

Patent Cooperation Treaty (PCT) Working Group

**Twelfth Session
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CORRECTIONS AND ADDITIONS OF INDICATIONS UNDER RULE 4.11

Document prepared by the United States of America

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 phase. As such, applicants who need to make such corrections or additions have no mechanism under which to make them, and are therefore at the discretion of the individual receiving Offices as to whether they will allow the correction or addition.

PROPOSAL

4. It is proposed 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 out in Annex I to the present document. It is further proposed to modify the Administrative Instructions accordingly by adding a new Section 419*bis*, as set out in Annex II to the present document.

5. The proposal was discussed by the Meeting of International Authorities during its twenty-sixth session, held in February 2019 in Cairo. As stated in paragraphs 34 and 35 of the Summary by the Chair, document PCT/MIA/26/13 (reproduced in the Annex to document PCT/WG/12/2):

“34. Authorities agreed that it was appropriate to permit correction or addition of indications under Rule 4.11, and considered that the similarity of the proposed Rule 26*quater* to that of existing Rule 26*ter* gave confidence that the details were appropriate and could be effectively administered.

“35. The Meeting invited the United States Patent and Trademark Office to present the proposals to the PCT Working Group.”

6. *The Working Group is invited to comment on the proposed amendments to the Regulations and the proposed modifications to the Administrative Instructions set out in the Annexes to this document.*

[Annex I follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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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 [No Change] *Reference to Continuation or Continuation-in-Part, or Parent Application or Grant*

(a) If:

- (i) the applicant intends to make an indication under Rule 49*bis*.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 49*bis*.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 the notice reaches the International Bureau before the technical preparations for international publication have been completed.

26quater.2 Late Correction or Addition of Indications

Where any correction or addition of an indication referred to in Rule 4.11 is not timely received 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 MODIFICATIONS TO THE ADMINISTRATIVE INSTRUCTIONS²

Section 419bis
Processing of Corrections or Additions under Rule 26quater

(a) Where any indication referred to in Rule 4.11, or any correction thereof under Rule 26quater.1, is submitted to the International Bureau within the time limit under Rule 26quater.1, the International 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]

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