

Informal Consultation on Reform of the Patent Cooperation Treaty (PCT)

Introduction

The Intellectual Property Office (IPO) is currently engaged in a program of work to identify ways to improve the PCT system. Backlogs of work in many of the major patent offices around the world are currently posing serious challenges to the patent granting system worldwide. The PCT system has the potential to be a key tool in addressing these challenges by reducing global duplication of work and raising patent quality. However, the current PCT system has many shortcomings – it is often slow and inefficient and there is a general lack of confidence in the quality of the work performed in the international phase, which often leads to unnecessary duplication of work in the national phase.

Earlier this year Francis Gurry, the Director General of WIPO, produced a paper setting out a ‘roadmap’ of the type of work he believes is needed to transform the use of the PCT to the benefit of all offices and users. The IPO is keen to contribute to this work and we have used the proposals in the roadmap as a basis for our own investigations. We have also considered further ideas that were put forward by other PCT Member States at the May 2009 meeting of the PCT Working Group. During the course of our work we have conducted informal consultations with users to obtain their views on PCT reform - the Patent Practice Working Group were consulted at their April 2009 meeting and we also held a PCT focus group with some of our users in June 2009.

In the light of our investigations we have developed a set of ideas for reform of the PCT system. Some of these ideas would require changes to the PCT Regulations, others relate to behavioural changes required of other Member States, and one concerns our internal procedures for processing international applications in the UK national phase.

The ideas put forward in this document are likely to be of interest to anyone who files, or is interested in, international patent applications under the PCT. We are keen to obtain the views of as wide a cross section of our actual and potential customers as possible before we decide how to proceed. We would particularly like to know the extent to which the ideas would change the way businesses and individuals make use of the PCT system, both in the international and national (UK and otherwise) phases. We would also welcome views on whether our ideas are heading in the right direction to address the problems in the current PCT system.

The results of this work will be used to inform the UK's position on PCT reform in international fora. Where appropriate, our ideas will be put forward for consideration at the next meeting of the PCT Working Group in 2010.

Summary of Questions

1. Collaborative international search

Q1(a): What do you think about the idea of collaborative search?

Q1(b): Do you have any views on the form that collaborative search should take?

Q1(c): Would you be prepared to pay a higher search fee for a better quality international search?

2. Third party observations

Q2(a): What do you think about the idea of introducing a system for filing third party observations in the international phase?

Q2(b): Do you think that the suggested details of the system would strike a fair balance between the interests of the applicant and of third parties?

Q2(c): Do you have any alternative suggestions for the form that the system should take?

3. International preliminary examination

Q3(a): What do you think of the ideas for reforming the IPE procedure?

Q3(b): Do you think the suggested changes would affect the way applicants use the IPE procedure?

Q3(c): Do you think there is any value in the idea of collaborative international examination?

Q3(d): Do you think that the time limit for national phase entry under Chapter II should be extended?

Q3(e): If so, what should the time limit be and what measures should be taken to prevent applicants using Chapter II as a delaying tactic?

Q3(f): Do you have any other suggestions for improving the IPE procedure?

4. Top-up search in the international phase

Q4(a): What do you think about the idea of introducing a top-up search into the IPE procedure?

Q4(b): What do you think about our suggested way of dealing with citations published after the priority date at IPE?

Q4(c): Would you be prepared to pay a higher fee for an IPE that included a top-up search?

5. Accelerated processing option in the international phase

Q5(a): What do you think of the idea of introducing an accelerated processing option in the international phase?

Q5(b): Which of the two criteria for granting a request for acceleration would you prefer – a requirement to provide an adequate reason for the request or the payment of an additional fee?

Q5(c): Do you think the availability of an accelerated processing option under the PCT would stop applicants from filing parallel national applications in addition to their PCT applications?

6. Deferred search in the international phase

Q6(a): What do you think about the idea of delaying the international search until after publication?

Q6(b): How important is it for the international search report to be available in time for international publication (i) from the point of view of third parties and (ii) from the point of view of the applicant?

