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ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

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./ The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith working documents PCT/R/2/2 to 4 for the second session of the *Committee on Reform of the Patent Cooperation Treaty (PCT)*, which will be held in Geneva from July 1 to 5, 2002.

The working documents are also available on WIPO's web site (see <http://www.wipo.int/pct/en/meetings>).

May 31, 2002

Enclosures: documents PCT/R/2/2 to 4

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PCT/R/2/2

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

Second Session
Geneva, July 1 to 5, 2002

RESULTS OF THE WORK OF THE WORKING GROUP ON
REFORM OF THE PATENT COOPERATION TREATY (PCT)

Memorandum prepared by the Director General

1. The Assembly of the International Patent Cooperation Union (PCT Union), at its thirtieth (13th ordinary) session held in Geneva from September 24 to October 3, 2001, considered the report of the first session of the Committee contained in document PCT/R/1/26.
2. In its report, the Committee agreed that reform of the Patent Cooperation Treaty (PCT) should be based on a number of general objectives set out in paragraph 66 of the report. In addition, the Committee agreed on recommendations to the Assembly concerning the establishment of a working group (see paragraphs 67 and 68 of the report), and concerning the referral to the working group, for its consideration and advice, of a number of matters (see paragraphs 60 to 75 of the report).
3. The Committee also agreed on recommendations to the Assembly concerning the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly (see paragraph 205 of the report):

“The Committee agreed to recommend to the Assembly that between the September 2001 and September 2002 sessions of the PCT Assembly, there should be

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three meetings devoted to the reform of the PCT: two meetings of a working group that would report to this Committee, and the second session of the Committee itself. The working group should meet once before the end of 2001 and once in March or April 2002. The working group should consider the matters set out in paragraphs 69 to 75, above, in the light of the general objectives set out in paragraph 66, above, on the basis of drafts to be prepared by the International Bureau. The results of the work of the working group would be submitted to the second session of the Committee. The objective would be to have a first set of Rule changes adopted by the Assembly in September 2002, in coordination with the preparation of further changes, including changes to the Treaty itself. Further discussion, including discussion of longer-term proposals, would take place after September 2002.”

4. The Assembly (see document PCT/A/30/7, paragraph 23):

“(i) took note of the report of the first session of the Committee on Reform of the PCT contained in document PCT/R/1/26, and

“(ii) unanimously approved the Committee’s recommendations concerning the establishment of a working group, the matters to be referred to the working group, and the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly, as set out, respectively, in paragraphs 67 and 68, 69 to 75, and 205 of the Committee’s report.”

5. Pursuant to the Assembly’s decision, the Director General convened the first session of the Working Group on Reform of the PCT, which was held in Geneva from November 12 to 16, 2001, and the second session of the Working Group was held in Geneva from April 29 to May 3, 2002. The proceedings at the Working Group’s sessions were informal, and there were no formal reports. Summaries of the sessions were prepared by the Chair, taking into account comments made by delegations on the draft versions, and are contained in documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively, the latter being reproduced in the Annex to this document.

6. The Working Group considered proposals, as recommended by the Committee and decided by the Assembly, relating to improved coordination of international search and international preliminary examination and the time limit for entering the national phase, the concept and operation of the designation system, and changes related to the Patent Law Treaty (PLT), and certain proposals for general simplification and streamlining of PCT procedures. A summary of the discussions of the proposals at the second session appears in paragraphs 5 to 58 of document PCT/R/WG/2/12.

7. The summary of the second session of the Working Group records that (see document PCT/R/WG/2/12, paragraph 60):

“It was agreed that revised proposals on the matters mentioned in paragraphs 5 to 58, above, would be prepared by the International Bureau, taking into account the discussion and conclusions reflected in this Summary and other points of detail noted by the Secretariat, for consideration by the Committee on Reform of the PCT at its second session which was tentatively scheduled for July 1 to 5, 2002. Draft proposals would, where appropriate, be made available for comment on the PCT reform electronic forum in advance of their issuance as formal documents.”

and that (see document PCT/R/WG/2/12, paragraph 63):

“The Working Group agreed that this Summary and the revised proposals referred to in paragraph 60, above, representing the results of the work of the Working Group, should be submitted to the Committee on Reform of the PCT for consideration at its second session in July 2002.”

8. The Committee is invited to consider the results to date of the work of the Working Group on Reform of the PCT represented in document PCT/R/WG/2/12 and reproduced in the Annex to this document, together with the revised proposals contained in the other documents before the Committee.

[Annex follows]

ANNEX

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session

Geneva, April 29 to May 3, 2002

SUMMARY OF THE SESSION

prepared by the Chair

(WIPO document PCT/R/WG/12)

INTRODUCTION

1. The session was opened by Mr. Francis Gurry, Assistant Director General, who welcomed the delegates on behalf of the Director General. Mr. Philip Thomas (WIPO) acted as Chair of the session and Mr. Claus Matthes (WIPO) as Secretary. The list of participants is contained in document PCT/R/WG/2/INF/1.

2. The matters for discussion at the session were the following, as recommended by the Committee on Reform of the Patent Cooperation Treaty (PCT) (“the Committee”) at its 1st session in May 2001 and agreed by the Assembly of the PCT Union (“the Assembly”) at its 30th (13th ordinary) session in September-October 2001 (see document PCT/R/1/26, paragraphs 69 to 75, and document PCT/A/30/7, paragraphs 15 to 22):¹

(i) the concept and operation of the designation system;

(ii) improved coordination of international search and international preliminary examination and the time limit for entering the national phase;

(iii) conform filing date requirements to those in the Patent Law Treaty (PLT), conform “missing part”-type requirements to PLT procedure, and other PLT-consistent changes;

(iv) (possibly) other proposals for general simplification and streamlining of PCT procedures.

3. The Working Group took into account the results of its 1st session as set out in the Summary of the Session prepared by the Chair and set out in document PCT/R/WG/1/9.² The documents before the Working Group at its 2nd session are listed in the Annex.^{3,*}

4. The session’s proceedings were informal. All five days of the session were devoted to discussions, and there was no formal report. This summary sets out the Chair’s view of the status of the matters discussed by the Working Group, noting areas where agreement has been

¹ See WIPO’s Web site at http://www.wipo.int/pct/en/reform/index_1.htm (for the Committee) and http://www.wipo.int/eng/document/govbody/wo_pct/index_30.htm (for the Assembly).

² See WIPO’s Web site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

³ The working documents for the 2nd session are available on WIPO’s Web site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

* The Annex to document PCT/R/WG/2/12 is reproduced as the Appendix to the present document.

reached and identifying what future work needs to be undertaken. Particular interventions are not recorded.

THE CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM⁴

5. Discussions were based on document PCT/R/WG/2/2.

Automatic indication of all designations possible under the PCT

6. The International Bureau indicated that paragraph 5(e) of document PCT/R/WG/2/2 was not intended to suggest that Article 27(5) was exhaustive on the question of prior art effect, but rather that it must be read giving proper effect to Articles 11(3) and 64(4).

7. The proposals contained in document PCT/R/WG/2/2, Annex I, were generally agreed, subject to the matters raised in the following paragraphs.

