

# On the alignment of the European Patent Convention and the Patent Cooperation Treaty with requirements of the Patent Law Treaty

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## Summary and Conclusions

In this thesis, results are presented of a study on the alignment of the European Patent Convention and the Patent Cooperation Treaty with requirements of the Patent Law Treaty. The Patent Law Treaty (PLT) was drafted with the aim to “streamline and harmonize” formal requirements set by national or regional Patent Offices for the filing of national or regional patent applications and the maintenance of patents. The PLT provisions refer as much as possible to the provisions of the Patent Cooperation Treaty (PCT) and its Regulations in order to keep the PLT as simple as possible and to avoid creating different international standards regarding patent formalities with respect to national and international applications. The harmonization of procedures under national and regional patent laws was expected to result in easier access to worldwide patent protection and cost reduction for applicants in those procedures.

The Patent Law Treaty does not harmonize substantive patent law; instead, the approach is more to the administrative side of the patent process. Inventors seeking patent protection must follow certain rules which vary from country to country. The PLT aims to simplify the rules and make them the same for all Contracting Parties. As is discussed in this thesis, the PLT did not achieve this goal.

During the last decade, requirements of the Patent Law Treaty have been implemented in, for instance, the Patent Cooperation Treaty (PCT; April 2007) and in the European Patent Convention (“EPC 2000”; December 2007). When studying and comparing the outcome of the implementation, not much “harmonization and streamlining” can be detected between the PCT and the EPC. In fact, there was more coherence between the EPC and the PCT with respect to requirements for filing patent applications before both patent treaties were aligned with the PLT. This is all the more peculiar when it is taken into account that more than 50% of the patent applications received by the European Patent Office (EPO) are not European patent applications but international applications, for which the EPO in its capacity of “receiving Office” has to apply the provisions of the PCT. The PCT provisions deviate in crucial aspects from the corresponding provisions in the EPC, such that the response from the EPO is significantly different depending on the treaty under which the application was filed. This should not be the case.

By way of example, if an applicant or an inventor files a European patent application at the European Patent Office (EPO) under the provisions of the European Patent Convention (EPC) or, alternatively, files an international application at the EPO, as receiving Office under the provisions of the Patent Cooperation Treaty (PCT), the same EPO has to deal with totally different requirements with respect to:

- The accordance of a date of filing,
- Filing an application by reference to a previously filed application, or
- Filing missing parts of the description or missing drawings.

In practice, this leads to “strange” situations, such as, *e.g.*:

- Upon receiving a European patent application, the EPO will accord a date of filing if the applicant only files a description; claims are not a filing date requirement. However, the EPO acting as receiving Office under the PCT, will not accord an international filing date to an international application if the applicant does not file at least one claim.
- Filing an international application by reference to a previously filed application is not possible under the PCT, whereas this is allowable under the provisions of the EPC.
- The EPO, acting as receiving Office for an international application, allows an applicant to file (an entire set of) claims or the entire description as “missing element”, whereas this is clearly not allowable under the provisions of the EPC where only “missing parts of the description or missing drawings” can be filed.
- If a missing element or part is to be added later on into an international application, based on an earlier priority application, such priority claim must have been made on the original filing date, *i.e.* the “date on which one or more elements referred to in PCT Article 11(1)(iii) were first received by the receiving Office”.  
If an applicant requests insertion of a missing part of the description or missing drawings into an already filed European patent application, based on an earlier priority application, the priority claim in question may be added later on.

While aligning the various national patent laws and regional patent treaties with requirements of the relatively new Patent Law Treaty (PLT), each of the involved national or regional patent Offices seemingly interpreted the PLT from their own perspective without much consultation with colleague Offices.

For the purpose of this thesis, a number of subjects of the Patent Law Treaty have been selected. These subjects of study are:

- 1) Requirements for the accordance of a filing date with focus on the following three issues:
  - The basic requirements for according a filing date;
  - The filing date in those cases where a missing part of the description or a missing drawing is filed;
  - The filing of an application by reference to a previously filed application.
- 2) Relief in respect of time limits including continued processing and reinstatement of rights, after a finding of due care or unintentionality by the Office.
- 3) Restoration of the priority right.

None of the above subjects was present in the Draft PLT put before the *Committee of Experts on the Patent Law Treaty* at its first session in December 1995, although some of the later-inserted provisions were modeled after texts in the Basic Proposal submitted to

the 1991 Diplomatic Conference on the "*Treaty supplementing the Paris Convention for the Protection of Industrial Property as far as Patents are Concerned*".

