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./ The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith documents PCT/R/WG/4/1, 1 Add.1, 2, 4, 4 Add.1, 4 Add.2, 5, 7 and 8, prepared for the fourth session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which will be held in Geneva from May 19 to 23, 2003.

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

March 26, 2003

Enclosures: documents PCT/R/WG/4/1, 1 Add.1, 2, 4, 4 Add.1, 4 Add.2, 5, 7 and 8

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

Fourth Session
Geneva, May 19 to 23, 2003

OPTIONS FOR RESTORATION OF THE RIGHT OF PRIORITY:

“UNINTENTIONALITY” CRITERION; “DUE CARE” CRITERION;
RETAIN PRIORITY CLAIM FOR INTERNATIONAL PHASE LEAVING
RESTORATION FOR NATIONAL PHASE

Document prepared by the International Bureau

BACKGROUND

1. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT¹ relating, as recommended by the Committee on Reform of the PCT (“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).

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

2. TherewaswideagreementatthefirstsessionoftheWorkingGrouponthegeneral approachtotaken(see documentPCT/R/WG/1/9, paragraph21). Amongthematters agreedwasthat(see paragraph21(v)):

“priorityshouldbegivenbytheWorkingGrouptothosematterswhichwouldresultin thegreatestandmostimmediatepracticalbenefitsforusers, havingregardalsotothe degreeofcomplexityinvolvedandtoworkloadimplicationsforOfficesand Authorities;forexample, prioritymightbegiventothefollowing:

– provisionsforrestorationofthepriorityrightincertaincircumstances;

....”

3. TheproposalspreparedbytheInternationalBureauforconsiderationatthefirstsession oftheWorkingGroupincludedprovisionsforrestorationoftherightofprioritysimilar tothoseinthePLT(see documentPCT/R/WG/1/5, AnnexIII). TheWorkingGroup’s discussionsareoutlinedindocumentPCT/R/WG/1/9, paragraphs22and23:

“22. DiscussionswerebasedondocumentPCT/R/WG/1/5, andin particularon proposednewRule26 *bis*.3, containedinAnnexIIItothatdocument, whichwould provideforrestorationofthepriorityrightforuptotwomonthsbeyondtheusual 12-monthpriorityperiod. Thecommentsandconcernsexpressedbyvarious delegationsincludedthefollowing:

(i) therewasgeneralagreementwiththeideaofprovidingforameansof restorationofpriorityrights, consistentlywithcorrespondingprovisionsofthePLT, duringtheinternationalphaseofthePCTprocedure;

(ii) notingthattheadministrationofthoseprovisionsinthenationalphase wouldbeamatterforROs[receivingOffices], theimportanceofasinglestandard, orat leastconsistentpractice, amongthevariousROswasemphasizedbyseveral delegations;

(iii) delegationsdifferedintheirviewsastotheappropriatecriterionwhich shouldapplyinthecontextofthePCT(underRule26 *bis*.3(a)(iii))incaseswherethe applicantfailedtofiletheinternationalapplicationwithinthe12-monthpriorityperiod, notingthatthePLTprovidedforContractingPartiestochoosebetweentwocriteria:

– mostdelegationsfavoredadoptingthemoreliberalcriterionof “unintentional”failureinthecontextofthePCT;

– certaindelegationsfavoredadoptingthemorestrictcriterionof“duecare”;

– certaindelegationsfavoredgivingROsachoiceastowhichofthetwo criteriatoapply, aswouldbethecaseforContractingPartiestothePLT;

(iv) itwasrecognizedbytheWorkingGroupthatprovisionforrestorationofthe priorityrightintheinternationalphaseimpliedthattheRO’sdecisionwouldneedto haveeffectforthepurposesofthenationalphase;

(v) most delegations believed that the RO's decisions should be binding on DOs [designated Offices] (as under proposed Rule 26 *bis*.3(f)), but certain delegations believed that the RO's decisions should be subject to review by DOs in at least some circumstances, although there was no agreement as to what circumstances should be relevant in this context;

(vi) it was pointed out that, if the PCT were to require that one particular criterion be applied by all ROs, it would be possible for an Office to have to apply one criterion in its capacity as a PCT RO and the other criterion in its capacity as a national Office processing national applications or as a DO processing international applications entering the national phase;

(vii) it was recognized that priority dates had two related but distinct effects:

– “procedural” in the sense that certain important time limits under the PCT were recalculated by reference to the priority date;

– “substantive” in the sense that it was at the priority date that it would be determined whether the invention satisfied the requirements of novelty and inventive step (non-obviousness);

(viii) the recognition in the national phase of an RO's decision to restore the priority right was more particularly related to the procedural effect; the procedural effect was the dominant consideration in, for example, PCT Article 2(xi) and Rule 26*bis*.2(a);

(ix) the fact that a considerable number of countries' national laws did not presently provide for restoration of priority rights, at least according to PLT criteria, suggested that transitional reservations would need to be allowed for if restoration provisions were to be introduced under the PCT.

“23. It was agreed that the International Bureau should prepare a revised proposal which would:

(i) provide for restoration of the priority right by the RO based on the “unintentional” criterion, but identifying alternatives in the related comments or explanation;

(ii) make it clear that it was the procedural effect of the priority right, rather than the substantive effect, that should be recognized for the purposes of the national phase.”

4. Revised proposals relating to the reinstatement of right of priority were prepared by the International Bureau for consideration by the Working Group at its second session (see document PCT/R/WG/2/3). The Working Group's discussions are outlined in document PCT/R/WG/2/12, paragraphs 54 to 56:

“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) considerations 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)).

[...]

“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.”

5. Further revised proposals relating to the reinstatement of right of priority were prepared by the International Bureau for consideration by the Committee at its second session (see document PCT/R/2/5). The Committee's discussions are outlined in document PCT/R/2/9, paragraphs 111 to 123 and 125:

“111. Discussion was based on the proposals by the International Bureau set out in document PCT/R/2/5.

[...]

“Restoration of Priority Claims

“117. The Delegation of Canada, supported by the Delegations of Australia and the United States of America, stated that, while it supported in principle the concept of providing relief where the 12-month priority period was not complied with, it was concerned that the restoration of a priority claim as proposed in Rule 26bis.3 could be considered to be a matter of substance. Noting that the PLT and the PCT operated in different contexts, the Delegations suggested that such relief might, instead, be provided by amendment of Rules 4.10 and 26bis.1.

“118. The Delegation of Japan stated that, although it supported the proposed restoration of priority claims in principle, it was concerned that, in some cases, such restoration could leave insufficient time for the transmittal of the record copy and translation within 13 months as required by Rule 22.1. The Delegation of Kenya also referred to the need to avoid problems of meeting time limits that might arise where a priority claim was restored.

“119. The Delegation of Austria, supported by the Delegations of Spain, Germany, Ireland, France, Sweden, Portugal, Denmark, the Netherlands and Greece and the Representative of the EPO, suggested that the criterion for restoration under proposed new Rule 26bis.3(a)(iii) should be changed from “unintentional” to “due care.” The

Delegation of the United Kingdom emphasized a preference for retaining a single criterion; otherwise, there was a possibility that applicants who had missed the 12-month priority period might shop around for receiving Offices with the most liberal criterion. The suggested change was opposed by the Delegation of Australia, supported by the Delegations of the United States of America and Canada, on the grounds that the “unintentional” criterion was broader and therefore more applicant -friendly.

“120. The Committee agreed that the words “or the International Bureau, as the case maybe,” in proposed new Rule 26 *bis*.3(e) were unnecessary.

“121. The Delegation of the United Kingdom and the Representative of the EPO suggested, in connection with proposed Rule 26 *bis*.3(g), that express provisions should be made, where the receiving Office refused a request for restoration of priority claim, for a designated Office to review that decision, noting that Articles 24 and 25 would not appear to be applicable in such a case. The Committee agreed that the revised proposal should contain such a provision. The Delegation of the United Kingdom also questioned whether the review by a designated Office should be based on its own criterion or that used by the receiving Office.

“122. In response to a comment by the Delegation of China, the International Bureau explained that the transitional reservations provided for in proposed Rule 26 *bis*.3(h) were intended to apply only to the provisions of Rule 26 *bis*.3 and not to Rules 26 *bis*.1 and 26 *bis*.2, since the latter provisions were already in force and were not subject to reservations. So as to clarify the matter, the Committee agreed that the words “this Rule” should be replaced by “paragraphs (a) to (g).”

“123. Having regard to the number of outstanding issues connected with the proposed provisions relating to restoration of priority claims, and noting that the proposal had not been extensively considered by the Working Group, the Committee felt that they were not yet ripe to proceed to the Assembly.

[...]

“Further Consideration

“125. The Committee agreed to recommend to the Assembly that the proposed amendments of Rules 4.10, 26 *bis*.3 and 48.2 set out in Annex II to document PCT/R/2/5 should be revised by the International Bureau, taking into account the comments and concerns expressed at the Committee’s session, and submitted to the Working Group [...] for discussion at its next session.”

6. The Assembly, at its 31st (18th extraordinary) session, held in Geneva from September 23 to October 1, 2002, unanimously approved the Committee’s recommendation concerning the proposed amendments of certain Rules relating to the restoration of the right of priority (see document PCT/A/31/10, paragraph 44(i)).

7. Further revised proposals relating to the reinstatement of the right of priority were prepared by the International Bureau for consideration by the Working Group at its third session (see document PCT/R/WG/3/2). The Working Group’s discussions are outlined in document PCT/R/WG/3/5, paragraphs 13 to 27:

“RESTORATION OF THE RIGHT OF PRIORITY

“13. Discussions were based on documents PCT/R/WG/3/2 and 2 Add.1.

“14. There was little support for the proposal by the International Bureau in document PCT/R/WG/3/2 that the criterion for restoration of the right of priority should, at the choice of the applicant, be either “due care” or “unintentionality,” with a higher fee being payable where the applicant chooses to request the receiving Office to apply the “unintentionality” criterion.

“15. Several delegations and representatives of users emphasized the importance of enabling restoration of the right of priority, noting that unintentional errors and unforeseen difficulties in meeting the priority deadline were a fact of life for applicants and their representatives, notwithstanding their keen desire to respect it. Although a number of delegations expressed the desire for a single criterion to be established in connection with the restoration of the right of priority by receiving Offices in the international phase, there was no agreement as to what that criterion should be.

“16. A considerable number of delegations and representatives of users were of the opinion that the criterion to be applied by receiving Offices in the international phase should be “unintentionality,” stating that such an approach would be more user-friendly and also simpler for receiving and designated Offices to apply, and that it would bring about more uniformity among Offices. Several other delegations and one representative favored the adoption of the more stringent criterion of “due care,” on the understanding that any designated Office would be free to apply a more liberal criterion (such as “unintentionality”) to the application when it entered the national phase.

“17. It was noted that, under the proposal for a “due care” criterion as just outlined, where the receiving Office refused a request for restoration, the dates for international publication and national phase entry would expire up to 14 months later than would have been the case if the request had been allowed. A subsequent request for restoration before a designated Office in the national phase on the basis of “unintentionality” would be difficult to sustain since, if it were to be allowed, the “proper” dates for international publication and national phase entry would, in retrospect, be up to 14 months earlier than had in fact been the case. The applicant may therefore be obliged to request international publication and to enter the national phase early, on the basis of times calculated from the earlier priority dates sought, in the mere hope that the request for restoration would be allowed by the designated Office.

“18. The proposal by the EPO in document PCT/R/WG/3/2 Add.1 would enable the applicant to request restoration on the ground of “unintentionality” in the national phase if a request based on “due care” had been refused in the international phase. While some delegations supported the proposal, it was noted that it would obligate the applicant to request restoration during the international phase on the ground of “due care” even in cases where that criterion was clearly not complied with, simply in order to be able to pursue the matter further in the national phase on the ground of “unintentionality”. Some delegations and representatives of users pointed to the desirability of enabling the applicant to place on file, before the publication date, a statement of intention to request restoration later in the national phase and evidence in support of that request.

“19. One delegation said that one of its user groups had suggested that a possible approach could be to automatically retain in the international application any priority claim which was based on an earlier application with a filing date earlier than 12 months, but not more than 14 months, from the international filing date, leaving the possibility of restoration to be governed by the national law and decided separately by each designated Office. Several delegations and representatives of users expressed the concern that such an approach, while in compliance with the requirements of the PLT, would lead to a diversity of practices among designated Offices and require the applicant to engage in a multitude of parallel procedures in which essentially the same issue was at stake.

“20. Several delegations suggested that guidance should be provided in the context of the PCT as to the application of the two criteria, noting that no such guidance was provided in the context of the provisions concerning the matter in the PLT and that little information was available as to the present practices of the various Offices. One delegation suggested that it would be useful to conduct a survey of present practices by sending a questionnaire to all PCT Offices and Authorities. That survey should seek information as to the application of the criteria of “due care” and “unintentionality” in general, that is, not restricted to cases where restoration of the right of priority was sought, but also in cases, for example, of late payment of annuities, in order to obtain guidance as to the differences between the two criteria and to assist in the establishment of guidelines. The questionnaire should also seek information as to the proof required.

“21. Certain delegations suggested that provisions for restoration of the right of priority should not be proceeded with until a majority of PCT Contracting States provided for such restoration under their national law, which would be in compliance with the PLT. However, a majority expressed the view that as a solution to this question of principle should not be delayed, noting that the inclusion in the Regulations of provisions dealing with restoration of the right of priority would, in the long term and notwithstanding the likelihood that a number of Contracting States would make transitional reservations, encourage national laws to provide for the matter in a harmonized way.

“22. Several delegations expressed concern as to whether the draft provisions as proposed by the International Bureau were compatible with the provisions of Article 8(2)(a), which referred to the Paris Convention with regard to the conditions for, and the effect of, priority claims, and Article 27(5), which stated that nothing in the Treaty and the Regulations was intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desired. In the latter connection, it was pointed out that the inclusion of provisions in the PLT for restoration of the right of priority suggested that the procedure was not regarded as a substantive matter in the context of the PLT. One delegation commented that the distinction between procedural and substantive aspects of the proposal was unclear and should be further explored.

“23. In connection with review during the national phase of a receiving Office’s decision on a request for restoration of the right of priority, some delegations questioned whether there was a need, in proposed Rule 26bis.3(j), to distinguish between the “designated Office” on the one hand and the “designated State” on the other, and suggested that the provision might better refer to what was permitted or required in the national law. One delegation suggested that designated Offices should be able to

review any decision by the receiving Office on the grounds that it was erroneous. Doubt was expressed by another delegation as to how far the Regulations could restrict the circumstances in which a decision of the receiving Office could be reviewed by a court in the national phase.

“24. One delegation suggested that a provision similar to proposed Rule 26bis.3(k) should be included to enable receiving Offices, as well as designated Offices, to make transitional reservations in relation to proposed Rule 26bis.3(a) to (j).

“25. In the light of the discussions, the Working Group agreed that:

(i) the proposal to leave the choice of criterion to the applicant, as proposed in document PCT/R/WG/3/3, was not supported;

(ii) there was no general agreement as to which of the two criteria for restoration provided for in the PLT, namely “due care” or “unintentionality,” should apply in the case of determinations by a receiving Office;

(iii) it would be preferable to continue to seek a solution under which a decision of the receiving Office to restore the right of priority would be given proper effect by designated Offices, rather than to leave the matter to be determined separately by each designated Office under a variety of national laws;

(iv) it was necessary to ensure that any provision concerning restoration of the right of priority was compatible with Articles 8 and 27(5), although it was noted that, under the PLT, the restoration of the right of priority was not considered to be a matter of substance;

(v) practical problems and confusion would arise if receiving Offices were obliged to apply one criterion as a receiving Office and a different criterion as a designated Office or national Office;

(vi) whatever solution, if any, were to be found, there would be a need for guidance, preferably in the PCT Receiving Office Guidelines, on the practice to be followed.

“26. It was agreed that the International Bureau should prepare a revised proposal presenting three options for further consideration by the Working Group providing, respectively, for the criterion of “due care,” for the criterion of “unintentionality,” and for the automatic retention of the priority date for the purposes of the international phase, leaving the question whether its restoration was allowable to the national phase. The revised proposal would also provide, under any of those options, for an indication of the intention or request for restoration and for supporting evidence to be filed in the international phase and to be included in the international publication.

“27. It was also agreed that the International Bureau should send a questionnaire to all PCT Offices and Authorities requesting information as to the application of such criteria under the various national laws and practices.”

REVISED PROPOSALS; REPLIES TO QUESTIONNAIRE

8. As agreed by the Working Group at its third session, Annexes I and II to this document contain revised proposals for amendment of the PCT Regulations to provide for the restoration of the right of priority, taking into account the discussion and conclusions reflected in the summary by the Chair.

9. Annex I contains proposals drafted on the basis that restoration would be by the receiving Office, the same criterion being applied by all receiving Offices, but with options as to whether that criterion would be “unintentionality” (option A) or “due care” (option B).

10. Annex II contains proposals (option C) drafted on the basis of retention of the priority claim for the purposes of the international phase, leaving the question whether the right of priority can be restored to be decided by the designated or elected Office in the national phase. Noting that the PLT has not yet entered into force, Annex II also contains a proposal to incorporate into the PCT Regulations a provision, with the same requirements as PLT Article 13(2) and PLTR Rule 13(4) and (5), which would oblige designated and elected Offices to provide for the restoration of the right of priority where the date on which the earlier application was filed was not a date falling within the period of 12 months preceding the international filing date but was a date falling within the period of 14 months preceding the international filing date if the designated Office finds that the failure to file the international application within the period of 12 months from the date of filing of the earlier application occurred in spite of due care required by the circumstances having been taken or, at the option of the designated Office, was unintentional. A transitional reservation provision is also included, recognizing that some national laws will need to be amended to bring them in line with the PCT Regulations as proposed to be amended.

11. For an overview of the replies received in response to the questionnaire concerning the application of the criteria of “due care” and “unintentionality” under the various national laws and practices, see document PCT/R/WG/4/1 Add. 1.

12. Article 13 and Rule 14 of the PLT are reproduced for ease of reference in Annex III.

13. The Working Group is invited to consider the proposals contained in Annexes I and II to this document.

[Annex I follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ²

RESTORATION OF THE RIGHT OF PRIORITY

OPTION A:

RESTORATION BY RECEIVING OFFICE BASED ON “UNINTENTIONALITY” ³

OPTION B:

RESTORATION BY RECEIVING OFFICE BASED ON “DUE CARE” ³

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

³ See Annex II for Option C: Retain Priority Claim for International Phase Leaving Restoration for National Phase.

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, [that date](#) being [subject to Rule 26bis.3](#), a date falling within the period of 12 months preceding the international filing date;

[COMMENT: It is proposed to amend item (i) of paragraph (a) so as to clarify that, where the applicant is submitting a request for restoration of the right of priority, the date on which the earlier application was filed as indicated in the request does not have to be a date falling within the period of 12 months preceding the international filing date.]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 26 bis

Correction or Addition of Priority Claim ; Restoration of Right of Priority

26bis.1 [No change]

[COMMENT: Note, however, that the Working Group, at its third session, approved proposed amendments of Rule 26bis.1 with a view to their possible submission to the Assembly for adoption at its next session in September - October 2003; see document PCT/R/WG/3/2 and the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 28 and 29.]

26bis.2 ~~Invitation to Correct~~ Defects in Priority Claims

[COMMENT: Consequential on the proposed deletion of the reference to "invitation" in paragraph (b).]

(a) Where the receiving Office or, if the receiving Office fails to do so, the International

Bureau, finds that:

(i) a priority claim does not comply with the requirement of Rule 4.10(a)(i) and a request for restoration of the right of priority under Rule 26bis.3 has not been filed; or

(ii) a priority claim does not comply with the other requirements of Rule 4.10; or

(iii) ~~that~~ any indication in a priority claim is not the same as the corresponding indication appearing in the priority document ;

[Rule 26bis.2(a), continued]

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim.

[COMMENT: There appears to be no need for an invitation to correct a priority claim where a request for restoration of that right of priority has been filed by the applicant, showing that the applicant, while being aware of the fact that the filing date of the earlier application as indicated in the request does not fall within the 12 months preceding the international filing date, has no intention to correct that priority date but rather wishes to have the right of priority restored under Rule 26 bis.3, below.]

(b) If, ~~in response to an invitation under paragraph (a),~~ the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim so as to comply with the requirements of Rule 4.10, or does not, where applicable, before the expiration of the time limit under Rule 26bis.3(b), submit a request for restoration of the right of priority, that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly, provided that a priority claim shall not be considered not to have been made only because the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing or because an indication in the priority claim is not the same as the corresponding indication appearing in the priority document.

[Rule 26bis.2 (b), continued]

[COMMENT: Paragraph (b) is proposed to be amended so as to clarify that a priority claim cannot be considered not to have been made under this paragraph where the applicant has filed a request for restoration of right of priority. Rather, the decision by the receiving Office on whether or not to consider the priority claim not to have been made is governed by proposed new Rule 26bis.3, below (that is, the decision to restore the right of priority or to refuse the request for restoration). In this context, it is also proposed to delete the words “, in response to an invitation under paragraph (a),” which appear to be superfluous; whether or not the notice of correction or the request for restoration is received as a result of an invitation would seem irrelevant.]

(c) [No change]

26bis.3 Restoration of Right of Priority

(a) The receiving Office shall, subject to paragraphs (b) to (e), restore the right of priority where the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date but is a date falling within a period of 14 months preceding the international filing date if the receiving Office finds that the failure to file the international application within the period of 12 months from the date of filing of the earlier application [OPTION A: was unintentional] [OPTION B: occurred in spite of due care required by the circumstances having been taken].

[COMMENT: It is proposed to use similar terminology to that used in Rule 4.10(a)(iii) (“... date on which the earlier application was filed, being a date falling within the period of 12 months preceding the international filing date”) rather than, as in previous drafts, terminology which may cause confusion with the term “priority period” as used in the Paris Convention (see the earlier draft of Rule 26bis.3(a) in document PCT/R/WG/3/2 (“... an earlier application has an international filing date which is later than the date on which the priority period referred to in paragraph (f) expired but is within two months from that date ...”).]

[Rule 26bis.3, continued]

(b) Restorations shall be made on the request of the applicants submitted to the receiving Office within a time limit of 14 months from the date on which the earlier application was filed, stating the reasons for the failure to file the international application within the period of 12 months from the date of filing of the earlier application.

[COMMENT: See the Comment on paragraph (a), above.]

(c) The request referred to in paragraph (b) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration equal to 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

[COMMENT: Paragraph (c) is modeled after Rule 12.3(e) as adopted by the PCT Assembly in October 2002.]

(d) The receiving Office:

(i) may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b) be filed within a time limit which shall be reasonable under the circumstances;

(ii) shall not refuse, totally or in part, a request under paragraph (b) for restoration of a right of priority without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[Rule 26bis.3, continued]

(e) Where the international application did not claim the priority of the earlier application, the request referred to in paragraph (b) shall be accompanied by a notice adding the priority claims so as to comply with the requirements of Rule 4.10.

(f) Where the receiving Office refuses a request for restoration of the right of priority under paragraph (b), the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office shall so declare and shall inform the applicant accordingly .

(g) Where the receiving Office has refused a request under paragraph (b) for restoration of the right of priority, or where such a request is pending at the time of the completion of the technical preparations for international publication:

(i) the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning that request for restoration; a copy of the request under this item shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3);

[Rule 26bis.3(g), continued]

(ii) the applicant may furnish to the International Bureau, and the International Bureau shall include in its files, a copy of any declaration or other evidence filed in support of the statement of reasons referred to in paragraph (b).

[COMMENT: This item has been included following suggestions made by some delegations and representatives of users during the third session of the Working Group (see summary of the session by the Chair, document PCT/R/WG/3/5, paragraph 18.)]

(h) Where the receiving Office has refused a request under paragraph (b) for restoration of the right of priority, a designated Office may, on the request of the applicant, review the decision by the receiving Office, provided that a copy of the international application (unless the communication provided for in Article 20 has already taken place) and the appropriate translation (as prescribed) have been furnished and the national fee (if any) has been paid within the time limit applicable under Article 22 that would apply if the right of priority were restored. The designated Office may require that a request for review shall be presented to it within the time limit applicable under Article 22 and may subject the making of the request to the payment to it of a fee for its own benefit.

(i) When reviewing the decision of the receiving Office in accordance with paragraph (h), the designated Office shall:

[Rule 26bis.3(i), continued]

(i) subject to item (ii), where the designated Office finds that the failure to file the international application within the period of 12 months from the date of filing of the earlier application [OPTION A: was unintentional] [OPTION B: occurred in spite of due care required by the circumstances having been taken], it shall restore the right of priority for the purposes of the designated State or States concerned;

(ii) where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than those provided for under this Rule, apply the requirements under the applicable national law instead of the requirements under this Rule.

[COMMENT: The text of new paragraphs (h) and (i) has been further revised, following agreement in the second session of the Committee that express provisions should be made, where the receiving Office refused a request for restoration, for a designated Office to review that decision, noting that Articles 24 and 25 would not appear to be applicable in such a case (see the report of the second session of the Committee, document PCT/R/2/9, paragraph 121).]

(j) Where the receiving Office has restored a right of priority under paragraph (a), no designated Offices shall review the decision of the receiving Office unless it has reasonable doubts that a requirement under this Rule was not complied with, in which case it shall notify the applicant accordingly, indicating the reasons for those doubts and giving the applicant an opportunity to make observations within a reasonable time limit.

[Rule 26bis.3(j), continued]

[COMMENT: New paragraph (j) is proposed to be added with a view to striking an equitable balance between the interests of the applicant in not having the decision by the receiving Office to restore the right of priority routinely reviewed by designated Offices and the right of designated Offices to revoke an incorrectly restored right of priority. Designated Offices, during the national phase, would have to respect the decision taken by the receiving Office during the international phase unless they have good reason not to.]

(k) Where the receiving Office has restored a right of priority under paragraph (a), the designated Office in the case referred to in paragraph (j), the courts and any other competent organ of the designated State shall, when determining the right of priority:

(i) subject to item (ii), apply the requirements under this Rule and shall not disregard the right of priority only because the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date, unless a requirement under this Rule was not complied with;

(ii) where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under this Rule, apply the requirements under the applicable national law instead of the requirements under this Rule.

[COMMENT: New paragraph (k) is proposed to be added so as to require the designated Office (when reviewing a decision by the receiving Office in the case referred to in paragraph (j)), the courts and any other competent organ of the designated State to apply the same criteria as the receiving Office under Rule 26bis.3 or, where the requirements under the national law are more favorable than the requirements under Rule 26bis.3, to apply those requirements.]

[Rule 26bis.3, continued]

(l) If, on [date of adoption of these modifications by the PCT Assembly], any provision of paragraphs (j) and (k) is not compatible with the national law applied by the designated Office, that provision shall not apply in respect of that Office for as long as it continues not to become 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.

[COMMENT: If the “unintentionality” criterion were adopted under paragraph (a), a national law applied by a designated Office which provided for the “due care” criterion or any other criterion more stringent than the “unintentionality” criterion would not be compatible with the provisions of paragraphs (j) and (l). On the other hand, if the “due care” standard were adopted under paragraph (a), a national law applied by a designated Office which provided for a more stringent criterion than “due care” or did not provide for restoration at all would not be compatible with the provisions of paragraphs (j) and (l). In both cases, such a designated Office could make use of the transitional reservation provision provided for in paragraph (l). So as to achieve a uniform approach to the question of restoration of the right of priority at least during the international phase, it is not proposed to amend paragraph (l) further so as to permit receiving Offices to make a similar transitional reservation where the national law applied by the receiving Office is not compatible with the provisions of Rule 26bis.3, in particular, paragraph (a) (as was suggested by one delegation during the third session of the Working Group; see the summary of the Chair, document PCT/R/WG/3/5, paragraph 23).]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (ix) [No change]

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under Rule 26 *ter.1*, which was received by the International Bureau before the expiration of the time limit under Rule 26 *ter.1*;

(xi) any information concerning a request for restoration of the right of priority, the publication of which is requested under Rule 26 *bis.3(g)(i)*.

[COMMENT: This item has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the intention of the applicant to request restoration where the request for restoration of the right of priority under Rule 26 *bis.3* has been refused by the receiving Office or is pending at the time of completion of technical preparations for international publication (see document PCT/R/WG/3/5, paragraph 26).]

[Rule 48.2, continued]

(b) Subject to paragraph (c), the front pages shall include:

(i) to (iii) [No change]

(iv) an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26 *ter*.1;

(v) indications concerning any right of priority which has been restored under Rule 26bis.3(a);

[COMMENT: This item has been included following agreement at the second session of the Working Group to “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)” (see document PCT/R/WG/2/12, paragraph 54(iv)).]

(vi) an indication that the pamphlet contains information concerning a request for restoration of the right of priority, the publication of which is requested under Rule 26bis.3(g)(i);

[COMMENT: This item has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the intention of the applicant to request restoration where the request for restoration of the right of priority under Rule 26bis.3 has been refused by the receiving Office or is pending at the time of completion of technical preparations for international publication (see document PCT/R/WG/3/5, paragraph 26).]

[Rule 48.2(b), continued]

(vii) where the applicant has furnished copies of any declaration or other evidence referred to in Rule 26bis.3(g)(ii), an indication to that effect .

[COMMENT: This item has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the fact that the applicant has furnished to the International Bureau, for inclusion in its files, copies of any declaration or other evidence filed in support of the statement of reasons referred to in Rule 26bis.3(b).]

(c) to (i) [No change]

48.3 to 48.6 [No change]

Rule 76⁴

Copy, Translation and Fee Under Article 39(1);

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 Application of Certain Rules ~~22.1(g), 47.1, 49, 49bis and 51bis~~

Rules 22.1(g), 26bis.3(h) to (l), 47.1, 49, 49bis and 51 bis shall apply, provided that:

(i) to (v) [No change]

[COMMENT: Proposed amendment of Rule 76.5 is consequential on the proposed amendment to Rule 26 bis.3.]

76.6 *[Remains deleted]*

⁴ The “present” text shown is that of Rule 76 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

Rule 80

Computation of Time Limits

80.1 to 80.7 [No change]

80.8 *Time limits Computed From the Priority Date*

(a) Where a change in the priority date is caused by:

(i) the correction or addition of a priority claim under Rule 26bis.1; or

(ii) the restoration of a right of priority under Rule 26bis.3;

any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

(b) For the purposes of computing any time limit which is computed from the priority date, if a priority claim does not comply with Rule 4.10(a)(i) because the date on which the earlier application was filed was not a date falling within the period of 12 months preceding the international filing date, that priority claim shall not be taken into account for the purposes of computing any such time limit except where the right of priority has been restored in accordance with Rule 26bis.3.

[Rule 80.8(b), continued]

[COMMENT: Note that the Working Group, in its third session, has already approved the proposed addition of new Rule 80.8, to the extent that it deals with the correction and addition of a priority claim under Rule 26bis.1, with a view to its possible submission to the Assembly for adoption at its next session in September - October 2003 (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraph 29). Consequential on the proposed addition of new Rule 26bis.3 (see above), it appears necessary to further amend Rule 80.8(b) so as to ensure that a priority claim which does not comply with Rule 4.10(a)(i) (because the date on which the earlier application was filed is not a date falling within the 12 months preceding the international filing date) is nevertheless taken into account for the purposes of computing time limits if the right of priority is restored under proposed new Rule 26bis.3(a).]

[Annex II follows]

ANNEXII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ⁵

RESTORATION OF THE RIGHT OF PRIORITY

OPTION C:

RETAIN PRIORITY CLAIM FOR INTERNATIONAL PHASE
LEAVING RESTORATION FOR NATIONAL PHASE

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⁵ 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 2 6bis

Correction or Addition of Priority Claim

26bis.1 [No change]

[COMMENT: Note, however, that the Working Group, at its third session, approved proposed amendments of Rule 26bis.1 with a view to their possible submission to the Assembly for adoption at its next session in September -October 2003; see document PCT/R/WG/3/2 and the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 28 and 29.]

26bis.2 ~~Invitation to Correct~~ Defects in Priority Claims

(a) [No change]

(b) If, ~~in response to an invitation under paragraph (a),~~ the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claims so as to comply with the requirements of Rule 4.10, that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly, provided that a priority claim shall not be considered not to have been made only because :

[COMMENT: As in Annex I to this document, it is proposed to delete the words “, in response to an invitation under paragraph (a),” which appear to be superfluous; whether or not the notice of correction is received as a result of an invitation would seem irrelevant.]

