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PROPOSALS WITH RESPECT TO RECTIFICATION OF OBVIOUS MISTAKES

Document prepared by the United States of America

SUMMARY

1. This document contains proposals for amendment of the Regulations under the PCT relating to the rectification of obvious mistakes in international applications. Specifically, the document proposes to amend PCT Rule 91.1(d)¹ so as to permit the contents of the PCT request to be taken into account for the purposes of considering whether mistakes in the description, claims or drawings were obvious and thus rectifiable.

BACKGROUND

2. The Working Group on Reform of the Patent Cooperation Treaty, at its May 2005 meeting, approved amendments to PCT Rule 91 (see documents PCT/R/WG/7/6 and PCT/R/WG/7/13). At the meeting of the Working Group, it was proposed that PCT Rule 91.1(d) be amended to allow use of the request to determine the obviousness of a rectification to the description, claims or drawings. The proposal was not adopted.

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.

3. In this regard, paragraph 66 of the report of the meeting (document PCT/R/WG/7/13) states:

“66. Proposals by certain delegations that Rule 91.1(d) be amended so as to permit the contents of the abstract and of the request to be taken into account for the purposes of considering whether mistakes in the description, claims or drawings were obvious and thus rectifiable were opposed by several other delegations, and the Working Group agreed that they should not proceed. It was noted that Article 3(3) expressly provided that the abstract “merely serves the purpose of technical information and cannot be taken into account for any other purpose”.

4. While the report clearly sets forth why a related proposal to allow use of the abstract in determining obviousness of a mistake was not adopted, the report is silent as to why the proposal to permit the contents of the request to be taken into account was not adopted. After consultations with the International Bureau, it is the recollection of the representatives from the United States Patent and Trademark Office that the failure to adopt such a proposal resulted from the belief that there was no information in the request that would be pertinent to rectifications to those parts of the international application.

5. Since the amendment to the Rule became effective on April 1, 2006, the United States Patent and Trademark Office acting as receiving Office has encountered numerous applications which have contained a reference to the priority claim in the description and that reference has contained a mistake when compared with the priority information set forth in the request. If the receiving Office were allowed to take the request into account in determining whether the mistake was obvious, the mistake could be rectified. However, under Rule 91.1(d) as currently drafted, the rectification cannot be approved.

PROPOSALS TO AMEND RULE 91.1(d)

6. Therefore, it is proposed to amend PCT Rule 91.1(d) to allow the receiving Office to use the request to determine obviousness of the rectification.

7. The Working Group is invited to consider the proposals contained in the Annex to this document

[Annex follows]

ANNEX

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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 91

**Rectification of Obvious Mistakes in
the International Application and Other Documents**

91.1 *Rectification of Obvious Mistakes*

(a) to (c) [No change]

(d) In the case of a mistake in the description, claims or drawings or in a correction or amendment thereof, the competent authority shall, for the purposes of paragraph (c), only take into account the contents of the description, claims, ~~and~~ drawings and the request part of the international application and, where applicable, the correction or amendment concerned.

(e) to (h) [No change]

91.2 and 91.3 [No change]

[End of Annex and of document]