

Patent Law Treaty: Promises Not Delivered—How the Negotiations Resulted in Ambiguities in the Treaty

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The Patent Law Treaty 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. In this Article, a number of core issues of the Patent Law Treaty has been selected: requirements for the accordance of a filing date, relief in respect of time limits and restoration of priority. A conclusion of this Article is that the goals of the Patent Law Treaty were not achieved by the Treaty as concluded. One of the reasons is that the Treaty contains too many optional requirements (“may require”), which may be implemented as compulsory by the Contracting Parties, allowing them too much freedom when implementing requirements of the Treaty into their national and regional patent laws. This defies the aim of harmonization and streamlining of the Patent Law Treaty. The negotiation history is described and discussed with emphasis on what went wrong during the negotiations. Reasons for the failure of the Patent Law Treaty are discussed and recommendations for repair are given.

Keywords patent law treaty; negotiations; effect of PLT; filing date requirements; relief in respect of time limits; continued processing; reinstatement of rights; restoration of priority right

Introduction to Patent Law Treaty

The Patent Law Treaty (PLT) was concluded during a Diplomatic Conference held at the World Intellectual Property Organization (WIPO) in Geneva (Switzerland) from May 11 to June 2, 2000.¹ The PLT is open to States member of WIPO and/or States party to the *Paris Convention for the Protection of Industrial Property*;² it is also open to certain intergovernmental organizations, such as the European Patent Organization.³ Instruments of ratification or accession must be deposited with the Director General of WIPO. The PLT entered into force on April 28, 2005.

The PLT emanated from discussions on the reform of substantive patent law that began in 1984. Those discussions continued until June 1991, during which a first part of a Diplomatic Conference to conclude a “Treaty Supplementing the Paris Convention as far as Patents are Concerned.”⁴ The second part of the Diplomatic Conference was scheduled for July 1993, but did never take place. In January 1994, the United States discontinued substantive patent law harmonization discussions due to a lack of domestic support for the effort.⁵ The international community was disappointed by the ensuing “loss of momentum” on the subject of substantive patent law harmonization as a result of the position of the United States.

In 1995, it was agreed that another approach for promoting harmonization, covering matters concerning the formality requirements of national and regional patent procedures, would be initiated by WIPO.⁶ Five sessions of the *Committee of Experts on the Patent Law Treaty*,⁷ and three sessions of its successor, the *Standing Committee on the Law of Patents* (SCP),⁸ were held to develop the “Basic Proposal” to be presented to the *Diplomatic Conference for the Adoption of the Patent Law Treaty*, which was held from May 11 to June 2, 2000.^{9,10}

The Final Act of the PLT witnessing the Diplomatic Conference and its outcome, was signed by 104 countries and 3 Intergovernmental Organizations. At present 66 countries signed the PLT. In 2005 the PLT was in force in 11 countries; currently (October 2014) there are 36 Contracting Parties.¹¹

The PLT includes 27 articles and 21 rules. In addition, six “Agreed Statements” were adopted at the end of the Conference.¹²

Aim and Purpose of the PLT

Since the adoption of the PLT, the involvement of the WIPO has diminished as there are no centralized functions. The International Bureau of WIPO merely acts as a depository of the PLT and is not in a position to give an official interpretation of the Treaty; such interpretation being in the exclusive competence of the PLT Contracting Parties.

The PLT aims at harmonizing and streamlining formal procedures relating to national and regional patent applications and maintenance of patents. In spite of the goal of harmonization, the PLT does not establish a uniform procedure for all PLT Contracting Parties by leaving many requirements optional, thereby allowing divergence in implementation between PLT Contracting Parties.¹³

The PLT sets forth, with one exception, maximum formal/procedural requirements that Contracting Parties may impose on patent applicants and patentees. Otherwise, PLT Contracting Parties are free to provide requirements that, from the viewpoint of applicants and owners, are more favorable than PLT requirements.¹⁴ The one exception to this freedom are the filing date requirements, which are both a maximum and a minimum, i.e., a so-called “filing-date standard.”¹⁵

The aim of the PLT is to simplify the formal obligations and to reduce the associated costs for patent applicants and owners of patents in obtaining and preserving their rights in inventions in many countries of the world. The PLT complements the existing international obligations and fosters the policy of strong intellectual property protection. The PLT simplifies the filing of an application and obtaining and maintaining of patents throughout the world and, to a large extent, promotes the merging of national and international formal requirements associated with patent applications and patents.

In a birds’ eye view, the principle features of the PLT offer the following advantages:

- The PLT simplifies and minimizes application requirements for obtaining a filing date;
- The PLT imposes a maximum on the formal requirements that a PLT Contracting Party may impose;
- The PLT eases representation requirements for formal matters;
- The PLT provides a basis for means of communications, including the electronic filing of applications;
- The PLT provides relief in respect of time limits that may be imposed by the Office of a PLT Contracting Party and re-instatement of rights where an applicant or owner has unintentionally failed to comply with a time limit and that failure has the direct consequence of causing a loss of rights; and
- The PLT provides for correction or addition of priority claims and restoration of priority rights.

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 (see Mulder (2011a) for a discussion of the issue of “Incorporation by reference of PCT provisions into the PLT”). The main reason for this is that the PCT already regulates in detail the formality requirements with respect to patent applications.¹⁶

From the viewpoint of inventors, applicants and patent attorneys, standardization and simplification of the formality requirements lead to a reduced risk of formality errors resulting in a less frequent loss of rights. On the other hand, Offices may operate more efficiently because of the simplification of procedures and the streamlining of the process. Eventually, this will result in cost reductions on both sides.

After the failure in 1994 of the earlier “Treaty Supplementing the Paris Convention as far as Patents are Concerned,” there was an eagerness to conclude a new Treaty which was limited to cover matters concerning the formality requirements of national and regional patent procedures. This pushing ahead has resulted in the introduction of weaknesses into the PLT. In particular, the achievement of the goal of the

PLT to “streamline and harmonize” formal requirements was often disregarded if a negotiating party insisted to have certain measures implemented into the PLT, which reflected peculiarities of its national law. This has resulted in a Treaty which allows too much freedom when a Contracting Party implements the basic requirements of the PLT into its national or regional patent law.

Basic Features of the PLT

In a number of documents, the main features of the PLT are described.^{17,18,19} In the following paragraphs a condensed overview of these principle features is presented.

Filing Date Requirements

The accordance of a date of filing is essential to deciding who has priority for the grant of a patent in each country and to determining prior art and the patentability of the invention. It is also relevant to claiming a right of priority under the Paris Convention as well as to the calculation of the term of patent protection.

Article 5 PLT sets a maximum and minimum set of requirements for obtaining a filing date and procedures to avoid loss of the filing date because of a failure to comply with other formality requirements. In principle, the Office of any PLT Contracting Party is obliged to accord a filing date to an application on the basis of only three elements. These requirements are (Article 5(1)(a) PLT):

- (i) an indication that what is filed is intended to be a patent application;
- (ii) indications identifying the applicant or allowing the applicant to be contacted; and
- (iii) a part which on the face of it appears to be a description.

No additional element can be required for a filing date to be accorded. In particular, a PLT Contracting Party cannot require the presence of one or more claims as a filing date requirement. In addition, an applicant can file the description in any language (Article 5(2)(b) PLT), or replace the description and/or drawings by a reference to a previously filed application (Article 5(7) PLT). A PLT Contracting Party may, for the purposes of the filing date, accept a drawing as the element referred to Article 5(1)(a)(iii) PLT (Article 5(1)(b) PLT).

The PLT also provides rules to establish a filing date where a part of the description or drawing is missing from the initially filed application. Normally, the filing of a missing part results in the accordance of a later filing date, i.e., the filing date becomes the date on which the missing part or missing drawing is filed (Article 5(6)(a) PLT). 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 (Article 5(6)(b) PLT).

Standardized Application and Forms

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 (Article 6(1) PLT). In addition, the PLT provides for the establishment of several *Model International Forms* that have to be accepted by all Offices of PLT Contracting Parties (Article 6(2) and 8(3) PLT).

Simplified Procedures Before the Office

“Simplification” is one of the keywords for the PLT. The PLT simplifies a number of procedures before the Office of PLT Contracting Parties during the processing of a patent application, as well as for the maintenance of a patent.

The PLT allows an Office of a PLT Contracting Party to require an applicant or owner to appoint a representative for the purposes of any procedure before the Office, except for certain procedures (Article 7 (2) PLT). In addition, an Office may only require the applicant to file evidence in support of the formal contents of an application, declarations of priority or the authentication of translations when the Office has a reasonable doubt as to the truthfulness of the indications or the accuracy of the translation submitted by the applicant (Article 6(6) PLT). As regards signature, a PLT Contracting Party may require evidence only where the Office has a reasonable doubt as to its authenticity (Article 8(4)(c) PLT).

A PLT Contracting Party may not require the applicant to file a copy or a certified copy of the earlier application or the previously filed application if such earlier application or previously filed application has been filed with the Office of that Contracting Party (Rule 4(3) PLT). The same applies to cases where the Office could obtain the copy or the certification from other Offices through a digital library, which is accepted by that Office for that purpose (Rule 4(3) PLT). In addition, an Office may require a translation of the earlier application only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable (Rule 4(4) PLT).

Avoiding Loss of Rights

Apart from the filing date requirements, one of the principal features of the PLT is that it prescribes procedures for the avoidance of unintentional loss of rights as a result of failure to comply with formality requirements. It can be regarded as a breakthrough of the PLT that for all these measures of relief, time limits with a duration of at least two months are specified.

Relief in Respect of Time Limits

In principle, the PLT provides three types of relief procedures. The first is an extension of the time limit (for at least 2 months) where an applicant or owner requests the extension *prior* to the expiration of the time limit (Article 11(1)(i) PLT). The second is an extension of the time limit (again for at least 2 months) where an applicant or owner requests the extension *after* the expiration of the unobserved time limit (Article 11(1)(ii) PLT). The third remedy is the provision of continued processing (Article 11(2) PLT).

A PLT Contracting Party is not obliged to provide the first type of extension (extension *prior* to the expiration of the time limit). However, it is obliged to provide either the second type of extension (extension *after* the expiration of the time limit) or continued processing. Relief under these provisions is limited to non-compliance with a time limit fixed by the Office for an action in a procedure before the Office; it does not apply to time limits the duration of which is fixed in the law.

