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PATENT LAW TREATY AND REGULATIONS UNDER PATENT LAW TREATY

MESSAGE

FROM

THE PRESIDENT OF THE UNITED STATES

TRANSMITTING

PATENT LAW TREATY AND REGULATIONS UNDER THE PATENT LAW TREATY (THE "TREATY"), DONE AT GENEVA ON JUNE 1, 2000, BETWEEN THE GOVERNMENTS OF 53 COUNTRIES INCLUDING THE UNITED STATES OF AMERICA

SEPTEMBER 5, 2006.—Treaty was read the first time, and together with the accompanying papers, referred to the Committee on Foreign Relations and ordered to be printed for the use of the Senate

U.S. GOVERNMENT PRINTING OFFICE
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LETTER OF TRANSMITTAL

THE WHITE HOUSE, *September 5, 2006.*

To the Senate of the United States:

With a view to receiving the advice and consent of the Senate to ratification, subject to the reservation outlined below, I transmit herewith the Patent Law Treaty and Regulations Under the Patent Law Treaty (the "Treaty"), done at Geneva on June 1, 2000, between the Governments of 53 countries including the United States of America. I also transmit, for the information of the Senate, the Key Provisions of the Patent Law Treaty report prepared by the Department of State.

Strong intellectual property protection is a cornerstone of free trade and global market access. This Treaty promotes patent protection by codifying harmonizing, and reducing the costs of taking the steps necessary for obtaining and maintaining patents throughout the world. The provisions set forth in the Treaty will safeguard U.S. commercial interests by making it easier for U.S. patent applicants and owners to protect their intellectual property worldwide.

The Treaty generally sets forth the maximum procedural requirements that can be imposed on patent applicants, and in addition, provides standardized requirements for obtaining a filing date from which no party may deviate. Additionally, the Treaty provides that applicants cannot be required to hire representation for, among other things, the purpose of filing an application and that patents may not be revoked or invalidated because of noncompliance with certain application requirements, unless the noncompliance is a result of fraud. The Treaty does not limit the United States from providing patent requirements that are more favorable to the patent applicant or patent owner than those set forth in the Treaty or from prescribing requirements that are provided for in our substantive law relating to patents. Additionally, the Treaty is not intended to limit the United States from taking actions that it deems necessary for the preservation of its essential security interests.

This Treaty is in harmony with current U.S. patent laws and regulations, with minor exceptions to be addressed in proposed legislation. Because U.S. law does not require that each patent application apply to only one invention or inventive concept, and because the U.S. Patent and Trademark Office assesses that implementing a provision of the Treaty requiring "unity of invention" for all national applications would require a substantive and impractical change to our Patent Law, I recommend that the following reservation be included in the U.S. instrument of ratification, as allowed by the Treaty:

> Pursuant to Article 23, the United States declares that Article 6(1) shall not apply to any requirement relating to unity of

invention applicable under the Patent Cooperation Treaty to an international application.

I recommend that the Senate give early and favorable consideration to this Treaty and give its advice and consent to its ratification, subject to the reservation described above.

GEORGE W. BUSH.

LETTER OF SUBMITTAL

DEPARTMENT OF STATE,
Washington, DC, September 5, 2006.

The PRESIDENT,
The White House.

THE PRESIDENT: I have the honor hereby to submit to you, with a view to its transmittal to the Senate for advice and consent to ratification, the Patent Law Treaty adopted at Geneva on June 1, 2000. This Treaty was adopted under the auspices of the World Intellectual Property Organization to simplify the formal procedures and reduce associated costs for patent applicants and owners of patents seeking to obtain and preserve their rights in inventions around the world.

Fifty-three countries, including the United States, plus the European Patent Office, have signed the Treaty. As of January 2006, eleven countries have taken the necessary steps to become bound parties to the Treaty, which entered into force on April 28, 2005.

The Treaty complements existing U.S. international obligations and furthers our policy related to prompting strong intellectual property protection. The Treaty, which is supported by U.S. interests, will make it easier for U.S. patent applicants and patent owners to obtain and maintain patents throughout the world, as well as in the United States, by simplifying and, to a large degree, harmonizing national and regional formal requirements associated with patent applications and patents.

The Department of Commerce and the Office of the United States Trade Representative join the Department of State in requesting that the Patent Law Treaty be transmitted to the Senate for its advice and consent to ratification as soon as possible, subject to the reservation described within the enclosed document.

Respectfully submitted,

CONDOLEEZZA RICE.

Enclosure: Key Provisions of the Patent Law Treaty

KEY PROVISIONS OF THE PATENT LAW TREATY

The Treaty sets forth, with one exception, the maximum procedural requirements that Contracting Parties may impose on patent applicants and patentees. The one exception is Article 5, which sets forth standardized requirements for obtaining a filing date from which Contracting Parties cannot deviate.

Article 2 presents two general principles: that a Contracting Party shall be free to provide requirements which, from the viewpoint of patent applicants and patent owners, are more favorable than the requirements set forth in the Treaty and the Regulations

(annexed to the Treaty), and that nothing in the Treaty or its Regulations is intended to be construed as limiting the freedom of a Contracting Party to prescribe requirements provided for in its substantive law relating to patents. Article 3 describes the patent applications and patents to which the Treaty applies, which include utility patent applications that are filed with the Office of a Contracting Party (which for the United States would be the United States Patent and Trademark Office ("USPTO")). Article 5 provides a filing date standard. It mandates that a Contracting Party must, with only minor exceptions, provide a filing date for a patent application that is the date on which its Office has received the following elements:

(i) an express or implicit indication to the effect that the submitted elements are intended to be an application;

(ii) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted; and

(iii) a description of the invention to be patented.

Furthermore, Article 5 requires Contracting Parties to provide for "reference filing" in which a reference to a previously filed application shall, for the purposes of the filing date, constitute the description required for the subsequent application. During the negotiations of the Treaty, the United States strongly supported the adoption of this Article, with the knowledge that the requirement for the inclusion of a claim for filing date purposes pursuant to section 111(a) of title 35 of the United States Code would have to be eliminated if the United States were to become a party to the Treaty. Additionally, a new subsection will have to be added to section 111 of title 35 to implement the "reference-filing" provision.

Article 6 mandates that, except where otherwise provided in the Treaty, no Contracting Party shall require compliance with any requirement relating to the form or contents of an application which is different from, or additional to: (1) the requirements relating to form or contents which are provided for in respect of international applications under the Patent Cooperation Treaty ("PCT"), done in 1970 and to which the United States is a Party; (2) the requirements relating to form or contents compliance with which, under the PCT, may be required by Contracting Parties once the national stage processing or examination of an international application has started; and (3) any further requirements in the Regulations.

Of note, the incorporation of the "form or contents" requirements from the PCT into this Article mandates the application of the PCT's "unity of invention" requirement for all national applications. This is the requirement that an application relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. United States law does not contain such a requirement. The USPTO advises that U.S. law should not be amended to include a "unity of invention" requirement, as this is a substantive patent law matter that would be impractical for the USPTO to implement at this time. Article 23(1) permits the United States to take a reservation on this issue; our proposed reservation is addressed below.

Article 7 and Rule 7 of the Regulations address requirements regarding representation. Article 7(2) provides that Contracting Parties may not mandate representation for the filing of an application

for filing date purposes, for the mere payment of a fee, or for other specified procedures. Article 8 and Rule 8 provide the basis upon which Contracting Parties may impose requirements relating to the form and means of transmittal of communications filed with its Office relating to a patent application or to an issued patent. These provisions specify that while generally Contracting Parties may exclude the filing of communications on paper, they must, if they adopt an electronic filing system, continue to accept the filing of communications on paper for the purpose of complying with a time limit.

Article 10(1) provides that once a patent has been granted, it may not be revoked or invalidated because of non-compliance with certain formal requirements referred to in Articles 6 and 8, except where the non-compliance occurred as a result of fraudulent intention. Paragraph (2) provides that a patent cannot be revoked or invalidated without giving at least one opportunity for the patent owner to make observations on the intended revocation or invalidation. Article 11 and Rule 12 require that the Offices of all Contracting Parties provide either for extensions of time limits fixed by those Offices, or for continued processing of applications or patents, when applicants or patent owners fail to comply with time limits. However, this Article and Rule do not apply to time limits that are not fixed by an Office, such as those set by domestic law, Article 12 and Rule 13 require that all Contracting Parties provide for the re-instatement of rights of an applicant or owner where such person has failed to comply with a time limit for an action before an Office and such failure has the direct consequence of causing a loss of rights with respect to an application or patent, subject to certain conditions. U.S. law already provides for revival of rights along the lines of those prescribed by this Article. The proposed implementing legislation for this Treaty includes a provision that would consolidate those existing provisions and apply a standard for relief that is consistent with current U.S. practice.

Article 13(1) requires Contracting Parties to provide for the correction or addition of a priority claim to an earlier application where a subsequent application is filed within the time limits prescribed in the Regulations. Paragraph (2) requires the restoration of priority rights where a subsequent application which claims or could have claimed the priority of an earlier application is filed after the expiration of the priority period but within the time limits prescribed by the Regulations and the failure to file within the priority period occurred in spite of due care having been taken or was unintentional. Paragraph (3) requires the restoration of the right of priority where there has been a failure to file a required copy of an earlier application. U.S. law currently permits correction and addition of priority claims, and during the negotiations the United States supported the concept of restoring priority rights for unintentional late filings. The acceptance of such delayed filings would require amendments to sections 119, 102(b) and 102(d) of title 35, United States Code.

Articles 15 through 27 are the Administrative and Final provisions of the Treaty. Notably, Article 15 obliges each Contracting Party to comply with the patent-related provisions of the Paris Convention for the Protection of Industrial Property of March 20,

1883, as revised and amended. The United States is a Party to that Convention and is already under an obligation to comply with those provisions. Article 22 applies the Treaty (other than Articles 5 and 6(1) and (2) and subject to the exclusion of proceedings in progress) to pending applications and patents which are in force, on the date on which the Treaty binds that Contracting Party pursuant to Article 21.

Article 17 of the Treaty provides the Contracting Parties shall have an Assembly. The tasks of the Assembly, set forth in Article 17(2), include: dealing with matters concerning the maintenance and development of the Treaty and its application and operation; amending the Regulations; establishing Model International Forms; and performing other functions as are appropriate under the Treaty.

Article 17(3) and (4) set forth voting procedures for the Assembly. Article 17(4) provides that the Assembly shall endeavor to take its decisions by consensus. Where, however, consensus cannot be achieved, decisions shall be taken by voting, in which each Contracting Party that is a State shall have one vote. Pursuant to Article 17(4)(ii), any Contracting Party that is an intergovernmental organization may vote, in place of its members, with a number of votes equal to the number of its Member States that are party to the Treaty. However, no such integovernmenta1 organization may participate in the vote if anyone of its Member States exercises its right to vote (either as a party to the Treaty or as a member of another such intergovernmental organization), and vice versa.

Article 17(5) provides that with the exception of matters covered under Articles 14(2) and (3), 16(1) and 19(3), the decisions of the Assembly shall require two-thirds of the votes cast (abstentions do not count as votes). However, as is common practice in multilateral intellectual property treaties, certain provisions of the Treaty may be amended by a super-majority vote of the Assembly, without the need for a revision conference. In this Treaty, such amendment procedures apply to amendments to Articles 17(2) and 17(6), which are procedural in nature. Article 17(2) sets forth the responsibilities of the Assembly, as discussed, and Article 17(6) provides that the Assembly shall meet in ordinary session once every two years upon convocation by the Director General. According to Article 19, adoption of amendments to Articles 17(2) and 7(6) requires a three-fourths majority vote of the Assembly. Once adopted, any amendment to these two Articles enters into force for all Contracting Parties one month after written notifications of acceptance have been received by the WIPO Director General from three-fourths of those Contracting Parties which were members of the Assembly at the time the amendment was adopted.

Article 20 provides that, in addition to States, certain intergovernmental organizations that are competent to grant patents and have their own legislation binding on all their member States concerning matters covered by this Treaty may become party to the Treaty.

IMPLEMENTING LEGISLATION

The legislation proposed to implement the Treaty states that it will take effect on the date that is one far after the date of enact-

ment of the legislation. The proposed legislation also provides that it will apply to all patents, whenever granted, and to all applications for patents pending on, or filed after, the date that is one year after the date of enactment of the legislation. Because the changes required for compliance with the Treaty are viewed by industry as desirable in and of themselves, the effective date of the proposed legislation is not contingent on entry into force of the Treaty. The delay of one year for the entry into effect of the legislation is necessary to provide sufficient time for the USPTO to promulgate the necessary implementing regulations.

RESERVATION TO ACCOMPANY UNITED STATES RATIFICATION

Article 23 of the Treaty provides that Contracting Parties may make a reservation to the effect that Article 6(1), which mandates that Contracting Parties require compliance relating to form and content of a patent application which are provided for under the PCT, shall not apply to any requirement under the PCT relating to unity of invention. As noted above, in the context of the discussion of Article 6(1), United States law does not contain such a requirement. The USPTO advises that it considers this to be a substantive patent law matter that it does not recommend changing. Accordingly, the Department of State recommends that the following reservation be included in the U.S. instrument of ratification:

> "Pursuant to Article 23, the United States declares that Article 6(1) shall not apply to any requirement relating to unity of invention applicable under the Patent Cooperation Treaty to an international application."

CONCLUSION

The Treaty is of great importance to the United States. Not only will it make it easier for United States patent applicants and patent owners to obtain and maintain patents throughout the world, but it will also lay the foundation for the next step in international patent reform—the harmonization of substantive matters.

PATENT LAW TREATY (PLT)
and
REGULATIONS UNDER THE PATENT LAW TREATY

Done at Geneva on June 1, 2000

and

EXPLANATORY NOTES ON THE PATENT LAW TREATY
and
THE REGULATIONS UNDER THE PATENT LAW TREATY

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Article 1

Abbreviated Expressions

For the purposes of this Treaty, unless expressly stated otherwise:

(i) "Office" means the authority of a Contracting Party entrusted with the granting of patents or with other matters covered by this Treaty;

(ii) "application" means an application for the grant of a patent, as referred to in Article 3;

(iii) "patent" means a patent as referred to in Article 3;

(iv) references to a "person" shall be construed as including, in particular, a natural person and a legal entity;

(v) "communication" means any application, or any request, declaration, document, correspondence or other information relating to an application or patent, whether relating to a procedure under this Treaty or not, which is filed with the Office;

(vi) "records of the Office" means the collection of information maintained by the Office, relating to and including the applications filed with, and the patents granted by, that Office or another authority with effect for the Contracting Party concerned, irrespective of the medium in which such information is maintained;

(vii) "recordation" means any act of including information in the records of the Office;

(viii) "applicant" means the person whom the records of the Office show, pursuant to the applicable law, as the person who is applying for the patent, or as another person who is filing or prosecuting the application;

(ix) "owner" means the person whom the records of the Office show as the owner of the patent;

(x) "representative" means a representative under the applicable law;

(xi) "signature" means any means of self-identification;

(xii) "a language accepted by the Office" means any one language accepted by the Office for the relevant procedure before the Office;

(xiii) "translation" means a translation into a language or, where appropriate, a transliteration into an alphabet or character set, accepted by the Office;

(xiv) "procedure before the Office" means any procedure in proceedings before the Office with respect to an application or patent;

(xv) except where the context indicates otherwise, words in the singular include the plural, and vice versa, and masculine personal pronouns include the feminine;

(xvi) "Paris Convention" means the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883, as revised and amended;

(xvii) "Patent Cooperation Treaty" means the Patent Cooperation Treaty, signed on June 19, 1970, together with the Regulations and the Administrative Instructions under that Treaty, as revised, amended and modified;

(xviii) "Contracting Party" means any State or intergovernmental organization that is party to this Treaty;

(xix) "applicable law" means, where the Contracting Party is a State, the law of that State and, where the Contracting Party is an intergovernmental organization, the legal enactments under which that intergovernmental organization operates;

(xx) "instrument of ratification" shall be construed as including instruments of acceptance or approval;

(xxi) "Organization" means the World Intellectual Property Organization;

(xxii) "International Bureau" means the International Bureau of the Organization;

(xxiii) "Director General" means the Director General of the Organization.

Article 2

General Principles

(1) [*More Favorable Requirements*] A Contracting Party shall be free to provide for requirements which, from the viewpoint of applicants and owners, are more favorable than the requirements referred to in this Treaty and the Regulations, other than Article 5.

(2) [*No Regulation of Substantive Patent Law*] Nothing in this Treaty or the Regulations is intended to be construed as prescribing anything that would limit the freedom of a Contracting Party to prescribe such requirements of the applicable substantive law relating to patents as it desires.

Article 3

Applications and Patents to Which the Treaty Applies

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

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

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

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

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

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

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

Article 4

Security Exception

Nothing in this Treaty and the Regulations shall limit the freedom of a Contracting Party to take any action it deems necessary for the preservation of essential security interests.

Article 5

Filing Date

(1) [*Elements of Application*] (a) Except as otherwise prescribed in the Regulations, and subject to paragraphs (2) to (8), a Contracting Party shall provide that the filing date of an application shall be the date on which its Office has received all of the following elements, filed, at the option of the applicant, on paper or as otherwise permitted by the Office for the purposes of the filing date:

(i) an express or implicit indication to the effect that the elements are intended to be an application;

(ii) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office;

(iii) a part which on the face of it appears to be a description.

(b) A Contracting Party may, for the purposes of the filing date, accept a drawing as the element referred to in subparagraph (a)(iii).

(c) For the purposes of the filing date, a Contracting Party may require both information allowing the identity of the applicant to be established and information allowing the applicant to be contacted by the Office, or it may accept evidence allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office, as the element referred to in subparagraph (a)(ii).

(2) [*Language*] (a) A Contracting Party may require that the indications referred to in paragraph (1)(a)(i) and (ii) be in a language accepted by the Office.

(b) The part referred to in paragraph (1)(a)(iii) may, for the purposes of the filing date, be filed in any language.

(3) [*Notification*] Where the application does not comply with one or more of the requirements applied by the Contracting Party under paragraphs (1) and (2), the Office shall, as soon as practicable, notify the applicant, giving the opportunity to comply with any such requirement, and to make observations, within the time limit prescribed in the Regulations.

(4) [*Subsequent Compliance with Requirements*] (a) Where one or more of the requirements applied by the Contracting Party under paragraphs (1) and (2) are not complied with in the application as initially filed, the filing date shall, subject to subparagraph (b) and paragraph (6), be the date on which all of the requirements applied by the Contracting Party under paragraphs (1) and (2) are subsequently complied with.

(b) A Contracting Party may provide that, where one or more of the requirements referred to in subparagraph (a) are not complied with within the time limit prescribed in the Regulations, the application shall be deemed not to have been filed. Where the application is deemed not to have been filed, the Office shall notify the applicant accordingly, indicating the reasons therefor.

(5) [*Notification Concerning Missing Part of Description or Drawing*] Where, in establishing the filing date, the Office finds that a part of the description appears to be missing from the application, or that the application refers

to a drawing which appears to be missing from the application, the Office shall promptly notify the applicant accordingly.

(6) [*Filing Date Where Missing Part of Description or Drawing Is Filed*] (a) Where a missing part of the description or a missing drawing is filed with the Office within the time limit prescribed in the Regulations, that part of the description or drawing shall be included in the application, and, subject to subparagraphs (b) and (c), the filing date shall be the date on which the Office has received that part of the description or that drawing, or the date on which all of the requirements applied by the Contracting Party under paragraphs (1) and (2) are complied with, whichever is later.

(b) Where the missing part of the description or the missing drawing is filed under subparagraph (a) to rectify its omission from an application which, at the date on which one or more elements referred to in paragraph (1)(a) were first received by the Office, claims the priority of an earlier application, the filing date shall, upon the request of the applicant filed within a time limit prescribed in the Regulations, and subject to the requirements prescribed in the Regulations, be the date on which all the requirements applied by the Contracting Party under paragraphs (1) and (2) are complied with.

(c) Where the missing part of the description or the missing drawing filed under subparagraph (a) is withdrawn within a time limit fixed by the Contracting Party, the filing date shall be the date on which the requirements applied by the Contracting Party under paragraphs (1) and (2) are complied with.

(7) [*Replacing Description and Drawings by Reference to a Previously Filed Application*] (a) Subject to the requirements prescribed in the Regulations, a reference, made upon the filing of the application, in a language accepted by the Office, to a previously filed application shall, for the purposes of the filing date of the application, replace the description and any drawings.

(b) Where the requirements referred to in subparagraph (a) are not complied with, the application may be deemed not to have been filed. Where the application is deemed not to have been filed, the Office shall notify the applicant accordingly, indicating the reasons therefor.

(8) [*Exceptions*] Nothing in this Article shall limit:

(i) the right of an applicant under Article 4G(1) or (2) of the Paris Convention to preserve, as the date of a divisional application referred to in that Article, the date of the initial application referred to in that Article and the benefit of the right of priority, if any;

(ii) the freedom of a Contracting Party to apply any requirements necessary to accord the benefit of the filing date of an earlier application to an application of any type prescribed in the Regulations.

Article 6

Application

(1) [*Form or Contents of Application*] Except where otherwise provided for by this Treaty, no Contracting Party shall require compliance with any requirement relating to the form or contents of an application different from or additional to:

(i) the requirements relating to form or contents which are provided for in respect of international applications under the Patent Cooperation Treaty;

(ii) the requirements relating to form or contents compliance with which, under the Patent Cooperation Treaty, may be required by the Office of, or acting for, any State party to that Treaty once the processing or examination of an international application, as referred to in Article 23 or 40 of the said Treaty, has started;

(iii) any further requirements prescribed in the Regulations.

(2) [*Request Form*] (a) A Contracting Party may require that the contents of an application which correspond to the contents of the request of an international application under the Patent Cooperation Treaty be presented on a request Form prescribed by that Contracting Party. A Contracting Party may also require that any further contents allowed under paragraph (1)(ii) or prescribed in the Regulations pursuant to paragraph (1)(iii) be contained in that request Form.

(b) Notwithstanding subparagraph (a), and subject to Article 8(1), a Contracting Party shall accept the presentation of the contents referred to in subparagraph (a) on a request Form provided for in the Regulations.

(3) [*Translation*] A Contracting Party may require a translation of any part of the application that is not in a language accepted by its Office. A Contracting Party may also require a translation of the parts of the application, as prescribed in the Regulations, that are in a language accepted by the Office, into any other languages accepted by that Office.

(4) [*Fees*] A Contracting Party may require that fees be paid in respect of the application. A Contracting Party may apply the provisions of the Patent Cooperation Treaty relating to payment of application fees.

(5) [*Priority Document*] Where the priority of an earlier application is claimed, a Contracting Party may require that a copy of the earlier application, and a translation where the earlier application is not in a language accepted by the Office, be filed in accordance with the requirements prescribed in the Regulations.

(6) [*Evidence*] A Contracting Party may require that evidence in respect of any matter referred to in paragraph (1) or (2) or in a declaration of priority, or any translation referred to in paragraph (3) or (5), be filed with its Office in the course of the processing of the application only where that Office may reasonably doubt the veracity of that matter or the accuracy of that translation.

(7) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (6) are not complied with, the Office shall notify the applicant, giving the opportunity to comply with any such requirement, and to make observations, within the time limit prescribed in the Regulations.

(8) [*Non-Compliance with Requirements*] (a) Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (6) are not complied with within the time limit prescribed in the Regulations, the Contracting Party may, subject to subparagraph (b) and Articles 5 and 10, apply such sanction as is provided for in its law.

(b) Where any requirement applied by the Contracting Party under paragraph (1), (5) or (6) in respect of a priority claim is not complied with within the time limit prescribed in the Regulations, the priority claim may, subject to Article 13, be deemed non-existent. Subject to Article 5(7)(b), no other sanctions may be applied.

Article 7

Representation

(1) [*Representatives*] (a) A Contracting Party may require that a representative appointed for the purposes of any procedure before the Office:

(i) have the right, under the applicable law, to practice before the Office in respect of applications and patents;

(ii) provide, as his address, an address on a territory prescribed by the Contracting Party.

(b) Subject to subparagraph (c), an act, with respect to any procedure before the Office, by or in relation to a representative who complies with the requirements applied by the Contracting Party under subparagraph (a), shall have the effect of an act by or in relation to the applicant, owner or other interested person who appointed that representative.

(c) A Contracting Party may provide that, in the case of an oath or declaration or the revocation of a power of attorney, the signature of a representative shall not have the effect of the signature of the applicant, owner or other interested person who appointed that representative.

(2) [*Mandatory Representation*] (a) A Contracting Party may require that an applicant, owner or other interested person appoint a representative for the purposes of any procedure before the Office, except that an assignee of an application, an applicant, owner or other interested person may act himself before the Office for the following procedures:

(i) the filing of an application for the purposes of the filing date;

(ii) the mere payment of a fee;

(iii) any other procedure as prescribed in the Regulations;

(iv) the issue of a receipt or notification by the Office in respect of any procedure referred to in items (i) to (iii).

(b) A maintenance fee may be paid by any person.

(3) [*Appointment of Representative*] A Contracting Party shall accept that the appointment of the representative be filed with the Office in a manner prescribed in the Regulations.