### **1 Negotiation history of the Patent Law Treaty.**

Since the continuation of the 1991 Diplomatic Conference in The Hague on the harmonization of the substantive provisions of patent laws had become impossible in view of the position taken by the Delegation of the United States of America, it was agreed in 1995 that another approach for promoting harmonization, covering matters concerning the formality requirements of national and regional patent procedures, would be initiated by the World Intellectual Property Organization (WIPO). Five sessions of the *Committee of Experts on the Patent Law Treaty*, and three sessions of its successor, the *Standing Committee on the Law of Patents* (SCP), were held to develop the "Basic Proposal" as presented to the Diplomatic Conference for the Adoption of the Patent Law Treaty, which was held in Geneva from May-June 2000.

During the negotiation process, a number of provisions in the PLT were brought forward by the Delegations in order to accommodate the local practice in their home countries. If no agreement could be reached on the implementation of such a requirement, often the desired amendment was incorporated in the PLT but without prescribing it as mandatory. As a consequence, the Patent Law Treaty contains a puzzling mix of compulsory requirements ("shall") and optional requirements which may be implemented as compulsory ("may require") by a PLT Contracting Party. Such diversity of requirements does not stimulate the achievement of the goal of the PLT to "streamline and harmonize" formal requirements set by national and regional Patent Offices for the filing of national or regional patent applications and the maintenance of patents.

From studying the documents relating to the negotiation history of the Patent Law Treaty, it can be inferred that the role of the World Intellectual Property Organization (WIPO) in the negotiation process resulting in the PLT was more of a facilitating nature than aimed at obtaining a Treaty that encompasses mainly compulsory requirements. The inclusion of optional requirements should only have been allowed in a limited number of exceptional cases. On the other hand, it can be understood that the desire to reach an agreement on a Patent Law Treaty, often made it necessary to bridge differences; this was not always possible, and this is one of the reasons why there are so many alternative routes in the PLT.

As the Patent Law Treaty does not directly involve the World Intellectual Property Organization, because there are no centralized functions, the International Bureau of WIPO merely acts as depository of the PLT and is not in a position to give an official interpretation of the Treaty, as such interpretation is the exclusive competence of the

PLT Contracting Parties. When asked, the WIPO will provide assistance to an aspirant PLT Contracting Party. Example texts have been prepared by the International Bureau of WIPO, which can be used as a guidance on how the requirements of the PLT can be implemented in the national/regional law; these texts have no official status. An aspirant PLT Contracting Party is, of course, free to make its own choices when implementing the Patent Law Treaty in its national/regional patent law. Nevertheless, it is believed that such textual suggestions would be helpful in understanding and illustrating the scope of the PLT and would stimulate a more uniform implementation of the PLT in national/regional patent laws. A more active role of the World Intellectual Property Organization would be welcomed in this respect.

## **2 Filing date requirements**

Article 5 of the PLT governs the requirements for the accordancy of a date of filing. In particular, Article 5(1) PLT prescribes the maximum and minimum number of elements of an application required for according a filing date. First, the Office receiving the application documents needs to be satisfied that the elements which it has received are intended as an application for a patent. Second, the Office must be provided with indications which identify the applicant and/or allow the applicant to be contacted. Instead of such indications, the Office may accept evidence allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office. Third, the Office must have received a disclosure of the invention, either in the form of what appears to be a description or, where permitted, a drawing in place of that description. In addition, a Contracting Party is obliged to accept, at the time of filing, the replacement of the description and any drawings in an application by a reference to a previously filed application, subject to certain formal requirements [Article 5(7) PLT].

The PLT also provides rules for establishing a filing date in those cases where a part of the description or drawing is missing from the initially filed application [Article 5(6) PLT]. Normally, the filing of a missing part or drawing results in the accordancy of a later filing date. However, if the application claims priority of an earlier application, and the missing part or drawing is “completely contained” in the earlier application, the originally accorded filing date will be maintained.

### **2.1 European Patent Convention**

In Chapter II of this thesis, the requirements in the European Patent Convention (EPC) for the accordancy of a date of filing and the option to file missing parts of the description or missing drawings are discussed in relation to requirements of the PLT. The filing date requirements of the PLT were fully adopted in the EPC [Rule 40(1) EPC].