Reinstatement of Rights

Another safeguard provision established by the PLT is the provision of reinstatement of rights if an applicant or owner fails to meet a time limit and, as a consequence, loses his rights with respect to an application or patent unintentionally or in spite of all due care required by the circumstances (Article 12 PLT). The time limit to request reinstatement of rights shall not be less than 2 months from the date on which the reason of the non-compliance with the time limit is removed, or not less than 12 months from the expiration of the missed time limit, whichever is shorter (Article 13(2) PLT). In contrast to the relief in respect of time limits, reinstatement of rights is applicable to all time limits, including time limits of which the duration is fixed in the law.

Correction and Addition of a Priority Claim

The PLT provides for the possibility of addition and correction of priority claims for national/regional applications (Article 13 PLT). This provision was copied into the PLT from the already existing provision in PCT Rule 26*bis*.1.²⁰

Restoration of the Priority Right

Another safeguard provision established by the PLT is the provision of restoration of the priority right. There are two cases to be considered. In the first case, restoration of the priority right must be provided where an application is filed after the expiration of the 12-month priority period if the failure to claim priority within the Paris Convention period occurred in spite of all due care taken by the applicant or was unintentional (Article 13(2) PLT). The request for restoration including the filing of the application must be made within a time limit of at least 2 months from the date on which the priority period expired.

In the second case, restoration of the priority right must be provided where an 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 (Article 13(3) PLT).

Paper and Electronic Communications

One of the goals of the PLT is to facilitate the implementation of electronic filing of applications and other communications while, at the same time, not excluding any users from the benefits of the patent system, if they are not ready to apply electronic filing.

In principle, a PLT Contracting Party may, if it so wishes, exclude paper filing (i.e. the implementation of full electronic filing) with certain exceptions (Rule 8 PLT). These exceptions are the obligation on all Offices to accord a filing date for a paper application (Article 5(1) PLT), and to accept the filing of communications on paper for the purpose of meeting a time limit (Article 8(1)(d) PLT).

Methodology

The research methodology used in this Article mainly consists of an analysis of the documents in relation to the negotiation history of the PLT. In particular, the reports and preparatory documents of the sessions of the *Committee of Experts on the Patent Law Treaty* in the period from December 1995 to December 1997, and the sessions of the SCP in the period from June 1998 to September 1999 have been studied.^{21,22} In addition, the *Summary Minutes of the Main Committees* during the *Diplomatic Conference for the Adoption of the Patent Law Treaty* held in Geneva in the period May-June 2000 have been studied.²³ Where necessary, the documents in relation to the 1991 Diplomatic Conference for the adoption of the “Treaty Supplementing the Paris Convention as far as Patents are Concerned” in The Hague were taken into account.²⁴

The majority of the *Travaux Préparatoires* of the PLT is not directly available to the public. Some of the later preparatory documents are accessible and downloadable from web pages of the WIPO. However, the earlier versions of the “Draft PLT Articles and Draft Regulations” including the corresponding “Notes,” “Reports” and other related documents can be accessed by requesting the WIPO to make them available.²⁵

Information has also been gathered by speaking with representatives of the *Patent Law Section* and the *Patent Cooperation Treaty Legal Division* of the WIPO and with representatives of the *Directorate-General Legal and International Affairs* of the European Patent Office. These conversations have been conducted off the record following the request of the persons involved not to be quoted in an explicit manner.

Negotiation History of the PLT

Five sessions of the *Committee of Experts on the Patent Law Treaty* in the period from December 1995 to December 1997,²⁶ and three sessions of the SCP in the period from June 1998 to September 1999,²⁷ were held in Geneva to come to the “Basic Proposal” of the PLT and its Regulations which was presented to the

Diplomatic Conference for the Adoption of the Patent Law Treaty in Geneva from May 11 to June 2, 2000.^{28,29}

As indicated above, the original negotiations to come to a “Patent Law Treaty” (officially addressed as the “Treaty Supplementing the Paris Convention as far as Patents are Concerned”;³⁰ also addressed as the “Patent Harmonization Treaty”) that would harmonize formal as well as substantive patent law stranded in January 1994 when the United States declared that it was unable to continue the discussions because of a lack of domestic support.³¹

In 1995, the WIPO initiated another approach for promoting harmonization whereby only matters concerning the *formality requirements* of national and regional patent procedures would be covered.^{32,33,34} Convened by the Director General following decisions made by the *General Assembly of WIPO* and the *Assembly of the Paris Union* in their meetings of September/October 1995,^{35,36} the *Committee of Experts on the Patent Law Treaty* held its first session in Geneva in December 1995. The meetings of the Committee were attended by representatives of States members of WIPO and/or the Paris Union. Representatives of the European Communities, the European Patent Office, the Organization of African Unity and the World Trade Organization as well as representatives of numerous non-governmental organizations took part in the sessions in an observer capacity.

During the meetings of the *Committee of Experts on the Patent Law Treaty* the delegation of the United States repeated time after time “that it was still not in a position to discuss substantive patent law harmonization.”³⁷ In addition, the delegation continuously expressed its concern about any requirement present in or introduced into the Draft PLT that could be regarded as a substantive requirement. By way of example, in the Draft PLT as presented at the second session of *Committee of Experts on the Patent Law Treaty*, there was a new Article on unity of invention (Article 6 and corresponding implementing Rule 6) which was regarded as “not appropriate for inclusion in this Treaty directed to formalities” as observed by the delegation of the United States.³⁸ In the Draft PLT as presented at the fourth session of the *Committee of Experts on the Patent Law Treaty* the Article on “unity of invention” was deleted.

In March 1998, the Assemblies of the Member States of WIPO and the Unions administered by the WIPO approved a proposal for the establishment of “Standing Committees.”^{39,40} The SCP became the successor of the *Committee of Experts on the Patent Law Treaty*. Because considerable progress had already been made, three sessions of the SCP (in June 1998, April 1999 and September 1999) were sufficient to convene a Diplomatic Conference in Geneva to conclude the PLT and the Regulations under the PLT (May 11 to June 2, 2000).

In this Article, aspects of the negotiation history will be described with respect to three core issues of the PLT (parts of this Article were incorporated in Mulder, 2011b). These are:

- (1) Requirements for the accordance of a filing date (Article 5 PLT). The focus will be on the following three issues:
 - The basic requirements for according a filing date (Article 5(1) PLT);
 - The filing date where a missing part of the description or a missing drawing is filed (Article 5(6) PLT);
 - The filing of an application by reference to a previously filed application (Article 5(7) PLT).
- (2) Relief in respect of time limits including continued processing (Article 11 PLT) and reinstatement of rights after a finding of due care or unintentionality by the Office (Article 12 PLT).
- (3) Restoration of the priority right (Article 13(2) and (3) PLT).

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 added provisions were modeled after texts in the Basic Proposal submitted to the 1991 Diplomatic Conference in The Hague.⁴¹

Filing Date Requirements

Committee of Experts on the Patent Law Treaty

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the first session of the *Committee of Experts on the Patent Law Treaty* there was no article on requirements for accordance of a filing date.⁴² This was also noted in the corresponding “Notes” prepared by the International Bureau.⁴³ In the “Report” adopted by the Committee of Experts, many delegations favored, amongst other things, the inclusion in the PLT of provisions relating to requirements for the accordance of a filing date.⁴⁴

As a consequence a first draft of an Article 3 PLT “Filing Date” was presented before the Committee on its second session.⁴⁵ The text was modeled after Article 8 of the Basic Proposal submitted to the 1991 Diplomatic Conference in relation to the “Patent Harmonization Treaty.”⁴⁶ The filing date requirements contained 4 items:

Article 3(1) (Requirements)

(a) *The filing date of the application shall be the date of receipt by the Office of a communication containing the following elements:*

- (i) *an express or implicit indication to the effect that the communication is an application for a patent;*
- (ii) *indications allowing the identity of the applicant to be established;*
- (iii) *a description;*
- (iv) *if the description is not in the language or in one of the languages of or admitted by the Office, an indication to the effect that the application contains a description.*

In the corresponding “Notes” prepared by the International Bureau, it was remarked that Article 3 sets an international standard for the granting of a filing date. In that respect, Article 3 is different from other provisions of the Treaty, which establish a maximum list of allowed requirements.⁴⁷ In the “Report” adopted by the Committee of Experts, many delegations noted with satisfaction that a provision on the filing date had been included.⁴⁸ Several delegations proposed that the payment of a filing fee should be a requirement for a filing date to be accorded; this proposal was rejected by a majority of delegations.⁴⁹ Several delegations also suggested that the inclusion of claims should be a requirement for a filing date to be accorded. This suggestion was opposed by a majority of delegations, which were of the view that, although claims were necessary before a patent could be granted, it was not necessary to furnish them at the date of filing.⁵⁰

In the third session of the *Committee of Experts on the Patent Law Treaty*, Article 3 PLT on “Filing Date” was renumbered to become Article 2 PLT.⁵¹ In addition, a new paragraph (4) was added to the Article allowing an applicant to replace the description and drawings by reference to another application from which priority is claimed; in addition, a certified copy of the earlier application must be furnished to the Office within a prescribed time limit. This provision was modeled after Article 8(4) of the Basic Proposal submitted to the 1991 Diplomatic Conference in relation to the “Patent Harmonization Treaty.”⁵²

In the subsequent “Report” adopted by the Committee of Experts, it was agreed that the paragraph on “filing by reference” would be maintained.⁵³ Several delegations suggested that the applicant should be required to furnish details concerning the date and country of filing of the previously filed application or even that the title of that application should be indicated.⁵⁴ It was also suggested that the provision should not be restricted to those applications in respect of which priority is claimed.⁵⁵ The delegation of the United States of America suggested that the paragraph should provide for the electronic exchange of documents between Offices in place of submitting certified copies.⁵⁶ The International Bureau explained

that if the required certified copy of the previously filed application were not filed, the application containing a reference to that previously filed application would be considered as not having been filed.⁵⁷ Eventually, many suggestions were honored in the later versions of the PLT. In addition, the regulatory requirements relating to “filing by reference to a previously filed application” were moved to the Regulations under the PLT and, due to lack of agreement between the delegations, contain a puzzling mix of compulsory requirements (“shall”) and optional requirements which may be implemented as compulsory (“may require”) by a PLT Contracting Party (see Rule 2(5) PLT: Requirements under Article 5(7)(a) PLT). The pile of optional requirements which may be implemented as compulsory by a PLT Contracting Party, allows too much freedom when implementing requirements of the PLT into its national and regional patent laws and is contrary to the aim of harmonization and streamlining as advocated by the PLT.

