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SUBJECT: Basic Proposal for the Patent Law Treaty (PT/DC/3)

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains the provisions of the Basic Proposal (BP) for the WIPO Patent Law Treaty (PLT) as well as the EPO's preliminary comments thereon.

This document has been distributed **in English and French only**.

INTRODUCTION

1. The Diplomatic Conference for the adoption of the Patent Law Treaty (PLT) has been scheduled to take place from 11 May to 2 June 2000 in Geneva. The preparatory documents and invitations for the Conference were distributed in November 1999 by the International Bureau of WIPO. As potential parties to the future PLT among others the European Patent Organisation and its contracting states (as well as the states invited to accede to the EPC) have been invited to participate in the forthcoming Diplomatic Conference.
2. In order to efficiently represent European interests in the Diplomatic Conference and to convincingly bring out the importance Europe attaches to harmonisation of patent law, an exchange of views among the EPC contracting states and the Office in regard of the various provisions of the draft treaty is felt to be necessary. Wherever possible, a common European approach should be developed and coordinated action agreed upon.
3. This document is meant as a basis for discussion. It contains the observations and suggestions of the EPO in particular in regard of provisions where adaptations or amendments to the Basic Proposal are felt to be appropriate. It further indicates where the future PLT means changing the EPC and the European patent grant procedure. No comments are given with regard to draft provisions which are felt to be acceptable. As to the administrative and final provisions of the draft PLT (in particular Articles 16, 19, 20, 21), reference is made to an analysis the Office presented to the Heads of Delegation in December 1999 (see excerpt in Annex I).
4. The EPO's overall assessment of the draft PLT and the Regulations thereto is a positive one. It is felt that the draft treaty now issued by the IB has met with broad acceptance in the SCP and in user circles, takes the international harmonisation of patent law another step forward and should make life easier for inventors and firms wanting to protect their inventions internationally.
5. The following documents form the basis for the comments below or are referred to:
 - PT/DC/3 Basic proposal for the Patent Law Treaty
 - PT/DC/4 Basic proposal for the Regulations under the Patent Law Treaty
 - PT/DC/5 Prov. 2 Explanatory Notes on the Patent Law Treaty (Notes)
 - SCP/1/7 Report First Session first part (SCP I 1)
 - SCP/1/11 Report First Session second part (SCP I 2)
 - SCP/2/13 Report Second Session (SCP II)

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 references to both 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 by means permitted by 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,

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irrespective of the medium in which such information is maintained;

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

(viii) "applicant" means the person whom the records of the Office show as the person who is applying for the patent, or whom the records of the Office show as another person who, pursuant to the applicable law, 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 any person, firm or partnership that can be 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;

Reservations: Art. 1(xii) BE, FI (see Note 1.10 + Report SCP I no. 100)

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(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 ("PCT"), signed on June 19, 1970, as amended and modified;

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

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

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

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

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Article 2
General Principles

PCT: Art. 27(4), 27(5)

(1) [*More Favourable Requirements*] A Contracting Party shall be free to provide for requirements which, from the viewpoint of applicants and owners, are more favourable 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.

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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 that can be filed as international applications under the Patent Cooperation Treaty;

(ii) divisional applications 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 in the Office of any Contracting Party under Articles 22 and 39(1) of the Patent Cooperation Treaty;

(ii) from the date on which processing or examination of the international application may start under Article 23 or Article 40 of that Treaty.

EPC: Art. 76, 150 ss
Paris Conv: Art. 4G(1), 4G(2)
PCT: Art. 22, 23, 39(1), 40, 48

ad: Art. 3(1)(b)

Part X of the EPC provides for the processing of international applications before the EPO. Thus Art. 3(1)(b) applies to the EPO although it is not party to the PCT.

→ Note 3.07 should be clarified accordingly.

ad: Art. 3(1)(b)(i)

The provision clarifies that the PLT (in particular Articles 11 and 12) does apply in respect of the time-limits for entry into the regional phase before the EPO (R. 107 EPC).

Revision of EPC

Articles 121, 122 EPC have to be revised in order to allow for further processing and/or reinstatement of rights if the time-limits for entering the European phase are missed (see under Articles 11 and 12 + CA/PL 19/99).