(4) [*Prohibition of Other Requirements*] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (3) be complied with in respect of the matters dealt with in those paragraphs, except where otherwise provided for by this Treaty or prescribed in the Regulations.

(5) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (3) are not complied with, the Office shall notify the assignee of the application, applicant, owner or other interested person, giving the opportunity to comply with any such requirement, and to make observations, within the time limit prescribed in the Regulations.

(6) [*Non-Compliance with Requirements*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (3) are not complied with within the time limit prescribed in the Regulations, the Contracting Party may apply such sanction as is provided for in its law.

Article 8

Communications; Addresses

(1) [*Form and Means of Transmittal of Communications*] (a) Except for the establishment of a filing date under Article 5(1), and subject to Article 6(1), the Regulations shall, subject to subparagraphs (b) to (d), set out the requirements which a Contracting Party shall be permitted to apply as regards the form and means of transmittal of communications.

(b) No Contracting Party shall be obliged to accept the filing of communications other than on paper.

(c) No Contracting Party shall be obliged to exclude the filing of communications on paper.

(d) A Contracting Party shall accept the filing of communications on paper for the purpose of complying with a time limit.

(2) [*Language of Communications*] A Contracting Party may, except where otherwise provided for by this Treaty or the Regulations, require that a communication be in a language accepted by the Office.

(3) [*Model International Forms*] Notwithstanding paragraph (1)(a), and subject to paragraph (1)(b) and Article 6(2)(b), a Contracting Party shall accept the presentation of the contents of a communication on a Form which corresponds to a Model International Form in respect of such a communication provided for in the Regulations, if any.

(4) [*Signature of Communications*] (a) Where a Contracting Party requires a signature for the purposes of any communication, that Contracting Party shall accept any signature that complies with the requirements prescribed in the Regulations.

(b) No Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature which is communicated to its Office, except in respect of any quasi-judicial proceedings or as prescribed in the Regulations.

(c) Subject to subparagraph (b), a Contracting Party may require that evidence be filed with the Office only where the Office may reasonably doubt the authenticity of any signature.

(5) [*Indications in Communications*] A Contracting Party may require that any communication contain one or more indications prescribed in the Regulations.

(6) [*Address for Correspondence, Address for Legal Service and Other Address*] A Contracting Party may, subject to any provisions prescribed in the Regulations, require that an applicant, owner or other interested person indicate in any communication:

(i) an address for correspondence;

(ii) an address for legal service;

(iii) any other address provided for in the Regulations.

(7) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (6) are not complied with in respect of communications, the Office shall notify the applicant, owner or other interested person, giving the opportunity to comply with any such requirement, and to make observations, within the time limit prescribed in the Regulations.

(8) [*Non-Compliance with Requirements*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (6) are not complied with within the time limit prescribed in the Regulations, the Contracting Party may, subject to Articles 5 and 10 and to any exceptions prescribed in the Regulations, apply such sanction as is provided for in its law.

Article 9

Notifications

(1) [*Sufficient Notification*] Any notification under this Treaty or the Regulations which is sent by the Office to an address for correspondence or address for legal service indicated under Article 8(6), or any other address provided for in the Regulations for the purpose of this provision, and which complies with the provisions with respect to that notification, shall constitute a sufficient notification for the purposes of this Treaty and the Regulations.

(2) [*If Indications Allowing Contact Were Not Filed*] Nothing in this Treaty and in the Regulations shall oblige a Contracting Party to send a notification to an applicant, owner or other interested person, if indications allowing that applicant, owner or other interested person to be contacted have not been filed with the Office.

(3) [*Failure to Notify*] Subject to Article 10(1), where an Office does not notify an applicant, owner or other interested person of a failure to comply with any requirement under this Treaty or the Regulations, that absence of notification does not relieve that applicant, owner or other interested person of the obligation to comply with that requirement.

Article 10

Validity of Patent; Revocation

(1) [*Validity of Patent Not Affected by Non-Compliance with Certain Formal Requirements*] Non-compliance with one or more of the formal requirements referred to in Articles 6(1), (2), (4) and (5) and 8(1) to (4) with respect to an application may not be a ground for revocation or invalidation of a patent, either totally or in part, except where the non-compliance with the formal requirement occurred as a result of a fraudulent intention.

(2) [*Opportunity to Make Observations, Amendments or Corrections in Case of Intended Revocation or Invalidation*] A patent may not be revoked or invalidated, either totally or in part, without the owner being given the opportunity to make observations on the intended revocation or invalidation, and to make amendments and corrections where permitted under the applicable law, within a reasonable time limit.

(3) [*No Obligation for Special Procedures*] Paragraphs (1) and (2) do not create any obligation to put in place judicial procedures for the enforcement of patent rights distinct from those for the enforcement of law in general.

Article 11

Relief in Respect of Time Limits

(1) [*Extension of Time Limits*] A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office in respect of an application or a patent, if a request to that effect is made to the Office

in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party:

(i) prior to the expiration of the time limit; or

(ii) after the expiration of the time limit, and within the time limit prescribed in the Regulations.

(2) [*Continued Processing*] Where an applicant or owner has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office in respect of an application or a patent, and that Contracting Party does not provide for extension of a time limit under paragraph (1)(ii), the Contracting Party shall provide for continued processing with respect to the application or patent and, if necessary, reinstatement of the rights of the applicant or owner with respect to that application or patent, if:

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

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

(3) [*Exceptions*] No Contracting Party shall be required to provide for the relief referred to in paragraph (1) or (2) with respect to the exceptions prescribed in the Regulations.

(4) [*Fees*] A Contracting Party may require that a fee be paid in respect of a request under paragraph (1) or (2).

(5) [*Prohibition of Other Requirements*] No Contracting Party may require that requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the relief provided for under paragraph (1) or (2), except where otherwise provided for by this Treaty or prescribed in the Regulations.

(6) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraph (1) or (2) may not be refused without the applicant or owner being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Article 12

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

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

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

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

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

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

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

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

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

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

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.

Article 14

Regulations

(1) [*Content*] (a) The Regulations annexed to this Treaty provide rules concerning:

(i) matters which this Treaty expressly provides are to be "prescribed in the Regulations";

(ii) details useful in the implementation of the provisions of this Treaty;

(iii) administrative requirements, matters or procedures.

(b) The Regulations also provide rules concerning the formal requirements which a Contracting Party shall be permitted to apply in respect of requests for:

(i) recordation of change in name or address;

(ii) recordation of change in applicant or owner;

(iii) recordation of a license or a security interest;

(iv) correction of a mistake.

(c) The Regulations also provide for the establishment of Model International Forms, and for the establishment of a request Form for the purposes of Article 6(2)(b), by the Assembly, with the assistance of the International Bureau.

(2) [*Amending the Regulations*] Subject to paragraph (3), any amendment of the Regulations shall require three-fourths of the votes cast.

(3) [*Requirement of Unanimity*] (a) The Regulations may specify provisions of the Regulations which may be amended only by unanimity.

(b) Any amendment of the Regulations resulting in the addition of provisions to, or the deletion of provisions from, the provisions specified in the Regulations pursuant to subparagraph (a) shall require unanimity.

(c) In determining whether unanimity is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

(4) [*Conflict Between the Treaty and the Regulations*] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 15

Relation to the Paris Convention

(1) [*Obligation to Comply with the Paris Convention*] Each Contracting Party shall comply with the provisions of the Paris Convention which concern patents.

(2) [*Obligations and Rights Under the Paris Convention*] (a) Nothing in this Treaty shall derogate from obligations that Contracting Parties have to each other under the Paris Convention.

(b) Nothing in this Treaty shall derogate from rights that applicants and owners enjoy under the Paris Convention.

Article 16

Effect of Revisions, Amendments and Modifications of the Patent Cooperation Treaty

(1) [*Applicability of Revisions, Amendments and Modifications of the Patent Cooperation Treaty*] Subject to paragraph (2), any revision, amendment or modification of the Patent Cooperation Treaty made after June 2, 2000, which is consistent with the Articles of this Treaty, shall apply for the purposes of this Treaty and the Regulations if the Assembly so decides, in the particular case, by three-fourths of the votes cast.

(2) [*Non-Applicability of Transitional Provisions of the Patent Cooperation Treaty*] Any provision of the Patent Cooperation Treaty, by virtue of which a revised, amended or modified provision of that Treaty does not apply to a State party to it, or to the Office of or acting for such a State, for as long as the latter provision is incompatible with the law applied by that State or Office, shall not apply for the purposes of this Treaty and the Regulations.

Article 17

Assembly

(1) [*Composition*] (a) The Contracting Parties shall have an Assembly.

(b) Each Contracting Party shall be represented in the Assembly by one delegate, who may be assisted by alternate delegates, advisors and experts. Each delegate may represent only one Contracting Party.

(2) [*Tasks*] The Assembly shall:

(i) deal with matters concerning the maintenance and development of this Treaty and the application and operation of this Treaty;

(ii) establish Model International Forms, and the request Form, referred to in Article 14(1)(c), with the assistance of the International Bureau;

(iii) amend the Regulations;

(iv) determine the conditions for the date of application of each Model International Form, and the request Form, referred to in item (ii), and each amendment referred to in item (iii);

(v) decide, pursuant to Article 16(1), whether any revision, amendment or modification of the Patent Cooperation Treaty shall apply for the purposes of this Treaty and the Regulations;

(vi) perform such other functions as are appropriate under this Treaty.

(3) [*Quorum*] (a) One-half of the members of the Assembly which are States shall constitute a quorum.

(b) Notwithstanding subparagraph (a), if, in any session, the number of the members of the Assembly which are States and are represented is less than one-half but equal to or more than one-third of the members of the Assembly which are States, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly which are States and were not represented and shall invite

them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect, provided that at the same time the required majority still obtains.

(4) [*Taking Decisions in the Assembly*] (a) The Assembly shall endeavor to take its decisions by consensus.

(b) Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such a case:

(i) each Contracting Party that is a State shall have one vote and shall vote only in its own name; and

(ii) any Contracting Party that is an intergovernmental organization may participate in the vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Treaty. No such intergovernmental organization shall participate in the vote if any one of its Member States exercises its right to vote and *vice versa*. In addition, no such intergovernmental organization shall participate in the vote if any one of its Member States party to this Treaty is a Member State of another such intergovernmental organization and that other intergovernmental organization participates in that vote.

(5) [*Majorities*] (a) Subject to Articles 14(2) and (3), 16(1) and 19(3), the decisions of the Assembly shall require two-thirds of the votes cast.

(b) In determining whether the required majority is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

(6) [*Sessions*] The Assembly shall meet in ordinary session once every two years upon convocation by the Director General.

(7) [*Rules of Procedure*] The Assembly shall establish its own rules of procedure, including rules for the convocation of extraordinary sessions.

Article 18

International Bureau

(1) [*Administrative Tasks*] (a) The International Bureau shall perform the administrative tasks concerning this Treaty.

(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may be established by the Assembly.

(2) [*Meetings Other than Sessions of the Assembly*] The Director General shall convene any committee and working group established by the Assembly.

(3) [*Role of the International Bureau in the Assembly and Other Meetings*] (a) The Director General and persons designated by the Director General shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly.

(b) The Director General or a staff member designated by the Director General shall be ex officio secretary of the Assembly, and of the committees and working groups referred to in subparagraph (a).

(4) [*Conferences*] (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for any revision conferences.

(b) The International Bureau may consult with member States of the Organization, intergovernmental organizations and international and national non-governmental organizations concerning the said preparations.

(c) The Director General and persons designated by the Director General shall take part, without the right to vote, in the discussions at revision conferences.

(5) [*Other Tasks*] The International Bureau shall carry out any other tasks assigned to it in relation to this Treaty.

Article 19

Revisions

(1) [*Revision of the Treaty*] Subject to paragraph (2), this Treaty may be revised by a conference of the Contracting Parties. The convocation of any revision conference shall be decided by the Assembly.

(2) [*Revision or Amendment of Certain Provisions of the Treaty*] Article 17(2) and (6) may be amended either by a revision conference, or by the Assembly according to the provisions of paragraph (3).

(3) [*Amendment by the Assembly of Certain Provisions of the Treaty*] (a) Proposals for the amendment by the Assembly of Article 17(2) and (6) may be initiated by any Contracting Party or by the Director General. Such proposals shall be communicated by the Director General to the Contracting Parties at least six months in advance of their consideration by the Assembly.

(b) Adoption of any amendment to the provisions referred to in subparagraph (a) shall require three-fourths of the votes cast.

(c) Any amendment to the provisions referred to in subparagraph (a) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the Contracting Parties which were members of the Assembly at the time the Assembly adopted the amendment. Any amendment to the said provisions thus accepted shall bind all the Contracting Parties at the time the amendment enters into force, and States and intergovernmental organizations which become Contracting Parties at a subsequent date.

Article 20

Becoming Party to the Treaty

(1) [*States*] Any State which is party to the Paris Convention or which is a member of the Organization, and in respect of which patents may be

granted, either through the State's own Office or through the Office of another State or intergovernmental organization, may become party to this Treaty.

(2) [*Intergovernmental Organizations*] Any intergovernmental organization may become party to this Treaty if at least one member State of that intergovernmental organization is party to the Paris Convention or a member of the Organization, and the intergovernmental organization declares that it has been duly authorized, in accordance with its internal procedures, to become party to this Treaty, and declares that:

(i) it is competent to grant patents with effect for its member States; or

(ii) it is competent in respect of, and has its own legislation binding on all its member States concerning, matters covered by this Treaty, and it has, or has charged, a regional Office for the purpose of granting patents with effect in its territory in accordance with that legislation.

Subject to paragraph (3), any such declaration shall be made at the time of the deposit of the instrument of ratification or accession.

(3) [*Regional Patent Organizations*] The European Patent Organisation, the Eurasian Patent Organization and the African Regional Industrial Property Organization, having made the declaration referred to in paragraph (2)(i) or (ii) in the Diplomatic Conference that has adopted this Treaty, may become party to this Treaty as an intergovernmental organization, if it declares, at the time of the deposit of the instrument of ratification or accession that it has been duly authorized, in accordance with its internal procedures, to become party to this Treaty.

(4) [*Ratification or Accession*] Any State or intergovernmental organization satisfying the requirements in paragraph (1), (2) or (3) may deposit:

(i) an instrument of ratification if it has signed this Treaty; or

(ii) an instrument of accession if it has not signed this Treaty.

Article 21

Entry into Force; Effective Dates of Ratifications and Accessions

(1) [*Entry into Force of this Treaty*] This Treaty shall enter into force three months after ten instruments of ratification or accession by States have been deposited with the Director General.

(2) [*Effective Dates of Ratifications and Accessions*] This Treaty shall bind:

(i) the ten States referred to in paragraph (1), from the date on which this Treaty has entered into force;

(ii) each other State, from the expiration of three months after the date on which the State has deposited its instrument of ratification or accession with the Director General, or from any later date indicated in that instrument, but no later than six months after the date of such deposit;

(iii) each of the European Patent Organisation, the Eurasian Patent Organization and the African Regional Industrial Property Organization, from the expiration of three months after the deposit of its instrument of ratification or accession, or from any later date indicated in that instrument, but no later than six months after the date of such deposit, if such instrument has been deposited after the entry into force of this Treaty according to paragraph (1), or three months after the entry into force of this Treaty if such instrument has been deposited before the entry into force of this Treaty;

(iv) any other intergovernmental organization that is eligible to become party to this Treaty, from the expiration of three months after the deposit of its instrument of ratification or accession, or from any later date indicated in that instrument, but no later than six months after the date of such deposit.

Article 22

Application of the Treaty to Existing Applications and Patents

(1) [*Principle*] Subject to paragraph (2), a Contracting Party shall apply the provisions of this Treaty and the Regulations, other than Articles 5 and 6(1) and (2) and related Regulations, to applications which are pending, and to patents which are in force, on the date on which this Treaty binds that Contracting Party under Article 21.

(2) [*Procedures*] No Contracting Party shall be obliged to apply the provisions of this Treaty and the Regulations to any procedure in proceedings with respect to applications and patents referred to in paragraph (1), if such procedure commenced before the date on which this Treaty binds that Contracting Party under Article 21.

Article 23

Reservations

(1) [*Reservation*] Any State or intergovernmental organization may declare through a reservation that the provisions of Article 6(1) shall not apply to any requirement relating to unity of invention applicable under the Patent Cooperation Treaty to an international application.

(2) [*Modalities*] Any reservation under paragraph (1) shall be made in a declaration accompanying the instrument of ratification of, or accession to, this Treaty of the State or intergovernmental organization making the reservation.

(3) [*Withdrawal*] Any reservation under paragraph (1) may be withdrawn at any time.

(4) [*Prohibition of Other Reservations*] No reservation to this Treaty other than the reservation allowed under paragraph (1) shall be permitted.

Article 24

Denunciation of the Treaty

(1) [*Notification*] Any Contracting Party may denounce this Treaty by notification addressed to the Director General.

(2) [*Effective Date*] Any denunciation shall take effect one year from the date on which the Director General has received the notification or at any later date indicated in the notification. It shall not affect the application of this Treaty to any application pending or any patent in force in respect of the denouncing Contracting Party at the time of the coming into effect of the denunciation.

Article 25

Languages of the Treaty

(1) [*Authentic Texts*] This Treaty is signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally and exclusively authentic.

(2) [*Official Texts*] An official text in any language other than those referred to in paragraph (1) shall be established by the Director General, after consultation with the interested parties. For the purposes of this paragraph, interested party means any State which is party to the Treaty, or is eligible to become party to the Treaty under Article 20(1), whose official language, or one of whose official languages, is involved, and the European Patent Organisation, the Eurasian Patent Organization and the African Regional Industrial Property Organization and any other intergovernmental organization that is party to the Treaty, or may become party to the Treaty, if one of its official languages is involved.

(3) [*Authentic Texts to Prevail*] In case of differences of opinion on interpretation between authentic and official texts, the authentic texts shall prevail.

Article 26

Signature of the Treaty

The Treaty shall remain open for signature by any State that is eligible for becoming party to the Treaty under Article 20(1) and by the European Patent Organisation, the Eurasian Patent Organization and the African Regional Industrial Property Organization at the headquarters of the Organization for one year after its adoption.

Article 27

Depositary; Registration

(1) [*Depositary*] The Director General is the depositary of this Treaty.

(2) [*Registration*] The Director General shall register this Treaty with the Secretariat of the United Nations.

REGULATIONS UNDER THE PATENT LAW TREATY

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Rule 1

Abbreviated Expressions

(1) [*"Treaty"; "Article"*] (a) In these Regulations, the word "Treaty" means the Patent Law Treaty.

(b) In these Regulations, the word "Article" refers to the specified Article of the Treaty.

(2) [*Abbreviated Expressions Defined in the Treaty*] The abbreviated expressions defined in Article 1 for the purposes of the Treaty shall have the same meaning for the purposes of the Regulations.

Rule 2

Details Concerning Filing Date Under Article 5

(1) [*Time Limits Under Article 5(3) and (4)(b)*] Subject to paragraph (2), the time limits referred to in Article 5(3) and (4)(b) shall be not less than two months from the date of the notification referred to in Article 5(3).

(2) [*Exception to Time Limit Under Article 5(4)(b)*] Where a notification under Article 5(3) has not been made because indications allowing the applicant to be contacted by the Office have not been filed, the time limit referred to in Article 5(4)(b) shall be not less than two months from the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office.

(3) [*Time Limits Under Article 5(6)(a) and (b)*] The time limits referred to in Article 5(6)(a) and (b) shall be:

(i) where a notification has been made under Article 5(5), not less than two months from the date of the notification;

(ii) where a notification has not been made, not less than two months from the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office.

(4) [*Requirements Under Article 5(6)(b)*] Any Contracting Party may, subject to Rule 4(3), require that, for the filing date to be determined under Article 5(6)(b):

(i) a copy of the earlier application be filed within the time limit applicable under paragraph (3);

(ii) a copy of the earlier application, and the date of filing of the earlier application, certified as correct by the Office with which the earlier application was filed, be filed upon invitation by the Office, within a time limit which shall be not less than four months from the date of that invitation, or the time limit applicable under Rule 4(1), whichever expires earlier;

(iii) where the earlier application is not in a language accepted by the Office, a translation of the earlier application be filed within the time limit applicable under paragraph (3);

(iv) the missing part of the description or missing drawing be completely contained in the earlier application;

(v) the application, at the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office, contained an indication that the contents of the earlier application were incorporated by reference in the application;

(vi) an indication be filed within the time limit applicable under paragraph (3) as to where, in the earlier application or in the translation referred to in item (iii), the missing part of the description or the missing drawing is contained.

(5) [*Requirements Under Article 5(7)(a)*] (a) The reference to the previously filed application referred to in Article 5(7)(a) shall indicate that, for the purposes of the filing date, the description and any drawings are replaced by the reference to the previously filed application; the reference shall also indicate the number of that application, and the Office with which that application was filed. A Contracting Party may require that the reference also indicate the filing date of the previously filed application.

(b) A Contracting Party may, subject to Rule 4(3), require that:

(i) a copy of the previously filed application and, where the previously filed application is not in a language accepted by the Office, a translation of that previously filed application, be filed with the Office within a time limit which shall be not less than two months from the date on which the application containing the reference referred to in Article 5(7)(a) was received by the Office;

(ii) a certified copy of the previously filed application be filed with the Office within a time limit which shall be not less than four months from the date of the receipt of the application containing the reference referred to in Article 5(7)(a).

(c) A Contracting Party may require that the reference referred to in Article 5(7)(a) be to a previously filed application that had been filed by the applicant or his predecessor or successor in title.

(6) [*Exceptions Under Article 5(8)(ii)*] The types of applications referred to in Article 5(8)(ii) shall be:

(i) divisional applications;

(ii) applications for continuation or continuation-in-part;

(iii) applications by new applicants determined to be entitled to an invention contained in an earlier application.

Rule 3

Details Concerning the Application Under Article 6(1), (2) and (3)

(1) [*Further Requirements Under Article 6(1)(iii)*] (a) A Contracting Party may require that an applicant who wishes an application to be treated as a divisional application under Rule 2(6)(i) indicate:

(i) that he wishes the application to be so treated;

(ii) the number and filing date of the application from which the application is divided.

(b) A Contracting Party may require that an applicant who wishes an application to be treated as an application under Rule 2(6)(iii) indicate:

(i) that he wishes the application to be so treated;

(ii) the number and filing date of the earlier application.

(2) [*Request Form Under Article 6(2)(b)*] A Contracting Party shall accept the presentation of the contents referred to in Article 6(2)(a):

(i) on a request Form, if that request Form corresponds to the Patent Cooperation Treaty request Form with any modifications under Rule 20(2);

(ii) on a Patent Cooperation Treaty request Form, if that request Form is accompanied by an indication to the effect that the applicant wishes the application to be treated as a national or regional application, in which case the request Form shall be deemed to incorporate the modifications referred to in item (i);

(iii) on a Patent Cooperation Treaty request Form which contains an indication to the effect that the applicant wishes the application to be treated as a national or regional application, if such a request Form is available under the Patent Cooperation Treaty.

(3) [*Requirement Under Article 6(3)*] A Contracting Party may require, under Article 6(3), a translation of the title, claims and abstract of an application that is in a language accepted by the Office, into any other languages accepted by that Office.

Rule 4

Availability of Earlier Application Under Article 6(5) and Rule 2(4) or of Previously Filed Application Under Rule 2(5)(b)

(1) [*Copy of Earlier Application Under Article 6(5)*] Subject to paragraph (3), a Contracting Party may require that a copy of the earlier application referred to in Article 6(5) be filed with the Office within a time limit which shall be not less than 16 months from the filing date of that earlier application or,

where there is more than one such earlier application, from the earliest filing date of those earlier applications.

(2) [*Certification*] Subject to paragraph (3), a Contracting Party may require that the copy referred to in paragraph (1) and the date of filing of the earlier application be certified as correct by the Office with which the earlier application was filed.

(3) [*Availability of Earlier Application or of Previously Filed Application*] No Contracting Party shall require the filing of a copy or a certified copy of the earlier application or a certification of the filing date, as referred to in paragraphs (1) and (2), and Rule 2(4), or a copy or a certified copy of the previously filed application as referred to in Rule 2(5)(b), where the earlier application or the previously filed application was filed with its Office, or is available to that Office from a digital library which is accepted by the Office for that purpose.

(4) [*Translation*] Where the earlier application is not in a language accepted by the Office and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the Contracting Party may require that a translation of the earlier application referred to in paragraph (1) be filed by the applicant, upon invitation by the Office or other competent authority, within a time limit which shall be not less than two months from the date of that invitation, and not less than the time limit, if any, applied under that paragraph.

Rule 5

Evidence Under Articles 6(6) and 8(4)(c) and Rules 7(4), 15(4), 16(6), 17(6) and 18(4)

Where the Office notifies the applicant, owner or other person that evidence is required under Article 6(6) or 8(4)(c), or Rule 7(4), 15(4), 16(6), 17(6) or 18(4), the notification shall state the reason of the Office for doubting the veracity of the matter, indication or signature, or the accuracy of the translation, as the case may be.