[Rule 26bis.2(b), continued]

(i) the indication of the number of the earlier application referred to in

Rule 4.10(a)(ii) is missing ; ~~or~~

(ii) ~~because~~ an indication in the priority claim is not the same as the corresponding indication appearing in the priority document ; or

(iii) the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date, provide d that the date on which the earlier application was filed is a date falling within the period of 14 months preceding the international filing date .

[COMMENT: Paragraph (b) is proposed to be amended so as to provide for the retention during the international phase of a priority claim where the earlier application the priority of which is claimed has a filing date which does not fall within the period of 12 months preceding the international filing date (see Rule 4.10(a)(i)) but falls within a period of 14 months preceding the international filing date (see the summary by the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraphs 19 and 26). See proposed new Rule 49bis (below) with regard to the procedure before the designated Offices.]

(c) [No change]

[Rule 26bis.2, continued]

(d) In the case referred to in paragraph (b)(iii), the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, a statement by the applicant concerning the fact that the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date but is a date falling within the period of 14 months preceding the international filing date. A copy of the statements shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: Paragraph (d) has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the intention of the applicant to request restoration of the right of priority in the national phase (see the summary by the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraph 26).]

Rule 48

International Publication

48.1 [Nochange]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (ix) [Nochange]

(x) any declaration referred to in Rule 4 .17(v), and any correction thereof under Rule 26 *ter.1*, which was received by the International Bureau before the expiration of the time limit under Rule 26 *ter.1*;

(xi) any statement referred to in Rule 26 *bis.2(d)*.

[COMMENT: See Comment on Rule 26 *bis.2(d)*, above.]

(b) Subject to paragraph (c), the front pages shall include:

(i) to (iii) [Nochange]

[Rule 48.2(b), continued]

(iv) an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26 *ter.1*;

(v) an indication that the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date but is a date falling within the period of 14 months preceding the international filing;

[COMMENT: The inclusion, on the front page of the pamphlet, of such indication appears useful.]

(vi) where the applicant has furnished a statement referred to in Rule 26bis.2(d), an indication to that effect .

[COMMENT: This item has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the intention of the applicant to request restoration of the right of priority in the national phase (see document PCT/R/WG/3/5, paragraph 26).]

(c) to (i) [No change]

48.3 to 48.6 [No change]

Rule 49 ter

Restoration of Right of Priority

49ter.1 Restoration of Right of Priority

(a) In the case referred to in Rule 26.2bis(b)(iii), the designated Office shall, subject to paragraphs (b) and (c), restore the right of priority where the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date but is a date falling within the period of 14 months preceding the international filing if the designated Office finds that the failure to file the international application within the period of 12 months from the date of filing of the earlier application occurred in spite of due care required by the circumstances having been taken or, at the option of the designated Office, was unintentional.

(b) Restoration shall be made on the request of the applicants submitted to the designated Office within a time limit of two months from the date on which the requirements under Article 22 must be complied with, stating the reasons for the failure to comply with the priority period.

(c) The designated Office:

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

[Rule 49ter.1(c), continued]

(ii) may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b) be filed within a time limit which shall be reasonable under the circumstances;

(iii) shall not refuse, totally or in part, a request under paragraph (b) for restoration of a right of priority without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

(d) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under paragraphs (a) to (c), the designated Office shall, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under paragraph (e).

(e) If, on [date of adoption of these modifications by the PCT Assembly], any of the provisions of paragraphs (a) to (c) is not compatible with the national law applied by the designated Office, that provision shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office inform 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.

[Rule 49ter.1(e), continued]

[COMMENT: Noting that the PLT has not yet entered into force, it is proposed to incorporate into the PCT Regulations a provision with the same requirements as under PLT Article 13(2) and PLTR Rule 13(4) and (5) (the text of which is reproduced in Annex III) so as to oblige all designated and elected Offices to provide for the restoration of the right of priority where the earlier application the priority of which is claimed has a filing date which is not within the period of 12 months preceding the international filing date but falls within a period of 14 months preceding the international filing date if the designated Office finds that the failure to file the international application within the period of 12 months from the filing date of the earlier application occurred in spite of due care required by the circumstances having been taken or, at the option of the designated Office, was unintentional. 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.]

Rule76⁶

Copy, Translation and Fee Under Article 39(1);

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 Application of Certain Rules ~~22.1(g), 47.1, 49, 49 bis and 51 bis~~

Rules 22.1(g), 47.1, 49, 49 bis, 49 ter and 51 bis shall apply, provided that:

(i) to (v) [No change]

[COMMENT: Proposed amendment of Rule 76.5 is consequential on the proposed addition of new Rule 49 *ter*.]

76.6 *[Remains deleted]*

⁶ The “present” text shown is that of Rule 76 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

Rule80

ComputationofTimeLimits

80.1to80.7 [Nochange]

80.8 TimelimitsComputedFromthePriorityDate

(a) Whereachangeintheprioritydateiscausedby thecorrectionor additionofa priorityclaimunderRule 26bis.1,anytimelimitwhichiscomputedfromthepreviously applicableprioritydateandwhichhasnotalreadyexpiredshallbecomputedfromthepriority dateassochanged.

(b) Forthepurposesofcomputingan ytimelimitwhichiscomputedfromthepriority date,ifapriorityclaimdoesnotcomplywithRule 4.10(a)(i)becausethedateonwhichthe earlierapplicationwasfiledwasnotadatefallingwithinaperiodof12 monthsprecedingthe internationalfilingdate,thatpriorityclaimshallnotbetakenintoaccountforthepurposesof computinganysuchtimelimitexceptwherethepriorityclaimisnotconsiderednottohave beenmadeinaccordancewithRule 26bis.2(b)(iii).

[COMMENT:NotthattheWorking Group,inthirdsession,hasalreadyapprovedthe proposedadditionofnewRule80.8,totheextentthatitdealswiththecorrectionandaddition ofapriorityclaimunderRule 26bis.1,withaviewtoitspossiblesubmissiontotheAssembly foradoptionatitsnextsessioninSeptember -October2003(seethesummaryofthesession bytheChair,documentPCT/R/WG/3/5,paragraph29).Consequentialonthe proposed amendmentofRule26 bis.2(seeabove),itappearstobeneccessarytofurthramendRule 80.8(b)so astoensurethatapriorityclaimwhichdoesnotcomplywithRule 4.10(a)(i)(becausethedate onwhichtheearlierapplicationwasfiledisnotadatefallingwithinthe12 monthspreceding theinternationalfilingdate)isneverthelessstakenintoaccountforthepurposesofcomputing timelimitsifthatpriorityclaimis,inaccordancewithRule26 bis.2(b)(iii),notconsiderednot tohavebeenmade(seeRule 26bis.2asproposedtobeamended,above).]

[AnnexIIIfollows]

ANNEX III

ARTICLE 13 AND RULE 14 OF THE PATENT LAW TREATY (PLT)

Article 13

Correction or Addition of Priority Claim; Restoration of Priority Right

(1) [*Correction or Addition of Priority Claim*] Except where otherwise prescribed in the Regulations, a Contracting Party shall provide for the correction or addition of a priority claim with respect to an application (“the subsequent application”), 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 within the time limit prescribed in the Regulations; and
- (iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

(2) [*Delayed Filing of the Subsequent Application*] Taking into consideration Article 15, a Contracting Party shall provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, 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 within the time limit prescribed in the Regulations;
- (iii) the request states the reasons for the failure to comply with the priority period; and
- (iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(3) [*Failure to File a Copy of Earlier Application*] A Contracting Party shall provide that, where a copy of an earlier application required under Article 6(5) is not filed with the Office within the time limit prescribed in the Regulations pursuant to Article 6, the Office shall restore the right of priority, 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 within the time limit for filing the copy of the earlier application prescribed in the Regulations pursuant to Article 6(5);

(iii) the Office finds that the request for the copy to be provided had been filed with the Office with which the earlier application was filed, within the time limit prescribed in the Regulations; and

(iv) a copy of the earlier application is filed within the time limit prescribed in the Regulations.

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

(5) *[Evidence]* A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(6) *[Opportunity to Make Observations in Case of Intended Refusal]* A request under paragraphs (1) to (3) 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 14

Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13

(1) *[Exception Under Article 13(1)]* No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed.

(2) *[Requirements Under Article 13(1)(i)]* A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant.

(3) *[Time Limit Under Article 13(1)(ii)]* The time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(4) *[Time Limits Under Article 13(2)]* (a) The time limit referred to in Article 13(2), introductory part, shall expire not less than two months from the date on which the priority period expired.

(b) The time limit referred to in Article 13(2)(ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier.

(5) *[Requirements Under Article 13(2)(i)]* A Contracting Party may require that a request referred to in Article 13(2)(i):

(i) be signed by the applicant; and

(ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

(6) [*Requirements Under Article 13(3)*] (a) A Contracting Party may require that a request referred to in Article 13(3)(i):

(i) be signed by the applicant; and

(ii) indicate the Office to which the request for a copy of the earlier application had been made and the date of that request.

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the request referred to in Article 13(3) be filed with the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in Article 13(3)(iv) be filed with the Office within a time limit which shall be not less than one month from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.

(7) [*Time Limit Under Article 13(3)(iii)*] The time limit referred to in Article 13(3)(iii) shall expire two months before the expiration of the time limit prescribed in Rule 4(1).

[End of Annex and of document]

WIPO



PCT/R/WG/4/1 Add.1

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**WORKING GROUP ON REF ORM OF THE PATENT
COOPERATION TREATY (PCT)**

Fourth Session

Geneva, May 19 to 23, 2003

**APPLICATION OF THE CRITERIA OF "DUE CARE" AND "UNINTENTIONALITY"
UNDER NATIONAL PRACTICE IN CASES OF RESTORATION OF RIGHTS:**

REPLIES RECEIVED IN RESPONSE TO QUESTIONNAIRE

Document prepared by the International Bureau

BACKGROUND

1. At its third session, held in Geneva from November 18 to 22, 2002, the Working Group considered proposals for amendment of the Regulations under the PCT relating to the restoration of the right of priority. Noting that there was no general agreement in the Working Group as to which of the two criteria for restoration provided for in the PLT, namely, "due care" and "unintentionality," should apply under the PCT in the case of determinations by a receiving Office, it was agreed that the International Bureau should send a questionnaire to all PCT Offices and Authorities requesting information as to the application of such criteria under the various national laws and practices. As stated in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 20 and 27:

"20. Several delegations suggested that guidance should be provided in the context of the PCT as to the application of the two criteria, noting that no such guidance was provided in the context of the provisions concerning the matter in the PLT and that little information was available as to the present practices of the various Offices. One delegation suggested that it would be useful to conduct a survey of present practices by sending a questionnaire to all PCT Offices and Authorities. That survey should seek

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information as to the application of the criteria of “due care” and “unintentionality” in general, that is, not restricted to cases where restoration of the right of priority was sought, but also in cases, for example, of late payment of annuities, in order to obtain guidance as to the differences between the two criteria and to assist in the establishment of guidelines. The questionnaire should also seek information as to the proof required.

[...]

“27. It was also agreed that the International Bureau should send a questionnaire to all PCT Offices and Authorities requesting information as to the application of such criteria under the various national laws and practices.”

2. Revised proposals for the amendment of the Regulations, setting out different options for consideration by the Working Group, are contained in document PCT/R/WG/4/1.

3. By way of Circular C.PCT/887, dated December 19, 2002, the International Bureau sent a questionnaire concerning the application of the criteria of “due care” and “unintentionality” under the various national laws and practices to all national and regional Offices of or acting for a State party to the PCT. The Annex to this document contains the responses received by the date of this document.

4. *The Working Group is invited to take note of the content of the Annex.*

[Annex follows]

ANNEX

APPLICATION OF THE CRITERIA OF "DUE CARE" AND "UNINTENTIONALITY"
UNDER NATIONAL PRACTICE IN CASES OF RESTORATION OF RIGHTS:

REPLIES RECEIVED IN RESPONSE TO QUESTIONNAIRE

Question 1: Does the national law and/or practice applicable by your Office in cases of restoration of rights (that is, not restricted to cases where restoration of the right of priority is sought, and not restricted to the patent procedure) provide for the application of the criteria of "due care" and/or "unintentionality"? If so, in which context?

Response by Armenia: "The national law and practice applicable by your office does not provide for the application of the criteria of "due care" and/or "unintentionality".

Response by Australia: "The Australian Patents Act 1990 and the Patent Regulations contain provisions for extension of time under section 223 and regulation 22.11 (copies attached). These provisions effectively allow for a restoration of rights when a relevant act has not been done within time. These provisions allow the Commissioner of Patents to extend the time for doing an act where the failure to do the act was because of: (i) an error or omission by the person concerned or his or her agent or attorney (section 223(2)(a)); (ii) circumstances beyond the control of the person concerned (section 223(2)(b)); or (iii) despite the person concerned taking due care, as required in the circumstances, to ensure the doing of the act within that time, the relevant act is not done within time. (Section 223(2A)). Section 223(2A) was introduced in 2002 to bring the Patents Act into compliance with Article 12 of the PLT. In practice, there may be significant overlap between these three provisions. Because of the broad nature of (i), the majority of extensions are granted under this provision. Some guiding principles used include: -- the statutory provision to extend time is beneficial in nature, and should be applied beneficially; -- while the applicant has the burden of placing before the Commissioner the circumstances which it claims will justify the grant of an extension of time, this does not amount to a burden of proof and it is not appropriate that it should be so described; -- there must be a casual relationship or connection between the error or omission and the relevant act that is required to be done within the stipulated time. In addition, the applicants for an extension must demonstrate that they had an intention to do the relevant required act, and that an error or omission on their, or their agent's behalf, reasonably could be said to have caused the failure to complete the relevant act in the time prescribed. These provisions are available for almost any action that is required to be done within a certain time. Some exceptions where the provisions are not available are, for example, requests to file a first-in-time application, (as opposed to claiming priority); requests in respect of matters where the Commissioner has become *functus officio* (such as a request filed after grant to extend the time for filing a notice of opposition (for pre-grant opposition))."

Response by Austria: "The Austrian Patent Law applicable by the Austrian Patent Office in cases of restoration of rights provides for the application of the criterion of "due care". There are a limited number of cases where the restoration of rights is not possible. The most important ones are there in statement in the time limit for a petition for reinstatement and the reinstatement into the time limit under Article 4 of the Paris Convention. Section 129(2) of the Austrian Patent Law indicates all cases where restoration of rights is not possible".

Response by Belarus: “The national law and practice applicable by this office in cases of restoration of rights does not provide for the application of the criteria of “due care” and “unintentionality.”

Response by Belgium: “The Belgian law on patents of 28 March 1984, published in the *Moniteur Belge* issued on 9 March 1985, provides in Article 41 -1 the possibility for the patent applicant or patent owner to have his rights being restored if he has an “excuse légitime” for the non-payment of the annual fee on time. If the Office agrees to restore the right, such restoration is effective only after the rightholder has paid the annual fee within a time limit of one month from the date of the decision on the restoration of the right (Article 41 -2.2)). The Intellectual Property Office of Belgium considers that such provision does not fall within the scope of the criteria of “due care” and “unintentionality”. Besides, there is neither a provision in the Belgian law on patents nor in the practice before our Office providing for the use of such criteria. Therefore, the answer to the question is negative.”

Response by Bulgaria: “Restoration of rights may be requested only in cases when the delay in meeting of time limits occurs because of special unforeseen circumstances (Art. 49 BPL), that means in spite of all due care reasonably required by the circumstances.”

Response by Canada: “No, Canadian national law and/or Canadian Patent Office practice does not currently provide for the application of the criteria of “due care” and/or “unintentionality” in cases of restoration of rights.”

Response by China: “The Article 29 in our patent law is dealing with priority. There is no provision in our law dealing with the restoration of right of priority. There is a general provision in our regulation to deal with restoration of rights: Rule 7. Article 29: “Where, within twelve months from the date on which any applicant first filed in a foreign country an application for a patent for invention or utility model, or within six months from the date on which any applicant first filed in a foreign country an application for a patent for design, he or it files in China an application for a patent for the same subject matter, he or it may, in accordance with any agreement concluded between the said foreign country and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of the right of priority, enjoy a right of priority. Where, within twelve months from the date on which any applicant first filed in China an application for a patent for invention or utility model, he or it files with the Patent Administration Department Under the State Council an application for a patent for the same subject matter, he or it may enjoy a right of priority.” Rule 7: “Where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the Patent Administration Department under the State Council is not observed by a party concerned because of force majeure, resulting in loss of his or its rights, he or it may, within two months from the date on which the impediment is removed, at the latest within two years immediately following the expiration of that time limit, state the reasons, together with relevant supporting documents, and request the Patent Administration Department under the State Council to restore his or its rights. Where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the Patent Administration Department under the State Council is not observed by a party concerned because of any justified reason, resulting in loss of his or its rights, he or it may, within two months from the date of receipt of a notification from the Patent Administration Department under the State Council, state the reasons and request the Patent Administration Department under the State Council to restore his or its rights. Where the party concerned makes a request for an extension of a time limit specified by the Patent Administration Department under the State Council, he or it shall, before the time limit

expires, state the reasons to the Patent Administration Department under the State Council and go through the relevant formalities. The provisions of paragraphs one and two of this Rule shall not be applicable to the time limit referred to in Articles 24, 29, 42 and 62 of the Patent Law.”

Response by the Czech Republic: “The current Czech Patent Law No. 527/1990 Coll., as amended, contains provision regarding to the Excusing failure to comply with a time limit (Section 65, (1)): “The Office may excuse failure to comply with a time limit on legitimate grounds (*including “forcemajeure” circumstances*) if a party to the procedure so requests within two months of the day on which the reason for failure to comply has ceased to exist, provided that the omitted act has been performed within that period and that the administrative fee in accordance with the relevant statutory provisions has been paid.” The Czech practice under Section 65 is relatively generous towards the applicants and the owners. We have no problems with regard to the application of this criteria. The failure to comply with a time limit may be excused at the latest by one year as from the expiration of the period within which the act should have been performed.”

Response by Denmark: “We only apply the criteria of due care. We apply the criteria of due care in the context of non-observance of a time limit. We further apply the criteria on the entry into national phase. We do not have an instrument of restoration for re-establishment of priority right, but will have the instrument implemented in our national law within a few months.”

Response by Estonia: “There are no provisions in Estonian law concerning the restoration of the right of priority. Therefore the Republic of Estonia has also no practice in a forenamed matter. The provisions concerning the restoration of the right of priority will be included in our amended Patent Act which we expect to come into force in April 1, 2003.”

Response by the Eurasian Patent Office: “Yes, the Eurasian Patent Law provides for the application of the criteria of “due care” and “unintentionality” in cases of restoration of rights. According to new Rule 39 of the Patent Regulations under the Eurasian Patent Convention, which is in force as from 01 March, 2002, “rights relating to a Eurasian application or Eurasian patent which have lapsed as a result of the failure to respect the time limits prescribed for performing a particular procedural act may be restored on an appropriate request by the applicant or patent owner where the Eurasian Office considers that the failure to respect the time limit has occurred despite all the measures taken by the applicant or patent owner, which were suitable in the given circumstances, and that the delay was unintentional.” Those provisions are applicable for majority procedures under the Eurasian Patent Law excluding the following time limits: -- filing request for restoration of rights; -- claiming priority right; -- filing certified copy of a previous application; -- payment of the prescribed additional fee for a six-month period of grace for payment annual fee for maintenance of the Eurasian Patent; -- filing a notice of opposition under the administrative revocation of the Eurasian Patent.”

Response by the European Patent Office: “The EPC does not, in any of its regulations, refer to the criterion “unintentionality.” For *restitutio in integrum* (re-establishment of rights) under Article 122 EPC “all due care” is required.”

Response by Finland: “No, the office applies only the criteria of “due care.”

Response by France: “ The legal basis for restoration of rights in France is Articles L.512 -3 and R.512 -12 of the Code on Intellectual Property (CPI) for drawings and industrial designs, Articles L.712 -10 and R.712 -12 for trademarks, and Articles L.612- 16 (delay in meeting time limits), L.613 -22 (defect to payment of annual fee) and R.613 -52 for patents. Any right holder may apply for the restoration of rights in the event a time limit was not respected during the processing of the application at INPI. However, the restoration of the right of priority is currently not envisaged in French law (this will change after ratification of the PLT). While the wording of the different Articles on the restoration of rights is not homogenous, INPI and case law intend to apply identical substantive criteria for all IP rights. The restoration of rights in French law is subordinated to the proof of “impeachment” (“empêchement”) or “legitimate excuse” (“excuse légitime”), namely the rightholder must prove that the event which occurred is not due to his will, fault or negligence. The right holder applying for a “restitutio in integrum” must therefore demonstrate that the unfulfilment of the formality resulting on the loss of rights was not the result of his will but rather the result of circumstances which impeded him to accomplish the formality in spite of his due care (and some form of evidence must be submitted to the Office, such as a medical certificate, a letter between the rightholder and his agent etc.). French law applies therefore in a cumulative manner both criteria of due care and unintentionality. The criteria of unintentionality is not enough on its own.”

Response by Germany: “ Under German national law, applicable in procedures before the German Patent and Trade Mark Office, decisions on requests for reinstatement are based on the fault principle . The relevant provisions are contained in Sec. 123 Patent Law, Sec. 91 Trade Mark Law, Sec. 21 (1) Utility Model Law, referring to Sec. 123 Patent Law, and in Sec. 10 (6) Designs Law, referring to Sec. 123 (1) to (5) and (7) Patent Law. Fault encompasses all negligent and intentional acts or omissions. Negligence must be examined according to the criterion of due care. For example, pursuant to Sec. 276 (1), 2nd sentence, of the German Civil Code (*Bürgerliches Gesetzbuch*), a person acts negligently if he fails to observe the relevant required standards of care.”

Response by Hungary: “ The national law applicable by the Hungarian Patent Office in patent procedures and in other industrial property procedures provides for the criterion “without fault.” According to this criterion the request for restoration of rights must state the grounds of failure to comply with a time limit and the circumstances showing that the failure occurred without fault. In our view this criteria corresponds to the criterion “unintentionality.”

Response by India: “ As per our National law there is no provision for the restoration of right of priority. However, as a usual practice being followed in the Patent Office, India, under section 135 of the Patents Act, 1970, the restoration of priority is allowed if the same is made within 12 months from the date of filing of the basic application from which priority is claimed for the criteria “unintentionality” or “due care.”

Response by Indonesia: “ No, the national law and/or practice does not provide both criteria.”

Response by Israel: “ 1. Priority Right lost by failure to file application in priority period. 2. Priority Right lost by failure to file priority claim in time allowed. 3. Rights in international application lost by failure to enter national phase in time allowed. 4. Rights in application lost by failure to reply to Office Action and consequential refusal. 5. Rights in application lost by unauthorised withdrawal of application. 6. Patent Right lost by failure to renew patent in time.”

Response by Japan: “ There are some provisions in the Japanese patent law which contain the phrase “due to reasons outside control of the applicant or the owner of the right ” which is considered to be interpreted as similar to but deferent from “due care ” mentioned in your Question 1. Section 112 bis (1) of Patent Law (“ Restoration of patent right by late payment of annual fees”): “Where the patent right is one which was deemed to have been extinguished under Section 112 (4) or (5) or which was deemed never to have existed under Section 112 (6) and the owner of the extinguished patent right is unable to pay an annual fee and surcharge belatedly within the time limit for late payment under Section 112 (1) due to reasons outside his control, he may pay the annual fee and surcharge referred to in Section 112 (4) to (6) within 14 days (where he is a resident abroad, within two months) from the date on which the reasons ceased to be applicable but not later than six months following the expiration of the said time limit. ” (Ref. “Outline of Industrial Property Systems; JAPAN Patent Law ” <http://www.jpo.go.jp/index.htm>). Section 121 (2) of Patent Law (“ Trial against examiner’s decision of refusal”): “Where, due to reasons outside his control, a person is unable to demand a trial under the preceding subsection within the time limit prescribed therein, he may, notwithstanding that subsection, make the demand within 14 days (where he is a resident abroad, within two months) from the date when the reasons ceased to be applicable but not later than six months, following the expiration of the said time limit.” (Ref. “Outline of Industrial Property Systems; JAPAN Patent Law ” <http://www.jpo.go.jp/index.htm>). Section 173 (2) of Patent Law (“ Time limit for demand for retrial”): “Where, due to reasons outside his control, a person is unable to demand a retrial within the time limit prescribed in the preceding subsection, he may, notwithstanding that subsection, make the demand within 14 days (where he is a resident abroad, within two months) from the date when the reasons ceased to be applicable but not later than six months following the expiration of the said time limit.” (Ref. “Outline of Industrial Property Systems ; JAPAN Patent Law ” <http://www.jpo.go.jp/index.htm>). Section 4 of the Patent Law Enforcement Order (Section 67 bis (3) of Patent Law) (“ Registration of extension of term of patent right”): “ If the application could not be filed within 3 months following the rendered date of the disposition due to reason beyond control of the applicant, the application must be filed within 14 days (where he is a resident abroad, within 2 months) after the extinction of said reason (or within 9 months following the rendered date of the disposition, whichever period expires earlier).” (Ref. “Examination Information; Examination Guidelines for Patent and Utility Model in Japan; Part VI Patent Term Extension” <http://www.jpo.go.jp/index.htm>).”

Response by the Republic of Korea: “ Article 16 [Invalidation of Procedure]; (2) When a patent-related procedure has been invalidated under paragraph (1), if the delay of the time is deemed to have been caused by reasons not attributable to a person who received an invitation to amend, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may revoke a disposition of invalidation at the request of a person who received an invitation to amend within fourteen days from the date on which the reasons for the delay ceased to exist. However, this provision shall not apply where one year has elapsed after the designated period expires.” Article 17 [Subsequent Completion of Procedure]: “ If a person who initiated a patent -related procedure has failed to observe the time limit for requesting a retrial under Article 132 ter, or the time limit for demanding a retrial under Article 180 (1) for reasons not attributable to himself, he may subsequently complete the procedure that he failed to conduct within fourteen days after said reasons cease to exist. However, this provision shall not apply in a case where one year has elapsed after said period expires.” Article 81 bis [Recovery of a patent application or patent right by late payment of the patent fees]: “ (1) If a patentee or any person wishing to register a patent right has failed to observe the time limit for late payment of the patent fees under Article 8 (1) due to any cause

not attributable to himself, he may make late payments of the patent fees within fourteen days after said month has elapsed after said period expires under Article 81(1).”

Response by the Kyrgyz Republic: “The Kyrgyz Republic Law provides restoration of the right of priority and of patent procedure and determines different terms depending on particular cases. Particularly, term of restoration of the right of priority is two months since the date of missed term expiry. However, national law does not distinguish the criteria “due care” and “unintentionality” during restoration of applicant’s rights in general and restoration of the right of priority in particular.”

Response by Latvia: “Latvian Patent Law (as well as Trademark Law and Designs Law) does not contain such expressions as “due care” or “unintentionality.” Our Patent Law provides for a restoration of rights in cases when patent maintenance fee is not paid in due time or an applicant has not replied to some invitation of examiner or has not paid any procedural fee in due time. These provisions are Article 12(7) and 12(8) of the Patent Law: Art. 12(7): “...The annual maintenance fee must be paid before the beginning of the next year of payment. If the fee has not been paid within due time period, but the patent owner pays it, together with an additional fee, within the following six months, the patent shall be considered as maintained in force.” Art. 12(8): “The terms... may be renewed, if the request for the renewal has been received no later than six months after the expiration of the prescribed term and *there has been due cause for non-observance of the term*. An additional fee must be paid for...renewal of terms.” In practice it is sufficient if a patent owner or an applicant just gives some explanation of non-observance of the terms (for example, he/she has not received a letter from Patent Office, he/she has been in hospital, and the like).”

Response by Lithuania: “In practice of our Office, there were no cases for the application of these criteria.”

Response by Madagascar: “The expressions “due care” and “unintentionality” do not appear in the national legislation. However, the national legislation states that “any person who cannot respect legal time limits because of “*forcemajeure*” and who, as a result, loses a right related with a patent application or with a patent already granted may ask for the restoration of that right if evidence concerning the failure is furnished.” (Article 33.1 of Ordinance 89-019 of 31/07/89). “The request for restoration shall be submitted to the Office in written form within a time limit of two months after the end of the “*forcemajeure*”. The request shall be justified and it shall clearly and precisely mention the “*forcemajeure*” which impeded the respect of a time limit under this decree.” (Article 58.1 and 2 of Decree 92-993 of 02/12/92).”

Response by Moldova: “The Republic of Moldova legislation provides for the restoration of applicant/owner rights for every patent procedure (except for withdrawn applications), including for patent restoration in case of non-payment of the prescribed maintenance fee, within six months after the expiration of the failed time limit. This possibility of restoration is applied to every case without any restriction, regardless of the reason for the failure to comply with the time limit. After the expiration of this six month time limit, the national legislation provides the further reinstatement of rights for cases in which the loss of rights occurred in *forcemajeure* circumstances. Such provisions apply to: (a) every case of failure to comply with the time limit for a procedure in respect to an application; (b) in case of failure to comply with the time limit prescribed for payment of the maintenance fee; (c) in case of failure to claim a priority; (d) in case of failure to present a copy of the earlier application (where restoration of the right of priority is sought). As regards points (a) and (b), the

legislation provides the application of both criteria (“due care” and “unintentionality”), as for (c) and (d) - the criteria of “unintentionality.”

Response by Monaco: “ Monégasquelawno606onpatentsofinvention,datedJune20,1955, donotmentionthecriterionof“duecare”and“unintentionality”.Inpractice,theDivisionof IntellectualPropertyapplies the criteria of “legitimate excuse” (“excuse légitime”) in order to restore the rights of the owner, for instance in the case of a delay in the payment of annual fees.”

Response by Mongolia: “Yes”

Response by the Netherlands: “ThenationallawoftheNetherlandsprovidesonlyforthe criterionof“duecare,”butthecriterion“duecare”impliesthatthelossofrightwasnot intended.(Intentionallynotobservingatimelimitcanneverleadtorestorationinthe Netherlands). Article23,paragraph1ofthe PatentActoftheKingdom1995,states that restorationofrights is only possible if a timelimit is not observed “ *despitetakingallduecare requiredbythecircumstances* .”Art.23ofthePatentActoftheKingdom1995,first paragraphreads:“1.If, *despitetakingallduecare*requiredbythecircumstances,the applicantfororproprietorofapatentorthe proprietorofaEuropeanpatenthasnotbeen able to observe a timelimit with respect to the Office or the officer referred to in Article 99 [MvdB industrial property office in the Netherlands Antilles], he shall, at his request, have his rights re-established by the Office, if failure to observe the timelimit pursuant to this Act has directly led to the loss of any right or means of redress.” Most frequently, restoration is requested because a patent annuity was (unintentionally) not paid in time, leading to the loss of the patent.”

Response by New Zealand: “The criterion of “unintentionality” is provided for in sections 35(1), 36(1) and 37(3) of the New Zealand Patents Act 1953. Section 35 deals with the restoration of lapsed patents, section 36 deals with the restoration of applications for patents that have not been sealed and section 37 deals with the restoration of applications that have not been accepted. The criterion of “unintentionality” is also provided for in our informal process for allowing late entry into national phase. This process is outlined in The Intellectual Property Office of New Zealand Information for Clients No. 8 issue dated 29 September 1999. The Trade Marks Act, 1953 and Designs Act, 1953 do not contain the criteria of “due care” and/or “unintentionality”. The criterion of “due care” is not provided for in the New Zealand Patents Act 1953. However, the criterion of “ *due diligence and prudence*” is present in section 93. This section allows the Commissioner of Patents to extend the time for filing a convention application or complete after provisional application provided the applicant has shown *due diligence and prudence* in their attempt to have the application filed on time.”

Response by Norway: “With the exception of time limits for right of priority and the appeal procedure, the applicant for a patent who has failed to comply with a time limit prescribed in or pursuant to the Patent Act and who thereby has suffered loss of rights shall, upon request, have his rights restored if he can prove that he or his representative has taken *allduecare* which may reasonably be required. This provision applies correspondingly *to* a patent holder who has not paid the annual fee within the prescribed time limit.”

Response by the Philippines: “Pertinent Philippine laws and regulations do not categorically provide for the criteria of “due care” in case of restoration of rights relating to national patent applications. On the other hand, the term “unintentional” is mentioned in Rule 306.4 of the Rules and Regulations on Inventions, wherein a priority claim may be submitted even after

the filing of the application provided that it is accompanied by a declaration of the applicant that the delay in the submission was not intentional. Further, in practice, an application that is deemed abandoned and withdrawn may be revived if the reason for failure to prosecute on time is due to fraud, accident, mistake or excusable negligence (Rule 930 Rules and Regulations on Inventions).”