With respect to the filing of missing parts of the description or missing drawings based on content which is “completely contained” in an earlier application from which priority is claimed, the *Guidelines for Examination in the European Patent Office* implementing Rule 56(3) EPC allow an applicant to add the priority claim *after* the filing date of a European patent application. This is a direct violation of Article 5(6)(b) PLT and, in addition, is in conflict with the requirement that a patent application may not be amended to contain subject-matter extending beyond the content of the application as filed [Article 123(2) EPC]. It is recommended to amend Rule 56(3) EPC to bring it into conformity with Article 5(6)(b) PLT. Alternatively, the section of the Guidelines should be amended to stipulate that, if an applicant desires to file missing items based on content in a priority application, the priority claim should have been made on the initial filing date of the application. This would bring the EPC in line with the requirements of the PLT.

In Chapter III of this thesis, the filing date requirements are discussed in relation to filing a European patent application by reference to a previously filed application. Upon implementing the “filing by reference” requirements, the EPO made its own selection from the mix of compulsory and optional requirements as given in Article 5(7)(a) and Rule 2(5)(b) PLT. In particular, Rule 40(2) EPC states that the applicant must state the filing date and number of that application and the Office with which it was filed, and indicate that the reference replaces the description and any drawings. In addition, Rule 40(3) EPC requires an applicant to file a certified copy of the previously filed application within two months of filing the application. Rule 40(3) EPC contains the additional requirement that the applicant must file a translation of the previously filed application in those cases, where that application is not in an official language of the EPO. Although both the filing of the copy and the translation of the previously filed application are mentioned in the same paragraph of Rule 40 EPC, the EPO has decided to treat these requirements differently. Whereas the filing of the copy is made compulsory for the accordance of the date of filing, the filing of the translation is considered as an issue of formalities. Hence, if an applicant does not file the certified copy of the previously filed application in due time, his application will not be treated as a European patent application. On the other hand, the date of filing already accorded to his application will be retained if the applicant does not furnish a required translation of the previously filed application. The fact that one element in a paragraph in a Rule titled “Date of filing” is treated as a filing date requirement, whereas another element in the same paragraph is not, renders Rule 40(3) EPC unclear. It is recommended to move the requirement to furnish a required translation to another Rule.

In practice, the option of “filing by reference” appears already to have become outdated as a result of advances in transmission technology and should not be regarded as a preferred option for filing a patent application. Therefore, the option of “filing by reference” could be abolished in Rule 40(1)(c) EPC, thereby at the same time deleting Rule 40(2) and (3) EPC.

Although the implementation of filing date requirements in the EPC 2000 closely follows the PLT provisions, it has resulted in a system that is substantially more complicated than under the EPC 1973, thereby defying the aim of streamlining the PLT.

## **2.2 Patent Cooperation Treaty**

In Chapter IV of this thesis, the requirements in the Patent Cooperation Treaty (PCT) for the accordance of a date of filing and the option to file missing parts of the description or missing drawings are discussed in relation to requirements of the PLT.

Both the PLT and the PCT are international treaties on patent law. The PCT cannot become a “Contracting Party” to the PLT. So there is, *ex lege*, no reason for the PCT to comply with the requirements set by the PLT. A main feature of the PLT is that it provides standardized formality requirements for patent applications which are filed with a national or regional patent Office. Instead of defining these requirements again or differently in the PLT, it was decided to *incorporate by reference* the provisions of the PCT and its Regulations, wherever appropriate, into the PLT. The main reason for this is that the PCT already regulates in detail the formality requirements with respect to patent applications. As the PLT is directly linked to the PCT, it seems “strange” that the PCT does not better “comply” with the basic requirements of the PLT, *e.g.* with respect to the accordance of the international filing date.

The International Bureau of WIPO and the *Working Group on Reform of the PCT* have undertaken a substantial effort to promote alignment of the PCT with the letter and spirit of the PLT. However, in a number of situations the Working Group concluded that “bending” the PCT Rules to accommodate certain PLT provisions would (also) require amendment of the Articles of the PCT which is largely impossible. In other situations a certain amount of reluctance could be sensed on the part of the Working Group to deal with the matter. In reports of the meetings of the Working Group often sentences can be found suggesting that “any proposals to align other provisions under the PCT would not be presented to the Working Group until a future session, as this does not appear to be a high priority.” In later meetings of the Working Group the matter was never dealt with again.