8. In connection with proposed amended Rule 4:

(i) provision should be made for the mention in the request of details of a parent application where a patent of addition, etc., is sought, similarly to Rule 4.1(b)(iii) dealing with parents of a continuation or continuation-in-part of an earlier application, on the understanding that the absence of such an indication could be corrected by the applicant in the national phase; Rule 4.13 should also be reviewed in this connection;

(ii) the wording of Rule 4.9(a)(i) should make it expressly clear that it is only possible to designate States which are Contracting States at the filing date of the application;

(iii) the wording of Rule 4.9(a)(ii) and (iii) should be revised to provide that the filing of the request “constitute” the desired effect rather than “have the effect of the wish of the applicant”;

(iv) the terminology used in Rule 4.9(b) (“prior to the time of performing the acts ...” and that used in Rule 49*bis*.1 (“within the time limit applicable ...”) should desirably be aligned;

(v) the wording of Rule 4.9(c) should be revised to make it clear what was the nature of the circumstances in which it would operate (that is, in cases of “self-designation” as explained in document paragraph 12(iv) of PCT/R/WG/1/9), having regard to the provisions of the national laws affected (that is, to those of Germany, Japan and the Republic of Korea), noting that “incompatibility” did not correctly describe those circumstances;

⁴ 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 (the current texts are available on WIPO’s Web site at http://www.wipo.int/pct/en/access/legal_text.htm. References to “national laws,” “the national phase,” etc., include reference to regional laws, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (the texts are available as document PT/DC/47 on WIPO’s Web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

(vi) the request form should contain a box which would enable applicants to make exclusions of designations under Rule 4.9(c) during the transitional period during which that Rule would operate;

(vii) Rule 4.9(d) should be deleted as being unnecessary having regard to the limited and transitional nature of Rule 4.9(c).

9. It was agreed that the present requirements in respect of indications and signature under Rules 4.5 and 4.15 should be retained. However, in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide such signature and the indications required under Rule 4.5(a) to (c) in respect of all of two or more applicants, two safeguards for applicants should be added.

10. The first safeguard would provide that, for the purposes of Article 14(1)(a)(i), it would be sufficient that the request be signed by at least one applicant. The second safeguard would provide that, for the purposes of Article 14(1)(a)(ii), it would be sufficient that indications required under Rule 4.5(a) to (c) be provided in respect of at least one applicant who is entitled according to Rule 19 to file the international application with the receiving Office concerned.

11. It was also agreed that, consequential to those changes, provision should be made in Rule 51*bis*.1 to permit designated Offices to require, in the national phase, the signature and required indications in respect of all applicants where those had not been provided in the international phase. In addition, to enable the receiving Office to contact a common representative appointed, or considered, under Rule 90.2, such representative should have provided the indications required under Rule 4.5(a) to (c).

12. It was further agreed that safeguards for applicants corresponding to those provided in relation to the request should be also added in relation to the signature, and to the indications in respect of the applicant, required in the demand.

13. While most delegations favored the simplicity of an automatic and all-inclusive designation, the Delegation of Germany drew attention to the wording of certain Articles of the Treaty which contemplate the possibility that the applicant may (for example) designate only one Contracting State (see Article 4) or choose only one form of protection (see Article 43). It was agreed that further consideration should be given to the question whether such possibilities needed to be specifically enabled by procedures available under the Regulations. In the event that they did need to be enabled, while recognizing that they might not be of great practical significance, one possibility might be the withdrawal of designations on the same day as the application was filed and to provide that such a withdrawal be considered as the exclusion of the designations concerned.

14. It was noted that, when an automatic and all-inclusive designation system had been adopted, future contractual arrangements between applicants and others would need to take that fact into account.

15. It was noted that further consequential amendments would be needed to Rule 32.2(b) and (c).

16. In connection with proposed Rule 49*bis*:

(i) in Rule 49*bis*.1(a) and (b), the reference to “Article 22(1) and 39(1)(a)” should be simply to “Article 22,” noting that Rule 76.5 made the provisions applicable to Chapter II;

(ii) in Rule 49*bis*.2, the words “a further time which shall be reasonable under the circumstances” should be replaced by “at least two months from [the time of entering the national phase]” (the wording of the latter to be aligned with that in Rules 4.9(b) and 49*bis*.1; see paragraph 8(iv), above).

17. It was agreed that Rule 76.6 no longer had any effect and should be deleted, since all transitional reservations made under that provision had since been withdrawn.

Automatic indication of all elections possible under the PCT

18. The proposals contained in document PCT/R/WG/2/2, Annex II, were generally agreed, subject to the matters raised in the following paragraphs.

19. Considering that there is no longer a need for a specific regulation for the concept of “later election”, it was agreed that Rule 56 should be deleted. Consequential amendment of other Rules (such as Rule 61.2) would then also be needed.

“Flat” international filing fee

20. The proposals contained in document PCT/R/WG/2/2, Annex III, were generally agreed, subject to the matters raised in the following paragraphs.

21. It was agreed that further consideration should be given to the basis for calculation of the late payment fee contemplated in Rule 16*bis*.2(b), depending on the amount which might be fixed for the new flat international filing fee (see Schedule of fees, item 1).

22. It was agreed that item 1 of the Schedule of Fees should refer to “each sheet of the international application.”

“Communication on request” system

23. The proposals contained in document PCT/R/WG/2/2, Annex IV, were generally agreed, subject to the matters raised in the following paragraphs.

24. It was agreed that Rule 47 as proposed to be amended and proposed new Rule 93*bis* should be revised to reflect the fact that those Rules would have to operate in relation to every Article 20 communication of a copy of the international application to a designated Office, no matter how that communication was effected, be it on the basis of a standing order for systematic communication of all or a certain class of documents or on the basis of a particular order for the communication of specified documents, be it on paper, in electronic form, by physical means (mailing) or by electronic means. Different considerations applied and could lead to different approaches, noting, in particular, the possibility of effecting communications by electronic means via a central data source (“intellectual property digital library” (IPDL)) from which Offices would be able to “pull” documents rather than have them “pushed” to Offices by the International Bureau.

25. It was agreed that further consideration should be given to the nature of the act of “communication,” the operation of Article 22(1), the safeguard afforded to applicants by the last sentence of present Rule 47.1(c), against the background of the proposed communication on request system, the possibilities available for Offices to make either particular orders for the communication of particular documents or standing orders for the communication of all or a certain class of documents, and the use of the term “IPDL” in the context of communication by electronic means.

CHANGES RELATED TO THE PLT: LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

26. Discussions were based on documents PCT/R/WG/2/5 and 5 Add.1.

Alignment with language-related filing date requirements of the PLT

27. It was agreed that no change was needed to the existing PCT Regulations in order to give effect to the language-related filing date requirements of the PLT, noting that PCT Rule 19.4(a)(ii) already provided for transmission to the International Bureau as receiving Office, without loss of filing date, of an international application which was not in a language accepted by the receiving Office with which it was filed, and noting that the International Bureau accepted any language for the purposes of filing of international applications. The PCT was thus already “PLT-compliant” in relation to language-related filing date requirements.