Rule 6

Time Limits Concerning the Application Under Article 6(7) and (8)

(1) [*Time Limits Under Article 6(7) and (8)*] Subject to paragraphs (2) and (3), the time limits referred to in Article 6(7) and (8) shall be not less than two months from the date of the notification referred to in Article 6(7).

(2) [*Exception to Time Limit Under Article 6(8)*] Subject to paragraph (3), where a notification under Article 6(7) has not been made because indications allowing the applicant to be contacted by the Office have not been filed, the time limit referred to in Article 6(8) shall be not less than three months from the date on which one or more of the elements referred to in Article 5(1)(a) were first received by the Office.

(3) [*Time Limits Under Article 6(7) and (8) Relating to Payment of Application Fee in Accordance with the Patent Cooperation Treaty*] Where any fees required to be paid under Article 6(4) in respect of the filing of the application are not paid, a Contracting Party may, under Article 6(7) and (8), apply time limits for payment, including late payment, which are the same as those applicable under the Patent Cooperation Treaty in relation to the basic fee component of the international fee.

Rule 7

Details Concerning Representation Under Article 7

(1) [*Other Procedures Under Article 7(2)(a)(iii)*] The other procedures referred to in Article 7(2)(a)(iii) for which a Contracting Party may not require appointment of a representative are:

(i) the filing of a copy of an earlier application under Rule 2(4);

(ii) the filing of a copy of a previously filed application under Rule 2(5)(b).

(2) [*Appointment of Representative Under Article 7(3)*] (a) A Contracting Party shall accept that the appointment of a representative be filed with the Office in:

(i) a separate communication (hereinafter referred to as a "power of attorney") signed by the applicant, owner or other interested person and indicating the name and address of the representative; or, at the applicant's option,

(ii) the request Form referred to in Article 6(2), signed by the applicant.

(b) A single power of attorney shall be sufficient even where it relates to more than one application or patent of the same person, or to one or more applications and one or more patents of the same person, provided that all applications and patents concerned are identified in the single power of attorney. A single power of attorney shall also be sufficient even where it relates, subject to any exception indicated by the appointing person, to all existing and future applications or patents of that person. The Office may require that, where that single power of attorney is filed on paper or as otherwise permitted by the Office, a separate copy thereof be filed for each application and patent to which it relates.

(3) [*Translation of Power of Attorney*] A Contracting Party may require that, if a power of attorney is not in a language accepted by the Office, it be accompanied by a translation.

(4) [*Evidence*] A Contracting Party may require that evidence be filed with the Office only where the Office may reasonably doubt the veracity of any indication contained in any communication referred to in paragraph (2)(a).

(5) [*Time Limits Under Article 7(5) and (6)*] Subject to paragraph (6), the time limits referred to in Article 7(5) and (6) shall be not less than two months from the date of the notification referred to in Article 7(5).

(6) [*Exception to Time Limit Under Article 7(6)*] Where a notification referred to in Article 7(5) has not been made because indications allowing the applicant, owner or other interested person to be contacted by the Office have not been filed, the time limit referred to in Article 7(6) shall be not less than three months from the date on which the procedure referred to in Article 7(5) was commenced.

Rule 8

Filing of Communications Under Article 8(1)

(1) [*Communications Filed on Paper*] (a) After June 2, 2005, any Contracting Party may, subject to Articles 5(1) and 8(1)(d), exclude the filing of communications on paper or may continue to permit the filing of communications on paper. Until that date, all Contracting Parties shall permit the filing of communications on paper.

(b) Subject to Article 8(3) and subparagraph (c), a Contracting Party may prescribe the requirements relating to the form of communications on paper.

(c) Where a Contracting Party permits the filing of communications on paper, the Office shall permit the filing of communications on paper in accordance with the requirements under the Patent Cooperation Treaty relating to the form of communications on paper.

(d) Notwithstanding subparagraph (a), where the receiving or processing of a communication on paper, due to its character or its size, is deemed not practicable, a Contracting Party may require the filing of that communication in another form or by other means of transmittal.

(2) [*Communications Filed in Electronic Form or by Electronic Means of Transmittal*] (a) Where a Contracting Party permits the filing of communications in electronic form or by electronic means of transmittal with its Office in a particular language, including the filing of communications by telegraph, teleprinter, telefacsimile or other like means of transmittal, and there are requirements applicable to that Contracting Party under the Patent Cooperation Treaty in relation to communications filed in electronic form or by electronic means of transmittal in that language, the Office shall permit the filing of communications in electronic form or by electronic means of transmittal in the said language in accordance with those requirements.

(b) A Contracting Party which permits the filing of communications in electronic form or by electronic means of transmittal with its Office shall notify the International Bureau of the requirements under its applicable law relating to such filing. Any such notification shall be published by the International Bureau in the language in which it is notified and in the

languages in which authentic and official texts of the Treaty are established under Article 25.

(c) Where, under subparagraph (a), a Contracting Party permits the filing of communications by telegraph, teleprinter, telefacsimile or other like means of transmittal, it may require that the original of any document which was transmitted by such means of transmittal, accompanied by a letter identifying that earlier transmission, be filed on paper with the Office within a time limit which shall be not less than one month from the date of the transmission.

(3) [*Copies, Filed in Electronic Form or by Electronic Means of Transmittal, of Communications Filed on Paper*] (a) Where a Contracting Party permits the filing of a copy, in electronic form or by electronic means of transmittal, of a communication filed on paper in a language accepted by the Office, and there are requirements applicable to that Contracting Party under the Patent Cooperation Treaty in relation to the filing of such copies of communications, the Office shall permit the filing of copies of communications in electronic form or by electronic means of transmittal, in accordance with those requirements.

(b) Paragraph (2)(b) shall apply, *mutatis mutandis*, to copies, in electronic form or by electronic means of transmittal, of communications filed on paper.

Rule 9

Details Concerning the Signature Under Article 8(4)

(1) [*Indications Accompanying Signature*] A Contracting Party may require that the signature of the natural person who signs be accompanied by:

(i) an indication in letters of the family or principal name and the given or secondary name or names of that person or, at the option of that person, of the name or names customarily used by the said person;

(ii) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.

(2) [*Date of Signing*] A Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required but is not supplied, the date on which the signing is deemed to have been effected shall be the date on which the communication bearing the signature was received by the Office or, if the Contracting Party so permits, a date earlier than the latter date.

(3) [*Signature of Communication on Paper*] Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party:

(i) shall, subject to item (iii), accept a handwritten signature;

(ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;

(iii) may, where the natural person who signs the communication is a national of the Contracting Party and such person's address is on its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment on its territory, require that a seal be used instead of a handwritten signature.

(4) [*Signature of Communications Filed in Electronic Form or by Electronic Means of Transmittal Resulting in Graphic Representation*] Where a Contracting Party permits the filing of communications in electronic form or by electronic means of transmittal, it shall consider such a communication signed if a graphic representation of a signature accepted by that Contracting Party under paragraph (3) appears on that communication as received by the Office of that Contracting Party.

(5) [*Signature of Communications Filed in Electronic Form Not Resulting in Graphic Representation of Signature*] (a) Where a Contracting Party permits the filing of communications in electronic form, and a graphic representation of a signature accepted by that Contracting Party under paragraph (3) does not appear on such a communication as received by the Office of that Contracting Party, the Contracting Party may require that the communication be signed using a signature in electronic form as prescribed by that Contracting Party.

(b) Notwithstanding subparagraph (a), where a Contracting Party permits the filing of communications in electronic form in a particular language, and there are requirements applicable to that Contracting Party under the Patent Cooperation Treaty in relation to signatures in electronic form of communications filed in electronic form in that language which do not result in a graphic representation of the signature, the Office of that Contracting Party shall accept a signature in electronic form in accordance with those requirements.

(c) Rule 8(2)(b) shall apply *mutatis mutandis*.

(6) [*Exception to Certification of Signature Under Article 8(4)(b)*] A Contracting Party may require that any signature referred to in paragraph (5) be confirmed by a process for certifying signatures in electronic form specified by that Contracting Party.

Rule 10

Details Concerning Indications Under Article 8(5), (6) and (8)

(1) [*Indications Under Article 8(5)*] (a) A Contracting Party may require that any communication:

(i) indicate the name and address of the applicant, owner or other interested person;

(ii) indicate the number of the application or patent to which it relates;

(iii) contain, where the applicant, owner or other interested person is registered with the Office, the number or other indication under which he is so registered.

(b) A Contracting Party may require that any communication by a representative for the purposes of a procedure before the Office contain:

(i) the name and address of the representative;

(ii) a reference to the power of attorney, or other communication in which the appointment of that representative is or was effected, on the basis of which the said representative acts;

(iii) where the representative is registered with the Office, the number or other indication under which he is registered.

(2) [*Address for Correspondence and Address for Legal Service*] A Contracting Party may require that the address for correspondence referred to in Article 8(6)(i) and the address for legal service referred to in Article 8(6)(ii) be on a territory prescribed by that Contracting Party.

(3) [*Address Where No Representative Is Appointed*] Where no representative is appointed and an applicant, owner or other interested person has provided, as his address, an address on a territory prescribed by the Contracting Party under paragraph (2), that Contracting Party shall consider that address to be the address for correspondence referred to in Article 8(6)(i) or the address for legal service referred to in Article 8(6)(ii), as required by the Contracting Party, unless that applicant, owner or other interested person expressly indicates another such address under Article 8(6).

(4) [*Address Where Representative Is Appointed*] Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for correspondence referred to in Article 8(6)(i) or the address for legal service referred to in Article 8(6)(ii), as required by the Contracting Party, unless that applicant, owner or other interested person expressly indicates another such address under Article 8(6).

(5) [*Sanctions for Non-Compliance with Requirements Under Article 8(8)*] No Contracting Party may provide for the refusal of an application for failure to comply with any requirement to file a registration number or other indication under paragraph (1)(a)(iii) and (b)(iii).

Rule 11

Time Limits Concerning Communications Under Article 8(7) and (8)

(1) [*Time Limits Under Article 8(7) and (8)*] Subject to paragraph (2), the time limits referred to in Article 8(7) and (8) shall be not less than two months from the date of the notification referred to in Article 8(7).

(2) [*Exception to Time Limit Under Article 8(8)*] Where a notification under Article 8(7) has not been made because indications allowing the applicant, owner or other interested person to be contacted by the Office have not been filed, the time limit referred to in Article 8(8) shall be not less than three months from the date on which the communication referred to in Article 8(7) was received by the Office.

Rule 12

Details Concerning Relief in Respect of Time Limits Under Article 11

(1) [*Requirements Under Article 11(1)*] (a) A Contracting Party may require that a request referred to in Article 11(1):

(i) be signed by the applicant or owner;

(ii) contain an indication to the effect that extension of a time limit is requested, and an identification of the time limit in question.

(b) Where a request for extension of a time limit is filed after the expiration of the time limit, a Contracting Party may require that all of the requirements in respect of which the time limit for the action concerned applied be complied with at the same time as the request is filed.

(2) [*Period and Time Limit Under Article 11(1)*] (a) The period of extension of a time limit referred to in Article 11(1) shall be not less than two months from the date of the expiration of the unextended time limit.

(b) The time limit referred to in Article 11(1)(ii) shall expire not earlier than two months from the date of the expiration of the unextended time limit.

(3) [*Requirements Under Article 11(2)(i)*] A Contracting Party may require that a request referred to in Article 11(2):

(i) be signed by the applicant or owner;

(ii) contain an indication to the effect that relief in respect of non-compliance with a time limit is requested, and an identification of the time limit in question.

(4) [*Time Limit for Filing a Request Under Article 11(2)(ii)*] The time limit referred to in Article 11(2)(ii) shall expire not earlier than two months after a notification by the Office that the applicant or owner did not comply with the time limit fixed by the Office.

(5) [*Exceptions Under Article 11(3)*] (a) No Contracting Party shall be required under Article 11(1) or (2) to grant:

(i) a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 11(1) or (2);

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

(iii) relief in respect of a time limit for the payment of maintenance fees;

(iv) relief in respect of a time limit referred to in Article 13(1), (2) or (3);

(v) relief in respect of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;

(vi) relief in respect of a time limit for an action in *inter partes* proceedings.

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements of a procedure before the Office shall be required under Article 11(1) or (2) to grant relief in respect of a time limit for an action in that procedure in respect of any of those requirements beyond that maximum time limit.

Rule 13

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

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

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

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

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

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

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

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

(iii) referred to in Article 13(1), (2) or (3);

(iv) for an action in *inter partes* proceedings.

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).

Rule 15

Request for Recordation of Change in Name or Address

(1) [*Request*] Where there is no change in the person of the applicant or owner but there is a change in his name or address, a Contracting Party shall accept that a request for recordation of the change be made in a communication signed by the applicant or owner and containing the following indications:

(i) an indication to the effect that recordation of a change in name or address is requested;

(ii) the number of the application or patent concerned;

(iii) the change to be recorded;

(iv) the name and address of the applicant or the owner prior to the change.

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

(3) [*Single Request*] (a) A single request shall be sufficient even where the change relates to both the name and address of the applicant or the owner.

(b) A single request shall be sufficient even where the change relates to more than one application or patent of the same person, or to one or more applications and one or more patents of the same person, provided that the numbers of all applications and patents concerned are indicated in the request. A Contracting Party may require that, where that single request is filed on paper or as otherwise permitted by the Office, a separate copy thereof be filed for each application and patent to which it relates.

(4) [*Evidence*] A Contracting Party may require that evidence be filed with the Office only where the Office may reasonably doubt the veracity of any indication contained in the request.

(5) [*Prohibition of Other Requirements*] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the request referred to in paragraph (1), except where otherwise provided for by the Treaty or prescribed in these Regulations. In particular, the filing of any certificate concerning the change may not be required.

(6) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (4) are not complied with, the Office shall notify the applicant or owner, giving the opportunity to comply with any such requirement, and to make observations, within not less than two months from the date of the notification.

(7) [*Non-Compliance with Requirements*] (a) Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (4) are not complied with within the time limit under subparagraph (b), the Contracting Party may provide that the request shall be refused, but no more severe sanction may be applied.

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

(i) subject to item (ii), not less than two months from the date of the notification;

(ii) where indications allowing the Office to contact the person who made the request referred to in paragraph (1) have not been filed, not less than three months from the date on which that request was received by the Office.

(8) [*Change in the Name or Address of the Representative, or in the Address for Correspondence or Address for Legal Service*] Paragraphs (1) to (7) shall apply, *mutatis mutandis*, to any change in the name or address of the representative, and to any change relating to the address for correspondence or address for legal service.

Rule 16

Request for Recordation of Change in Applicant or Owner

(1) [*Request for Recordation of a Change in Applicant or Owner*] (a) Where there is a change in the person of the applicant or owner, a Contracting Party shall accept that a request for recordation of the change be made in a communication signed by the applicant or owner, or by the new applicant or new owner, and containing the following indications:

(i) an indication to the effect that a recordation of change in applicant or owner is requested;

(ii) the number of the application or patent concerned;

(iii) the name and address of the applicant or owner;

(iv) the name and address of the new applicant or new owner;

(v) the date of the change in the person of the applicant or owner;

(vi) the name of a State of which the new applicant or new owner is a national if he is the national of any State, the name of a State in which the new applicant or new owner has his domicile, if any, and the name of a State in which the new applicant or new owner has a real and effective industrial or commercial establishment, if any;

(vii) the basis for the change requested.

(b) A Contracting Party may require that the request contain:

(i) a statement that the information contained in the request is true and correct;

(ii) information relating to any government interest by that Contracting Party.

(2) [*Documentation of the Basis of the Change in Applicant or Owner*]
(a) Where the change in applicant or owner results from a contract, a Contracting Party may require that the request include information relating to the registration of the contract, where registration is compulsory under the applicable law, and that it be accompanied, at the option of the requesting party, by one of the following:

(i) a copy of the contract, which copy may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original contract;

(ii) an extract of the contract showing the change, which extract may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being a true extract of the contract;

(iii) an uncertified certificate of transfer of ownership by contract drawn up with the content as prescribed in the Model International Form in respect of a certificate of transfer and signed by both the applicant and the new applicant, or by both the owner and the new owner.

(b) Where the change in applicant or owner results from a merger, or from the reorganization or division of a legal entity, a Contracting Party may require that the request be accompanied by a copy of a document, which document originates from a competent authority and evidences the merger, or the reorganization or division of the legal entity, and any attribution of rights involved, such as a copy of an extract from a register of commerce. A Contracting Party may also require that the copy be certified, at the option of the requesting party, by the authority which

issued the document or by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original document.

(c) Where the change in applicant or owner does not result from a contract, a merger, or the reorganization or division of a legal entity, but results from another ground, for example, by operation of law or a court decision, a Contracting Party may require that the request be accompanied by a copy of a document evidencing the change. A Contracting Party may also require that the copy be certified as being in conformity with the original document, at the option of the requesting party, by the authority which issued the document or by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office.

(d) Where the change is in the person of one or more but not all of several co-applicants or co-owners, a Contracting Party may require that evidence of the consent to the change of any co-applicant or co-owner in respect of whom there is no change be provided to the Office.

(3) [*Translation*] A Contracting Party may require a translation of any document filed under paragraph (2) that is not in a language accepted by the Office.

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

(5) [*Single Request*] A single request shall be sufficient even where the change relates to more than one application or patent of the same person, or to one or more applications and one or more patents of the same person, provided that the change in applicant or owner is the same for all applications and patents concerned, and the numbers of all applications and patents concerned are indicated in the request. A Contracting Party may require that, where that single request is filed on paper or as otherwise permitted by the Office, a separate copy thereof be filed for each application and patent to which it relates.

(6) [*Evidence*] A Contracting Party may require that evidence, or further evidence in the case of paragraph (2), be filed with the Office only where that Office may reasonably doubt the veracity of any indication contained

in the request or in any document referred to in the present Rule, or the accuracy of any translation referred to in paragraph (3).

(7) [*Prohibition of Other Requirements*] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (6) be complied with in respect of the request referred to in this Rule, except where otherwise provided for by the Treaty or prescribed in these Regulations.

(8) [*Notification; Non-Compliance with Requirements*] Rule 15(6) and (7) shall apply, mutatis mutandis, where one or more of the requirements applied under paragraphs (1) to (5) are not complied with, or where evidence, or further evidence, is required under paragraph (6).

(9) [*Exclusion with Respect to Inventorship*] A Contracting Party may exclude the application of this Rule in respect of changes in inventorship. What constitutes inventorship shall be determined under the applicable law.

Rule 17

Request for Recordation of a License or a Security Interest

(1) [*Request for Recordation of a License*] (a) Where a license in respect of an application or patent may be recorded under the applicable law, the Contracting Party shall accept that a request for recordation of that license be made in a communication signed by the licensor or the licensee and containing the following indications:

(i) an indication to the effect that a recordation of a license is requested;

(ii) the number of the application or patent concerned;

(iii) the name and address of the licensor;

(iv) the name and address of the licensee;

(v) an indication of whether the license is an exclusive license or a non-exclusive license;

(vi) the name of a State of which the licensee is a national if he is the national of any State, the name of a State in which the licensee has his domicile, if any, and the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any.

(b) A Contracting Party may require that the request contain:

(i) a statement that the information contained in the request is true and correct;

(ii) information relating to any government interest by that Contracting Party;

(iii) information relating to the registration of the license, where registration is compulsory under the applicable law;

(iv) the date of the license and its duration.

(2) [*Documentation of the Basis of the License*] (a) Where the license is a freely concluded agreement, a Contracting Party may require that the request be accompanied, at the option of the requesting party, by one of the following:

(i) a copy of the agreement, which copy may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original agreement;

(ii) an extract of the agreement consisting of those portions of that agreement which show the rights licensed and their extent, which extract may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being a true extract of the agreement.

(b) A Contracting Party may require, where the license is a freely concluded agreement, that any applicant, owner, exclusive licensee, co-applicant, co-owner or co-exclusive licensee who is not party to that agreement give his consent to the recordation of the agreement in a communication to the Office.

(c) Where the license is not a freely concluded agreement, for example, it results from operation of law or a court decision, a Contracting Party may require that the request be accompanied by a copy of a document evidencing the license. A Contracting Party may also require that the copy be certified as being in conformity with the original document, at the option of the requesting party, by the authority which issued the document or by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office.

(3) [*Translation*] A Contracting Party may require a translation of any document filed under paragraph (2) that is not in a language accepted by the Office.

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

(5) [*Single Request*] Rule 16(5) shall apply, *mutatis mutandis*, to requests for recordation of a license.

(6) [*Evidence*] Rule 16(6) shall apply, *mutatis mutandis*, to requests for recordation of a license.

(7) [*Prohibition of Other Requirements*] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (6) be complied with in respect of the request referred to in paragraph (1), except where otherwise provided for by the Treaty or prescribed in these Regulations.

(8) [*Notification; Non-Compliance with Requirements*] Rule 15(6) and (7) shall apply, *mutatis mutandis*, where one or more of the requirements applied under paragraphs (1) to (5) are not complied with, or where evidence, or further evidence, is required under paragraph (6).

(9) [*Request for Recordation of a Security Interest or Cancellation of the Recordation of a License or a Security Interest*] Paragraphs (1) to (8) shall apply, *mutatis mutandis*, to requests for:

(i) recordation of a security interest in respect of an application or patent;

(ii) cancellation of the recordation of a license or a security interest in respect of an application or patent.

Rule 18

Request for Correction of a Mistake

(1) [*Request*] (a) Where an application, a patent or any request communicated to the Office in respect of an application or a patent contains a mistake, not related to search or substantive examination, which is correctable by the Office under the applicable law, the Office shall accept that a request for correction of that mistake in the records and publications of the Office be made in a communication to the Office signed by the applicant or owner and containing the following indications:

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

(ii) the number of the application or patent concerned;

(iii) the mistake to be corrected;

(iv) the correction to be made;

(v) the name and address of the requesting party.

(b) A Contracting Party may require that the request be accompanied by a replacement part or part incorporating the correction or, where paragraph (3) applies, by such a replacement part or part incorporating the correction for each application and patent to which the request relates.

(c) A Contracting Party may require that the request be subject to a declaration by the requesting party stating that the mistake was made in good faith.

(d) A Contracting Party may require that the request be subject to a declaration by the requesting party stating that the said request was made

without undue delay or, at the option of the Contracting Party, that it was made without intentional delay, following the discovery of the mistake.

(2) [*Fees*] (a) Subject to subparagraph (b), a Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(b) The Office shall correct its own mistakes, *ex officio* or upon request, for no fee.

(3) [*Single Request*] Rule 16(5) shall apply, *mutatis mutandis*, to requests for correction of a mistake, provided that the mistake and the requested correction are the same for all applications and patents concerned.

(4) [*Evidence*] A Contracting Party may only require that evidence in support of the request be filed with the Office where the Office may reasonably doubt that the alleged mistake is in fact a mistake, or where it may reasonably doubt the veracity of any matter contained in, or of any document filed in connection with, the request for correction of a mistake.

(5) [*Prohibition of Other Requirements*] No Contracting Party may require that formal requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the request referred to in paragraph (1), except where otherwise provided for by the Treaty or prescribed in these Regulations.

(6) [*Notification; Non-Compliance with Requirements*] Rule 15(6) and (7) shall apply, *mutatis mutandis*, where one or more of the requirements applied under paragraphs (1) to (3) are not complied with, or where evidence is required under paragraph (4).

(7) [*Exclusions*] (a) A Contracting Party may exclude the application of this Rule in respect of changes in inventorship. What constitutes inventorship shall be determined under the applicable law.

(b) A Contracting Party may exclude the application of this Rule in respect of any mistake which must be corrected in that Contracting Party under a procedure for reissue of the patent.

Rule 19

Manner of Identification of an Application Without Its Application Number

(1) [*Manner of Identification*] Where it is required that an application be identified by its application number, but such a number has not yet been issued or is not known to the person concerned or his representative, the application shall be considered identified if one of the following is supplied, at that person's option:

(i) a provisional number for the application, if any, given by the Office;

(ii) a copy of the request part of the application along with the date on which the application was sent to the Office;

(iii) a reference number given to the application by the applicant or his representative and indicated in the application, along with the name and address of the applicant, the title of the invention and the date on which the application was sent to the Office.

(2) [*Prohibition of Other Requirements*] No Contracting Party may require that identification means other than those referred to in paragraph (1) be supplied in order for an application to be identified where its application number has not yet been issued or is not known to the person concerned or his representative.

Rule 20

Establishment of Model International Forms

(1) [*Model International Forms*] The Assembly shall, under Article 14(1)(c), establish Model International Forms, in each of the languages referred to in Article 25(1), in respect of:

(i) a power of attorney;

(ii) a request for recordation of change in name or address;

(iii) a request for recordation of change in applicant or owner;

(iv) a certificate of transfer;

(v) a request for recordation, or cancellation of recordation, of a license;

(vi) a request for recordation, or cancellation of recordation, of a security interest;

(vii) a request for correction of a mistake.

(2) [*Modifications Referred to in Rule 3(2)(i)*] The Assembly shall establish the modifications of the Patent Cooperation Treaty request Form referred to in Rule 3(2)(i).

(3) [*Proposals by the International Bureau*] The International Bureau shall present proposals to the Assembly concerning:

(i) the establishment of Model International Forms referred to in paragraph (1);

(ii) the modifications of the Patent Cooperation Treaty request Form referred to in paragraph (2).