In preparation for the *Diplomatic Conference for the Adoption of the Patent Law Treaty*, the International Bureau investigated how future changes to the PCT could be *incorporated by reference* into the PLT. This principle, which was not explicitly dealt with in the provisions of the Basic Proposal of the PLT, was *implicitly* assumed in order to make the interface between the PLT and the PCT viable over time. The International Bureau could not identify any identical or analogous provisions in other international treaties. Various options to deal with this problem were discussed at the Diplomatic Conference, resulting in the adoption of Article 16 and 17(2)(v) PLT. In addition, an “Agreed Statement” was formulated during the Conference, consolidating the relationship between the PLT and the PCT. The effect of Article 16(1) PLT is that any

revisions, amendments and modifications to the PCT will only apply for the purpose of the PLT under certain conditions.

With respect to issues relating to the filing of an international application only the issue of filing missing parts of the description or missing drawings was incorporated in the PCT [PCT Rule 20.5]. Other issues prescribed in the PLT, such as the requirements for according an international filing date to an international application and the filing of a description and/or drawings by a reference to another application were not implemented.

With respect to the filing date requirements, PCT Article 11(1) prescribes a number of requirements which are much more restrictive than what is prescribed in Article 5(1) PLT. The most notorious difference is the compulsory presence of "a part which on the face of it appears to be a claim or claims" [PCT Article 11(1)(iii)(e)]. A way to circumvent this in the PCT would be to regard claims as a "legal fiction". A proposal to this effect, prepared in great detail by the International Bureau, included the introduction of a suitably worded pre-printed statement to be included in the Request Form as well as the presence of "claim-like" wording in the description. Unfortunately, the proposal was not accepted.

With respect to "filing by reference", the PCT was not aligned to the PLT. There was an initial proposal which would provide for a reference to another document replacing the description, drawings and claims. Later on, the matter of "filing by reference" in the sense of the PLT was not pursued in the *Working Group on Reform of the PCT*. With today's tools of filing an application electronically, providing for filing by reference has lost its advantages.

With respect to the filing of missing parts of the description or missing drawings, the PCT has "stretched" the requirements of the PLT by allowing applicants to file also a missing claim or claims [PCT Rule 20.5 PCT]. This would seem logical, because claims are a filing date requirement under the PCT. However, the PCT also allows an applicant to file, under the same provision, *all* the claims or the *entire* description as a so-called "missing element" [PCT Rule 20.3 and 20.6]. There is no equivalent provision in the PLT. All these possibilities have been incorporated in PCT Rule 20 implementing the filing date requirements, thereby making it one of the more complicated Rules in the PCT. Allowing an applicant to late file the entire description or the entire set of claims should not have been implemented in the PCT.

As said before, it is strange that a number of fundamental provisions of the PLT have not been incorporated into the PCT. This is all the more peculiar, because in earlier years flexibility to the PCT system was added by amending the Regulations under the PCT, while mitigating the rigidity of certain PCT Articles. On a number of occasions this resulted in inconsistencies between the PCT Articles and its Regulations. In the same spirit, it would have been possible to realize a better alignment between the PCT and the PLT. In particular, mitigation of the compulsory presence of claims when filing an



international application in view of the requirements in the PLT is desirable and would have been possible. Users of the PCT system would welcome a better alignment of at least some filing date-related requirements and provisions dealing with defects which may affect the filing date.

### **3 Relief in respect of time limits**

Article 11 of the PLT governs the requirements for the extension of time limits and for “continued processing” of an application or a patent. In general, Article 11 PLT obliges a PLT Contracting Party to provide relief in respect of time limits. Such relief may be in the form of an extension of the time limit [Article 11(1) PLT] and/or continued processing [Article 11(2) PLT]. Relief in respect of the time limit is subject only to the filing of a request and, where applicable, to the payment of a fee. Accordingly, the applicant or owner concerned may not be required to state the grounds on which the request is based or to file evidence with the Office. In particular, a PLT Contracting Party is not permitted to make the grant of the relief under Article 11 PLT conditional on a finding of due care or unintentionality by the Office.

The relief a PLT Contracting Party is obliged to provide under Article 11(1) and (2) PLT is restricted to time limits “fixed by the Office for an action in a procedure before the Office”. It is for each PLT Contracting Party to decide which time limits are fixed by the Office. A typical example of a time limit fixed by Offices is the time limit for response to an examiner’s substantive examination report.