Response by Poland: “The new Industrial Property Law (in force since August 22, 2001) provides for two categories of cases of restoration of rights: (a) relief in respect of non-restorable time limits fixed by the statute itself, and (b) relief in respect of time limits fixed by the Patent Office in the course of protection granting proceedings. In respect of non-restorable time limits, the Law provides that in case of failure to observe the time limit, the respective right may be restored provided that relevant proof is furnished by the interested party in evidence that non-observance of the time limit concerned has been caused by an act of God (force majeure). This rule is applicable in particular in respect of the following rights: - for furnishing the original copy of the patent application transmitted by means of fax, which is required for preserving the priority right; - for submitting a request for the extension of the trademark registration for subsequent ten-year periods; - for the payment of the renewal fee for a subsequent protection period; - for submitting a request for restoration of the time limit for payment of the fee concerned. In this category of cases the criterion of “due care” prevails in practice. In respect of time limits fixed by the Patent Office in the course of protection granting proceedings, the respective rights are restorable in case of non-observance of the relevant time-limit, provided that a party provides a plausible explanation that non-observance has been without fault on its part. Although the applied criterion is not expressly named in the above presented provisions of the Polish IPL Law, the criterion that prevails in practice is close to “due care,” rather than to “unintentionality.”

Response by Portugal: “At the moment, the Portuguese law has only restoration of rights for late payment of annuities (article 281 -2). As from 1st July 2003 the new Portuguese law provides the restoration of rights (article 8) with the application of the criteria of “due care.” This provision doesn’t comprise the restoration of the right of priority.”

Response by the Russian Federation: “Our patent law in cases of restoration of rights provides for the application of the criteria of “reasons beyond the applicant’s control” (article 19(2)) and “valid (justifiable) reasons for the delay” (article 21(12)) which are similar to “due care” and “unintentionality” respectively. “For reasons beyond the applicant’s control” - where the applicant claiming Convention priority cannot for reasons beyond the applicant’s control, be filed within 12 months from the filing date of the prior application, the time limit may be extended. “Valid reasons for the delay” - is applied in many cases, for example, for the restoration of rights where the applicant has failed to furnish the additional materials required by the examiner, within the prescribed time limit.”

Response by Saint Lucia: “We are presently in the process of completing our Patents Regulations. We therefore have not had any experience in the area in question.”

Response by Singapore: “1a. Under our Patents Act and Rules for example, provision on restoration of patent rights are available. 1b. Although the criteria is not “due care”, the term “reasonable care” is applied for restoration of lapsed patent cases. 1c. Please find attached, an extract from our Patents Act and Rules containing our restoration provisions [Section 39, Rules 53 & 53A] and those on extensions of time provisions [Section 110, Rules 100, 108 & 109]. 1d. It would be noted that under our restoration provisions, rule 53A only has an “unintentional” requirement. Rule 53A applies only to a restricted number of cases, which

fell under our transitional provisions when we introduced the revised patents system in 1995. I.e. On extensions of time, there are varying levels of consideration. In general practice, one could say that the “unintentional” test applies, that is to say, the delay or omission was not deliberate. -- The first group of time periods is not extendible. [Rule 108(2)]. -- In the second group of time periods, extensions of time are sought in writing without use of a form or payment of fees. The decision to extend time in this group is discretionary. [Rule 108(1)]. -- The third group of time periods are extendible if extensions have not been granted previously, and that the request for extensions is made within the period for which extension is sought and that extensions sought does not exceed 3 months. Such extensions are granted as soon as the relevant forms and fees are paid. [Rule 108(3)]. -- The fourth group of time periods is related to the time periods mentioned in the third group. The fourth group applies when the conditions in the third group are not met. In such cases, the Registrar may ask the Applicants would to furnish a statutory declaration or affidavit to support this extension request, over and above the filing of the form and fees. The decision to extend time in this group is discretionary. [Rule 108(4) to (6)].”

Response by the Slovak Republic : “The Industrial Property Office of the Slovak Republic, in cases of restoration of the right of priority, applies only criteria “due care”. Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts (The Patent Law) explains application of the criteria “due care” in Article 36, paragraph 5.”

Response by Slovenia: “The criterion of “due care” is used in Article 68 of Industrial Property Act (Official Gazette RS, No. 45/01 and 96/02), hereinafter referred to as IPA on restitution in integrum. Paragraph (1) states that a party to the proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to observe any time limit set out for the obligations required by the Office in accordance with IPA and the executive regulations issued pursuant to IPA, may request, on the basis of justifiable reasons, to have his rights re-established if then non-observance had the consequence of causing the deeming of the application, or of any request, to have been withdrawn, or the rejection or refusal, or the loss of the right. The provisions of this Article follow the provisions of Article 122 of the European Patent Convention”.

Response by Spain: “Article 25 of the Law 17/2001, December, 7, on Trademarks, provides only for the application of the DUECARE criteria. This Article is also applicable to patents. Nevertheless, the right of priority is excluded of restoration of rights.”

Response by Sweden: “Yes, only due care. All due care required by the circumstances has to be observed by the patent holder or the applicant and by the agents involved.”

Response by Turkey : “Partially Yes, our national law provides non-payment of the yearly annuities for reasons of Force Majeure for the reinstatement of the rights under Article 134. “Article 134: Where a patent right terminates for non-payment of yearly annuities; with the holder of the patent bringing evidence of force majeure for reasons of which the said fee could not be paid, the patent shall be revalidated. The claim related to force majeure shall be put forward within six months as from the publication, in the bulletin, of the announcement pertaining to the termination of the patent right. The patentee’s claim related to force majeure is published in the bulletin. The parties interested may express their observations on the matter within one month as from the date of publication. The patent shall be revalidated upon the decision of the Institute. The revalidation of a patent shall not affect the acquired rights of third parties who have secured such rights as a result of the termination of the patent right. The rights of third parties and the scope of such rights shall be determined by the court.

Where a patent is revalidated, the holder of the patent shall be obliged to pay the fees he failed to pay and the additional fees.”

Response by the United Kingdom: “We do not apply the criteria of “due care” though we do apply the criteria of “reasonable care” in the cases of applications to restore patents which have ceased because of a failure to pay a renewal fee. Section 28(3) of the Patents Act 1977 provides: “If the comptroller is satisfied that the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.” We have no specific provisions in our law which provides for the restoration of a patent application. However, rule 110(4) of the Patents Rules 1995 allows the Comptroller to extend certain times or periods prescribed in our patents rules for doing an act or taking any proceedings. Where an application has been treated as withdrawn because of a failure to meet such a time or period, and the Comptroller agrees to extend that time or period, the application will be reinstated provided the applicant completes the required action within the time or period so extended. Rule 110(4) allows the Comptroller to extend a time or period if she “thinks fit.” Therefore she has wide discretion to apply whatever criteria she wishes. In practice, when assessing extension requests under the rule it has been our policy to allow such requests if we are satisfied that the applicant had a “continuing underlying intention” to proceed with the application. This principle is based on precedent established in an Office decision on an earlier extension request and is similar to the criteria of “unintentionality.”

Response by the United States of America: “Yes. The national law and practice of the United States provides for the application of the criteria of “due care” and/or “unintentionality” in certain cases involving restoration of rights. U.S. statutory law expressly provides for the application of the criterion “unintentionality” with regard to the restoration of rights involving: A. *patent applications* that have become abandoned for failure to timely submit: 1) a proper reply to an outstanding Office action or notice (35 U.S.C. 41(a)(7)); 2) payment of the issue or publication fee (35 U.S.C. 41(a)(7)); 3) notification of a filing in a foreign country or under a multilateral international agreement subsequent to the submission of a non-publication request (35 U.S.C. 122(b)(2)(B)(iii)). B. *patents* that have expired for failure to timely pay the maintenance fee (35 U.S.C. 41(c)(1)). C. *reexamination proceedings* that were terminated for failure to timely file a proper response (35 U.S.C. 41(a)(9)). U.S. statutes also provide for restoration of rights caused by “unavoidable delay” in the cases identified above (with the exception of the failure to timely submit the notifications specified in A.3). 35 U.S.C. 41(c)(1), 133 and 151. Though the criterion of “due care” is not expressly identified in these statutes, a consideration of “due care” is relevant to the determination of whether a delay was “unavoidable” within the meaning of the statutes, as further explained in the Response to Question 2.”

Question 2: (only applicable if the answer to question 1 is “yes”): What does “due care” and/or “unintentionality” mean under the national law and/or practice applicable by your Office?

Response by Australia: “Section 223(2)(a) (“error or omission”) perhaps equates closest to “unintentionality” whereas section 223(2)(b) (“circumstances beyond the control of the person concerned”) and section 223(2A) (“due care”) possibly equate to “due care”. Deliberation or mistake in judgment fall within the scope of 223. An error or omission may

include a breakdown in procedure or a failure to exercise due diligence. Delays by post and courier constitute the major source of extensions under section 223(2)(b) (“circumstances beyond the control of the person concerned”). In some situations sickness or accidents satisfy the requirement of this paragraph, e.g. if an applicant prosecuting his or her own case becomes ill, the probability is that he or she would be entitled to an extension. On the other hand, if a technical assistant to a firm of Attorneys missed a time limit owing to an illness, it would be expected that the firm would have made arrangements accordingly, in anticipation of this kind of occurrence. If not, it would appear that where an error or omission might be involved, circumstances beyond control would not. In effect, section 223(2)(b) is a “*force majeure*” provision. A “*force majeure*” is outside the control of the person concerned and something that could not have been avoided by that person’s exercise of due care. A particular issue here is the effect of Bankruptcy. A sequestration order is made as the culmination of a sequence of events which the applicant could have avoided with the exercise of due care – consequently becoming bankrupt is not a circumstance beyond control within the meaning of section 223. Subsection 223(2A) (“due care”) brings the Patents Act into compliance with Article 12 of the PLT. This subsection provides that where, despite the due care of the person concerned, a relevant act is not done within time, and the person files an application for an extension of time within the prescribed period, the Commissioner must extend the time for doing the act. Unlike subsections 223(2)(a) or 2(b), there is no discretionary power to be exercised. Also the time for doing a relevant act can only be extended under subsection 223(2A) after the time period has expired. Subsection 223(2A) is only applicable in limited circumstances. It is of narrower scope than the provisions of subsection 223(2)(a). Extensions of time under subsection 223(2A) would only arise where the person concerned had appropriate systems in place and did everything that could reasonably be expected to ensure the relevant act was done and despite that, a relevant act was not done in time. A reasonable enquiry is whether the systems or mechanisms put in place were appropriate to ensure the relevant act was performed in time. If the person concerned did not have adequate systems in place or had not done everything reasonably possible to ensure the relevant act was done in time, an extension under section 223(2A) would not be appropriate. To date, there have been no applications for extensions under section 223(2A), and no judicial interpretation of the meaning of “due care” in this provision.”

Response by Austria: “Due care means that a person is prevented by an unforeseeable or unavoidable event from observing a time limit.”

Response by Bulgaria: “Under the national law and practice the Patent Office reinstates the rights of the applicant if he was unable to observe the time limit in spite of all due care reasonably required by the circumstances that were unforeseen and accidental. These circumstances have to be an obstacle that could be not foreseen by the applicant.”

Response by Denmark: “Due care: The non-observance of a time limit vis-à-vis the Patent Authority prescribed by or provided for in our law, that causes a loss of right to an applicant who has taken all due care reasonably required. The claim for restoration can normally only be accepted when it is well documented that full reliable office routines are set in place and these routines are being handled by qualified staff and a double checking system are set in place. Then non-observance of a time limit is caused by a human mistake in spite of the system set in place.”

Response by the Eurasian Patent Office: “In view of deficiency of practice for application of the two criteria the EAPO exercise “healthy commonsense” in determination whether or not the required care has been exercised and non-observance of a time limit was unintentional.

Now, in any case at filing request for restoration of right by the applicant, the EAPO requires to submit a proof that non-observance of a time limit was caused in spite of all measures taken by the applicant and/or indicate a cause of non-observance of a time limit in the case of application of criteria “unintentionality”. Where the EAPO finds that all measures taken by the applicant took place actually and/or the cause of non-observance of the time limit was not dependant on the applicant, the rights will be restored.”

Response by the European Patent Office: “it is believed that there is no difference between “due care” “all due care”. No definition of the criterion “all due care” is provided in the European Patent Convention or its Implementing Regulations. It follows that the interpretation of its criterion is based on board of appeal case law. The case law has established that all due care is considered to have been taken if non-compliance with the time limit results either from exceptional and unforeseen circumstances or from an isolated mistake within a normally satisfactory monitoring system. A mistake of law, particularly one regarding the provisions on notification and calculation of time limits, does not, as a general rule, constitute grounds for establishment of rights.”

Response by France: “ Unintentionality: The procedure of restoration of rights should not be considered as a right of repentance for the rightholder who intended to abandon his right and to recover it after the end of the required time limit. The unfulfilment of a formality within the required time limit by a rightholder resulting in the loss of his right cannot benefit from the procedure of restoration of rights when such an action was made on purpose. For instance, a firm holding a patent and assisted by a patent agent decides not to pay its annual fee because it cannot exploit that patent. That firm will not be in a position to apply for the restoration of its right because it could find a licensee after the end of the time limit for payment of the annual fee. The Office would always examine all elements of evidence submitted to it in order to turn down any possible unintentionality. When the Office is convinced that the rightholder did not want to abandon his right, it will then examine if he acted in due care so as to impede the loss of the right. Due care: The statement over the circumstances which resulted with the unaccomplishment of the time limit must prove that the rightholder has taken all necessary steps to rightly manage his right: --if the rightholder asks another person to manage his right, such a person should be a professional (patent agent, lawyer, industrial property unit of a firm) and the rightholder must have given that person the ability to properly fulfil his duties. The Office requires then some evidence concerning the profession of the person in charge of managing the right and who is alleged to be responsible for the default. That person should be able to present his comments on the matter. A default committed by an agent who is not professional or by an agent working for the rightholder when this one is a firm could not be considered by the Office as “excuse légitime” if there is not also proven that the said person had some competence in the field of industrial property. On the other hand, the Office could consider as an “excuse légitime” the fact that a patent agent committed a default when carrying on his tasks on the ground of internal reorganization. --if the rightholder manages himself her/his right, the Office would examine the particular circumstances of the case and would dismiss any evidence of undue care. For instance, the inventor who manages his right alone could invoke her/his health problems (submission of a medical or hospital certificate required) as an “excuse légitime.” On the contrary, the Office would dismiss the restoration of the right if the rightholder says she was on holidays or that she did not know about the time limit for payment of the annual fee. ”

Response by Germany: “The standard applied to the due care requirement is the customary diligence which a prudent party to the procedure would have exercised in the concrete individual case. In this context, the following must be considered: -- The nature of the

defaulting party (The degree of strictness of requirements depends on whether the party is an individual applicant, the patent department of a big company or an attorney. The degree of diligence required is based on the diligence that may objectively be expected from a comparable prudent person in the individual case.) -- All circumstances of the case. In this connection, the fault principle applies (as explained in respect of question 1). This means that the defaulting party must prove that the non-observance of the time limit occurred despite exercise of due care.”

Response by Hungary: “The Hungarian national law does not define the criterion “without fault,” so it depends on the discretion of the Office to judge in the particular case whether the failure occurred without fault. The criterion “without fault” means under the practice of the Hungarian Patent Office that if the grounds and circumstances stated in the request for restoration of rights are made likely and provided that these are considered to be justifiable, the request is admissible.”

Response by India: “There is no specific provision. Applicant is required to prove that he has taken “due care” and the omission is unintentional.”

Response by Israel: “The above terms as such do not appear in the Israel Patent Law. Each procedure for restoration of rights has its own criteria defined by law or practice (see Q.4 below).”

Response by Japan: “While the Japanese industrial property laws do not provide for either of those criteria as explained above, under them, the criterion of “reasons outside control of the applicant or the owner of the right” has been interpreted as follows. (a) Objective reasons such as natural disasters (e.g.: damage on a house/building due to a big earthquake, flood, heavy snow, or destructive storm; disconnected communication lines; and block on transportation). (b) The prescribed procedure was not carried out in spite of the due care provided by the party concerned who has a normal level of alertness (e.g. serious diseases; destruction of documents by fire; and unexpected errors in the mailing service).”

Response by the Republic of Korea: “The KIPO does not use the same terminology as “due care” or “unintentionality” to recover a patent right or a patent procedure. However, I think that the KIPO also applies a similar principle with “due care” as shown at Question 1 in cases of restoration of any patent-related procedure or rights. It will be set forth at Question 4 in detail.”

Response by the Republic of Moldova: “The national legislation allows the possibility of restoration of the rights in *force majeure* situations as from August 2001, after the ratification by the Republic of Moldova of the PLT. For the time being, the legislation does not define the criteria of “due care” and “unintentionality,” each case being examined and treated individually.”

Response by Monaco: “The term “legitimate excuse” means any serious impeachment, independent from the will of the patent owner, which impeded that owner to proceed with the required formalities (“force majeure”, legal, financial or administrative obstacles, mistake by the agent, etc.).”

Response by Mongolia: “The criteria “due care” is used in accordance with Article 26(4) of the Patent Law of Mongolia.”

Response by the Netherlands: “Due care” or more specific “despite taking all due care required by the circumstances” means that: --the patentee, or third persons deployed by him, keeps his own administration of time limits which have to be respected; --within this administration, time limits have to be cross-checked independently. This cross-check must be built in the administrative system, because even well-educated, properly trained and accurately working personnel/staff can sometimes make a mistake; --the letters of the Office, reminding that a time limit is due, are legally treated as a non-binding, free service. It is not considered a valid argument if the patentee claims that the reminder of the Office did not reach him. These letters are sent by regular mail, so it is not 100% guaranteed that the letter arrives at the address of the patentee.”

Response by New Zealand: “Unintentionality not done or made or performed with purpose or intent. Due diligence and prudence –rightful, earnest and constant effort and caution with regard to practical matters.”

Response by Norway: “The interpretation of the conception “due care” is rather strict regarding the attention shown by the applicant and/or his representative.”

Response by the Philippines: “Since the rule does not define “unintentionality”, the same must be taken in its ordinary context. Hence, it contemplates that the delay is not willful or deliberate. The criteria of fraud, accident or excusable negligence under Rule 930 may be used to determine whether or not the delay is unintentional.”

Response by Poland: “Due care” means that in case of failure to observe a time limit the applicant is expected to show his not being at fault or that he has not acted negligently. In case of non-restorable time limits the applicant is supposed to produce evidence that non-observance of the time limit was caused by exceptional occurrences, which were unpredictable and unavoidable in the circumstances, and incapable of being remedied with any available means. In case of restorable time limits the applicant is not expected to provide any evidence showing his not being at fault, but only to make plausible the occurrence of the factors or circumstances that prevented him from observing the time limit. “Unintentionality” does not involve any need for the applicant to produce evidence or make the facts plausible. What suffices is his statement of his inability to observe the time limit.”

Response by the Russian Federation: “for reasons beyond the applicant’s control:” - emergency, force majeure - natural disasters, hostilities, irregularities in the mail service etc. “valid reasons for the delay:” - various reasons such as an applicant’s disease, his business trip, loss of the documents, deficiency in the work of technical service etc.”

Response by Singapore: “2a. These terms “due care,” “reasonable care” and/or “unintentionality” are not specifically defined in our Patents Act and Rules. However, since the UK Patents Act also contains a similar requirement in its restoration provisions [UK Section 28], the law and practice in UK on the term “reasonable care,” would be persuasive but they are not binding. 2b. On “unintentionality,” one would refer to the ordinary meaning of the word in the absence of any express statutory definitions or precedents, i.e. not deliberate.”

Response by the Slovak Republic: “Under the national law the term “due care” means such action of the applicant whom (in spite of his effort) the impartial facts (such as illness, irregularities in the mail service, failure of electronic means and soon) avoided perform the act with the Office in prescribed time limit.”

Response by Slovenia: “The criterion of “due care” is considered in the light of each individual case of non-compliance with the time limit, taking into account specific circumstances of the case. A general definition of that term would be “an appropriate care that should be taken under circumstances of the case by a person who is on average reasonably capable applicant/owner or professional representative.”

Response by Spain: “ ‘Due care’ means that the applicant or the owner must act with the reasonable vigilance under the circumstances, and this is something that must be proved accurately.”

Response by Sweden: “All due care has been observed if the responsible person has made arrangements in good time to perform the omitted act at the Patent Office within the prescribed time limit. However, an unexpected event has prevented him from performing this act in time. An example of such an event is a sudden illness. An isolated mistake by a person at a patent agency with a well-functioning system can be accepted if this person is carefully trained and supervised by the agent.”

Response by the United Kingdom: “ *Reasonable Care* ” – This term is not defined in our patents legislation (i.e. The Patents Act 1977 and The Patents Rules 1995). In determining whether a patentee has taken reasonable care, the Office looks to key principles and precedents set in decisions on past cases, particularly decisions by the Patents Court on appeals against Office decisions, such decisions being binding on us. The following is a summary of the key precedents we rely on. (a) The words “reasonable care” do not need explanation. The standard is that required of the particular patentee acting reasonably in ensuring that the fee is paid. (b) A patent is a valuable item of property and a proprietor is, therefore, expected to set up a payments system which contains more safeguards than would be needed to ensure the payment of an ordinary commercial debt. (c) In delegating responsibility to an employee to pay renewal fees, a proprietor must ensure that that employee is properly trained and issued with clear instructions. Where a competent, experienced and reliable employee fails to pay a renewal fee the proprietor should not be held to have failed to have taken reasonable care. However, it has been held that a failure by a senior employee (the “directing mind”), with overall responsibility for maintaining patents in force, would constitute a failure to take reasonable care. (d) If a patentee places responsibility for paying renewal fees in the hands of a professional body such as a patent agency or an annuity paying agency, an error by that body, which resulted in a renewal fee not being paid, would not constitute a failure by the proprietor to take reasonable care, provided the proprietor did not contribute to the failure. (e) If a proprietor fails to receive a renewal reminder from his agent or this Office because he did not provide the agent or this Office with an up-to-date address then that would constitute a failure to take reasonable care on the part of the proprietor. (f) Where a proprietor is prevented from paying a renewal fee because of ill health then he would not be regarded as failing to take reasonable care though severe mental strain or being physically run down would not be a sufficient basis for allowing restoration. (g) If a proprietor took a conscious decision to abandon a patent and then changed his mind after it had ceased it would not be possible to claim that he took reasonable care to pay the renewal fee. (h) Lack of funds to pay a renewal fee would not necessarily preclude restoration so long as the proprietor could demonstrate that he intended to pay the fee, attempted to avoid impecuniosity, made diligent efforts to obtain financial assistance and was prevented from paying due to circumstances beyond his control. “ *Continuing Underlying Intention* ” – The precedent case, referred to above, is *Heatex Group Ltd’s Application*. A copy of the decision issued on that case is attached. Unlike decisions of the Courts, the views expressed by the Hearing Officer are not binding on the Office. Nevertheless, the Hearing Officer’s comment

that for discretion to be exercised in the applicant's favour there must have been a "continuing underlying intention" to proceed with his application is considered a forceful principle which has been applied in subsequent cases when determining whether to allow extension requests. In his decision the Hearing officer held that to allow an extension on the basis of a change of mind by the applicant would be a massive assault on public certainty which should be resisted. Moreover, if extensions were allowed, where there had been a change of mind, it would not be clear when it would be appropriate to exercise discretion against an applicant."

Response by the United States of America: "I. "unintentionality" "Unintentionality" is a criterion applied pursuant to U.S. statutes in determining whether the delay in submitting a required submission that resulted in abandonment of a patent application, expiration or lapse of a patent, or termination of a reexamination proceeding will be excused and rights restored. Delay resulting from a deliberately chosen course of action on the part of the applicant or patent owner is not an "unintentional" delay within the meaning of the statutes. See MPEP 711.03(c). Where, for example, an applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional." See *In re Application of G.*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). Moreover, an intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988). Additionally, the entire delay must be unintentional. This requires not only that the delay in submitting the required submission that resulted in the abandonment, lapse or termination was unintentional, but also that the delay in filing the initial petition to restore the patent rights was unintentional and that any delay in filing a grantable petition was unintentional. See MPEP 711.03(C). II. "Due care". As indicated in the Response to question 1, "due care" is not an express requirement of U.S. statutes dealing with restoration of rights, but it is considered under U.S. national law and practice in determining whether a delay in submitting a required reply was "unavoidable" within the meaning of the statutes. The criterion of "due care" is also set forth in a U.S. regulation concerning acceptance of a late payment of the maintenance fee. (37 CFR 1.378(b)(3) requires, inter alia, "a showing that the delay was unavoidable since *reasonable care* was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patente e was notified of, or otherwise became aware of, the expiration of the patent."). U.S. courts have adopted the "reasonably prudent person" standard in determining if a delay in submitting the required reply was unavoidable: *The word unavoidable.... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.* *In re Mattullath*, 38 App. D.C. 497, 514 -15 (1912) "Due care" is generally defined as "that care which an ordinary prudent person would have exercised under the same or similar circumstances". See *Black's Law Dictionary*, 6th Ed., 1990. In the light of *Mattullath*, "due care", for the purposes of establishing "unavoidable" delay under restorative patent statutes, means that degree of care that is generally used and observed by prudent and careful persons in relation to their most important business. Thus for example, a delay resulting from

an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of “unavoidable” delay, provided it is shown that (A) the error was the cause of the delay; (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (C) the employee was sufficiently trained and experienced with regard to the function and a routine for its performance that reliance upon such employee represented the exercise of due care. See In re Egbers, 6 USPQ2d 1869, 1872 (Comm’r Pat 1988), *rev’d on other grounds subnom.*, Theodor Groz & Sohne & Emst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm’r Pat. 1988). Or, for example, where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, incorrect address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of “unavoidable” delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address, and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. See MPEP 711.03(c). Delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the MPEP, does not constitute “unavoidable” delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm’r Pat. 130, 131 (1891).

Question 3: (only applicable if the answer to question 1 is “yes”): If both criteria are being applied under the national law and/or practice applicable by your Office, what are the differences between the two criteria?

Response by Australia: “There is some overlap between the various provisions for extension of time. However, in many cases the circumstances fit one criterion and not the others. The “error or omission” or “unintentionality” criteria basically allow for an extension of time where there has been an error or omission affecting the carrying out of the parties’ intentions. An error or omission includes a breakdown in procedure or a failure to exercise due diligence. For example, a party may have a diary or watching system in place to monitor due dates. That system may be inadequate or flawed, resulting in a failure to perform an action in the required time. An extension would be allowable as the result of an error or omission arising from the inadequate system, but the party could not be said to have exercised due care in implementing or using such a system. Similarly, it would not be circumstances beyond the person’s control. The “error or omission” provisions also allow for extensions where there has been a failure to perform an act within time due to a lack of knowledge or unfamiliarity with the system. For example, infrequent users of the system may have the intention of doing the act but do not realise it has to be done within a certain time. Similarly, errors may arise where other countries have different provisions for doing an act. For example, under Australian law in relation to micro-organism deposits, the specification must include the name of the depository and accession number before the specification becomes open to public inspection. This is different to some other jurisdictions which sometimes result in errors. These errors are unlikely to satisfy the requirements for “circumstances beyond control” or “due care”, but may be grounds for an extension under “error or omission”. Sometimes, the circumstances leading to the original failure to do something may satisfy either the “error or omission” provisions or the “circumstances beyond control” or “due care” provisions.

However, where due care is exercised it would be expected that the problem would be discovered and remedied soon rather than later. Therefore, while either provision would lead to an extension being granted, the length of the extension allowable may be different depending on the provisions. The provisions of “circumstances beyond control” (section 223(2)(b)) and “due care” (section 223(2A)), although having significant overlap, also include significant differences. The “due care” provisions include time limits within which the extension must be applied for and limits on the length of the extension. The “due care” provisions may be used to extend time only after the time has expired, whereas the time may be extended either before or after the time has expired for the other provisions. Further, where the requirements for an extension under “due care” have been satisfied, an extension is mandatory, whereas under “error or omission” or “circumstances beyond control”, the Commissioner retains a discretion to grant an extension. Such a discretion would generally only be exercised adversely to the person if they had not taken steps to rectify the problem in a reasonable time frame, had not acted in good faith or some other public interest outweighed the reasons for granting the extension. In balancing the factors involved when exercising a discretion, the Commissioner proceeds on the basis that it is more important to consider the consequences of extending or refusing to extend time than to debate the reasons why the act was not done in time.”

Response by the Eurasian Patent Office: “The EAPO applies the two criteria. The differences between the criteria consist in the following: “*due care*” – In this case the applicant should submit a proof that he exercised all due care for observance of a time limit. For example, rights will be restored where error was caused by procedural mistake within a normally operated administrative system. “*unintentionality*” – The applicant should indicate a cause of non-observance of a time limit and the cause should not depend on the applicant. For example, irregularities in the mail service.”

Response by France: “Both criteria are cumulative in the French procedure for restoration of rights. The rightholder who had the will to keep his rights but who has not shown that he was vigilant enough will not obtain the restoration of his rights (e.g. the trademark owner who asked another person to do the renewal of the annual fee on his behalf will not be able to ask for the restoration of his rights on the sole ground that the person made a mistake or forgot about it). The lack of intentionality will not be enough.”

Response by India: “Due care should prove that the applicant has taken all possible care to claim priority and unintentionality should establish that without the priority claim the applicant will suffer hardship.”

Response by Israel: “The answers are numbered according to the answers to Question 1.
 1. Applicant must convince the Commissioner that the failure to file the application in time was due to circumstances which were beyond the control of the applicant or his agent, or were unpreventable (Law).
 2. Applicant must convince the Commissioner that the failure to file the priority claim in time was due to a bona fide mistake (Law).
 3. Applicant must convince the Commissioner that the failure to enter the national phase in time was due to circumstances that were beyond the control of the applicant or his agent, or were unpreventable (Practice based on law under item 1).
 4. Applicant must show that he did not intend to withdraw or abandon the application and that there was good reason for the failure to reply. (Practice).
 5. Applicant must show that the withdrawal was made illegally, e.g. without authorization. (Law).
 6. Applicant must convince the Commissioner that there was a reasonable cause for the failure to renew in time, that the applicant did not intend that the patents should lapse and that the application for restoration was made as soon as possible after the non-renewal was

discovered (Law). Items 1-3 are close to the criteria of “due care”, and the Commissioner may apply his discretion to interpret the law accordingly. Items 4-6 are close to “unintentionality.”

Response by the Republic of Moldova: “As the clear definitions of both criteria are not given in our legislation, the strict rules of application of one or other criteria do not exist too. However, the practices show that the principle “unintentionality” can be treated as having a larger meaning and can be more easily applied. In future we intend to confine to the criterion of “unintentionality,” because in this case the applicant/owners shall only provide evidence certifying the *forcemajeure* situation, while in case of application of “due care” criterion, it would be necessary to provide documents in support of the action taken by the applicant/owner to remove the reason of failure to comply with the time limit.”

Response by the Netherlands: “The criterion “unintentionally” is not used in the Netherlands. Therefore, the question does not apply to the situation in the Netherlands, although, “due care” implies that the loss of right was “unintentionally”.

Response by New Zealand: “Unintentionality describes the intent or lack thereof of the person concerned to perform a specific task. The intent of the person to perform the required action in the action under consideration, rather than the quality or manner in which the task itself was carried out. Due diligence and prudence on the other hand is a direct reference to the manner in which a task was carried out, and can be determined by consideration of the actions of the concerned party.”

Response by Norway: “In accordance with the Norwegian Patent Act, the possibility of restoration of right is restricted to cases of exceeded time limits in spite of all due care taken.”

Response by the Russian Federation: “For reasons beyond the applicant’s control” is applied only to cases mentioned in question 1 (convention priority). The office can demand a documentary evidence of such reasons; no fee is required. “Valid reasons for the delay” is applied in many cases; no documentary evidence is required, the applicants should pay a prescribed fee.”

Response by Singapore: “3a. One could consider the term “reasonable care” to require a higher degree of care to be taken as opposed to the term “unintentional” which requires a lower degree of care. 3b. On “unintentionality”, one needs only to show that the delay or omission to meet the deadline was not a deliberate act.”