In the meantime, the WIPO General Assembly and the Assembly of the Paris Union⁵⁸ considering a Memorandum by the Director General in respect of *Matters Concerning the Patent Law Treaty*, decided, amongst others, to include filing date provisions in the draft PLT.⁵⁹

In the fourth session of the *Committee of Experts on the Patent Law Treaty*, Article 2 PLT on “Filing Date” was renumbered to become Article 4 PLT.⁶⁰ The formulation “a description” in item (iii) of Article 4(1)(a) PLT of the requirements for accordance of a filing date was broadened to read: “a part which on the face of it appears to be a description,” this formulation is identical to the one in PCT Article 11(1)(iii)(d). In addition, in item ii of Article 4(1)(a) PLT, apart from “indications allowing the identity of the applicant ... to be established,” a formulation was added “or allowing the applicant ... to be contacted by the Office.” For example, where the application indicates the address without any name and there is only one resident at that address, the requirement of Article 4(1)(a)(ii) PLT would be regarded as having been complied with.

In the Draft PLT, a new item (b) was added to Article 4(3) PLT (*subsequent compliance with requirements*) in relation to the late filing of drawings. If the applicant files missing drawings later on, the filing date would become the date on which the Office has received those drawings. Where these “later furnished drawings do not contain new matter” the original filing date may be retained. In the “Report,” the International Bureau commented that the standard applied by a PLT Contracting Party in determining whether later furnished drawings contained “new matter” was a matter of substance.⁶¹

In the fifth session of the *Committee of Experts on the Patent Law Treaty* there were no substantial changes in Article 4 PLT on “Filing Date”.⁶² A new item (c) was added to Article 4(3) PLT in relation to missing drawings and missing parts of the description, a provision according to which, where priority is claimed in the application, the contents of the priority document has to be taken into account in establishing whether correction by way of furnishing a missing part of the description or missing drawing should be allowed without loss of the initial filing date.⁶³

Standing Committee on the Law of Patents

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the first session of the *Standing Committee on the Law of Patents*, Article 4(1)(a) PLT was restricted to three items:⁶⁴

Article 4(1) (Elements of Application)

(a) *Subject to paragraphs (2) to (5), a Contracting Party shall provide that the filing date of an application shall be the date on which its Office has received all of the following elements, filed by 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;

The above formulations of the filing date requirements are already relatively close to the texts adopted during the Diplomatic Conference.

In the “Draft PLT and Draft Regulations” presented at the first session of the *Standing Committee on the Law of Patents*, the provision permitting an applicant to replace the description and any drawings in an application by reference to a previously filed application in respect of the same invention was no longer restricted to references to applications from which priority is claimed, but broadened to also cover references to any previously filed application by the same applicant or his predecessor in title (Article 4(7) PLT).⁶⁵

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the second session of the *Standing Committee on the Law of Patents*, there were no substantial changes in Article 4 PLT on “Filing Date”.⁶⁶ Following a proposal by the delegation of Australia with respect to the paragraph in Article 4 PLT in relation to the filing of missing parts of the description and missing drawings, and suggestions by the International Bureau based on this proposal, the formulation “the missing part of the description and the missing drawing ... do not contain *new matter*” in paragraph (5) of Article 4 PLT, was replaced by “the missing part of the description or missing drawing be *completely contained* in the earlier application”; this formulation was incorporated in a new paragraph of the Rule regulating the details concerning the filing date requirements under Article 4 PLT.^{67,68}

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the third session of the *Standing Committee on the Law of Patents*, Article 4 PLT on “Filing Date” and implementing Rule 2 PLT were “framed” indicating that the Article and Rule had been adopted by the Standing Committee.⁶⁹ Two amendments are worth mentioning. The first one is that a new item was added to the requirements of Rule 2(4) PLT in relation to the situation where the applicant files missing parts of the description or missing drawings based on an earlier application from which priority is claimed (Article 4(6) (b) PLT), i.e. that “the application, at the time of filing, contained an indication that the contents of the earlier application were *incorporated by reference* in the application”.⁷⁰ The second one is that in Article 4(6)(b) PLT relating to the situation where the applicant files missing parts of the description or missing drawings based on an earlier application from which priority is claimed, the words “at the time of filing” were replaced by the words “at the date on which one or more elements referred to in Article 4(1)(a) were first received by the Office”.⁷¹ It is noted that all requirements in Rule 2(4) PLT are of the kind “may require”: this allows a PLT Contracting Party to select its own mix of compulsory requirements when implementing the filing of missing parts of the description or missing drawings based on an earlier application. This freedom of choice is contrary to the aim of the PLT to streamline and harmonize formal requirements.

Diplomatic Conference for the Adoption of the PLT

In the Draft Proposal submitted to the *Diplomatic Conference for the Adoption of the Patent Law Treaty* submitted by the Director General of WIPO, Article 4 PLT on “Filing Date” was renumbered to become Article 5 PLT.⁷²

Issues relevant for the Draft PLT were discussed at a session of the *PCT Assembly* held in March 2000; these issues were summarized in a document submitted for consideration to the PLT Diplomatic Conference.⁷³ In relation to the filing date requirements, it was suggested that a discussion should take place at the Diplomatic Conference on the question of amending draft Article 5(1) PLT, perhaps in a general way or subject to future amendments of the Regulations, in order to allow applicants to obtain a filing date using future technologies.⁷⁴

During the meetings at the *Diplomatic Conference for the Adoption of the Patent Law Treaty*, the filing date requirements were extensively discussed.^{75,76} Of course, the issue of adding a fourth item: “(iv) a part which on the face appears to a claim or claims” was brought up and rejected (again).⁷⁷

It was observed by a representative of the WIPO, that PCT Article 11(1) was also relevant as the PCT was the starting point for the provision on the filing date in Article 5(1) PLT.⁷⁸ The drafting of the PLT had closely followed the PCT, although, in some cases, it had been deemed that the PLT should be more user-friendly. In PCT Article 11(1), there are seven requirements for according a filing date under the PCT. Two of those requirements would not apply to national filings, because they dealt with residency requirements and the designation of a PLT Contracting State. Of the remaining five, three corresponded to items in the PLT. There were two remaining items in the filing date requirements for the PCT where the PLT was more liberal, namely the inclusion of claims and the language requirements.⁷⁹ A Representative of the European Patent Organization said that Article 5(1) PLT was perhaps the most important provision in the draft PLT, as it established a uniform worldwide standard; any possible deviation from this standard, including the possibility for national Offices to require a fee, should be avoided.⁸⁰ Eventually, the three items of Article 5(1)(a) PLT for establishing a filing date were maintained as proposed.

In addition, the language requirements in Article 5(2) PLT were adopted in relation to the languages in which the three items of Article 5(1)(a) PLT can be filed.⁸¹ It was observed by a representative of the WIPO that the possibility of filing the description of an application in any language was one of the key issues of the draft PLT.⁸²

With respect to Article 5(5) PLT relating to the notification concerning a missing part of the description or a missing drawing, a representative of the WIPO emphasized that an Office would not be required to make any special check for missing descriptions or drawings; also, Article 5(5) PLT did not apply where the Office discovered the omission in a different procedure, for example in the course of substantive examination.⁸³ With regard to Article 5(6) PLT relating to the situation where the missing part of the description or the missing drawing was filed subsequently, the representative of the WIPO pointed out that the filing date would, under Article 5(6)(a) PLT, be the date on which the missing part of the description or missing drawing was received by the Office, whereas Article 5(6)(b) and (c) PLT addressed two situations in which the earlier date of receipt of the incomplete application could be preserved as the filing date.⁸⁴ Article 5(5) and (6) PLT were meant to give an applicant the opportunity to file missing parts as quickly as possible in order to minimize the loss of filing date.⁸⁵

With respect to Article 5(7) PLT allowing an applicant to replace the description or the drawings by a reference to an earlier application, a representative of the WIPO emphasized that it is a very user-friendly provision.⁸⁶ The representative of the *Institute of Professional Representatives before the European Patent Office (epi)* said that filing by reference would particularly be beneficial for small applicants who had to file in the last minute before the expiration of the priority period, and who were not interested in applying in a great number of countries, and therefore did not want to incur the cost of a PCT application.⁸⁷

Conclusion

From the above overview of the negotiations, it can be concluded that Article 5 PLT is a breakthrough in that it simplifies and minimizes application requirements for obtaining a filing date. However, even the text of article comprises at least two formulations specifying optional requirements, which may be implemented as compulsory (“may require”) by a PLT Contracting Party. Furthermore, Rule 2 PLT implementing Article 5 PLT includes a complicated mix of “shall” and “may require” requirements. The majority of the latter requirements results from specific wishes of negotiating parties to insert a certain optional requirement into the draft Treaty. The inclusion of “may require” formulations should have been avoided or at least minimized because it introduces too much freedom for PLT Contracting Parties when

implementing requirements of the PLT into their national and regional patent laws. This abundance of “may require” formulations is contrary to the aim of harmonization and streamlining of the PLT.

