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Official Notice

Patent Cooperation Treaty (PCT) Rule Changes Effective – 1 April 2006, and 1 April 2007

The PCT Assembly Meeting of September/October 2005 agreed to some amendments to the PCT Rules. Some of these rule changes come into effect on 1 April 2006. The more significant rule changes come into effect on 1 April 2007. The purpose of this notice is to provide an overview of the amendments, and their practical effect for practitioners dealing with IP Australia as an Authority under the PCT.

Note: This notice is intended to provide an overview of the new rules, and therefore focuses on the main issues. Where it is necessary to make use of the new mechanisms – especially with respect to Missing pages, and Restoration of Priority – practitioners should ensure they are familiar with all relevant provisions to ensure the mechanism is available in their particular circumstances. The text of the rule changes as submitted to the PCT Assembly are currently available at: www.wipo.int/meetings/en/doc_details.jsp?doc_id=48427

Rule changes with effect from 1 April 2006

Arabic as a language of Publication

Under Rule 12 of the PCT, an International Application can be filed in any language accepted by the Receiving Office. (IP Australia accepts a filing in *any* language – although it requires a translation into English for the purpose of Search and Examination [rules 12.3 and 55.2].) Rule 48.3 specifies the languages of publication. Where an application is not filed in a language of publication, the applicant must provide a translation into a language of publication within 14 months of the priority date.

Rule 48.3 has been amended to include Arabic as a language of publication. The languages of publication will now be Arabic, Chinese, English, French, German, Japanese, Russian and Spanish.

Amendment to PCT Minimum Documentation Requirements

Rule 34 sets out the ‘Minimum Documentation’ requirements for consideration during an International Search. It has been amended to include patent documents of the Republic of Korea.

International Publication, and PCT Gazette, in electronic form

There are a number of technical amendments to the PCT rules to properly accommodate the move to electronic publication of pamphlets, and the PCT Gazette.

Rule changes with effect from 1 April 2007

Missing Elements and Parts of the International Application

The PCT Rules have been amended to better deal with the situation where a PCT application is filed with a part or element missing. The principle changes are embodied in revised Rule 20, which sets out the basis for determining the International Filing Date.

The most notable aspect of this amendment is the ability to rectify the omission of a part or element without loss of the filing date, if the missing part or element was completely contained in the priority document. In order to invoke this mechanism:

- The PCT Request Form must include a statement of incorporation by reference of the priority document [see Rule 4.18]. (The statement can be added to the Request after the filing date – but **ONLY** if the statement was otherwise contained in or submitted with the international application when it was filed.) A standard statement (the form of wording having been agreed to by the member states) will be included on the PCT Request forms produced by WIPO (including PCT-Safe). Practitioners should not use an alternative form of wording unless they fully understand the implications in each of the possible designated states.
- For the incorporation by reference to be effective, it must be confirmed within 2 months of filing [see rules 20.6 and 20.7]. That is, it is important to identify the existence of a missing part or element fairly soon after filing. Where an entire element is missing, applicants can expect to receive a notification from the Receiving Office to this effect. However applicants should have no expectation that the Receiving Office will notice, or check for, the existence of a missing part.
- A copy of the priority document must be filed with the notice of confirmation if the applicant has not met rules 17.1(a), (b), or (b-*bis*) in relation to the priority document [Rule 20.6]. **In practical effect**, the need to file the priority document at the time of confirmation can only arise for applications filed with the Australian Receiving Office if the priority document is **not** an Australian application.
- When confirming the incorporation by reference, it will be necessary to identify the missing part or element in the priority document that is being incorporated [Rule 20.6].
- To maintain the filing date, the missing part or element must be incorporated without any change. If the Receiving Office finds that the missing part or element was *not* completely contained in the priority document, the missing part or element will still be included. However the international filing date will be corrected to be the date of filing the missing part [Rule 20.5(c), 20.6(c)].
- If the filing date is lost as a result of the incorporation of the missing part, the applicant can request the missing part be disregarded and the original filing date restored. This must be done within one month of being notified of a change in the filing date as a result of the incorporation of the missing part [Rule 20.5(e)].
- Where the applicant makes use of the incorporation by reference mechanism:
 - this fact will be identified on the Pamphlet [Rule 48.2(v)];
 - a Designated Office may require a translation of the priority document [Rule 51*bis*.1(e)(ii)] together with an indication of where the missing part or element was contained; and
 - a Designated Office may treat the application as if the filing date had been lost as a result of the incorporation of the missing part or elements. This can only occur if the Designated Office considers the relevant rules under the PCT have not been complied with, and has given the applicant an opportunity to make observations. Where this situation arises, the applicant has an opportunity to request the missing part or element be disregarded – such that the filing date is not lost [Rule 82*ter*.1].