It is important to realize that Article 11(1) PLT does not *oblige* a PLT Contracting Party to provide for the extension of a time limit fixed by the Office. However, a PLT Contracting Party that does *not* provide for extension *after* expiration of the time limit [Article 11(1)(ii) PLT] is obliged to provide for continued processing under Article 11(2) PLT in respect of these time limits.

Article 12 PLT obliges a PLT Contracting Party to provide for the reinstatement of rights with respect to an application or patent following failure to comply with a time limit for an action in a procedure before the Office. In contrast to Article 11 PLT, where an applicant cannot be required to state the grounds on which the request is based, such reinstatement is subject to a finding by the Office that the failure occurred in spite of all due care required by the circumstances or, at the option of the PLT Contracting Party, was unintentional. In further contrast to Article 11 PLT, Article 12 PLT is not restricted to time limits fixed by the Office, although there are some exceptions.

#### **3.1 European Patent Convention**

In Chapter V of this thesis, the requirements in the European Patent Convention (EPC) for the extension of time limits and the remedy of further processing are discussed, whereas Chapter VI deals with the remedy of re- establishment of rights.

The European Patent Convention (EPC) distinguishes two types of periods: the so-called "Office periods" and "Convention periods", depending on whether the duration of the period is specified by the European Patent Office (EPO) or fixed in an Article or Rule of the EPC, respectively.

If "a period to be specified" by the EPO is missed in grant proceedings or in *ex parte* appeal proceedings, further processing may be requested. There is only one exception in the EPC: further processing is ruled out if the applicant does not respond in due time to an invitation to repair deficiencies in the priority claim [Rule 59 EPC, but see § 4.1]. Article 11 PLT only provides for relief in respect of time limits fixed by the Office. Hence, the EPO need not provide for further processing in relation to Convention periods in view of the PLT. Nevertheless, in many cases the EPO allows an applicant to file a request for further processing if a Convention period has not been observed although there is an extensive list of Convention periods for which further processing is ruled out.

In the EPC 2000 revision, the scope of application of "further processing" [Article 121 and Rule 135 EPC] was broadened in order to make it the standard legal remedy in cases of failure to observe periods in the procedure up to the grant of the European patent. Further processing is the main remedy under the EPC for non-observance of a period before the EPO. However, the availability of this remedy under the EPO is limited to grant proceedings and to appeal proceedings after refusal of the application. This is in line with the exceptions listed in Rule 12(5) PLT. However, the EPO does not allow further processing in limitation/revocation proceedings [Article 105a EPC].

In addition, the Article on re-establishment of rights [Article 122 EPC] was amended to take account of the broadening of the scope of application of further processing. The EPO will grant a request for re-establishment of rights, provided the prescribed conditions have been met [Article 122(2) and Rule 136 EPC]. In particular, the request for re-establishment must be filed within two months from the removal of the cause of non-compliance with the period, but at the latest within one year of expiry of the unobserved period. What is new in the EPC 2000 is that re-establishment in the priority period [Article 87(1) EPC] has become possible (see § 4.1).

Due to the requirement of proving "all due care" in Article 122(1) EPC, the remedy of re-establishment of rights is not as straightforward and reliable as further processing. In addition, a request for re-establishment does not have suspensive effect on the proceedings. Therefore, any person may, under certain conditions, start using the invention and continue such use without payment. Re-establishment of rights is ruled out for periods in respect of which further processing can be requested. As almost half of the periods in the EPC Implementing Regulations are excluded from further processing, the remedy of re-establishment of rights is, in principle, available in respect of all these periods. In addition, re-establishment of rights is available if the proprietor of a European patent in opposition or subsequent appeal proceedings fails to observe "a period to be

specified" by the EPO. Because further processing is only possible for applicants, re-establishment is, in principle, available in these periods.

Upon aligning the European Patent Convention with requirements of the Patent Law Treaty, the legislator chose for a relatively complete implementation into the EPC of the requirements in relation to relief in respect of time limits and reinstatement of rights as prescribed in the PLT. In addition, in many cases, the EPO allows relief beyond what is prescribed in the PLT. However, the EPC is not compliant with the PLT in some cases. Although the duration of a large number of periods has been fixed in the EPC Articles and Rules, and although the remedy of further processing is frequently ruled out in respect of these periods, the number of possible remedies available to parties before the EPO is significantly beyond what is prescribed in the PLT.