Relief in Respect of Time Limits

Committee of Experts on the Patent Law Treaty

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the first session of the *Committee of Experts on the Patent Law Treaty*, there was no article on relief in respect of time limits.⁸⁸ In the “Report” adopted by the Committee of Experts, a number of delegations favored, amongst other things, the inclusion in the PLT of provisions relating to the extension of specific time limits.⁸⁹

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the third session of the *Committee of Experts on the Patent Law Treaty*, there was a new Article 12 PLT “Extension of a time limit”.⁹⁰ Article 12 PLT sets a minimum of rights a Contracting Party shall extend to an applicant or owner in respect of a request for an extension of a time limit. It is to be noted that this Article deals with the time limit for an action before the Office, and not the time limit before a court.⁹¹ Article 12(1) PLT addresses the situation in which an applicant or owner requests the extension of a time limit *before* that time limit has expired. However, in accordance with subparagraph (c), the term does not include the submission of a priority claim for which a new Article 13 PLT (belated claiming of priority) was introduced. An Office would not be permitted to impose any payment of a fee for the *first* extension of the time limit.⁹² Article 12(2) PLT addresses the situation in which an applicant or owner requests the extension of a time limit *after* that time limit has expired. Subparagraph (b) is intended to prevent that an applicant or owner loses rights attached to his application or other communication because of a failure to meet a time limit if he has taken all due care required by the circumstances to comply with the time limit.⁹³

In the meantime, the WIPO General Assembly and the Assembly of the Paris Union (meeting in September/October 1996) considering a Memorandum by the Director General in respect of *Matters Concerning the Patent Law Treaty*, decided, amongst others, to include provisions relating to restoration of rights where a time limit has been missed (including “further processing”) and extension of time limits which have not yet expired but whose extension has been requested by the party concerned.⁹⁴

In the “Report” adopted by the Committee of Experts of the third session, many delegations and representatives of intergovernmental and non-governmental organizations supported the principle of harmonization of extension of time limits expressed in Article 12 PLT.⁹⁵ However, several delegations expressed the view that it was necessary to differentiate between time limits established by law or convention and those established by the Office. By way of example, several delegations observed that the time limit for the payment of fees for the maintenance of industrial property rights should not be extensible beyond what was prescribed by Article 5*bis* of the Paris Convention.⁹⁶

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the fourth session of the *Committee of Experts on the Patent Law Treaty*, Article 12 PLT was renumbered to become Article 13 PLT and new Article 14 PLT was introduced.⁹⁷ Article 13 PLT sets a minimum of rights a PLT Contracting Party must extend to an applicant or owner in respect of a request for an extension of a time limit *established by the Office* whereas the extension of time limits established by national legislation or regional treaty is regulated by Article 14 PLT.⁹⁸ Article 13(1) PLT addresses the situation in which an applicant or owner requests the extension of a time limit established by the Office *before* that time limit has expired whereas Article 13(2) PLT addresses the situation in which an applicant or owner requests the extension of a time limit established by the Office *after* that time limit has expired.⁹⁹ Article 14 PLT sets a minimum of rights a PLT Contracting Party must extend to an applicant or owner concerned in respect of a request for an extension of a time limit established by national legislation or under a treaty providing for the grant of regional patents. Except in respect of intervening rights (Article 14(5) PLT), any

PLT Contracting Party would be free to be more liberal in granting such an extension. As in the case of Article 13 PLT, it was noted that Article 14 PLT deals with the time limit for an action before the Office, and not the time limit before a court.¹⁰⁰

In the “Report” adopted by the Committee of Experts it was agreed that Article 13(2) PLT related to restoration, not extension, and should be transferred to Article 14 PLT.¹⁰¹ In addition, a proposal by the delegation of the United States of America that the concept “in spite of due care required by the circumstances” be replaced by the concept “the failure to comply was unintentional” was approved.¹⁰²

Relief in the form of “further processing” or restoration of rights may be available in the case where the time limit to request extension of a time limit has expired.¹⁰³ In particular, Article 14(1)(a) PLT was introduced following the approval by the previous session of the Committee of Experts that a proposal providing for “further processing” should generally be permitted on the mere basis of a request and the payment of a fee.¹⁰⁴ Further processing under this provision would be restricted to the cases in which an application is to be, or has been, refused or considered withdrawn or abandoned following failure to comply with a time limit fixed by the Office for an action before the Office.¹⁰⁵

In the “Report” adopted by the Committee of Experts, the Representative of the European Patent Organization explained that it was intended to extend further processing under the European Patent Convention (in view of the EPC 2000 Revision) to non-compliance with time limits established under that Convention.¹⁰⁶ Accordingly, it was agreed that the International Bureau would revise the corresponding provisions.

Standing Committee on the Law of Patents

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the first session of the *Standing Committee on the Law of Patents*, Article 13 PLT (“Extension of a time limit fixed by the Office”) was restricted to requests for extension of a time limit fixed by the Office for an action in a procedure before the Office *prior* to the expiration of that time limit.¹⁰⁷ Article 13(1) PLT provides for the extension of a time limit as of right; in particular, the applicant or owner concerned could not be required to state the grounds on which the request is based.¹⁰⁸ Article 14 PLT provides that “further processing” of an application should generally be permitted on the mere basis of a request and the payment of a fee.¹⁰⁹ In contrast to restoration of rights, a Contracting Party would not be permitted to restrict further processing to those cases in which the failure to comply with the time limit occurred in spite of all due care or was unintentional, so that there would be no requirement for a declaration or other evidence in this respect.¹¹⁰

Article 15 PLT provides for the restoration of rights in respect of an application or patent following failure to comply with a time limit for an action before the Office. However, restoration would be restricted to those situations in which the failure of the time limit occurred in spite of all due care required by the circumstances or was unintentional (Article 15(1)(iii) PLT).¹¹¹

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the second session of the *Standing Committee on the Law of Patents*, Articles 13, 14, 15 and 16 PLT were renumbered to become Articles 10, 11, 12 and 13 PLT, respectively.¹¹² In the corresponding “Notes” the distinction between Articles 10, 11, 12 and 13 PLT was explained by the International Bureau:¹¹³

- Article 10 PLT provides for the extension of a time limit as of right, where the request for such extension is made *before* the expiration of that time limit. It is limited to the extension of time limits fixed by the Office for an action in a procedure before the Office and is subject only to the payment of a fee. Accordingly, the applicant or owner concerned could not be required to state the grounds on which the request under Article 10 PLT is based.¹¹⁴
- In contrast, Articles 11 and 12 PLT apply where the request for relief is made *after* the expiration of the time limit concerned. Article 11 PLT provides for the Office to consider the time limit to have been

complied with, and to continue processing and re-instate any rights with respect to the application (or patent), subject only to the payment of a fee, provided that the request is filed, and the requirements in respect of which the time limit applied are complied with in due time.¹¹⁵ As in the case of Article 10 PLT, Article 11 PLT is limited to the extension of time limits fixed by the Office for an action in a procedure before the Office.

- As in the case of Article 11, Article 12 PLT provides for the re-instatement of rights where the request is made after the expiration of the time limits concerned. In contrast to Article 11 PLT, Article 12 PLT is not restricted to time limits fixed by the Office but applies to any time limit in respect of which failure to comply has the direct consequence of causing a loss of rights with respect to the application or patent concerned.¹¹⁶
- Article 13 PLT provides for the addition of a priority claim (Article 13(1) PLT). In addition, Article 13 PLT provides for the restoration of a priority claim in the case of the delayed filing of the subsequent application (Article 13(2) PLT) or the failure to furnish a copy of the earlier application within the prescribed time limit (Article 13(3) PLT). In order to avoid the possibility of double relief, the time limits referred to in Article 13(1), (2) and (3)(a) PLT are expressly excluded in the exceptions under Articles 10 to 12 PLT.^{117,115,116,117}

Each of Articles 10 to 13 PLT sets the *maximum* standard, which a PLT Contracting Party may apply. A PLT Contracting Party would be permitted, but is not obliged, to dispense with any requirement under these Articles, or to apply any requirement or provide any relief which, from the viewpoint of applicants, owners or other interested persons, is more favorable than the requirements or relief prescribed in these Articles and associated Regulations.¹¹⁸

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the third session of the *Standing Committee on the Law of Patents*, Article 10 PLT (“relief in respect of the non-compliance with a time limit”) was reformulated to provide for relief in respect of the non-compliance with a time limit fixed by the Office with regard to an application or a patent, without specifying the form of relief.¹¹⁹ In particular, Article 10 PLT does not distinguish between extensions of time limits filed after the expiration of the un-extended time limit and remedies like continued processing, which have the effect to reinstate the rights of the applicant or owner. It only obliges PLT Contracting Parties to provide for at least one relief for applicants or owners in the case of a missed time limit, subject only to a request and the payment of a fee.¹²⁰

In the “Report” of the third session of the *Standing Committee on the Law of Patents*, the basic concept of draft Article 10 PLT providing certain relief without specifying its mechanism was supported in general.¹²¹ However, some delegations preferred to accommodate both requests filed before and after the expiration of the time limit. Based on the discussion, the International Bureau presented a revised text of Article 10 PLT for consideration by the Committee, which reads as follows:¹²²

Article 10(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:

- (a) *prior to the expiration of the time limit; or*
- (b) *after the expiration of the time limit, and within the time limit prescribed in the Regulations.*

Article 10(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 (notify the applicant or owner, and) 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:

- (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 above text of Article 10 PLT is a combination of the earlier Articles 10 and 11 PLT and is already relatively close to the text adopted during the Diplomatic Conference. As regards Article 10(1) PLT, several delegations supported the text suggested by the International Bureau; other Representatives were in favor of replacing “may” by “shall.”¹²³

Diplomatic Conference for the Adoption of the PLT

In the Draft Proposal submitted to the *Diplomatic Conference for the Adoption of the Patent Law Treaty* submitted by the Director General of WIPO, Article 10 PLT on “Relief in respect of time limits” was renumbered to become Article 11 PLT and Article 13 PLT on “Re-instatement of rights after a finding of due care or unintentionality by the Office” was renumbered to become Article 12 PLT.¹²⁴

During the meetings at the *Diplomatic Conference for the Adoption of the Patent Law Treaty*, the requirements for extension of time limits were extensively discussed. A delegation asked whether a PLT Contracting Party was obliged to provide for the extension of time limits even though Article 11(1) PLT was a “may” provision. A representative of the WIPO referred to Article 11(2) PLT according to which a PLT Contracting Party that did *not* provide for the extension of time limits *after* the expiration of the time limit (Article 11(1)(ii) PLT), would be obliged to provide for continued processing.¹²⁵ A representative of the European Patent Organization said that Article 11(2) PLT was the core provision of the whole Article, making it mandatory to provide for relief of missed time limits, either in form of an extension of the time limit requested after its expiry, or through continued processing.¹²⁶⁻¹²⁷

With respect to Article 12 PLT, a Representative of WIPO explained that Article 12 PLT provided for the re-instatement of rights after a finding of due care or unintentionally by the Office. In contrast to Article 11 PLT, Article 12 PLT was not limited to time limits fixed by the Office, but applied to any time limit for an action in a procedure before the Office. It also only dealt with time limits where failure to comply had the direct consequence of causing loss of rights with respect to an application or patent.¹²⁸

Conclusion

From the above overview of the negotiations, it can be concluded that Articles 11 and 12 PLT regulate minimum requirements for relief in respect of time limits and reinstatement of rights. However, the formulations chosen in Article 11 PLT in relation to extension of time limits and the provision of continued processing are a typical compromise while accommodating the common practice before the US Patent and Trademark Office (USPTO) and the European Patent Office (EPO). The EPO allows extension of office time limits (see Rule 132 EPC “Periods specified by the European Patent Office”) if requested before the expiry of the time limit and allows applicants to request continued processing when the time limit is overrun (see Article 121 and Rule 135 EPC “Further processing of the European patent application”). On the other hand, the USPTO allows applicants to request extension of time limits after

expiry of the time limit. Both options were accommodated in the PLT by inserting the formulation “may require” into Article 11(1) PLT. Article 11(2) PLT contains a “shall,” but this comes into effect only if the “may require” extension of time limits after expiry of the time limit (Article 11(1)(ii) PLT) is not provided in the national law.