Q6(c): Would you make use of an option to defer search until after publication?

7. Improved procedures for correction of errors made by the RO or the IB

Q7: Do you have any comments on the draft amendments to the Regulations in Annex 1?

8. Accelerated processing option in the national phase for applications with a positive IPRP

Q8(a): What do you think of the idea of introducing an accelerated processing option in the UK national phase for international applications having a positive IPRP?

Q8(b): Would the option of accelerated processing in the national phase provide an incentive to get the application in order in the international phase?

Q8(c): Is there any place for using fee reductions in the national phase (UK or otherwise) to provide an incentive to get a positive IPRP in the international phase?

9. Summary questions

Q9: Do you have any other comments on our ideas?

Q10: Do you have any other suggestions for improving the PCT system?

Background

Francis Gurry's PCT roadmap and the ideas put forward by Japan, Korea and the USA are summarised below.

Francis Gurry's PCT roadmap

The roadmap is based on the following fundamental principles:

- (a) Duplication of work should be minimised. Defects in international applications should be identified early (in the international phase where possible) and national offices should seek to eliminate procedures which encourage or result in duplicative processing.
- (b) The system must deliver results (especially search reports, international publications and international preliminary examination reports) which meet the needs of applicants and designated offices of all types: large and small, examining and non-examining.
- (c) The system must be accessible to applicants of all types from all Contracting States.
- (d) Patents granted on the basis of international applications should have a high presumption of validity if examined, or the likely extent of validity should be easily determined if registered without examination.
- (e) Unnecessary actions for offices and applicants should be eliminated.
- (f) Information relating to international applications should be available as freely and efficiently as possible.

In line with the above principles, the roadmap defines a number of proposed areas of work that Dr Gurry believes would need to be pursued in order to ensure that the PCT is effective. These are summarised below:

(i) Compliance and Consistency

There must be confidence that work done in the international phase has been done in accordance with the requirements of the Treaty. In order to build such confidence, International Authorities should provide an assurance that work performed by them in the international phase will not be repeated by the same office acting as designated office in the national phase.

The international application should, as far as possible, have a consistent effect in all Contracting States. There are currently approximately 150 reservations, notifications and declarations of incompatibility in force relating to various PCT Articles, Rules and Administrative Instructions. Contracting

States and offices should seek to eliminate these inconsistencies. The International Bureau should offer assistance in this process.

(ii) Making International Examination More Complete, Relevant and Useful

Written opinions (WO) and international preliminary reports on patentability (IPRP) should be useful to designated offices. The benefits of Chapter II processing (international preliminary examination) should be enhanced to encourage applicants to achieve a positive IPRP before entering the national phase.

Discussions are required to determine how to make examination in the international phase more complete and useful to applicants (including the possibility of extending the time limit for national phase entry under Chapter II) such that more applications enter the national phase with a positive IPRP and are likely to be found in order for grant without further national action.

Dr Gurry's proposals for improving international examination include:

- Development of a system to allow third party observations to be filed in the international phase.
- Consider including matters such as clarity, support and formalities defects in the international examination report, with a view to making the IPRP suitable to form a first national examination report in designated offices.
- Inclusion of top-up searches in international preliminary examination.

(iii) Eliminating Unnecessary Procedure

Processes need to be examined to see if they serve any useful purpose, either in general or because the system is used in particular ways by applicants to overcome perceived difficulties e.g. in some states, parallel national applications are often pursued in favour of direct entry into the national phase. Consideration needs to be given to whether office procedures and fee structures can be changed to encourage the international application to be pursued in favour of a duplicative national application.

(iv) Collaborative International Search and Preliminary Examination

It is proposed to build on the concept of supplementary international search to offer an option where the international search and preliminary examination are conducted by a 'virtual' authority consisting of examiners from several offices in different regions working collaboratively. For example, searches would be performed by at least three examiners in different offices with different language specialities. This would increase confidence in work done in the international phase in order to reduce unnecessary duplication of work in the national phase.