Rule 21

Requirement of Unanimity Under Article 14(3)

Establishment or amendment of the following Rules shall require unanimity:

(i) any Rules under Article 5(1)(a);

(ii) any Rules under Article 6(1)(iii);

(iii) any Rules under Article 6(3);

(iv) any Rules under Article 7(2)(a)(iii);

(v) Rule 8(1)(a);

(vi) the present Rule.

Agreed Statements by the Diplomatic Conference Regarding the Patent Law Treaty and the Regulations under the Patent Law Treaty

1. When adopting Article 1(xiv), the Diplomatic Conference understood that the words "procedure before the Office" would not cover judicial procedures under the applicable law.

2. When adopting Articles 1(xvii), 16 and 17(2)(v), the Diplomatic Conference understood that:

   (1) The PLT Assembly would, when appropriate, be convened in conjunction with meetings of the PCT Assembly.

   (2) Contracting Parties of the PLT would be consulted, when appropriate, in addition to States party to the PCT, in relation to proposed modifications of the PCT Administrative Instructions.

   (3) The Director General shall propose, for the determination of the PCT Assembly, that Contracting Parties of the PLT which are not party to the PCT be invited as observers to PCT Assembly meetings and to meetings of other PCT bodies, when appropriate.

   (4) When the PLT Assembly decides, under Article 16, that a revision, amendment or modification of the PCT shall apply for the purposes of the PLT, the Assembly may provide for transitional provisions under the PLT in the particular case.

3. When adopting Articles 6(5) and 13(3), and Rules 4 and 14, the Diplomatic Conference urged the World Intellectual Property Organization to expedite the creation of a digital library system for priority documents. Such a system would be of benefit to patent owners and others wanting access to priority documents.

4. With a view to facilitating the implementation of Rule 8(1)(a) of this Treaty, the Diplomatic Conference requests the General Assembly of the World Intellectual Property Organization (WIPO) and the Contracting Parties to provide the developing and least developed countries and countries in transition with additional technical assistance to meet their obligations under this Treaty, even before the entry into force of the Treaty.

The Diplomatic Conference further urges industrialized market economy countries to provide, on request and on mutually agreed terms and conditions, technical and financial cooperation in favour of developing and least developed countries and countries in transition.

The Diplomatic Conference requests the WIPO General Assembly, once the Treaty has entered into force, to monitor and evaluate the progress of that cooperation every ordinary session.

5. When adopting Rules 12(5)(vi) and 13(3)(iv), the Diplomatic Conference understood that, while it was appropriate to exclude actions in relation to *inter partes* proceedings from the relief provided by Articles 11 and 12, it was desirable that the applicable law of Contracting Parties provide appropriate relief in those circumstances which takes into account the competing interests of third parties, as well as those interests of others who are not parties to the proceedings.

6. It was agreed that any dispute arising between two or more Contracting Parties concerning the interpretation or the application of this Treaty and its Regulations may be settled amicably through consultation or mediation under the auspices of the Director General.

EXPLANATORY NOTES ON THE PATENT LAW TREATY AND THE REGULATIONS UNDER THE PATENT LAW TREATY*

prepared by the International Bureau

* These Notes were prepared by the International Bureau of the World Intellectual Property Organization (WIPO) for explanatory purposes only. They have not been adopted by the Diplomatic Conference. Where a conflict exists between the Notes and the provisions of the Treaty and Regulations, the latter prevail. Where a provision appears not to require explanation, no Note has been provided. The term "Agreed Statement" in the Explanatory Notes refers to an Agreed Statement by the Diplomatic Conference regarding the Patent Law Treaty and the Regulations under the Patent Law Treaty.

I. Explanatory Notes on the Patent Law Treaty

Notes on Article 1
(Abbreviated Expressions)

1.01 *Item (i).* The term "Office" includes both the national Office of any State which is a Contracting Party to the Treaty, and the regional Office of any intergovernmental organization which is a Contracting Party. For example, the Treaty will apply to the European Patent Office if, and only if, the European Patent Organisation is a Contracting Party. The term also includes branch offices of such national and regional Offices. The reference to "other matters covered by this Treaty" covers the situation in which the Office of a Contracting Party administers procedures in respect of patents, for example, the recordation of change of owner, even if patents are granted on its behalf by another Office, for example, a regional Office.

1.02 *Item (iv).* The question of whether an entity other than a natural person or a legal entity, for example a firm or partnership that is not a legal entity, is considered a person for the purpose of any procedure covered by the Treaty and Regulations, remains a matter for the applicable law of the Contracting Party concerned. Similarly, the question of what constitutes a legal entity, for example, a German *Offene Handelsgesellschaft,* is not regulated by the Treaty and Regulations and also remains a matter for the applicable law of the Contracting Party concerned.

1.03 *Item (v).* The term "communication" is used in the Treaty and Regulations to refer only to matter which is filed with the Office. Accordingly, a notification or other correspondence sent by the Office to an applicant, owner or other interested person does not constitute a "communication" as defined under this item. As regards the form and means of transmittal of communications to the Office, reference is made to the provisions of Articles 5(1)(a) and 8(1) and Rule 8 (see Notes 5.06, 8.02 to 8.05 and R8.01 to R8.08).

1.04 *Item (vi).* Information referred to under this item includes the contents of applications and patents, in particular the description, claims, abstract and drawings, as well as corrections of mistakes referred to in Rule 18(1). An example of information maintained by an Office in

respect of applications filed with, and patents granted by, another authority with effect for the Contracting Party concerned is information maintained by a Contracting State to the European Patent Convention in respect of European patents granted by the European Patent Office designating that Contracting State, irrespective of whether the European Patent Organisation (EPO) is a Contracting Party.

1.05 *Item (vii).* The term "recordation" refers to any act of including information in the records of the Office, regardless of the means used for including such information or the medium in which the information is recorded or stored.

1.06 *Items (viii) and (ix).* The terms "applicant" and "owner" are used in the Treaty and Regulations to refer only to the person who is indicated as such in the records of the Office. Accordingly, any other person who might have, or purports to have, a legal claim of ownership or other rights is not considered an applicant or owner for the purposes of the Treaty or the Regulations. In the case of a request for recordation of a change in the person of the applicant or owner (see Rule 16), during the period of time between the actual legal transfer and recordation of the change, the transferor continues to be referred to in the Treaty as the "applicant" or "owner" (that is, the person shown in the records of the Office as the applicant or owner), and the transferee is referred to as the "new applicant" or "new owner" (see Rule 16(1)). Once recordation of the change has taken place, the transferee becomes the "applicant" or "owner" (since that person is now the person shown in the records of the Office as the applicant or owner). As regards the term "person," reference is made to the explanation under item (iv) (see Note 1.02).

1.07 The question of who may apply for a patent, for example, whether a German *Offene Handelsgesellschaft* referred to in Note 1.02 may apply, remains a matter for the applicable law of the Contracting Party concerned. Where the applicable law provides that a patent must be applied for in the name of the actual inventor or inventors, the "person who is applying for the patent" could be the inventor or joint inventors. Where a person is permitted under the applicable law to apply for a patent in place of an inventor who, for example, is dead, or legally incapacitated, that person is the "person who is applying for the patent." "Another person who is filing the application" could, for example, under

certain circumstances, be the inventor's legal representative or sole heir in the United States of America. Where the applicable law provides that an application may be submitted by any natural or legal person, the applicant is the person submitting the application. Where the applicable law of a Contracting Party provides that several persons may jointly be applicants or owners, the words "applicant" and "owner" are to be construed as including "applicants" and "owners" (see item (xv)). "Another person who is prosecuting the application" could, in particular, be an assignee of record of the right, title and interest in an application, where the applicable law of a Contracting Party requires the patent to be applied for in the name of the actual inventor and also provides that such an assignee is entitled to conduct the prosecution of the application to the exclusion of the named inventor.

1.08 *Item (x).* The question of who may be a "representative," for example, an attorney or patent agent, remains a matter for the applicable law of the Contracting Party concerned. Accordingly, a Contracting Party may permit a firm or partnership that is not a legal entity to be a representative, although it is not obliged to do so. Under Article 7(1)(a), a Contracting Party may require that any representative who is appointed shall have the right to practice before the Office, and that any such representative shall provide, as his address, an address on a territory prescribed by that Contracting Party (see Notes 7.02 to 7.04).

1.09 *Item (xi).* It is implicit that the "signature" of a communication under the Treaty must be that of a person who is authorized to sign the communication concerned. Accordingly, the Office may reject the signature of a person who is not so authorized. Certain forms of signature that a Contracting Party shall accept, or may require, are expressly referred to under Rule 9(3) to (5), namely a hand-written, printed or stamped signature, a seal, a bar-coded label, or a signature filed in electronic form or by electronic means of transmittal.

1.10 *Item (xii).* The expression "a language accepted by the Office" refers to a verbal language and not, for example, to a computer language. What constitutes "a language accepted by the Office" remains a matter for the applicable law of the Contracting Party concerned. The expression "for the relevant procedure before the Office" provides for the situation in which the Office has different language requirements

for different procedures, as will normally be the case in view of the obligation on Contracting Parties under Article 5(2)(b) to accept a description in any language for the purposes of according a filing date. It also provides for the situation in which the language of a procedure before the Office is regulated by geographical considerations as, for example, in Belgium.

1.11 *Item (xiv).* The expression "procedure before the Office" covers any procedure in which an applicant, owner or other interested person communicates with the Office, either to initiate proceedings before the Office or in the course of such proceedings. It covers all procedures in proceedings before the Office and is therefore not restricted to those procedures which are referred to in express terms under Articles 5 to 14. Examples of such procedures are the filing of an application, the filing of a request for recordation of a licensing agreement, the payment of a fee, the filing of a response to a notification issued by the Office, or the filing of a translation of an application or patent. It also covers procedures in which the Office contacts an applicant, owner or other interested person in the course of proceedings relating to an application or patent, for example, the issuance of a notification that an application does not comply with certain requirements, or the issuance of a receipt for a document or a fee. It does not cover procedures which, for legal purposes, do not constitute a part of the proceedings before the Office with respect to an application or patent, for example, the purchase of a copy of a published application or the payment of a bill for information services to the public provided by the Office. In addition, when adopting Article 1(xiv), the Diplomatic Conference understood that the words "procedure before the Office" would not cover judicial procedures under the applicable law (Agreed Statement No. 1). It follows, however, from the fact that the Treaty and Regulations include, in certain provisions, explicit exceptions for quasi-judicial proceedings and proceedings before boards of appeal or other review bodies constituted in the framework of an Office (see Article 8(4)(b) and Rules 12 and 13), that, otherwise, the words "procedure before the Office" cover quasi-judicial proceedings.

1.12 *Item (xvii).* Provisions on the effect of revisions, amendments and modifications of the Patent Cooperation Treaty (PCT), including the Regulations and the Administrative Instructions under the PCT, are

contained in Article 16 (see Notes 16.01 to 16.04).

1.13 *Item (xviii).* Provisions on eligibility for becoming party to the Treaty are contained in Article 20.

1.14 *Item (xxiii).* It is to be noted that, in addition to the tasks of the Director General under the Treaty, in Agreed Statement No. 6, it was agreed that any dispute arising between two or more Contracting Parties concerning the interpretation or the application of this Treaty and its Regulations may be settled amicably through consultation or mediation under the auspices of the Director General.

Notes on Article 2
(General Principles)

2.01 *Paragraph (1).* This paragraph states, in express terms, a principle which applies to all of the provisions of the Treaty other than Article 5. It recognizes that the Treaty does not establish a completely uniform procedure for all Contracting Parties, but provides assurance for applicants and owners that, for example, an application that complies with the maximum requirements permitted under the Treaty and Regulations will comply with formal requirements applied by any Contracting Party. A similar provision is contained in PCT Article 27(4).

2.02 *Paragraph (2).* A similar provision is contained in PCT Article 27(5), first sentence.

Notes on Article 3
(Applications and Patents to Which the Treaty Applies)

3.01 *Paragraph (1)(a).* This provision applies the Treaty and Regulations to those national and regional applications listed under items (i) and (ii) which are filed with or for the Office of a Contracting Party. No distinction is made between applications filed by nationals of Contracting Parties and applications filed by other nationals. Thus, in the case of a Contracting Party which is a State, the Treaty and Regulations apply to national applications filed with the national Office of that State, irrespective of the nationality of the applicant. In the case of a

Contracting Party which is an intergovernmental organization, the Treaty and Regulations apply to applications filed with the Office of that intergovernmental organization, irrespective of any designation of States in those applications and of the nationality of the applicant.

3.02 The expression "applications ... which are filed ... for the Office of a Contracting Party" covers, in particular, applications for a regional patent that are filed with the Office of a State X, which is a member State of a regional organization, for onward transmission to the Office of that organization. However, a regional application which designates State X is not an application filed for the Office of State X. Accordingly, where, for example, both the EPO and State X were party to the Treaty, the Treaty and Regulations would apply to European applications and to national applications filed with the Office of State X. However, if State X were party to the Treaty, but the EPO were not, the Treaty and Regulations would apply to national applications filed with the Office of State X, but not to European applications, even if State X were designated. Conversely, if the EPO were party to the Treaty, but State X were not, the Treaty and Regulations would apply to European applications, including those designating State X, but would not apply to national applications filed with the Office of State X.

3.03 The terms "applications for patents for invention" and "applications for patents of addition" are to be construed in the same sense as these terms in PCT Article 2(i). Accordingly, the Treaty and Regulations do not apply to the applications listed in that Article other than applications for patents for invention and applications for patents of addition, namely, applications for inventors' certificates, utility certificates, utility models, certificates of addition, inventors' certificates of addition, and utility certificates of addition. However, a Contracting Party is free to apply some or all of the provisions of the Treaty and Regulations to such other applications, even though it is not obliged to do so. Similarly, the Treaty and Regulations do not apply to applications for "plant patents" which are not patents for invention, although they do apply to applications for patents in respect of plants which are inventions, for example plants which are the result of genetic engineering.

3.04 *Item (i).* Under this item, the Treaty and Regulations apply to those types of applications for patents for invention and for patents of addition permitted to be filed as international applications under the

PCT. In addition to "conventional applications," in respect of which no special treatment is requested, the Treaty and Regulations also apply to applications for continuation or continuation-in-part of an earlier application, in accordance with PCT Rule 4.14. Since it is possible to convert, in the "national phase," an international application in the name of a sole inventor to an application in the name of joint inventors, the Treaty and Regulations also apply to such applications, even though they do not regulate the substantive requirements for such conversion. This item does not regulate the types of applications that a Contracting Party shall accept; this remains a matter for the applicable law of the Contracting Party concerned.

3.05 Except for the provisions in respect of communications, the Treaty and Regulations do not apply to types of applications for patents for invention which are not permitted to be filed as international applications under the PCT, such as provisional applications and applications for re-issue patents. The Treaty and Regulations also do not apply to applications for patent term extension, for example, in respect of patents for pharmaceutical products under the laws of Japan, the United States of America and the European Community, since these are not applications for the grant of a patent. Similarly, they do not apply to applications for patent term adjustment, for example, as in the United States of America, in respect of the determination of additional patent term for delays in the issuance of a patent. In addition, they do not apply to an application for the conversion of an application for a European patent into a national application for one or more designated States since this is a request for a different type of treatment rather than an application for the grant of a patent. However, the Treaty does apply to the application once it has been converted to a national application, if the country concerned is party to the Treaty. However, a Contracting Party is free to apply some or all of the provisions of the Treaty and Regulations to any type of applications not covered by paragraph (1), although it is not obliged to do so. As regards divisional applications, reference is made to the explanation under item (ii) (see Note 3.06).

3.06 *Item (ii).* This item is included since a divisional application is not a type of application that is permitted to be filed under the PCT under item (i). Reference is also made to the provisions relating to the filing date of divisional applications under Article 5(8) and Rule 2(6)(i).

3.07 *Paragraph (1)(b).* This paragraph applies to Contracting Parties which are PCT Contracting States. It also applies to intergovernmental organizations that may be designated under the PCT. The phrase "Subject to the provisions of the Patent Cooperation Treaty" is included to ensure that the provisions of the PCT continue to apply to international applications in the "national phase." For example, a filing date accorded under PCT Article 11 to an international application cannot be challenged by the applicant, in the "national phase," on the grounds that the application would have been entitled to an earlier filing date under Article 5(1) of this Treaty.

3.08 *Item (i).* Under this item, the provisions of the Treaty and Regulations, in particular, reinstatement of rights under Article 12 and Rule 13, apply in relation to the time limits under PCT Articles 22 and 39(1), namely the time limits for the furnishing of a copy of the international application and any required translation, and the payment of any required fee, to designated Offices and elected Offices, respectively. However, those provisions do not apply in respect of time limits in the "international phase" of an international application, which are governed by the PCT.

3.09 *Item (ii).* Under this item, the Treaty and Regulations apply to an international application in respect of any procedure commenced on or after that application has entered the "national phase" in a national or regional Office under the PCT.

3.10 *Paragraph (2).* The Treaty and Regulations apply both to national and regional patents granted by the Office of a Contracting Party and to patents granted on behalf of a Contracting Party by another Office, in particular, the regional Office of an intergovernmental organization, irrespective of whether that intergovernmental organization is party to the Treaty. For example, if State X referred to in Note 3.02 were party to the Treaty, the Treaty and Regulations would apply both to patents granted by the Office of State X and to patents granted by the European Patent Office in so far as they have effect in State X, irrespective of whether the EPO were party to the Treaty. If the EPO were party to the Treaty, the Treaty and Regulations would apply to all European patents for the purposes of any procedures before the European Patent Office, for example, the revocation of patents in opposition proceedings, even if State X were not party to the Treaty.

3.11 The terms "patents for invention" and "patents of addition" are to be construed in the same sense as those expressions in PCT Article 2(ii). Accordingly, the Treaty and Regulations do not apply to patents which are listed in that Article other than patents for invention and patents of addition, namely, inventors' certificates, utility certificates, utility models, certificates of addition, inventors' certificates of addition, and utility certificates of addition (see also Note 3.03). However, a Contracting Party is free to apply some or all of the provisions of the Treaty and Regulations to such other patents, even though it is not obliged to do so.

3.12 Also, in accordance with the definition in PCT Article 2(ix), the term "patent" applies to national and regional patents. In addition, it follows from both paragraphs (1)(b) and (2) that the Treaty and Regulations apply to patents for inventions and patents of addition granted on international applications. Although the Treaty and Regulations do not apply to those types of applications which are not permitted to be filed as international applications under the PCT, such as provisional applications, applications for re-issue patents and applications for conversion (see Note 3.05), they do apply to patents granted in respect of such types of applications. For example, the Treaty and Regulations apply to granted re-issue patents, although they do not apply to applications for such patents. However, the Treaty and Regulations do not apply to *sui generis* titles of protection relating to patent term extensions, which are not patents.

Note on Article 4
(Security Exception)

4.01 A similar provision is contained in Article 73(b) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). The "essential security interests" of a Contracting Party which is an intergovernmental organization refers to the security interests of its member States.

Notes on Article 5
(Filing Date)

5.01 A Contracting Party is obliged to accord a filing date to an application which complies with the requirements applicable under this Article. Furthermore, a Contracting Party is not permitted to revoke the filing date accorded to an application which complies with those requirements. In particular, the filing date of an application may not be revoked for failure to comply with a requirement under Article 6, 7 or 8 within the applicable time limit, even if that application is subsequently refused or considered withdrawn on the grounds of such non-compliance (see also Note 5.02).

5.02 *Paragraph (1).* This paragraph prescribes the elements of an application to be filed for the purposes of according a filing date. First, the Office needs to be satisfied that the elements that it has received are intended to be an application for a patent. Second, the Office must be provided with indications which identify the applicant and/or allow the applicant to be contacted. In place of such indications, under subparagraph (c), evidence allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office may be accepted by the Office. Third, the Office must have received a disclosure of the invention, either in the form of a part which on the face of it appears to be a description or, where permitted by the Contracting Party under subparagraph (b), a drawing in place of that description. Since the list of elements under paragraph (1) is exhaustive, a Contracting Party is not permitted to require any additional elements for a filing date to be accorded, in particular, that the application contain one or more claims. Where an application as filed does not contain one or more claims which may be required under Article 6(1)(i) (with reference to PCT Article 3(2)), a Contracting Party may require that these be subsequently filed under Article 6(7), within the time limit prescribed in Rule 6(1). However, the failure to file such claims within that time limit will not result in the subsequent loss of the filing date, even if the application is refused or considered withdrawn under Article 6(8)(a). Another example is where, in accordance with Article 6(1) and with reference to PCT Rule 11.9, a Contracting Party requires that an application on paper be typed or printed: the filing date of an application which does not comply with

that requirement, in particular a handwritten application, cannot be revoked on that ground. The same considerations apply where an application does not comply with any other requirement under Article 6, 7 or 8, for example, it is not accompanied by a filing fee required under Article 6(4) (see also Notes 6.16 and 6.22 to 6.24).

5.03 *Paragraph (1)(a), introductory words.* The words "Except as otherwise prescribed in the Regulations" is intended, in particular, to provide for the possibility of special requirements that may be required in the future in respect of applications filed in electronic form or by electronic means of transmittal. At present, no such Regulations are provided. The establishment of any Rules by the Assembly under this provision requires unanimity under Rule 21(i).

5.04 The wording "date on which its Office has received all of the following elements" covers both the case in which all of the required elements are received on the same day and the case in which they are received on different days as provided for under paragraph (4).

5.05 Each Contracting Party is free to decide for itself what constitutes the date on which its Office has received all of the elements. This could apply where, for example, an application is received after the Office has closed for the receipt of communications, or on a day when the Office is not open for the receipt of communications. In addition, a Contracting Party is free to deem, as receipt by the Office, receipt of an application by a specified branch or sub-office of an Office, by a national Office on behalf of an intergovernmental organization having the power to grant regional patents, by a postal service, or by a specified delivery service.

5.06 The introductory words also oblige a Contracting Party to accept, for the purposes of the filing date, the filing of items (i) to (iii) "on paper or as otherwise permitted by the Office." The phrase "on paper" refers to paper form transmitted by physical means (see Note 8.03). This obligation to accept filing on paper, for the purposes of the filing date, will continue to apply even where, after June 2, 2005, a Contracting Party excludes the filing of communications on paper under Rule 8(1)(a). The phrase "as otherwise permitted by the Office" relates, in particular, to the case where the required elements are filed in an electronic form or by an electronic means of transmittal

permitted by the Contracting Party concerned under Rule 8(2). The restriction to "[means of transmittal] permitted by the Office for the purposes of the filing date" is necessary since an Office may not have the technical capability to accept filings in all electronic forms or by all electronic means of transmittal. Where an application that complies with the filing date requirements under paragraph (1) does not comply with the requirements in respect of the form and means of transmittal of communications applied by the Contracting Party concerned under Article 8(1) and Rule 8, that Contracting Party may require, under Article 8(7), that, for the application to proceed, the applicant comply with those requirements within the time limit prescribed in Rule 11(1). However, failure to do so will not result in the subsequent loss of the filing date, even if the application is refused or considered withdrawn under Article 8(8).

5.07 *Item (i).* It follows from the definition of the term "application" in Article 1(ii) and the provision of Article 3(1)(a), that this item requires an express or an implicit indication to the effect that the elements referred to are intended to be a national or regional application to which the Treaty and Regulations apply. Whether, in a particular case, the indications which have been given are sufficient to be considered as an implicit indication that the elements in question are intended to be such an application, is a matter to be determined by the Office in the circumstances of that case.

5.08 *Item (ii) and paragraph (1)(c).* These provisions are different from the corresponding provision in respect of international applications under PCT Article 11(1)(iii)(c) which requires the name of the applicant to be indicated. Whether, in a particular case, indications which have been given are sufficient for "allowing the identity of the applicant to be established" and/or for "allowing the applicant to be contacted by the Office," is a matter to be determined by the Office in the circumstances of that case. Where an application complies with the requirements of paragraph (1), but does not indicate the name and address of the applicant required under Article 6(1)(i) (having regard to PCT Rule 4.4 and 4.5), a Contracting Party may require that these indications be subsequently filed under Article 6(7), within the time limit prescribed in Rule 6(1). However, the failure to file such indications within that time limit will not result in the subsequent loss of the filing date even if the application is refused or considered withdrawn under Article 6(8)(a).

5.09 *Item (iii).* This provision is the same as the requirement in respect of international applications under PCT Article 11(1)(iii)(d). For the purpose of determining whether a filing date should be accorded, the Office only needs to establish whether, in its opinion, the application contains a part that on the face of it appears to constitute a description. The questions whether that part satisfies the formal requirements relating to the description allowed under Article 6(1), and the substantive requirements for the grant of a patent, are not relevant to this determination. In particular, this provision does not in any way impinge on the right of a Contracting Party to apply its relevant law in respect of sufficiency of disclosure, in particular, to require that, for the application to proceed to grant, the description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art, and to indicate the best mode for carrying out the invention known to the inventor, as provided for in Article 29(1) of the TRIPS Agreement and PCT Article 5 and Rule 5. However, insufficiency of disclosure shall not affect the filing date in respect of what, in fact, had been disclosed.