- (**Note:** At this time, the manner in which these issues will be dealt with in the Australian legislation has not been decided.)

Reservations

The Rules provide for two reservations for this new mechanism:

- Firstly, a Receiving Office can make a reservation if the national law of that country is incompatible with certain specific rules [Rule 20.8(a)]. Consequently, the ability to deal with missing parts or elements may not be available before all Receiving Offices.
- Secondly, and more importantly, a Designated Office can make a reservation if the national law of that country is incompatible with certain specific rules [Rule 20.8(b)]. That is, while the Receiving Office may incorporate a missing part or element without loss of the filing date, a Designated Office that has made a reservation will allocate a later filing date. However, in such circumstances Rule 82^{ter} will continue to apply – so that the filing date can be restored by removing the missing part or element before that office.

It is anticipated that Australia will not be making any reservations under these provisions. However practitioners faced with having to rely on the missing parts provisions should note which countries have a current reservation against the mechanism.

Drafting of Provisional specifications

The missing parts mechanism comes into effect for PCT applications filed from 1 April 2007. Having regard to the possibility of restoration of priority, **practitioners should consider including at least one claim in any provisional applications filed after 1 February 2006**. This will ensure that the filing date of a PCT application claiming priority from that provisional application can maintain its filing date, in the event that the claims are accidentally omitted from the PCT application at filing.

Australian Practice for national filings

These changes to the PCT are an implementation of Article 5(6) and (7) of the Patent Law Treaty. Practitioners are reminded that the Australian legislation was amended in 2001 to implement this mechanism for national filings – see regulation 3.5A.

Restoration of the Right of Priority

The PCT Rules have been amended to provide for the restoration of the right of priority where an international application is filed up to two months after the end of the normal 12-month priority period. Formally this is not an extension of the priority period – but it has the same practical effect.

The restoration mechanism is largely dealt within new Rule 26^{bis}.3, and operates as follows:

- Restoration is available in respect of priority applications filed between 12 and 14 months before the International Filing Date [Rule 26^{bis}.3(a)].
- The request for restoration must be filed no later than 14 months from the filing date of the priority application [Rule 26^{bis}.3(e)].
- The request should be accompanied by a declaration or other evidence in support of the requested restoration [Rule 26^{bis}.3(b)(iii)], and the Receiving Office may require the declaration be filed with it ‘within a time limit which shall be reasonable in the circumstances’. At this time it may be assumed that IP Australia will require such a declaration, and expect that typically it is filed at the same time as (or a small number of days after) the filing of the request for restoration.