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

Article 4
National Security

Nothing in this Treaty and the Regulations shall limit the freedom of any Contracting Party to take any action deemed necessary for the preservation of its national security.

EPC: Art. 75(2)
PCT: Art. 27(8)
TRIPS: Art. 73

Article 5
Filing Date

(1) [*Elements of Application*] (a) Subject to paragraphs (2) to (8), a Contracting Party shall provide that the filing date of an application shall be [no later than] the date on which its Office has received all of the following elements, filed, at the option of the applicant, on paper or by other means permitted by the Office:

(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).

EPC: Art. 80, 90; R. 39-43

PCT: Art. 11

ad: Art. 5(1)(a)

Article 5 is intended to set a general standard for awarding a filing date. Thus there is no room for contracting parties to apply more favourable conditions. This principle is expressly confirmed by Article 2(1) and justified by the importance which the harmonisation of the filing date issue has for international patent practice. A uniform approach as to the filing date requirements is of particular importance for claiming priority under the Paris Convention as it would lead to a common standard with regard to the so-called "regular national filing" under Article 4A(3) Paris Conv.

→ The text in square brackets "no later than" - introduced on an intervention by the US (Report SCP II No. 100) cannot be supported. The additional language weakens the harmonising effect of the provision, introduces a concept different from the PCT standard (Art. 11) and does not seem to be necessary as the constitution of the date of receipt is dependent on national practices (see note 5.04).

ad: Art 5(1)(b)

This provision too weakens the harmonising effect of Article 5. As to the consequences of allowing the description to be replaced by a drawing, it is felt that there is a considerable risk that the later filed description could contain subject-matter which extends beyond the content of the application as filed. The EPO therefore does not intend to make use of this option.

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(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 of paragraphs (1) and (2), the Office shall, as soon as practicable, notify the applicant, giving an 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 referred to in paragraphs (1) and (2) are not complied with in the application as initially filed, the filing date shall, subject to subparagraph (b) and paragraph (5), be [no later than] the date on which all of the requirements referred to in paragraphs (1) and (2) are subsequently complied with.

Nevertheless, the EPO will be obliged to recognise priority claims based on priority documents which merely contain a drawing if Paris Convention Countries make use of the option of Article 5(1)(b). Although this was expressed during SCP I (see Report SCP I 1 no. 117) by the EPO there seemed to be no opposition to this (primarily US-supported) provision among EPC contracting states.

→ Should the position of the majority of the EPC countries have changed since then, consideration should be given to taking up the issue again during the Diplomatic Conference.

ad: Art. 5(3)

The issue is dealt with under Art. 90(1)(a), 90(2) and R. 39 EPC. In order to be in conformity with the PLT the one-month time-limit in R. 39 EPC must be extended to two months (R. 2(1)). The notion of the term "as soon as practicable" is unclear and suggests that an office has more time than under the wording, "promptly" (see Art. 5(5)). The EPO has always preferred "promptly" (see Report SCP II no. 29)

ad: Art. 5(4)(a)

The text in square brackets cannot be supported (see above - ad: Art. 5(1)(a)).

The EPC's suggestion to provide for the applicant to be informed of the new filing date (see R. 39 EPC) has not been taken up by the SCP (Report CE 5, no. 78).

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(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 regarded as not having been filed. Where the application is regarded as not having 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.

ad: Art. 5(4)(b)

For the reasons indicated above under ad Art. 5(1)(a) it is suggested that the "may" in the first sentence of the provision (introduced on a proposal from the US) be replaced by a "shall" (see also Report CE 4, no. 63).

→ Should there be a majority of EPC countries supporting this suggestion, consideration should be given to taking up the issue at the Diplomatic Conference.

ad: Art. 5(5), 5(6)

With regard to missing drawings the procedure under the EPC (Art. 91(6), R. 43 EPC) is essentially in line with the PLT requirements. It is understood that the term "in establishing the filing date" in Art. 5(5) does encompass both the procedure under Art. 90 EPC and that under Art 91(6) EPC.

→ Thus only the time-limit of one month in R. 43 EPC has to be extended to two months. As far as the missing part of the description is concerned, revision of Art. 91(6) EPC is necessary (see below)

As to the wording ["no later than"] in Art. 5(6)(a), (b) and (c) see above under ad: 5(1)(a).

