide an explicit legal basis in the PCT for an Office to excuse delays in meeting a time limit due to the unavailability of any permitted electronic means of communication for the filing of documents or for the payment of fees at the Office. This unavailability may be due to scheduled maintenance, unforeseen outages or other like reasons.

BACKGROUND

2. At the twenty-fifth session of the Meeting of International Authorities in February 2018, the European Patent Office (EPO) submitted a proposal to extend a time limit at an Office in the event of outages in electronic communications affecting the filing of documents (document PCT/MIA/25/12). Previously, the EPO had initiated discussions on this topic at a meeting of the IP5 Offices in Tokyo in November 2017. Following discussions at the twenty-fifth session of the Meeting (see paragraphs 29 to 34 of the Summary by the Chair of the session, document PCT/MIA/25/12), the EPO submitted a proposal to the eleventh session of the PCT Working Group in June 2018 (document PCT/WG/11/19). Paragraphs 264 to 281 of the Report of the session (document PCT/WG/11/27) give details of the discussions at the PCT Working Group; the follow-up in paragraph 281 is reproduced below:

“281. The Working Group noted the intention of the European Patent Office to consult further with interested parties, taking into account the comments made, with a view to submitting a revised proposal to the next session of the Working Group.”

3. Means of electronic communication are paramount for Offices in their interactions with users. These means of communication can, however, become unavailable at the Offices' end due to maintenance or outages (e.g. cyberattacks or any technical problems). A recent example has been the "significant unplanned electronic business system outage" that affected the capacity of the United States Patent and Trademark Office to accept international applications filed electronically from August 15 to 23, 2018¹.
4. Regular maintenance of electronic systems is necessary to improve the quality of online services offered to users. Sometimes this may affect users' ability to use them in full. Maintenance is normally scheduled in the weekends in order to avoid any inconvenience for users. For instance, the EPO publishes advance notices on a dedicated page of its website several days before any periods of unavailability due to such work. It recommends that parties check the website regularly to avoid being taken by surprise by downtimes due to maintenance announced in advance. However, this precautionary measure may not be sufficient in all circumstances.
5. Applicants may be excused in case of unavailability of means of electronic communication at their end in specific circumstances under Rule 82*quater*.1, provided that evidence is submitted on each particular case. However, the PCT does not contain safeguard provisions in case of unavailability of electronic communication services for reasons attributable to patent Offices.
6. Rule 134(1) of the European Patent Convention (EPC) protects EPO users in the event of unavailability of any of the electronic means of communication on the last day of a period for performing procedural acts. It does so by extending that period to the first working day on which all means of electronic communication are available. Such extension is conditional on the unavailability being attributable to the EPO. In the absence of any specific provision in the PCT, the EPO currently applies Rule 134(1) EPC in a supplementary manner as per Article 150(2) EPC. Other Offices follow a similar approach, but not all. In any event, it is not easy for designated Offices to understand on which basis a specific time limit was extended during the international phase.

PROPOSAL

7. In order to provide for greater transparency and reliability, and with a view to further harmonize practices at receiving Offices, a proper legal basis in the PCT is advisable. This is also to the benefit of larger Offices which receive international applications originating from many different receiving Offices, each applying their "own" practice in situations of unavailability of their electronic filing facilities.
8. The EPO thus proposes the introduction of a new Rule 82*quater*.2 (see Annex) to excuse delays in case of technical problems affecting official means of electronic communication, irrespective of whether these are scheduled (maintenance) or unforeseen (outages) by the Office concerned. Time limits may be extended to the next working day when all permitted means of electronic communication are available.
9. Unlike under Rule 82*quater*.1, applicants would not be required to submit evidence under proposed new Rule 82*quater*.2. Reference to the unavailability of the means of electronic communication would suffice and the non-observance of a time limit in a specific case would be excused without further assessment by the Office, thereby streamlining procedures. Proposed new Rule 82*quater*.2(b) has the same purpose than, and is thus aligned to, Rule 82*quater*.1(c).

¹ See PCT Newsletter 09/2018, available on the WIPO website at https://www.wipo.int/edocs/pctndocs/en/2018/pct_news_2018_9.pdf.

10. The proposal does not only relate to the filing of international applications and subsequent documents but also to fee payments since the non-payment of fees within the applicable time limits may also result in the loss of rights. Further details could be specified in the Receiving Office Guidelines.

11. This solution would make the system of excusing delays in the PCT more reliable, traceable and transparent for users, designated Offices and third parties. National Offices would be free to decide whether and how to excuse delays in meeting time limits for a determined period and communicate this decision to the users according to their own practice. Such information would be notified to the International Bureau as well so the public would be properly informed (e.g. PCT Newsletter).

12. In order to ensure that the safeguards provided for under proposed new Rule 82^{quater}.2 also apply to the priority period, Rule 2.4(b) would need to be amended consequently (see Annex).

13. The Meeting is invited to consider the proposed amendments to the Regulations set out in the Annex to this document.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS²

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 2

Interpretation of Certain Words

2.1 to 2.3 [No change]

2.4 “Priority Period”

(a) [No change] Whenever the term “priority period” is used in relation to a priority claim, it shall be construed as meaning the period of 12 months from the filing date of the earlier application whose priority is so claimed. The day of filing of the earlier application shall not be included in that period.

(b) Rules [80.5](#) and [82quater.2](#) shall apply *mutatis mutandis* to the priority period.

Rule 82^{quater}

Excuse of Delay in Meeting Time Limits

82^{quater}.1 Excuse of Delay in Meeting Time Limits

(a) to (c) *[No change]*

82^{quater}.2 Unavailability of Electronic Means of Communication at the Office

(a) Any national Office or intergovernmental organization may provide that, where a time limit fixed in the Regulations for performing an action before that Office or organization is not met due to the general unavailability of any of the permitted electronic means of communication at that Office or organization, delay in meeting the time limit shall be excused. Unavailability may be caused by scheduled maintenance, unforeseen outage or other like reason. The Office or organization concerned shall publish such information and notify the International Bureau accordingly.

(b) The excuse of a delay in meeting a time limit under paragraph (a) need not be taken into account by any designated or elected Office before which the applicant, at the time the information referred to in paragraph (a) is published, has already performed the acts referred to in Article 22 or Article 39.

[End of Annex and of document]