Article 12 PLT is also a compromise because no choice was made between whether and, if so, how much argumentation is required upon requesting re-instatement of rights. For a request for re-instatement to be successful, the EPO requires that the applicant for or proprietor of a European patent proves “all due care required by the circumstance” (see Article 122 and Rule 136 EPC “Re-establishment of rights”) whereas before the USPTO it is sufficient that the delay was “unintentional.” Again this introduces too much freedom for PLT Contracting Parties when implementing requirements of the PLT into their national and regional patent laws and is contrary to the aim of harmonization and streamlining of the PLT.

Restoration of Priority Right

Committee of Experts on the Patent Law Treaty

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the first session of the *Committee of Experts on the Patent Law Treaty*, there was no article on restoration of the priority right.¹²⁹ In the “Report” adopted by the Committee of Experts, a number of delegations favored, amongst other things, the inclusion in the PLT of provisions relating to restoration of rights.¹³⁰

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the third session of the *Committee of Experts on the Patent Law Treaty*, there was a new Article 13 PLT “Belated claiming of priority”.¹³¹ This provision was modeled after Article 7 of the Basic Proposal submitted to the 1991 Diplomatic Conference in relation to the “Patent Harmonization Treaty”.¹³²

Article 13(1) PLT addresses the situation in which an application which could claim the priority of an earlier application does not, when filed, contain such a claim. The paragraph allows the claiming of priority in a separate declaration filed later than the application. This is permissible since the Paris Convention does not require that the priority claim (“the declaration” containing the priority claim, according to the terminology of Article 4D(1) of that Convention) be contained in the subsequent application itself.¹³³ Article 13(2) PLT provides for the restoration of the priority right where a subsequent application is filed after, but within 2 months from, the date on which the priority period expired. It applies only where the failure to file the application within the priority period occurred in spite of all due care required by the circumstances having been taken.¹³⁴

In the meantime, the WIPO General Assembly and the Assembly of the Paris Union (meeting in September/October 1996) considering a Memorandum by the Director General in respect of *Matters Concerning the Patent Law Treaty*, decided, amongst others, to include provisions relating to the belated claiming of priority (delayed submission of priority claim and delayed filing of the subsequent application) in the draft PLT.¹³⁵

In the subsequent “Report” adopted by the Committee of Experts, the basic concept of draft Article 13 PLT was supported in general.¹³⁶

In the fourth session of the *Committee of Experts on the Patent Law Treaty*, Article 13 PLT on “Belated claiming of priority” was renumbered to become Article 15 PLT.¹³⁷ In the “Report” adopted by the Committee of Experts, the delegation of France asked whether, under Article 15(2)(a) PLT, the priority period would be extended to 14 months or would remain a 12-month period subject to possible restoration and, in the latter case, whether third party rights would be recognized.¹³⁸ The International Bureau replied that the priority period would remain a 12-month period and that third party rights would not be recognized in case of restoration.

In the fifth session of the *Committee of Experts on the Patent Law Treaty*, the title of Article 15 PLT was amended to become: “Addition and restoration of priority claim.”¹³⁹ As before, Article 15(1) PLT addresses the situation in which an application which could claim the priority of an earlier application does not, when filed, contain such a priority claim.¹⁴⁰ Article 15(2) PLT provides for the restoration of the priority right where a subsequent application is filed after, but within 2 months, from the expiration of the priority period. It was noted again that the priority period, namely the 12-month period under Article 4C(1) of the Paris Convention, would not be extended.¹⁴¹ Article 15(3) PLT provides a remedy for the applicant where his 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 for the applicant to comply with the prescribed time limit, despite a timely request for that copy having been made.¹⁴² A new paragraph (5) was added to Article 15 PLT allowing a PLT Contracting Party to levy a fee in relation to Article 15(1), (2) or (3) PLT to be paid to its Office.

Standing Committee on the Law of Patents

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the first session of the *Standing Committee on the Law of Patents*, Article 15 PLT on “Addition and restoration of priority claim” was renumbered to become Article 16 PLT.¹⁴³

Article 16(1) PLT in relation of the addition of a priority claim is modeled after a portion of PCT Rule 26bis.1.^{144,145} Article 16(2) PLT in relation to restoration of the priority was amended to include that the failure to furnish that application within the priority period occurred either in spite of all due care required by the circumstances having been taken, or, at the option of the PLT Contracting Party, was unintentional.¹⁴⁶

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the second session of the *Standing Committee on the Law of Patents*, Article 16 PLT was renumbered to become Article 13 PLT. In the corresponding “Notes” the scope of Articles 13 PLT in relation to Articles 10-12 PLT was explained by the International Bureau (also see Standing Committee on the Law of Patents Section): Article 13 PLT provides for the addition of a priority claim (Article 13(1) PLT). In addition, Article 13 PLT provides for the restoration of a priority claim in the case of the delayed filing of the subsequent application (Article 13(2) PLT) or the failure to furnish a copy of the earlier application within the prescribed time limit (Article 13(3) PLT).

In the “Draft PLT and Draft Regulations” prepared by the International Bureau and presented at the third session of the *Standing Committee on the Law of Patents*, there were only minor amendment to Article 13 PLT on “Correction, addition or restoration of priority claim.”¹⁴⁷ Later on, the title was amended to read: “Correction or addition of priority claim; restoration of priority right.”¹⁴⁸ In the “Report” of the third session of the *Standing Committee on the Law of Patents*, only minor amendments were proposed and adopted. Amongst others, the word “may” in the chapeau of Article 13(1) PLT was changed into “shall.”¹⁴⁹

Diplomatic Conference for the Adoption of the PLT

With respect to Article 13 PLT in the Draft Proposal submitted to the *Diplomatic Conference for the Adoption of the Patent Law Treaty* submitted by the Director General of WIPO, a representative of the WIPO explained Article 13 PLT comprised three provisions relating to priority claims, all of which were intended to be very user-friendly.^{150,151} The remedy of Article 13(1) PLT already existed under the PCT in Rule 26bis.1. With respect to Article 13(2) PLT, the Representative of WIPO explained that this paragraph provided for the restoration of the priority right where the application claiming priority was not received by the Office until after the expiration of the 12-month priority period. It did not provide for an extension of the priority period provided for under the Paris Convention and the provision would apply only after the expiration of that period.¹⁵²

With respect to Article 13(3) PLT, the Representative of WIPO noted that it was intended to address the situation where the applicant requested a copy of the earlier application on which the priority claim was based, but as a result of delays in the Office with which the earlier application had been filed, he did not receive it in time to comply with the period for filing that application, which was typically 16 months.¹⁵³

Conclusion

From the above overview of the negotiations, it can be concluded that Article 13 PLT regulates minimum requirements for the correction or addition of a priority claim (Article 13(1) PLT), the restoration of a priority claim in the case of the delayed filing of the subsequent application (Article 13(2) PLT) or the failure to furnish a copy of the earlier application within the prescribed time limit (Article 13(3) PLT).

Article 13(1) PLT was copied into the PLT based on PCT Rule 26*bis*.1 which functions well. However, Article 13(2) PLT is again (see Conclusion in Restoration of Priority Right Section) a compromise between different viewpoints of the delegations, because no choice was made between whether and, if so, how much argumentation is required upon requesting restoration of the priority right. For a request for restoration to be successful, the EPO requires that the applicant for or proprietor of a European patent proves all due care required by the circumstance whereas before the USPTO it is sufficient that the delay was unintentional. Again this introduces too much freedom for PLT Contracting Parties when implementing requirements of the PLT into their national and regional patent laws and is contrary to the aim of harmonization and streamlining of the PLT.

Guidance by WIPO

The WIPO is a specialized agency of the United Nations.¹⁵⁴ It is dedicated to developing a balanced and accessible international intellectual property system.¹⁵⁵

During the negotiation process of the PLT, the WIPO played an active role by preparing the draft texts of the PLT and its Regulations, looking for compromises and seeking political agreement between the interests of the various States.

As the conclusion of the PLT, the involvement of the WIPO has diminished, 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.

The International Bureau has issued a set of *Explanatory Notes* on the PLT and Regulations under the PLT; the Notes have not been adopted by the Diplomatic Conference.¹⁵⁶ These Notes are helpful in understanding the meaning of the PLT. However, these texts are based on the Notes prepared by the International Bureau of WIPO in preparation for the meetings of the *Committee of Experts on the Patent Law Treaty* and the SCP, which are sometimes difficult to understand, if one has not followed the developments during the negotiation process.

In order to stimulate the electronic distribution of draft modifications in the Treaty and the submission of comments and observations, a *PLT Web Forum* was established following a decision of the *PLT Assembly* at its first session.^{157,158} The PLT Web Forum is intended to be used for consultations prior to the meetings of the PLT Assembly.¹⁵⁹

As the PLT is a mix of compulsory requirements (“shall”) and optional requirements which may be implemented as compulsory (“may require”) by a PLT Contracting Party, a lot of choices need be made when implementing the PLT into the national/regional patent law of an aspirant PLT Contracting Party.¹⁶⁰

In 2010 a *Questionnaire* was established and placed on the *PLT Web Forum* to collect information from the PLT Contracting Parties on how the PLT is implemented at the national/regional level, and to

share such information with current and future PLT Contracting Parties, as well as with patent practitioners and the public.¹⁶¹ The Questionnaire encompasses eleven categories of questions, amongst which are the following ones:

- Question 1 - Filing date (Article 5 and Rule 2 PLT);
- Question 4 - Relief in respect of time limits (Article 11 and Rule 12 PLT);
- Question 5 - Reinstatement of Rights (Article 12 and Rule 13 PLT);
- Question 6 - Restoration of priority rights where the filing of the subsequent application was delayed (Article 13(2) and Rule 14(4) and (5) PLT);
- Question 7 - Restoration of priority rights where the filing of a copy of the earlier application was delayed (Article 13(3) and Rule 14(6) PLT).