### **3.2 Patent Cooperation Treaty**

In Chapter VII of this thesis, the requirements in the Patent Cooperation Treaty (PCT) for relief in respect of time limits under the PLT and the remedy of reinstatement of rights in the PCT are discussed.

Due to the tight time schedule in the international phase, relief in respect of time limits under the PCT is rather limited. In addition, the duration of the time limits in the PCT Rules is often not specified but only indicated as "within a time limit which shall be reasonable under the circumstances". However, the term "reasonable under the circumstances" lacks definition in the PCT Rules; it also cannot be found in the *PCT Applicant's Guide* and the *PCT Administrative Instructions*. The preferred option would be to delete the notion "reasonable under the circumstances" from the PCT in its entirety and replace it by a time limit with a specified (minimum) duration. Where possible, the duration of the time limit should be set to be (at least) two months, thereby promoting alignment of the PCT with the provisions of the PLT.

If the term is maintained in the PCT, a definition including a minimum duration should be incorporated in the PCT Rules. Using undefined terms in legislation, in particular in patent law treaties, puts the applicant in an uncertain position. To make things worse, there are time limits in the PCT without a specified duration and where also the term "reasonable under the circumstances" is not included. The lack of the indication of any duration of time limits should be remedied.

In addition, the frequently-found formulation in the PCT Rules that the time limit "may be extended" by the receiving Office or other responsible Authority "at any time before a decision is taken" also leaves the applicant in an uncertain position: if the Office or Authority has already taken the decision, then there is no remedy in the international phase. So, if the applicant finds out that he has overrun a time limit, he must immediately make a phone call and ask whether the decision has already been taken. This type of discretionary extension should be deleted from the PCT Rules in its entirety. Preferably, it should be replaced by a formulation as can be found in PCT Rule 66.2(e):

“The time limit for replying to the notification may be extended if the applicant so requests before its expiration.” Such a formulation would be compliant with Article 11(1)(i) PLT.

It can be concluded that the existing provisions in the PCT Regulations with respect to the extension of time limits cause a great deal of uncertainty on the side of the applicants and give too much freedom to the receiving Offices and International Authorities who can more or less freely set and determine the duration of the time limits.

During the amendment round of the Regulations under the PCT in April 2007, when a number of PCT provisions was aligned with the provisions in the PLT, the duration of a number of time limits in the PCT was better defined and amended to become two months. In addition, the time limits in the newly introduced provisions were in most cases also set to be two months. As far as known, the PCT system did cope very well with these 2-month time limits. So, it seems that despite the fears with respect to the “tight time schedule” in the international phase, the PCT system is able to deal with situations where the applicants are given more certainty by allowing them more time. This opens a window of opportunity to better define and stretch the duration of other time limits in the international phase of the PCT and, in addition, to consider putting in place a system of allowing extension of a number of time limits. This would promote further alignment of the provisions of the PCT with those of the PLT.

There are no provisions under the PCT for *continued processing* if the applicant has failed to comply with a time limit fixed by the Office, as provided for under Article 11(2) PLT. The *Working Group on Reform of the PCT* considered that the inclusion into the PCT Regulations of general provisions providing for the extension of time limits was already regarded as problematic in view of a proper functioning of the PCT system. Adding an additional time limit for allowing the applicant to benefit from continued processing was regarded a bridge too far for the “tight time schedule” of the PCT. However, it would be welcomed by the applicants if at least in the case that the international application is considered withdrawn, a remedy such as continued processing were introduced into the PCT. Introducing of such a Rule with a limited scope and seeing how it works out in practice is conceivable.

The issue of introducing “reinstatement of rights” was discussed in the *Working Group on Reform of the PCT* in order to promote alignment of the PCT with the requirements in Article 12 PLT. As a result, PCT Rule 49.6 was introduced in relation to the reinstatement of rights after failure to comply with the requirements for national/regional phase entry within the prescribed time limits. The discussions were based on the recognition that Article 3(1)(b)(i) PLT expressly provides that the provisions of the PLT and the Regulations under the PLT are applicable, subject to the provisions of the PCT, to international applications in respect of the time limits applicable under PCT Articles 22 and 39 in the Office of the PLT Contracting Party. In other words, under the PLT, any national Office of a State which is both a PLT and a PCT Contracting Party and which acts

as a designated or elected Office under the PCT is obliged to apply the provisions of the PLT, in particular Article 12 PLT in relation to reinstatement of rights, to an international application which missed the applicable time limit for entry into the national phase before that Office. PCT Rule 49.6 was introduced into the PCT already on January 1, 2003. Upon adopting the Rule, the option was created for designated Offices to declare that their national law is not compatible with that provision. Unfortunately, the list of States having such reservation is still rather substantial. The WIPO should actively promote the reduction of the number of reservations.