Response by the United Kingdom: “The differences between the two criteria should be apparent from the answer to question 2. The standard of “reasonable care” is a stricter test than “continuing underlying intention.” This can be illustrated by taking the example where an applicant relies on reminders from his agent to pay patent renewal fees but fails to inform his agent of a change of address. As a consequence he does not receive the reminders and the fee remains unpaid and the patent lapses. In applying the criteria of reasonable care we would probably refuse to restore the patent on the grounds that the applicant failed to take reasonable care to ensure that his agent was provided with an up-to-date address. However, provided the applicant could show that, despite his failure to tell the agent that he had changed his address, he always intended maintaining his patent in force we would probably allow the request based on the criteria of “continuing underlying intention.” An example of when a request for an extension of time, using the “continuing underlying intention” criteria, is likely to be refused

is where there is clear evidence that the applicant took a conscious decision to abandon a patent but later decided to try and restore it after he realized that it may have commercial value. Also, where a considerable period of time has elapsed since the expiry of a prescribed time it is difficult for an applicant to prove that he had a continuing underlying intention to pursue the application. The fact that the “reasonable care” test is tougher than the “continual underlying intention” test is reflected in the fact that around 80% of the requests were received to restore patents, which is based on the “reasonable care” test, are allowed while over 95% of applications were received to extend time limits, which is based on “continuing underlying intention”, are allowed. It is also worth noting that in the case of restoring patents under section 28(3) of the Patents Act 1977, section 28A provides for protection against infringement action for third parties whom they may have taken steps to work the invention covered by a patent after the patent had been announced as ceased following a failure to pay a renewal fee. No such provision is included in the Act or the Rules to cover third parties in situations where an application for a patent has ceased due to a failure by the applicant to meet a time period. However, when reinstating such patents following the exercise of discretion to extend the time period it is the Office's practice to impose similar terms to those contained in section 28A to protect the interests of third parties.”

Response by the United States of America: “Unintentionality” is subjective, as it depends upon the state of mind of the person whose delay is relevant (e.g., the applicant or patent owner). “Due care,” on the other hand, is objective, as it is measured against care that would have been exercised by the “reasonably prudent person.” With regard to “unintentionality”, the Office will, in most cases, accept the relevant person’s statement that the entire delay was unintentional as sufficient, unless facts of record suggest otherwise. This is because the person presenting such a statement to the Office has a duty of candor and good faith, and is obligated to inquire into the underlying facts and circumstances before presenting such a statement to the Office. See CFR 10.18. In addition, providing an appropriate statement may have an adverse effect when attempting to enforce the patent. See Lumenyte Int’l Corp. v. Cable Lite Corp., Nos. 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 3839 27 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional). “Due care”, on the other hand, requires a showing that the care actually exercised rose to the level of care that would have been exercised by the reasonably prudent person. This showing requires the applicant or patent owner to produce greater evidence than is required in the case of “unintentionality”. Thus, for example, a showing of an unavoidable delay in the case of a docketing error will require, *inter alia*: (1) evidence concerning the procedures in place that should have avoided the error resulting in delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(2). Or, for example, where an unavoidable delay in submitting the maintenance fee is alleged, MPEP 2590 instructs that “an adequate showing requires a statement by all persons with direct knowledge of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in statements should be furnished as exhibits to the statement.

Question 4: (only applicable if the answer to question 1 is “yes”): Do guidelines exist which further define the two criteria and explain how to apply them? If so, please reproduce the guidelines here or attach a copy to this questionnaire.

Response by Australia: “Guidelines are set out in Part 26 of the Australian Patent Office Manual of Practice and Procedure, Volume 3.” These guidelines are currently being reviewed and updated.”

Response by Austria: “No guidelines exist which further define the criterion “due care.”

Response by Bulgaria: “There is no guideline for definition of the criterion, the general principles of Civil Law are applied.”

Response by Denmark: “According to our guidelines there are two steps in the application procedure. 1. The application for restoration has to be sent to the patent office within two months after the patent owner has realized that the patent has lapsed. If the two months period has not been respected the application for restoration will not be examined and the restoration will be refused. 2. If that deadline is respected the application for restoration will be examined from the principle of due care.”

Response by the European Patent Office: “Some information regarding re-establishment of rights is provided in the Guidelines for Examination in the EPO (E - V 111, 2.2.1, Annex 1). Here, it is mentioned that the applicant or proprietor must supply evidence that the delay was caused by unforeseeable factors. The Guidelines further refer to decision D6/82 stating that errors of law do not constitute grounds for re-establishment of rights (see Question 2). The case law of the boards of appeal may be considered as guidelines in a broader sense, as the first instance bases its practice on this case law. No further guidelines on the application of Article 122 EPC are available.”

Response by France: “ Guidelines on the processing of patent applications made up of case law and administrative practice at INPI contain principles on the procedure of restoration of rights.”

Response by Germany: “There are no internal guidelines or provisions. The approach of the German Patent and Trade Mark Office is oriented on the legal provisions and extensive case law.”

Response by India: “No such guideline is available. Matter is decided on case to case basis.”

Response by the Republic of Korea: “The guideline for formality examination of a patent application prepared by the KIPO and written with Korean language defines that “reasons not imputable to a person who received an invitation to amend” include the situations like by a natural disaster or other unavoidable circumstances despite ordinary people’s due care. And it shows some examples such as the notification of invalidation transmitted to inappropriate persons are recoverable and an unawareness of public notification as an irrecoverable case.”

Response by the Republic of Moldova: “ As it was mentioned above, the legislation does not give any definition of the criteria thereof. However, the Regulations on the Application of the Law on Patents for Inventions contain provisions for reinstatement of rights, particularly in regard of presentation of reasons and proofs.”

Response by Monaco: “No guideline was ever prepared as to the definition and implementation of the criteria of “legitimate excuse.”

Response by the Netherlands: “At this moment, it is assumed that the guidelines under the old patent act of 1910 still apply. In these guidelines, based on jurisprudence of NIPO, the following requirements are laid down. Not only the patentee himself has to take “*all due care required by the circumstances*”, but also (internally) his own personnel, as well as (externally) his patent attorney and the personnel of the patent attorney and all other persons employed by the patentee or his patent attorney (like “CPI”, a company specialised in providing patent annuity services). The administrative personnel must be well trained and instructed. The administrative system must be set up in a way that it takes into account that even well educated, properly trained and accurate working personnel/staff can sometimes make a mistake. This implies that crucial time limits must be checked independently, so that accidental mistakes (of personnel) are discovered in time within the system. Mistakes, which are unforeseeable, e.g. due to a fatal combination of accidental events, are excusable. An isolated mistake in a properly working administrative system with sufficient cross-checking is excusable.”

Response by Norway: “In the assessment as to whether due care is shown, it is required that the applicant or his representative has a system for monitoring time limits. If the failure to comply with that time limit occurs, in spite of the system, it will be assessed if the system seems to be well functioning under normal circumstances. If so, and the failure to comply with the time limit is due to a single, isolated procedural error, the condition for due care is considered fulfilled and the right will be restored. The assessment of circumstances related to exceeded time limits due to a failure done by office staff for by single, individual applicants is less strict than failures done by professional representatives. It is, however, necessary that the office in question can show that the staff is well instructed and trained by the responsible attorney. In addition, their work should be regularly spot-tested. Workloads, long-lasting illness or financial difficulties are not considered as sufficient grounds in cases of restoration of rights. Failures resulted from cases of force majeure will always be considered as fulfilling the condition of “due care.”

Response by Singapore: 4a. As mentioned above, the provisions on restoration in Singapore are similar to those found in UK. Hence, the case law and the practice in UK could serve as precedents (but they are not binding) when we consider the requirement of “reasonable care” in Singapore. 4b. On “unintentionality”, one would have to show that the delay or omission to meet the deadline was not a deliberate act.”

Response by the Slovak Republic: “No. The rights and duties of the applicant, in relation to restoration of the priority right, are clearly specified in the Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts (Patent Law) in its provisions.”

Response by Slovenia: “There are no national guidelines concerning those criteria. As a rule, the Office is following applicable national court decisions and the practice of Boards of Appeal of European Patent Office.”

Response by Spain: “There are still no guidelines in this matter because that legal provision has been in force only since July 31 2002.”

Response by the United Kingdom: “Limited guidelines are contained in our Manual of Patent Practice, relevant extracts of which are attached as an annex A. In the case of “reasonable care”, the guidelines provide the references for the precedent cases to which we refer when assessing restoration requests. As the Hearing Office for section 28 restoration cases, I also give regular PowerPoint presentations in which I describe by example the factors taken into account when determining whether a patentee has taken “reasonable care”. Extracts from my speaking notes are attached as an annex B. Apart from the short reference in the Manual of Patent Practice, the only other guide to what is meant by a “continuing underlying intention” is the *Heatex Ltd* precedent case referred to above”

Response by the United States of America: “Guidelines are set forth in MPEP 711.03(3)(C)(111) and 2590.”

Question 5: (only applicable if the answer to question 1 is “yes”): What are the main problems, if any, with regard to the application of the two criteria?

Response by Australia: “A difficulty arises under the provisions of “due care” in identifying whether or not the party actually took due care. Different applicants/patentees and their agents have a myriad of systems in place. The lines between when a time limit was missed because of an absence of due care or because of some other reason can often be blurred. In some cases, there may be multiple layers of responsibility, such as the applicant/patentee, their in-house counsel, the foreign attorneys and the Australian attorneys. There may also be multiple levels of responsibility within each of these categories. It is sometimes difficult establishing where the relevant error actually occurred in such a case, although an intention to do the act may be readily apparent. The provisions of due care also do not lend themselves readily to infrequent users of the system, as they are unlikely to have sophisticated systems in place and often have an inadequate knowledge of the system. Therefore while there is a requirement for a causal relationship between the error and the failure to act, it is occasionally difficult to determine what the actual error was or how it occurred. This is particularly the case where there has been a change in the applicant/patentee and/or their attorney, or when the relevant person is no longer employed. In these cases it is necessary to look at the intention and the consequences of granting or refusing the extension. In other cases, the applicant may not have had the opportunity to form an intention, because some necessary precursor did not happen due to an error or omission. Some common deficiencies that occur in processing requests (in relation to the actual request and supporting evidence) are: -- The request is for the incorrect period -- particularly in respect of applications to enter the national phase; -- The request is in respect of the incorrect action -- particularly in respect of filing a divisional application; and in respect of correcting errors during the national phase that arise during the international phase of a PCT application; -- The request is in respect of a matter that cannot be extended (e.g. request to file a first instance application; requests in respect of matters where the Commissioner has become *functus officio* [such as a request filed after grant to extend the time for filing a notice of opposition.]) -- The declaration is of low evidentiary value by relying upon hearsay (“I declare that the [foreign] associate has told me that this client has told him that....”) -- particularly in situations where there is no apparent reason (other than mere inconvenience) why the person having the direct knowledge of the circumstances cannot provide a declaration. This is to be contrasted with the situation where “person X, formerly of our employ” committed an error, where hearsay evidence may be quite appropriate. -- Declarations that apparently provide ‘selective’ extracts of supporting documents whilst avoiding documents that may be less favourable to their case. (As a

particular subset of this situation - declarations which refer or allude to documents as supporting their case, but fail to provide copies of them.)”

Response by Bulgaria: “The main problems are connected with assessment of the evidences furnished by the applicant that support thereasons for the delay.”

Response by Denmark: “The problems that occur in relation to using the criteria all due care are that this criteria is very subjective and it is very difficult to have a common practice. of importance is being put on the explanation given by the patent holder and there is a tendency that patent bureaus have a large advantage when giving the explanation because they are well aware of what the criteria are. The system therefore seems to give some advantage to the professional applicant at the expense of the private applicant.” Alot

Response by the Eurasian Patent Office: “One of the main problems in respect of application of the two criteria is deficiency of applicable practice and guidelines for definition of the criteria.”

Response from the European Patent Office: “As each individual case has to be examined on its own merits and since third party interests may be involved, the evaluation of all due care” requires careful consideration and may be time-consuming. Essential elements are fact-finding and evaluation of evidence provided by the party concerned. Where more than one person is involved it needs to be established who should have exercised “all due care” and to what extent. Further, it should be mentioned that the role of Article 122 EPC will change as soon as the Revision Act adopted on 29 November 2000 during the Diplomatic Conference of the EPCC Contracting States, will enter into force. The new version of Article 121 EPC (further processing) broadens the scope of application of further processing and makes it the standard legal remedy in cases of failure to observe time limits in the European grant procedure. It takes account of current international legal trends and practical requirements, according to which further processing should, in the interest of procedural economy and legal certainty, be given priority over re-establishment of rights. It follows from the new version of Article 122 EPC that the scope of application is narrowed down in view of the new provisions governing further processing. Further processing is, however, excluded when the applicant has missed the priority period. Here, re-establishment of rights will be the only available remedy.” ons

Response by France: “The right holder may have some difficulties in certain circumstances to show evidence and to demonstrate the existence of both criteria. It may also be problematic for the Office to evaluate the quality of the evidence, which is being submitted. The Office therefore makes decisions on a case-by-case basis, in light of the circumstances of each case, and in general the right holder would get his right restored if there is some doubt.”

Response by Germany: “The German Patent and Trade Mark Office does not encounter problems in applying the criterion of due care in practice. Sufficient terms of reference are provided, in particular, by the very extensive case law on this matter.”

Response by India: “There is no specific problem, these second criteria follow the first one.”

Response by Israel: “The items above which are close to “due care” require the Commission to exercise discretion, which is to some extent subjective. It is difficult to provide guidelines because the circumstances in each case are different and each case is determined according to its merits.”

Response by Japan: “ It does not seem to be any problem in applying the criterion of “due care”. As regards the criterion of “unintentionality”, however, it would be difficult to make a judgement because judgement on “unintentionality” greatly depends on the subjective element of the applicant.”

Response by the Republic of Korea: “The KIPO has not met any problems with regard to the application of the criteria.”

Response by Republic of Moldova: “ The main problem consists in the lack of a uniform and equivalent treatment by the Offices, caused by the absence of a clear definition of the situations to which can be applied these criteria.”

Response by Monaco: “The principal difficulty consists in the appreciation of the criteria of “legitimate excuse” according to the circumstances.”

Response by the Netherlands: “In the Netherlands, only the “due care” criterion applies. There are no problems with this criterion.

Response by New Zealand: “No problems with regard to the application of these criteria have been noted. The use of the Patents Act 1953 and Commissioners Decisions make this area relatively straightforward.”

Response by Norway: “Seen from the office’s point of view, the main problems regarding the use of the “due care” criterion is the time -consuming hearing of the cases. Furthermore, it will always be a possibility that professional attorneys, who know the office’s practice in these cases, is able to adjust the application of restoration accordingly.”

Response by the Philippines: “The lack of specific guidelines defining “unintentionality” makes such criterion broad and subject to abuse by the applicants and right holders.”

Response by Poland: *The most difficult is to establish where “unintentionality” ends and “due care” starts (whether the applicant’s act or omission of acting may be considered just to be unintentional [undesigned, unmeant] or rather negligent and without due diligence) and what is the intensity of his willful being at fault.”

Response by Singapore: “5a. To show “reasonable care”, one would have to adduce evidence to show that a certain degree of care is already in place to prevent a delay or omission in meeting the deadline. One can foresee problems arising when it comes to collating such evidence that would satisfy the Patent Office. 5b. On “unintentionality”, one would have to show that the delay or omission to meet the deadline was not a deliberate act. This requirement is met when the person explains as such, in a sworn statement.”

Response by the Slovak Republic: “No. The rights and duties of the applicant, in relation to restoration of the priority right, are clearly specified in the Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts (Patent Law) in its provisions.”

Response by Slovenia: “The criterion of “due care” is used in connection with restitution in integrum cases. This institute is used for specific cases where two main conditions have to be fulfilled: 1. “due care” criterion and 2. justifiable reasons for non -compliance with the time limit. For applicants/owners or professional representatives it is especially difficult to meet

thecriterionof“duecare”sinceitisverydifficulttoprovethatalltheappropriatecarehas beentakenunderthecircumstancesofthecase.”

ResponsebySpain: “Wehavehadnoproblemswiththeapplicationofrestorationofrights.”

ResponsebySweden: “Themainproblemistodecidethenecessarystandardforallduecare sinceallcircumstancesmustbetakenintoconsiderationinthespecificcase.”

ResponsebytheUnitedKingdom: “Oneoftheproblemsweencounterwhenassessing applicationstorestorepatentsbasedonthe“reasonablecare”testisthedifficultyinobtaining evidence.Fo rinstance,itcanbeverydifficultforanapplicanttoprovethathedidnot receiveareminderletterfromhisagentorthisOfficeorthathishealthwassuchastoprevent himpayingthefee.Inthecaseof“continualunderlyingintention”,theproblemcanbethe reverseinthatitisdifficulttodisproveanapplicant’sclaimthatthatwashisintention. Applicantswhodonotuseprofessionalagenciesforthepurposesofremindingand/or paymentofrenewalfeescanoccasionallyfinditdifficulttop resentthisOfficewiththevidence toshowthattheirown“inhouse”systemsareeffectandrobustastodemonstratethatthey havetakenreasonablecare.”

ResponsebytheUnitedStatesofAmerica: “Themainproblemwiththe“duecare“criterion isthatit requiringsupportingevidence,whichmustbecarefullyconsidered.Thispresentsa greateradministrativeburdenupontheOfficethaninthecaseof“unintentionality”.In addition,theshowingrequiredbytheapplicanttoestablish“duecare”isgreater thaninthe caseof“unintentionality.”Thus,thecriterionof“duecare”isless“applicantfriendly”than thecriterionof“unintentionality”.

[EndofAnnexandofdocument]

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Fourth Session
Geneva, May 19 to 23, 2003

CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

“MISSING PART” REQUIREMENTS

Document prepared by the International Bureau

BACKGROUND

1. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals designed to align the PCT with the requirements of the Patent Law Treaty (PLT), based on document PCT/R/WG/1/5.
2. Among the PLT-related proposals contained in document PCT/R/WG/1/5 were proposals to conform the PCT “missing part” requirements to those of the PLT (see document PCT/R/WG/1/5, Annex I). However, due to time constraints, a number of the proposals contained in document PCT/R/WG/1/5, including those related to “missing part” requirements, could not be discussed during the first session of the Working Group. Rather, the Working Group desired to give priority 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,” in particular, proposals concerning restoration of the right of priority and relief when time limits were missed, especially the time limit for entering the national phase (see the first session summary by the Chair, document PCT/R/WG/1/9, paragraph 21(v)).

3. For these second session of the Working Group, the International Bureau prepared a document outlining possible further PLT -related changes to the PCT, suggesting, in general, that those PLT -related proposals contained in document PCT/R/WG/1/5 which had not been discussed during the first session of the Working Group would not need to be addressed as matters of high priority. With regard to the proposal to conform the PCT "missing part" requirements to those of the PLT, as contained in Annex I to document PCT/R/WG/1/5, it was suggested that "[i]n light of the discussions at the first session of the Working Group, this proposal is considered to have a relatively low priority and will not be resubmitted for consideration by the Working Group until a later date" (see document PCT/R/WG/2/6, paragraph 9; the Working Group at its second session was unable in the time available to consider document PCT/R/WG/2/6 – see document PCT/R/WG/2/12, paragraph 59).

4. At its third session, the Working Group reviewed proposals for reform which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group was the proposal to conform the PCT "missing part" requirements to those of the PLT, as originally submitted to the Working Group in document PCT/R/WG/1/5. The Working Group agreed that the International Bureau should resubmit the proposals for further consideration by the Working Group (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 35 to 40, in particular, paragraph 38).

CONFORM PCT "MISSING PART" REQUIREMENTS TO THOSE OF THE PLT

5. The present document contains further revised text of the proposals related to "missing part" requirements originally contained in Annex I to document PCT/R/WG/1/5. They have been further revised so as to take into account, as was suggested in document PCT/R/WG/2/6, that there is no intention to proceed, until a future session of the Working Group, with certain other PLT related proposals which were also contained in Annex I to document PCT/R/WG/1/5, such as proposal to align the PCT filing date requirements with regard to claims, "drawing as description," and replacement of description and drawing by reference to previously filed application to those of the PLT.

Structure of Rule 20

6. In the context of "missing part" requirements, it is proposed to revise Rule 20 so as to remove to the Administrative Instructions matters of detail related to the stamping of dates, etc., which are presently dealt with in Rules 20.1 to 20.3, and to leave the Rule to deal with the more significant question of the according of the international filing date. The existing provisions of the Rule would be renumbered accordingly. A new provision would be added as Rule 20.3(c) and (d) dealing with the question of subsequent compliance with Article 11(1). Rule 20.5 as amended would deal with missing parts, including the case where the missing part is completely contained in an earlier application the priority of which is claimed (see below). The proposed amendments would align the order of the provisions dealing with the according of the international filing date with the (logical) order in which a receiving Office determines whether and which date to accord as the international filing date.

International filing date where missing part is filed

7. Under PLT Article 5(6)(a), late submission (within certain time limits) of a missing part of the description or a missing drawing results in according as the filing date the date on

which the Office has received the missing part of the description or the missing drawing, or the date on which all the filing date requirements are complied with, whichever is later. The same principle is applied under the PCT where sheets (description, claims, drawings) pertaining to the same application are not received on the same day. However, while the Treaty (PCT Article 14(2)) expressly deals with the case of missing drawings, neither the Treaty nor the Regulations specifically deal with the according (or correction) of an international filing date where sheets other than missing drawings are received later than the date on which papers were first received. This matter is expressly dealt with only in the Administrative Instructions (see Section 309 of the Administrative Instructions) and in the Receiving Office Guidelines (see paragraphs 200 to 207 of the Receiving Office Guidelines). In order to clarify the procedure, it is proposed to deal with this important matter in the Regulations (rather than in the Administrative Instructions and the Receiving Office Guidelines) and to amend Rule 20 accordingly (see Rule 20.5 as proposed to be amended).

International filing date where missing part is completely contained in earlier application

8. The main difference between the “missing part” requirements of the PLT and those of the PCT is that, under the PLT, the applicant can rectify the omission, at the time of filing, of a part of the description or of a drawing without loss of the filing date if the application claims the priority of an earlier application and the missing part of the description or the missing drawing is completely contained in that earlier application (see PLT Article 5(6) and PLT Rule 2(3) and (4)). There is no equivalent provision in the PCT. It is proposed to amend the PCT Regulations by adding new Rule 20.5(e) so as to align PCT requirements to those of the PLT.

Alignment of certain related requirements under the PCT with those under the PLT

9. In the context of “missing part” type requirements, it is also proposed to align certain related requirements under the PCT with those under the PLT, in particular time limits for compliance with non-filing date related requirements (see Rule 26 as proposed to be amended).

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

“MISSING PART” REQUIREMENTS

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Rule 20

International Filing Date

~~Receipt of the International Application~~

[COMMENT: It is proposed to revise Rule 20 so as to remove to the Administrative Instructions matters of detail related to the stamping of dates, etc., which are presently dealt with in Rules 20.1 to 20.3, and to leave the Rule to deal with the more significant question of the according of the international filing date. The existing provisions of the Rule would be renumbered accordingly. A new provision would be added as Rule 20.3(c) and (d) dealing with the question of subsequent compliance with Article 11(1), and new Rule 20.5 would deal with missing parts and missing drawings.]

~~20.1 Date and Number~~

~~(a) Upon receipt of papers purporting to be an international application, the receiving Office shall indelibly mark the date of actual receipt on the request of each copy received and the international application number on each sheet of each copy received.~~

~~(b) The place on each sheet where the date or numbers shall be marked, and other details, shall be specified in the Administrative Instructions.~~

[COMMENT: It is proposed to delete present Rule 20.1 and to move the content of that Rule to the Administrative Instructions. Present Rule 20.4 would be renumbered as Rule 20.1.]

~~20.2—Receipt on Different Days—~~

~~(a) In cases where all the sheets pertaining to the same purpo—
rtes international
application are not received on the same day by the receiving Office, that Office shall correct
the date marked on the request (still leaving legible, however, the earlier date or dates already
marked) so that it indicates the day on whi—
ch the papers completing the international
application were received, provided—~~

~~(i) where no invitation under Article 11(2)(a) to correct was sent to the applicant,
the said papers are received within 30 days from the date on which sheets were first receiv—
ed;~~

~~(ii) where an invitation under Article 11(2)(a) to correct was sent to the applicant,
the said papers are received within the applicable time limit under Rule 20.6;~~

~~(iii) in the case of Article 14(2), the missing drawings are received within 30 days
from the date on which the incomplete papers were filed;~~

~~(iv) the absence or later receipt of any sheet containing the abstract or part thereof
shall not, in itself, require any correction of the date marked on the request.~~

~~(b) Any sheet received on a—
date later than the date on which sheets were first received
shall be marked by the receiving Office with the date on which it was received.~~

[COMMENT: It is proposed to delete present Rule 20.2 and to move the content of the
chapeau of present paragraph (a) (“that Office shall correct the date marked on the request
(still leaving legible, however, the earlier date or dates already marked) so that it indicates the
day on which the papers completing the international application were received”) and the
content of present paragraph (b) to the Administrative Instructions. Present Rule 20.5 would
be renumbered as Rule 20.2.]

~~20.3—Corrected International Application—~~

~~In the case referred to in Article 11(2)(b), the receiving Office shall correct the date
marked on the request (still leaving legible, however, the earlier date or dates already marked)
so that it indicates the day on which the last required correction was received.~~

[COMMENT: It is proposed to delete present Rule 20.3 and to move the content of that Rule to the Administrative Instructions. Present Rule 20.6 would be renumbered as Rule 20.3. The matter of subsequent compliance with Article 11(1) requirements (“the case referred to in Article 11(2)(b)”) would be dealt with in proposed new Rule 20.3(c) and (d) (see below).]

20.1 ~~20.4~~ *Determination Under Article 11(1)*

[COMMENT: Apart from the renumbering, no change is proposed to the present Rule, but the text is reproduced below for convenient reference. A decision by the Assembly may be necessary to ensure that transitional reservations that were made under existing Rule 20.4(d) continue to be effective under that provision as renumbered Rule 20.1(d).]

(a) [No change] Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers comply with the requirements of Article 11(1).

(b) [No change] For the purposes of Article 11(1)(iii)(c), it shall be sufficient to indicate the name of the applicant in a way which allows his identity to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

(c) [No change] For the purposes of Article 11(1)(ii), it shall be sufficient that the part which appears to be a description (other than any sequence listing part thereof) and the part which appears to be a claim or claims be in a language accepted by the receiving Office under Rule 12.1(a).

(d) [No change] If, on October 1, 1997, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.

20.2 ~~20.5~~ *Positive Determination* Under Article 11(1)

[COMMENT: Renumbering and clarification of the title only. No change is otherwise proposed to the present Rule but the text is reproduced below for convenient reference.]

(a) [No change] If the determination under Article 11(1) is positive, the receiving Office shall stamp on the request the name of the receiving Office and the words “PCT International Application,” or “Demande internationale PCT.” If the official language of the receiving Office is neither English nor French, the words “International Application” or “Demande internationale” may be accompanied by a translation of these words in the official language of the receiving Office.

(b) [No change] The copy whose request has been so stamped shall be the record copy of the international application.

(c) [No change] The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

20.3 ~~20.6~~ Correction Under Article 11(2) ~~Invitation to Correct~~

(a) The invitation to correct under Article 11(2) ~~(a)~~ shall specify the requirement provided for under Article 11(1) which, in the opinion of the receiving Office, has not been fulfilled.

[COMMENT: Renumbering and clarification only.]

(b) The receiving Office shall send the invitation referred to in paragraph (a) promptly .
In the invitation, the receiving Office shall invite ~~shall mail the invitation to~~ the applicant to
furnish the required correction, and to make observations, within the time limit under
paragraph (d)(i) ~~and shall fix a time limit, reasonable under the circumstances of the case, for~~
~~filing the correction. The time limit shall not be less than 10 days, and shall not exceed one~~
~~month, from the date of the invitation~~ . If that such time limit expires after the expiration of
one year from the filing date of any application whose priority is claimed, the receiving Office
shall ~~may~~ call this circumstance to the attention of the applicant.

[COMMENT: With regard to the requirement to give the applicant the opportunity to make observations, see PLT Article 5(3). It is also proposed to make it mandatory for receiving Offices to draw the applicant's attention to the fact that the time limit for correction expires after the expiration of the priority period.]

(c) Where one or more of the requirements under Article 11(1) are not complied with at
the time of receipt of the purported international application but are complied with on a later
date falling within the applicable time limit under paragraph (d), the international filing date
shall, subject to Rule 20.5, be that later date and the receiving Office shall proceed as
provided in Rule 20.2.

[Rule 20.3(c), continued]

[COMMENT: See PLT Article 5(4). It is proposed to add new paragraphs (c) and (d) so as to clarify the procedure with regard to the according of the international filing date in case of subsequent compliance with Article 11(1) requirements, in particular in view of proposed new Rule 20.5 (according of the international filing date in case a missing part or missing drawing is filed, including the case that a missing part or missing drawing is completely contained in the earlier application the priority of which is claimed; see below).]

(d) The time limit referred to in paragraphs (b) and (c) shall be:

(i) where an invitation referred to in paragraph (a) was sent to the applicant, [one month] [two months] from the date of the invitation;

[COMMENT: See PLT Article 5(3) and PLT Rule 2(1). The time limit has been put in square brackets since it appears inherently problematic to include in the PCT Regulations more generous (“PLT -style”) time limits than is presently the case, noting that the proper functioning of the PCT system relies to a great extent on actions taking place in a very limited time and within strict deadlines.]

(ii) where no invitation referred to in paragraph (a) was sent to the applicant, [one month] [two months] from the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office.

[COMMENT: See PLT Article 5(4) and PLT Rule 2(2). While the PLT provides for the time limit under item (ii) only in cases where no invitation was sent to the applicant “because indications allowing the applicant to be contacted by the Office have not been filed”, it is proposed to apply that time limit to *all* cases where no invitation has been sent to the applicant. The time limits have been put in square brackets since it appears inherently problematic to include in the PCT Regulations more generous (“PLT -style”) time limits than is presently the case, noting that the proper functioning of the PCT system relies to a great extent on actions taking place in a very limited time and within strict deadlines.]

20.4 ~~20.7~~ *Negative Determination* Under Article 11(1)

If the receiving Office does not ~~;~~ receive a correction under Article 11(2) within the applicable ~~prescribed~~ timelimit under Rule 20.3(d), ~~receive a reply to its invitation to correct,~~ or if ~~a~~ the correction is furnished ~~offered~~ by the applicant but the application still does not fulfill the requirements ~~sp~~ provided for under Article 11(1), it shall:

[COMMENT: Consequential on the proposed amendment of present Rule 20.6 (renumbered Rule 20.3 and the proposed addition of new Rule 20.3(c) and (d).]

(i) promptly notify the applicant that the ~~his~~ application is considered not to have been filed ~~is not and will not be treated as an international application~~ and shall indicate the reasons therefor,

[COMMENT: Item (i) is proposed to be amended so as to align the terminology with that used in PLT Article 5(4)(b). Items (ii) to (iv) are not proposed to be amended but are reproduced below for convenient reference.]

(ii) [No change] notify the International Bureau that the number it has marked on the papers will not be used as an international application number,

(iii) [No change] keep the papers constituting the purported international application and any correspondence relating thereto as provided in Rule 93.1, and

(iv) [No change] send a copy of the said paper to the International Bureau where, pursuant to a request by the applicant under Article 25(1), the International Bureau needs such a copy and specially asks for it.

20.5 Missing Part of Description, Claims or Drawings

(a) Where the receiving Office notices that a part of the description, the claim or claims or the drawings (if any) appear to be missing from the application (“missing part”), including the case where the application refers to drawings which in fact are not included in the application, that Offices shall promptly invite the applicant to furnish the missing part (if any) and to make observations within the time limit under paragraph (c)(i). If that time limit expires after the expiration of one year from the filing date of any application whose priority is claimed, the receiving Office shall call this circumstance to the attention of the applicant.

[COMMENT: Under the present PCT “missing part” requirements, the receiving Office is required to notify the applicant only in case of a missing drawing (see PCT Article 14(2)) but not in case of a missing part of the description or of a missing part of a claim or claims. In accordance with PLT Article 5(5), it is proposed to extend the (applicant friendly) concept of a “missing part” notification also to a missing part of the description and, notwithstanding that the presence of claims is a filing date requirement under the PCT, to a missing part of a claim or claims. Where the receiving Office sends to the applicant an invitation to correct under Article 11(2)(a) or Article 14(1)(b), the “missing part” notifications should be included in that invitation; the Administrative Instructions would have to be modified accordingly. In line with the Notes on the PLT, it is further proposed to modify the Administrative Instructions and the Receiving Office Guidelines so as to make it clear that there is no obligation on the receiving Office to carry out a check for a missing part (of the description or of a claim or claims) or a missing drawing beyond the existing obligation to check that the number of the sheets of description actually filed corresponds to the number indicated in Box VIII of the request (see paragraph 149 of the Receiving Office Guidelines) and the obligation to examine the checklist in the request and the text of the international application for reference to drawings and to check whether drawings are included in the international application (see paragraph 193 and 194 of the Receiving Office Guidelines). Note that the last sentence of proposed new paragraph (a) would need to be further amended should a provision concerning the restoration of the right of priority be added to the PCT Regulations (see document PCT/R/WG/4/1), since the international filing date could then be later than 14 months from the filing date of the earlier application whose priority is claimed.]