5.10 *Paragraph (1)(b).* This provision permits, but does not oblige, a Contracting Party to accord a filing date on the basis of one or more drawings in place of a written description. The question whether, for example, a chemical formula, a sequence listing or a photograph is considered a drawing for the purposes of this provision is a matter for the Contracting Party concerned. Where the Office of a Contracting Party which does not apply this provision receives an application in which the invention is disclosed only in one or more drawings that incorporate textual matter, it is for that Office to determine whether, in the circumstances of the case, such textual matter fulfills the requirement under paragraph (1)(a)(iii).

5.11 It is to be noted that a country of the Paris Union is, at present, free to accord a filing date to an application in which the invention is disclosed only in a drawing, and that such application, as a regular national filing under the domestic legislation of a country of the Paris Union, gives rise to a right of priority under Article 4A(2) of the Paris Convention.

5.12 *Paragraph (2)(a).* In order for the Office to understand that what it received is intended to be a patent application, the indication to the effect that the elements received are intended to be a patent application may be required to be in a language accepted by the

Office. Similarly, the Office may need the indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office in a language accepted by the Office so that it can identify or contact the applicant accordingly.

5.13 *Paragraph (2)(b).* This provision requires a Contracting Party to accept, for the purpose of establishing a filing date, a "part which on the face of it appears to be a description" which is filed in any language. Where that part is filed in a language which is not a language accepted by the Office, the Contracting Party may require that a translation of the description referred to in Article 6(3), first sentence, be filed, under Article 6(7), within the time limit prescribed in Rule 6(1) (see also Note 6.13). However, the failure to file such a translation within that time limit will not result in the subsequent loss of the filing date even if the application is refused or considered withdrawn under Article 6(8)(a). As regards the expression "a language accepted by the Office," reference is made to the explanation under Article 1(xii) (see Note 1.10)

5.14 The same considerations apply to any textual matter incorporated in a drawing which, under paragraph (1)(b), is accepted as "the part which on the face of it appears to be a description" under paragraph (1)(a)(iii).

5.15 Although the submission of one or more claims is not necessary for obtaining a filing date, where the application as filed contains claims which are in a language not accepted by the Office, a Contracting Party may require that a translation referred to in Article 6(3), first sentence, be filed, under Article 6(7), within the time limit prescribed in Rule 6(1) (see also Note 6.13). The failure to file the required translation within that time limit shall not result in the subsequent loss of the filing date even if the application is refused or considered withdrawn under Article 6(8)(a).

5.16 *Paragraph (3).* Reference is made to the general provisions concerning notifications under Article 9 (see Notes 9.01 to 9.05).

5.17 *Paragraph (4)(a).* This provision permits an applicant to subsequently remedy any non-compliance with the requirements applied under paragraphs (1) and (2). It applies whether or not the applicant has

been notified of such non-compliance under paragraph (3). This provision gives the applicant the possibility of proceeding with the application on the basis of the elements which have been filed and any fees already paid, without the need to re-file the application or pay additional filing fees. However, for the proper conduct of business before the Office, a Contracting Party may require that all the requirements in question be complied with within the time limit applicable under paragraph (4)(b) (see Note 5.18).

5.18 *Paragraph (4)(b).* This provision permits, but does not oblige, a Contracting Party to regard an application as not having been filed, where the requirements referred to in paragraphs (1) and (2) that were not complied with when the application was first received by the Office are not complied with within the time limit prescribed in Rule 2(1) or (2). An applicant who wishes to proceed with an application that has been regarded as not having been filed under this provision will have to re-file the application in its entirety and, if the Office does not permit the transfer of fees from the initially filed application, to pay new fees.

5.19 *Paragraph (5).* This provision is modeled after PCT Article 14(2). It obliges the Office to notify the applicant where, in establishing the filing date, it finds that a part of the description or a drawing appears to be missing. As it is restricted to the situation where the apparent omission is found in establishing the filing date, this provision does not apply where an apparent omission is found in any other procedure, in particular, in the course of substantive examination, when the procedures under paragraph (6)(a) to (c) would not be appropriate. It is to be noted that this provision does not require the Office to check, in establishing the filing date, whether a part of the description or drawing is missing. Reference is also made to the general provisions concerning notifications under Article 9 (see Notes 9.01 to 9.05).

5.20 *Paragraph (6)(a).* This provision obliges a Contracting Party to include, in the application, a missing part of the description or a missing drawing that is filed within the time limit prescribed in Rule 2(3). It applies whether or not the applicant has been notified under paragraph (5). Except where subparagraph (b) or (c) applies, the filing date is the date of receipt of the missing part of the description or missing drawings, provided that all of the requirements for the according of a filing date

applied under paragraphs (1) and (2) are complied with on that date. It is to be noted that this provision does not prevent a Contracting Party from permitting, without loss of filing date, the subsequent inclusion, by way of correction or amendment in accordance with the applicable law, of a drawing or the text of a part of the description where that correction or amendment does not extend the subject matter beyond the content of the application as filed.

5.21 *Paragraph (6)(b).* This provision obliges a Contracting Party to include, upon the request of the applicant, a missing part of the description or missing drawing in the application without loss of the filing date, where that missing part or missing drawing is contained in an earlier application and the requirements prescribed in Rule 2(4) are complied with (see Notes R2.03 and R2.04). The question of whether, in a particular case, a missing part of the description or a missing drawing is completely contained in the earlier application is one question for the Office to determine on the facts of that case. Where it is subsequently determined, for example in the course of substantive examination, that the missing part of the description or missing drawing was not completely contained in the earlier application as required under Rule 2(4)(ii), the Office may rescind the filing date accorded under this provision and re-accord it under subparagraph (a).

5.22 *Paragraph (6)(c).* This provision permits the applicant to withdraw a later filed missing part of the description or missing drawing in order to avoid the date of receipt of that part or that drawing being accorded as the filing date under subparagraph (a).

5.23 *Paragraph (7)(a).* This provision obliges a Contracting Party to accept, at the time of filing, the replacement of the description and any drawings in an application by a reference to a previously filed application, subject to compliance with the requirements of Rule 2(5) (see Notes R2.05 to R2.08). A Contracting Party may require, in accordance with Article 6(1)(i) (having regard to PCT Article 3(2)), that the replaced description and drawings be filed under Article 6(7) within the time limit prescribed in Rule 6(1). The failure to file that description or drawings within that time limit will not result in the subsequent loss of the filing date, even if the application is refused or considered withdrawn under Article 6(8)(a).

5.24 *Paragraph (7)(b).* Under this provision, an application may be considered as not having been filed where the applicant fails to comply with the requirements under Rule 2(5). Since, under subparagraph (a), the reference must be made upon the filing of the application, it is implicit that the requirements applied under Rule 2(5)(a) must be complied with on the filing date of the application. Any requirements applied under Rule 2(5)(b) must be complied with within the time limit applied under that Rule (see also Note 6.26).

5.25 *Paragraph (8), item (ii).* The types of application under this item are prescribed in Rule 2(6).

Notes on Article 6
(Application)

6.01 *Paragraph (1).* This paragraph applies the requirements relating to the form or contents of international applications under the PCT to national and regional applications.

6.02 The wording of this provision is modeled after that of PCT Article 27(1). It is implicit that the expression "form or contents of an application" is to be construed in the same way as the expression in that Article. The Notes to that Article in the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty, at page 35 of the Final Text of the Treaty and Notes, contain the following explanation:

"The words 'form or contents' are used merely to emphasize something that could go without saying, namely that requirements of substantive patent law (criteria of patentability, etc.) are not meant."

6.03 In accordance with the general principle contained in Article 2(2), paragraph (1) is similarly not intended to be construed as prescribing any requirements of substantive law (see Note 2.02). The requirement, allowed under Article 29.2 of the TRIPS Agreement, that an applicant for a patent provide information concerning the applicant's foreign applications and grants, is not a requirement as to the "form or contents of an application" for the purposes of this provision. Similarly, requirements in respect of duty of disclosure, indications as to whether an application was prepared with the assistance of an

invention marketing company and, if so, indications of the name and address of that company and requirements in relation to the disclosure of search results on related applications and patents, are also not requirements as to the "form or contents of an application" for the purposes of this provision. Further, requirements as to the "form or contents of an application" do not include any requirements relating to foreign investments, public concessions or public contracts under national laws and bilateral and multilateral agreements.

6.04 Under Article 23(1), a State or intergovernmental organization may declare through a reservation that the provisions of Article 6(1) shall not apply to any requirement relating to unity of invention applicable under the PCT (see Note 23.01).

6.05 *Paragraph (1), introductory words.* The requirements referred to in these introductory words which are "otherwise provided for by this Treaty" are, in particular, those under Articles 6(2) to (6), 7 and 8 and the Regulations provided for under those Articles, namely Rules 7 to 10.

6.06 *Item (i).* This item prohibits a Contracting Party from imposing requirements in respect of the form or contents of a national or regional application that are more strict than those applicable to international applications under the PCT, except where otherwise provided for in accordance with the introductory words or item (iii) of this paragraph (see Notes 6.05 and 6.09). As in the case of PCT Article 27(4), a Contracting Party is free, under Article 2(1), to provide for requirements in respect of the form or contents of national and regional applications which, from the viewpoint of applicants, are more favorable than the requirements provided for under the PCT.

6.07 *Item (ii).* This item permits a Contracting Party to require that a national or regional application comply with any requirements relating to the "form or contents" that any State party to the PCT is allowed to apply in the "national phase" of an international application, in particular, the requirements that are allowed under PCT Rule 51*bis*. It is to be noted that this item is not restricted to the particular "national phase" requirements under the PCT applied by the Contracting Party concerned, but rather applies to any "national phase" requirements allowed under the PCT.

6.08 As regards the effect of revisions, amendments and modifications to the PCT, the Regulations and Administrative Instructions under the PCT, reference is made to Article 16 (see Notes 16.01 to 16.04).

6.09 *Item (iii).* This item provides authority for the further requirements under Rule 3(1) in respect of divisional applications and of applications by new applicants determined to be entitled to an invention contained in an earlier application (see Note R3.01).

6.10 *Paragraph (2)(a).* This provision permits, but does not oblige, a Contracting Party to require the use of a request Form prescribed by that Contracting Party. It also allows a Contracting Party to require that the contents of the request which are provided for in respect of international applications under PCT Rule 4.1, as well as any contents allowed to be required under paragraph (1)(ii) or prescribed in Rule 3(1), be contained in the request. For example, a Contracting Party may require that the request contain various declarations as provided in PCT Rule 4.17.

6.11 *Paragraph (2)(b).* This provision obliges a Contracting Party, notwithstanding paragraph (2)(a), to accept the presentation of the formal contents of a request on a request Form, as prescribed in Rule 3(2) (see Notes R3.02 to R3.04).

6.12 The effect of the phrase "and subject to Article 8(1)" is that a Contracting Party may require that a request Form provided for in Rule 3(2) comply with the requirements in respect of the form and means of transmittal of communications in general applied by that Contracting Party under that Article and Rule 8. However, where, after June 2, 2005, a Contracting Party excludes the filing of communications on paper under Rule 8(1)(a), that Contracting Party will still be obliged, under Article 5(1), to accept, for the purposes of the filing date, the filing on paper of a request Form containing the indications required under that Article (see Note 5.06).

6.13 *Paragraph (3), first sentence.* This sentence permits a Contracting Party to require, after the filing date, the filing of a translation of the "part which on the face of it appears to be a description" referred to in Article 5(1)(a)(iii), where that part is not in a language accepted by the Office (as permitted for the purposes of the filing date under

Article 5(2)(b) – see Notes 5.12 and 5.13). It also permits a Contracting Party to require that the applicant file a translation of any other parts of the application which are not in an accepted language, or file a transliteration of, for example, a name or address which is not in an accepted alphabet or character set. Reference is also made to the abbreviated expression "translation" in Article 1(xiii).

6.14 *Paragraph (3), second sentence.* Rule 3(3) provides that a Contracting Party may require, under this provision, a translation of the title, claims and abstract that are in a language accepted by the Office into any other languages accepted by that Office. Amendment of that Rule requires unanimity under Rule 21(iii).

6.15 *Paragraph (4).* This paragraph permits, but does not oblige, a Contracting Party to charge fees in respect of applications. However, it does not regulate to whom the fee is paid, for example, whether it is paid to the Office, another agency of the government or a bank. It also does not regulate the method of payment, so that each Contracting Party is free to decide whether to allow payments made, for example, from a deposit account with the Office or by electronic transaction, or whether to require, for example, in the case of applications filed electronically, that fees be paid by using a deposit account. A Contracting Party is also permitted to require the amount of the fee and/or its method of payment to be indicated, for example, on a fee sheet as prescribed under PCT Rule 3.3(a)(ii).

6.16 In addition to the fee to be paid in respect of the application, a Contracting Party may require the payment of separate fees, for example, for the publication of the application and the granting of the patent. A Contracting Party is permitted to combine those fees and require payment of such a combined fee upon the filing of the application (which may nevertheless be called an "application fee"). Under the second sentence of Article 6(4), payment of the application fee may be subjected to the same time limits, and the same sanctions for non-payment, as those applicable under the PCT, namely, PCT Article 14(3) and Rules 15.4 and 16bis (see Rule 6(3) and Notes 6.22 to 6.24 and R6.02). However, it is made clear in Article 5(1) that a Contracting Party may not refuse a filing date because the application fee has not been paid (see Note 5.02).

6.17 *Paragraph (5).* Regulations under this paragraph are prescribed in Rule 4. When adopting Articles 6(5) and 13(3) and Rules 4 and 14, the Diplomatic Conference urged the World Intellectual Property Organization to expedite the creation of a digital library system for priority documents, as being of benefit to applicants, patent owners and third parties wanting access to priority documents (Agreed Statement No.3).

6.18 *Paragraph (6).* This paragraph reduces the burden on applicants by restricting the need for evidence in support of the formal contents of applications, declarations of priority and translations. Although it is for each Contracting Party to interpret the phrase "may reasonably doubt the veracity of any matter," the intention is that the Office may not ask for evidence on a systematic or a "spot-check" basis, but only where there are grounds for reasonable doubt. For example, where the applicant claims the benefit of Article 3 of the Paris Convention, but there is doubt as to the veracity of the applicant's allegations as to his nationality, the Office may require evidence in that matter. The Office is obliged, under paragraph (7), to notify the applicant of the requirement to file evidence and, under Rule 5, to state its reason for doubting the veracity of the matter in question.

6.19 In accordance with Article 2(2), the provisions of paragraph (6) do not apply to evidence that may be required in respect of substantive patent law. In particular, irrespective of whether or not there is reasonable doubt, a Contracting Party is permitted to require evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, as is also allowed as a national requirement in respect of international applications under PCT Rule 51*bis*.1(a)(v).

6.20 *Paragraph (7).* The time limits under this paragraph are prescribed in Rule 6(1) and (3). Reference is also made to the general provisions on notifications under Article 9 (see Notes 9.01 to 9.05).

6.21 *Paragraph (8).* The time limits under this provision are prescribed in Rule 6(1) to (3).

6.22 *Paragraph (8)(a).* The sanction which may be applied under this provision may include refusal of the application. The effect of the reference to Article 5 is that a Contracting Party may not revoke a filing

date for failure to comply with requirements referred to in this provision.

6.23 Where the application fee, if any, is not paid, the sanction may be the same as that applicable under the PCT in respect of the non-payment of fees due upon filing an international application (PCT Article 3(4)(iv)), that is, the international application is considered withdrawn (PCT Article 14(3)(a)) but the filing date is not affected. Where the application fee is paid late in response to a notification under Article 6(7), the Contracting Party may require the payment of a late payment fee (see PCT Rule 16*bis*). As to the time limit for payment, see Rule 6(3) and Note R6.02.

6.24 In addition, in cases where the application fee is not paid, a Contracting Party is free to subject the provision of copies of the application to the applicant (typically for use as priority documents) to the payment of a surcharge in addition to the usual fee. Furthermore, a Contracting Party is free to impose a fee for retention of an application for which a filing fee has not been paid, for the purpose of retaining the application for the benefit of priority claims in subsequently filed applications.

6.25 The effect of the reference to Article 10 in paragraph (8)(a) is that a Contracting Party cannot revoke or invalidate a patent for failure to comply with the requirements applied under paragraphs (1), (2), (4) and (5), except where the non-compliance occurred as a result of a fraudulent intention.

6.26 *Paragraph (8)(b).* In accordance with Article 4D(4) of the Paris Convention, the consequence of failure to comply with the formality requirements in respect of a priority claim within the time limit prescribed in Rule 6(1) or (2) is generally the loss of the priority right. In addition, under this provision, the application may not be refused for failing to comply with such requirement. Nevertheless, where the description and drawings of a later application are replaced by a reference to a previously filed application under Article 5(7)(a), and the requirements under that Article, as prescribed in Rule 2(5), are not complied with within the time limit applicable under that Rule, the Contracting Party may refuse that later application under Article 5(7)(b), even where the same requirements are applicable in

respect of a priority claim in the later application. The words "Subject to Article 13" are included to cover the situation in which a priority claim is corrected or added, or a priority right is restored, under that Article.

Notes on Article 7
(Representation)

7.01 This Article relates only to the appointment of a representative and to the possible limitation of the effect of such appointment, but does not deal with the termination of the appointment. In the latter respect, and in respect of any other matter relating to representation which is not covered by the Treaty, a Contracting Party is free to establish whatever provisions that it wishes. For example, a Contracting Party may provide that the appointment of a new representative terminates the appointment of all previous representatives unless otherwise indicated in the power of attorney. Or, a Contracting Party that allows sub-representation may require that the power of attorney expressly authorize a representative to appoint sub-representatives. Furthermore, a Contracting Party may require that, in the case of two or more co-applicants, those co-applicants be represented by a common representative.

7.02 *Paragraph (1)(a), introductory words.* As regards the terms "representative" and "procedure before the Office," reference is made to the explanations under Article 1(x) and (xiv), respectively (see Notes 1.08 and 1.11).

7.03 *Item (i).* The phrase "have the right ... to practice before the Office" is modeled after the terminology in PCT Rule 90.1(a) to (c). This item permits a Contracting Party to require that the appointed representative be a person, for example, a registered patent attorney, who is admitted to practice before the Office in respect of applications and patents. It also permits a Contracting Party to have a less strict requirement, for example, that any person may be appointed as representative unless debarred from acting as a representative on the grounds of misconduct. This item also leaves to the applicable law the matter of whether, and what type of, a firm or partnership may be appointed as a representative.

7.04 *Item (ii).* This item permits a Contracting Party to require that a representative provide, as his address, an address on a territory prescribed by the Contracting Party. A Contracting Party may apply this requirement instead of, or in addition to, the requirement that the applicant have the right to practice before the Office under item (i). A Contracting Party may, in particular, require under item (ii) that the address be on its own territory. Alternatively, it may require that the address be on any of two or more territories; for example, a Contracting Party that is a member of a regional grouping, such as the European Union, may require that the address be on the territory of any member State of that regional grouping. This item is without prejudice to the right of a Contracting Party to require that a communication contain the address of the representative under Rule 10(1)(b)(i) and an address for correspondence and/or legal service on its own territory under Article 8(6) and Rule 10(2) and (4).

7.05 *Paragraph (1)(b) and (c).* Paragraph (b) is modeled after PCT Rule 90.3(a). The term "procedure before the Office" is defined under Article 1(xiv) (see Note 1.11). Where any provision of the Treaty or Regulations refers to an act by, or in relation to, an applicant, that act may be performed by, or in relation to, the applicant's representative. For example, where a communication is required to be signed by the applicant, the communication may be signed by the representative on behalf of the applicant. However, under paragraph (1)(c), in the case of an oath or declaration or the revocation of a power of attorney, a Contracting Party is free to provide that the signature of a representative shall not have the effect of the signature of the applicant. The situation is the same where an owner or other interested person is represented. Where the Office is required to notify an applicant under Article 5(3) or 6(7), the notification is normally sent to the applicant's representative. However, a Contracting Party may provide that correspondence be sent to the person who is represented, where that person provides his own address as the address for correspondence and/or legal service under Article 8(6).

7.06 *Paragraph (2)(a).* This provision permits, but does not oblige, a Contracting Party to require representation for the purposes of any procedure before the Office, except as provided under items (i) to (iv) and subparagraph (b).

7.07 Where an assignee of an application, an applicant, owner or other interested person from abroad acts for himself before the Office in respect of any of the procedures included in items (i) to (iv), he may be required, under Article 8(6) and Rule 10(2), to provide an address for correspondence and/or legal service on a prescribed territory (in particular, a territory in which the Office is located).

7.08 Items (i) to (iv) do not prevent an assignee of an application, an applicant, owner or other interested person from appointing a representative for any of the procedures concerned. However, any representative who is appointed must comply with the requirements under paragraph (1) applied by the Contracting Party concerned. In particular, it is permissible for an applicant to appoint a representative from his own country to represent him in a foreign country, only if that representative is entitled to practice in that foreign country, which will not normally be the case.

7.09 "An assignee of an application" could, in particular, be a corporate applicant who is an assignee of the right, title and interest in an application, where the applicable law of a Contracting Party requires the patent to be applied for in the name of the actual inventor. As regards the terms "applicant," "owner," and "procedure before the Office," reference is made to the explanations under Article 1(viii), (ix) and (xiv) (see Notes 1.07, 1.08, and 1.11). As regards the expression "other interested person," reference is made to the explanation under Article 8(6) (see Note 8.14).

7.10 *Item (i).* This item permits an assignee of an application or an applicant (as defined in Article 1(viii)) to file an application for the purposes of the filing date without appointing a representative. In particular, it permits the assignee or applicant to file the elements of an application referred to in Article 5(1), or an application containing a reference to a previously filed application under Article 5(7). It is implicit that the application filed by the assignee or applicant for the purposes of the filing date may additionally contain one or more elements additional to those referred to in Article 5(1). In particular, the application as filed may contain one or more claims and/or be accompanied by a translation and the filing fee. However, a Contracting Party is permitted to require that, after the filing date, a representative be appointed for, for example, filing one or more

claims under Article 6(1) or a translation of a previously filed application under Rule 2(5)(b) or the payment of a filing fee as required under Article 6(4).

7.11 *Item (ii).* The expression "mere payment of a fee" permits a Contracting Party to require representation for any other act that is associated with the payment of the fee concerned, for example, a request for search or examination. Any Contracting Party may decide whether the payment of the fee is mere or not.

7.12 *Item (iii).* Other procedures under this item, in respect of which the appointment of a representative may not be mandatory, are prescribed in Rule 7(1) (see Note R7.01). Amendment of that Rule requires unanimity under Rule 21(iii).

7.13 *Item (iv).* Under this item, the requirement to appoint a representative is expressly excluded for the issue of a receipt or a notification by the Office in respect of any of the procedures referred to in items (i) to (iii). It is to be noted that, under Article 8(6) and Rule 10, a Contracting Party may require that the assignee, applicant, owner or other interested person concerned provide an address for correspondence and/or an address for legal service on a prescribed territory (in particular, its own territory) to which the receipt or notification in question can be sent.

7.14 *Paragraph (2)(b).* This provision obliges a Contracting Party to accept the payment of maintenance fees by, for example, the owner himself or a maintenance fee payment company that does not have right to be appointed as a representative for procedures before the Office. It is to be noted that, under Article 8(6) and Rule 10, a Contracting Party may require that the owner, or other person paying the maintenance fees, provide an address for correspondence and/or an address for legal service on a prescribed territory (in particular, its own territory) to which any receipt or notification in respect of those fees can be sent.

7.15 *Paragraph (3).* The Regulations under this paragraph are prescribed in Rule 7(2) to (4).

7.16 *Paragraph (4).* This paragraph establishes the exhaustive character of the list of formal requirements permitted under paragraphs (1) to (3)

with respect to the matter of representation dealt with under these paragraphs. The requirements referred to in this paragraph which are "otherwise provided for by this Treaty or prescribed in the Regulations" are, in particular, those under Article 8 and Rules 7 and 15(8).

7.17 *Paragraph (5).* The time limit under this paragraph is prescribed in Rule 7(5). Reference is also made to the provisions on notifications under Article 9 (see Notes 9.01 to 9.05).

7.18 *Paragraph (6).* The time limit under this paragraph is prescribed in Rule 7(5) and (6).

Notes on Article 8
(Communications; Addresses)

8.01 As to the term "communication," reference is made to Article 1(v).

8.02 *Paragraph (1)(a).* The requirements that a Contracting Party is permitted to apply under this provision are prescribed in Rule 8. In particular, Rule 8(2) applies the requirements under the PCT in relation to communications filed in electronic form or by electronic means (see Notes R8.05 to R8.08). The exception in respect of the filing date under Article 5(1) is needed because that Article provides for a filing date to be accorded where the prescribed elements of an application are filed, at the option of the applicant, on paper or as otherwise permitted by the Office for the purposes of the filing date. The effect of the reference to Article 6(1) is that, in the case of an application, the requirements in respect of the form or contents of an application under that Article prevail over the provisions under this paragraph.