Translation of international application for the purposes of international publication

28. The proposals contained in the Annex to document PCT/R/WG/2/5 were agreed, subject to the further modifications proposed in document PCT/R/WG/2/5 Add.1, subject to the matters raised in the following paragraphs.

29. It was agreed that further consideration should be given to the basis for calculation of the late furnishing fee contemplated in Rules 12.3(e) and 12.4(e), depending on the amount which might be fixed for the proposed new “flat” international filing fee under item 1 of the Schedule of Fees (see paragraphs 20 to 22, above).

30. It was noted that the combined effect of the existing provisions of PCT Rules 12.1(c), 12.3(b) and 26.3^{ter}(c), and proposed new Rule 12.4(b), is such as to prevent a receiving Office from requiring a translation of the request if it is filed in any language of publication under the PCT, even if that language is not accepted by the receiving Office. Consideration should be given to further amendments which would enable the receiving Office to require a translation of the request into a language which is both a language of publication and a language accepted by the receiving Office.

IMPROVED COORDINATION OF INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION AND THE TIME LIMIT FOR ENTERING THE NATIONAL PHASE: EXPANDED INTERNATIONAL SEARCH SYSTEM

31. Discussions were based on documents PCT/R/WG/2/1, 1 Add.1, 9, 9 Corr., 10 and 11, particularly focusing on document PCT/R/WG/2/9, submitted by the United States of America, which proposed a simplified approach.

32. It was agreed that the proposed amendments of the Regulations set out in the documents should be further revised, taking into account the matters mentioned in the following paragraphs:

33. While a more extensive combination of the international search and international preliminary examination procedures would be considered in the context of long-term reform of the PCT, the separate procedures under Chapters I and II of the Treaty would be retained in the context of amending the Regulations to introduce the proposed expanded international search (EIS) system. The international preliminary examination procedure under Chapter II should continue to be initiated by the filing of a demand. The existing possibility for International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) to combine the procedures under Rule 69.1(b) would be retained.

34. Since all ISAs would be responsible for preparing international search opinions (ISOs) which were analogous in their content to international preliminary examination reports (IPERs), the Regulations should ensure that the qualifications for appointment of an ISA include all of those which apply for appointment of an IPEA.

35. If the applicant did not file a demand for international preliminary examination, the ISO would be re-issued as a report as part of the Chapter I procedure. The title of the report remained to be decided. Possibilities mentioned (but not agreed) during the session included: "international preliminary examination report" used in such a way as to distinguish the reports under Chapters I and II, "international initial examination report," "international search examination report," "international report on patentability" and "international advisory report." Further suggestions would be welcomed by the Secretariat.

36. Under the Chapter I procedure, the ISO would remain confidential until the report mentioned in the previous paragraph was communicated to designated Offices by the International Bureau, with the international application, 30 months from the priority date, unless the applicant expressly requested early entry into the national phase under Article 23(2) before a designated Office, in which case the report would be transmitted to that Office. The communication of international applications at the expiration of the applicable time limit under Article 22 to designated Offices of States which had made transitional reservations in connection with the modified time limit under that Article would not include the report, but the report would be sent to such Offices at the same time it was sent to Offices which had not made reservations. Once the report had been communicated, it would also be made publicly available by the International Bureau.

37. No special provisions would be included in the Regulations for the applicant to comment on the ISO. Under the Chapter I procedure, the applicant could, however, submit comments on an informal basis to the International Bureau. Such informal comments would be sent to designated Offices by the International Bureau and made publicly available, as would be the report resulting from the ISO. Designated Offices would be free to require a translation of such comments. Under the Chapter II procedure, any response to the ISO would need to be submitted to the IPEA under Article 34 as part of the international preliminary examination procedure.

38. It was not necessary to require that the same Office act as both ISA and IPEA, noting that any IPEA could, under the existing system, restrict its competence to applications in

respect of which the international search had been carried out by the same Office acting as ISA.

39. In accordance with the view of the majority of those delegations which expressed views on the matter, the ISO would, for the purposes of the international preliminary examination procedure, be considered to be the first written opinion in that procedure, on the understanding that this did not imply that the IPEA would be bound by the conclusions contained in the ISO. However, any IPEA would be entitled to inform the International Bureau that ISOs which had not been prepared by the same Office in the capacity of ISA would not be considered to be first written opinion in relation to the procedure before that IPEA; such an IPEA would then have to issue a first written opinion after receiving the demand, although that opinion could, of course, incorporate part or all of the content of the ISO.

40. The time limit for submitting a demand for international preliminary examination would be three months after the issuance of the ISO or 22 months from the priority date, whichever was later, and the time limit for paying the necessary fees would need to be adjusted accordingly. During the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 were still in force, the demand would have to be filed within 19 months from the priority date if the applicant wished to have 30 months in which to enter the national phase in those countries.

41. Any arguments and/or amendments in response to the ISO would also have to be submitted within three months after the issuance of the ISO or 22 months from the priority date, whichever was later, if they were to be taken into account by the IPEA, failing which the IPEA would be free to proceed straight to the issuance of the IPER, without issuing any further notification to the applicant. That time limit would apply even where the demand had been filed earlier.

42. Several non-governmental organizations representing users of the PCT system proposed that the applicant should be guaranteed a second written opinion after filing a demand (that is, in addition to the ISO which was considered to be the first written opinion). That proposal did not find support among delegations, but it was noted that the International Preliminary Examination Guidelines, which the IPEAs were obliged to apply and observe, provide for the issuance of a further opinion where the applicant made a serious attempt to respond to a (first) written opinion.

43. The ISO (or an accompanying form) should outline to the applicant the available options and consequences in terms of filing a demand, particularly if the same Office were not to act as both ISA and IPEA (see paragraph 39, above), time limits, responding to the matters raised in the ISO under Chapter I (by way of submitting informal comments) or Chapter II (by way of filing a demand and Article 34 arguments or amendments), etc.

44. No change would be proposed, at least for the time being, to the time limit for the preparation of the international search report (ISR). The Delegation of the United States of America urged consideration of a relaxed time limit for the preparation of the ISR.

45. The EIS system needed to operate simply and safely during the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 were still in force, as well as in the future.

46. Provision would be made for the International Bureau to make reports resulting under Chapter I from the ISO publicly available, together with any informal comments received, and to make IPERs publicly available on behalf of elected Offices which so request.

47. The scope of the relevant prior art to be considered in the preparation of both the ISR and the ISO, and the basis on which prior art was cited, including the date to which the search should be carried out, would correspond to the international preliminary examination procedure.

48. If for any reason the applicant filed a demand but the international application or the demand was subsequently withdrawn with the result that an IPER was not issued, the report resulting from the ISO would be available to the elected Offices. That is, either an IPER or the report resulting from the ISO would always be available to Offices in the national phase.

49. A number of drafting points were noted by the Secretariat and would be taken into account in the preparation of revised proposals.