[Rule 20.5, continued]

(b) Where the applicant furnishes a missing part to the receiving Office within the applicable time limit under paragraph (c), that part shall be included in the international application and, subject to paragraphs (e) and (f), the international filing date shall be the date on which the receiving Office received that part or the date on which all of the requirements of Article 11(1) are complied with, whichever is later.

[COMMENT: See PLT Article 5(6). It is proposed to add new paragraph (b) so as to clarify, in the Regulations, the procedure with regard to the according (or correction) of an international filing date where sheets completing the international application are submitted on a date later than the date on which papers were first received. At present, while Article 14(2) deals with the procedure in case of missing drawings, neither the Treaty nor the Regulations clearly spell out the procedure with regard to the according (or correction) of an international filing date where sheets other than missing drawings are received later than the date on which papers were first received; at present, this issue is expressly dealt with only in the Administrative Instructions (see Section 309) and in the Receiving Office Guidelines (see paragraphs 200 to 207).]

(c) The time limit referred to in paragraphs (a) and (b) shall be:

(i) where an invitation referred to in paragraph (a) was sent to the applicant, [one month] [two months] from the date of the invitation;

(ii) where no invitation referred to in paragraph (a) was sent to the applicant, [one month] [two months] from the date on which one or more elements referred to in Article 11(1) were first received by the receiving Office.

[COMMENT: With regard to the applicable time limit, see PLT Article 5(6) and PLT Rule 2(3)(i) and (ii). The time limits have been put in square brackets since it appears inherently problematic to include in the PCT Regulations more generous (“PLT -style”) time limits than is presently the case, noting that the proper functioning of the PCT system relies to a great extent on action taking place in a very limited time and within strict deadlines.]

[Rule 20.5, continued]

(d) The applicant may, in a notice submitted to the receiving Office within the applicable time limit under paragraph (c), request that a missing part furnished under paragraph (b) be disregarded, in which case the international filing dates shall be the date on which all of the requirements of Article 11(1) are complied with.

[COMMENT: See PLT Article 5(6)(c). The proposed wording (“request to disregard”) differs from that used in the PLT (“withdraw”) so as to avoid confusion with withdrawals under Rule 90 *bis*.]

(e) Where the international application claims the priority of an earlier application [and, on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, contained an indication that the contents of the earlier application were incorporated by reference in the international application,] and the applicant furnishes a missing part under paragraph (b) whose content is completely contained in that earlier application, the international filing dates shall be the date on which all the requirements of Article 11(1) are complied with, provided that, within the applicable time limit under paragraph (b):

[COMMENT: The main difference between the “missing part” requirements of the PLT and those of the PCT is that, under the PLT, the applicant can rectify the omission, at the time of filing, of a part of the description or of a drawing without loss of the filing date if the application claims the priority of an earlier application and the missing part of the description or the missing drawing is completely contained in that earlier application (see PLT Article 5(6) and PLT Rule 2(3) and (4)). There is no equivalent provision in the PCT. In order to align PCT requirements to those of the PLT, it is proposed to add such provision to the PCT Regulations. PLT Rule 2(4) leaves it at the option of any PLT Contracting Party whether it wishes to require that the application, at the date on which papers were first received, contained an indication that the contents of the earlier application were incorporated by reference in the application (see PLT Rule 2(4)(v)). Delegations may wish to consider whether or not to include such requirement in the PCT Regulations; the text corresponding to that requirement has thus been put in square brackets. Furthermore, it is proposed *notto* include in paragraph (b) a requirement, as permitted under PLT Rule 2(4)(ii), that the

[Rule 20.5(e), continued]

applicant, upon invitation by the Office, must file a certified copy of the earlier application (the “priority document”), in addition to the “simple” copy of the earlier application required to be furnished under item (ii) of paragraph (b) (see below). The furnishing of a “simple” copy of the earlier application would appear sufficient for the purposes of the international phase; the consequences in case of any discrepancies between the “simple” copy and the certified copy of the earlier application would have to be dealt with in the national phase.]

(i) the applicant submits a request according to the receiving Office;

(ii) a copy of the earlier application is furnished to the receiving Office;

[COMMENT: See PLTR Rule 2(4)(i).]

(iii) where the earlier application is not the same language accepted by the receiving Office under Rule 12.1(a) as the international application, a translation of the earlier application into that language is furnished to the receiving Office; and

[COMMENT: See PLTR Rule 2(4)(iii).]

(iv) the applicant furnishes to the receiving Office an indication as to where, in the earlier application or in the translation referred to in item (iv), the missing part is contained.

[COMMENT: See PLTR Rule 2(4)(vi). Under the PLT, there is no provision which would require the applicant to furnish a statement to the effect that the missing part (or missing drawing) furnished later is identical to the “missing part” as contained in the earlier application; it would thus appear that the receiving Office would be required to compare the missing part furnished later with the “missing part” as contained in the earlier application.]

Rule 26

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

26.1 Invitation Under Article 14(1)(b) to Correct ~~Time limit for Check~~

(a) The receiving Office shall ~~issue the invitation to correct provided for in~~
~~Article 14(1)(b)~~ as soon as possible, preferably within one month from the receipt of the
international application , invite the applicant, under Article 14(1)(b), to furnish the required
correction, and to make observations, within the time limit under Rule 26.2.

[COMMENT: The title is proposed to be amended so as to correctly cover the subject matter
of paragraph (a). With regard to the requirement to give the applicant the opportunity to make
observations, see PLT Article 6(7).]

(b) ~~[Deleted] If the receiving Office issues an invitation to correct the defect referred to~~
~~in Article 14(1)(a)(iii) or (iv) (missing title or missing abstract), it shall notify the~~
~~International Searching Authority accordingly.~~

[COMMENT: It is proposed to move the content of present paragraph (b) to the
Administrative Instructions.]

26.2 *Time Limit for Correction*

The time limit referred to in Rule 26.1 Article 14(1)(b) ~~shall be reasonable under the~~
~~circumstances and shall be~~ [one month][two months] ~~fixed in each case by the receiving~~
~~Office. It shall not be less than one month~~ from the date of the invitation to correct. It may be
extended by the receiving Office at any time before a decision is taken.

[Rule 26.2, continued]

[COMMENT: See PLT Article 6(7) and PLTR Rule 6(1). The time limits have been put in square brackets since it appears inherently problematic to include in the PCT Regulations more generous (“PLT -style”) time limits than is presently the case, noting that the proper functioning of the PCT system relies to a great extent on action taking place in a very limited time and within strict deadlines.]

26.3 to 26.4 [No change]

26.5 *Decision of the Receiving Office*

(a) The receiving Office shall decide whether the applicant has submitted the correction within the time limit under paragraph (b) Rule 26.2, and, if the correction has been submitted within the applicable ~~that~~ time limit, whether the international application so corrected is or is not to be considered withdrawn, provided that no international application shall be considered withdrawn for lack of compliance with the physical requirements referred to in Rule 11 if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

(b) The time limit referred to in paragraph (a) shall be:

(i) where an invitation under Rule 26.2 was sent to the applicant, [one month]
[two months] from the date of the invitation;

(ii) where no invitation under Rule 26.2 was sent to the applicant, [one month]
[two months] [three months] from the date on which one or more of the elements referred to in Article 11(1)(iii) were first received by the receiving Office.

[Rule 26.5(b), continued]

[COMMENT: See PLT Article 6(7) and PLTRule 6(1) and (2). The time limits have been put in square brackets since it appears inherently problematic to include in the PCT Regulations more generous (“PLT -style”) time limits as is presently the case, noting that the proper functioning of the PCT system relies to a great extent on action taking place in a very limited time and within strict deadlines. While the PLT provides for the time limit under item (ii) only in cases where no invitation was sent to the applicant “because indications allowing the applicant to be contacted by the Office have not been filed”, it is proposed to apply that time limit to *all* cases where no invitation has been sent to the applicant.]

~~26.6 Missing Drawings~~

~~(a) If, as provided in Article 14(2), the international application refers to drawings which in fact are not included in that application, the receiving Office shall so indicate in the said application.~~

[COMMENT: It is proposed to move the content of paragraph (a) to the Administrative Instructions.]

~~(b) The date on which the applicant receives the notification provided for in Article 14(2) shall have no effect on the time limit fixed under Rule 20.2(a)(iii).~~

[COMMENT: The proposed deletion of present paragraph (b) is consequential on the proposed amendment of Rule 20 (see above).]

[End of Annex and of document]

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Fourth Session
Geneva, May 19 to 23, 2003

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS;
SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION;
PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT ;
INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY;
CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

Document prepared by the International Bureau

BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group were certain proposals aimed at further streamlining and simplifying the PCT procedure.

2. The Working Group agreed that specific proposals for amendment of the Regulations would be prepared by the Secretariat, taking into account the discussion and conclusions reflected in the summary of the third session of the Working Group by the Chair and other points of detail noted by the International Bureau, for further consideration by the Working Group, where possible at its next session. Proposals for consideration in the short term would primarily be dealt with by way of amending the Regulations, but longer term proposals

involving revision of the Treaty should also be identified and draft provisions prepared (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 112).

3. The Annexes to this document contain a number of proposed amendments of the PCT Regulations aimed at further streamlining and simplifying the PCT procedure:¹

(i) Annex I contains proposals concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13ter.1 (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57; and paragraphs 5 to 7, below);

(ii) Annex II contains proposals to simplify the protest procedure before both the International Searching Authority ("ISA") and the International Preliminary Examining Authority ("IPEA") in case of non-unity of invention (see document PCT/R/WG/3/1, Annex I, items 4 and 10; the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97; and paragraphs 8 to 10, below);

(iii) Annex III contains proposals to permit, upon request of the applicant, the publication of a translation furnished by the applicant, or of the international application as filed in a non-publication language, together with the international application (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 82; and paragraphs 11 and 12, below);

(iv) Annex IV contains a proposal to allow for the use of, and to introduce, a standardized international form for entry into the national phase (see document PCT/R/WG/3/5, paragraphs 67 and 68; the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 67 and 68; and paragraphs 13 and 14, below);

(v) Annex V contains proposals to further amend Rules 4.11(a)(iv), 43 bis.1(b) and 94.2 as adopted by the PCT Assembly on October 1, 2002, and due to enter into force on January 1, 2004 (see document PCT/A/31/10); it also contains a proposal to amend Rule 17.2, consequential on the amendment of Rule 17.1 as adopted by the PCT Assembly on October 1, 2002, and due to enter into force on January 1, 2004. See also paragraph 15, below.

4. The proposals are further outlined in the following paragraphs.

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

5. At its third session, the Working Group reviewed a proposal to amend Rule 13ter and to provide that International Searching Authorities and International Preliminary Examining Authorities would no longer be obliged to issue invitations to furnish sequence listings in computer readable form complying with the prescribed standard or to carry out an international search and international preliminary examination in case where a sequence listing complying with that standard had not been filed (see document PCT/R/WG/3/1, Annex I, item 5).

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 are included for ease of reference.

6. The Working Group agreed not to proceed with the proposal. However, recognizing that it was desirable that sequence listings complying with the prescribed standards should be furnished together with the international application so as not to delay the start of the international search, it was agreed that the International Bureau should prepare a proposal which would permit Authorities to require the payment of a late furnishing fee where an invitation had to be issued under Rule 13ter.1(a)(ii) or (e) (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57).

7. Annex I contains a proposal to amend Rule 13ter.1 accordingly.

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

8. With regard to the protest procedure before both the International Searching Authority ("ISA") and the International Preliminary Examining Authority ("IPEA") in case of non-unity of invention, the Working Group during its third session agreed that the International Bureau should prepare a proposal for simplifying the protest procedure under Rules 40 and 68 (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97, in particular, paragraph 97).

9. It was also agreed (see document PCT/R/WG/3/5, paragraph 97) that:

"...in order to discover more information about the experience of Authorities regarding this issue, the International Bureau should send out a questionnaire asking them to indicate how many invitations they issued per year under Rules 40 and 68, how many additional fees were paid under protest, and how many of the invitations were in respect of applications containing claims to more than, say, 10 inventions."

10. Annex II contains a proposal to amend Rules 40 and 68 accordingly. An overview of the replies received in response to the questionnaire sent out by the International Bureau to all International Searching and Preliminary Examining Authorities (Circular C.PCT/896) is contained in document PCT/R/WG/4/4 Add.1.

PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT

11. During its third session, the Working Group discussed proposals for a possible deletion of Article 64(4), based on document PCT/R/WG/3/1, Annex II, item 28. The Working Group agreed that further consideration of this matter, while it would be within the competence of the Working Group, should be deferred until progress had been made in discussions of prior art issues by the Standing Committee for the Law of Patents (SCP). As a related matter, the Working Group agreed, however, that the International Bureau should look into the possibility of amending Rule 48 so as to provide for the electronic publication by the International Bureau of translations, furnished by the applicant, of the international application (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraphs 78 to 82).

12. Annex III contains proposals to amend Rule 48 so as to require the International Bureau, on request of the applicant, to publish, together with the international application, any translation of the international application furnished by the applicant or, where the international application was filed in a language which is not a language of publication, the international application in the language in which it was filed.

INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

13. At the third session of the Working Group, several delegations and representatives of users supported the proposed introduction of a standardized international form for entry into the national phase (see document PCT/R/WG/3/1, Annex I, item 11 (introduce international forms for national phase entry)), including standard texts of declarations similar to those provided for in the case of the request for entry under Rule 4.17, on the understanding that the use of such a form by applicants would be optional and not a requirement for a valid national phase entry. The Working Group agreed that the International Bureau should prepare such a proposal (see document PCT/R/WG/3/5, paragraphs 67 and 68).

14. Annex IV contains a proposal to amend Rule 49.4 accordingly. As regards the draft of a standardized international form for entry into the national phase, the International Bureau is studying the possible content of such a form, taking into account the various national requirements of designated and elected Offices allowed under Rule 51bis.

CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

15. Annex V contains proposals to further amend Rules 4.11(a)(iv), 43bis.1(b) and 94.2 as adopted by the PCT Assembly on October 1, 2002, and due to enter into force on January 1, 2004 (see document PCT/A/31/10), and to amend Rule 17.2. These proposed amendments are in the nature of corrigenda or consequential amendments based on the amendments already adopted. Explanations are set out in Annex VI in Comments relating to the provisions concerned.

16. The Working Group is invited to consider the proposals contained in the Annexes to this document.

[Annex I follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

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Rule 13ter

Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Sequence Listing for International Authorities

(a) Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:

(i) [No change]

(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it and to pay, where applicable, the late furnishing fee referred to paragraph (a-bis), within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.

[COMMENT: Text modeled after Rule 12.3(c)(ii). Further amendments of Rule 13ter are proposed in document PCT/R/WG/4/6 (Deposit of Sequence Listings).]

(a-bis) The furnishing of a sequence listing in response to an invitation under paragraph (a)(ii) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee. The amount of the late furnishing fee shall be determined by the International Searching Authority and shall be specified in the invitation under paragraph (a)(ii).

[COMMENT: Text modeled after Rules 12.3(e) and 40.2(a).]

[Rule 13ter.1, continued]

(b) [Remains deleted]

(c) If the applicant ~~has~~ does not within the time limit fixed in the invitation, furnished
the required sequence listing and paid any required late furnishing fee ~~comply with an~~
~~invitation under paragraph (a) within the time limit fixed in the invitation~~, the International
Searching Authority shall not be required to search the international application ~~to the extent~~
~~that such non-compliance has the result that a meaningful search cannot be carried out~~.

[COMMENT: The proposed amendment to paragraph (c) is consequential on the proposed introduction (at the option of the International Searching Authority) of the late furnishing fee under paragraph (a) *-bis*): where the applicant does not pay any required late furnishing fee, the International Searching Authority would not be required to carry out international search, even if the applicant has furnished the required sequence listing.]

(d) [No change]

(e) [No change] Paragraphs (a) and (c) shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

[COMMENT: No change is proposed to paragraph (e) which is included in this document only for ease of reference. The effect of the proposed change to paragraph (a) would be that the International Preliminary Examining Authority would be permitted, under paragraph (e), to require the payment of a late furnishing fee where it had issued an invitation to furnish a sequence listing complying with the prescribed standard.]

13ter.2 [No change]

[Annex I follows]

ANNEXII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

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Rule 40

Lack of Unity of Invention (International Search)

40.1 *Invitation to Pay Additional Fees; Time Limit*

[COMMENT: Clarification only.]

The invitation to pay additional fees provided for in Article 17(3)(a) shall:

(i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention; ~~and shall~~

(ii) invite the applicant to pay the additional fees within [one month] [two months] from the date of the invitation, and indicate the amount of those fees to be paid ; and

(iii) invite the applicant to pay, where applicable, the protest fee referred to in Rule 40.2(e) within [one month] [two months] from the date of the invitation, and indicate the amount to be paid.

[COMMENT: It is proposed to amend Rule 40.1 so as to deal with all matters to be included in the invitation to the applicant (reasons, time limit for payment of additional fees and amount of those fees; where applicable, time limit for payment of protest fee and amount of that fee) for in just one Rule. See also Rule 40.3, below, which is proposed to be deleted. For the time limit for compliance with the invitation under items (ii) and (iii), two months would be consistent with the PLT but one month may be more appropriate to the tight time frame under which the PCT procedure operates.]

40.2 *Additional Fees*

(a) and (b) [No change]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protests shall be examined by a ~~three-member~~ board of appeal or other review body constituted in the framework ~~special instance~~ of the International Searching Authority ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

[COMMENT: To simplify the procedure, it is proposed to leave the form of the review body and its composition to the ISA. The expression “board of appeal or other review body constituted in the framework of...” is modeled after the terminology in paragraph 1.11 of the Explanatory Notes on the Patent Law Treaty. Furthermore, it does not appear necessary to provide for a protest in respect of unity of invention to be considered, in the first instance, by a higher authority than a board of appeal or other review body constituted in the framework of the ISA. This would, of course, not prevent a higher authority from hearing an appeal against a decision of that board of appeal or other review body.]

(d) ~~[Deleted] The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person whom made the decision which is the subject of the protest.~~

[COMMENT: It is proposed that the form of the review body and its composition should be left to the ISA.]

[Rule 40.2, continued]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee.
~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest ("protest fee"). The protest fees shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 40.1(iii), paid any required ~~If the protest fee is not so paid,~~ the protest shall be considered withdrawn and the International Searching Authority shall so declare. The protest fees shall be refunded to the applicant where the ~~three member~~ board of appeal or other review body, ~~special instance or higher authority~~ referred to in paragraph (c) find that the protest was entirely justified.

[COMMENT: The amendment to the first sentence is proposed for the purpose of simplification – it does not appear necessary to oblige an ISA which wishes to require the payment of a protest fee for the examination of the protest to apply at a two-stage review process. The proposed amendment to the last sentence is consequential on the proposed amendment of paragraph (c).]

40.3 [Deleted] *Time Limit*

~~The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant's address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.~~

[COMMENT: See Comment on Rule 40.1 as proposed to be amended, above.]

Rule 68

Lack of Unity of Invention

(International Preliminary Examination)

68.1 [No change]

[PRODOMO: Rule 68 could be further simplified by deleting Rule 68.1 and amending Rule 68.2 to provide an invitation in all cases (subject to Rule 66.1(e)), in line with the Chapter I procedure under Rule 40.1. However, this is not proposed since it would take away the present applicant-friendly “no invitation” procedure under Rule 68.1.]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, [the invitation](#) shall:

(i) specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement; ~~and shall~~

(ii) specify ~~the amount of the additional fees and~~ the reasons for which the international application is not considered as complying with the requirement of unity of invention; ~~It shall, at the same time,~~

[Rule 68.2, continued]

(iii) invite the applicant to comply with the invitation within [one month] [two months] from the date of the invitation; ~~fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limit shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation~~

(iv) indicate the amount of the required additional fee to be paid in case the applicant so chooses; and

(v) invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within [one month] [two months] from the date of the invitation, and indicate the amount to be paid .

[COMMENT: The amendments proposed to Rule 68.2 correspond to those proposed to Rule 40.1.]

68.3 *Additional Fees*

(a) and (b) [No change]

[Rule 68.3, continued]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protests shall be examined by a ~~three-member~~ board of appeal or other review body constituted in the framework ~~special instance~~ of the International Preliminary Examining Authority, ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the elected Offices as an annex to the international preliminary examination report.

[COMMENT: The amendments proposed to paragraph (c) correspond to those proposed to Rule 40.2(c).]

(d) ~~[Deleted] The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person whom the decision which is the subject of the protest.~~

[COMMENT: The proposed deletion of paragraph (d) corresponds to the proposed deletion of Rule 40.2(d).]

[Rule 68.3, continued]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a protest fee. ~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fees shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 68.2(iii), paid any required ~~If the~~ protest fee ~~is not paid~~, the protest shall be considered withdrawn and the International Preliminary Examining Authority shall so declare. The protest fees shall be refunded to the applicant where the ~~three-member~~ board of appeal or other review body, ~~special instance or higher authority~~ referred to in paragraph (c) finds that the protest was entirely justified.

[COMMENT: The amendments proposed to paragraph (e) correspond to those proposed to Rule 40.2(e).]

68.4 and 68.5 [No change]

[Annex III follows]

ANNEXIII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

PUBLICATION OF TRANSLATIONS IN ADDITION TO
INTERNATIONAL PUBLICATION OF THE INTERNATIONAL APPLICATION

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Rule 47

Communication to Designated Offices

47.1 and 47.1 [No change]

47.3 *Languages; Translations*

(a) The international application communicated under Article 20 shall be in the language in which it is published.

(b) Where the language in which the international application is published is different from the language in which it was filed, the International Bureau shall furnish to any designated Office, upon the request of that Office, a copy of that application in the language in which it was filed or of any translation furnished under Rule 48.3(d)(ii).

47.4 [No change]

Rule 48

International Publication

48.1 and 48.2 [No change]

48.3 Languages of Publication

(a) [No change] If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.

(b) [No change] 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.

(c) If the international application is published under paragraph (a) or (b) in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

[Rule 48.3, continued]

(d) Upon request by the applicant received by the International Bureau prior to the expiration of 16 months from the priority date, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, the International Bureau shall publish, together with the international application as published under paragraph (a) or (b):

(i) in the case referred to in paragraph (b), the international application in the language in which it was filed;

(ii) any translation of the international application furnished by the applicant within the time limit under paragraph (e).

[COMMENT: The proposed publication of the international application in the language in which it was filed (if filed in a non-publication language) and of any translation of the international application furnished by the applicant would take place in addition to, but would not form part of, the international publication of the international application under Article 21. Publication and communication to designated Offices of the international application in a language different from the language in which international publication takes place would be beneficial for the protection of rights of the applicant under the national law of certain designated States, for example, designated States which make provisional protection after the international publication of an international application conditional on the furnishing of a translation, or States where the prior art effect of an international application is, in accordance with Article 64(4), dependent on the publication of a translation into a language accepted by the Office of the designated State concerned.]

48.4 to 48.6 [No change]

[Annex IV follows]

ANNEXIV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:
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Rule 49

Copy, Translation and Filing Under Article 22

49.1 to 49.3 [No change]

49.4 *Use of National or International Form*

(a) No applicant shall be required to use a ~~national~~ form when performing the acts referred to in Article 22.

(b) The designated Offices shall accept the use by the applicant, when performing the acts referred to in Article 22, of the form prescribed by the Administrative Instructions for the purposes of this paragraph, provided that the Office may require that the form shall be filed in a language of publication which it accepts for the purposes of this paragraph.

[COMMENT: The provision and use of any form for national phase entry (be it a national form made available by the designated Office concerned or the new international form) would remain optional, as at present. In addition, it is proposed to require any designated Office to accept the prescribed international form where the applicant chooses to use that form. By virtue of Rule 76.5, the same would apply to any elected Office. As is the case for all forms under the PCT which are to be used by the applicant, the form would be made available by the International Bureau in all seven languages of publication. As regards the draft of a standardized international form for entry into the national phase, the International Bureau is studying the possible content of such form, taking into account the various national requirements of designated and elected Offices allowed under Rule 51bis.]

49.5 to 49.6 [No change]

[Annex V follows]

ANNEXV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:
 CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

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Rule 4

The Request (Contents)

4.1 to 4.10 [No change]

4.11 *ReferencetoEarlierSearch,ContinuationorContinuation -in-Part,orParent
Application orGrant*

(a) If:

(i) to (iii) [No change]

(iv) the applicant intends to make an indication under Rule 49 *bis.1(d) ~~(e)~~* 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, as the case may be, identify the application in respect of
which the earlier search was made or otherwise identify the search, or indicate the relevant
parent application or parent patent or other parent grant.

[COMMENT: With regard to Rule 4.11 as adopted by the Assembly on October 1, 2002,
with effect from January 1, 2004 (see document PCT/A/31/10), it is proposed to further
amend Rule 4.11(a)(iv) so as to replace the erroneous reference to Rule 49bis.1(c) with a
reference to Rule 49bis.1(d).]

(b) [No change]

4.12 to 4.14 [*Remain deleted*]

4.14bis to 4.18 [No change]

Rule 17

The Priority Document

17.1 [No change]

17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a) ~~or~~ (b) or (b -bis), the International Bureau shall, at the specific request of the designated Office, subject to paragraph (a-bis), promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(a-bis) No designated Office shall request a copy of the priority document from the International Bureau under paragraph (a) if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

[COMMENT: It is proposed to amend Rule 17.2 so as to take into account the fact that, in the future, priority documents may be available to designated Offices from digital libraries; in the future, no designated Office shall request the International Bureau to furnish a copy of the priority document if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library. See Rule 17.1 as amended by the Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10).]

(b) and (c) [No change]

Rule 43 bis

Written Opinion of the International Searching Authority

43bis.1 *Written Opinion*

(a) [No change]

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), ~~66.2(a), (b) and (e)~~, 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

[COMMENT: With regard to Rule 43 bis as adopted by the Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10), it is proposed to further amend Rule 43 bis.1(b) so as to delete the reference to Rule 66.2(a), (b) and (e). Rule 66.2(a) and (b) concern the content of the written opinion of the International Preliminary Examining Authority (IPEA) and should not be referred to as applying *mutatis mutandis* to the written opinion by the International Searching Authority (ISA). The references in Rule 43 bis.1(b) to the various paragraphs of Rule 70 are correct and sufficient: all issues covered in Rule 66.2(a) and (b) are also covered in Rule 70 (Rule 70.12(iii) correspond to Rule 66.2(a)(i); Rule 70.6 correspond to Rule 66.2(a)(ii); Rule 70.12(i) correspond to Rule 66.2(a)(iii); Rule 66.2(iv) is not applicable to the written opinion by the ISA; Rule 70.12(ii) correspond to Rule 66.2(a)(v); Rule 70.2(d) correspond to Rule 66.2(a)(vi); Rule 70.12(iv) correspond to Rule 66.2(a)(vii); Article 35(2) and Rules 70.6(a), 70.8 and 70.12 correspond to Rule 66.2(b); Rule 66.2(e) is not applicable to the written opinion by the ISA) (see also the Comment on proposed new Rule 43bis.1 in document PCT/R/2/7).]

(c) [No change]

Rule 94

Access to Files

94.1 [No change]

94.2 *Access to the File Held by the International Preliminary Examining Authority*

At the request of the applicant or any person authorized by the applicant, or of an
elected Office, once the international preliminary examination report has been ~~established~~
communicated to that Office in accordance with Rule 73.2(a) or (b)(i), ~~of any elected Office,~~
the International Preliminary Examining Authority shall furnish, subject to reimbursement of
the cost of the service, copies of any document contained in its file.

[COMMENT: The proposed amendment of Rule 94.2 is consequential on the amendment of Rule 73.2 as adopted by the Assembly on October 1, 2002 with effect from January 1, 2004 (see document PCT/A/31/10), so as to ensure that copies of any document contained in the file of the International Preliminary Examining Authority are not furnished to any elected Office before the international preliminary examination report has been communicated to that Office, that is, usually, not before the expiration of 30 months from the priority date (see Rule 73.2 as in force from January 1, 2004).]

94.3 [No change]]

[End of Annex V and of document]

WIPO



PCT/R/WG/4/4 Add.1

ORIGINAL: English

DATE: March 17, 2003

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

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

**Fourth Session
Geneva, May 19 to 23, 2003**

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION:

REPLIES RECEIVED IN RESPONSE TO QUESTIONNAIRE

Document prepared by the International Bureau

BACKGROUND

1. At its third session, held in Geneva from November 18 to 22, 2002, the Working Group considered proposals for amendment of the Regulations under the PCT relating to changes necessary or desirable to simplify the procedures before the International Searching Authorities and International Preliminary Examining Authorities in cases where there is a finding of lack of unity of invention. The Working Group's discussions are outlined in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97:

"Unity of Invention

"95. Discussions were based on document PCT/R/WG/3/1, Annex I, items 4 (simplify the non-unity procedure before the ISA) and 10 (simplify the non-unity procedure before the IPEA), and Annex II, items 10 and 18 (eliminate unity of invention procedure).

"96. Certain delegations proposed the abolition of the protest system before International Searching Authorities under Rule 40 and International Preliminary Examining Authorities under Rule 68, with a view to reducing the workload of the

Authorities. The majority of delegations and representatives of users, while recognizing that the procedures under Rules 40 and 68 were cumbersome, opposed the proposal to eliminate the protest procedure altogether on the grounds that it would remove the applicant's right to challenge a finding of non-unity of invention by an Authority, thus increasing the burden on applicants and designated Offices in the national phase and resulting in incomplete searches and examinations of a greater number of international applications. It was suggested that the problem of non-unity in excessively complex or "mega-" applications would be better dealt with by other measures such as by introducing an additional fee based on the number of claims present in the application.

"97. The Working Group agreed that the International Bureau should prepare a proposal for simplifying the protest procedure under Rules 40 and 68. It was also agreed that, in order to discover more information about the experience of Authorities regarding this issue, the International Bureau should send out a questionnaire asking them to indicate how many invitations they issued per year under Rules 40 and 68, how many additional fees were paid under protest, and how many of the invitations were in respect of applications containing claims to more than, say, 10 inventions."

2. Proposals for amendment of the Regulations relating the protest procedure in case of lack of unity of invention are contained in document PCT/R/WG/4/4, Annex II.

3. By way of Circular C. PCT 896, dated December 19, 2002, the International Bureau sent a questionnaire concerning the protest procedure in cases of lack of unity of invention to all International Searching and Preliminary Examining Authorities. The Annex to this document contains the responses received by the date of this document.

4. The Working Group is invited to take note of the content of the Annex.

[Annex follows]

ANNEX

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION:
REPLIES RECEIVED IN RESPONSE TO QUESTIONNAIRE

LACK OF UNITY OF INVENTION BEFORE THE INTERNATIONAL SEARCHING
AUTHORITY (ISA)

Question 1: How many invitations to pay additional fees provided for in Article 17(3)(a) did your Office issue in its capacity as an ISA in each of the years 2000 and 2001? Please also indicate the number of international searches carried out by your Office in its capacity as an ISA in each of the years 2000 and 2001.

Response by Australia: “2000: 1779 searches conducted (total) with 152 invitations issued (for 267 searches). 2001: 1996 searches conducted (total) with 178 invitations issued (for 244 searches).”

Response by Austria: “In the year 2000, the Austrian Patent Office as ISA issued 4 invitations and in the year 2001, the Office issued 1 invitation to pay additional fees. In the year 2000, 706 international searches and in the year 2001, 352 international searches were carried out.”

Response by Canada: “As CIPO was only recently approved by the PCT Assembly to assume the responsibilities of an ISA and IPEA, and will not actually commence operation until July 2004, CIPO is not in a position at this time to respond to the questions asked in the questionnaire.”

Response by China: “Our office in the capacity as an ISA had received 746 International Applications in 2000 and issued 8 invitations to pay additional fees for them. Our Office in the capacity as an ISA had received 1656 International Applications in 2001 and issued 5 invitations to pay additional fees for them.”

Response by the European Patent Office: “2000: 51465 international searches, 2722 invitations; 2001: 53353 international searches, 3134 invitations.”

Response by Japan: “2000: 8468 international searches, 247 invitations; 2001: 10716 international searches, 495 invitations; 2002: 12646 international searches, 762 invitations.”

Response by Spain: “2000: 557 international searches, 4 non-unity cases, 1 invitation; 2001: 611 international searches, 6 non-unity cases, 1 invitation.”