8.03 The "form" of communication refers to the physical form of the medium which contains the information, for example, paper sheets, a floppy disk or an electronically transmitted document. It also encompasses physical requirements, and the presentation or arrangement of the information or data in a communication, for example, a format which uses standard data identifier tags to facilitate converting data from paper to electronic form. In addition, it also includes the notion of "electronic document formats," such as pdf, XML, SGML, TIFF. The "means of transmittal"

refers to the means, for example, the physical or electronic means, used to transmit the communication to the Office. For example, an application on paper mailed to the Office is a communication in paper form transmitted by physical means, while a floppy disk mailed to the Office is a communication in electronic form transmitted by physical means. A telefacsimile transmission resulting in a paper copy is a communication in paper form transmitted by electronic means, while a telefacsimile transmission to a computer terminal is a communication in electronic form transmitted by electronic means. In addition, an electronic transmission from computer to computer is a communication in electronic form transmitted by electronic means. The term "filing of communications" refers to transmission of a communication to the Office. A Contracting Party is not required to accept the filing of communications in any and all electronic forms, or by any and all electronic means of transmittal, simply because that Contracting Party permits the filing of communications in electronic form or by electronic means. Rule 8(2)(b) specifies that a Contracting Party shall notify the International Bureau of the requirements under its applicable law relating to such filing.

8.04 *Paragraph (1)(b) and (c).* These provisions ensure that no Contracting Party is obliged, against its wishes, to accept the filing of communications in electronic form or by electronic means of transmittal, or to exclude the filing of communications on paper. The Office of any Contracting Party may choose to accept filings on paper only, or both paper and electronic filing. This will continue to be the case after June 2, 2005, even though after that date any Contracting Party will be permitted, under Rule 8(1)(a), to exclude the filing of communications on paper, except as provided under Article 8(1)(d) and Article 5(1).

8.05 *Paragraph (1)(d).* Under this provision, a Contacting Party is obliged to continue to accept the filing of communications on paper for the purpose of complying with a time limit, even where, after June 2, 2005, a Contracting Party excludes the filing of communications on paper under Rule 8(1)(a). The phrase "on paper" refers to paper form transmitted by physical means (see Note 8.03). Where, for the purposes of complying with a time limit, an applicant files a communication on paper with an Office that requires the filing of communications in electronic form or by electronic means of transmittal, that Office will be

permitted to treat the filing on paper as a formal defect, and to require, under paragraph (7), that the communication be re-filed in an electronic form or by electronic means of transmittal complying with the requirements applied by that Contracting Party under Rule 8.

8.06 *Paragraph (2).* This paragraph provides, generally, that a Contracting Party may require that any communication be in a language accepted by the Office. However, Article 5(2)(b) expressly provides that, for the purposes of the filing date, the part of the application which on the face of it appears to be a description may be in any language. In that case, the Office may require that a translation be filed under Article 6(3) (see also Note 6.13). The Treaty and Regulations also expressly provide for the filing of a translation of: (i) a copy of an earlier application under Article 6(5) and Rules 2(4)(iii) and 4(4); (ii) a copy of a previously filed application under Rule 2(5)(b)(i); (iii) a power or attorney under Rule 7(3); and (iv) documentation of the basis of a change in applicant or owner under Rule 16(3), or of the basis of a license under Rule 17(3). As regards the expression "a language accepted by the Office," reference is made to the explanation under Article 1(xii) (see Note 1.10).

8.07 *Paragraph (3).* This paragraph obliges a Contracting Party to accept communications filed on a Model International Form established under Article 14(1)(c) and Rule 20. The effect of the phrase "subject to paragraph (1)(b)" is that a Contracting Party that does not accept the filing of communications other than on paper is not obliged to accept the filing of a communication on a Model International Form that applies, for example, to communications filed in electronic form or by electronic means of transmittal. As regards the possibility, under Rule 8(1)(a), for a Contracting Party to exclude the filing of communications on paper after June 2, 2005, reference is made to the explanations under paragraph (1)(d) and Articles 5(1)(a) and 6(2)(b) (see Notes 8.05, 5.06 and 6.12).

8.08 *Paragraph (4).* In accordance with Article 1(xi), the term "signature" means any means of self-identification (see also Note 1.09).

8.09 *Paragraph (4)(a).* Regulations concerning the signature of communications filed on paper, in electronic form or by electronic means of transmittal are prescribed in Rule 9.

8.10 *Paragraph (4)(b).* Except in the cases referred to in Notes 8.11 and 8.12, this provision obliges a Contracting Party to accept a signature of the person concerned as sufficient authentication of a communication without the need for further authentication by way of, for example, attestation or notarization of that signature, thereby reducing the burden on applicants, owners and other interested persons.

8.11 In accordance with the express exception under paragraph (4)(b), a Contracting Party may require attestation, notarization, authentication, legalization or other certification of the signature of communications to the Office in respect of quasi-judicial proceedings. It is a matter for the Contracting Party concerned to determine what constitute such quasi-judicial proceedings. Also, in accordance with the exception prescribed in Rule 9(6), a Contracting Party may require confirmation of a signature in electronic form which does not result in a graphic representation of the signature.

8.12 *Paragraph (4)(c).* In case of reasonable doubt as to the authenticity of the signature, the Office may require the applicant, owner or other person filing the communication to file evidence of authenticity. Such evidence may, at the option of the applicant, owner or other interested person, be in the form of a certification, even though such certification may not be required by the Office under paragraph (4)(b). The Office is obliged under Rule 5 to inform the applicant of the reason for its doubt. In addition, the same considerations that apply to the requirement for evidence under this provision also apply to the requirement for evidence in respect of an application under Article 6(6) (see Note 6.18).

8.13 *Paragraph (5).* The indications that a Contracting Party may require under this paragraph are prescribed in Rule 10(1).

8.14 *Paragraph (6), introductory words.* As regards the terms "applicant" and "owner," reference is made to the explanations under Article 1(viii) and (ix), respectively (see Notes 1.07 and 1.08). An "other interested person" could be, for example, a petitioner for the revocation of a patent or, in the case of a transfer of an application or patent, the new applicant or owner. As regards the sanction for failure to comply with the requirements under paragraph (6), reference is made to paragraph (8) (see Note 8.18).

8.15 *Items (i) and (ii).* What constitutes an address for correspondence or an address for legal service under these items is a matter for the applicable law of the Contracting Party concerned. It is also a matter for the applicable law of the Contracting Party concerned as to whether, and in what circumstances, the Office requires an address for correspondence or an address for legal service, or both, and in what communications such address(es) shall be indicated. Since the term "address for service" may be construed, depending on the applicable law, as either of the addresses under item (i) or (ii), a Contracting Party may use the term "address for service" in place of "address for correspondence" or "address for legal service," or both. The Regulations under these items are prescribed in Rule 10(2) to (4) (see Notes R10.03 to R10.05).

8.16 *Item (iii).* This item is intended to provide for any future developments which necessitate a Contracting Party requiring an address other than those under items (i) and (ii), for example, an e-mail address or other electronic location. At present, no provision for such other address is included in the Regulations.

8.17 *Paragraph (7).* It is to be noted that, under this paragraph, the Office is required to notify either the applicant, owner or other interested person who filed the communication, not all three. The time limit under this paragraph is prescribed under Rule 11(1). Reference is also made to the general provisions on notification under Article 9 (see Notes 9.01 to 9.05).

8.18 *Paragraph (8).* The time limit under this paragraph is prescribed in Rule 11(1) and (2). The effect of the reference to Article 5 is that, where an application complies with the requirements under that Article for according a filing date, a Contracting Party is obliged to accord that filing date and cannot revoke the filing date for failure to comply with requirements applied under paragraphs (1) to (6), even where the application is subsequently refused or considered withdrawn under this paragraph (see also Note 5.01). The effect of the reference to Article 10 is that a Contracting Party cannot revoke or invalidate a patent for failure to comply with the requirements applied under paragraphs (1) to (4), except where the non-compliance occurred as a result of a fraudulent intention. Reference is also made to the restrictions on the sanctions that may be applied under this paragraph as prescribed in Rule 10(5).

Notes on Article 9
(Notifications)

9.01 This Article does not regulate the means of notification, for example, by mail, registered mail, or publication of a notice in an Official Gazette, or what constitutes the date of a notification for the purposes of determining the expiration of a time limit calculated from that date. These matters are therefore left to the applicable law of the Contracting Party concerned.

9.02 *Paragraph (1).* This paragraph prescribes the addresses that a Contracting Party is obliged to regard as sufficient for the purpose of notifications under the Treaty and Regulations. The reference to "any other address provided for in the Regulations for the purpose of this provision" is to provide for the possibility of permitting a Contracting Party to utilize, for example, an e-mail address or other electronic location, for the purpose of notifications in the future. However, no such other addresses are provided for in the Regulations at present. Where an address referred to in this paragraph has not been provided to the Office, a Contracting Party may, but is not obliged to, additionally provide that a notification has legal effect if it is sent to an address that is not referred to in this paragraph but has been provided. In particular, where the applicant provides indications allowing him to be contacted by the Office under Article 5(1)(a)(ii) and (c), but neither an address for correspondence nor an address for legal service has been provided, a notification that is sent by the Office to such a contact address may constitute a sufficient notification. A Contracting Party may also provide for other means of notification under its applicable law. Reference has not been made to the address in Article 8(6)(iii), since such an address may be required for purposes other than notification.

9.03 *Paragraph (2).* This provision is included for avoidance of doubt. It applies, in particular, where, as permitted for the purposes of the filing date under Article 5(1)(a)(ii) and (c), an application contains indications allowing the identity of the applicant to be established but not indications allowing the applicant to be contacted by the Office.

9.04 *Paragraph (3).* This paragraph is included for the avoidance of doubt. It is to be noted that, in general, the prescribed time limits for compliance with requirements under the Treaty and Regulations are

calculated from the date of notification and therefore do not commence until that notification has been made. The only exceptions are where a notification has not been made because indications allowing the person concerned to be contacted by the Office have not been filed and where a notification has not been made with respect to a missing part of the description or missing drawing under Article 5(6)(a) and (b) (see Rule 2(3)(ii) and Note R2.02). The effect of the reference to Article 10 is that a Contracting Party cannot revoke or invalidate a patent for failure to comply with the requirements applied under Articles 6(1), (2), (4) and (5) and 8(1) to (4), except where the non-compliance occurred as a result of a fraudulent intention.

9.05 It is also to be noted that this paragraph does not relieve the Office of any obligation under the Treaty and Regulations to notify an applicant, owner or other interested person of a failure to comply with a requirement.

Notes on Article 10
(Validity of Patent; Revocation)

10.01 *Paragraph (1).* This paragraph establishes that, where after a patent has been granted on an application, it is subsequently discovered that the application failed to comply with one or more of the specified formal requirements, such non-compliance may not be a ground for revocation or invalidation of that granted patent, except in the case of fraudulent intention. This applies both in respect of such grounds before the Office and such grounds before any other competent authority, including a court. This also applies irrespective of whether the non–compliance occurred because the Office failed to notify the applicant, under Article 6(7) or 8(7), of the failure to comply with the requirement(s) concerned or because the applicant failed to comply with the requirement(s) in response to a notification under those Articles. Reference is also made to the explanation under Article 9(3) (see Notes 9.04 and 9.05). The phrase "it may not be revoked or invalidated" is intended to also cover sanctions which are of equivalent effect to revocation or invalidation, such as non-enforceability of rights.

10.02 Paragraph (1) is restricted to the case of non-compliance with the requirements referred to in Article 6(1), (2), (4) and (5) and 8(1) to (4) as these are requirements which, although they may be needed for the

processing of the application, are not essential to the content of the granted patent. A Contracting Party is permitted, but not obliged, to provide for the revocation or invalidation of a granted patent when it is subsequently discovered that the application did not comply with any other formal requirements, in particular, that a translation of any part of the application required under Article 6(3), or evidence required under Article 6(6), had not been filed.

10.03 This provision does not prevent the revocation of a patent granted on an application where the application did not comply with a substantive requirement, for example, a requirement that the description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art or indicate the best mode for carrying out the invention known to the inventor.

10.04 Since paragraph (1) is restricted to requirements in respect of applications, it does not prevent the revocation or invalidation of a granted patent for failure to comply with formal requirements in respect of the patent itself, for example, the requirement under a regional treaty for the filing of a translation of a regional patent. Similarly, it covers only those fees payable prior to the grant of a patent, such as the filing, publication and grant fees. It does not cover the lapse of a patent for the non-payment of a maintenance fee. This paragraph is also not applicable where there has been a voluntary surrender of a patent for the purpose of re-issue.

10.05 The exception for the situation in which the non-compliance occurred as a result of fraudulent intention is included to prevent the applicant benefiting from such fraud. What constitutes "fraudulent intention" is a matter for the applicable law of the Contracting Party. In particular, it may be interpreted to cover inequitable conduct. Alternatively, it may be restricted to the situation in which civil or criminal liability is established.

10.06 *Paragraph (2).* This paragraph provides two safeguards for owners in respect of the formal aspects of proceedings for the revocation or invalidation of a patent. First, the owner must be given at least one opportunity to make observations on the intended revocation or invalidation. Second, the owner must be given at least one opportunity to make amendments and corrections where permitted under the applicable law. This paragraph does not regulate the form

of observations which an owner may make. For example, an owner may be given the opportunity to file written observations. Alternatively, a Contracting Party may provide only for oral observations. The effect of the expression "where permitted under the applicable law" is that no Contracting Party is required to provide an opportunity for amendments and corrections to be made where its national law does not provide for such amendments or corrections, either at all or in the circumstances of the particular proceedings.

10.07 Paragraph (2) applies to all proceedings for the revocation or invalidation of a patent. It therefore applies, subject to the provisions of paragraph (3) (see Note 10.09), to proceedings before the Office and to proceedings before any other competent authority, including a court. It also applies to all such proceedings irrespective of the grounds for revocation or invalidation, that is including substantive grounds, for example, lack of novelty. However, except as provided under paragraph (1), the grounds on which a granted patent may be revoked or invalidated, such as lack of novelty, as well as any other aspect of such proceedings, are not regulated by this paragraph and remain a matter for the applicable law of the Contracting Party concerned.

10.08 As in the case of paragraph (1), the phrase "A patent may not be revoked or invalidated" is intended to also cover sanctions which are of equivalent effect to revocation or invalidation, such as non-enforceability of rights (see Note 10.01).

10.09 *Paragraph (3).* This paragraph ensures that a Contracting Party may continue to apply any procedures, under its applicable law, for the enforcement of law in general to proceedings for the revocation or invalidation of a patent.

Notes on Article 11
(Relief in Respect of Time Limits)

11.01 This Article obliges a Contracting Party to provide relief in respect of time limits. Such relief may be in the form of an extension of a time limit under paragraph (1) and/or continued processing under paragraph (2). Such relief is subject only to the filing of a request in

accordance with the requirements of paragraph (1) or (2) and Rule 12 (see Note 11.08), and the payment of any fee required under paragraph (4). Accordingly, the applicant or owner cannot be required to state the grounds on which the request is based. In addition, in contrast to the reinstatement of rights under Article 12, a Contracting Party is not permitted to make the grant of relief under Article 11 conditional on a finding of due care or unintentionality by the Office.

11.02 The relief that a Contracting Party is obliged to provide under paragraphs (1) and (2) is restricted to time limits "fixed by the Office for an action in a procedure before the Office." It is further subject to certain exceptions under paragraph (3) and Rule 12(5) (see Notes R12.02 to R12.07). The term "procedure before the Office" is defined in Article 1(xiv). When adopting that Article, the Diplomatic Conference understood that the words "procedure before the Office" did not cover judicial procedures under the applicable law (see Note 1.11). It is for each Contracting Party to decide which time limits, if any, are fixed by the Office. An example of a time limit that is fixed by some Offices is the time limit for response to an examiner's substantive examination report. It follows that Article 11 does not apply to time limits that are not fixed by the Office, in particular, time limits established by national legislation or under a treaty providing for the grant of regional patents. It also does not apply to time limits for actions that are not before the Office, for example, actions before a court. Accordingly, although a Contracting Party is free to apply the same requirements in respect of such other time limits, it is also free to apply other requirements, or to make no provision for relief (other than reinstatement of rights under Article 12), in respect of those other time limits.

11.03 *Paragraph (1).* This paragraph provides for relief in the form of the extension of a time limit fixed by the Office. Under item (i), a Contracting Party may require that the request for extension be filed before the expiration of that time limit. Under item (ii), a Contracting Party may require that the request be filed after that expiration and within the time limit prescribed in Rule 12(2)(b). A Contracting Party may, of course, provide for both types of relief under items (i) and (ii). The requirements in respect of the request, the period of the extension, and the time limit for filing a request referred to in item (ii) are

prescribed in Rule 12(1) and (2). In particular, a Contracting Party may, under Rule 12(1)(b), require that all of the requirements in respect of which the time limit to be extended applied be complied with at the same time as the request under item (ii) is filed.

11.04 Paragraph (1) does not oblige a Contracting Party to provide for the extension of a time limit fixed by the Office under either item (i) or (ii). However, a Contracting Party that does not provide for extension after expiration of the time limit under item (ii) must provide for continued processing under paragraph (2).

11.05 *Paragraph (2).* This paragraph obliges a Contracting Party to provide for relief in the form of continued processing, after the applicant or owner has failed to comply with a time limit fixed by the Office, where that Contracting Party does not provide for the extension of time limits under paragraph (1)(ii). The effect of such continued processing is that the Office continues with the procedure concerned as if that time limit had been complied with. Also, the Office must, if necessary, reinstate the rights of the applicant or owner with respect to the application or patent concerned. The requirements in respect of the request referred to in item (i) are prescribed in Rule 12(3). The time limit for filing a request, and complying with all of the requirements in respect of which the time limit concerned applied, referred to in item (ii), is prescribed in Rule 12(4).

11.06 *Paragraph (3).* The exceptions under this paragraph are prescribed in Rule 12(5).

11.07 *Paragraph (4).* Although a Contracting Party is permitted to charge a fee under this paragraph, it is not obliged to do so. Reference is also made to the explanation given under Article 6(4) (see, in particular, Note 6.15).

11.08 *Paragraph (5).* This provision prohibits a Contracting Party from imposing requirements additional to those provided under paragraphs (1) to (4). In particular, the applicant or owner concerned cannot be required to state the grounds on which the request is based or to file evidence with the Office. The requirements referred to in this paragraph which are "otherwise provided for by this Treaty or prescribed in the Regulations" are, in particular, those under Articles 7 and 8 and Rules 7 to 10.

11.09 *Paragraph (6).* This paragraph only gives the requesting party the right to make observations on the intended refusal of a request under paragraph (1) or (2), for example, to assert that a fee required under paragraph (4) had in fact been paid. The term "intended refusal" does not imply that a Contracting Party would have to notify an applicant prior to refusal, giving him the opportunity to show the cause why a request should not be denied. This paragraph does not provide an additional time limit to comply with any requirement under Article 11 or Rule 12 that was not complied with in making the request. As in the case of Article 10(2), this paragraph does not regulate the form of observations which an applicant or owner must be given an opportunity to make (see Note 10.06). The term "refusal" is meant also to cover sanctions which are of equivalent effect to refusal of the request under paragraph (1), such as the request being treated as abandoned or withdrawn.

Notes on Article 12
(Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office)

12.01 This Article obliges a Contracting Party to provide for the reinstatement of rights with respect to an application or patent following failure to comply with a time limit for an action in a procedure before the Office. In contrast to Article 11, such reinstatement is subject to a finding by the Office that the failure occurred in spite of due care required by the circumstances or, at the option of the Contracting Party, was unintentional. Also in contrast to Article 11, Article 12 is not restricted to time limits fixed by the Office, although it is subject to certain exceptions under paragraph (2) and Rule 13(3). A Contracting Party may, in accordance with Article 2(1), provide for continued processing in place of reinstatement of rights under Article 12 where the requirements in respect of such continued processing are more favorable, from the viewpoint of applicants and owners, than the requirements under Article 12 and Rule 13.

12.02 *Paragraph (1), introductory words.* The phrase "that failure has the direct consequence of causing a loss of rights with respect to an application or patent" is intended to cover the situations where a failure to comply with a time limit causes a loss of rights with respect

to the ability to obtain or maintain a patent. For example, where failure to comply with a time limit under Rule 2(3) pursuant to Rule 2(4) in respect of filing a copy of the earlier application in relation to the filing date requirements concerning the missing part of the description under Article 5(6)(b) has the direct consequence of the loss of the earlier filing date which, in turn, has the indirect consequence of the refusal of the application on the grounds of prior publication, a Contracting Party is not obliged to provide, under paragraph (1), for reinstatement of the loss of rights resulting from that refusal. As regards the term "procedure before the Office," reference is made to the explanation under Article 1(xiv). When adopting that Article, the Diplomatic Conference understood that the words "procedure before the Office" did not cover judicial procedures under the applicable law (see Note 1.11).

12.03 *Item (i).* The Regulations under this item are prescribed in Rule 13(1).

12.04 *Item (ii).* The time limit under this item is prescribed in Rule 13(2).

12.05 *Item (iii).* The applicant or owner may be required under paragraph (4) to file a declaration or other evidence in support of the reasons referred to in this item.

12.06 *Item (iv).* This item restricts reinstatement of rights under paragraph (1) to cases where the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances, or, at the option of the Contracting Party, was unintentional, for example, where there had been a loss in the mail or an interruption in the mail service, as provided for under PCT Rule 82. In making that finding, the Office may allow interested third parties to oppose to the request for reinstatement of rights.

12.07 *Paragraph (2).* The exceptions under this paragraph are prescribed in Rule 13(3).

12.08 *Paragraph (3).* Reference is made to the explanations given under Article 6(4) (see, in particular, Note 6.15).

12.09 *Paragraph (5).* Reference is made to the explanations given under Article 11(6) (see Note 11.09).

12.10 *Intervening Rights.* The Treaty and Regulations do not regulate the rights, if any, acquired by a third party for any acts which were started, or for which effective and serious preparations were started, in good faith, during the period between the loss of rights resulting from the failure to comply with the time limit concerned and the date on which those rights are reinstated. These remain a matter for the applicable law of the Contracting Party concerned.

Notes on Article 13
(Correction or Addition of Priority Claim; Restoration of Priority Right)

13.01 *Paragraph (1).* This provision, which is modeled after PCT Rule 26*bis*.1, permits the applicant to correct or add a priority claim, on or after the filing date, to an application which could have claimed the priority of an earlier application but did not do so. It applies both where the application as filed contains no priority claim and where the application already claims the priority of one or more earlier applications. It is to be noted that the Paris Convention does not require that the priority claim ("the declaration" referred to in Article 4D(1) of that Convention) be contained in the subsequent application itself.

13.02 *Item (i).* The requirements referred to in this item are prescribed in Rule 14(2).

13.03 *Item (ii).* The time limit referred to in this item is prescribed in Rule 14(3).

13.04 *Item (iii).* It is to be noted that, where the filing date of the subsequent application is later than the date of expiration of the priority period, restoration of the priority right may be possible under paragraph (2).

13.05 *Paragraph (2).* This provision provides for the restoration of the priority right where a subsequent application is filed after the expiration of the priority period, but within the time limit prescribed in Rule 14(4)(a). It applies only where the failure to file the 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. The expression "Taking into consideration Article 15" is intended to clarify that Article 13(2) was adopted by the Diplomatic Conference taking into account the provisions of the Paris Convention.

A priority claim may be restored under this paragraph even if it is not included in the subsequent application as filed, provided that it accompanies the request for restoration (see Rule 14(5)(ii)).

13.06 *Item (i).* The requirements under this item are prescribed in Rule 14(5).

13.07 *Item (ii).* The time limit referred to in this item is prescribed in Rule 14(4)(b).

13.08 *Item (iii).* The applicant may be required under paragraph (5) to file a declaration or other evidence in support of the reasons for the failure to comply with the priority period.

13.09 *Paragraph (3).* This paragraph provides a remedy for the applicant where a right of priority is lost because of the failure, on the part of the Office with which the earlier application was filed to provide a copy of that application in time, to comply with the time limit applicable under Article 6(5), despite a timely request for that copy having been made. Since this time limit is normally established by national legislation or under a regional treaty, but not by the Office, a remedy in this respect will not normally be available by way of extension of time limit or continued processing under Article 11. When adopting Articles 6(5) and 13(3) and Rules 4 and 14, the Diplomatic Conference urged the World Intellectual Property Organization to expedite the creation of a digital library system for priority documents. Such a system would be of benefit to applicants, patent owners and others wanting access to priority documents (Agreed Statement No. 3).

13.10 *Item (i).* The requirements under this item are prescribed in Rule 14(6).

13.11 *Item (ii).* The effect of this item is to permit an applicant who is unable to file the required copy of the earlier application within the time limit referred to in Rule 4(1) to, instead, file a request for restoration of the priority right within that time limit.

13.12 *Item (iii).* The time limit for making a request for a copy of the earlier application under this item is prescribed in Rule 14(7). This time limit provides a legal assurance for the applicant in that, if he requests a copy of the earlier application within that time limit, he is entitled to

restore his priority right in the event that the Office concerned fails to provide that copy in time for compliance with the time limit referred to in Rule 4(1). It is implicit that the request for a copy of the earlier application must, within the time limit prescribed in Rule 14(7), comply with any requirements in relation to that request, in particular, it must be accompanied by the applicable fee.