CHANGES RELATED TO THE PLT: MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

50. Discussions were based on document PCT/R/WG/2/4.

51. Although the contents of document PCT/R/WG/2/4 could not, in the time available, be discussed in detail, the majority of the delegations which expressed their views agreed with the general approach outlined in the document, and it was agreed that the proposals should be submitted to the next session of the Committee. The revised proposals would envisage the possibility that national laws could make provisions concerning the prior rights of third parties and the right of third parties to intervene.

52. The Delegation of Japan expressed its concern about the proposed inclusion in the PCT Regulations of provisions having a similar effect to PLT Article 12 and PLT Rule 13(2). The Delegation believed that the PCT should not duplicate provisions which already are included in the PLT, noting that PLT Article 12 and PLT Rule 13(2) expressly applied to the time limits under PCT Articles 22 and 39(1) (see Note 3.08 on PLT Article 3(1)(b)). The Delegation also believed that the proposals dealt with substantive matters which should be left to national law to decide. The Delegation also believed that the proposal would cause severe practical problems for designated Offices because of the delays in national processing which would result.

CHANGES RELATED TO THE PLT: RIGHT OF PRIORITY AND PRIORITY CLAIMS

53. Discussions were based on document PCT/R/WG/2/3.

54. Although the contents of document PCT/R/WG/2/3 could not, in the time available, be discussed in detail, there was general support for proposed new Rule 26*bis*.3 relating to restoration of priority claims. Revised proposals should take into account the following considerations:

(i) the substantive validity of a priority claim in terms of the Paris Convention would remain a matter for national law;

(ii) national law could make provisions concerning the prior rights of third parties and the right of third parties to intervene;

(iii) the need for information concerning the fact that a priority claim had been restored to be communicated to designated Offices, for example, by the inclusion of indications on the front page of the published application (PCT pamphlet);

(iv) consideration should be given to reducing or eliminating the ability of a designated Office to review a decision of the receiving Office to restore or refuse to restore a priority claim (see Rule 26bis.3(h)).

55. It was agreed that proposed amended Rules 17.1 and 66.7, relating to the possibility, in line with the PLT, that priority documents may be available, in the future, from digital libraries, should proceed together with the proposed amendment of Rule 47.1 and related provisions (see paragraphs 24 and 25, above). Proposed amended Rules 26bis.1 and 26bis.2 and new Rule 80.8, relating to the correction and addition of priority claims, should similarly also proceed.

56. It was agreed that revised proposals should preferably be submitted to the second session of the Committee, although it was recognized that the time available may not permit the necessary revision of the proposals.

OTHER PROPOSALS FOR GENERAL SIMPLIFICATION AND STREAMLINING OF PCT PROCEDURES

Waiver of requirement for separate power of attorney under Rule 90.4

57. Discussions were based on the proposal to amend Rule 90.4 contained in document PCT/R/WG/2/7, Annex II, and document PCT/R/WG/2/7 Add.1.

58. It was agreed that Rule 90.4 should be amended to provide that any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement provided in Rule 90.4(b) that a separate power of attorney be submitted to it. It would be for the Office, the Authority or the International Bureau, as the case may be, to decide in what circumstances the requirement would be waived (for example, in cases where the agent concerned was the subject of an indication under Rule 4.7(b)). The Office, the Authority or the International Bureau would be permitted to require a separate power of attorney in particular instances even if it had waived the requirement in general. The signature of the applicant would always have to be required in the case of a withdrawal under Rule 90bis or a change in the person of the applicant under Rule 92bis.

OTHER MATTERS

59. The Working Group was unable in the time available to consider the following matters upon which proposals had been submitted to it for consideration at the session (see also related comments in documents PCT/R/WG/2/10 and 11):

(i) Changes related to the Patent Law Treaty (PLT):

- Absence of “formal” claims (document PCT/R/WG/2/8);

- Other PLT-related changes (document PCT/R/WG/2/6);

(ii) General simplification and streamlining of PCT procedures: Signature of the international application and related documents (document PCT/R/WG/2/7) (with the exception of the matters mentioned in paragraphs 57 and 58, above).

FUTURE WORK

60. It was agreed that revised proposals on the matters mentioned in paragraphs 5 to 58, above, would be prepared by the International Bureau, taking into account the discussion and conclusions reflected in this Summary and other points of detail noted by the Secretariat, for consideration by the Committee on Reform of the PCT at its second session which was tentatively scheduled for July 1 to 5, 2002. Draft proposals would, where appropriate, be made available for comment on the PCT reform electronic forum⁵ in advance of their issuance as formal documents.

NEXT SESSION

61. The International Bureau indicated that the third session of the Working Group was tentatively scheduled for November 25 to 29, 2002.

CONCLUSION

62. This Summary of the Session was prepared under the responsibility of the Chair, taking into account comments made by delegations on the draft (Prov.) version.

63. The Working Group agreed that this Summary and the revised proposals referred to in paragraph 60, above, representing the results of the work of the Working Group, should be submitted to the Committee on Reform of the PCT for consideration at its second session in July 2002.

[Appendix follows]

⁵ See WIPO's Web site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

LIST OF DOCUMENTS¹

- PCT/R/WG/2/1 Improved coordination of international search and international preliminary examination and the time limit for entering the national phase: Expanded international search system
(document prepared by the International Bureau)
- PCT/R/WG/2/1 Add.1 Proposed expanded international search system: EPO response (Addendum to document PCT/R/WG/2/1)
(proposals submitted by the European Patent Office (EPO))
- PCT/R/WG/2/2 The concept and operation of the designation system: Automatic indication of all designations possible under the PCT; Related proposals: Elections; International filing fee; “Communication on request” system
(document prepared by the International Bureau)
- PCT/R/WG/2/3 Changes related to the Patent Law Treaty (PLT): Right of priority and priority claims
(document prepared by the International Bureau)
- PCT/R/WG/2/4 Changes related to the Patent Law Treaty (PLT): Missed time limit for entering the national phase
(document prepared by the International Bureau)
- PCT/R/WG/2/5 Changes related to the Patent Law Treaty (PLT): Language of the international application and translations
(document prepared by the International Bureau)
- PCT/R/WG/2/5 Add.1 Proposed new Rule 12.4 (Addendum to document PCT/R/WG/2/5)
(Proposals submitted by the Republic of Korea)
- PCT/R/WG/2/6 Changes related to the Patent Law Treaty (PLT): Other PLT-related changes
(document prepared by the International Bureau)
- PCT/R/WG/2/7 General simplification and streamlining of PCT procedures: Signature of the international application and related documents
(document prepared by the International Bureau)
- PCT/R/WG/2/7 Add.1 Signature requirements (Addendum to document PCT/R/WG/2/7)
(proposals submitted by Australia)

* The Appendix to the present document reproduces the Annex to document PCT/R/WG/2/12.