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EPO comments (if any)

(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 [no later than] 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 referred to in 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 [no later than] the date on which all the requirements referred to in 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 [no later than] the date on which the requirements referred to in paragraphs (1) and (2) are complied with.

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EPO comments (if any)

(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 considered as not having been filed.

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

ad: Art. 5(7)

The "may" in Art. 5(7)(b) should be replaced by a "shall" (see above ad: Art. 5(4)(b), 5(1)(a)). As to the substance of the provision, revision of the EPC is necessary (see below).

Revision of EPC

Art. 80 EPC has to be revised with regard to the minimum requirements for according a filing date (in particular deletion of express designation of a contracting state and the requirement to file claims (Art. 5(1)), the language requirement with regard to the description (Art. 5(2)) and the reference filing (Art. 5(7)).

Art. 91 EPC must be amended in order to provide for the accordance of a new filing date in the case of late-filed parts of the description (Art. 5(6)(a)) and the acceptance of such late-filed parts and late-filed drawings as originally filed where it is established that these were contained in the application whose priority is claimed (Art. 5(6)(b)).

(see CA/PL 5/00)

Reservations: Art. 5(1)(a) - BE (see Note 5.06)
 Art. 5(1)(2) - ES (See Note 5.02)

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EPO comments (if any)

*Article 6
Application*

EPC: Art. 78, 81, R. 26, 17; Art. 33; Art. 87, 88, R. 38
PCT: Art. 3, 4, 7, 8, 11, 27, R. 3-12

(1) [*Form or Contents of Application*] Except where otherwise provided for by this Treaty or prescribed in the Regulations, and subject to paragraph (6), no Contracting Party shall require compliance with any requirement relating to the form or contents of an application different from or additional to:

ad Article 6(1)

Article 6(1) has the effect that in principle the PCT standard as to form and content of the international application becomes applicable to national and regional applications. Such harmonisation on the basis of the PCT and the requirements allowed thereunder has always been supported by the EPO.

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

The concept implies that any future change to the PCT requirements will automatically have effect on the obligations of the contracting parties to the PLT.

(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 Contracting State of that Treaty once the processing or examination of an international application, as referred to in Article 23 or Article 40 of the said Treaty, has started;

Revision of the EPC

Art. 33 EPC should be revised in order to enable the EPO Administrative Council to amend EPC Articles to comply with international treaties.

(iii) any further requirements prescribed in the Regulations.

(see CA/PL 3/00)

ad Article 6(1)(iii), R. 3

Rule 3(1) expressly allows to require the indications needed in case of divisional applications and applications under Article 61(1)(b).

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EPO comments (if any)

(2) [*Request Form or Format*] (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, or in a format, prescribed by that Contracting Party. A Contracting Party may also require that any further contents prescribed in the Regulations pursuant to paragraph (1)(iii) be contained in that request Form or format.

(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, or in a format, 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.

(4) [*Fees*] A Contracting Party may require that fees be paid in respect of the application.

(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 with the Office in accordance with the requirements prescribed in the Regulations.

ad Article 6(5). R. 4

Rule 4 of the PLT Regulations specifies the details under which a copy and a translation of the priority document may be required. The EPO had always supported this Rule and in particular paragraphs 3 and 4 under which a priority document may not be required when it is available to an office, or a translation may only be asked for when the validity of the priority claim is relevant for determining the patentability of the invention.

Revision of the EPC

Article 88 EPC has to be revised accordingly (see CA/PL 17/98).

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EPO comments (if any)

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

(7) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (5) are not complied with, or where evidence is required under paragraph (6), the Office shall notify the applicant, giving an 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 Article 5, 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 considered non-existent. Subject to Article 5(7)(b), no other sanctions may be applied.

Reservations:

Art. 6(1) - US has reserved its position as regards the applicability of PCT Rule 13 (Unity of Invention).

Rule 4(4) - BE, GR, IE, PT, ES (see Note R 4.05)

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EPO comments (if any)

Article 7
Representation

EPC: Art. 133, 134, R. 100, 101
PCT: R. 90

(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) Any 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 Contracting Party may require that an applicant, owner or other interested person appoint a representative for the purposes of any procedure before the Office after the filing date, other than:

(i) the payment of maintenance fees;

[(ii) any procedure referred to in Article 5;]

[(iii) the payment of fees;]

[(iv) the filing of a translation;]

[(v) any other procedure as prescribed in the Regulations;]

(vi) the issue of a receipt or notification by the Office in respect of any procedure referred to in item[s] (i) [to (v)].