13.13 *Paragraph (4).* Reference is made to the explanations given under Article 6(4) (see, in particular, Note 6.15).

13.14 *Paragraph (6).* Reference is made to the explanations given under Article 11(6) (see Note 11.09).

13.15 *Intervening Rights.* Reference is made to the explanations regarding intervening rights under Article 12 (see Note 12.10).

Notes on Article 14
(Regulations)

14.01 *Paragraph (1)(b).* The Regulations under this provision are prescribed in Rules 15 to 18.

14.02 *Paragraph (1)(c).* The Regulations under this provision are prescribed in Rule 20. Reference is also made to Article 17(2)(ii).

14.03 *Paragraph (3)(a).* The Rules that require unanimity under this provision are specified in Rule 21.

Notes on Article 15
(Relation to the Paris Convention)

15.01 *Paragraph (1).* This paragraph obliges each Contracting Party to comply with those provisions of the Paris Convention which concern patents, namely Articles 2 to 5*quater*, 11 and 12. This obligation applies even if the Contracting Party concerned is not party to the Paris Convention.

15.02 *Paragraph (2)(a).* This provision maintains the existing obligations that Contracting Parties have to each other under the Paris Convention.

15.03 *Paragraph (2)(b).* This provision, maintains the rights of applicants and owners under the Paris Convention.

Notes on Article 16
(Effect of Revisions, Amendments and Modifications of the Patent Cooperation Treaty)

16.01 Under this Article, revisions, amendments and modifications to the PCT (including the Regulations and Administrative Instructions under the PCT) do not apply automatically for the purposes of this Treaty and the Regulations (the "PLT"). Instead, as provided under Article 17(2)(v), the Assembly referred to in Article 17 (the "PLT Assembly"), is required to decide whether any such revisions, amendments or modifications shall apply for the purposes of the PLT.

16.02 In relation to Articles 1(xvii), 16 and 17(2)(v), the Diplomatic Conference adopted the following agreed statement (Agreed Statement No. 2):

"When adopting Articles 1(xvii), 16 and 17(2)(v), the Diplomatic Conference understood that:

(1) The PLT Assembly would, when appropriate, be convened in conjunction with meetings of the PCT Assembly;

(2) Contracting Parties of the PLT would be consulted, when appropriate, in addition to States party to the PCT, in relation to proposed modifications of the PCT Administrative Instructions;

(3) The Director General shall propose, for the determination of the PCT Assembly, that Contracting Parties of the PLT which are not party to the PCT be invited as observers to PCT Assembly meetings of other PCT bodies, when appropriate;

(4) When the PLT Assembly decides, under Article 16, that a revision, amendment or modification of the PCT shall apply for the purposes of

the PLT, the Assembly may provide for transitional provisions under the PLT in the particular case."

16.03 *Paragraph (1).* This paragraph applies to revisions and amendments of the PCT and its Regulations where these revisions and amendments are adopted by a special conference or the PCT Assembly after June 2, 2000. As regards the Administrative Instructions, this paragraph applies to modifications which are promulgated after June 2, 2000. The effect of this paragraph is that any future revisions, amendments and modifications to the PCT will only apply for the purposes of the PLT if two conditions are satisfied. First, the revision, amendment or modification of the PCT is consistent with the Articles of the PLT. Second, that revision, amendment or modification of the PCT is adopted by the PLT Assembly, for the purposes of the PLT, by a majority of three-fourths of the votes cast. Accordingly future changes to the PCT will not apply for the purposes of the PLT unless and until they are formally adopted by the PLT Assembly.

16.04 *Paragraph (2).* This paragraph relates to provisions of the PCT ("transitional provisions"), by virtue of which a revised, amended or modified provision of the PCT does not apply to a State party to the PCT, or to an Office acting for such a State, for as long as that revised, amended or modified provision is incompatible with the law applied by that State or Office. In accordance with this paragraph, a State or Office is not permitted to apply an existing PCT transitional provision for the purposes of the PLT after it has become bound by the PLT. In addition, if a future PCT Assembly adopts an amendment of the PCT Regulations together with a transitional provision, that transitional provision will also not apply directly under the PLT. However, when the PLT Assembly decides whether an amendment of the PCT Regulations shall apply for the purposes of the PLT, that Assembly may decide to adopt a corresponding transitional provision under the PLT.

Notes on Article 17
(Assembly)

17.01 *Paragraph (1)(a).* This provision establishes an Assembly of Contracting Parties. In accordance with Article 1(xviii), the term "Contracting Party" means any State or intergovernmental organization party to this Treaty.

17.02 *Paragraph (2), item (ii).* This item parallels Article 14(1)(c).

17.03 *Item (v).* Reference is made to the explanations given under Article 16(1) (see Notes 16.01 to 16.03).

17.04 *Paragraph (4)(b), item (ii).* The third sentence of this item ensures that two intergovernmental organizations with one or more States in common, for example, the European Community and the European Patent Organisation, may not both participate in the same vote in place of their member States. The question of whether an intergovernmental organization or its member States should vote is a matter to be decided by that organization and those States.

Note on Article 18
(International Bureau)

18.01 This Article is a standard provision in WIPO Treaties.

Note on Article 19
(Revisions)

19.01 *Paragraph (2).* This paragraph specifies those provisions of the Treaty which may be revised by the Assembly, without requiring a revision conference of the Contracting Parties under Paragraph (1). It is restricted to amendments in respect of the tasks and sessions of the Assembly under Article 17(2) and (6).

Notes on Article 20
(Becoming Party to the Treaty)

20.01 *Paragraph (1).* In addition to States which grant their own patents, States which do not grant patents, but for which patents are obtainable through another Office, are eligible to become party to the Treaty, provided that such States are parties to the Paris Convention or members of WIPO.

20.02 *Paragraphs (2) and (3).* Under paragraph (2), an intergovernmental organization is eligible to become party to the Treaty if it complies with three conditions. First, in line with the requirements for the eligibility of States under paragraph (1), at least one of its member States must be party to the Paris Convention or a member of WIPO. Second, it must make a declaration that (i) it is competent to grant patents with effect for its member States, or (ii) it is competent in respect of, and has its own legislation binding on all its member States concerning, matters covered by the Treaty, and it has, or has charged, a regional Office for the purpose of granting patents with effect in its territory in accordance with that legislation. Third, the intergovernmental organization must also declare that it has been duly authorized, in accordance with its internal procedures, to become party to the Treaty. Those intergovernmental organizations that made the declaration referred to in paragraph (2)(i) or (ii) in the Diplomatic Conference are listed in paragraph (3).

Note on Article 21
(Entry into Force; Effective Dates of Ratifications and Accessions)

21.01 *Paragraphs (1) and (2).* The effect of paragraphs (1) and (2)(i) is that the Treaty will bind the first ten States to ratify or accede to the Treaty three months after the date of ratification or accession by the tenth State. Those ten States will therefore not be able to indicate a later effective date, as provided for in the case of other States, under paragraph (2)(ii).

Notes on Article 22
(Application of the Treaty to Existing Applications and Patents)

22.01 This Article ensures that the Treaty has no retrospective effect with respect to any act that was commenced in a Contracting Party before the date on which that Contracting Party becomes bound by the Treaty. It also ensures that a Contracting Party does not need to maintain two different systems, one in respect of new applications and new patents, and another in respect of existing applications and existing applications.

22.02 *Paragraph (1).* This paragraph obliges a Contracting Party to apply the provisions of the Treaty and Regulations to applications which are pending, and to patents which are in force, on the date on which the Treaty binds that Contracting Party. For example, a Contracting Party is obliged to apply Article 12 to an existing patent where the owner fails to comply with a time limit after the date on which that Contracting Party becomes bound by the Treaty. However, it is to be noted that, since the requirements of Articles 6(1), (2), (4) and (5) and 8(1) to (4) were not applicable to patents granted before the date on which it becomes bound by the Treaty, a Contracting Party is not obliged to apply the provisions of Article 10(1) to such patents. The term "applications which are pending" is intended to refer generally to applications in respect of which, on the date in question, no patent has been granted and no final decision has been made on the refusal, lapse or abandonment of the application, or on a sanction of equivalent effect. The term "patents which are in force" is intended to refer generally to patents which have not expired and in respect of which no final decision has been made on the revocation, invalidation or lapse of the patent, or on a sanction of equivalent effect. However, it is a matter for the Contracting Party concerned to decide which applications are pending, and which patents are in force, on the date on which it becomes bound by the Treaty. It is also to be noted that, under Article 3, the provisions of the Treaty and Regulations also apply to applications filed, and patents granted, after the date on which the Contracting Party concerned becomes bound by the Treaty.

22.03 To ensure that there is no retroactive effect, paragraph (1) is subject to two exceptions. First, a Contracting Party is not obliged to apply, to such pending applications or patents in force, the provisions in respect of the filing date of an application under Article 5, the form or contents of an application under Article 6(1), or the presentation of contents of an application under Article 6(2). Second, it is subject to the provisions of paragraph (2) (see Note 22.04).

22.04 *Paragraph (2).* Under this paragraph, a Contracting Party is not obliged to apply the provisions of the Treaty and Regulations to individual procedures in proceedings with respect to applications and patents, if that procedure commenced before the date on which the Treaty and

Regulations bind that Contracting Party. For example, where the Office of a State notifies a time limit for an action in a procedure that is less than the time limit for that action prescribed by the Regulations, and that State subsequently becomes bound by the Treaty before the expiration of that time limit, the Office is not obliged to change the notified time limit. Similarly, where an applicant or owner has failed to comply with a time limit before the date on which the State concerned became bound by the Treaty, that State is not obliged, for example, to provide relief in respect of that non-compliance under Article 12.

22.05 It is a matter for each Contracting Party concerned to decide what constitutes a "procedure" for the purposes of paragraph (2) and whether a procedure in question commenced before the date on which the Treaty binds that Contracting Party.

Note on Article 23
(Reservations)

23.01 *Paragraphs (1), (2) and (4).* Paragraph (1) permits a State or intergovernmental organization to make a reservation in respect of any requirement under Article 6(1) relating to unity of invention. Under paragraph (2), that reservation must accompany the instrument of ratification of, or accession to, the Treaty. As provided for in paragraph (4), a Contracting Party is not permitted to make any reservation that is not provided for in paragraph (1). It is implicit that a reservation applies only to the State or intergovernmental organization that makes it.

II. Explanatory Notes on the Regulations under the Patent Law Treaty

Notes on Rule 2
(Details Concerning the Filing Date Under Article 5)

R2.01 *Paragraphs (1) and (2).* The time limit of not less than two months from the date of the notification, prescribed by paragraph (1) for subsequent compliance with the filing date requirements of Article 5(1) and (2), is more favorable, from the viewpoint of applicants, than the corresponding time limits under PCT Rules 20.2(a)(ii) and 20.6(b), which prescribe a time limit of between 10 days and one month for fulfilling the filing date requirements in respect of an international application under PCT Article 11(1). It is implicit that, where indications allowing the applicant to be contacted have been filed, the time limit under paragraph (1) does not start running until the Office has notified the applicant under Article 5(3) (see Note 9.04). Where indications allowing the applicant to be contacted have not been filed, the time limit prescribed in paragraph (2) applies.

R2.02 *Paragraph (3).* This paragraph prescribes the time limits for filing a missing part of the description or a missing drawing under Article 5(6)(a) and (b). It is to be noted that the time limit under item (ii) applies in all cases where a notification has not been made, and not only where indications allowing the applicant to be contacted have not been filed.

R2.03 *Paragraph (4), item (iii).* As regards the expression "a language accepted by the Office," reference is made to the explanation under Article 1(xii) (see Note 1.10). As regards the term "translation," reference is made to Article 1(xiii).

R2.04 *Items (iv) and (vi).* The determination under item (iv) that the missing part of the description or missing drawing is completely contained in the earlier application may be carried out as a clerical check, based on the indication provided by the applicant under item (vi) as to where that missing part or missing drawing is contained in the earlier application or translation of the earlier application. As regards the expression "completely contained in the earlier application" in item (iv), reference is made to the explanation under Article 5(6)(b) (see Note 5.20).

R2.05 *Paragraph (5)(a).* In accordance with this provision, the indication that the description and any drawings are replaced by the reference to the previously filed application, as well as the number of that application and the Office with which that application was filed, must be included in the application. This provision does not require that the reference identify any claims of the previously filed application that are incorporated by reference, since claims are not required for the purposes of the filing date.

R2.06 *Paragraph (5)(b).* In order to incorporate the content of the replaced description and drawings, a Contracting Party may require a copy, or a certified copy, and where appropriate, a translation of the previously filed application. A certified copy of the previously filed application referred to in item (ii) may provide a safeguard against fraudulent references.

R2.07 The time limit of not less than four months under item (ii) corresponds to the minimum time limit for filing a certified copy of an earlier application in respect of a priority claim under Rule 4(1) and (2).

R2.08 *Paragraph (5)(c).* Where the applicant indicated in the application containing the reference is not the same as the applicant identified in the previously filed application, the Office may require a declaration or other evidence that the previously filed application had been filed by that applicant's predecessor or successor in title.

R2.09 *Paragraph (6), item (iii).* This item applies where, for example, a court or other competent authority decides that a person other than the applicant is entitled to be granted a patent for an invention and orders that, if a new application for that invention is filed by that other person, it shall be treated as having been filed on the filing date of the earlier application.

Notes on Rule 3

(Details Concerning the Application Under Article 6(1), (2) and (3))

R3.01 *Paragraph (1).* This paragraph provides for further requirements in respect of divisional applications under Rule 2(6)(i), and applications by new applicants determined to be entitled to an invention contained in an earlier application under Rule 2(6)(iii) (see Note R2.09). It does not

provide for indications in respect of applications for a patent of addition, or applications for a continuation or continuation-in-part (as referred to in Rule 2(6)(ii)), since the requirements in respect of such applications under PCT Rule 4.13 and 4.14, respectively, are incorporated by reference under Article 6(1)(i). Amendment of this paragraph requires unanimity under Rule 21(ii).

R3.02 *Paragraph (2), item (i).* This item obliges a Contracting Party to accept the use of a request Form corresponding to the PCT request Form with any modifications established by the Assembly under Rule 20(2). Such modifications could include, for example, omission of the indication for the designation of PCT Contracting States, omission of the indication for the designation of States of regional organizations, and the addition of the indications for a request that the application be treated as a divisional application or an entitlement application referred to in Rule 2(6)(i) and (iii).

R3.03 *Items (ii) and (iii).* Item (ii) permits an applicant to use a PCT request Form for the purpose of filing a national or regional application by accompanying the Form with an indication to that effect. Item (iii) provides for the future possibility that the PCT request Form may be modified to provide for such an indication.

R3.04 *Paragraph (3).* This paragraph is intended to permit a Contracting Party which has more than one official language to require a translation of the title, claims and/or abstract of an application that is in one of the official languages, into any other official languages. Amendment of this provision requires unanimity under Rule 21(iii).

Notes on Rule 4

(Availability of Earlier Application Under Article 6(5) and Rule 2(4) or of Previously Filed Application Under Rule 2(5)(b))

R4.01 *Paragraph (1).* The time limit under this provision for filing a copy of the earlier application is not less than 16 months from the filing date of the earlier application. This time limit, which is the same as that under PCT Rule 17.1, is more generous than the minimum period of three months from the filing of the subsequent application provided

in Article 4D(3) of the Paris Convention. It is to be noted that, under that Article of the Paris Convention, a Contracting Party may not require a fee for the filing of the copy, if it is filed within three months of the filing of the subsequent application. If the time limit under paragraph (1) is not complied with because of a failure, on the part of the Office with which the earlier application was filed, to provide a copy in time, restoration of the priority right may be available under Article 13(3).

R4.02 *Paragraph (2).* This paragraph maintains the right of a Contracting Party, under Article 4D(3) of the Paris Convention, to require certification of the copy of the earlier application and of the date of filing of that application.

R4.03 *Paragraph (3).* The intention of this paragraph is to reduce the burden on applicants of providing copies of earlier applications and previously filed applications, and certification of filing dates. Thus, where the earlier application or previously filed application is filed with the Office of the Contracting Party concerned, it serves no useful purpose for the applicant to request a copy of the earlier application or previously filed application from that Office and then re-file it with the same Office. Similarly, in that circumstance, certification of the filing date serves no purpose since it would be that Office which provides the certification.

R4.04 The expression "is available to that Office from a digital library which is accepted by the Office for that purpose" is intended to take account of developments which would enable Offices to obtain copies of earlier applications from such a digital library. When adopting Articles 6(5) and 13(3) and Rules 4 and 14, the Diplomatic Conference urged the World Intellectual Property Organization to expedite the creation of a digital library system for priority documents, which would be of benefit to patent owners and others wanting access to priority documents (Agreed Statement No. 3).

R4.05 *Paragraph (4).* This paragraph applies only to the translation of earlier applications referred to in paragraph (1), that is for the purposes of a priority claim under Article 6(5). In order to significantly reduce the burden on applicants, paragraph (4) provides that Contracting Parties waive their right under the Paris Convention to require a translation of

an earlier application in every case. Instead, the Office or other competent authority, such as a court or board of appeal, may require such translation only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, in particular, where relevant prior art is published between the priority date and the filing date of the application concerned. It is to be noted that paragraph (4) applies to any proceedings in which the patentability of the invention concerned is determined, for example, substantive examination of the application, opposition to the grant of a patent, revocation of a patent, or a counterclaim of invalidity in infringement proceedings. It is for the Office or other competent authority concerned to decide whether, in the particular proceedings in suit, "the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable."

Notes on Rule 6

(Time Limits Concerning the Application Under Article 6(7) and (8))

R6.01 *Paragraphs (1) and (2).* Where the filing date of an application is not earlier than the date on which one or more of the elements referred to in Article 5(1)(a) were first received by the Office, a Contracting Party may calculate the time limit under paragraph (1) from the filing date. However, this is not possible in the case of applications referred to in Rule 2(6), for example, divisional applications, which are entitled to an earlier filing date. Reference is also made to the explanations given under Rule 2(1) and (2) (see Note R2.01).

R6.02 *Paragraph (3).* The time limit under PCT Rule 15.4(a) for paying the basic fee component of the international fee is one month from the date of receipt of the international application. The time limit for responding to an invitation under PCT Rule 16*bis* to pay a missing fee is one month from the date of the invitation. In this context, an invitation under PCT Rule 16*bis* corresponds to a notification under Article 6(7).

Notes on Rule 7
(Details Concerning Representation Under Article 7)

R7.01 *Paragraph (1).* Amendment of this paragraph requires unanimity under Rule 21(iv).

R7.02 *Paragraph (2)(a).* This provision obliges a Contracting Party to accept the appointment of a representative either (i) in a separate power of attorney signed by the applicant or other person appointing the representative, or (ii) in the request Form or format signed by the applicant (as under PCT Rule 90.4(a)). A Contracting Party is free, but not obliged, to accept the appointment of a representative in any other manner. As in the case of communications in general, a Contracting Party is permitted, under Article 8 and Rule 8, to apply requirements as regards the form and means of filing a power of attorney. Under Article 8(3), a Contracting Party is obliged to accept the presentation of a power of attorney on a Model International Form established under Rule 20(1)(i).

R7.03 *Paragraph (2)(b).* This provision obliges a Contracting Party to accept a single power of attorney in respect of one or more applications and/or patents of the same person. A Contracting Party is also obliged to accept what is sometimes referred to as a "general power of attorney," that is, a power of attorney that relates to all existing and future applications and/or patents of the same person. It is implicit that any power of attorney is only valid for any period prescribed by the general civil law of the Contracting Party concerned, as, for example, a period of one or three years under the law of the Russian Federation. In the second sentence, the words "subject to any exception indicated by the appointing person" oblige a Contracting Party to allow the person making the appointment to indicate possible exceptions both in the power of attorney itself and at a later time. Apart from this, Rule 7 does not regulate further details of the so-called "general power of attorney."

R7.04 Under the third sentence of paragraph (2)(b), a Contracting Party may require that a separate copy of the single power of attorney be filed for each application and patent to which it relates. It may also require,

under Rule 10(1)(b)(ii), that any communication made to the Office by a representative for the purposes of a procedure before the Office contain a reference to any power of attorney or general power of attorney.

R7.05 *Paragraph (3).* As regards the terms "a language accepted by the Office" and "translation," reference is made to Article 1(xii) and (xiii) (see Note 1.10).

R7.06 *Paragraph (4).* An Office that requires evidence under this paragraph is obliged, under Rule 5, to state its reason for doubting the veracity of the indication in question. As regards the phrase "where the Office may reasonably doubt the veracity of," reference is made to the explanation under Article 6(6) (see Note 6.18).

Notes on Rule 8
(Filing of Communications Under Article 8(1))

R8.01 *Paragraph (1)(a).* This provision guarantees, until June 2, 2005, the right of applicants, owners and other interested persons to file communications on paper with the Office of any Contracting Party, except as provided under subparagraph (d). After that date, any Contracting Party will be permitted, but not required (see Article 8(1)(c) and Note 8.04) to exclude the filing of communications on paper, except for the purposes of a filing date under Article 5(1) and for meeting a time limit under Article 8(1)(d) (see Notes 5.05 and 8.03, respectively). Accordingly, this provision has no effect for the Office of a Contracting Party that does not accept the filing of communications other than on paper. Amendment of this provision requires unanimity under Rule 21(v).

R8.02 When adopting this provision, the Diplomatic Conference adopted the following agreed Statement: with a view to facilitating the implementation of Rule 8(1)(a) of this Treaty, the Diplomatic Conference requests the General Assembly of the World Intellectual Property Organization (WIPO) and the Contracting Parties to provide the developing and least developed countries and countries in transition with additional technical assistance to meet their obligations

under this Treaty, even before the entry into force of the Treaty; the Diplomatic Conference further urges industrialized market economy countries to provide, on request and on mutually agreed terms and conditions, technical and financial cooperation in favor of developing and least developed countries and countries in transition; the Diplomatic Conference requests the WIPO General Assembly, once the Treaty has entered into force, to monitor and evaluate the progress of that cooperation every ordinary session (Agreed Statement No. 4).

R8.03 *Paragraph (1)(c).* The requirements applicable under this provision are, in particular, those relating to the physical requirements of international applications prescribed in PCT Rule 11.

R8.04 *Paragraph (1)(d).* This provision is intended, in particular, to permit a Contracting Party to require that the description and drawings of so-called "mega-applications," many of which are found in the fields of computer technology and biotechnology, be filed in an electronic form and/or by an electronic means of transmittal. In theses cases, a non-paper form, such as an electronic form, permits effective processing and publication of voluminous applications by the Office. It is to be noted that this provision does not permit a Contracting Party to circumvent the provisions of subparagraph (1)(a).

R8.05 *Paragraph (2)(a).* The requirements under the PCT applicable under this provision are prescribed under PCT Rules 89*bis* and 92.4. As regards the terms "electronic form" and "electronic means of transmittal," reference is made to the explanation given under Article 8(1)(a) (see Note 8.03). In addition to communications filed by telegraph, teleprinter and telefacsimile, this provision is also applicable to electronic means of transmittal that do not result in the filing of a printed or written document, but, for example, telefacsimile transmission to a computer terminal. This provision does not prevent a Contracting Party from allowing electronic filing in accordance with its own requirements. It only obliges a Contracting Party, which permits the electronic filing of communications under the PCT in respect of international applications, to accept the electronic filing of communications in respect of national or regional applications in accordance with those PCT requirements.

R8.06 The restriction of the requirements to a particular language covers the situation in which the PCT prescribes different requirements for the electronic filing of applications in different languages. Thus, the requirements for electronic filing in a language using the Latin alphabet, for example, English, may be different from the requirements for electronic filing in a language which does not use that alphabet, for example, Chinese.

R8.07 *Paragraph (2)(c).* A similar provision is contained in PCT Rule 92.4(d). Where a document is prepared on a computer and directly transmitted by telefacsimile, a printout of that document from the computer could be considered as the original.

R8.08 *Paragraph (3)(a).* The requirements under the PCT applicable under this provision are prescribed under PCT Rule 89*ter*.1. That Rule enables a national Office or intergovernmental organization to provide that, where an international application, or other document relating to an international application, is filed on paper, a copy thereof in electronic form, in accordance with the PCT Administrative Instructions, be furnished by the applicant.

Notes on Rule 9
(Details Concerning the Signature Under Article 8(4))

R9.01 *Paragraph (1).* This paragraph applies to the signature of any natural person, including the case where a natural person signs on behalf of a legal entity. Item (ii), which corresponds to the note in the signature box of the PCT request Form, applies, in particular, where a person signs on behalf of a legal entity.

R9.02 *Paragraph (4).* This paragraph applies to cases, for example, where communications are filed by telefacsimile resulting in the filing of communications on paper on which the graphic representation of the handwritten signature appears. It also applies to communications filed by telefacsimile transmission to a computer terminal on which the graphic representation of the handwritten signature appears. In accordance with Rule 8(2)(c), a Contracting Party may, in all cases, require the filing of the original of the transmitted document on which

the original signature appears. In addition, where the Office has reasonable doubt as to the authenticity of a signature, it may request evidence under Article 8(4)(c) (see Note 8.12). As regards the terms "electronic form" and "electronic means of transmittal," reference is made to the explanation under Rule 8(2)(a) (see Note R8.03).

