

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

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

PROPOSAL TO PROVIDE FOR CORRECTION OR ADDITION OF INDICATIONS UNDER RULE 4.11

Document prepared by the United States Patent and Trademark Office

SUMMARY

1. It is proposed to provide a specific legal basis under the PCT for the correction or addition of the indications provided for in Rule 4.11(a)(i) and (ii).

BACKGROUND

2. Rule 4.11(a)(i) provides for an indication, in the Request, that the international application is to be treated, under Rule 49bis.1(a) or (b), as an application either: (1) not for the grant of a patent but for the grant of another kind of protection; or (2) for the grant of more than one kind of protection. Rule 4.11(a)(ii) provides for an indication, in the Request, that the international application is to be treated, under Rule 49bis.1(d), as a continuation or continuation-in-part of an earlier application. Rule 49bis.2 precludes a national Office from requiring the furnishing of such indication before the performance of the acts under Article 22.

3. However, there is no legal provision under the PCT or its Regulations for the correction or addition of such indications during the international stage. As such, applicants who need to make such corrections or additions have no mechanism under which to make such a request, and are therefore at the discretion of the individual receiving Offices as to whether they will allow the correction.

4. The United States Patent and Trademark Office (USPTO) first presented this proposal at the IP5 Working Group 3 Meeting held in November 2018 in Seoul, Republic of Korea. In those discussions, it was suggested that the proposal could be broadened to include the correction of

other indications included on the Request. If the Authorities agree that the proposal should be further broadened, the USPTO will work with the International Bureau and any interested Authorities to modify it further before presenting it to the twelfth session of the PCT Working Group, provisionally scheduled to take place from June 11 to 14, 2019.

5. It is noted that the proposal provides for the correction/addition of both the indications concerning the types of protection set forth in paragraph (a)(i) of Rule 4.11 and the types of applications set forth under paragraph (a)(ii) of Rule 4.11. However, in that the indications under Rule 4.11(a)(i) are not provided for in practice at the USPTO, it is not entirely clear to the USPTO that provision need be made to allow for their correction/addition. As such, the USPTO would also welcome the input of other Offices to which those indications are pertinent regarding whether they should be included in proposed Rule 26*quater*.

PROPOSAL

6. The USPTO proposes to provide a specific legal basis for correction or addition of the indications provided for in Rule 4.11 within a period that would ensure their inclusion in the international publication through the addition of a proposed new Rule 26*quater*, as set forth in the Annex to this document. The USPTO further proposes to amend the Administrative Instructions accordingly.

7. *The Meeting is invited to comment on:*

(i) the proposed amendments to the Regulations and Administrative Instructions in the Annex to this document; and

(ii) the specific issues discussed in paragraphs 4 and 5, above.

[Annexes follow]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

TABLE OF CONTENTS

Rule 4 The Request (Contents)	2
4.1 to 4.10 [No change]	2
4.11 <i>Reference to Continuation or Continuation-in-Part, or Parent Application or Grant</i> [No change]	2
4.12 to 4.19 [No change]	2
Rule 26quater Correction or Addition of Indications under Rule 4.11	3
26quater.1 <i>Correction or Addition of Indications</i>	3
26quater.2 <i>Processing of Indications</i>	3

¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 4

The Request (Contents)

4.1 to 4.10 [No change]

4.11 Reference to Continuation or Continuation-in-Part, or Parent Application or Grant

[No change]

(a) If:

- (i) the applicant intends to make an indication under Rule 49bis.1(a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or
- (ii) the applicant intends to make an indication under Rule 49bis.1(d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall indicate the relevant parent application or parent patent or other parent grant.

(b) The inclusion in the request of an indication under paragraph (a) shall have no effect on the operation of Rule 4.9.

4.12 to 4.19 [No change]

Rule 26quater

Correction or Addition of Indications under Rule 4.11

26quater.1 Correction or Addition of Indications

The applicant may correct or add to the request any indication referred to in Rule 4.11 by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

26quater.2 Processing of Indications

Where the International Bureau receives any correction or addition of an indication under Rule 26quater.1 after the expiration of the time limit under Rule 26quater.1, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions.

[Annex II follows]

PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS UNDER THE
PATENT COOPERATION TREATY

Section 419bis
Processing of an Indication under Rule 26quater

(a) Where the applicant, in a notice submitted to the International Bureau, corrects or adds an indication under Rule 26quater.1, that Bureau shall enter the correction or addition in the request, draw a line through, while still leaving legible, any indication deleted as a result of the correction, and enter, in the margin, the letters "IB."

(b) The International Bureau shall promptly notify the applicant of any indication corrected or added under Rule 26quater.1.

(c) Where any indication referred to in Rule 4.11, or any correction thereof under Rule 26quater.1, is submitted to the International Bureau after the expiration of the time limit under Rule 26quater.1, the International Bureau shall notify the applicant accordingly and inform the applicant that such an indication or correction should be submitted directly to the designated Office or Offices concerned.

[End of Annex II and of document]