The provision of PCT Rule 49.6 is the only instance where the PCT provides for reinstatement of rights. The *Working Group on Reform of the PCT*, as far as known, has never discussed introducing the remedy of reinstatement of rights for missing any other time limit in the PCT.

#### **4 Restoration of priority**

Article 13(2) PLT obliges a PLT Contracting State to provide for the restoration of the priority right in those cases where a subsequent application is filed after the expiration of the priority period, but within a time limit which may not be less than two months from the date on which the priority period expired. A reference to Article 15 PLT was included in Article 13(2) PLT to clarify that due account is taken of the provisions of the Paris Convention. The request for restoration of a priority claim may be filed after the filing of the subsequent application, provided that it accompanies the request for restoration.

In addition, Article 13(3) PLT obliges a PLT Contracting State to provide for the restoration in those cases where a right of priority is lost because of the failure, on the part of the Office with which the earlier application was filed to provide a copy of that application in time, to comply with the prescribed time limit, despite a timely request for that copy having been made. Since the time limit for filing the priority document is normally established by national legislation or under a regional treaty, but not by the Office, a remedy in this respect will normally not be available by way of extension of the time limit or continued processing under Article 11 PLT. The request for restoration of a priority claim may be filed after the filing of the subsequent application, provided that it accompanies the request for restoration.

##### **4.1 European Patent Convention**

In Chapter VI of this thesis, the requirements in the European Patent Convention (EPC) in relation to the remedy of re-establishment of rights in the priority period and for failure to file a certified copy of the priority application are discussed. In both cases the EPC employs the term "re-establishment of rights" instead of "restoration" as used in the PLT.

For re-establishment of the priority period under Article 87(1) EPC, the minimum time limit fixed by Rule 14(4) PLT has been incorporated: the period for filing such requests

ends two months after expiry of the priority period [Rule 136(1) EPC]. The normal period of one year for requesting re-establishment of rights does not apply here in view of the central importance of establishing the date of filing and/or priority for the valid claiming of priority.

The procedure for filing priority documents under the EPC is regulated via Rule 53(1) EPC. If the priority document is not provided within 16 months from the earliest period date claimed, the EPO will invite the applicant to provide it within "a period to be specified" [Rule 59 EPC]; the applicant may request extension of the period before expiry of the normal period. As further processing in the period of Rule 59 EPC is ruled out, re-establishment of rights is, in principle, possible in respect of the late filing of the priority application.

By providing a remedy for the loss of a priority right in relation to the delayed filing of the subsequent application as well as in relation to the failure to file a copy of the priority application in due time, the EPC has been aligned with the requirements of the PLT.

#### **4.2 Patent Cooperation Treaty**

In Chapter VII of this thesis, the remedy of restoration of the priority right in the PCT is discussed.

By adopting PCT Rule 26*bis*.3 relating to the restoration of the right to priority by the receiving Office, the PCT was aligned with the corresponding provision in Article 13(2) PLT. The request for restoration can be based on the fact that the failure to file the international application within the 12-month priority period occurred in spite of due care required by the circumstances having been taken or was unintentional, depending on which criterion is applied by the receiving Office. The time limit for filing a request for restoration of the right of priority before the receiving Office was set to be two months from the expiry of the priority period, which is in line with the provisions in the PLT. In the corresponding PCT Rule 49*ter*.2 in relation to a request for restoration of the right of priority before the designated Office, the applicant is given only one month to file the request; this time limit should be amended to become two months.

Following the adoption of PCT Rules for restoration of the right of priority, options were created for receiving and designated Offices to declare that their national law is not compatible with that provision. At present, the list of PCT Contracting States with such reservations is still rather substantial, thereby reducing the scope and applicability of the provision of restoration of the right to priority under the PCT. The WIPO should actively promote the reduction of the number of reservations.

