

Public Consultation Paper

Patent Law Treaty

The [*Patent Cooperation Treaty*](#) (PCT) reduces the time, cost and complexity of applying for patent protection by providing a mechanism for a single application to have effect in a number of different countries. In contrast, the [*Patent Law Treaty*](#) (PLT) has been developed to harmonise and streamline national and regional formality procedures where applications are made directly to individual countries or with regional patent offices. Australia has been a member of the PCT since 31st March 1980 and is considering joining the PLT.

Background

The PLT was adopted at a Diplomatic Conference on 1 June 2000 and entered into force on 28 April 2005. The PLT applies to national and regional applications for patents, patents of addition and divisional applications. It aims to harmonise and streamline formal procedures for obtaining and maintaining a patent in a similar way to the [*Trademark Law Treaty*](#) (to which Australia has been a party since 21 January 1998) and the newer [*Singapore Treaty on the Law of Trademark*](#) which simplify and streamline procedures for trade marks. These treaties do not harmonize substantive requirements of patent or trade mark law.

Fourteen countries, including the United Kingdom and Denmark, are now party to the [*PLT*](#). There are forty five signatories to the treaty including a number of the major countries in which Australian applicants seek protection, such as the USA and France, as well as the European Patent Office. A number of these signatories are now considering or preparing for accession to the treaty. For example, accession is currently under consideration by the US Senate.

Australia's *Patents Act 1990* is already consistent with the requirements of the PLT.

Objectives of the PLT

The PLT seeks to streamline and harmonise formal requirements set by national and regional patent offices for the filing and processing of national and regional patent applications.

Briefly, the PLT provides for:

- **Standardisation of the requirements for allocation of a filing date to patent applications** (see Article 5)

The filing date is the date on which the Patent Office of a Contracting Party receives all of the following elements:

- (a) an express or implicit indication that the elements are intended to be an application;
- (b) indications allowing the Office to identify or contact the applicant – indications of both may be required by an Office; and
- (c) a part which on the face of it appears to be a description.

The treaty also provides for the allocation of a filing date in circumstances where the application includes a reference to an earlier filed application for establishing the filing date or where parts of the description or drawings are missing and are subsequently filed.

- **the standardisation of the formal requirements for national and regional patent applications based on the requirements for international applications under PCT** (see Article 6)

This will eliminate procedural gaps between the national, regional and international patent systems.

- **Model International Forms such as patent request forms, powers of attorney, and for recordation of licences, security interests and assignment of ownership.** (see Articles 8 and 14 and Rule 20)

Countries may still use their own forms however where a document is filed using one of the model forms provided under the PLT, it must be accepted.

- **simplification of patent office procedures**

This includes providing that:

- Offices are prohibited from requiring the applicant or other interested person to appoint a local agent or legal representative for certain procedures including filing an application for the purposes of obtaining a filing date and payment of fees including maintenance fees (see Article 7);
 - Offices are prohibited from requiring evidence in certain circumstances unless that Office has reason to doubt the veracity of a matter or the accuracy of a translation (for example see Article 6(6)); and
 - Requests made in relation to a number of applications, such as for a change of name or address or a power of attorney, can be made in a single communication (see Rules 7, 15 and 17).
- **safeguarding against unintentional loss of rights where formality requirements or time limits have not been met.**

Most significantly the PLT provides for:

- notification of non-compliance with formal requirements and the opportunity to correct within established time limits (see for example Article 6(7));
- restrictions on the revocation of patents for failure to meet formal requirements (see Article 10);
- extensions of time or continuation of processing where time limits set by the office (not statutory time limits) are not met in certain circumstances eg a time limit set for the applicant to respond to an examination report. (see Article 11); and
- reinstatement of rights including priority rights in certain circumstances where the failure to meet a time limit was despite due care or (at the option of the contracting party) was unintentional (see Articles 12 and 13).

- **facilitating electronic filing (see Article 8)**

Contracting Parties can choose how they receive communications and whether they accept only electronic or paper correspondence or both. They must however accept paper communications for the purpose of complying with a time limit or for establishing the filing date. Where a contracting party accepts electronic communications for the purpose of and according to the requirements of the PCT it must accept non-PCT communications meeting same requirements.

Impact on Australian Domestic Law

The *Patents Act 1990* is already consistent with the requirements of the PLT and no further legislative action is required for accession.

Other Impacts

While IP Australia accepts paper and electronic communications for the purpose of both PCT and non-PCT applications, technical inconsistencies exist between the electronic systems such that non-PCT communications meeting PCT electronic communication standards cannot be processed in some circumstances. Hence currently Rule 8(2)(a) is not fully satisfied. To address this issue changes to IP Australia's electronic communications systems will be required so that non-PCT communications made in accordance with PCT requirements will be accepted in all cases.

Benefits

Inventors seeking patent protection must, as a first step, meet certain formality requirements in order to avoid rejection of their application. The PLT simplifies and harmonises the formal requirements member states can apply in relation to patent applications and establishes important safeguards against loss of rights on procedural grounds. More specifically in simplifying and standardising the requirements, the PLT offers patent applicants and patent offices a number of advantages including:

- use of standardised forms that reduce the risk of error;
- simplified procedures leading to cost reductions for inventors, applicants, patent attorneys and patent offices; and
- enhanced legal certainty for applicants filing in their home country and abroad.

Patent applicants will therefore have greater certainty in prosecuting patent applications in the patent offices of contracting parties and reduced compliance costs.

The economies of member states also stand to benefit from the harmonisation of IP systems as technology transfer is facilitated and foreign investment is encouraged.

Should Australia ratify the PLT?

Australia is undergoing domestic treaty processes to assist the Australian Government in deciding whether Australia should accede to the PLT.

The PLT is seen as a major step towards further harmonization of patent law and is expected to reduce the cost of patent protection and make the process of obtaining a patent more user-friendly and more widely accessible.

Australia already provides a patent system that is substantially PCT compliant and hence provides significant benefits to local and foreign applicants in this country. Accession to the PLT by other countries and regional patent organisations, including Australia's major trading partners, will be a significant benefit to Australians applying for patent protection overseas.

Important benefits of Australia's accession to the PLT lie in the positive example it provides for our trading partners and in the ability it will give Australia to encourage non-members to simplify and harmonise their domestic patent systems to be consistent with the PLT.

As a consequence, Australian patent holders seeking to protect and commercialise their inventions in foreign markets will reap the benefits of greater harmonisation, flexibility and security.

Accession to the PLT will also enable Australia to influence further enhancement of the treaty through participation in the PLT Assembly. This would include Australia's ability to contribute to the development of the model international forms.

Further information on the PLT including the full text, can be found on the WIPO website at: **<http://www.wipo.int/treaties/en/>**