Response by Sweden: “2000: 114; 2001: 97”

Question 2: How many of the invitations referred to in question 1 were issued in respect of international applications found to contain 10 or more inventions?

Response by Australia: “2000: 2; 2001: 4”

Response by Austria: “None”

Response by China: “1”

Response by the European Patent Office: “No records”

Response by Japan: “Not available”

Response by Spain: “2000: none; 2001: none”

Response by Sweden: “Not recorded”

Question 3: In response to invitations referred to in question 1: (i) how many additional fees were paid to your Office on average per international application in respect of which such invitation was issued; and (ii) how many additional fees were so paid on average per international application containing 10 or more inventions (see question 2)?

Response by Australia: “(i) 2000: 36%; 2001: 38%. (ii) 2000: 50% (1/2); 2001: 50% (2/4) (although one of these only paid partial fees).”

Response by Austria: “(i) 4; (ii) none”

Response by China: “(i) $3 \times 800 = 2400$ (CNY)”

Response by the European Patent Office: “(i) No precise records, but anecdotal evidence suggests additional fees are usually not paid; (ii) No records”

Response by Japan: “(i) Not available; (ii) Not available”

Response by Spain: (i) 2000: 1 invitation; 0 additional fees paid; 2001: 1 invitation; 0 additional fees paid; (ii) 2000: 0 containing 10 or more inventions, 0 additional fees paid; 2001: 0 containing 10 or more inventions, 0 additional fees paid”

Response by Sweden: “(i) 2000: 63.2 %; 2001: 56.7%; (ii) 2000: 0%; 2001: 0 %”

Question 4: In response to invitations referred to in question 1, in how many cases did the applicant pay additional fees to your Office under protest?

Response by Australia: “2000: 4; 2001: 6”

Response by Austria: “None”

Response by China: “1”

Response by the European Patent Office: “2000: 144; 2001: 167”

Response by Japan: “Not available”

Response by Spain: “2000: 1 invitation to pay additional fees, 0 paid under protest.
2001: 1 invitation to pay additional fees, 0 paid under protest

Response by Sweden: “(i) 2000: 18; (ii) 2001: 14”

Question 5: In how many of the cases referred to in question 4 did your Office order the (i) total reimbursement or (ii) partial reimbursement to the applicant of the additional fees because it was found that the protest was justified (see Rule 40.2(c))?

Response by Australia: “(i) 2000: 0/4; 2001: 3/6; (ii) 2000: 1/4; 2001: 0/6”

Response by Austria: “None”

Response by China: “None”

Response by the European Patent Office: “(i) 2000: 31; 2001: 47; (ii) 2000: 17; 2001: 16”

Response by Japan: “(i) Not available; (ii) Not available”

Response by Spain: “There are no cases”

Question 6: (to be answered only by ISAs which require the applicant to pay a fee for the examination of the protest (“protest fee”); see Rule 40.2(e)): In how many of the cases referred to in question 4 did your Office refund the protest fee because it was found that the protest was entirely justified (see Rule 40.2(e))?

Response by Australia: “Not applicable; the Australian Patent Office does not require a protest fee.”

Response by Austria: “None”

Response by China: “None”

Response by the European Patent Office: “2000 (after prior review of the justification of the invitation to pay additional fees (Rule 40.2 (e)) - not the protest itself): 6

Response by Japan: “Not available”

Response by Spain: “No protest fee”

Response by Sweden: “Not applicable”

LACK OF UNITY OF INVENTION BEFORE THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEA)

Question 7: How many invitations to restrict the claims or to pay additional fees provided for in Article 34(3)(a) did your Office issue in its capacity as an IPEA in each of the years 2000 and 2001? Please also indicate the number of international preliminary examinations carried out by your Office in its capacity as an IPEA in each of the years 2000 and 2001.

Response by Australia: “2000: 1393 IPEs conducted (total) with 2 invitations issued. 2001: 1853 IPEs conducted (total) with 6 invitations issued.”

Response by Austria: “In the years 2000 and 2001 the Austrian Patent Office as IPEA issued 2 invitations 1 for each year. In the year 2000, 199 international preliminary examinations were carried out.”

Response by the European Patent Office: “2000: 1591 invitations to restrict claims; 33609 international preliminary examinations carried out. 2001: 1447 invitations to restrict claims; 39388 international preliminary examinations carried out.”

Response by Japan: “2000: 106 invitations to pay additional fees; 4162 IPERs. 2001: 236 invitations to pay additional fees; 5163 IPERs. 2002: 292 invitations to pay additional fees; 6577 IPERs.

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not recorded”

Question 8: In how many cases, if any, in each of the years 2000 and 2001 did your Office find that the requirement of unity of invention was not complied with but choose not to invite the applicant to restrict the claims or to pay additional fees provided for in Article 34(3)(a)?

Response by Australia: “Data unavailable, but is believed to be significant”

Response by Austria: “Three (3)”

Response by the European Patent Office: “In 2000: approx. 2 100 (estimated). In 2001: approx. 2 900 (estimated).”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not recorded”

Question 9: How many of the invitations referred to in question 7 were issued in respect of international applications found to contain 10 or more inventions?

Response by Australia: “None (for both years)”

Response by Austria: “None”

Response by the European Patent Office: “No records; likely to be small given EPO’s attitude towards Article 17(2) (a)(ii) and Rule 66.1 (e) PCT”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not recorded”

Question 10: In response to invitations referred to in question 7, in how many cases did the applicant choose to restrict the claims rather than to pay additional fees?

Response by Australia: “2000: 0; 2001: 1”

Response by Austria: “None”

Response by the European Patent Office: “No records”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not recorded”

Question 11: In response to invitations referred to in question 7: (i) how many additional fees were paid to your Office on average per international application in respect of which such invitation was issued; and (ii) how many additional fees were so paid on average per international application found to contain 10 or more inventions (see question 9)?

Response by Australia: (i) 2000: 100% (2/2); 2001: 83% (5/6); (ii) none (no invitations issued on such applications in either year)”

Response by the Austria: “(i) 4”

Response by the European Patent Office: “(i) no records; (ii) no records”

Response by Japan: “(i) Not available; (ii) Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “(i) zero; (ii) not recorded (see question 9)”

Question 12: In response to invitations referred to in question 7, in how many cases did the applicant pay additional fees to your Office under protest?

Response by Australia: “None in either year”

Response by Austria: “None”

Response by the European Patent Office: “Approximately 10 per cent (estimated)”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “2000: 0; 2001: 0”

Question 13: In how many cases referred to in question 12 did your Office order the (i) total reimbursement or (ii) partial reimbursement to the applicant of the additional fees because it was found that the protest was justified (see Rule 68.3(c))?

Response by Australia: “(i) None (no protests filed); (ii) None (no protests filed)”

Response by Austria: “None”

Response by the European Patent Office: “(i) and (ii): no records for either, but only a relatively small percentage of cases where additional fees were paid under protest would result in total or partial reimbursement”

Response by Japan: “(i) Not available; (ii) Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “(i) 2000: 0; 2001: 0; (ii) 2000: 0; 2001: 0”

Question 14: (to be answered only by IPEAs which require the applicant to pay a fee for the examination of the protest (“protest fee”); see Rule 68.3(e)): In how many cases referred to in question 12 did your Office refund the protest fee because it was found that the protest was entirely justified (see Rule 48.3(e))?

Response by Australia: “Not applicable - the Australian Patent Office does not require a protest fee” (Please note: The Australian Patent Office notes that there are few protests compared with the number of invitations issued (despite there being no protest fee) and our experience suggests that the vast majority of protests we currently receive have some real basis. We therefore strongly support the opportunity to protest. We have however made a number of changes in internal procedures to streamline the invitation and protest process, including: 1. Where a large number of inventions have been identified, the applicant is

contacted by phone to ensure that the primary invention is identified before any search is conducted or any invitation issued. Reasons are provided in the invitation where the client has been previously contacted but these are not lengthy and detailed; 2. Protests are referred to a single reviewer who seeks independent technical advice from a high level examiner. The reviewer will make their decision based on that advice and the time taken to complete the second search but will only provide detailed reasons for the decision to the applicant if their protest is dismissed; and 3. Regardless of outcome of the protest, internal feedback about the review is provided to the examiner who issued the original invitation for quality and training purposes.)”

Response by Austria: “None”

Response by the European Patent Office: “Approximately 2 or 3 per year”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not applicable”

[End of Annex and of document]

WIPO



PCT/R/WG/4/4 Add.2

ORIGINAL: English

DATE: March 20, 2003

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

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

**Fourth Session
Geneva, May 19 to 23, 2003**

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

RECTIFICATION OF CLEAR MISTAKES (OBVIOUS ERRORS)

Document prepared by the International Bureau

BACKGROUND

1. At its first session, held on November 12 to 16, 2001, the Working Group discussed a proposal by the United States of America that Rule 91¹ be amended to limit the rectification of obvious errors to errors occurring in the request and to eliminate the rectification of obvious errors in the description, claims, drawings, and abstract of international applications (see document PCT/R/WG/1/4, paragraphs 8 to 12). Those discussions are summarized in document PCT/R/WG/1/9, as follows:

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

“Proposal to amend Rule 91 (see document PCT/R/WG/1/4)

“34. The comments and concerns expressed by various delegations included the following:

(i) while some delegations expressed support for the approach taken in the proposal, others felt that the correction of obvious errors should not be limited to errors occurring in the request but should continue to be possible also with regard to such errors in the description, claims and drawings; any such requests for correction should be dealt with as early as possible during the international phase rather than by individual [designated Offices] in the national phase;

(ii) noting the workload of Offices in dealing with requests under present Rule 91, it was recognized that a balanced solution would have to be found which would continue to give applicants the flexibility needed to correct obvious errors without putting too heavy a burden on Offices dealing with requests for rectifications;

(iii) noting ongoing discussions in the context of the draft [Substantive Patent Law Treaty], some delegations expressed their desire for a review of the present definition of “obvious error” under Rule 91.1(b).

“35. It was agreed that the proposal to amend Rule 91 should not be included in revised drafts to be prepared by the International Bureau, although delegations may wish to further consider the matter in the light of the discussion.”

2. For the second session of the Working Group, the International Bureau prepared a paper (document PCT/WG/2/6) outlining possible further PLT-related changes to the PCT. In relation to the correction of mistakes under PLT Rule 18, paragraph 14 of that document explained:

“Correction of mistakes

“14. The PLT sets out the requirements that a Contracting Party is permitted to apply as regards requests for correction by the Office of mistakes in respect of an application (see PLT Rule 18). In particular, it sets out the contents of the request that an Office may require; it also obliges the Office to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements. However, it does not regulate what mistakes may be corrected. PCT Rule 91.1 provides for rectification of obvious errors in the international application or other papers. However, it does not set out any requirements as to the contents of the request for rectification. It also does not require the receiving Office, International Searching Authority or International Preliminary Examining Authority or International Bureau, as the case may be, to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements.”

3. However, it was suggested “that any proposals to align the PCT with PLT Rule 18 in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority” (see document PCT/WG/2/6, paragraph 15; the

Working Group at its second session was unable in the time available to consider document PCT/WG/2/6 (see document PCT/WG/2/12, paragraph 59)).

4. During its third session, the Working Group reviewed a proposal by the Representative of the European Patent Office (EPO) that Rule 91.1(b) be amended so as to refer to a “person skilled in the art” rather than “anyone” when determining whether a rectification offered by the applicant was “obvious” under Rule 91.1(b). Several delegations supported the proposal and also expressed the view that, in general, Rule 91 was unnecessarily strict. It was agreed that the EPO and the International Bureau should work together to review Rule 91 and to submit a written proposal for consideration by the Working Group (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraph 64).

5. The Annex to this document contains proposals to amend Rule 91 accordingly, and proposals for consequential amendments of Rules 12, 48, 66 and 70. For information and clarity, the proposals for amendment of Rule 91 are presented both in the form of a “clean” text of the Rule 91 as it would stand after amendment and in the form of a marked-up text of Rule 91 as proposed to be amended.

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

RECTIFICATION OF CLEAR MISTAKES (OBVIOUS ERRORS)

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Rule 12

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

12.1 [No change]

12.2 *Language of Changes in the International Application*

(a) [No change]

(b) Any rectification under Rule 91 ~~91.1~~ of a mistake ~~an obvious error~~ in the international application shall be in the language in which the application is filed, provided that:

[COMMENT: Consequential on the proposed amendment of Rule 91 (see below).]

(i) and (ii) [No change]

(c) [No change]

12.3 and 12.4 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (vi) [No change]

(vii) any request for rectification of a mistake, any reasons and any comments referred to in Rule 91.3(d) where the request for publication under Rule 91.3(d) was received by the International Bureau before the completion of the technical preparations for international publication ~~referred to in the third sentence of Rule 91.1(f),~~

(viii) to (x) [No change]

(b) to (h) [No change]

(h-bis) If the authorization for rectification of a mistake in the international application referred to in Rule 91.1(b)(i) and (ii) is received by the International Bureau after completion of the technical preparations for international publication, either the pamphlet (containing the international application as rectified) will be republished or a statement reflecting all the rectifications will be published. In the latter case, at least the front page shall be republished

and the sheets containing the rectifications, or the replacement pages and the letter furnished under Rule 91.2(c), as the case may be, shall be published.

(i) The Administrative Instructions shall determine the cases in which the various alternatives referred to in paragraphs (g), ~~and~~ (h) and (h-bis) shall apply. Such determination shall depend on the volume and complexity of the amendments or rectifications and/or the volume of the international application and the cost factors.

(j) If the request for publication under Rule 91.3(d) was received by the International Bureau after the completion of the technical preparations for international publication, the request for rectification, any reasons and any comments referred to in Rule 91.3(d) shall be promptly published after the receipt of the request for publication, and the front page shall be republished.

[COMMENT: The proposed amendments of Rule 48.2 are consequential on the proposed change of approach with regard to the time limit within which a request for rectification of a mistake may be made; see proposed new Rule 91.2(a), below.]

48.3 to 49.6 [No change]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 to 66.5 [No change]

66.5 *Amendment*

Any change, other than the rectification of a mistake ~~obvious errors~~, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

[COMMENT: Consequential on the proposed amendment of Rule 91 (see below).]

66.6 to 66.9 [No change]

Rule 70

**International Preliminary Report on Patentability by
the International Preliminary Examining Authority
(International Preliminary Examination Report)**

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*

Each replacement sheet under Rule 66.8(a) or (b), each replacement sheet containing amendments under Article 19 and each replacement sheet containing rectifications of [a mistake](#) ~~obvious errors~~ authorized under Rule [91.1\(b\)\(iii\)](#) ~~91.1(e)(iii)~~ shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

70.17 [No change]

Rule 91 [“clean” copy]²

Rectification of Mistakes in

the International Application and Other Documents

91.1 *Rectification of Mistakes*

(a) A mistake in the international application or other document submitted by the applicant may, subject to paragraphs (b) to (e) and Rules 91.2 and 91.3, be rectified on the request of the applicant.

(b) A rectification shall be made only if it is authorized by “the relevant authority,” that is to say:

(i) by the receiving Office if the mistake is in the request;

(ii) by the International Searching Authority if the mistake is in any part of the international application other than the request, or in any amendment or correction of that application, or in any document submitted to that Authority;

(iii) by the International Preliminary Examining Authority if the mistake is in any part of the international application other than the request, or in any amendment or correction of that application, or in any document submitted to that Authority;

² Comments on particular provisions appear only in the “marked-up” copy following.

[Rule 91.1(b), continued]

(iv) by the International Bureau if the mistake is in any document, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

(c) The relevant authority shall authorize a rectification if it finds that, as at the applicable date under paragraph (d), the alleged mistake was clearly a mistake and that the meaning which would result from the proposed rectification was clearly the same as the meaning intended in the international application or other document; otherwise, the relevant authority shall refuse to authorize the rectification. In the case of a mistake in the description, the claims or the drawings, or in an amendment thereof or a correction thereof under Rule 26, that finding shall be made on the basis of what a person skilled in the art would have understood, as at the applicable date under paragraph (d), from reading the international application or the amendment or correction.

(d) For the purposes of paragraph (c), the applicable date shall be:

(i) in the case of a mistake in the international application, the international filing date;

(ii) in the case of a mistake in any other document, including an amendment or a correction of the international application, the date on which that document was submitted.

[Rule 91.1, continued]

(e) The omission of an entire element or sheet of the international application shall not be rectifiable under this Rule[, but nothing in this Rule shall prevent the inclusion under Rule 20.5 of a missing part containing an entire element or sheet].

(f) Where the receiving Office, the International Bureau, the International Searching Authority or the International Preliminary Examining Authority discovers what appears to be a rectifiable mistake in the international application or other document, it may invite the applicant to request rectification in accordance with this Rule.

91.2 Requests for Rectification

(a) The request for rectification shall be submitted to the relevant authority within the following time limit, as applicable:

(i) where the relevant authority is the receiving Office, the International Bureau or the International Searching Authority, [26] [27] [28] months from the priority date;

(ii) where the relevant authority is the International Preliminary Examining Authority, the time when that Authority begins to draw up the international preliminary examination report.

[Rule 91.2, continued]

(b) The request for rectification shall contain the following indications:

- (i) an indication to the effect that rectification of a mistake is requested;
- (ii) the mistake to be rectified; and
- (iii) the proposed rectification;

and may, at the option of the applicant, contain:

- (iv) a brief explanation of the mistake and the proposed rectification.

(c) Rule 26.4 shall apply *mutatis mutandis* as to the manner in which a rectification shall be requested.

91.3 *Authorization of Rectifications*

(a) The relevant authority shall promptly decide whether, in accordance with Rule 91.1(c), to authorize or refuse to authorize the rectification and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor.

[Rule 91.3, continued]

(b) Where the rectification is authorized by the relevant authority, it shall be made in the international application or other document concerned as provided in the Administrative Instructions.

(c) Where a rectification is authorized by the relevant authority, it shall be effective:

(i) in the case of a mistake in the international application, from the international filing date;

(ii) in the case of a mistake in another document, including an amendment or a correction of the international application, from the date on which that document was submitted.

(d) Where authorization of the rectification is refused, the International Bureau shall, upon request submitted to it by the applicant within [one month] [two months] from the date of the decision by the relevant authority, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the relevant authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of that request, of those reasons and of those comments (if any) shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

Rule 91 [“marked-up” copy]

Rectification of Mistakes in the International Application
and Other ~~Obvious Errors in~~ Documents

91.1 *Rectification of Mistakes*

(a) A mistake ~~Subject to paragraphs (b) to (g *quater*), obvious errors~~ in the international application or other document ~~papers~~ submitted by the applicant may, subject to paragraphs (b) to (e) and Rules 91.2 and 91.3, be rectified on the request of the applicant.

[COMMENT: Although the draft SPLT uses the term “correction” instead of “rectification” (see draft SPLT Article 7(3) and draft SPLT Rule 7(2)), it is proposed, in the context of PCT Rule 91, to continue to use the term “rectification” so as to maintain the distinction between “amendments” of the description, claims or drawings (under Articles 19 and 34) and “corrections” of formal defects (under Article 14 and Rule 26).]

[Rule 91.1, continued]

(b) ~~(e)~~ A ~~No~~ rectification shall be made only if it is authorized by “the relevant authority,” that is to say ~~except with the express authorization:~~

(i) by ~~of~~ the receiving Office if the mistake ~~error~~ is in the request; ;

(ii) by ~~of~~ the International Searching Authority if the mistake ~~error~~ is in any part of the international application other than the request, or in any amendment or correction of that application, or in any document ~~paper~~ submitted to that Authority; ;

(iii) by ~~of~~ the International Preliminary Examining Authority if the mistake ~~error~~ is in any part of the international application other than the request, or in any amendment or correction of that application, or in any document ~~paper~~ submitted to that Authority; ;

(iv) by ~~of~~ the International Bureau if the mistake ~~error~~ is in any document ~~paper~~, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

[COMMENT: The purpose of the proposed amendment is to clarify that “the relevant authority” referred to in paragraphs (c), (f) and (g) of Rule 91.1 and paragraphs (b), (c), (d) and (e) of Rule 91.2 is the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, as the case may be.]

[Rule 91.1, continued]

~~(c) (b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.~~ The relevant authority shall authorize a rectification if it finds that, as at the applicable date under paragraph (d), the alleged mistake was clearly a mistake and that the meaning which would result from the proposed rectification was clearly the same as the meaning intended in the international application or other document; otherwise, the relevant authority shall refuse to authorize the rectification. In the case of a mistake in the description, the claims or the drawings, or in an amendment thereof or a correction thereof under Rule 26, that finding shall be made on the basis of what a person skilled in the art would have understood, as at the applicable date under paragraph (d), from reading the international application or the amendment or correction.

[COMMENT: Noting the discussion by the Working Group at its third session, it is proposed to make the requirements under this paragraph more realistic and, in the case of a mistake in the description, claims or drawings, to refer to a “person skilled in the art” rather than “anyone” when determining whether such a mistake is rectifiable.]

[Rule 91.1, continued]

(d) For the purposes of paragraph (c), the applicable date shall be:

(i) in the case of a mistake in the international application, the international filing date:

(ii) in the case of a mistake in any other document, including an amendment or a correction of the international application, the date on which that document was submitted.

[COMMENT: A finding under paragraph (c) would thus be made: (i) where the mistake was in the description, claims or drawings: on the basis of what a person skilled in the art would have understood, as at the international filing date, from reading the international application; (ii) where the mistake was in the request: on the basis of what the person in the receiving Office in charge of authorizing the request for rectification would have understood, as at the international filing date, from reading the international application; (iii) where the mistake is in an amendment or a correction of the international application, on the basis of what a person skilled in the art would have understood, at the time on which the amendment or correction in question was submitted, from reading the amendment or correction; (iv) where the mistake is in any other document: on the basis of what the person in the relevant authority in charge of authorizing the request for rectification would have understood, at the time on which the document in question was submitted, from reading that document.]

[Rule 91.1, continued]

(e) ~~(e)~~ The omission ~~Omissions~~ of an entire element ~~s~~ or sheets of the international application, ~~even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets,~~ shall not be rectifiable under this Rule[, but nothing in this Rule shall prevent the inclusion under Rule 20.5 of a missing part containing an entire element or sheet].

[COMMENT: The words in square brackets would be included only if the proposed amendments of Rule 20 in document PCT/R/WG/4/2 relating to inclusion of “missing parts” proceed at the same time as the present amendments; otherwise, those words would need to be added at a later date when Rule 20 is amended.]

(f) ~~(d)~~ Where the receiving Office, the International Bureau, the International Searching Authority or the International Preliminary Examining Authority discovers ~~Rectification may be made on the request of the applicant. The authority having discovered~~ what appears to be a rectifiable mistake in the international application or other document, it ~~an obvious error~~ may invite the applicant to ~~present a~~ request ~~for~~ rectification ~~as provided in paragraphs (e) to (g-*quater*)~~ in accordance with this Rule. ~~Rule 26.4 shall apply *mutatis mutandis* to the manner in which rectifications shall be requested.~~

[COMMENT: Clarification only. It is proposed to move the last sentence of present paragraph (d) to proposed new Rule 91.2(b) (see below).]

91.2 Requests for Rectification

(a) The request for rectification shall be submitted to the relevant authority within the following time limit, as applicable ~~The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g bis), (g ter) and (g quater), be effective:~~

[COMMENT: It is proposed to fix a clear time limit for the submission of the request for rectification by the applicant rather than, as under present Rule 91.1(g), making the effectiveness of the authorization for rectification dependent on the timely receipt by the International Bureau of the authorization (and hence of the timely processing by the relevant authority of the request for rectification).]

(i) where the relevant authority is ~~it is given by~~ the receiving Office, the International Bureau or ~~by~~ the International Searching Authority, [26] [27] [28] months ~~if its notification to the International Bureau reaches that Bureau before the expiration of 17 months~~ from the priority date;

[COMMENT: Existing items (i) and (iii) were designed to ensure that a rectification authorized during the Chapter I procedure (if the applicant did not request international preliminary examination under Chapter II) would be included in the international application as published 18 months from the priority date, noting also that the application had to enter the national phase of processing 20 months from the priority date. Where the applicant requested international preliminary examination under Chapter II, present item (ii) provided for rectifications to be made after the publication of the application but before the applicant entered the national phase 30 months from the priority date. However, the time limit for entering the national phase under Chapters I and II is now the same, namely, 30 months from the priority date, so it does not seem necessary to maintain the present distinction between Chapters I and II in this respect. It is therefore proposed to link the time limit for rectification to the time for national phase entry in all cases. Under Chapter I, a time limit towards the end of the 30 month period seems appropriate.]

[Rule 91.2(a), continued]

(ii) where the relevant authority is ~~it is given by~~ the International Preliminary Examining Authority, the time when that Authority begins to draw up ~~if it is given before the establishment of~~ the international preliminary examination report;

[COMMENT: See the Comment concerning item (i). Where the applicant requests international preliminary examination under Chapter II, slightly different considerations apply since the International Preliminary Examining Authority will be actively processing the application. Each replacement sheet containing a rectification of a mistake authorized by the International Preliminary Examining Authority is annexed to the international preliminary examination report (see Rule 70.16 as proposed to be amended, above). The appropriate time limit therefore would be the time when the Authority begins to draw up the international preliminary examination report.]

~~(iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.~~

[COMMENT: Rectification by the International Bureau is dealt with in proposed amended item (i).]

[Rule 91.2, continued]

(b) The request for rectification shall contain the following indications:

(i) an indication to the effect that rectification of a mistake is requested;

(ii) the mistake to be rectified; and

(iii) the proposed rectification;

[COMMENT: See PLT Rule 18(1)(a)(i), (iii) and (iv). The indication under PLT Rule 18.1(a)(ii) (the number of the application or patent concerned) is not included here since the request for rectification must be in the form of, or accompanied by, a letter identifying the international application to which it relates (see PCT Rule 92.1(a)). The indication under PLT Rule 18.1(a)(v) (the name and address of the requesting party) is not included since rectification may be made only on the request of the applicant (see paragraph (d), above).]

and may, at the option of the applicant, contain:

(iv) a brief explanation of the mistake and the proposed rectification.

[COMMENT: Such an explanation would assist the relevant authority in deciding whether a rectification should be authorized. Note that Article 19(1) provides for a statement explaining amendments of the claims under that Article.]

(c) Rule 26.4 shall apply *mutatis mutandis* as to the manner in which a rectification shall be requested.

91.3 Authorization of Rectifications

(a) ~~[91.1](f)~~ The relevant authority shall promptly decide whether, in accordance with Rule 91.1(c), to authorize or refuse to authorize the rectification and ~~Any authority which authorizes or refuses any rectification~~ shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. ~~The authority which authorizes a rectification shall promptly notify the International Bureau accordingly.~~

[COMMENT: The proposed amendments would align the wording with that used elsewhere in the amended Rule.]

(b) Where the rectification is authorized by the relevant authority, it shall be made in the international application or other document concerned as provided in the Administrative Instructions.

[COMMENT: Sections 325, 413, 511 and 607 of the Administrative Instructions would have to be modified.]

[Rule 91.3, continued]

(c) Where a rectification is authorized by the relevant authority, it shall be effective:

(i) in the case of a mistake in the international application, from the international filing date;

(ii) in the case of a mistake in another document, including an amendment or a correction of the international application, from the date on which that document was submitted.

[COMMENT: Proposed new paragraph (c) would clearly spell out the effective date of a rectification once authorized.]

[Rule 91.3, continued]

(d) ~~91.1(f)~~ Where ~~the~~ authorization of the rectification ~~is~~ ~~was~~ refused, the International Bureau shall, upon request submitted to it ~~made~~ by the applicant within [one month] [two months] from the date of the decision by the relevant authority, ~~prior to the time relevant under paragraph (g bis), (g ter) or (g quater)~~ and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the relevant authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of that ~~the~~ request, of those reasons and of those comments (if any) ~~for rectification~~ shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: Under paragraph (d) as proposed to be amended, upon request of the applicant, the International Bureau would also publish information with regard to a request for rectification which was refused by the International Preliminary Examining Authority, even if the request for publication is received after international publication. This would fill a gap which exists under the present Regulations: under present Rule 91.1(f), any request for publication of information with regard to a refused request for rectification has to be received by the International Bureau prior to completion of technical preparations for international publication. In practice, this means that information concerning a request for rectification which has been refused by the International Preliminary Examining Authority after international publication is neither published nor mentioned in the international preliminary examination report: only authorized rectifications are annexed to that report (see present Rule 70.16; see also Rule 70.16 as proposed to be amended, above).]

[Rule 91.3, continued]

~~{91.1}(g *bis*) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.~~

~~{91.1}(g *ter*) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.~~

~~{91.1}(g *quater*) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.~~

[End of Annex and of document]

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Fourth Session
Geneva, May 19 to 23, 2003

FORMALITIES CHECKING UNDER THE PCT

Document prepared by the International Bureau

BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group was a proposal to reduce or eliminate formalities review procedures at both the receiving Offices and the International Bureau.

2. The Working Group's discussions on this proposal are summarized in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 41 to 43, as follows:

“Formalities Review

“41. Discussions were based on document PCT/R/WG/3/1, Annex I, item 1 (reduce or eliminate formalities review).

“42. Several delegations expressed the view that procedures relating to the checking of formalities by both the receiving Offices and the International Bureau should be reviewed so as to avoid unnecessary duplication of work and further streamline procedures. This would require consideration of many current processes, but would be

particularly relevant to procedures relating to international applications filed and processed, in the future, in electronic form.

“43. It was agreed that the International Bureau should work with interested delegations and representatives of users, using the PCT reform electronic forum, to identify:

(i) formalities checking processes that were carried out by both receiving Offices and the International Bureau, with a view to proposing changes to the Administrative Instructions and the PCT Receiving Office Guidelines to do away with any unnecessary duplication;

(ii) simplifications in the formalities review that could be progressively implemented together with the planned implementation of electronic filing and processing of international applications under the PCT.”

3. This document outlines the roles which the Treaty and the Regulations have assigned to receiving Offices and the International Bureau with regard to the checking of formalities, gives some statistical information on formal defects in international applications, and elaborates on the likely impact of recent developments (the latest Rule changes adopted by the Assembly in October 2002, the ongoing reorganization of the International Bureau's Office of the PCT and the planned implementation of electronic filing) may have on the formalities checking of international applications.

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THE ROLES OF RECEIVING OFFICES AND THE INTERNATIONAL BUREAU WITH REGARD TO FORMALITIES CHECKING

4. Before taking a closer look at how and by whom formalities checking of international applications is carried out under the present system, it is worthwhile to recall the history of the PCT so as to better understand the roles of receiving Offices and the International Bureau with regard to formalities checking.

Early Draft of the PCT

5. The 1967 draft of the PCT¹ provided that the International Bureau should be responsible for carrying out the examination of all international applications “as to form,” including compliance with what today would be referred to as filing date requirements under Article 11. Draft Article 7(1) of the 1967 draft PCT (“Examination of International Application as to Form”) provided (see document PCT/I/4, page 23):

“(1) The International Bureau shall examine the international application in order to discover whether it complies with the requirements prescribed in Article 5; however, as far as the description, claims, drawings, and the abstract, are concerned, the examination shall be limited to discovering whether they contain obvious formal defects.”

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

6. This proposal for draft Article 7(1), however, was not supported by a majority of delegations attending the first meeting of the "Committee of Experts on a Patent Cooperation Treaty (PCT)." The report of that meeting summarizes the discussion on draft Article 7 as follows (see document PCT/I/11, page 7):

"24. The majority of the Committee was of the opinion that the examination of the international application as to form should not be done by the International Bureau except when other authorities were not available, for example, when the international application is filed direct with the International Bureau. Opinions differed on who should, as a rule, do such examination. Some proposed that it be done by the searching Authorities, others that it be done by any national Office which is ready to receive and transmit international application even if such an Office is not a searching Authority. In any case, the International Bureau should set up a machinery to harmonize the practices of all authorities controlling the conformity of applications with the formal requirements of the PCT."

7. Consequently, later drafts and the final text of the Treaty and the Regulations assigned at the Washington Diplomatic Conference in June 1970 no longer provided for the International Bureau to be responsible for the examination of the international application "as to form." Rather, the receiving Offices were made responsible for the checking and processing of international applications (see Article 10), including checking for compliance with the filing date requirements under Article 11 and checking for formal defects under Article 14.

8. However, the International Bureau and, to a lesser extent, the International Searching Authorities, were given the responsibility of supporting the receiving Offices in carrying out their tasks. Procedures were put in place to ensure that certain defects noted by the International Bureau (and, in certain cases, by the International Searching Authority) were brought to the attention of the receiving Office (see present Rules 28.1 and 29.3; see also Rule 60.1(e) with regard to defects in the demand).