(v) Fees and Other National Measures

National offices should consider whether their fees provide appropriate incentives for applicants to ensure that international applications are processed as efficiently as possible, with defects and patentability issues

dealt with in the international phase. Other incentives such as accelerated or simplified national processing for international applications with a positive IPRP are proposed to encourage applicants to amend the application in the international phase to overcome defects.

Further incentives should be considered to ensure that the system is accessible to individuals and small businesses from developing countries e.g. ISAs could offer a certain number of searches to be carried out free of charge for applicants meeting appropriate criteria.

Ideas put forward by other States

The following proposals for PCT reform were put forward by Japan, Korea and the USA at the meeting of the PCT Working Group in May 2009.

(i) Deferred Search and Third Party Observations (Japan)

International search would be delayed until after publication and a system for filing third party observations would be introduced. Performing the search after publication would enable “secret prior art” to be covered by the search and could eliminate the need for a top-up search at a later stage. The ISR and WO would therefore reflect both “secret prior art” and third party observations. The current timing of establishing the ISR and WO before publication would be retained as an option.

(ii) Three Track PCT System (Korea)

In order to meet the needs of all users of the PCT, it is proposed to introduce three processing options – accelerated, normal and deferred.

- Accelerated

International search performed within three months of date of receipt of search copy; international preliminary examination (IPE) requested within three months of date of transmittal of ISR and WO; IPE completed within six months of commencement of examination; IPE received by applicant within twelve months of international filing date.

- Normal

Current procedures and timelines for the international search and international preliminary examination would be followed.

- Deferred

The deferred search option proposed by Japan would be followed – the ISR and WO would be established after international publication.

(iii) Comprehensive PCT Reform (USA)

A comprehensive revision of the international patent system would be performed which would result in the establishment of a new Patent Cooperation Treaty, PCT II. The aim would be to ensure that the work done under the new system was of such a high quality that it would be readily used and accepted by national offices. The new system would include the following

features: (i) the combining of international and national processing, (ii) search/examination collaboration among Authorities, (iii) allowing for submission of prior art by the applicant, and (iv) allowing for third party submissions.

After publication, searches would be performed by two separate authorities. A third authority would receive the results of those searches, perform its own search and then perform an international examination using the results of the three searches and the prior art submissions by the applicant and third parties. Applications receiving a positive report on patentability at the end of the processing by the third authority would be automatically granted in all member states on entry to the national phase, subject to each member state having a given amount of time to issue a notification of refusal if their national requirements for grant had not been met.

Our Ideas

The ideas that follow have taken into account the proposals put forward by WIPO, Japan, Korea and the USA (summarised above), and the views expressed by our users at the PPWG and the PCT focus group. They set out our view of how PCT reform should be progressed to improve the quality of the work done under the PCT, increase efficiency and make the system more useful for users.

1. Collaborative international search

Under the current system the international search is not perceived as being of a high quality, with the result that many designated and elected Offices repeat the search when the application enters the national phase. The WIPO roadmap proposes introducing a 'collaborative international search' whereby the international search would be performed by three or more international searching authorities (ISAs) working collaboratively to give a higher quality, more extensive search. Such a collaborative search could utilise the different language specialities and search techniques of different ISAs to cover as wide a range of prior art as possible.

Although this idea would require more resources to go into the international search than at present, this would be worthwhile if it results in less duplication of work in the national phase. It is likely that the additional resources required for collaborative search would lead to an increase in the international search fee but our consultations so far suggest that users would be prepared to pay more for a higher quality international search if it leads to less work, and therefore decreased costs, in the national phase.

We therefore propose to support further investigation into collaborative international search.

Q1(a): What do you think about the idea of collaborative search?

Q1(b): Do you have any views on the form that collaborative search should take?

Q1(c): Would you be prepared to pay a higher search fee for a better quality international search?

2. Third party observations

There is no mechanism under the current PCT system for third parties to submit observations on a published international application. It is proposed to introduce such a mechanism to help to ensure that all relevant prior art is available to the applicant and the IPEA during the international phase. This would allow the applicant to amend their application in the international phase to overcome prior art identified by third parties, thus reducing the risk of new prior art coming to light during the national phase.