Most of these Questions are split into a number of sub-questions. By way of example, three of the six sub-questions of Question 1 read as follows:

- Q1-2 Does your Office accept a drawing as the element referred to as “a part which on the face of it appears to be a description” in Article 5(1)(a)(iii) PLT? (Reference: Article 5(1)(b) PLT).
- Q1-5 For the filing date to be determined under Article 5(6)(b) PLT (filing of a missing part of the description or a missing drawing), which of the optional elements referred to in Rule 2(4) PLT are required by your Office? (Reference: Rule 2(4) PLT).
- Q1-6 For a reference to a previously filed application to replace the description and any drawing for the purpose of the filing date under Article 5(7) PLT, which of the requirements referred to in Rule 2(5) PLT are required by your Office? (Reference: Rule 2(5) PLT)

A number of PLT Contracting Parties have posted answers to the Questionnaire.¹⁶² From the responses a large variety of choices can be observed. With respect to Q1-2 (Is a “drawing” accepted as a “description?”), 10 PLT Contracting Parties answered “Yes,” 14 “No” and one Party answered: “This is something we would consider on a case by case basis if and when it arose.”¹⁶³

With respect to Q1-5 (“filing missing parts of the description or missing drawings”) six sub-questions have to be answered in relation to “which of the optional elements referred to in PLT Rule 2(4) are required by your Office?”.¹⁶⁴

Question Q1-5	Yes	No
(a) A <i>copy</i> of the earlier application	20	3
(b) A copy of the earlier application and its filing date, <i>certified</i> as correct	8	15
(c) A <i>translation</i> of the earlier application	15	8
(d) The missing part of the description or missing drawing must be <i>completely contained</i> in the earlier application	17	6
(e) The application must contain an indication that the contents of the earlier application were <i>incorporated by reference</i>	10	13
(f) An indication as to <i>where the missing part of the description or the missing drawing is contained</i> in the earlier application or in the translation	9	14

With respect to Q1-6 (“filing by reference”) five sub-questions have to be answered in relation to “which of the requirements referred to in PLT Rule 2(5) are required by your Office?”¹⁶⁵

Question Q1-6	Yes	No
(a) The reference to a previously filed application must indicate the <i>filing date</i> of the previously filed application	16	6
(b) A <i>copy</i> of the previously filed application	17	5
(c) A copy of the previously filed application, <i>certified</i> as correct	7	15
(d) A <i>translation</i> of the previously filed application	15	7
(e) The reference mentioned in PLT Article 5(7)(a) shall be to a previously filed application that has been filed by the <i>applicant or his predecessor or successor in title</i>	11	11

From the above comparison, it can be concluded that when a country considers becoming a Contracting Party to the PLT, studying the responses to the Questionnaire is not very helpful in making choices.

When asked, the WIPO provides assistance to an aspirant PLT Contracting Party. This assistance is given bilaterally on a case-by-case basis, depending on the circumstances of the country concerned. Example texts can be employed as a guidance on how the requirements of the PLT can be implemented in the national/regional law. However, these texts have no official status.

Two examples are given here. The first example of a textual suggestion relates to the requirements for the accordance of a filing date (Article 5 PLT). Such an Article could be formulated in the national law as follows:¹⁶⁶

“Filing date of the Application

1. *The accordance of the filing date of an application shall require that on such a date the application filed with the Institution contains:*
 - (a) *an express indication that the grant of a patent is applied for;*
 - (b) *information identifying the applicant or allowing the applicant to be contacted; and*
 - (c) *a part which on the face of it appears to be a description, or reference to a previously filed application.*
2. *A reference to a previously filed application under paragraph 1(c) shall state the filing date and number of that application and the Office with which that application was filed. The reference shall indicate that it replaces the description for the purpose of the filing date.*
3. *Where the application contains a reference under paragraph 2, a copy of the previously filed application shall be filed within two months from the date on which the application containing the reference was received by the Institute. Where the previously filed application is not in one of the official languages of (), a translation thereof shall be filed within the same period.”*

The second example relates to the remedy of “continued processing.” With respect to providing relieve in respect of time limits, a PLT Contracting Party may provide for the extension of a time limit fixed by the Office for an action in a procedure before the Office, if a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party either *prior* to the expiration of the time limit, or *after* the expiration of the time limit (Article 11(1) and Rule 12(1) PLT). In principle, the PLT does not oblige a PLT Contracting Party to impose continued processing. However, the relief is mandatory if it is not allowed to file the request for an extension of a time limit *after* the expiration of the time limit (Article 11(2) and Rule 12(3) and (4) PLT). This implies that if a PLT Contracting Party chooses that the request for the extension of the time limit can only be filed *before* the expiration thereof, providing continued processing is mandatory, but

if a giving country allows that the request for extension can be filed *after* the expired time limit (but within a certain period of time; Rule 12(2)(b) PLT), there is no need providing for continued processing provisions. On the other hand, if the national law of a PLT Contracting Party (already) has a provision on continued processing, it is not mandatory to provide for the extension of time limits (see the wording “may provide for the extension” in the chapeau of Article 11(1) PLT).

A textual suggestion in relation to providing “continued processing” in the patent law of a PLT Contracting Party reads as follows:

- 1) *If the applicant for a patent has failed to perform an act in the course of the procedure before the Institute within a time limit prescribed by this Law (or the Regulations), the direct result of which is a loss of rights conferred by a patent application, he may file a request for the continued processing. The Institute shall allow the continued processing, provided that the applicant:*
 - (a) *files a request for the continued processing, and performs all the omitted acts within a time limit referred to in paragraph 2 of this Article;*
 - (b) *pays the fee and procedural charges in accordance with Article () of this Law.*
- 2) *A time limit for filing a request and for the performance of the omitted acts referred to in paragraph 1 of this Article shall be two months from the notification to the applicant or holder of a patent.*
- 3) *If the omitted acts have not been performed within a time limit referred to in paragraph 2 of this Article, or if the fees and procedural charges referred to in Article () of this Law have not been paid, a request for the continued processing shall be considered as not filed, and the Institute shall issue a conclusion to that effect.*
- 4) *A request for the continued processing shall not be filed in the case of failure to comply with a time limit:*
 - (a) *referred to in paragraph 2 of this Article,*
 - (b) *(...)*
 - (c) *for performing all the acts in the appeal procedure,*
 - (d) *for actions in inter partes proceedings.*
- 5) *The content of the request, the conditions and the procedure concerning the request referred to in paragraph 1 of this Article shall be regulated more specifically by the Implementing Regulations.*

An aspirant PLT Contracting Party is, of course, entirely free to make its own choices when implementing the PLT in its national/regional patent law. Nevertheless, it is believed that such textual suggestions are very 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 WIPO would be welcomed in this respect.

Discussion

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,¹⁶⁷ the WIPO incited new negotiations in 1995 which eventually resulted in the adoption of the PLT during a Diplomatic Conference held in Geneva in 2000. The resulting PLT focuses on the harmonization of patent formalities with the aim of stimulating uniformity, simplification and cost reduction within the international patent system.

During the negotiation process, a number of provisions in the PLT were modeled after texts of Articles already contained in the Basic Proposal submitted to the 1991 Diplomatic Conference in relation to the “Patent Harmonization Treaty.”¹⁶⁸ In addition, many proposals to amend the Draft Articles and

Draft Regulations under 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 that this was mandatory. As a consequence, the PLT contains a 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 is counterproductive with respect to achieving 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, the maintenance of patents and certain additional requirements.¹⁶⁹

From studying the documents relating to the negotiation history of the PLT, it can be inferred that the role of the 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 PLT 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.

By allowing too much freedom in relation to the fundamental requirements of the PLT has resulted in a fallible Treaty. This conclusion becomes the more evident from studying the answers posted by a number of PLT Contracting Parties to the Questionnaire on the PLT Web Forum.¹⁷⁰ The large variety of choices defies any striving to “streamline and harmonize” formal requirements.

In principle, there are two ways in solving these fundamental problems of the PLT. One option to make the PLT more coherent is to amend the Treaty in a comprehensive manner. As a first step, the Regulations under the PLT could be made more restrictive by deleting the majority of the “may require” formulations and/or by reformulating them into obligatory (“shall”) requirements. Amending the PLT Rules does not require a Revision Conference. Whether consensus can be reached on these amendments is questionable, in particular, because a number of PLT Contracting Parties has already amended their national or regional law in view of the PLT as concluded in 2000.

Another option would be to re-open negotiations in relation to the “Treaty Supplementing the Paris Convention as far as Patents are Concerned.” This could work because the objections by one of the major Contracting Parties have recently been overcome.¹⁷¹⁻¹⁷²

By not changing anything in the PLT, the Contracting Parties will continue to implement the PLT into their national law. This will result in less harmonization and streamlining in patent laws than before the adoption of the PLT.

Conclusion

When the PLT 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 (receiving) 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 PLT are regarded as counterproductive to achieving that objective.

Perhaps this is also one of the reasons why accession to the PLT of countries and intergovernmental organizations, such as the European Patent Organization, takes place at a slow pace.¹⁷³

In view of the above, the following conclusions can be formulated:

- (1) The PLT 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.
- (2) The PLT 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 PLT into their national and regional patent laws. This defies the aim of harmonization and streamlining of the PLT. A solution to make the PLT more coherent would be to amend the PLT Rules in making them more restrictive.
- (3) The WIPO could play a more active role in issuing instructions and guidelines on how to implement the PLT in national and regional patent laws. A preferred manner of implementing the PLT could be advocated.
- (4) The provision in the PLT 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.
- (5) 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.
- (6) 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.