9. Moreover, certain other responsibilities with regard to the checking of formalities were directly assigned to the International Bureau, requiring the International Bureau to invite the applicant to correct a defect rather than calling the defect to the attention of the receiving Office. For example, where the receiving Office fails to notice that a priority claim does not comply with the requirements of Rule 4.10, it is the International Bureau's responsibility to invite the applicant to correct such defective priority claim by furnishing the required correction directly to the International Bureau (see present Rule 26bis.2; a similar provision was already contained in Rule 4.10 in the final text of the Regulations as adopted at the Washington Diplomatic Conference in 1970). Similar responsibilities have been assigned to the International Bureau later by way of amendment of the Regulations, for example, in the context of the processing of declarations referred to in Rule 4.17 (both the receiving Office and the International Bureau may invite the applicant to correct a defective declaration (see Rule 26ter.2)).

10. While the records of the Washington Diplomatic Conference on the PCT and other available documents do not expressly elaborate on the reasoning behind this division of labor between receiving Offices and the International Bureau, the "founders" of the PCT clearly were concerned about issues such as how best to ensure uniform processing of all

international applications by all receiving Offices² and “reasonably uniform international publication.”³ Moreover, it must have seemed logical in view of the division of labor between different Offices and Authorities and the International Bureau, to require the International Bureau to call a defect to the attention of the receiving Office where such defect had apparently been overlooked by that Office but had been noted by the International Bureau in the course of the processing of the international application, or to let the International Bureau deal directly with the applicant where the correction of a defect was required urgently in view of pending international publication.

Present System

11. The role of the International Bureau under the present system in respect of formalities checking may thus best be described as:

(i) supporting receiving Offices and International Preliminary Examining Authorities in carrying out their tasks with regard to the formalities checking of the international application and of the demand, respectively, in the interest, in particular, of uniform processing of all international applications and demands by all receiving Offices and International Preliminary Examining Authorities, respectively, and “reasonably uniform international publication”; and

(ii) carrying out certain formalities checks directly assigned to it, in particular with regard to defects the correction of which is required in view of the pending international publication.

12. Accordingly, the International Bureau performs a formalities check of every record copy received and:

(i) where it considers that any of the filing date requirements listed in Article 11(1)(i) to (i ii) was not complied with on the date which was accorded as the international filing date and the receiving Office had not invited the applicant to correct such defect, brings such defect to the attention of the receiving Office (see Article 14(4) and Rule 29(3));

(ii) where, in its opinion, the international application contains any of the defects referred to in Article 14(1)(a)(i) (“it is not signed as provided in the Regulations”), Article 14(1)(a)(ii) (“it does not contain the prescribed indications concerning the applicant”) and Article 14(1)(a)(v) (“it does not comply to the extent provided in the Regulations with the prescribed physical requirements”) and the receiving Office had not invited the applicant to

² See the report of the first meeting of the Committee of Experts, document PCT/I/11, page 7, paragraph 24, at the end (cited in paragraph 6, above): “In any case, the International Bureau should set up a machinery to harmonize the practices of all authorities controlling the conformity of applications with the formal requirements of the PCT.”

³ The 1968 draft of Rule 26.1(a) (which later was renumbered and became present Rule 28.1(a)) provided: “If, in the opinion of the International Bureau or of the Searching Authority, the international application contains certain defects, particularly that it does not comply with the prescribed physical requirements necessary for reasonable uniform publication, the International Bureau or the Searching Authority, respectively, shall bring such defects to the attention of the Receiving Office.”

corrects such defect, brings such defect to the attention of the receiving Office (see Rule 28.1);

(iii) where it finds that any priority claim does not comply with the requirements of Rule 4.10 and the receiving Office has failed to do so, invites the applicant to correct the priority claim (see Rule 26*bis*.2);

(iv) where it finds that any declaration referred to in Rule 4.17 does not comply with the requirements of that Rule, invites the applicant to correct the declaration (see Rule 26*ter*.2);

(v) under Chapter II, where a defect in the examination is noticed by the International Bureau, brings such defect to the attention of the International Preliminary Examining Authority (see Rule 60.1(e)).

13. Since record copies are usually received by the International Bureau together with copies of the invitation to correct formal defects sent by the receiving Office to the applicant, the International Bureau is in a position to see which defects, if any, the receiving Office had noticed and invited the applicant to correct. It is thus ensured, in accordance with the Regulations, that the International Bureau brings only those formal defects to the attention of the receiving Office which had been overlooked by that Office, or that the International Bureau invites the applicant to correct a defect only where the receiving Office had failed to do so.

Occurrence in Practice of Defects Found by the International Bureau

14. The following figures regarding defects noticed by the International Bureau and, in accordance with Rule 28.1, called to the attention of the receiving Office concerned illustrate the role of the International Bureau in the formalities checking of international applications.

15. In 2002, the International Bureau received a total number of 84,102 record copies of international applications filed with the five biggest receiving Offices acting under the PCT, that is, the United States Patent and Trademark Office, the European Patent Office, the Japan Patent Office, the United Kingdom Patent Office and the German Patent Office. In respect of those 84,102 record copies, the International Bureau noted a total of 59,900 defects, which apparently had been overlooked by the receiving Office concerned, and brought those defects to the attention of that Office or, where the International Bureau has the authority to do so, directly invited the applicant to correct the defect.

16. Most of the defects noted by the International Bureau and brought to the attention of the receiving Office concerned fell in one of the following three categories:

(i) the international application was not signed as provided in the Regulations (see Article 14(1)(a)(i)) (32,540 defects related to missing or defective powers of attorney; 4,142 defects related to missing or defective signatures);

(ii) the international application did not comply to the extent provided in the Regulations with the prescribed physical requirements (Article 14(1)(a)(v)) (10,774 defects related to drawings; 1,606 defects related to description, claims or abstract; 2,214 defects related to the title of the invention (in particular, discrepancy between request and description); 114 defects related to the request; 237 missing abstracts);

(iii) the international application did not contain the prescribed indications concerning the applicant (see Article 14(1)(a)(ii)) (3,329 defects related to addresses and indications concerning nationality and residence of the applicant).

17. In addition, the International Bureau noted a total of 4,944 "other" defects (in particular, defects related to priority claims and declarations referred to in Rule 4.17) in respect of most of which the International Bureau invited the applicant to correct the defect rather than bringing the defect to the attention of the receiving Office.

18. Overall, more than 60% of all defects noted by the International Bureau related to signature requirements (in particular, missing powers of attorney), about 25% related to physical requirements of the international application (in particular, drawings), more than 5% related to defects relating to indications concerning the applicant, and more than 8% related to "other" defects.

IMPACT OF RECENT DEVELOPMENTS ON FORMALITIES CHECKING

19. A number of recent developments will likely have a substantial impact on the formalities checking of international applications by receiving Offices and the International Bureau, as outlined in the following paragraphs.

Rule Changes Adopted by the PCT Assembly in October 2002

20. In October 2002, in the context of the overhaul of the designations system, the PCT Assembly adopted amendments to the PCT Regulations which likely will have an immediate and considerable impact on formalities checking of international applications, in particular with regard to defects related to signature requirements (see paragraph 16(i), above) and furnishing of indications concerning the applicant (see paragraph 16(iii), above), which in 2002 made up more than 65% of all defects noted by the International Bureau and called to the attention of the receiving Office concerned.

21. In order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide signatures and indications in respect of all applicants (where there are two or more), under the amended Regulations as in force from January 1, 2004, it will be sufficient that the request be signed by at least one applicant and that indications be provided in respect of at least one applicant who is entitled under Rule 19 to file the international application with the receiving Office concerned. Moreover, as of January 1, 2004, whereas sole applicant is represented by an agent, or where all co-applicants are represented by a common agent or a common representative, the receiving Office, the International Searching Authority, the International Preliminary Examining Authority and the International Bureau will be entitled to waive the requirement that a separate power of attorney be submitted.

22. Consequently, as of January 1, 2004:

(i) where there are two or more applicants, the receiving Office will no longer be required to invite the furnishing of missing signatures if the request is signed by at least one applicant (see Rule 26.2*bis* as in force from January 1, 2004); this should dramatically reduce the number of defects related to signature requirements, the number of invitations to be issued by the receiving Office and, consequently, the number of cases in which the International

Bureau has to bring such defect to the attention of the receiving Office (see paragraph 16(i), above);

(ii) where there are two or more applicants, the receiving Office will no longer be required to invite the furnishing of missing indications with regard to address and nationality and residence, or the correction of defective indications, if such indications are furnished in respect of at least one applicant who is entitled to file the international application with the receiving Office concerned; this should dramatically reduce the number of defects related to indications concerning the applicant, the number of invitation to be issued by the receiving Office and, consequently, the number of cases in which the International Bureau has to bring such defect to the attention of the receiving Office (see paragraph 16(iii), above);

(iii) the receiving Office may waive the requirement that a separate power of attorney be submitted, in which case a missing power of attorney would no longer be considered a defect and thus no invitation would have to be issued by the receiving Office.

Reorganization of the Office of the PCT

23. In the context of the ongoing project to automate PCT operations at the International Bureau (the IMPACT project), a new organizational structure and new and more efficient business processes have been introduced within the Office of the PCT. The Office of the PCT has moved away from the previously rigid and task-specific hierarchical organizational structure and adopted a team-oriented approach, resulting in a more flexible organizational structure that will allow for innovative new functions and services to be introduced over time, with a view, in particular, to improving the day-to-day operational cooperation between the International Bureau and receiving Offices, International Authorities and designated/elected Offices.

24. Under the new organizational structure, small processing teams have been put in place, each being responsible for the processing of record copies received from a limited number of particular receiving Offices. In each processing team, experienced senior staff will act as points of contact for questions by applicants, receiving Offices, International Authorities and designated/elected Offices relating to international applications processed by that team, with the aim of providing a superior level of customer-oriented service. So as to improve the day-to-day cooperation between each processing team and "its" receiving Office, particular emphasis will be put on training, advice and support, and personal contacts between staff in receiving Offices and the processing teams. It is hoped and expected that these measures will lead to a more uniform and efficient processing of international applications by all receiving Offices and the International Bureau, including uniform international publication.

25. In this context, it is to be noted that one of the processing teams, namely, the processing team which processes record copies received from the International Bureau as receiving Office, has started a pilot study, together with the staff from the International Bureau as receiving Office, to identify inefficiencies and unnecessary duplication of work in the formalities checking processes that are carried out by both the International Bureau as receiving Office and the International Bureau (proper), with a view to introducing simplified and more efficient business processes in the day-to-day cooperation between all receiving Offices and the International Bureau. It may be worthwhile to consider whether a similar study should also be carried out with regard to further simplifications in the formalities review of international applications filed in electronic form.

Filing and Processing of International Applications in Electronic Form

26. Filing and processing of international applications and related documents in electronic form has become possible and will inevitably change the way in which Offices, Authorities and the International Bureau process international applications. Modifications of the Administrative Instructions under the PCT designed to enable the implementation of electronic filing and processing of international applications and related documents entered into force on January 7, 2002. The modifications (Part 7 and Annex F of the Administrative Instructions) contained, respectively, the necessary legal framework and technical standard. In November 2002, the European Patent Office as receiving Office received the first international application filed in electronic form. PCT-SAFE, the electronic filings software being developed by the International Bureau as an extension of the PCT-EASY software, will be made available to applicants and receiving Offices later this year. In the context of the checking of formalities, it is of particular interest to note that:

(i) the PCT-SAFE electronic filings software will contain approximately 200 validations; the validation function is used to check and confirm that data entered by the applicant are consistent and meet the PCT requirements for according an international filing date as well as formality requirements, avoiding mistakes made by the applicant before the international application is filed;

(ii) compliance of the body of the international application (description, claims, abstract) with certain physical requirements (such as margins, writing of text matter, numbering of sheets, etc.) in the interest of "reasonable uniform international publication" will be of less importance, given that the body of the international application will be in fully electronic form and thus can be brought into any required format or shape for the purposes of international publication;

(iii) receiving Offices, when performing the formalities check, will benefit from the automated validation functions of the software, automatically detecting defects still contained in the international application.

REVIEW OF FORMALITIES CHECKING PROCESSES CARRIED OUT BY BOTH RECEIVING OFFICES AND THE INTERNATIONAL BUREAU

27. In light of what has been outlined above, the Working Group, when reviewing the formalities checking processes that are carried out by both receiving Offices and the International Bureau, may wish to consider the following questions:

(i) In the context of formalities checking, is the "division of labor" between the receiving Offices and the International Bureau as envisaged by the "founding fathers" of the PCT and provided for in the Regulations still appropriate?

(ii) Are the issues of "uniform international processing of all international applications by all receiving Offices" and "uniform international publication" still of concern?

(iii) Do the formalities checking processes that are carried out by both receiving Offices and the International Bureau add any value to the system, in particular, from the applicant's point of view, or do they constitute an unnecessary duplication of work which should be avoided and done away with?

(iv) In view of the likely impact of the Rule changes adopted in October 2002 and the ongoing "pilot study" by the International Bureau on formalities checking processes (see paragraph 25, above), should proposals for changes to the Regulations, the Administrative Instructions or the Receiving Office Guidelines be included in the work program of the Working Group now, or should such proposals await the likely impact of these Rule changes and the results of the pilot study?

28. *The Working Group is invited to consider the issues raised in this document.*

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(PCT UNION)

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

Fourth Session
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OPTIONS FOR FUTURE DEVELOPMENT OF
INTERNATIONAL SEARCH AND EXAMINATION

Document prepared by the International Bureau

BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform which had already been submitted to the Committee on Reform of the PCT ("the Committee") or to the Working Group but not yet considered in detail, and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group were proposals related to international search and preliminary examination (see the Summary by the Chair, document PCT/WG/3/5, paragraphs 87 to 94). The Working Group agreed that the International Bureau should prepare, for discussion at its next session, an options paper on possible future development of the international search and examination system, including options whereby designated Offices, particularly smaller designated Offices, could derive great benefit from the results of the international phase.

2. This document outlines possible options for the future development of international search and examination. The Working Group is invited to discuss the options with a view to identifying possible features of the future PCT search and examination system as starting points for further consideration by the Working Group.

REFORM OF INTERNATIONAL SEARCH AND EXAMINATION SO FAR

3. So far, discussions in the Committee and the Working Group, including discussions on a possible future PCT search and examination system, have focused on changes which could be made through amendments to the Regulations rather than a revision of the Treaty itself. The result was the enhanced international search and preliminary examination system that was adopted by the PCT Assembly at its 31st (18th extraordinary) session, held from September 23 to October 1, 2002 (see document PCT/A/31/10, paragraphs 45 to 48 and Annex V), which will be implemented from January 1, 2004.

4. Certain features of the recently adopted changes reflect the existing provisions of the Treaty concerning international search and examination. Different approaches would be available if an entirely new system were to be created without constraint by those present limitations, for example:¹

(i) the Treaty is based on a distinct separation between the compulsory international search procedure (under Chapter I of the Treaty) and the optional (both for applicants and for Contracting States) international preliminary examination procedure (under Chapter II); however, the recently adopted enhanced international search and preliminary examination system provides (with effect from January 1, 2004) for the compulsory establishment of a written opinion by the International Searching Authority which is equivalent, in effect, to the first written opinion of the International Preliminary Examining Authority;

(ii) the Treaty limits the scope of the international preliminary examination report (see Article 35(2)) in a way which, while not entirely precluding comments on certain matters that may be applicable in some States but not others, reduces the possibility of establishing a report which caters for different needs; it also does not envisage procedures which might be used by an Authority which wished to perform national examination on the application simultaneously with international preliminary examination.

5. In view of these and other limitations presently imposed by the Treaty, the enhanced international search and preliminary examination system as adopted by the Assembly represents a good balance of different interests for the present, without amending the Treaty itself. Of particular note is that it provides a reasoned opinion on novelty, in inventive step and other matters for almost all international applications, which is useful for designated Offices, particularly smaller Offices and Offices with no capacity for search and examination, especially in developing countries. However, while some significant further changes might be achieved through amendment of the Regulations only, it seems likely that any further fundamental changes could be achieved only through a revision of the Treaty itself.

¹ References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "Chapter I" and "Chapter II" are to those of the PCT. 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.

POSSIBLE FEATURES OF A FUTURE INTERNATIONAL SEARCH AND EXAMINATION SYSTEM

6. While this document looks at possible features of a future system for international search and examination under the PCT, it must be remembered that the PCT operates in the more general context of the international patent system as a whole, and that there are inevitably more general implications in that broader context when fundamental changes to the PCT system are being considered. For example, some of the objectives of reform of the PCT formulated by the Committee were:

(i) “reduction of costs for applicants, bearing in mind the differing needs of applicants in industrialized and developing countries, including individual inventors and small and medium-sized enterprises as well as larger corporate applicants;”

(ii) “avoiding unnecessary duplication in the work carried out by PCT Authorities and by national and regional industrial property Offices;” and

(iii) “ensuring that the system works to the advantage of all Offices, irrespective of their size”

(see document PCT/R/1/26, paragraphs 66(ii), (iv) and (v) respectively). The desire by some Offices to bring together, so far as possible, the international and national processing of an application provides another example. It is particularly important to consider how the international system will work in harmony with, and to the benefit of, the systems in developing countries and States with non-examining Offices. For these States, the international system should be able to produce search and examination reports which are of maximum benefit at a national level, reducing the likelihood of invalid patents being granted, including in the case of registration systems.

7. Many of the possible options for change to the international search and examination system would appear to require revision of the Treaty or the addition of optional protocols to it (see document PCT/R/WG/3/3 which outlines options for a possible revision of the Treaty itself). Amendments or protocols to the Treaty which add features which are optional and purely complementary to the existing system could be implemented relatively quickly since they would not need to be ratified by all States before they came into force, but only by those States which wished to be bound by them. However, it is unlikely that changes of this sort could be used to change the way international search and examination itself is conducted, since this would almost inevitably result in a need for Authorities to draw up reports or opinions according to different standards for use in the various Contracting States, depending on whether or not they had ratified a particular protocol, and might require the applicant to formulate alternative versions of the international application, neither of which would be practical.

INTERESTS TO BE CONSIDERED

8. In order to be effective, the system must meet the needs of a number of different stakeholders. Though these have different interests, this does not always mean that their wishes for aspects of the system conflict; while some of their interests have to be balanced against one another, others are complementary:

(i) *inventors and applicants*: want the PCT system to be cheap and flexible enough to meet different wishes regarding timing and quality; some wish to use the international system primarily to delay the cost of entry into the national phase; others wish to take the maximum possible advantage of search (in particular) and examination, ensuring that the application has a high presumption of validity in the forum in which it enters the national phase;

(ii) *national Offices (in their role as designated or elected Offices) and administrations*: generally want the PCT system to deliver timely reports of high quality and relevance to the national phase, particularly in the case of smaller Offices and Offices with no capacity for search and examination, especially in developing countries;

(iii) *third parties, including consumers and competitors*: want the PCT system to be fast; reliable, with the end result having the maximum possible legal certainty in all Contracting States; and transparent, giving as much information as possible about the processing, such as through publication of the international application and the availability of the reports of the Authorities;

(iv) *administrators of the international system (particularly receiving Offices, International Authorities and the International Bureau)*: want a PCT system where it is realistic for them to provide the defined service in all respects of function, quality and timing within their financial and manpower limits.

9. When an amendment of the Treaty itself is considered, the new system, as a whole, needs to provide sufficient benefits for all stakeholders to justify the considerable upheaval involved. Search and examination lie at the very heart of the international patent system, both during the international phase of the PCT and during the national phase grant procedure. While it is likely that many aspects of the current system would be retained, it is appropriate to consider objectively which parts of the current system are essential, what might be done more efficiently, and what could be omitted altogether in a system being designed from a new and broader international perspective. The system should also allow flexibility in processing, leaving as much detail as possible to the Regulations, Administrative Instructions or to guidelines, recognizing that the needs of the system in another 25 years' time may not be the same as those today.

THE ESSENTIALS OF A NATIONAL OPTION FOR INTERNATIONAL SEARCH AND EXAMINATION

10. The fundamental nature of patent search and examination, including international search and examination under the PCT, is well established and widely accepted, and is unlikely to change: an examiner attempts by a search to discover the prior art which is most relevant to a claimed invention and, using the results of the search, determines whether the application meets defined standards in respect of novelty, inventive step and other matters. However, within this broad scope, there is room for consideration of most of the details concerning when, whether, where, how, and according to what criteria, search and examinations should be carried out on an international application. In addition, the effect of any search and examination should be considered with respect to the future life of the patent application, both internationally and under the different national systems in which it may have effect, including those in developing countries and States without examining Offices. Some of these aspects are further explored in the following paragraphs.

THE RESULT OF SEARCH AND EXAMINATION

11. The present system provides for the establishment of a mandatory international search report, typically around 16 months from the priority date, and an optional international preliminary examination report, typically around 28 months from the priority date.
12. The objective of the international search is to discover relevant prior art. As a principle, the only question which need be asked for this is whether the definition of “relevant prior art” is appropriate to the needs of any international examination and, in turn, of the national and regional systems under which patents may eventually be granted. Of course, in attempting to achieve the objective, practical matters such as timing of the search, the documentation considered and the methodology of the search need to be considered; some of these issues are raised below.
13. The international preliminary examination report always contains an opinion on novelty, inventive step and industrial applicability, as defined in the Treaty, and, depending on the practice of the Authority concerned, may contain an opinion on a range of other matters including defects in form or contents, whether amendments go beyond the disclosure in the application as filed, clarity of the description, claims and drawings, and whether the claims are fully supported by the description.
14. The objective of the international preliminary examination is expressly to formulate a “preliminary and non-binding” opinion on the criteria of novelty, inventive step and industrial applicability. The Treaty also makes it expressly clear that Contracting States have freedom to apply additional or different criteria when deciding whether an invention is patentable or not (Article 33(5)), that the international preliminary examination report is not to contain any statement on the question whether the invention is or seem to be patentable or unpatentable under any national law (Article 35(2), and, more generally, that nothing in the Treaty is intended to limit the freedom of Contracting States to prescribe their own criteria in respect of substantive conditions of patentability (Article 27(5)).
15. That being said, the PCT criteria in fact differ little from the criteria for patentability applicable to patent applications and patents under national and regional patent laws, and according to which examination reports are prepared by those Offices which conduct substantive examination applications. It needs to be recognized, of course, that there are differences among substantive patent laws as to the meaning and application of those criteria, but it must equally be acknowledged that there is also a great degree of commonality (even without any further harmonization that may come as a result of the ongoing discussion of a draft Substantive Patent Law Treaty by WIPO’s Standing Committee on the Law of Patents).
16. The terms “preliminary” and “non-binding” used in the PCT to describe the international preliminary examination procedure are closely related but nevertheless distinct from one another. “Non-binding” means that States are free to accept or reject the result of the examination. The term “preliminary,” on the other hand, suggests that there may be further work left to do before a complete view on patentability can be taken. It is possible that the non-binding nature of the procedure could be maintained while at the same time enhancing the possibilities for an applicant to obtain an opinion which is “more final” (or at least “less preliminary”) in the sense that there could be greater opportunities for obtaining a fully positive report before entering the national phase of processing.

17. Most applicants using the international patents system would like to see a positive international search and examination report be followed by international grant, whether as a true international grant or as national grants following more or less automatically from such a report – that is that both the preliminary and then on – binding natures of the international examination would be reduced. However, there are significant political and practical difficulties which would need to be overcome for this to happen, other than by the more widespread acceptance by national Offices unilaterally that a positive international examination report will normally mean that an application is in order for national grant. Some of the wishes and challenges are set out in greater detail in paragraphs 187 to 199 of document A/37/6 (“WIPO Patent Agenda: Options for Development of the International Patent System”). For the purposes of this document, it is merely necessary to note the general points set out in the following paragraphs.

18. Substantive patent laws are not fully harmonized and it is neither practical nor desirable for an international system to cater specifically for each individual national law. Consequently, it might be considered that any international examination will inevitably be “preliminary,” unless the national definition of patentability happens to coincide exactly with the standards applied to international examination. However, in practice, as pointed out above, the variation in laws in most respects, including novelty and inventive step, are small. Furthermore, it may be possible to allow international examination reports to make comments on a strictly limited range of options within less harmonized matters which are particularly likely to affect national laws which are not presently commented on (see Article 35(2) and Rules 66.2 and 70.12, as well as paragraph 31, below); for example, whether claims relate to surgical methods, plants or animals (in the case that the Authority carries out search and examination in relation to such matter – otherwise the matter is in any case explained as the reason for which search or examination has not been carried out). This could make an international examination report more useful, particularly to States which apply these types of exclusions. While this would, of course, make international examinations slightly more complex, it could eliminate the need for separate subsequent consideration in many States, provided that any claims which failed to meet criteria relevant under their particular law were abandoned before grant in the State concerned.

Granting national patents

19. Even if the examination can be improved so that it is less preliminary in nature, it is likely to be essential for the foreseeable future that it remain, in general, non-binding, leaving the decision on whether or not to grant a patent to the national Office of each State. On the other hand, it would remain open to States to make the system more efficient by choosing to accept the results of international examination. This could be done informally simply by unilaterally deciding to grant patents on the basis of a positive international examination report (or one which reported only potential defects which are not in fact relevant to the law of that State). Alternatively, an optional chapter or protocol could be added to the Treaty, providing a formal agreement to the same effect. Some of the possibilities are set out below.

20. One possibility is simply the formalization of the process, which is already common in many States, whereby a positive international examination report would result in automatic grant in participating States, subject to completing formalities such as payment of fees and provision of any necessary translation. Alternatively, as systems similar in some way to that

under the Madrid Protocol² could be used, where in an application which was found to meet the appropriate criteria would be the subject of an international grant, which had an equivalent effect to grant in a participating national Office, subject to the right of each State to subsequently cancel the grant within a certain period if it was found to fail to meet the relevant national criteria (in addition, of course, to forms of proceedings for revocation after grant which might apply to conventional domestic patents).

21. In either case, if the international examination report was enhanced to include a statement of whether the subject matter of the application related to any of the areas where conditions of patentability commonly differ significantly (for example surgical methods, plants or animals), each State could make reservations in respect of such subject matter, so that applications where such matter had been noted in the examination report would not be subject to the automatic or central grant procedure in respect of that State.

22. Such a system could be of particular benefit to smaller Offices, including those in developing countries. This would allow them to implement a system where fewer patents would be granted which failed to meet the national criteria for patentability and, where appropriate, allow them to focus the resources of their national Office on the limited number of applications where the report indicated that a condition which is relevant to the national law may exist.

23. If a formal system of recognition were adopted, it might also be appropriate to consider the introduction of an international opposition system, which again might be possible through the use of protocols. This possibility is not discussed in detail, but some of the advantages would be similar to those considered above in respect of international examination at a later stage of granted patents (see paragraphs 40 to 43, below).

ACTIONS PERFORMED AS PART OF SEARCH AND EXAMINATION

24. As noted above, changes could be introduced to make the results of international search and examination more useful. Some such options are considered below. While it appears that these could, at least in part, be implemented by amendments to the Regulations under the existing Treaty, it is, at present, not intended to introduce proposals for amendments only of the Regulations, in particular in view of the facts that they would introduce extra work for International Authorities, which the Committee on Reform of the PCT considered inappropriate at the present time and noting that their benefits may be achieved most effectively only in cooperation with other enhancements, which would require amendments, or a protocol, to the Treaty.

Multiple searches; additional examination

25. The Committee on Reform of the PCT, in its first meeting, considered the question of allowing applicants the option of requesting searches by several International Authorities (see document PCT/R/1/26, paragraphs 109 to 146). While there was some support, the general conclusion was that this was undesirable duplication of work and inappropriate, at least while some International Searching Authorities had difficulties with existing workloads. For the moment, it would be better to concentrate on improving the search tools available and

² Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

promoting consistency. It was noted that applicants were at liberty to commission further searches outside of the PCT system if they wished.

26. However, considering the longer term, a number of States pointed out that systems could be arranged where additional searches clearly added value. For example, it may sometimes be desirable for searches performed by the European Patent Office or the United States Patent and Trademark Office to be supplemented by a “complementary search” performed by the Japan Patent Office or Rospatent of their Japanese or Russian language collections, respectively. If such a system were introduced, it might also be desirable for an Authority performing such an additional search to include an opinion on how any new documents found, which did not have equivalents in the main search report, affected the novelty or inventive step of the application. Such an opinion might then be annexed to the opinion produced by the main Authority, without the difficulty of the confusion which would be caused by a complete new opinion. It is likely that such additional searches and written opinions could be provided for by means of amendments to the Regulations under the existing Treaty.

“Top-up” searches

27. As pointed out above, international search at present typically takes place around 15 months from the priority date of the application. As long as the international application’s priority date is valid, this is usually adequate for determining novelty and inventive step in relation to the prior art defined by Rule 64.1, since only material published before the “relevant date” may be considered. However, in most States, patent documents published after that date may also be relevant to novelty and/or inventive step if they have an earlier priority date. This can be extremely important in many fast-moving technologies.

28. Rules 33, 64.3 and 70.10 make some allowance for inclusion of such documents within the reports. However, at the time that international search is performed, these documents may not yet have been published, or else might otherwise not have become available to the International Authority. A “top-up” search at a later stage in the international phase may eliminate the need for this check to be made by individual States and allow relevant documents to be brought to the attention of applicants at a point where appropriate amendments can still be made and examined centrally, if so desired, making the international preliminary report on patentability more useful for both applicants and Offices of elected States, particularly non-examining Offices. Performing the entire search at this stage would of course eliminate this extra step. However, it should be noted that this would also delay the start of examination; furthermore, many users of the system value these search reports being available before international publication for the applicant and being part of the international publication for informing third parties (see paragraph 36). The increasing use of electronic publication means that associating searches (whether original searches or top-up searches) with international publications which occurred earlier will, however, become easier in the future.

29. It is likely that top-up searches could also be introduced as a part of the international preliminary examination procedure by means of amendments to the Regulations under the existing Treaty. This would need to be accompanied by a review of the “other observations” which may accompany the international preliminary examination report according to the regulations made under Article 35(2).

Scope of examination reports

30. The primary function of the international preliminary examination report is to provide an opinion on novelty, inventive step and industrial applicability, as defined by the Treaty. While the tests for these requirements differ slightly around the world, in practice, it would appear that there is very little difference in the outcomes of these tests in any particular case. On the other hand, there are other areas where the differing tests, although relevant only to a small minority of patent applications, have very significant differences with regard to patentability in different States. Examples of this include patents for surgical methods, plants or animals and views on what constitute technology.

31. Clearly, greater harmonization of national patent laws would make it easier for the PCT to provide examination reports which were closely aligned with national requirements. However, in the meantime, without going into the individual laws of each State, it may be desirable for international examination reports to comment on such aspects where practice varies. At present, Rules 39 and 67 set out certain subject matter which International Authorities are not obliged to search or examine, which cover most, if not all, of the relevant areas. Where the Authority chooses not to perform a search or examination, this will be explained. However, in the case that a search or examination is carried out, there may be no indication in the international preliminary report on patentability that the application may be considered to contain such subject matter. A readily identifiable indication that the patent does not relate to potentially excluded matter need not be a great burden for the International Preliminary Examining Authority and may give States greater confidence in using the results of the international examination directly, or, where appropriate, in identifying those cases where greater scrutiny of the application in accordance with the relevant national law is likely to be necessary. This would clearly be beneficial to States where such limitations exist and which have non-examining Offices, and could also be used to reduce the burden on examining Offices. Such a change may be possible simply by amending the Regulations (primarily Rules 66 and 70).

TIMING OF SEARCH AND EXAMINATION

32. The timing of search and examination is not a fundamental principle of patent law but is fixed according to a balance of interests that need to be viewed in the light of the conditions of the time. Consequently, it would be desirable for a revised Treaty to merely establish the fundamental criteria that an international patent application is expected to meet, leaving the Regulations to determine the timing and the extent to which these conditions must be tested during the international processing of the application.

33. The amendments adopted by the Assembly in 2002 recognize that it is significantly more efficient to perform the first examination of a patent application at the same time that it is searched. It is unlikely that changes in methods of working will change that conclusion in the future. However, questions of timing, with regard to both the start of the process and whether search and examination are performed together, or whether they are essential in all cases, need to take several further issues into account, as outlined in the following paragraphs.

Does every patent application need to be searched and examined?

34. At present, an international search is carried out on every international application and, under the enhanced international search and preliminary examination system, a first examination report will also, in effect, be carried out on every application. However, by no means all patent applications have significant commercial value, and for those which are commercially unimportant to patentees and third parties, a great deal of work is therefore performed in ensuring that patents are valid covering inventions which no competitor would in any case wish to exploit. Some States have patent systems where unexamined rights are registered, requiring examination only when it is desired to enforce the rights or on request by a third party who wants to be certain of the scope of those rights.