(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.

ad: Art. 7(2)

With regard to the question of mandatory representation the EPO has always advocated a liberal approach. For reasons of efficiency the Office certainly prefers to deal with professional representatives rather than with inexperienced applicants. It is felt, however, that this preference does not justify obliging inventors to act through patent agents where an action can easily be carried out by the applicant or where such an obligation, under certain circumstances, may lead to the risk of a loss or rights (see eg Report SCP II, no. 66).

→ Consequently the EPO is strongly in favour of removing the square brackets as regards items (iii) - (v).

With regard to item (ii) a general exemption referring to procedures under Article 5 is not justified, given the complexity of these procedures, in particular with regard to the requirements relating to the late filing of missing parts of the description under Article 5(6) and the reference filing under Article 5(7).

Reservations: Art. 7(2) - AT, BE, DE, IE, PT, ES
- JP (see Note 7.09)

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EPO comments (if any)

(5) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (3) are not complied with, or where evidence is required under the Regulations pursuant to paragraph (3), the Office shall notify the applicant, owner or other interested person, giving an 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 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.

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EPO comments (if any)

*Article 8
Communications; Addresses*

(1) [*Form, Format and Means of Filing of Communications*]

(a) Except for the establishment of a filing date under Article 5(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, format and means of filing 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.

EPC: Art. 75, 76, R. 24, 26, 36; Notice of 22/7/97 concerning EASY (OJ EPO 1997, 377), of 2/6/92 concerning filing of applications etc.(OJ EPO 1992, 306), *epoline*
PCT: R. 89bis, 92(4)

ad Article 8(1), R. 8

The provision guarantees that no Contracting Party is obliged to accept the filing of electronic communications or to exclude the filing of applications on paper. Rule 8(1) further specifies that any Contracting Party may, subject to Articles 8(1)(a) and (1)(d), exclude the filing of communications on paper after a period of ten years from the entry into force of the PLT.

Where a Contracting Party permits electronic filing under Article 8(1)(a), it is obliged to accept filings made in conformity with the electronic standard provided for under the PLT (R. 8(2)(a)). Thus the PLT standard will automatically be a standard to be accepted by Contracting Parties allowing electronic filing. Rule 8(2)(a), however, does not exclude that Contracting Parties in addition thereto allow electronic filing in accordance with other standards.

→ Rule 24 EPC provides for the necessary flexibility to adapt EPC filing requirements to the future PLT standard.

Reservation: Art. 8(1)(d) - JP (see Note 8.04)

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EPO comments (if any)

(3) [*Model International Forms; Model International Formats*]

Notwithstanding paragraph (1)(a), and subject to paragraph (1)(b), a Contracting Party shall accept the presentation of the contents of a communication on a Form or in a format which corresponds to a Model International Form or a Model International Format 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 as prescribed in the Regulations.

(c) Subject to subparagraph (b), a Contracting Party may require that evidence be filed with the Office 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.

ad Article 8(4), R. 9

Rule 9 specifies the requirements which Contracting Parties may prescribe with regard to signatures. As to signatures in electronic form, a Contracting Party will also have to accept electronic signatures which comply with the PLT standard (R. 9(5)(b)).

→ Amendment of Rule 26(2)(i) EPC has to be considered in the context with the introduction of electronic filing. Rule 36(5) EPC already today provides for the necessary flexibility in regard of documents filed subsequently.

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EPO comments (if any)

(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:

(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 (3), (4)(a) and (b), (5) and (6) are not complied with in respect of communications, or where evidence is required under paragraph (4)(c), the Office shall notify the applicant, owner or other interested person, giving an 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 under paragraphs (1) to (6) are not complied with within the time limit prescribed in the Regulations, the Contracting Party may, subject to Article 5 and to any exceptions prescribed in the Regulations, apply such sanction as is provided for in its law.

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Article 9
Notifications

EPC: Art. 119, R. 77 - 82

(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.

