

Patent Cooperation Treaty (PCT) Working Group

**Twelfth Session
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SAFEGUARDS IN CASE OF OUTAGES AFFECTING OFFICES

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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-sixth session of the Meeting of International Authorities in February 2019, 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/26/5, see paragraphs 24 to 32 of the Summary by the Chair of the session, document PCT/MIA/26/13, reproduced in the Annex to document PCT/WG/12/2). Previously, the EPO had initiated discussions on this topic at a meeting of the IP5 Offices in Tokyo in November 2017, followed up by discussions at the twenty-fifth session of the Meeting of International Authorities (see paragraphs 29 to 34 of the Summary by the Chair of the session, document PCT/MIA/25/12), and at the eleventh session of the PCT Working Group (document PCT/WG/11/19 and paragraphs 264 to 281 of the Report, document PCT/WG/11/27).

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. This represents a burden for Offices which have to assess such cases. 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. As a result, 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 in support of a convergence of practices among receiving Offices, a proper legal basis in the PCT is advisable. This would also benefit larger Offices that receive international applications originating from many different receiving Offices, which are currently each applying their "own" national 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 again 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 and relieving Offices from the burden of assessing each case. The proposed wording of new Rule 82*quater*.2(b) has the same purpose as, and is thus aligned to, Rule 82*quater*.1(c). The aim is to ensure that designated Offices are not bound to decisions taken by other Authorities after entry into their respective national phase.

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. Also, the EPO's experience under Rule 134(1) EPC is that any abuse of the system is very unlikely. Applicants cannot anticipate the unavailability of filing systems at Offices' end, be it due to maintenance or outages, and consequently make use of an undue extension of time limits. Likewise, maintenance is in the scope of the proposed new PCT provision as otherwise applicants would be expected to comply with their obligations prior to the actual time limits set in the PCT Regulations. This additional burden on applicants would not be acceptable.

11. The proposal would cover all time limits fixed in the PCT Regulations for performing an act before Offices, including fee payments since the non-payment of fees within the applicable time limits may also result in the loss of rights. As under Rule 82*quater*.1, the proposed new safeguard under Rule 82*quater*.2 would not apply to the priority period, since it is not a time limit fixed in the Regulations. Applicants could, however, request restoration of the priority right under Rule 26*bis*.3. In case the proposed Rule is applied, the Office concerned would notify the relevant information to the International Bureau in order to ensure that the public and other Offices are properly informed, for example, via the PCT Newsletter. Further details regarding the implementation of the proposed new Rule could be specified in the PCT Receiving Office Guidelines, including information on the legal effect of non-observance of time limits, to ensure that applicants are not being misled as to the consequences of such non-observance.

12. The present proposal would make the system of excusing delays in the PCT more reliable, traceable and transparent for users, designated Offices and third parties. It is understood that not all Offices could make use of the new provision in view of different practices under their respective national laws, and that, thus, Offices would still 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. The introduction of this provision into the PCT would nonetheless represent an important step towards a convergence of practices for those Offices that do excuse delays under their national laws in such circumstances.

13. The Working Group is invited to comment on 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 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 unavailability of any of the permitted electronic means of communication at that Office or organization, delay in meeting that time limit shall be excused, provided that the respective action was performed on the next subsequent working day on which the said electronic means of communication was no longer unavailable. Unavailability may be caused by scheduled maintenance, unforeseen outage or other like reason. The Office or organization concerned shall publish information on any such unavailability including the period of the unavailability, 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]