35. The PCT needs to offer an efficient route of access to patent systems in all of the Contracting States, taking into account the different forms which exist. At the moment, the requirement of full search and examination in all cases for a significant number of States suggests that as much of this work as possible ought to be done in the international phase to avoid duplication. However, as part of a wider review of patent procedures in coming years, States may wish to consider the degree to which full search and/or examination of every patent application is essential prior to grant. Without reviewing in this paper the questions concerning balancing efficient processing and certainty for both applicants and third parties, which would affect the outcome of any such national review, it may be prudent to create a framework which could be adjusted to provide the international system which overall best suits the national frameworks into which it feeds, whatever these may be at the time.

Importance of early search

36. Users stress that, for international applications which are likely to be commercially valuable, it is particularly important, both from the point of view of applicants and third parties, to ensure that a high quality international search report is established before international publication and that timely issuance of the international search report should not be delayed by other processing requirements.

Should (full) international examination be compulsory?

37. A significant proportion of users at present do not wish to pursue international examination and have called for this part of the PCT procedure to remain optional, rather than tying the examination even more closely to international search. It may be observed that the recently adopted amendments to the system effectively make at least the early stages of international examination compulsory. On the other hand, many States, particularly developing countries and those without (national or regional) examining Offices, wish to see full international examination of a large proportion of, or even of all, international applications. It would seem most appropriate to overcome this apparent conflict of interests by seeking to strengthen the international phase, including international examination, rather than weakening it, such that States would be more likely to accept the results of the international procedure without further unnecessary examination in the national phase; use of the PCT system with a strengthened international phase would thus become the most efficient and desirable way for applicants to gain rights internationally.

Overall timescale of international phase

38. The amount of time which the international applications spend in the international phase before having to be converted into national applications is, again, a balance of interests. One of the major benefits of the system to applicants is that it provides a significantly longer period than the Paris Convention route to consider the importance of the invention (having regard to its novelty and inventive step, possible further developments and other matters of commercial viability) before committing to the time and expense of preparing national applications. It is also necessary to consider how long is required to perform effectively any international search and examination. Against this is the desire of third parties to know at the earliest opportunity what the scope of protection will be and in which States protection will exist.

39. Given that, in many States, further national examination must take place before any patent is granted, this final point suggests that it would be difficult to justify any significant further extension of the international phase in its current form. However, this might change if improvements to the international examination were introduced such that the time involved in national processing could be reduced, or even perhaps in some cases eliminated, with national patents being granted with little or no extranational examination, as is described in paragraph 19, above. If the international phase were to be extended to achieve such a purpose, it might lead overall to earlier certainty in the scope of rights granted around the world following from the international application.

The possibility of international (re-)examination during the national phase

40. States may also wish to consider whether, and if so in which cases, the Treaty should allow for international examination at a later stage, following national phase entry, for example, following the discovery of prior art which was not found during the international search. It is likely that this would be an optional service, in the sense that it would remain up to individual States to decide whether to use the service and what recognition, if any, should be given to the results of such a later examination.

41. International examination of granted patents, or of applications in respect of which national processing had already begun, would mean the end of the current arrangement where the international and national phases are, at least for the vast majority of international applications, relatively distinct. Properly implemented and used, this could have significant advantages for patentees and third parties alike, allowing reassessment of patents in the light of previously undiscovered prior art, and the opportunity to make appropriate amendments centrally, thereby avoiding expensive litigation.

42. Furthermore, such a system could be of particular value to developing countries and small Offices which may not have the capacity to make such assessments and could be a significant aid to national courts in providing a neutral opinion as to validity when cases do go to court. On the other hand, it would imply a significant change of approach in States where, under the present system, significant examination is commonly undertaken during the national phase, requiring applications to be brought into a form different from that of the international application which has been the subject of a positive international preliminary examination report before a patent is granted. Careful study would be required to determine whether and, if so, how national and international systems could work effectively in parallel. Other complicating factors would also need to be considered, such as that the patents in different

States may have been assigned to different people, whomay have different views on the need for re-examination, or the appropriate way in which to overcome any difficulties which were raised.

43. International examination at a later stage need not necessarily be limited to applications which had begun as international applications. In the same way that Article 15(5) at present allows for the possibility of an "international -type search" the provisions might be extended to allow international -type examination of national patents. This would allow uniform treatment of patents in States with non -examining Offices, irrespective of whether applications had been made by the national or international route.

Means of effecting changes in timing and optional nature

44. At present, the Treaty makes it clear that, subject to very limited exceptions, an international search is mandatory for all international applications and that full international preliminary examination takes place only at the demand of the applicant. Any change to this would require an amendment to the Treaty. On the other hand, the timing of international search and, where a demand is made, international preliminary examination are set out in the Regulations and could easily be amended, within the limits imposed by the requirements of the Treaty.

45. In the case of introducing international (re -) examination at a later stage, this could be done in two ways. It could be the subject of an amendment to the Treaty. Alternatively, since, as noted above, it would necessarily be an optional process, which need not have effect in all Contracting States, it could be the subject of an optional protocol, to be ratified by those States which wished to use the results. In either case, an amendment would also be required to the agreement between the International Bureau and at least one International Authority prepared to carry out such new work.

QUALITY AND CONSISTENCY OF INTERNATIONAL SEARCH AND EXAMINATION

46. Consideration will also need to be given to whether any revision of the Treaty would need to update provisions concerning the quality and consistency of international search and examination under the PCT system, such as allowing for ensuring the application of common standards and development or use of common tools and databases for search. However, this paper does not address these issues in detail, pending the outcome of current related initiatives, such as the work of the PCT quality framework "virtual" task force and the consideration by the Meeting of International Authorities under the PCT of the minimum documentation requirements and new draft International Search and Preliminary Examination Guidelines.

EXAMPLES OF POSSIBLE SYSTEMS

47. The Annex to this document sets out a number of simple examples of possible systems, illustrating different ways of approaching some of the issues outlined in this document. Each example assumes that applications will be published 18 months from the priority date which, of course, might itself be reviewed as part of the creation of any revised system. All examples consider a "typical" application, based on a priority application 12 months before the filing date and not taking into account complications such as divisional applications. Such other

factors would, of course, need to be addressed in tandem with any detailed proposals for revision of the search and examinations system.

48. The Working Group is invited to consider and discuss options for the future development of the international search and examinations system, having due regard to the matters raised in this document.

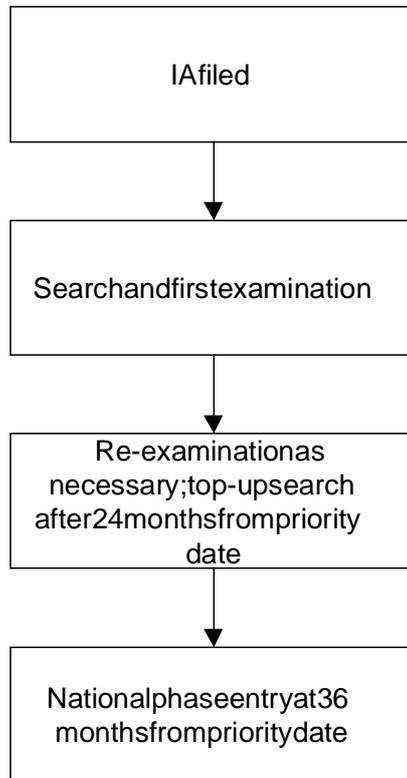
[Annex follows]

ANNEX

EXAMPLES OF POSSIBLE SYSTEMS

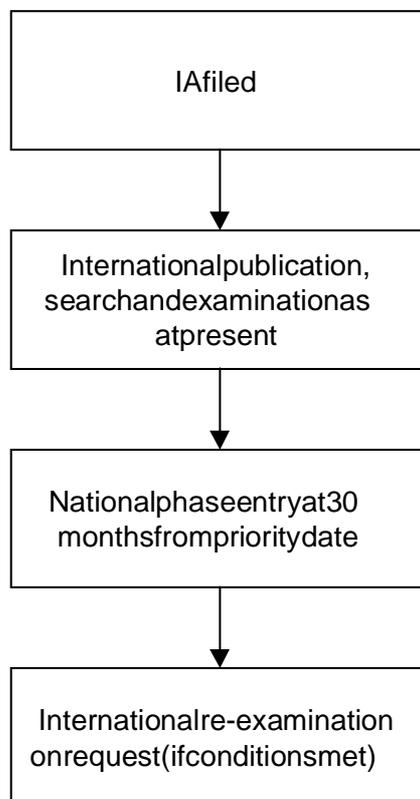
EXAMPLE A

SYSTEM WITH TOP-UP SEARCHES AND FURTHER EXAMINATION



1. This example shows a system with an international phase extended by six months. This time would be used to permit further search and examination actions during the international phase, including a top-up search (see paragraphs 27 to 29 of the main document). The examination report might also be broadened to include specific statements of whether or not any of the subject matter relates to matters where national laws significantly vary, for example, whether the claim in invention is a surgical method or a plant (see paragraphs 30 to 31 of the main document).

EXAMPLE B
SYSTEM ALLOWING POST-GRANT RE-EXAMINATION

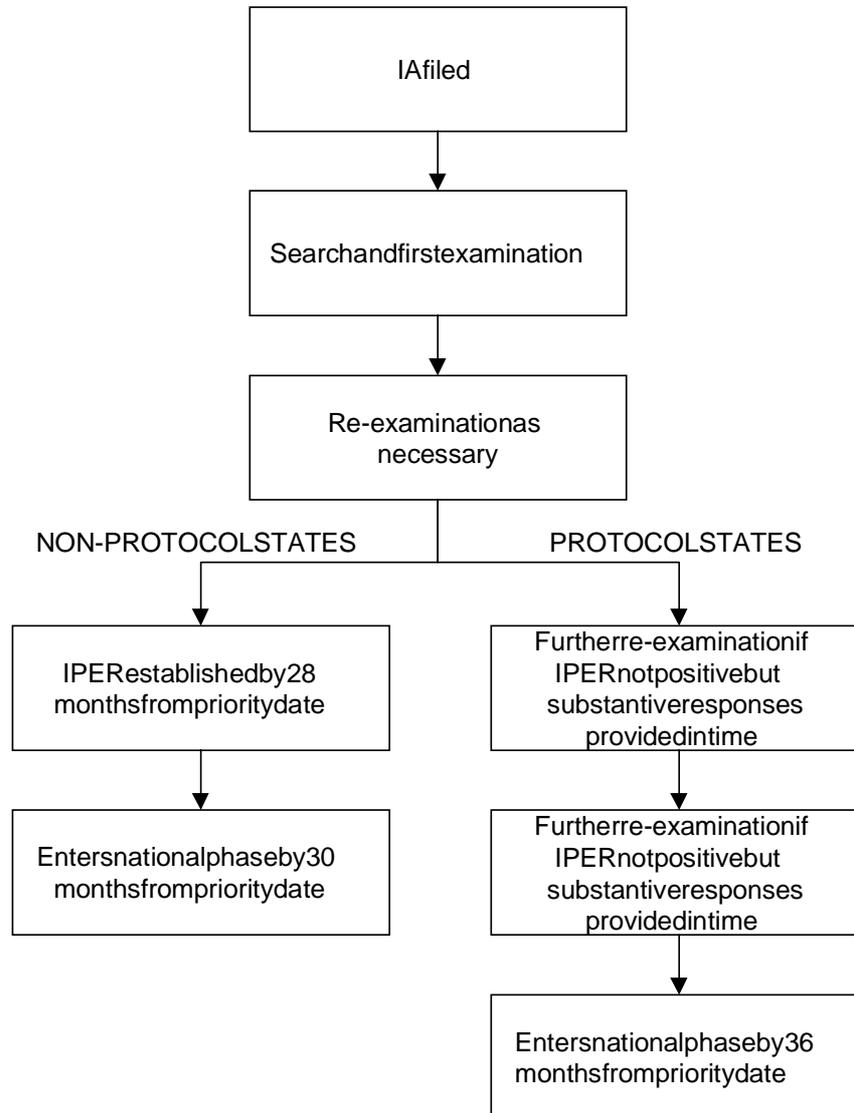


1. In this example, the timing and content of the international phase is similar to that at present, but the system allows for international examination to be requested later on international applications for which patents may already have been granted in certain cases, for example where new prior art has been found which may affect the novelty or inventive step of the invention (see paragraph 41 of the main document). It would be necessary to allow such requests even after the patent has lapsed where infringement proceedings are still possible.

2. Several possibilities could be envisaged with respect to how the re-examination is requested. This might only be permitted at the request of a Contracting State, or else it might also be permitted at the direct request of the owner of the patent, or even of a third party.

3. The patentee would be permitted to file amendments, following a similar process to pre-grant examination, but with additional rules ensuring that amendments were not permitted to extend the scope of protection, and possibly with more stringent time limits for response. As with current international preliminary examination reports, Member States would take such a report into account for the purposes of national invalidity or amendment proceedings, but need not be bound by it.

EXAMPLE C
SYSTEM WITH OPTIONAL FURTHER EXAMINATION



1. In this example, a protocol is added to the existing Treaty, allowing for further processing in the international phase. If the international preliminary examination is being carried out by an Authority which so permits, the applicant can request further examination, allowing a limited extra period within which to conduct further rounds of amendment or argument, with a view to the application being brought into a state which would achieve a positive international preliminary examination report. If this is not complete within 28 months from the priority date, an international preliminary examination report is established automatically on the basis of the latest written opinion for the purpose of the States which are not party to the protocol. However, the international application will not yet enter the national phase in those States which have ratified the protocol.

2. Once the international application meets the requirements of novelty, inventive step and industrial applicability as defined in the Regulations, a final international examination report is issued, if necessary endorsed with comments, noting the existence of certain subject matter

where conditions of patentability vary considerably around the world (see paragraphs 30 and 31 of the main document). This will normally result in a patent being granted without further examination in any of the States party to the protocol.

3. If the application still does not meet the requirements of novelty, inventive step and industrial applicability within 34 months from the priority date, a final report similar to the international preliminary examination report will be established and the international application will enter the national phase as usual. In order to prevent this process from being abused by simply buying time before entry to the national phase, the final report and national phase would be triggered earlier in the event of the applicant failing to provide a substantive response to a written opinion within the specified time. al

[End of Annex and of document]

WIPO



PCT/R/WG/4/8

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

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

Fourth Session

Geneva, May 19 to 23, 2003

**ABOLITION OF THE HANDLING FEE
AND INCORPORATION INTO
THE INTERNATIONAL FILING FEE**

Document prepared by the International Bureau

BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group were proposals related to PCT fees (see document PCT/R/WG/3/1, Annex I, items 15 (“Eliminate fee for each page in excess of 30 sheets”) and 16 (“Reassess fees”)).

2. During the discussions on those proposals by the Working Group, it was recalled that, following the amendments of the Regulations adopted by the Assembly in October 2002 and the introduction of the “flat” international filing fee, which would come into effect on January 1, 2004, a process to determine the amount of that fee had already started in the course of preparing WIPO’s Draft Program and Budget 2004-2005, taking into consideration the proposed level of budgetary resources, including reserve requirements (see document PCT/A/31/10, paragraphs 50 and 51, and the summary of the third Working Group session by the Chair, document PCT/R/WG/3/5, paragraphs 44 and 45). As part of that

process, the structure of fees payable for the benefit of the International Bureau has been reviewed, including the need for a separate handling fee under Chapter II.

3. It is noted that the handling fee is paid for the benefit of the International Bureau in cases where the applicant files a demand for international preliminary examination. The work undertaken by the International Bureau in connection with the processing of the demand includes publication of information about the filing of the demand and, most notably, the translation (where necessary), and communication to elected Offices, of the international preliminary examination report. Much of that work will, however, with the implementation of the enhanced international search and international preliminary examination system with effect from January 1, 2004, be performed in respect of the international preliminary report on patentability under Chapter I of the PCT which will be established in respect of each and every international application, irrespective of whether a demand is filed. There is therefore no longer any need to maintain the handling fee as a separate fee.

4. The International Bureau therefore now proposes that the separate handling fee be abolished and that it be incorporated into the new "flat" international filing fee that is to enter into force on January 1, 2004. Annex I contains proposals for amendments to the Regulations which would be consequential on the abolition of the handling fee.

5. The amount of 1,530 Swiss francs shown in the proposed amended Schedule of Fees in Annex I is utilized for the calculation of the estimated income in the context of the WIPO's proposed program and budget 2004-2005 presented in document WO/PBC/6/2. The amount is recalled in Appendix C of that document. Annex II of the present document also contains an extract from document WO/PBC/6/2 concerning fees and fee income in respect of international applications under the PCT.

6. It is to be noted that amendments to certain Rules dealing with fees, including the handling fee, were adopted by the Assembly at its thirty-first session and are due to enter into force on January 1, 2004 (see document PCT/A/31/10, Annex V). Consequential on the proposal to abolish the handling fee, some of those Rules would have to be further amended.

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

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

INCLUSION OF THE HANDLING FEE
IN THE INTERNATIONAL FILING FEE

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Rule 57¹

Deleted The Handling Fee

[COMMENT: As to the reasons for the proposed deletion of this Rule, see paragraph 3 under “Background,” above.]

~~57.1 Requirement to Pay~~

~~Each demand for international preliminary examination shall be subject to the payment of a fee for the benefit of the International Bureau (“handling fee”) to be collected by the International Preliminary Examining Authority to which the demand is submitted.~~

~~57.2 Amount~~

~~(a) The amount of the handling fee is as set out in the Schedule of Fees.~~

~~(b) [Deleted]~~

~~(c) The handling fee shall be payable in the currency or one of the currencies prescribed by the International Preliminary Examining Authority (“prescribed currency”), it being understood that, when transferred by that Authority to the International Bureau, it shall be freely convertible into Swiss currency. The amount of the handling fee shall be established, in each prescribed currency, for each International Preliminary Examining Authority which prescribes the payment of the handling fee in any currency other than Swiss currency, by the~~

¹ The “present” text shown is that of Rule 57 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

[Rule 57.2(c), continued]

~~Director General after consultation with the Office with which consultation takes place under Rule 15.2(b) in relation to that currency, or, if there is no such Office, with the Authority which prescribes payment in that currency. The amount so established shall be the equivalent, in round figures, of the amount in Swiss currency set out in the Schedule of Fees. It shall be notified by the International Bureau to each International Preliminary Examining Authority prescribing payment in that prescribed currency and shall be published in the Gazette.~~

~~(d) Where the amount of the handling fee set out in the Schedule of Fees is changed, the corresponding amounts in the prescribed currencies shall be applied from the same date as the amount set out in the amended Schedule of Fees.~~

~~(e) Where the exchange rate between Swiss currency and any prescribed currency becomes different from the exchange rate last applied, the Director General shall establish the new amount in the prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that the interested International Preliminary Examining Authority and the Director General may agree on a date falling during the said two month period in which case the said amount shall become applicable for that Authority from that date.~~

[COMMENT: The directives given by the Assembly would have to be modified accordingly.]

~~57.3 Time Limit for Payment; Amount Payable~~

~~(a) Subject to paragraphs (b) and (c), the handling fee shall be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later.~~

~~(b) Subject to paragraph (c), where the demand was transmitted to the International Preliminary Examining Authority under Rule 59.3, the handling fee shall be paid within one month from the date of receipt by that Authority or 22 months from the priority date, whichever expires later.~~

~~(c) Where, in accordance with Rule 69.1(b), the International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search, that Authority shall invite the applicant to pay the handling fee within one month from the date of the invitation.~~

~~(d) The amount of the handling fee payable shall be the amount applicable on the date of payment.~~

~~57.4 and 57.5 [Deleted]~~

~~57.6 Refund~~

~~The International Preliminary Examining Authority shall refund the handling fee to the applicant:~~

[Rule 57.6, continued]

~~(i) if the demand is withdrawn before the demand has been sent by that Authority to the International Bureau, or~~

~~(ii) if the demand is considered, under Rule 54.4 or 54bis.1(b), not to have been submitted.~~

Rule 58

The Preliminary Examination Fee

58.1 *Right to Ask for a Fee*

(a) [No change]

(b) The amount of the preliminary examination fee, if any, shall be fixed by the International Preliminary Examining Authority. ~~As to the time limit for payment of the preliminary examination fee and the amount payable, the provisions of Rule 57.3 relating to the handling fee shall apply *mutatis mutandis*.~~

[COMMENT: Proposed amendment consequential on proposed deletion of Rule 57.3, above. See also proposed new Rule 58.2, below.]

(c) [No change]

58.2 *Time Limit for Payment; Amount Payable*

(a) Subject to paragraphs (b) and (c), the preliminary examination fee shall be paid within one month from the date on which the demand was submitted or 22 months from the priority date, whichever expires later.

[COMMENT: Modeled after Rule 57.3(a) (as amended with effect from January 1, 2004), the deletion of which is proposed above.]

[Rule 58.2, continued]

(b) Subject to paragraph (c), where the demand was transmitted to the International Preliminary Examining Authority under Rule 59.3, the preliminary examination fee shall be paid within one month from the date of receipt by that Authority or 22 months from the priority date, whichever expires later.

[COMMENT: Modeled after Rule 57.3(b) (as amended with effect from January 1, 2004), the deletion of which is proposed above.]

(c) Where, in accordance with Rule 69.1(b), the International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search, that Authority shall invite the applicant to pay the preliminary examination fee within one month from the date of the invitation.

[COMMENT: Modeled after Rule 57.3(c) (as amended with effect from January 1, 2004), the deletion of which is proposed above.]

(d) The amount of the preliminary examination fee payable shall be the amount applicable on the date of payment.

[COMMENT: Modeled after Rule 57.3(d) (as amended with effect from January 1, 2004), the deletion of which is proposed above.]

58.3 [No change]

Rule 58bis²

Extension of Time Limit ~~Limits~~ for Payment of Preliminary Examination Fee ~~Fees~~

[COMMENT: The proposed amendment is consequential on the proposed deletion of Rule 57, above.]

58bis.1 Invitation by the International Preliminary Examining Authority

- (a) Where the International Preliminary Examining Authority finds:
- (i) that the amount paid to it is insufficient to cover ~~the handling fee and~~ the preliminary examination fee; or
 - (ii) by the time it is ~~they are~~ due under Rule 58.2 ~~Rules 57.3 and 58.1(b)~~, that no preliminary examination fees ~~was~~ were paid to it;

the Authority shall invite the applicant to pay to it the amount required to cover that ~~those~~ fees, together with, where applicable, the late payment fee under Rule 58bis.2, within a time limit of one month from the date of the invitation.

[COMMENT: The proposed amendments are consequential on the proposed deletion of Rule 57, above.]

- (b) [No change]

² The “present” text shown is that of Rule 58bis as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

[Rule 58bis.1, continued]

(c) Any payment received by the International Preliminary Examining Authority before that Authority sends the invitation under paragraph (a) shall be considered to have been received before the expiration of the time limit under [Rule 58.2](#) ~~Rule 57.3 or 58.1(b), as the case may be.~~

[COMMENT: The proposed amendment is consequential on proposed deletion of Rule 57, above.]

(d) [No change]

58bis.2 Late Payment Fee

(a) The payment of [the preliminary examination](#) fees in response to an invitation under Rule 58bis.1(a) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

- (i) 50% of the amount of [the](#) unpaid fees which is specified in the invitation, or
- (ii) if the amount calculated under item (i) is less than [\[10%\] of the preliminary examination](#) ~~the handling~~ fee, an amount equal to [\[10%\] of the preliminary examination](#) ~~the handling~~ fee.

[Rule 57.2, continued]

(b) The amount of the late payment fee shall not, however, exceed ~~double~~ the amount of [20%] of the preliminary examination fee ~~the handling fee~~.

[COMMENT: The proposed amendments are consequential on the proposed deletion of Rule 57, above.]

Rule 69³

Start of and Time Limit for International Preliminary Examination

69.1 *Start of International Preliminary Examination*

(a) Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of all of the following:

- (i) [no change]
- (ii) the amount due (in full) for ~~the handling fee and~~ the preliminary examination fee, including, where applicable, the late payment fee under Rule 58*bis*.2; and
- (iii) [no change]

provided that the International Preliminary Examination Authority shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54*bis*.1(a) unless the applicant expressly requests an earlier start.

[COMMENT: The proposed amendment is consequential on the proposed deletion of Rule 57, above.]

³ The “present” text shown is that of Rule 69 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

[Rule 69.1, continued]

(b) to (e) [No change]

69.2 [No change]

Rule 96

The Schedule of Fees

96.1 *Schedule of Fees Annexed to Regulations*

The amount~~s~~ of the [international filing](#) fee~~s~~ referred to in Rule~~s~~ 15 ~~and 57~~ shall be expressed in Swiss currency. ~~It~~ ~~They~~ shall be specified in the Schedule of Fees which is annexed to these Regulations and forms an integral part thereof.

[COMMENT: The proposed amendment is consequential on the proposed deletion of Rule 57, above.]

SCHEDULE OF FEES⁴

Fees	Amounts
1. International Filing Fee: (Rule 15.2)	<u>1,530</u> 650 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling Fee: (Rule 57.2)	233 Swiss francs

Reductions

~~2.3.~~ The international filing fee is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed:

- (a) on paper together with a copy thereof in electronic form; or
- (b) in electronic form.

~~3.4.~~ The international filing fee ~~All fees payable~~ (where applicable, as reduced under item ~~2.3~~) ~~is are~~ reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[Annex II follows]

⁴ The “present” text shown is that of the Schedule of Fees as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

ANNEX II

EXTRACT FROM DOCUMENT WO/PBC/6/2
(PROPOSED PROGRAM AND BUDGET 2004-2005)

PCT SYSTEM: INTERNATIONAL APPLICATIONS, FEES AND FEE INCOME

The estimated income from the PCT is elaborated as part of the biennial budget process of WIPO. The Proposed Program and Budget 2004-2005 submitted in document WO/PBC/6/2 contains detailed information and estimates for the period 1998 to 2009 on the number of PCT international applications, average level of fee for each application and annual PCT income. As indicated in document WO/PBC/6/2, the proposed budget 2004-2005 amounts to Sfr655.4 million, funded by income of Sfr603.5 million and surplus resources of SFr51.9 million. In order to illustrate the magnitude of PCT income in the context of the WIPO operation, it is noted that PCT income accounts for approximately 80 per cent of total WIPO income for the biennium 2004-2005. Moreover, an adjustment in the average PCT fee by one percent is estimated to result in a change in the biennial income by Sfr4.7 million.

In the following, paragraphs 310 to 312 and Table 19 on PCT international applications, fees and fee income for the period 1998-2009 as contained in Chapter C (Financial Indicators, Income Estimates and Resource Plan) of document WO/PBC/6/2 are recalled for information.

“310. Income from PCT fees is anticipated to increase from Sfr123,881,000 in 1996 to Sfr300,402,000 in 2009 as elaborated in Table 19. International applications are anticipated to increase by 301.3 per cent, whereas average fee is being reduced by 36.9 per cent during that period.

“311. The estimated 189,800 international applications for 2009 is 66.3 per cent higher than the actual amount for 2002 of 114,100 applications. The projected number of international applications have been discussed with the trilateral offices (USPTO, JPO, EPO), and take into account the effects of the recent slowdown on patent filings, and the anticipated economic recovery. The actual level of PCT applications in 2002 was in line with the initial estimates, as it is expected will be the case for 2003, which anticipates a 7 per cent rate of growth with respect to 2002. Future years are expected to experience growth because of, on the one hand, higher levels of national patent filings as the economy situation is expected to improve, and on the other hand, as higher proportions of national filings choose the PCT-route to file internationally. This effect will be supported by a user-friendlier PCT system, by sustained reductions in PCT fees and by improved knowledge from potential applicants of the PCT System of the advantages it provides. It is worth noting the steady increases that the proportion of PCT international applications represent on national patent filings worldwide; however, the degrees of penetration are very different across regions, with the United States of America and Europe showing wider use of the PCT among their domestic patent applicants, while Japan and other World regions show a higher potential for growth. Due to the combined effect of economic evolution and regional factors, PCT international applications are projected to continue increasing, but with a decelerated rate of growth.

“312. The average fee per application in 2002 was Sfr1,626, a decrease of 7.5 per cent with respect to the average fee in 2001. This reduction is essentially attributable to the decrease in the maximum number of payable designations from six to five as of January 1, 2002. However, the reduction between 2001 and 2002 of the actual fee paid per

application was in excess of 16 per cent due to the reversal in the result of exchange rate fluctuations: PCT fees are set in Swiss francs and subsequently fixed in other currencies through an adjustment mechanism which takes into account cumulative changes in the exchange rate over time. While in 2000 and 2001 significant gains were made benefiting from the position of a strong US dollar, the progressive weakening of that currency relative to the Swiss franc during 2002, made the International Bureau to incur losses because of these currency fluctuations. In order to separate these effects from decisions made on fees by Member States, Table 19 shows the average fee calculated in Swiss francs according to the profile of the average international application, while estimating separately income from fees paid to the International Bureau as a Receiving Office and fluctuations essentially due to the fact that payments are made to national patent offices in their local currencies. As of January 1, 2004, the average fee is estimated at Sfr1,678. As of 2004, the average fee is calculated in accordance with a flat international filing fee structure. This simplified structure takes into account the processing by the International Bureau of a written opinion by the International Searching Authority in respect of every application filed. Prior to 2004, only applications for which an International Preliminary Examination Report was sought were subject to this sort of processing. In absolute terms, the average fee increases by 3.2 per cent between 2003 and 2004. Taking into account the increased volume of processing as compared to 2003, a comparative average fee for 2004 would amount to Sfr1,731. Against this amount, the indicative average 2004 fee of Sfr1,678 represents a decrease of Sfr53 or 3.1 per cent. Detailed PCT fee schedule is provided to this document. It has been indicated in the introduction to this section that following the completion of major infrastructure investments by the Secretariat, additional fee reductions could be sought. The financial projections attached to this document anticipate a further 6.0 per cent fee reduction as of January 1, 2007, which will supplement the 3.1 per cent fee reduction currently proposed as of January 1, 2004.”

Table 19
PCT System 1996-2009: Volume, Average Fee and Income

<i>Year</i>	<i>1996</i>	<i>1997</i>	<i>1998</i>	<i>1999</i>	<i>2000</i>	<i>2001</i>	<i>2002</i>	<i>2003</i>	<i>2004</i>	<i>2005</i>	<i>2006</i>	<i>2007</i>	<i>2008</i>	<i>2009</i>
<i>International Applications</i>														
Volume	47,291	54,422	67,007	74,023	90,948	103,947	114,100	122,000	134,700	148,000	161,700	171,500	181,700	189,800
% Change	21.6%	15.1%	23.1%	10.5%	22.9%	14.3%	9.8%	6.9%	10.4%	9.9%	9.3%	6.1%	5.9%	4.5%
<i>Average Fee Per Application</i>														
Fee	2,502	2,607	2,201	2,122	1,927	1,757	1,626	1,626	1,678 ^a	1,678	1,678	1,578	1,578	1,578
% Change	17.6%	4.2%	(15.6)%	(3.6)%	(9.1)%	(8.8)%	(7.5)%	--	3.2%	--	--	(6.0)%	--	--
<i>Income (in thousands of Swiss francs)</i>														
Fee Income	118,302	141,882	147,505	157,045	175,300	182,680	185,527	198,372	226,027	248,344	271,333	270,627	286,723	299,504
WIPO RO Income	446	486	647	624	593	267	590	630	650	700	765	811	859	898
Fluctuations	5,133	9,631	(1,137)	1,387	13,663	7,404	(11,605)	--	--	--	--	--	--	--
Total, Income	123,881	151,999	147,015	159,056	189,556	190,351	174,512	199,002	226,677	249,044	272,098	271,438	287,582	300,402
% Change	49.7%	22.7%	(3.3)%	8.2%	19.2%	0.4%	(8.3)%	14.0%	13.9%	9.9%	9.3%	(0.2)%	5.9%	4.5%

^a As of 2004, the average fee is calculated in accordance with a flat international filing fee structure. This simplified structure takes into account the processing by the International Bureau of a written opinion by the International Searching Authority in respect of every application filed. Prior to 2004, only applications for which an International Preliminary Examination Report was sought were subject to this sort of processing. In absolute terms, the average fee increases by 3.2% between 2003 and 2004. Taking into account the increased volume of processing as compared to 2003, a comparative average fee for 2004 would amount to Sfr1,731. Against this amount, the indicative average 2004 fee of Sfr1,678 represents a decrease of Sfr53 or 3.1%.