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PROPOSED AMENDMENT OF RULE 4.9

Document prepared by the International Bureau

SUMMARY

1. This document contains a proposal for a drafting correction to the text of Rule 4.9(b)¹ in order to avoid an unintended effect.

BACKGROUND

2. At its 31st (18th extraordinary) session, held in Geneva in September-October 2002, the PCT Assembly adopted amendments to the Regulations relating to concept and operation of the designation system. The amendments, which entered into force on January 1, 2004, introduced the all-inclusive designation system under which the applicant, by filing an international application, obtains an automatic and all-inclusive coverage of all possible designations available under the Treaty, including all kinds of protection as well as both national and regional patent protection, without needing, at the time of filing the application, to designate individual Contracting States, to choose certain kinds of protection or to indicate expressly whether national or regional protection is sought (see Rule 4.9 as amended). Such matters are left to be dealt with in the national phase (see new Rule 49bis).

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be. References to “national laws”, “national applications”, “the national phase”, etc., include reference to regional laws, regional applications, the regional phase, etc.

3. Rule 4.9(b) provides for one limited exception to the all-inclusive coverage of all Contracting States, designed to address the issue of the “self-designation” provisions which appear in the national law of certain Contracting States, as follows:

“(b) Notwithstanding paragraph (a)(i), if, on October 1, 2002, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request may, for as long as that national law continues to so provide, contain an indication that the designation of that State is not made, provided that the designated Office informs the International Bureau by January 1, 2003, that this paragraph shall apply in respect of designations of that State. The information received shall be promptly published by the International Bureau in the Gazette.”

4. The objective of amended Rule 4.9(b) was to allow for such an exclusion only in those cases where an international application claims the priority of an earlier national application filed in a Contracting State where the “self-designation” provisions apply (see document PCT/A/31/6, paragraph 50), assuming of course that a notification under the Rule has been given by the designated Office concerned. However, the wording of the amended Rule on a literal reading had the unintended effect of allowing the exclusion of such a State in the case of any international application, whether or not it claims the priority of an earlier national application filed in that State, that is, whether or not the issue of “self-designation” arises in the particular case. It is therefore proposed to make a drafting correction to Rule 4.9(b) so as to state expressly that it applies only where the international application claims the priority of an earlier national application having effect in such a State.

5. Proposed amendments designed to make the correction are set out in the Annex.

6. The opportunity is also taken to deal with another potential difficulty in the wording of existing Rule 4.9(b) in that it makes the exclusion of a State with “self-designation” provisions in its national law dependent on whether the national law continues to provide for the self-designation situation. Rather, in the interests of certainty for applicants, Offices and third parties, it seems preferable to make the ability to make such exclusions dependent on the existence of a current notification by the designated Office concerned, and the revised wording thus relates the making of such an exclusion dependent on whether a notification under the provision is still in force at the international filing date.

7. In order to avoid complicated transitional provisions, it appears to be preferable to require fresh notifications under the Rule to be given by designated Offices of countries whose national laws include “self-designation” provisions, noting that only a small number of such notifications were given when the existing version of the Rule was adopted in 2002.

8. *The Working Group is invited to consider the proposals contained in the Annex.*

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

PROPOSED AMENDMENT OF RULE 4.9

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 4

The Request (Contents)

4.1 to 4.8 [No change]

4.9 *Designation of States; Kinds of Protection; National and Regional Patents*

(a) [No change] The filing of a request shall constitute:

(i) the designation of all Contracting States that are bound by the Treaty on the international filing date;

(ii) an indication that the international application is, in respect of each designated State to which Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State;

(iii) an indication that the international application is, in respect of each designated State to which Article 45(1) applies, for the grant of a regional patent and also, unless Article 45(2) applies, a national patent.

[Rule 4.9, continued]

(b) Notwithstanding paragraph (a)(i), if, on October 5, 2005,³ ~~October 1, 2002~~, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request in which the priority of an earlier national application having effect in that State is claimed may, ~~for as long as that national law continues to so provide~~, contain an indication that the designation of that State is not made, provided that the designated Office notifies ~~informs~~ the International Bureau by January 5, 2006,³ ~~January 1, 2003~~, that this paragraph shall apply in respect of designations of that State and that that notification is still in force on the international filing date. The information received shall be promptly published by the International Bureau in the Gazette.

4.10 to 4.18 [No change]

[End of Annex and of document]

³ October 5, 2005, is the date on which it is expected that the PCT Assembly at its 34th session would adopt its report and hence these and any other amendments of the Regulations. January 5, 2006, is three months from that date.