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Notes

1. *Patent Law Treaty*, WIPO Publication No. 258(E). See <http://www.wipo.int/treaties/en/ip/plt/> (Accessed October 2014).
2. *Paris Convention for the Protection of Industrial Property*, WIPO Publication No. 351(E). See <http://www.wipo.int/treaties/en/ip/paris/> (Accessed October 2014).
3. At present, the European Patent Organization is not a Contracting Party to the Patent Law Treaty. The option for Intergovernmental Organizations to become Party to the PLT was created in Article 20(2) PLT. In addition, the European Patent Organization is explicitly mentioned in Article 20(3) and Article 26 PLT as one of the Regional Patent Organizations that may become Party to the PLT. In the *Basic Proposal for the Revision of the European Patent Convention* (issued in preparation of the Revision Conference in November 2000), the European Patent Organization indicated its wish to become a Contracting Party to the PLT. “Basic Proposal for the Revision of the European Patent Convention”; Document MR/2/00, *Travaux Préparatoires to the EPC 2000*; comment in

- relation to Article 80 EPC. See: <http://www.epo.org/law-practice/legal-texts/archive/documentation/travaux-preparatoires.html> (Accessed October 2014).
4. "Records of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned - Volume I: First Part of the Diplomatic Conference - The Hague, 1991", WIPO Publication No. 351(E).
 5. "The Situation Concerning the Patent Law Treaty (PLT)" (memorandum of the International Bureau), Consultative Meeting for the further preparation of the Diplomatic Conference for the Conclusion of the Patent Law Treaty, Document PLT/CM/2 (March 1995), Items 4 and 7.
 6. "Report" (adopted by the Assembly), Assembly of the International Union for the Protection of Industrial Property (Paris Union), Document P/A/XXII/2 (October 1994).
 7. Committee of Experts on the Patent Law Treaty. See http://www.wipo.int/meetings/en/topic.jsp?group_id=53 (Accessed October 2014).
 8. Standing Committee on the Law of Patents. See http://www.wipo.int/meetings/en/topic.jsp?group_id=61&items=30 (Accessed October 2014).
 9. Diplomatic Conference for the Adoption of the Patent Law Treaty. See http://www.wipo.int/meetings/en/topic.jsp?group_id=136 (Accessed October 2014).
 10. "Records of the Diplomatic Conference for the Adoption of the Patent Law Treaty (Geneva, 2000)", WIPO Publication No 327(E).
 11. PLT Contracting Parties. See http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=4 (Accessed October 2014). On December 18, 2013, the PLT entered into force for the United States of America thereby becoming the 36th Contracting Party.
 12. "Agreed Statements by the Diplomatic Conference regarding the Patent Law Treaty and the Regulations under the Patent Law Treaty" (adopted by the Diplomatic Conference on June 1, 2000). See http://www.wipo.int/treaties/en/text.jsp?file_id=289482 (Accessed October 2014).
 13. "Basic Features to the Patent Law Treaty" (prepared by the Secretariat) (November 2006), Item 3. See http://www.wipo.int/patent-law/en/pdf/plt_features.pdf (Accessed October 2014).
 14. "Report" (adopted by the Standing Committee), Standing Committee on the Law of Patents, Document SCP/3/11 (September 1999). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3824 (Accessed October 2014).
 15. "Notes" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/2/4 (February 1999). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3713 (Accessed October 2014).
 16. "Basic Features to the Patent Law Treaty (PLT)" (prepared by the International Bureau; November 2006).
 17. "The Patent Law Treaty (PLT)" in the *WIPO Intellectual Property Handbook: Policy, Law and Use* - Chapter 5: "International Treaties and Conventions on Intellectual Property", items 5.398-5.423 (WIPO Publication No. 489). See <http://www.wipo.int/about-ip/en/iprm/> (Accessed October 2014).
 18. "Basic Features to the Patent Law Treaty (PLT)" (prepared by the International Bureau; November 2006).
 19. "Explanatory Notes on the Patent Law Treaty and Regulations under the Patent Law Treaty adopted by the Diplomatic Conference on June 1, 2000" (prepared by the International Bureau), Diplomatic Conference for the Adoption of the PLT, Document PT/DC/48 Prov. (November 2000), Note 11.01. See http://www.wipo.int/export/sites/www/scp/en/meetings/pt_dc/pdf/pt_dc_48p1.pdf (Accessed October 2014). Also see <http://www.wipo.int/patent-law/en/plt.htm> (Accessed October 2014).
 20. PCT Rule 26bis.1 allows an applicant to correct or add a priority claim, on or after the filing date, to an application which could have claimed the priority of an earlier application but did not do so. PCT Rule 26bis.1 was introduced in the PCT on July 1, 1998.
 21. Committee of Experts on the Patent Law Treaty. See http://www.wipo.int/meetings/en/topic.jsp?group_id=53 (Accessed October 2014).

22. Standing Committee on the Law of Patents. See http://www.wipo.int/meetings/en/topic.jsp?group_id=61&items=30 (Accessed October 2014).
23. "Records of the Diplomatic Conference for the Adoption of the Patent Law Treaty (Geneva, 2000)", WIPO Publication No 327(E), pp. 262-568.
24. "Records of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned - Volume I: First Part of the Diplomatic Conference - The Hague, 1991", WIPO Publication No. 351(E).
25. Recently, an e-version of the *Records of the Diplomatic Conference for the Adoption of the Patent Law Treaty* (Geneva, 2000) was made available on the ftp website of WIPO. See ftp://ftp.wipo.int/pub/library/ebooks/Internationalconferences-recordsproceedings/wipo_pub_327e.pdf (Accessed October 2014).
26. Committee of Experts on the Patent Law Treaty. See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3286 (Accessed October 2014).
27. Standing Committee on the Law of Patents. See http://www.wipo.int/meetings/en/topic.jsp?group_id=61&items=30 (Accessed October 2014).
28. "Diplomatic Conference for the Adoption of the Patent Law Treaty". See http://www.wipo.int/meetings/en/details.jsp?meeting_id=4057 (Accessed October 2014). Many of the early documents are not electronically available but can, on request, be obtained from the WIPO.
29. "Records of the Diplomatic Conference for the Adoption of the Patent Law Treaty (Geneva, 2000)", WIPO Publication No 327(E).
30. "Records of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned - Volume I: First Part of the Diplomatic Conference - The Hague, 1991", WIPO Publication No. 351(E).
31. On January 24, 1994, the International Bureau was informed, through a *press release* of the Department of Commerce of the United States of America, "that the United States would not seek to resume negotiations of a treaty harmonizing the world's patent laws at this time. While other international negotiations continue, we will maintain our first-to-invent system while keeping open the option of full patent harmonization in the future". See "The Situation Concerning the Patent Law Treaty (PLT)" (memorandum of the International Bureau), Consultative Meeting for the further preparation of the Diplomatic Conference for the Conclusion of the Patent Law Treaty, Document PLT/CM/2 (March 1995), Item 7.
32. "Report" (adopted by the Assembly), Assembly of the International Union for the Protection of Industrial Property (Paris Union), Document P/A/XXII/2 (October 1994).
33. "The Situation Concerning the Patent Law Treaty (PLT)" (memorandum of the International Bureau), Consultative Meeting for the further preparation of the Diplomatic Conference for the Conclusion of the Patent Law Treaty, Document PLT/CM/2 (March 1995).
34. "Report" (adopted by the Consultative Meeting), Consultative Meeting for the further preparation of the Diplomatic Conference for the Conclusion of the Patent Law Treaty, Document PLT/CM/4 (May 1995).
35. WIPO General Assembly, Meeting WO/GA/XVI (September 25 to October 3, 1995). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=2688 (Accessed October 2014). The documents are not electronically available.
36. International Union for the Protection of Industrial Property (Paris Union) Assembly, Meeting P/A/XXIII (September 25 to October 3, 1995).
37. See e.g. "Committee of Experts on the Patent Law Treaty - Report" (adopted by the Committee of Experts), Document PLT/CE/II/5 (June 1996), Item 12: "The delegation of the United States of America recalled its opening remarks made in the first session of the Committee of Experts and stated that it was still not in a position to discuss substantive patent law harmonization."
38. *Ibid*, Item 12: "The distinction between formal and substantive matters was important. In this regard, the delegation expressed its concern over inclusion of the new Article on unity of invention as a substantive requirement that was not appropriate for inclusion in this Treaty directed to formalities."

39. "Assembly of the Member States of WIPO - General Report" (adopted by the Assemblies of the Member States), Document A/32/7 (March 1998). See http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=778 (Accessed October 2014).
40. "Organizational Matters and Overview of the Issues to be Considered by the Standing Committee on the Law of Patents" (Memorandum prepared by the International Bureau), Document SCP/1/2 (May 1998). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3462 (Accessed October 2014).
41. "Records of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned - Volume I: First Part of the Diplomatic Conference - The Hague, 1991", WIPO Publication No. 351(E).
42. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/I/2 (October 1995).
43. "Notes" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/I/4 (October 1995), Item 2.01.
44. "Report" (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/I/5 (December 1995), see *e.g.* Items 14 (Canada), 27 (Switzerland), 37 (EPO) and 193 (Chairman).
45. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/II/2 (April 1996).
46. "Records of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned - Volume I: First Part of the Diplomatic Conference - The Hague, 1991", WIPO Publication No. 351(E), Article 8 "Filing Date".
47. "Notes" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/II/3 (April 1996), Item 3.01.
48. "Report" (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/II/5 (June 1996), see *e.g.* Items 15 (Switzerland), 16 (Canada), 28 (EPO).
49. *Ibid*, Items 162-163.
50. *Ibid*, Item 164 .
51. "Selected Provisions of the Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/2 (September 1996).
52. "Records of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned - Volume I: First Part of the Diplomatic Conference - The Hague, 1991", WIPO Publication No. 351(E), Article 8 "Filing Date".
53. "Report" (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/6 (November 1996), Item 63.
54. *Ibid*, Item 64.
55. *Ibid*, Item 65.
56. *Ibid*, Item 66.
57. *Ibid*, Item 67.
58. Meeting of the Assembly of the Paris Union: September 23 to October 2, 1996 (Geneva).
59. "Scope of the Patent Law Treaty" (Memorandum by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/5 (October 1996).
60. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/IV/2 (April 1997).
61. "Report" (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/IV/4 (June 1997), Item 62.
62. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/V/2 (October 1997). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3286 (Accessed October 2014).

63. "Notes" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/V/3 (October 1997), Item 4.23. See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3286 (Accessed October 2014).
64. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/1/3 (April 1998). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3462 (Accessed October 2014).
65. "Notes" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/1/4 (April 1998), Item 4.27.
66. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/2/3 (February 1999). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3713 (Accessed October 2014).
67. "Draft Article 4(5bis) and draft Rule 2(2)" (Proposal by the delegation of Australia), Standing Committee on the Law of Patents, Document SCP/2/9 (April 1999). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3713 (Accessed October 2014).
68. "Draft Article 4(5bis) and draft Rule 2(2)" (Suggestion of the International Bureau, based on the Proposal by the delegation of Australia in document SCP/2/9), Standing Committee on the Law of Patents, Document SCP/2/9bis (April 1999).
69. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/3/2 (June 1999).
70. "Notes" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/3/3 (June 1999), Item R2.07 (proposal by the delegation of the United States of America).
71. *Ibid*, Item 27.
72. "Basic Proposal for the Patent Law Treaty" (submitted by the Director General of WIPO), Diplomatic Conference for the Adoption of the Patent Law Treaty, Document PT/DC/3 (November 1999). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=4057 (Accessed October 2014).
73. "Results of the 28th (16th Extraordinary) Session of the PCT Assembly, March 13 to 17, 2000; Issues for possible Discussion at the Diplomatic Conference" (prepared by the International Bureau), Diplomatic Conference for the Adoption of the Patent Law Treaty, Document PT/DC/6 (April 2000).
74. *Ibid*, Item 33.
75. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 9th session (Friday, May 19, 2000, morning); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 701.
76. *Ibid*, Item 706.
77. *Ibid*, Item 705.
78. *Ibid*, Item 718.
79. *Ibid*, Item 718.
80. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 10th session (Friday, May 19, 2000, afternoon); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 731.
81. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 11th session (Friday, May 19, 2000, evening); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 811.
82. *Ibid*, Item 806.
83. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 19th session (Wednesday, May 24, 2000, evening); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 1861.
84. *Ibid*, Item 1861.