There is no provision under the PCT for the restoration of the right of priority in those cases where a copy of the earlier application has not been filed within the prescribed time limit. The intention of Article 13(3) PLT is to provide a safeguard in the situation where the applicant cannot submit a copy of an earlier application within 16 months from

the priority date, because of a delay in the Office with which the earlier application was filed. The *Working Group on Reform of the PCT* has, as far as known, never discussed the topic. A reason for this may have been that the PCT system already provides enough flexibility to file the required certified copy of the priority document. In addition, the advance in technology away from requesting paper copies and switching to the electronic exchange of priority documents between Offices, Authorities and the International Bureau appears to have diminished the need for introducing a remedy in the sense of Article 13(3) PLT. To this end, already on January 1, 2004 a new paragraph (*b-bis*) was added to PCT Rule 17.1 relating to the possibility that priority documents may be available to the receiving Office or to the International Bureau from digital libraries. The latter provision is in line with the PLT.

## **5 Conclusions**

When the Patent Law Treaty was negotiated in the nineties of the previous century, the emphasis was on making the filing of a patent application as simple and user-friendly as possible. Inventors and small business enterprises were afforded easy access to filing a patent application. The requirements for the accordance of a filing date were reduced to an absolute minimum, rendering it practically impossible to miss this date. As a consequence, procedures had to be put in place at the Offices allowing the applicant to meet additional requirements (such as furnishing a set of claims) at a later stage. All this laid a heavy administrative burden on the Offices which have to deal with such applications.

In the present time, the focus of the national Offices and intergovernmental organizations dealing with national and regional patent applications, is moving away from the needs of the applicants to issues such as how to deal with huge numbers of patent applications in a more efficient manner. Therefore, the procedural requirements of the Patent Law Treaty are regarded as counterproductive to achieving that objective. Perhaps, this is also one of the reasons why accession to the Patent Law Treaty of countries and intergovernmental organizations, such as the European Patent Organization, takes place at a slow pace.

In view of the above, the final conclusions of this study on the alignment of the European Patent Convention and the Patent Cooperation Treaty with requirements of the Patent Law Treaty can be summarized as follows:

- (i) The Patent Law Treaty did not achieve the goal of streamlining and harmonizing formal requirements set by national or regional Patent Offices for the filing of national or regional patent applications and the maintenance of patents.
- (ii) The Patent Law Treaty contains too many optional requirements which may be implemented as compulsory ("may require") by PLT Contracting Parties allowing them too much freedom when implementing requirements of the Patent Law Treaty in their national and regional patent laws.

- (iii) The World Intellectual Property Organization could play a more active role in issuing instructions and guidelines on how to implement the Patent Law Treaty in national and regional patent laws. A preferred manner of implementing the Patent Law Treaty could be advocated.
- (iv) The alignment of the European Patent Convention with requirements of the Patent Law Treaty was done in an exemplary manner. In line with their original intention, the European Patent Organization should accede to the Patent Law Treaty.
- (v) In view of the “intimate” relationship between the Patent Law Treaty and the Patent Cooperation Treaty, the latter Treaty could and should have been better aligned with the requirements of the Patent Law Treaty. Too many crucial provisions of the Patent Law Treaty have not been adopted by the Patent Cooperation Treaty.
- (vi) The large differences in the degree of alignment of the European Patent Convention with requirements of the Patent Law Treaty as compared to the Patent Cooperation Treaty, obliges the European Patent Office to respond in a substantially different manner depending on whether an applicant files a European patent application or an international application. This counteracts the aim of streamlining the Patent Law Treaty.
- (vii) The provision in the Patent Law Treaty allowing an applicant to file a missing part of the description or a missing drawing based on content which is “completely contained” in an earlier application from which priority is claimed, while maintaining the originally accorded filing date, is a powerful tool because it permits an applicant to complete his application without losing his priority claim.
- (viii) The option of “filing an application by reference to a previously filed application” as prescribed in the Patent Law Treaty has become outdated by advances in transmission technology and should be abolished.
- (ix) The obligation of a PLT Contracting State to provide for relief in respect of time limits either by means of providing an extension of the time limit or by providing continued processing is one of the major achievements of the PLT.
- (x) The obligation of a PLT Contracting State to provide for restoration of priority rights is a powerful instrument to rectify mistakes in relation to priority claims, allowing applicants to counteract the unintentional loss of such rights.