- An extension can be granted on the basis that the Receiving Office is satisfied that the failure to file the international application within the priority period:
 - occurred in spite of due care required by the circumstances having been taken; **or**
 - was unintentional.
- Subject to reservations being made, each Receiving Office shall apply at least one of these criteria, and may apply both. It is presently envisaged that IP Australia will apply both criteria.
- A Receiving Office may charge a fee for processing requests for restoration of priority [Rule 26bis.3(d)]. It may be anticipated that IP Australia will charge a fee.
- The request must state the reasons for failure to file the international application within the priority period, and preferably be accompanied by a declaration [Rule 26bis.3(b)]. Practitioners should assume that the requirements of this declaration are the same as for declarations required to support an extension of time under s.223 of the *Patents Act 1990*.
- A request cannot be refused without giving the applicant an opportunity to make observations on the intended refusal.
- Where an extension is granted, that fact, and the criteria applied, will be published on the pamphlet [Rule 48.2(a)(xi) and (b)(vi) and (vii)].

An important issue is that of the criterion that is used in justification of the restoration. If the restoration occurs under the ‘in spite of due care’ criterion, that restoration must be recognised by all designated offices (subject to reservations having been made). Restorations based on the ‘unintentional’ criterion will only be recognised by those countries that apply ‘unintentional’ in their national law. Accordingly an extension granted on the basis of ‘in spite of due care’ is far preferable in terms of coverage than one based on ‘unintentional’.

The Rules have put in place a regime that provides maximum certainty. However there is a need for checks and balances at the Designated Office stage. Accordingly, if a restoration is granted:

- the extension is not effective in a Designated State where the Designated Office or a court finds that the requirements to justify the restoration were not complied with [Rule 49ter.1(c)]. This particularly relates to the existence of the relevant criterion; but
- a Designated Office shall not review a decision of the Receiving Office unless it reasonably doubts (in particular) the relevant requirements were met [Rule 49ter.1(d)].

The fact that a Receiving Office refuses a request for restoration does not prevent the applicant applying for restoration under its national law, with Rule 49ter.2 setting out the requirements of national law that must be available (subject to any reservations made).

In making use of the restoration of priority mechanism, practitioners will need to be particularly mindful of:

- which criterion should the request be made in respect of, having regard to the reasons that are available to justify the restoration, and which countries accept the ‘unintentional’ criterion; and
- which countries have filed reservations, and in respect of which component of the mechanism. It is anticipated that many countries will file reservations with respect to certain parts of this mechanism.

Practitioners should note that the criterion of ‘unintentional’ can be equated to the s.223(2)(a) condition of ‘error or omission’. The requirement of ‘in spite of due care’ is of narrower ambit. It would include the *force majeure* situations that arise under the s.223(2)(b) condition of ‘circumstances beyond control...’ It would also cover a range of s.223(2)(a) errors or omissions. But it would not cover situations where the applicant or their agent had not exercised due care to endeavour ensuring the application was filed within the priority period. For example, a failure to maintain a diary system would probably be taken as an absence of due care.

Rectification of Obvious Mistakes

Rule 91 has been substantially revised to remove some of the apparent anomalies in the provision. The most notable change is that the requirement that both the mistake and its rectification must be obvious will be assessed by 'the competent authority' rather than 'anyone'. In making this determination, the rule provides that:

- **for a mistake in the description, claims or drawings:** the Authority can only take into account the contents of the description, claims and drawings. Recourse to other documents (such as the priority document, or covering letters) is not allowed; and
- **for mistakes in the Request:** the Authority can only take into account the contents of the international application itself, together with any other document submitted with the request or any priority document.

Particular rectifications that cannot be made under the new provisions are:

- Inserting a missing page or element of the application [Rule 91.1(g)];
- rectification of the Abstract [Rule 91.1(g)(ii)];
- Article 19 amendments can only be rectified by a competent IPEA; and
- Rule 91.1(g)(iv) excludes a rectification of a priority claim *if the rectification would cause a change in the priority date*.

The new rule allows a Designated Office to disregard a rectification if it would not have authorised the rectification if it had been a competent Authority. Consequently if an applicant is successful before an Authority in obtaining a 'rectification' of something that is not an 'obvious mistake', there is no obligation for Designated Offices to accept that rectification.

In practical effect, practitioners can assume that the revised rule makes little change to the type of rectifications that can be made.

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