R9.03 *Paragraph (5).* This paragraph applies to signatures on communications filed in electronic form that are not covered by the provisions under paragraph (4), because the signature does not appear as a graphic representation.

R9.04 *Paragraph (5)(a).* A "signature in electronic form" that may be required under this provision may be, for example, a signature in electronic or digital form attached to or logically associated with an electronic record which may be used to identify the signer of the electronic record and indicate the signer's approval of the information contained in the electronic record. A Contracting Party may further require that such a signature in electronic form be uniquely linked to the signer, be capable of identifying the signer, be created using means that the signer can maintain his sole control and be linked to the information contained in the electronic record in such a manner that any subsequent change of the data is detectable. It also could be a means of self-identification using an ID number and a password.

R9.05 *Paragraph (5)(b).* At present, there are no requirements under the PCT in relation to signatures in electronic form of communications filed in electronic form which do not result in a graphic representation of a signature.

Notes on Rule 10

(Details Concerning Indications Under Article 8(5), (6) and (8))

R10.01 *Paragraph (1)(a), item (iii).* The registration number or other indication referred to in this item may be required for data capture. In the case of electronic communications, it could be a personal identification number (PIN), or a digital certificate containing a registration number.

R10.02 *Paragraph (1)(b), item (iii).* Reference is made to the explanation under paragraph (1)(a)(iii) (see Note R10.01).

R10.03 *Paragraph (2).* As regards the requirement that an address be "on a territory prescribed by that Contracting Party," reference is made to the explanation under Article 7(1)(a)(ii) (see Note 7.04).

R10.04 *Paragraph (3).* This provision obliges a Contracting Party to treat, in the absence of an indication to the contrary, the address of an unrepresented applicant, owner or other interested person as the address for correspondence and the address for legal service under Article 8(6)(i) and (ii). As regards the requirement that an address be "on a territory prescribed by the Contracting Party," reference is made to the explanation under Article 7(1)(a)(ii) (see Note 7.04). It is to be noted that paragraph (3) does not prevent a Contracting Party from requiring an owner to indicate an address, on its territory, if that owner wishes to receive notifications in respect of the payment of maintenance fees.

R10.05 *Paragraph (4).* This provision obliges a Contracting Party to treat, in the absence of an indication to the contrary, the address of a representative as the address for correspondence and the address for legal service under Article 8(6)(i) and (ii). In addition, if that address is not on the territory of the Contracting Party, that Contracting Party may require, under Article 7(1)(a)(ii), that the address provided by the representative be on a territory prescribed by it (see Note 7.04). It is to be noted that paragraph (4) does not prevent a Contracting Party from requiring a representative to indicate an address, on its territory, for notifications in respect of the payment of maintenance fees.

R10.06 *Paragraph (5).* The term "refusal" is intended also to cover sanctions which are of equivalent effect to refusal of the application, such as the application being treated as abandoned or withdrawn.

Notes on Rule 12

(Details Concerning Relief in Respect of Time Limits Under Article 11)

R12.01 *Paragraphs (1)(a) and (3).* In accordance with Article 7(1)(b), a representative may sign on behalf of the applicant or owner.

R12.02 *Paragraph (5)(a).* This provision lists procedures in respect of which a Contracting Party is not obliged to provide for the extension of a time limit under Article 11(1) or continued processing under Article 11(2), although it is permitted to do so.

R12.03 *Item (i).* Under this item a Contracting Party is not obliged to grant more than one instance of relief under Article 11(1) or (2), although it is permitted to do so. It is similarly not obliged to grant continued processing under Article 11(2) after an extension of the time limit concerned has been previously granted under Article 11(1). Any second or subsequent instance of relief that is granted is not regulated by Article 11(1) or (2) or Rule 12, so that a Contracting Party is permitted to grant shorter extensions than, and/or to apply requirements which are additional to, or different from, those under that Article and that Rule.

R12.04 *Items (ii) and (iv).* These items are intended to prevent an applicant or owner from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R12.05 *Item (iii).* Although, under this item, a Contracting Party is not obliged to provide for the extension of, or continued processing in respect of, a time limit fixed by the Office for the payment of maintenance fees, it is still obliged to provide a period of grace for the payment of such fees under Article 5*bis*(1) of the Paris Convention.

R12.06 *Item (vi).* When adopting Rules 12(5)(vi) and 13(3)(iv), the Diplomatic Conference understood that, while it was appropriate to exclude actions in relation to *inter partes* proceedings from the relief provided by Articles 11 and 12, it was desirable that the applicable law of Contracting Parties provide appropriate relief in those circumstances which takes into account the competing interests of third parties, as well as those interests of others who are not parties to the proceedings (Agreed Statement No. 5).

R12.07 *Paragraph (5)(b).* This provision ensures that the provisions of the applicable law in respect of a maximum time limit for the grant of a patent prevail over relief in respect of a time limit fixed by an administrative action of the Office.

Notes on Rule 13
(Details Concerning Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office Under Article 12)

R13.01 *Paragraph (1).* In accordance with Article 7(1)(b), a representative may sign on behalf of the applicant or owner.

R13.02 *Paragraph (3).* This provision lists procedures in respect of which a Contracting Party is not obliged to provide for the reinstatement of rights under Article 12(1), although it is permitted to do so.

R13.03 *Items (ii) and (iii).* These items are intended to prevent an applicant or owner from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R13.04 *Item (iv).* Reference is made to Agreed Statement No. 5 referred to in Note R12.06.

Notes on Rule 14
(Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13)

R14.01 *Paragraph (1).* Although the expression "before the technical preparations for publication of the application have been completed" is intended to have the same meaning as that expression as used in PCT Rule 26*bis*.1(b), it is a matter for the Office concerned to decide whether or not, in any particular case, a request for early publication or for expedited or accelerated processing is withdrawn before those preparations have been completed.

R14.02 *Paragraph (2).* In accordance with Article 7(1)(b), a representative may sign on behalf of the applicant or owner.

R14.03 *Paragraph (3).* The applicable time limit for the correction or addition of a priority claim by a notice submitted to the receiving Office after the filing of an international application under PCT Rule 26*bis*.1(a) is 16 months from the priority date or, where that correction or addition would cause a change in the priority date, 16 months from the priority

date so changed, whichever 16-month period expires first, provided that such a priority claim may be submitted until the expiration of four months from the filing date of the international application. Reference is also made to Agreed Statement No. 3 referred to in Note 6.17.

R14.04 *Paragraph (5), item (i) and paragraph (6)(a), item (i).* Reference is made to the explanation given under Rule 13(1) (see Note R13.01).

R14.05 *Paragraph (6)(b), item (i).* The declaration or other evidence referred to in this item may be required in order that the Office may determine whether the requirement under Article 13(3)(iii) is complied with.

Notes on Rule 15
(Request for Recordation of Change in Name or Address)

R15.01 This Rule standardizes the procedure concerning requests for recordation of a change in the name or address of an applicant or owner where there is no change in the person of that applicant or owner, for example, a change in the name of a company or a change of name on marriage. It also applies, under paragraph (8), where there is a change in the name or address of the representative or in the address for correspondence or address for legal service. Where there is a change in the person of the applicant or owner, Rule 16 applies. As regards a change in the person of the representative, that is where a new representative is appointed, reference is made to the explanation under Article 7 (see Note 7.01).

R15.02 *Paragraph (1), introductory words.* In accordance with Article 1(vii), the term "recordation" means any act of including information in the records of the Office. As regards the terms "applicant" and "owner," reference is made to the explanations under Article 1(viii) and (ix) (see Notes 1.06 and 1.07).

R15.03 *Item (ii).* Where the application number has not been issued, or is not known, the provisions of Rule 19 apply.

R15.04 *Item (iv).* The name and address referred to in this item are those which are indicated in the records of the Office concerned. If that is

not the case, the Office may, for example, require that evidence that the indications given are correct be filed under paragraph (4), or that the change concerned be recorded beforehand or be included in the request.

R15.05 *Paragraph (2).* The amount of the fee may differ depending on the number of the patents or applications involved (see Note R15.06). Reference is also made to the explanations under Article 6(4) (see, in particular, Note 6.15).

R15.06 *Paragraph (3).* This paragraph obliges a Contracting Party to allow a change in both name and address, and a change in respect of more than one patent and/or application of the same person, to be included in a single request. However, it permits a Contracting Party to require that a separate copy of a single request be filed for each application and patent to which it relates. It is also implicit that a Contracting Party which so wishes may itself make a copy of the request for each application and patent, optionally on the payment, under paragraph (2), of an additional fee for each copy.

R15.07 *Paragraph (4).* This paragraph permits a Contracting Party to require evidence, for example, in the case of a change in both name and address, where there is a doubt as to whether such change is not in fact a disguised change in the person of the applicant or owner. The Office is obliged, under Rule 5, to state its reason for doubting the veracity of the indication concerned. As regards the phrase "may reasonably doubt the veracity of," reference is made to the explanations under Article 6(6) (see Note 6.18).

R15.08 *Paragraph (5).* This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (4). The requirements referred to in this paragraph which are "otherwise provided for by the Treaty or prescribed in these Regulations" are, in particular, those under Articles 7 and 8 and Rules 7 to 10. As provided in the second sentence, a Contracting Party may not require the filing of any certificate concerning the change, for example, a certified copy of the recordation of the change of the name of a company in the register of companies.

R15.09 *Paragraphs (6) and (7).* The effect of the prohibition, under paragraph (7)(a), of a more severe sanction than the refusal of the request for recordation, is that a Contracting Party may not provide for refusal of the application, or revocation of the patent, concerned for failure to comply with the requirements of Rule 15. Reference is also made to the general provisions on notifications under Article 9 (see Notes 9.01 to 9.05).

R15.10 *Paragraph (8).* As regards a change in the name or address of the representative, due to the *mutatis mutandis* effect of Rule 15(1), this provision applies only where there is no change in the person of the representative (see Note R15.01).

Notes on Rule 16
(Request for Recordation of Change in Applicant or Owner)

R16.01 This Rule standardizes the procedure concerning requests for recordation of a change in the person of an applicant and owner, in particular, changes resulting from a change of ownership. Where there is a change in the name, but no change in the person, of the applicant or owner, Rule 15 applies. It is to be noted that Rule 16 deals with the requirements which should be fulfilled before a Patent Office and not before any other authorities of a Contracting Party, for example, the fiscal authorities.

R16.02 *Paragraph (1)(a), introductory words.* Reference is made to the explanation given under Rule 15(1), introductory words (see Note R15.02).

R16.03 *Item (ii).* Reference is made to the explanations given under Rule 15(1)(ii) (see Note R15.03).

R16.04 *Item (vii).* The basis for the change in the person of the applicant or owner could be, for example, a contract assigning the ownership of the application or patent concerned, a merger, the reorganization or division of a legal entity, the operation of law, or a court decision transferring the ownership of an application or patent.

R16.05 *Paragraph (1)(b), item (ii).* An example of government interest is the provision under the law of the United States of America (35 U.S.C. § 267) which provides that the Director may extend the time for taking action in the case of an application which is the property of the United States of America.

R16.06 *Paragraph (2)(a).* This provision prescribes the documentation which may be required where the change in the person of the applicant or owner results from a contract. As provided in the introductory words, a Contracting Party may require that the request for recordation include information relating to the registration of the contract where such registration is compulsory.

R16.07 *Items (i) to (iii).* A Contracting Party may also require that the request for recordation be accompanied by any one of the documents listed in items (i) to (iii). A Contracting Party must accept documentation under any of those items, at the option of the requesting party. Accordingly, the Contracting Party is not permitted to prescribe which item shall accompany the request.

R16.08 It follows from Article 2(1) that a Contracting Party may accept, at the option of the requesting party, documentation that is less than, or different from, that prescribed in items (i) to (iii) provided that it also accepts the documentation prescribed in those items. For example, under item (ii), a Contracting Party may accept a transcription of an extract of the contract, instead of the extract itself, although it is not obliged to do so. Similarly, a Contracting Party may accept an uncertified transfer document signed by both the applicant and the new applicant or by both the owner and the new owner.

R16.09 Where a Contracting Party requires that a copy or extract of the contract filed under item (i) or (ii) be certified, it is the option of the applicant as to who (a notary public, a competent public authority or, where permitted, a representative) certifies the relevant document.

R16.10 Where the requesting party chooses to file a certificate of transfer, as provided in item (iii), a Contracting Party is not permitted to require that this certificate be the subject of any form of certification. Rule 20(1)(iv) provides for the establishment of a Model International Form for a certificate of transfer.

R16.11 *Paragraph (2)(b).* This provision applies where the change in the applicant or owner results from a merger, or from the reorganization or division of a legal entity (including a reorganization that results in more than one entity). A Contracting Party may require that the request be accompanied by a copy of a document, originating from a competent authority, evidencing that fact and any attribution of rights involved, for example, an extract from a register of commerce. It is only permitted to require that a copy of the document be filed; it cannot require that the original of the document be filed, or that the copy of the document be signed by the applicant and the new applicant or by the owner and the new owner. As regards the requirement that the copy be certified, reference is made to the explanation under Note R16.09.

R16.12 *Paragraph (2)(c).* This provision applies where the change in ownership does not result from a contract, from a merger, or from the reorganization or division of a legal entity (including a reorganization that results in more than one entity). In such a case, a Contracting Party may require that the request be accompanied by a copy of any document evidencing the change. Although a Contracting Party cannot require that the original of such a document be filed, it may require that the copy of that document be certified by, at the option of the requesting party, the authority which issued the document, a notary public, a competent public authority, or, where permitted, a representative.

R16.13 *Paragraph (2)(d).* This provision applies, in particular, where, under the applicable law, a co-applicant or co-owner who transfers his share in an application or patent needs the consent of any other co-applicant or co-owner to the change. It is a matter for the Contracting Party to determine what constitutes consent to the change, including whether a copy of a prior agreement of joint applicants or owners to the sale of a share constitutes sufficient evidence under this provision, and whether the communication containing the consent shall be signed.

R16.14 *Paragraph (3).* As regards the expression "a language accepted by the Office," reference is made to the explanation under Article 1(xii) (see Note 1.10). As regards the term "translation," reference is made to the definition under Article 1(xiii).

R16.15 *Paragraphs (4) and (5).* Reference is made to the explanations given under Rule 15(2) and (3) (see Notes R15.05 and R15.06).

R16.16 *Paragraph (6).* Evidence could be required under this paragraph where, for example, the Office has reason to suspect that the request may be fraudulent. Reference is also made to the explanations given under Rule 15(4) (see Note R15.07).

R16.17 *Paragraph (7).* This paragraph establishes the exhaustive character of the list of formal requirements under paragraphs (1) to (6) with respect to a request for recordation of a change in applicant or owner. An example of a prohibited requirement is making the admissibility of the request dependent on an advertisement of the change in one or several newspapers. Since, in accordance with Article 2(2), the Treaty does not regulate the substantive requirements relating to the validity of the change, a Contracting Party would be permitted to require the fulfillment of additional conditions of a substantive or fiscal nature, for example, in situations concerning inheritance, bankruptcy or tutelage. The requirements referred to in this paragraph which are "otherwise provided for by the Treaty or prescribed in these Regulations" are, in particular, those under Articles 7 and 8 and Rules 7 to 10.

R16.18 *Paragraph (8).* Reference is made to the explanations given under Rule 15(6) and (7) (see Note R15.09).

R16.19 *Paragraph (9).* This paragraph permits, but does not oblige, a Contracting Party, in particular, one which requires that a patent be applied for in the name of the actual inventor, to exclude the provisions of Rule 16 in respect of changes in inventorship. The second sentence is included for the avoidance of doubt.

Notes on Rule 17
(Request for Recordation of a License or Security Interest)

R17.01 *Paragraph (1)(a), introductory words.* It follows from the words "Where a license in respect of an application or patent may be recorded under the applicable law" that no Contracting Party is obliged to provide for recordation of such license, and that any Contracting Party which allows for such recordation is free to decide

which license may be recorded. Accordingly, a Contracting Party is not obliged to set a system for recordation of licenses under Rule 17. In accordance with Article 1(vii), the term "recordation" means any act of including information in the records of the Office.

R17.02 *Item (ii).* Reference is made to the explanation given under Rule 15(1)(ii) (see Note R15.03).

R17.03 *Paragraph (1)(b), item (ii).* Reference is made to the explanations given under Rule 16(1)(b), item (ii) (see Note R16.05).

R17.04 *Paragraph (2)(a).* It is to be noted that this provision does not prevent any authorities of a Contracting Party, for example, tax authorities or authorities establishing statistics, from requiring the parties to a license to furnish information in accordance with the applicable law of that Contracting Party. Apart from this, the considerations which apply to the documentation which may be required where the license is a freely concluded agreement under this provision are essentially the same as those which apply under Rule 16(2)(a) (see Notes R16.06 to R16.10). The words "portions of that agreement" in item (ii) include, in particular, information regarding the territory and duration of the licensing agreement, and whether there is a right to sub-license.

R17.05 *Paragraph (2)(b).* This provision permits a Contracting Party to require the filing of a document containing the consent, to recordation of a license which is a freely concluded agreement, of an applicant, owner, exclusive licensee, co-applicant, co-owner or co-exclusive licensee who is not party to that agreement. For example, where the applicant or owner has already granted an exclusive license in respect of an application or patent, a Contracting Party may require the consent of the exclusive licensee to the recordation of another license, in respect of that application or patent, to which the exclusive licensee is not a party. Similarly, a Contracting Party may require the consent of the applicant or owner to a sub-license by an exclusive licensee. Also, where a co-applicant or co-owner licenses his share in an application or patent, a Contracting Party may require the consent of any other co-applicant, co-owner or co-exclusive licensee to the recordation of the license. A co-applicant, co-owner or co-exclusive licensee who represents all of the co-applicants, co-owners or co-exclusive licensees may consent to the change on behalf of the other co-applicants,

co-owners or co-exclusive licensees. The situation in which the consent of a co-applicant, co-owner or co-exclusive licensee cannot be obtained, for example, because that person cannot be contacted, is not regulated by the Treaty or Regulations and therefore remains a matter for the applicable law of the Contracting Party. Reference is also made to the explanations given under Rule 16(2)(d) (see Note R16.13).

R17.06 *Paragraph (2)(c).* This provision applies, in particular where the recordation is requested of a compulsory, or other non-voluntary, license ordered by a court or other competent authority.

R17.07 *Paragraph (3).* Reference is made to the explanation given under Rule 16(3) (see Note R16.14).

R17.08 *Paragraphs (4) and (5).* Reference is made to the explanations given under Rule 15(2) and (3) (see Notes R15.05 and R15.06).

R17.09 *Paragraphs (6) and (7).* Reference is made to the explanations given under Rule 16(6) and (7) (see Notes R16.16 and R16.17).

R17.10 *Paragraph (8).* Reference is made to the explanations given under Rule 15(6) and (7) (see Note R15.09).

R17.11 *Paragraph (9).* Item (i) relates to the recordation of a security interest, such as an interest in a patent or application, acquired by contract for the purpose of securing payment or performance of an obligation, or indemnifying against loss or liability, for example, where the rights in an application or patent have been pledged as a security for a loan. However, as in the case of recordation of licenses under paragraph (1), a Contracting Party is not obliged to provide for recordation of security interests, and any Contracting Party which does allow for such recordation is free to decide which security interests may be recorded. Similarly, under item (ii), a Contracting Party is not obliged to provide for cancellation of the recordation of a license or security interest.

R17.12 In applying the provisions of paragraphs (1) to (8), *mutatis mutandis*, to a request for recordation, or cancellation of recordation, of a security interest, references to the terms "a license," "licensor" and "licensee" are to be read as references to the terms "a security interest," "a person providing the security interest," and "a person in favor of whom the security interest is established," respectively.

Notes on Rule 18
(Request for Correction of a Mistake)

R18.01 This Rule regulates the formal requirements and procedures concerning the request for correction, by the Office, of a mistake not related to search or substantive examination. In accordance with Article 2(2), it does not regulate the substantive requirements which a Contracting Party may apply in determining the allowability of a correction. For example, a Contracting Party may require that the correction be obvious in the sense that it is unequivocally clear that nothing else could have been intended other than what is offered as the correction. It also does not regulate corrections in the application which are not the subject of a request for correction, in particular, the amendment of the description, claims or drawings, either voluntarily following the receipt of a search report, or in the course of substantive examination.

R18.02 *Paragraph (1)(a), introductory words.* The expression "mistake in the records of the Office" is to be interpreted in light of the definition of the term "records of the Office" under Article 1(vi) (see Note 1.04). Examples of mistakes which may be the subject of a request under paragraph (1) are mistakes in the bibliographic data, in details concerning a priority claim, or in the description, claims or drawings of the application or patent concerned. It follows from the wording "which is correctable under the applicable law" that the question of which mistakes are correctable is not regulated by this Rule. As regards the terms "applicant" and "owner," reference is made to the explanations given under Article 1(viii) and (ix) (see Notes 1.06 and 1.07).

R18.03 *Item (ii).* Reference is made to the explanations given under Rule 15(1)(ii) (see Note R15.03).

R18.04 *Paragraph (1)(b).* This provision allows a Contracting Party to require that a replacement part (for example, a replacement page in the case of an application filed on paper), or a part incorporating the correction (for example, an errata sheet), be filed. In the case where the request applies to more than one application and/or patent, an Office may require that a separate replacement part, or part incorporating the correction, be filed for each application and patent, to facilitate the work of the Office.

R18.05 *Paragraph (1)(c).* This provision permits a Contracting Party to refuse a request for correction of a mistake where the requesting party is unable to file a declaration that the said mistake was made in good faith, for example, where the mistake was made with deceptive intention. It is a matter for the Contracting Party concerned to decide what constitutes good faith.

R18.06 *Paragraph (1)(d).* This provision permits a Contracting Party to refuse a request for correction of a mistake where there was undue or intentional delay in making the request after the discovery of the mistake. It is a matter for the Contracting Party concerned to decide what constitutes undue or intentional delay; for example, it may consider that there is undue delay where the request is not diligently made.

R18.07 *Paragraph (2)(a).* Reference is made to the explanation given under Rule 15(2) (see Note R15.05).

R18.08 *Paragraph (3).* Reference is made to the explanation given under Rule 15(3) (see Note R15.06).

R18.09 *Paragraph (4).* This paragraph permits a Contracting Party to require evidence in the case of any request for correction where, for example, notwithstanding the declaration referred to in paragraph (1)(c), there is reasonable doubt as to whether the mistake was made in good faith, or where there is reasonable doubt as to whether the request was made without undue or intentional delay following the discovery of the mistake in accordance with paragraph (1)(d) (see also Note R18.06). Reference is also made to the explanations given under Rule 15(4) (see Note R15.07).

R18.10 *Paragraph (5).* Reference is made to the explanations given under Rule 15(5) (see Note R15.08). As regards the restriction to formal requirements, reference is made to the explanation in Note R18.01.

R18.11 *Paragraph (6).* Reference is made to the explanations given under Rule 15(6) and (7) (see Note R15.09).

R18.12 *Paragraph (7)(a).* This paragraph permits a Contracting Party, in particular, one which requires that a patent be applied for in the name

of the actual inventor, to apply provisions in respect of changes in inventorship which are different from, or additional to, provisions under paragraphs (1) to (6).

R18.13 *Paragraph (7)(b).* This provision is for the avoidance of doubt. Under the law of the United States of America, a patentee may apply for a re-issue patent to correct a patent that is, or may be, inoperative or invalid because the claims are too narrow or too broad due to an error made without deceptive intention.

Note on Rule 19
(Manner of Identification of an Application Without Its Application Number)

R19.01 *Paragraph (1).* This paragraph prescribes the indications and elements which a Contracting Party is obliged to accept where the application number is required to be filed under Rules 2(5)(a), 10(1)(a)(ii), 15(1)(ii), 16(1)(a)(ii), 17(1)(a)(ii) and 18(1)(a)(ii), but that number has not been issued or is not known. It follows from Article 2(1) that this paragraph allows a Contracting Party to accept less information than that prescribed in items (i) to (iii) or, additionally, to accept other means of identification.

Note on Rule 20
(Establishment of Model International Forms)

R20.01 *Paragraph (2).* The modifications of the PCT request Form referred to in this provision are the modifications for the purpose of filing national and regional applications in accordance with Article 6(2)(b) and Rule 3(2)(i) (see Note R3.02). The PCT request Form for the purposes of filing international applications under the PCT will continue to be established as part of the Administrative Instructions under PCT Rule 89.

Notes on Rule 21
(Requirement of Unanimity for Amending Certain Rules Under Article 14(3))

R21.01 *Item (i).* At present, no Regulations are provided under Article 5(1)(a).

R21.02 *Item (ii).* At present, Rule 3(1) provides the Regulations referred to in Article 6(1)(iii).

R21.03 *Item (iii).* At present, Rule 3(3) provides the Regulations referred to in Article 6(3).

R21.04 *Item (iv).* At present, Rule 7(1) provides the Regulations referred to in Article 7(2)(a)(iii).

I hereby certify that the foregoing text is a true copy of the original text in English of the Patent Law Treaty and the Regulations under the Patent Law Treaty adopted on June 1, 2000.

Kamil Idris
Director General
World Intellectual Property Organization

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