¹ The working documents for the session are available on WIPO’s Web site at

http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

- PCT/R/WG/2/8 Changes related to the Patent Law Treaty (PLT): Absence of “formal” claims
(document prepared by the International Bureau)
- PCT/R/WG/2/9 Revised U.S. proposal for PCT reform; Counterproposal to document PCT/R/WG/2/1
(proposal submitted by the United States of America)
- PCT/R/WG/2/9 Corr. Revised U.S. proposal for PCT reform; Counterproposal to document PCT/R/WG/2/1: Corrigendum (page 5 of document PCT/R/WG/2/9 – English version only)
(document prepared by the International Bureau)
- PCT/R/WG/2/10 Comments on the papers for the second session of the PCT Reform Working Group
(proposals submitted by the Institute of Professional Representatives before the European Patent Office (EPI))
- PCT/R/WG/2/11 Expanded international search system; Absence of “formal claims”
(proposals submitted by the Intellectual Property Institute of Canada (IPIC))
- PCT/R/WG/2/12 Prov. Draft summary of the session
(prepared by the Chair)

[End of Appendix and of document]

WIPO



PCT/R/2/3

ORIGINAL: English

DATE: May 31, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

Second Session
Geneva, July 1 to 5, 2002

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

Document prepared by the International Bureau

INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, *inter alia*, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces the second session summary as an Annex.¹

¹ Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

Language of the international application: alignment with language-related filing date requirements of the Patent Law Treaty (PLT)

3. For the first session of the Working Group, the International Bureau prepared proposals for amendment of the Regulations under the PCT² with a view to aligning the language-related filing date requirements under the PCT with those under the PLT, as recommended by the Committee (see document PCT/R/26, paragraphs 72 to 74). Those proposals (see document PCT/R/WG/1/5, Annex II) would have had far-reaching consequences on aspects of the PCT procedure, beyond the filing date requirements, that concern receiving Office processing, international search, international publication and international preliminary examination. However, the proposals could not be discussed by the Working Group in the time available during its first session.
4. Some of the proposals would have resulted in much greater complexity of the PCT system, mainly for the reason that the proposals had to accommodate the fact that, under the PCT, several Offices and Authorities (and not just one national Office, as is the case under the PLT) are involved in the processing of the application during the international phase, and each PCT Office and Authority is entitled, within certain limits, to decide on its own working languages.
5. In view of this apparent contradiction to the objectives of PCT reform relating to simplification of both procedures and the wording of the Regulations, the International Bureau reconsidered the issue in substance and proposed to the second session of the Working Group (see document PCT/R/WG/2/5, paragraphs 1 to 7) not to proceed with changes to the Regulations concerning the language-related filing date requirements but rather to adopt a new approach for addressing the issue, as outlined in the following paragraphs.
6. The main difference between the language-related filing date requirements of the PLT and those of the PCT is that, *under the PLT*, only two elements of the application (“an express or implicit indication to the effect that the elements are intended to be an application” and “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office”) must, for the purposes of the filing date, be in a language accepted by the Office, whereas the “part which on the face of it appears to be a description” may, for the purposes of according a filing date, be in any language (see PLT Article 5(2)). *Under the PCT*, both the “part which on the face of it appears to be a description” and the “part which on the face of it appears to be a claim or claims” must, for the purposes of according an international filing date, be in a language accepted by the receiving Office (see PCT Article 11(1)(ii) and PCT Rule 20.4(c)).
7. While, at first glance, there would appear to be a need to align the PCT language-related filing date requirements with those of the PLT, as originally proposed by the International

² 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 (the current texts are available on WIPO’s Web site at http://www.wipo.int/pct/en/access/legal_text.htm). References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO’s Web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

Bureau in Annex II to document PCT/R/WG/1/5, upon further reflection, such approach overlooked the fact that an international application filed in any language with any receiving Office is in practice entitled, at present, to be accorded an international filing date (provided, of course, that all other filing date requirements are met). This arises because, pursuant to PCT Rule 19.4(a)(ii), if the international application³ is not in a language accepted (under PCT Rule 12.1(a)) by the receiving Office with which it was filed, it is considered to have been received by the receiving Office on behalf of the International Bureau as receiving Office and would be transmitted to the International Bureau, which accepts any language for the purposes of filing of the international application. Such an application would therefore be accorded an international filing date by the International Bureau as receiving Office (if all other filing date requirements are met).

8. In other words, the PCT is already, in practice, “PLT-compliant” in relation to language-related filing date requirements, since an international application will be entitled to an international filing date no matter in which language and with which Office it was filed. In a sense, the PCT is even more applicant-friendly than the PLT in this respect since it does not require, as does the PLT, that at least two elements of the application (“an express or implicit indication to the effect that the elements are intended to be an application” and “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office”) must, for the purposes of the filing date, be in a language accepted by the Office. For the purposes of according an international filing date, the International Bureau as receiving Office accepts any element of the international application in any language.

9. At its second session, the Working Group discussed the proposed new approach for addressing the issue of the language of the international application as outlined in paragraphs 7 and 8, above, and agreed to it. The Working Group’s discussions are outlined in paragraph 27 of the summary of the session prepared by the Chair (document PCT/R/WG/2/12):

“27. It was agreed that no change was needed to the existing PCT Regulations in order to give effect to the language-related filing date requirements of the PLT, noting that PCT Rule 19.4(a)(ii) already provided for transmission to the International Bureau as receiving Office, without loss of filing date, of an international application which was not in a language accepted by the receiving Office with which it was filed, and noting that the International Bureau accepted any language for the purposes of filing of international applications. The PCT was thus already “PLT-compliant” in relation to language-related filing date requirements.”

10. It is thus proposed, recognizing that the PCT is already, in practice, consistent with the language-related filing date requirements of the PLT, not to proceed with changes to the PCT Regulations concerning the language-related filing date requirements.

Translation of the international application for the purposes of international publication

11. At present, where the international application is filed in a language which is accepted by the receiving Office and by the International Searching Authority that is to carry out the

³ More precisely, the description and/or the claims; language defects in the request, the abstract or any text matter in the drawings are considered formal defects under PCT Rule 26.3*ter*.

international search but is not a language of publication, it is the International Searching Authority which is responsible for the establishment of a translation of the international application into English (see present Rule 48.3(b)).⁴ In practice, it is normally the applicant who prepares the translation and furnishes it to the International Searching Authority. However, if the applicant does not do so, the International Searching Authority must prepare the translation itself. Although the Authority may charge a fee for preparing the translation (see present Rule 48.3(b), second sentence), this creates extra work for the Authority. In addition, in some cases the Authority is unable to recover the cost of preparing the translation, since there is no sanction if the applicant fails to pay the fee for the translation. The preparation of a translation appears to be a matter which should properly be the responsibility of the applicant.

12. During the first session of the Working Group, the Republic of Korea submitted a proposal for amendment of the PCT Regulations so as to require the applicant, rather than the International Searching Authority, to furnish the required translation and to introduce a sanction if the applicant fails to do so (see document PCT/R/WG/1/8), in line with earlier proposals submitted by the Korean Industrial Property Office, the Netherlands Industrial Property Office, the Swedish Patent and Registration Office and the European Patent Office, which were discussed in 1997 by an ad hoc advisory group on proposed amendments of the PCT Regulations. However, Working Group was unable to discuss the proposal in the time available during its first session.