Due to differences in national requirements for patentability, it is proposed to limit such observations to those relating to novelty and inventive step.

The details of such a system and the potential problems that it may present have not yet been considered in detail by WIPO. We think that the language issues associated with such a system could be addressed by introducing a requirement to file observations in either the language of filing or the language of publication of the international application, since it is reasonable to expect that a third party who has understood the application sufficiently to provide observations would be able to comment in one of those two languages. If the applicant files a demand for IPE and the observations are not in a language accepted by the IPEA, we think that the onus to provide a translation of the observations into a language accepted by the IPEA should be on the applicant. It would be in the applicant's interest to provide such a translation in order to obtain an IPE which takes into account all prior art.

In order to discourage abusive use of such a system and to allow applicants enough time to consider and translate any observations, we think that the time window for filing observations should be made fairly short – for example within three months of publication. Another option for discouraging abusive use would be to charge a nominal fee for filing observations.

Q2(a): What do you think about the idea of introducing a system for filing third party observations in the international phase?

Q2(b): Do you think that the suggested details of the system would strike a fair balance between the interests of the applicant and of third parties?

Q2(c): Do you have any alternative suggestions for the form that the system should take?

3. International preliminary examination

The option for requesting IPE under Chapter II of the PCT has rarely been used by applicants since the time limits for entering the national phase were brought into line

for all applications, regardless of whether or not IPE is requested. This drop in demand was thought to be due to applicants having used Chapter II simply as a tactic to delay entry into the national phase. Our consultations so far have suggested that this is not the case and that the reason Chapter II is not used is that IPEAs don't examine the international application and don't reply to the applicant's responses in time to obtain a positive report.

In the light of this fact, we think that reform of the IPE procedure should focus on making procedures before the IPEA more efficient so that sufficient rounds of amendment are possible in order to give the applicant a realistic chance of getting the application in order in the international phase.

We therefore support the introduction of a requirement for the applicant to respond to the objections in the written opinion (WO) of the ISA when filing a demand for international preliminary examination. We also think that the IPEA should be required to provide at least one WO, in addition to the one provided by the ISA, before issuing a negative international preliminary report on patentability (IPRP) to encourage a dialogue between the IPEA and the applicant. Suitable amendments to the PCT Regulations would seem to be the most effective way to impose such requirements.

IPEAs should also be encouraged to perform the IPE and consider the applicants responses in a timely manner.

These ideas would increase the chances of the application being put in order in the international phase, leading to less duplication of work in the national phase and lower costs for the applicant.

Q3(a): What do you think of the ideas for reforming the IPE procedure?

Q3(b): Do you think the suggested changes would affect the way applicants use the IPE procedure?

The WIPO roadmap proposes introducing a collaborative international examination whereby the IPE would be performed by three or more IPEAs working collaboratively. Although our consultations so far have indicated that users are strongly in favour of collaboration at search stage, users seemed less supportive of a collaborative examination process. Due to differing national examination requirements and the problems that would be introduced by translating the application into the different languages accepted by each IPEA, we think it would be difficult to achieve a meaningful international preliminary examination report through a collaborative process. Therefore, our preliminary view is that there is little value in this idea.

Q3(c): Do you think there is any value in the idea of collaborative international examination?

Some of our users have suggested that the time limit for national phase entry under Chapter II could be extended, e.g. to 48 months, to allow a more complete examination. However, any extension to the time limit would have to be accompanied by measures to prevent Chapter II being used simply as a delaying

tactic. For example, a deadline for getting the application in order in the international phase could be introduced whereby the application would go straight into an appeals procedure in the national phase if the deadline was not met. In general, to avoid abuse of the system, we would prefer not to extend the time limit for national phase entry if the system can be made to work properly under the current time limit of 30 months.

Q3(d): Do you think that the time limit for national phase entry under Chapter II should be extended?

Q3(e): If so, what should the time limit be and what measures should be taken to prevent applicants using Chapter II as a delaying tactic?