Basic Proposal for the Patent Law Treaty (PT/DC/3)

EPO comments (if any)

Article 10
Validity of Patent; Revocation

EPC: Art. 100, 102, 138
TRIPS: Art. 64

(1) [*Validity of Patent Not Affected by Non-Compliance with Certain Formal Requirements*] Once a patent has been granted, it may not be revoked or invalidated, either totally or in part, by the Office, or by a court, a board of appeal or any other competent authority of a Contracting Party, on the ground of non-compliance with one or more of the formal requirements with respect to an application referred to in Articles 6(1), (2), (4) and (5) and 8(1) to (4), 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, by the Office, a court, a board of appeal or any other competent authority of a Contracting Party, without the owner being given at least one 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.

Basic Proposal for the Patent Law Treaty (PT/DC/3)

EPO comments (if any)

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 made, 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, re-instatement of the rights of the applicant or owner with respect to that application or patent, if:

EPC: Art. 120, 121, R. 84 - 85b

ad Article 11

Article 11 applies only to time limits "fixed by an Office". Thus neither an extension of a time limit nor continued processing need to be provided for in regard of statutory time limits. The EPO had always opted for in principle applying Article 11 to all time limits, but did not find sufficient support in the SCP. It does not seem to be very promising to take up the issue again in the Diplomatic Conference.

ad Article 11(1), R. 12

It is important to note that there is no obligation to provide for an extension of time limits under Article 11(1). If, however, such extension is provided for, the Regulations specify the relevant details (R. 12).

ad Article 11(2), R. 12(4)

This is the core provision of the whole Article making compulsory a relief in respect of missed time limits either in form of an extension of the time limit requested after its expiry (Art. 11(1)(ii)) or via continued processing. The provision is the result of extensive discussions in the SCP and has always been supported by the EPO.

Reservations: Art. 11(2)(ii), R. 12(4) - FR

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EPO comments (if any)

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

The procedural details for requesting continued processing are laid down in Rule 12. Of particular importance is Rule 12(4) fixing the relevant time limit for filing the request for continued processing. Although that time limit (2 months) seems to be appropriate, it is felt that it should not start from the expiration of the time limit that was not complied with, but from the date of the notification informing the applicant on his failure to meet that time limit.

→ If the above view is shared by a majority of EPC states, a proposal for amendment of R. 12(4) should be made in the Diplomatic Conference.

(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.

ad Article 11(3), R. 12(5)

Rule 12(5) contains a listing of allowable exceptions under Article 11(3).

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

→ As to R. 12(5)(a)(i), the Office suggests removing the square brackets and limiting the exception to relief under Article 11(1)(ii) or 11(2). Thus continued processing would also have to be granted where a time limit is missed that has been extended under Article 12(1)(i).

(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.

→ As to R. 12(5)(a)(v), the text in square brackets should be deleted. Thus there would be no general exemption from the obligations under Article 11(1) or 11(2) in regard of relief in respect of time limits for actions before review bodies (boards

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EPO comments (if any)

(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 at least one opportunity to make observations on the intended refusal within a reasonable time limit.

of appeal) constituted in the framework of an Office. Under R. 12(5)(a)(vi) however, a possibility to make exceptions with regard to time limits in inter partes proceedings would be maintained.

→ As to R. 12(5)(a)(vii) the text in square brackets should be deleted (exemption from obligation under Art. 11 where accelerated processing has been granted).

Revision of EPC

Article 121 EPC has to be revised accordingly (see CA/PL 19/99).

Article 12

*Re-instatement of Rights After a Finding of Due Care
or Unintentionality by the Office*

(1) [*Request*] 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 re-instate 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 made, 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 grounds on which it is based; and

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

EPC: Art. 122

ad Article 12(1)

In contrast to Article 11(1)(ii) and 11(2), re-instatement of rights applies, subject to Article 12(2), to all time limits for an action before an Office. Such re-instatement, however, must be granted only subject to a finding by the Office that the failure occurred in spite of all due care required by the circumstances.

According to the principle stated in Article 2(1), a Contracting Party would nevertheless be free to re-instate the rights of an applicant without insisting on the due care requirements. Thus given a specific structure of the procedure for requesting continued processing, such processing may be suitable to also fulfil the obligations of a Contracting Party under Article 12(1).