13. At its the second session, the Working Group discussed proposals for amendment of the PCT Regulations, based on document PCT/R/WG/2/5, prepared by the International Bureau along the lines of the earlier proposal in document PCT/R/WG/1/8 submitted by the Republic of Korea. The Republic of Korea also submitted further proposals to the second session in document PCT/R/WG/2/5 Add.1. As outlined in the summary of the session prepared by the Chair (see document PCT/R/WG/2/12, paragraphs 28 to 30):

“28. The proposals contained in the Annex to document PCT/R/WG/2/5 were agreed, subject to the further modifications proposed in document PCT/R/WG/2/5 Add.1, subject to the matters raised in the following paragraphs.

“29. It was agreed that further consideration should be given to the basis for calculation of the late furnishing fee contemplated in Rules 12.3(e) and 12.4(e), depending on the amount which might be fixed for the proposed new “flat” international filing fee under item 1 of the Schedule of Fees (see paragraphs 20 to 22, above).

⁴ At present, this is the case, in practice: (i) where the international application is filed in Dutch with the Netherlands Industrial Property Office or the Belgium Industrial Property Office and the European Patent Office as International Searching Authority carries out international search (in Dutch); (ii) where the international application is filed with the Danish Patent and Trademark Office in Danish, Norwegian or Swedish, with the Finnish National Board of Patents in Finnish or Swedish, the Icelandic Patent Office in Danish, Norwegian or Swedish, the Norwegian Patent Office in Norwegian, or the Swedish Patent Office in Danish, Finnish, Norwegian or Swedish, and the Swedish Patent Office as International Searching Authority carries out the international search (in Danish, Finnish, Norwegian or Swedish); and (iii) where the international application is filed with the Korean Intellectual Property Office in Korean and that Office as International Searching Authority carries out international search (in Korean).

“30. It was noted that the combined effect of the existing provisions of PCT Rules 12.1(c), 12.3(b) and 26.3ter(c), and proposed new Rule 12.4(b), is such as to prevent a receiving Office from requiring a translation of the request if it is filed in any language of publication under the PCT, even if that language is not accepted by the receiving Office. Consideration should be given to further amendments which would enable the receiving Office to require a translation of the request into a language which is both a language of publication and a language accepted by the receiving Office.”

14. The Annex to the present document contains a redraft of the proposals contained in documents PCT/R/WG/1/8, PCT/R/WG/2/5 and PCT/R/WG/2/5 Add.1, taking into account the views expressed, and agreement reached, at the second session of the Working Group.

Language of the request

15. As requested by the Working Group (see document PCT/R/WG/2/12, paragraph 30), the International Bureau has considered a possible amendment of the PCT Regulations so as to allow a receiving Office to require a translation of the *request* part of an international application for the purposes of processing by it, even though it may be prepared to accept, for the purposes of according an international filing date, the filing of an *international application*⁵ in any language.

16. Present Rule 12.1(c) requires that the request be in a language which is both a language accepted by the receiving Office for the purposes of filing international applications and a language of publication. If the request meets that requirement, the receiving Office is not entitled, having regard to Rules 12.3(b) and 26.3ter(c), to require a translation of it, even though a translation of the remainder of the application may be required under Rule 12.3(a). This restriction may limit the capacity of some receiving Offices to adopt a more flexible approach in relation to the languages which it is prepared to accept for the purposes of Rule 12.1(a).

17. The Annex to this document thus contains a proposal to amend Rule 12.1(c) so as to enable a receiving Office to specify any language of publication which it accepts for the purposes of filing the request. This would enable receiving Offices to accept, for the purposes of according the international filing date, the filing of the international application⁵ in any language while, at the same time, enabling it to limit the languages that it is prepared to accept for the purposes of filing of the request, and to require a translation of the request if not in such a language.

18. The Committee is invited to consider the proposals contained in paragraph 10, above, and in the Annex.

[Annex follows]

⁵ More precisely, the description and the claims; language defects in the request, the abstract and any text matter in the drawings are considered formal defects under PCT Rule 26.3ter.

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

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¹ 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 12

**Language of the International Application and Translation
for the Purposes of International Search and International Publication**

12.1 *Languages Accepted for the Filing of International Applications*

(a) and (b) [No change]

(c) Notwithstanding paragraph (a), the request shall be filed in any ~~a~~ language of
publication which ~~is both a language accepted by~~ the receiving Office accepts for that purpose
~~under that paragraph and a language of publication.~~

[COMMENT: See paragraphs 15 and 17 in the Introduction to this document.]

(d) [No change]

12.2 *Language of Changes in the International Application*

(a) [No change]

(b) Any rectification under Rule 91.1 of an obvious error in the international application shall be in the language in which the application is filed, provided that:

(i) where a translation of the international application is required under Rule 12.3(a), [12.4\(a\)](#) ~~48.3(b)~~ or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language of the application and the language of that translation;

[COMMENT: The proposed amendment of item (i) is consequential on the proposed addition of new Rule 12.4 and deletion of Rule 48.3(b) (see below).]

(ii) [No change]

12.3 [No change]

12.4 Translation for the Purposes of International Publication

(a) Where the language in which the international application is filed is not a language of publication and no translation is required under Rule 12.3(a), the applicant shall, within 14 months from the priority date, furnish to the receiving Office a translation of the international application into English.

[COMMENT: See paragraphs 11 to 13 in the Introduction to this document. As at present (see present Rule 48.3(b), which is proposed to be deleted), the international application would be translated into, and published in, English.]

(b) Paragraph (a) shall not apply to the request nor to any sequence listing part of the description.

(c) Where the applicant has not, within the time limit referred to in paragraph (a), furnished a translation required under that paragraph, the receiving Office shall invite the applicant to furnish the required translation, and to pay, where applicable, the late furnishing fee required under paragraph (e), within 16 months from the priority date. Any translation received by the receiving Office before that Office sends the invitation under the previous sentence shall be considered to have been received before the expiration of the time limit under paragraph (a).

[Rule 12.4, continued]

(d) Where the applicant has not, within the time limit under paragraph (c), furnished the required translation and paid any required late furnishing fee, the international application shall be considered withdrawn and the receiving Office shall so declare. Any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 17 months from the priority date shall be considered to have been received before the expiration of that time limit.

(e) The furnishing of a translation after the expiration of the time limit under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late furnishing fee equal to [50%] of the international filing fee.

[COMMENT: The Working Group, at its second session, was of the view that further consideration should be given to the basis for calculation of the late furnishing fee contemplated in Rules 12.3(e) and 12.4(e), depending on the amount which might be fixed for the proposed new “flat” international filing fee under item 1 of the Schedule of Fees (see document PCT/R/WG/2/12, paragraph 29). The figure of 50% is therefore placed in square brackets. With regard to the proposal to add new Rule 12.4, see paragraphs 11 to 13 in the Introduction to this document. See also Rule 48.3(b), which is proposed to be deleted (see below).]

Rule 22

Transmittal of the Record Copy and Translation

22.1 *Procedure*

(a) to (g) [No change]

(h) Where the international application is to be published in the language of a translation furnished under Rule 12.3 [or 12.4](#), that translation shall be transmitted by the receiving Office to the International Bureau together with the record copy under paragraph (a) or, if the receiving Office has already transmitted the record copy to the International Bureau under that paragraph, promptly after receipt of the translation.