Q3(f): Do you have any other suggestions for improving the IPE procedure?

4. Top-up search in the international phase

The WIPO roadmap proposes introducing a top-up search into the IPE procedure. This would help to ensure that as much relevant prior art as possible is drawn to the applicant's attention during the international phase to increase the likelihood of the application being put in order for grant before it enters the national phase.

There would be some practical problems to be overcome due to differing national requirements regarding citable documents. To address these problems we think that the IPEA should draw to the applicant's attention all relevant documents having a priority date earlier than the priority date of the international application, but only consider documents published earlier than the priority date (i.e. those that would be citable in all States) in the international preliminary examination report. Documents published after the priority date that would only be citable in certain States could be considered in the national phase in those States.

The WIPO roadmap suggests that WIPO do not intend to raise the fee for IPE to cover the cost of a top-up search. However, we would like to know whether applicants would be prepared to pay an increased fee for this service if it was not possible to implement it without raising fees.

Q4(a): What do you think about the idea of introducing a top-up search into the IPE procedure?

Q4(b): What do you think about our suggested way of dealing with citations published after the priority date at IPE?

Q4(c): Would you be prepared to pay a higher fee for an IPE that included a top-up search?

5. Accelerated processing option in the international phase

Our consultations so far have indicated that users would like the PCT system to be as flexible as possible to accommodate the needs of different applicants. Users were therefore in favour of the introduction of an accelerated processing option in the international phase, as proposed by Korea.

Our initial view is to support the introduction of an option to request accelerated, search, publication and/or examination in the international phase. In order to prevent the system being overwhelmed with requests for acceleration we think that a fee could be imposed for such requests. Alternatively, the applicant could be required to provide reasons for the request which would be considered by the ISA, IB or IPEA in deciding whether to accept the request (much like the system in the UK).

We think that the introduction of an accelerated option would be helpful in addressing backlogs in the PCT system since it would bring the applications for which applicants would like quick processing to the front of queue. It may also reduce duplication of work by removing the need for applicants to file a parallel national application in addition to their PCT application in order to obtain a quick grant – our consultations revealed that this is a tactic that is used by applicants because processing via the PCT route is currently too slow.

Q5(a): What do you think of the idea of introducing an accelerated processing option in the international phase?

Q5(b): Which of the two criteria for granting a request for acceleration would you prefer – a requirement to provide an adequate reason for the request or the payment of an additional fee?

Q5(c): Do you think the availability of an accelerated processing option under the PCT would stop applicants from filing parallel national applications in addition to their PCT applications?

6. Deferred search in the international phase

The idea of delaying the international search until after international publication has been put forward by Japan, Korea and the USA. We have reservations about deferring the search because we think it is important that third parties are able to see the search report for a published application in order to assess the likely scope of the any resultant patent. That said, our consultations so far have indicated that our users would not be averse to having the search after publication, as long as there could be a guarantee that the search report would be available by a certain date within a short time of publication.

If there is strong support by other States for deferring the search, we would prefer that this was implemented as one option in the ‘three track system’ proposed by Korea. We do not think that deferred search should be the default option, as has been proposed by Japan and the USA.

Q6(a): What do you think about the idea of delaying the international search until after publication?

Q6(b): How important is it for the international search report to be available in time for international publication (i) from the point of view of third parties and (ii) from the point of view of the applicant?

Q6(c): Would you make use of an option to defer search until after publication?

7. Improved procedures for correction of errors made by the RO or the IB

Under the current PCT Regulations, rule 82ter allows the applicant to request correction of an error made by the RO or the IB where the international filing date is incorrect or a priority claim has been erroneously considered void. Under this rule, an applicant must wait until their application enters the national phase and then pursue the request before each designated or elected office individually. This provides a considerable period of uncertainty and causes the applicant to have to deal with varying national practices and procedures at a number of different offices in order to correct an error that was not their fault.