Reservations: Art. 12(1)(vi) - GB (see Note 12.06)

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EPO comments (if any)

(2) [*Exceptions*] No Contracting Party shall be required to provide for the re-instatement 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 grounds 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 at least one opportunity to make observations on the intended refusal within a reasonable time limit.

ad Article 12(2), R. 13(3)

The allowable exceptions under Article 12(2) are listed in Rule 13(3). It is felt that

→ R. 13(3)(ii) (maintenance fees),
R. 13(3)(v) (request for search and examination) as well as
R. 13(3)(vi) (translation of regional patent)
should not appear in the list.

→ With regard to what has been said above under "ad Article 12(1)", an additional exception should be introduced clarifying that re-instatement of rights need not be provided for where in respect of the time limit in question a more favourable relief is provided for under Article 11.

Revision of the EPC

Art. 122 (see CA/PL 19/99).

Basic Proposal for the Patent Law Treaty (PT/DC/3)

EPO comments (if any)

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 made 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*] 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:

EPC: Art. 122, 87, 88, R. 38
PCT: R. 26bis 1

ad Article 13

Referring to the principles in Article 2(1), further processing may be also suitable to fulfil a Contracting Party's obligations under Article 13 (see above ad Article 12(1)).

Revision of EPC

Art. 122 (see CA/PL 19/99).

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EPO comments (if any)

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

(ii) the request is made within the time limit prescribed in the Regulations;

(iii) the request states the grounds on which it is based; and

(iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of all 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*] 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 in accordance with the requirements prescribed in the Regulations; and

(ii) the request is made 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.

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EPO comments (if any)

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

(5) [*Opportunity to Make Observations*] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given at least one 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 licensing agreement or security interest;

(iv) correction of a mistake.

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EPO comments (if any)

(c) The Regulations also provide for the establishment of Model International Forms and Model International Formats, and for the establishment of a request Form or format 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.

Basic Proposal for the Patent Law Treaty (PT/DC/3)

EPO comments (if any)

Article 15
Relation to the Paris Convention

(1) [*Obligation to Comply with the Paris Convention*] Any 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
Assembly

see Annex I

(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.

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EPO comments (if any)

(c) The expenses of each delegation shall be borne by the Contracting Party that has appointed the delegation.

(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, Model International Formats, and the request Form or format, 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, Model International Format, and the request Form or format, referred to in item (ii), and each amendment referred to in item (iii);

(v) perform the function allocated to it under Article 19(2) in respect of the admission of certain intergovernmental organizations to become party to this Treaty;

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

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EPO comments (if any)

(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 endeavour 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:

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EPO comments (if any)

(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) and 18(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 17
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).

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EPO comments (if any)

(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 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 18
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 16(2) and (6) may be amended either by a revision conference, or by the Assembly according to the provisions of paragraph (3).

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EPO comments (if any)

(3) [*Amendment by the Assembly of Certain Provisions of the Treaty*] (a) Proposals for the amendment by the Assembly of Article 16(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, or which become Contracting Parties thereof at a subsequent date.

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EPO comments (if any)

Article 19
Becoming Party to the Treaty

See Annex I

(1) [*States*] Any State which is a party to the Paris Convention or which is a member of the Organization, and in respect of which patents may be obtained, either through the State's own Office or through the Office of another Contracting Party, may become party to this Treaty.

(2) [*Intergovernmental Organizations*] The Assembly may decide to admit any intergovernmental organization to become party to this Treaty if at least one member State of that intergovernmental organization is a party to the Paris Convention or a member of the Organization, and the intergovernmental organization 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.

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EPO comments (if any)

(3) [*Regional Patent Organizations*] [The European Patent Organisation][, the Eurasian Patent Organization][, the African Regional Industrial Property Organization][and the African Intellectual Property Organization], having made the declaration referred to in paragraph (2) in the Diplomatic Conference that has adopted this Treaty, may become party to this Treaty as intergovernmental organizations.

(4) [*Ratification or Accession*] Any State or intergovernmental organization referred to in paragraphs (1) to (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 20

Entry into Force; Effective Dates of Ratifications and Accessions

see Annex I

(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:

Basic Proposal for the Patent Law Treaty (PT/DC/3)

EPO comments (if any)

- (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 with the Director General, or from any later date indicated in that instrument;
- (iii) each of [the European Patent Organisation][, the Eurasian Patent Organization][, the African Regional Industrial Property Organization][and the African Intellectual 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, 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 admitted to become party to this Treaty, from the expiration of three months after the deposit of its instrument of accession, or from any later date indicated in that instrument.