[COMMENT: The proposed amendment of paragraph (h) is consequential on the proposed addition of new Rule 12.4 (see above).]

22.2 [*Remains deleted*]

22.3 [No change]

Rule 26

**Checking by, and Correcting Before, the Receiving Office of
Certain Elements of the International Application**

26.1 and 26.2 [No change]

26.3 *Checking of Physical Requirements Under Article 14(1)(a)(v)*

(a) [No change]

(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:

(i) [No change]

(ii) any translation furnished under Rule 12.3 [or 12.4](#) and the drawings for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

[COMMENT: The proposed amendment of item (ii) is consequential on the proposed addition of new Rule 12.4 (see above).]

26.3*bis* to 26.6 [No change]

Rule 29

International Applications or Designations Considered Withdrawn

29.1 *Finding by Receiving Office*

(a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rules 12.3(d) [or 12.4\(d\)](#) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

[COMMENT: The proposed amendment of paragraph (a) is consequential on the proposed addition of new Rule 12.4 (see above).]

(i) to (iv) [No change]

Rule 48

International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) [No change]

(a-*bis*) If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 [or 12.4](#), that application shall be published in the language of that translation.

[COMMENT: The proposed amendment of paragraph (a-*bis*) is consequential on the proposed addition of new Rule 12.4 (see above).]

(b) ~~[Deleted] If the international application is filed in a language which is not a language of publication and no translation into a language of publication is required under Rule 12.3(a), that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the~~

[Rule 48.3(b), continued]

~~circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the relevant portions of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.~~

[COMMENT: The proposed deletion of paragraph (b) is consequential on the proposed addition of new Rule 12.4 (see above).]

(c) [No change]

48.4 to 48.6 [No change]

[End of Annex and of document]

WIPO



PCT/R/2/4

ORIGINAL: English

DATE: May 31, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

Second Session
Geneva, July 1 to 5, 2002

MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

Document prepared by the International Bureau

INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, *inter alia*, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces the second session summary as an Annex.¹

¹ Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

Reinstatement of rights after failure to comply with requirements for entering the national phase within the time limits under Articles 22 and 39(1)

3. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT² relating, as recommended by the Committee, to changes necessary or desirable to bring the requirements under the PCT into line with the letter and spirit of the Patent Law Treaty (PLT) (see the report of the first session of the Committee, document PCT/R/26, paragraphs 72 to 74).

4. There was wide agreement at the first session of the Working Group on the general approach to be taken (see document PCT/R/WG/1/9, paragraph 21). Among the matters agreed was that (see paragraph 21(v)):

“priority should be given by the Working Group to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities; for example, priority might be given to the following:

...

– relief when time limits were missed, especially the time limit for entering the national phase.”

The Working Group further agreed at its first session (see document PCT/R/WG/1/9, paragraph 24):

“that the International Bureau should prepare a proposal which would provide in the PCT Regulations for extensions of the time limit for entering the national phase, similarly to PLT Article 3(1)(b)(i) read in the light of PLT Articles 11 and 12”.

5. At its second session, the Working Group considered proposals, prepared by the International Bureau, designed to afford relief where the time limit for entering the national phase was missed (see document PCT/R/WG/2/4). The discussion by the Working Group is outlined in the summary of the session (see document PCT/R/WG/2/12, paragraphs 51 and 52):

² 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 (the current texts are available on WIPO’s Web site at http://www.wipo.int/pct/en/access/legal_text.htm). References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO’s Web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

“51. Although the contents of document PCT/R/WG/2/4 could not, in the time available, be discussed in detail, the majority of the delegations which expressed their views agreed with the general approach outlined in the document, and it was agreed that the proposals should be submitted to the next session of the Committee. The revised proposals would envisage the possibility that national laws could make provisions concerning the prior rights of third parties and the right of third parties to intervene.

“52. The Delegation of Japan expressed its concern about the proposed inclusion in the PCT Regulations of provisions having a similar effect to PLT Article 12 and PLT Rule 13(2). The Delegation believed that the PCT should not duplicate provisions which already are included in the PLT, noting that PLT Article 12 and PLT Rule 13(2) expressly applied to the time limits under PCT Articles 22 and 39(1) (see Note 3.08 on PLT Article 3(1)(b)). The Delegation also believed that the proposals dealt with substantive matters which should be left to national law to decide. The Delegation also believed that the proposal would cause severe practical problems for designated Offices because of the delays in national processing which would result.”

6. PLT Articles 3 and 12 and PLT Rule 13(2) are reproduced for ease of reference in Annex I. Revised proposals for amendment of the PCT Regulations to enable the reinstatement of rights after failure to comply with the requirements for national phase entry within the time limit under PCT Article 22 or 39(1) is set out in Annex II to the present document. The key features of the proposals are outlined in the following paragraphs.

Present situation

7. If the applicant fails to perform the acts referred to in PCT Article 22 or 39(1) (generally, the furnishing of a translation of the international application and the payment of the national fee) before any designated or elected Office within the applicable time limit, the international application ceases to have the effect provided for in PCT Article 11(3) (that is, the effect of a regular national application) as far as that State is concerned, with the same consequences as the withdrawal of any national application in that State (see PCT Article 24(1)(iii)).

8. As regards the possibility for the applicant to excuse any delay in meeting the time limits under PCT Article 22 and 39(1), at present, the PCT provides for such possibility only in the particular case of irregularities in the mail service (delay or loss in mail, interruption in the mail service) under PCT Article 48(1) and PCT Rule 82.

9. In all other cases (that is, not related to irregularities in the mail service), the possibility of excusing a missed time limit under PCT Article 22 or 39(1) must be pursued before each designated or elected Office individually, and only as far as that Office is concerned. For each designated or elected Office where the applicant wishes to attempt to have such a delay excused, the applicant must perform all acts required for entry into the national phase and, at the same time, request the Office to maintain the effect of the application and to excuse the delay. In determining whether a delay may be excused, each Office must apply the conditions laid down by the applicable national law in the same way and under the same conditions as they are applied to national applications, including any time limit for filing a request to excuse the delay (see PCT Article 48(2)).

10. Examples of national provisions for excusing delays are those that allow reinstatement of rights, restoration, *restitutio in integrum*, revival of abandoned applications, further processing, continuation of proceedings, and so on (see PCT Rule 82*bis*.2).

11. While the national laws of many designated and elected Offices contain provisions which allow for the excuse of delays in meeting time limits, including the time limits applicable under PCT Articles 22 and 39(1), this is not the case in respect of all designated and elected Offices. Where the applicant misses the applicable time limit for entry into the national phase before an Office whose national law does not contain such provisions, the international application ceases to have the effect as far as that State is concerned, with the same consequences as the withdrawal of any national application in that State, and no further remedy is generally available.

Patent Law Treaty

12. In order to provide a remedy for applicants in such situations, PLT Article 3(1)(b)(i) expressly provides that the provisions of the PLT and the Regulations under the PLT (once in force) would be applicable, subject to the provisions of the PCT, to international applications in respect of the time limits applicable under PCT Articles 22 and 39(1) in the Office of the PLT Contracting Party. In other words, under the PLT, any national Office of a State which is a Contracting Party of both the PLT and the PCT and which acts as a designated or elected Office under the PCT would be obliged to apply the provisions of the PLT, in particular PLT Article 12, to an international application which missed the applicable time limit for entry into the national phase before that Office.