85. *Ibid*, Item 1867.
86. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 20th session (Thursday, May 25, 2000, morning); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 1944.
87. *Ibid*, Item 1960.
88. “Draft Patent Law Treaty and Draft Regulations” (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/I/2 (October 1995).
89. “Report” (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/I/5 (December 1995), Items 46 (Japan), 205 (France and AIPPI).
90. “Draft Patent Law Treaty and Draft Regulations” (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/2 (September 1996).
91. “Notes” (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/3 (September 1996), Item 12.01.
92. *Ibid*, Item 12.02.
93. *Ibid*, Item 12.05.
94. “Scope of the Patent Law Treaty” (Memorandum by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/5 (October 1996).
95. “Report” (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/6 (November 1996), Item 159.
96. *Ibid*, Item 167.
97. “Draft Patent Law Treaty and Draft Regulations” (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/IV/2 (April 1997).
98. “Notes” (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/IV/3 (April 1997), Item 13.01.
99. *Ibid*, Items 13.02 and 13.05.
100. *Ibid*, Item 14.01.
101. “Report” (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/IV/4 (June 1996), Item 189.
102. “Report” (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/IV/4 (June 1996), Item 190.
103. “Notes” (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/V/3 (October 1997), Item 13.05. See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3286 (Accessed October 2014).
104. *Ibid*, Item 14.01.
105. *Ibid*, Item 14.02.
106. “Report” (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/V/5 (December 1997), Item 213. See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3286 (Accessed October 2014).
107. “Draft Patent Law Treaty and Draft Regulations” (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/1/3 (April 1998). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3462 (Accessed October 2014).
108. “Notes” (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/1/4 (April 1998), Item 13.02.
109. *Ibid*, Items 14.01 and 14.10.
110. *Ibid*, Item 14.10.
111. *Ibid*, Item 15.01.

112. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/2/3 (February 1999). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3713 (Accessed October 2014).
113. "Notes" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/2/4 (February 1999), Item 10.01.
114. *Ibid*, Item 10.01.
115. *Ibid*, Item 10.02.
116. *Ibid*, Item 10.03.
117. *Ibid*, Item 10.04.
118. *Ibid*, Item 10.05.
119. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/3/2 (June 1999). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3713 (Accessed October 2014).
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121. "Report" (adopted by the Standing Committee), Standing Committee on the Law of Patents, Document SCP/3/11 (September 1999), Item 64.
122. *Ibid*, Item 71.
123. *Ibid*, Item 72.
124. "Basic Proposal for the Patent Law Treaty" (submitted by the Director General of WIPO), Diplomatic Conference for the Adoption of the Patent Law Treaty, Document PT/DC/3 (November 1999). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=4057 (Accessed October 2014).
125. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 13th session (Monday, May 22, 2000, morning); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Items 1196 and 1197.
126. *Ibid*, Item 1213.
127. For a comparison of the requirements in respect of relief regarding time-limits and the remedy of continued processing under the PLT with their counterparts in the European Patent Convention, see Cees Mulder: "Periods and Remedies under the EPC: Compliance of the EPC with the PLT: Part 1 - Extension of Periods and Further Processing", *European Intellectual Property Review*, Volume 34, Issue 1 (2012), pp. 12-21.
128. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 13th session (Monday, May 22, 2000, morning); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 1285.
129. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/I/2 (October 1995).
130. "Report" (adopted by the Committee of Experts), Committee of Experts on the Patent Law Treaty, Document PLT/CE/I/5 (December 1995), Items 46 (Japan), 169 (international Bureau), 200 (observer organization) and 205 (France and AIPPI).
131. "Draft Patent Law Treaty and Draft Regulations" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/2 (September 1996).
132. "Records of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned - Volume I: First Part of the Diplomatic Conference - The Hague, 1991", WIPO Publication No. 351(E), Article 7 "Belated claiming of priority".
133. "Notes" (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/3 (September 1996), Item 12.01.

134. “Draft Patent Law Treaty and Draft Regulations” (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/2 (September 1996), Article 13(2): “Delayed Filing of the Subsequent Application”.
135. “Scope of the Patent Law Treaty” (Memorandum by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/III/5 (October 1996).
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140. “Notes” (prepared by the International Bureau), Committee of Experts on the Patent Law Treaty, Document PLT/CE/V/3 (October 1997), Item 15.03.
141. *Ibid*, Item 15.06.
142. *Ibid*, Item 15.12.
143. “Draft Patent Law Treaty and Draft Regulations” (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/1/3 (April 1998). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=3462 (Accessed October 2014).
144. “Notes” (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/1/4 (April 1998), Item 16.02.
145. PCT Rule 26bis.1 entered into force on July 1, 1998.
146. “Notes” (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/1/4 (April 1998), Item 16.02, Item 16.06.
147. “Draft Patent Law Treaty and Draft Regulations” (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/3/2 (June 1999).
148. “Draft Patent Law Treaty: Working Document” (prepared by the International Bureau), Standing Committee on the Law of Patents, Document SCP/3/7 (July 1999).
149. *Ibid*, Item 80.
150. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 16th session (Tuesday, May 23, 2000, afternoon); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 1483.
151. For a comparison of the remedies of reinstatement of rights and restoration of the priority right under the PLT with the remedy of re-establishment of rights under the European Patent Convention, see Cees Mulder: “Periods and Remedies under the EPC: Compliance of the EPC with the PLT: Part 2 -Re-establishment of Rights”, *European Intellectual Property Review*, Volume 34, Issue 2 (2012), pp. 87–94.
152. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 16th session (Tuesday, May 23, 2000, afternoon); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 1502.
153. *Summary Minutes of the Main Committee I* (prepared by the International Bureau); 16th session (Tuesday, May 23, 2000, afternoon); published in *Records of the Diplomatic Conference for the Adoption of the Patent Law* (Geneva, 2000) (WIPO Publication 327E), Item 1573.

154. "Agreement between the United Nations and the World Intellectual Property Organization" (Agreement entered into effect on December 17, 1974). See http://www.wipo.int/treaties/en/text.jsp?file_id=305623 (Accessed October 2014).
155. "Convention Establishing the World Intellectual Property Organization" (signed at Stockholm on July 14, 1967 and as amended on September 28, 1979 (document WO 029 EN). See http://www.wipo.int/treaties/en/text.jsp?file_id=283854 (Accessed October 2014).
156. "Explanatory Notes on the Patent Law Treaty and Regulations under the Patent Law Treaty adopted by the Diplomatic Conference on June 1, 2000" (prepared by the International Bureau), Diplomatic Conference for the adoption of the PLT, Document PT/DC/48 Prov. (November 2000), Note 5.23. See http://www.wipo.int/export/sites/www/scp/en/meetings/pt_dc/pdf/pt_dc_48p1.pdf (Accessed October 2014). Also see <http://www.wipo.int/patent-law/en/plt.htm> (Accessed October 2014).
157. Meeting of the PLT Assembly in Geneva during the forty-first series of meetings of the Assemblies of the Member States of WIPO (September 26 to October 5, 2005).
158. "Future Work" (prepared by the International Bureau), PLT Assembly, 1st (ordinary) session, Document PLT/A/1/3. (July 2005), Item 3 (ii). See http://www.wipo.int/meetings/en/details.jsp?meeting_id=9003 (Accessed October 2014).
159. See <http://www.wipo.int/plt-forum/en/> (Accessed October 2014).
160. In the Articles of the PLT there are 19 occurrences and in the PLT Rules 58 occurrences of the wording "may require".
161. See <http://www.wipo.int/plt-forum/en/questionnaire/> (Accessed October 2014).
162. See <http://www.wipo.int/plt-forum/en/questionnaire/table.html> (Accessed October 2014). Currently (October 2014), 25 of the 36 PLT Contracting Parties have responded to the Questionnaire.
163. United Kingdom.
164. Ukraine declared that this procedure is "not applicable" in its Office.
165. Serbia has declared that its Patent Law does not contain such provisions. The Montenegrin has declared that its Patent Law does not contain such provisions.
166. Note that this text is more or less the same as what can be found in Rule 40(1) implementing the filing date requirements of Article 80 of the European Patent Convention (EPC 2000).
167. See § 1 and § 5.
168. "Records of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned - Volume I: First Part of the Diplomatic Conference - The Hague, 1991", WIPO Publication No. 351(E).
169. "Basic Features to the Patent Law Treaty" (prepared by the Secretariat) (November 2006), Item 2. See http://www.wipo.int/patent-law/en/pdf/plt_features.pdf (Accessed October 2014).
170. See <http://www.wipo.int/plt-forum/en/questionnaire/table.html> (Accessed October 2014).
171. Upon the entry into force of the *America Invents Act* (March 16, 2013), the main obstacles which obstructed agreement on the "Treaty Supplementing the Paris Convention as far as Patents are Concerned" in 1994 were overcome.
172. In December 2012, US Congress passed the *Patent Law Treaties Implementation Act of 2012* to implement the provisions of the Patent Law Treaty. This Act and ensuing changes became effective on December 18, 2013.
173. In the comment in relation to Article 80 EPC in the "Basic Proposal for the Revision of the European Patent Convention" (Document MR/2/00), *Travaux Préparatoires to the EPC 2000*, the EPO indicated its intention "to become a Contracting Party to the PLT". See: <http://www.epo.org/law-practice/legal-texts/archive/documentation/travaux-preparatoires.html> (Accessed October 2014). In the comment in relation to Article 80 EPC in the *Revision of the European Patent Convention (EPC 2000): Synoptic presentation EPC 1973/2000 - Part I: The Articles* (Official Journal of the European Patent Office, Special Edition No.4, 2007), the EPO did not

repeat this intention. See: http://archive.epo.org/epo/pubs/oj007/08_07/special_edition_4_epc_2000_synoptic.pdf (Accessed October 2014).

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