Article 21

Application of the Treaty to Existing Applications and Patents

(1) [*Principle*] (a) Subject to paragraph (2), a Contracting Party shall apply the provisions of this Treaty and the Regulations, other than Article 5 and Article 6(1) and (2), to applications which are pending, and to patents which are in force, on or after the date on which this Treaty binds that Contracting Party under Article 20.

[(b) A Contracting Party shall apply Article 12 and related Regulations, even where the failure to comply with a time limit occurred prior to the date on which this Treaty binds that Contracting Party under Article 20.]

(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 20.

Article 22
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.

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EPO comments (if any)

Article 23
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 24
Languages of the Treaty

(1) [*Original Texts*] This Treaty is signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally 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 for becoming party to the Treaty under Article 19(1), whose official language,

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EPO comments (if any)

or one of whose official languages, is involved, and [the European Patent Organisation][, the Eurasian Patent Organization][, the African Regional Industrial Property Organization][and the African Intellectual 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.

Article 25
Signature of the Treaty

See Annex I

The Treaty shall remain open for signature at the headquarters of the Organization for one year after its adoption by any State that is eligible for becoming party to the Treaty under Article 19(1) and by [the European Patent Organisation][, the Eurasian Patent Organization] [, the African Regional Industrial Property Organization][and the African Intellectual Property Organization].

Article 26
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.

ANNEX I

I. THE PLT'S ADMINISTRATIVE AND FINAL PROVISIONS

1. Accession, signature, ratification and entry into force are governed by Articles 19, 20 and 21 BP. Article 16 BP specifies the powers of parties to the future treaty, and their voting rights in the PLT Assembly.

A. ACCESSION

2. Under Article 19(2) BP, international organisations too may become party to the PLT if they grant patents with effect for their member states (Article 19(2)(i) BP) or have enacted legislation which is binding on these states in the field of patent law (Article 19(2)(ii) BP). However, such accession is normally subject to admission by the PLT Assembly.
3. Such admission is not however necessary for the regional patent organisations expressly mentioned in Article 19(3) BP (**EPO**, **EAPO**, **OAPI**, **ARIPO**), any of which can thus accede automatically if, in the Diplomatic Conference, it gives the declaration pursuant to Article 19(2)(i) BP, ie that it grants patents with effect for its member states.
4. Article 19(3) BP does not apply to the European Community, which can accede only under the general provisions of Article 19(2) BP. Article 19(2)(ii) BP is specifically tailored to the Community, being designed to allow its admission to accession if it enacts legislation binding on its member states on matters covered by the PLT. The planned EU regulation on the Community patent would fulfil this criterion.

NB: The USA has entered a reservation against Article 19(2)(ii) BP.

5. The European Community can thus accede only once the relevant legislation has entered into force. Admission is decided upon by the PLT Assembly, and requires a 2/3 majority of votes cast (Article 16(2)(v) and (5) BP).

B. SIGNATURE

6. For states, and the regional patent organisations (such as the EPO) entitled to accede under Article 19(3) BP, the Treaty remains open for signature for one year after its adoption (Article 25 BP). Signatory states and organisations can ratify it under Article 19(4)(i) BP; for others, provided they can become party to it under Article 19 BP, it is open for accession (Article 19(4)(ii) BP).
7. The PLT will thus operate a two-stage procedure. In the first, the text of the Treaty is confirmed, through signature, as authentic and definitive; in the second, the signatory states and organisations agree, by depositing their instruments of ratification, to be bound by it (see also Articles 10, 11, 14 and 15 of the Vienna Convention on the Law of Treaties).

C. RATIFICATION AND ENTRY INTO FORCE

8. Under Article 26(1) in conjunction with Article 19(4) BP, instruments of ratification and accession must be deposited with the Director General of WIPO. Under Article 20(2)(iii) BP, the Treaty becomes binding for the EPO (and the other regional patent organisations) three months after its entry into force if the instrument was deposited **before** the said entry into force. If the instrument is deposited **after** entry into force, the Treaty becomes binding three months after deposit or at any later date indicated in the instrument.
9. The PLT will enter into force three months after deposit of the tenth instrument of ratification or accession by a **state** (Article 20(1) BP). Instruments deposited by international organisations have no bearing on this.