Intervening rights of third parties

13. Note 12.10 on PLT Article 12 describes intervening rights of third parties as “the rights, if any, acquired by a third party for any acts which were started, or for which effective and serious preparations were started, in good faith, during the period between the loss of rights resulting from the failure to comply with the time limit concerned and the date on which those rights are reinstated” and the right of third parties to intervene (that is, to intervene in the matter of a request for the reinstatement of rights by furnishing, to the Office concerned, grounds for refusing such request). Noting that any such rights are, and remain, a matter for the national law applied by the designated or elected Office, there appears to be no need to expressly include a provision covering them in the PCT Regulations as was suggested in document PCT/R/WG/2/12, paragraph 51.

Amendments of the PCT Regulations

14. Noting that the PLT has not yet entered into force, it is proposed, as suggested in paragraph 24 of the first session summary, to incorporate into the PCT Regulations a provision with similar effect to PLT Article 12 and PLT Rule 13(2) so as to oblige all designated and elected Offices³ to provide for the reinstatement of rights of the applicant if the applicant has missed the applicable time limit under Article 22 or 39(1) for entry into the national phase in spite of due care required by the circumstances having been taken or, at the option of the designated or elected Office, where the delay was unintentional. Annex II to the

³ Existing Rule 76.5 would ensure that proposed new Rule 49.6 is also applied by elected Offices.

present document contains specific proposals to amend the PCT Regulations accordingly. A transitional reservation provision is included, recognizing that some national laws will need to be amended to bring them into line with the PCT Regulations as proposed to be amended.

15. The Committee is invited to consider the proposals contained in Annex II.

[Annex I follows]

PLT ARTICLES 3 AND 12 AND RULE 13

Article 3

Applications and Patents to Which the Treaty Applies

(1) [*Applications*] (a) The provisions of this Treaty and the Regulations shall apply to national and regional applications for patents for invention and for patents of addition, which are filed with or for the Office of a Contracting Party, and which are:

(i) types of applications permitted to be filed as international applications under the Patent Cooperation Treaty;

(ii) divisional applications of the types of applications referred to in item (i), for patents for invention or for patents of addition, as referred to in Article 4G(1) or (2) of the Paris Convention.

(b) Subject to the provisions of the Patent Cooperation Treaty, the provisions of this Treaty and the Regulations shall apply to international applications, for patents for invention and for patents of addition, under the Patent Cooperation Treaty:

(i) in respect of the time limits applicable under Articles 22 and 39(1) of the Patent Cooperation Treaty in the Office of a Contracting Party;

(ii) in respect of any procedure commenced on or after the date on which processing or examination of the international application may start under Article 23 or 40 of that Treaty.

(2) [*Patents*] The provisions of this Treaty and the Regulations shall apply to national and regional patents for invention, and to national and regional patents of addition, which have been granted with effect for a Contracting Party.

Article 12

*Reinstatement of Rights After a Finding of Due Care
or Unintentionality by the Office*

(1) [*Request*] A Contracting Party shall provide that, where an applicant or owner has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or patent, the Office shall reinstate the rights of the applicant or owner with respect to the application or patent concerned, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed, and all of the requirements in respect of which the time limit for the said action applied are complied with, within the time limit prescribed in the Regulations;

(iii) the request states the reasons for the failure to comply with the time limit; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(2) [*Exceptions*] No Contracting Party shall be required to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

(3) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(4) [*Evidence*] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.

(5) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraph (1) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Rule 13

Details Concerning Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office Under Article 12

(1) [*Requirements Under Article 12(1)(i)*] A Contracting Party may require that a request referred to in Article 12(1)(i) be signed by the applicant or owner.

(2) [*Time Limit Under Article 12(1)(ii)*] The time limit for making a request, and for complying with the requirements, under Article 12(1)(ii), shall be the earlier to expire of the following:

(i) not less than two months from the date of the removal of the cause of failure to comply with the time limit for the action in question;

(ii) not less than 12 months from the date of expiration of the time limit for the action in question, or, where a request relates to non-payment of a maintenance fee, not less than 12 months from the date of expiration of the period of grace provided under Article 5*bis* of the Paris Convention.

(3) [*Exceptions Under Article 12(2)*] The exceptions referred to in Article 12(2) are failure to comply with a time limit:

(i) for an action before a board of appeal or other review body constituted in the framework of the Office;

(ii) for making a request for relief under Article 11(1) or (2) or a request for reinstatement under Article 12(1);

- (iii) referred to in Article 13(1), (2) or (3);
- (iv) for an action in *inter partes* proceedings.

[Annex II follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹
MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

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¹ 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 49

Copy, Translation and Fee Under Article 22

49.1 to 49.5 [No change]

49.6 Reinstatement of Rights After Failure to Perform the Acts Referred to in Article 22

(a) Where the effect of the international application provided for in Article 11(3) has ceased because the applicant failed to perform the acts referred to in Article 22 within the applicable time limit, the designated Office shall, upon request of the applicant, notwithstanding Rule 82 and subject to paragraphs (b) to (g) of this Rule, reinstate the rights of the applicant with respect to that international application if it finds that any delay in meeting that time limit was unintentional or, at the option of the designated Office, that the failure to meet that time limit occurred in spite of due care required by the circumstances having been taken.

[COMMENT: See PLT Article 12(1)(iv). As is the case in PLT Article 12(1)(iv), it is proposed to leave it at the option of the designated Office to decide which standard it wishes to apply in deciding whether or not to reinstate the rights of an applicant who failed to perform the acts referred to in Article 22 within the applicable time limit. Note that the provisions of Rule 82 would still apply as a *lex specialis*.]

[Rule 49.6, continued]

(b) The request under paragraph (a) shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within whichever of the following periods expires first:

(i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or

(ii) 12 months from the date of the expiration of the applicable time limit under Article 22.

[COMMENT: See PLT Article 12(1)(ii) and PLT Rule 13(2).]

(c) The request under paragraph (a) shall state the reasons for the failure to comply with the applicable time limit under Article 22.

[COMMENT: See PLT Article 12(1)(iii).]

[Rule 49.6, continued]

(d) The national law applicable by the designated Office may require:

(i) that a fee be paid in respect of a request under paragraph (a);

[COMMENT: See PLT Article 12(3).]

(ii) that a declaration or other evidence in support of the reasons referred to in paragraph (a) be filed.

[COMMENT: See PLT Article 12(4).]

(e) Where any requirement referred to in paragraphs (c) and (d) is not already fulfilled during the same period within which the request under paragraph (a) for reinstatement of rights must, under paragraph (b), be submitted, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation.

[COMMENT: Modeled after present Rule 51*bis*.3(a).]

(f) The designated Office shall not refuse a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[COMMENT: See PLT Article 12(5).]

[Rule 49.6, continued]

(g) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (f) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in that respect of that designated Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[End of Annex and of document]