D. PLT ASSEMBLY AND VOTING RIGHTS

10. The PLT Assembly is composed of the delegations of the contracting parties (Article 16(1) BP). It has power in particular to amend the Regulations implementing the PLT (Article 16(2)(iii) BP), and thus over a number of matters of practical importance for the patent grant procedure (eg time limits, forms, formats, and filing arrangements).
11. The Assembly's decisions are normally taken by a two-thirds majority of votes cast, if they cannot be arrived at by consensus (Article 16(5) BP). The voting rights system is like that envisaged for PLT I (see Article 27(4) PLT I). All parties to the Treaty are entitled to vote; if the party is a state, it has one vote and can vote only in its own name (Article 16(4)(b)(i) BP).
12. International organisations can vote in the place of those of their member states which belong to the PLT, provided none of them has exercised its right to vote (Article 16(4)(b)(ii) BP). In such cases the organisation has a number of votes equal to the number of its member states which are party to the PLT.
13. A further complication is that an international organisation can vote only if no other such organisation has already voted in the place of the same states. Thus the EPO can take part in a vote only if neither an EPC contracting state nor the European Community (if party to the Treaty) has not exercised its own right to vote.

II. ASSESSMENT AND CONCLUSIONS

14. The BP provisions on PLT accession, signature and ratification are in line with those of the other WIPO treaties, and the Office has no fundamental reservations or objections. Express mention of the EPO and other regional patent organisations as entitled to accede shows how important these organisations have become in the patent field.
15. In itself, the EPO's right to accede has never been an issue. The USA's problem with Article 19(3) BP is not the accession right as such, merely the express mention of the organisations concerned (see point 6 above). There is no need to consider whether that mention ought to save these organisations from having to make, in the Diplomatic Conference, the declaration pursuant to Article 19(3) in conjunction with Article 19(2)(i) BP, namely that they grant patents. Certainly for the EPO this would only be a formality (see Article 4(3), 2(2) EPC).

16. Provided the Diplomatic Conference accepts Article 19(2) and (3) BP in the form proposed, the Office takes the view that the EPO should make the declaration at the Conference, as this would reinforce its right to accede automatically (see point 6 above). This would be done by the President of the Office, as the Organisation's representative under international law (see Article 5(3) EPC).
17. Whether the EPO should sign the Treaty (see points 9 and 10 above) immediately after the Diplomatic Conference, within the period for signature, or indeed at all, will depend mainly on the outcome of the Conference but also on the wishes of the EPC contracting states. In the Office's opinion, the Organisation should sign in close connection with the majority of the EPC contracting states, to bring out the importance Europe attaches to harmonisation of patent law.
18. It should be some years before the ratification issue (see points 11 and 12 above) arises for the EPO, ie once the amendments bringing the EPC into line with the PLT have been made or at least initiated.
19. In practice, the voting rights proposed for the PLT Assembly (see points 15 and 16 above) mean that those of international organisations are likely to be a dead letter. This is not entirely unproblematical for Europe: in developing the PLT, the contracting states, the Organisation and possibly also the European Community will tend to focus on the particular requirements of their own procedural legislation, and will not always be able to give enough weight to the interests of the organisation to which they belong, or of the states for whom they are voting. This is particularly awkward for a treaty - like the PLT - which regulates formal requirements and procedures, because Europe's patent procedure provisions still vary considerably.
20. Office representatives pointed this out at the SCP's second meeting (see SCP/2/13, point 126) but in view of the resistance expected from the US chose not to ask that the EPO be given an additional vote of its own in the PLT Assembly. In the Office's view, a separate vote for the EPO (and the other international organisations) is not feasible at the moment, particularly with the European Community also able to become a party to the PLT in the future.
21. If Europe agrees to the proposed voting system, it will need to clarify how best to represent, in the PLT Assembly, the specific interests of the EPO and European Community, and the national concerns of their member states, bearing also in mind that, for the foreseeable future, membership of the EPO and EU will not be identical.