We therefore suggest amending rules 20 and 26bis of the PCT Regulations to allow such errors to be corrected before the RO or the IB (whichever made the error) during the international phase. Draft amendments to the Regulations are included in Annex 1. The suggested amendments would give the applicant a short period of time (two months) in which to prove to the satisfaction of the RO or the IB that an error had been made. If the RO or the IB was satisfied that it made an error, it would have a month to rectify the error and the application would proceed as if the error had not been made.

The suggested amendments include a review clause, similar to that in rule 49ter(d) in relation to restoration of priority, which would allow designated or elected Offices to review a decision made by the RO or the IB under rule 20 or 26bis, but only if they reasonably doubt that the decision was correct.

The advantage of this idea is that, in cases where the error is quickly noticed, the applicant need only follow a single procedure with a single office rather than having to go to each designated or elected Office individually.

The procedure under rule 82ter would remain in place so that, if the error is not identified in sufficient time, the applicant still has the option of correcting the error in the national phase.

Q7: Do you have any comments on the draft amendments to the Regulations in Annex 1?

8. Accelerated processing option in the national phase for applications with a positive IPRP

The WIPO roadmap proposes offering incentives in the national phase for international applications having a positive IPRP. Our consultations so far have suggested that fee reductions in the UK national phase would not offer much of an incentive since UK fees are already comparatively low. As an alternative, we could offer the option of accelerated processing for applications entering the UK national phase with a positive IPRP. A request for accelerated processing would have to be made in writing specifying that the application has a positive IPRP. No further reasons would be required.

Given that an application having a positive IPRP would be likely to be already in order, or close to being in order for grant, the applicant would be able to get a very quick grant in the UK national phase.

We would also like to encourage other States to put similar incentives in place in the national phase.

Q8(a): What do you think of the idea of introducing an accelerated processing option in the UK national phase for international applications having a positive IPRP?

Q8(b): Would the option of accelerated processing in the national phase provide an incentive to get the application in order in the international phase?

Q8(c): Is there any place for using fee reductions in the national phase (UK or otherwise) to provide an incentive to get a positive IPRP in the international phase?

Summary

The above ideas set out our view of how PCT reform should progress. Before taking our ideas forward in the international arena, we want to make sure that they properly reflect the views of our users. Your responses to the above questions are therefore very important to us. We would also welcome any general comments you may have on the ideas as well as any other suggestions you may have for improving the PCT system.

Q9: Do you have any other comments on our ideas?

Q10: Do you have any other suggestions for improving the PCT system?

Responding to the Consultation

Please email your responses, including any answers to the above questions and any other views you may have, to: consultation@ipo.gov.uk. Alternatively, please use the following postal address:

Hazel Craven
Intellectual Property Office
Concept House
Cardiff Road
Newport NP10 8QQ

Tel: 01633 814083
Fax: 01633 814491

Please let us have your comments by **21 September 2009**.

Responses are welcomed from any individual, organisation or company. Copies of this document have been sent to the individuals and organisations listed in Annex 2. The document is also available on the Intellectual Property Office website at <http://www.ipo.gov.uk/consult-live.htm>.

Openness/Confidentiality

This is a public consultation, the results or conclusions of which may be published. As such, your response may be made public. If you do not want all or part of your response or name made public, please state this clearly in your response. Any confidentiality disclaimer that may be generated by your organisation's IT system or included as a general statement in your fax cover sheet will be taken to apply only to information in your response for which confidentiality has been requested.

Information provided in response to this consultation, including personal information, may be subject to publication or disclosure in accordance with the access to information regimes (these are primarily the Freedom of Information Act 2000 (FOIA), the Data Protection Act 1998 (DPA) and the Environmental Information Regulations 2004). If you want other information that you request to be treated as confidential, please be aware that, under the FOIA, there is a statutory Code of Practice with which public authorities must comply and which deals, amongst other things, with obligations of confidence.

In view of this, it would be helpful if you could explain to us why you regard the information you have provided as confidential. If we receive a request for disclosure of the information we will take full account of your explanation, but we cannot give an assurance that confidentiality can be maintained in all circumstances. The Intellectual Property Office will process your personal data in accordance with the DPA and in the majority of circumstances this will mean that your personal data will not be disclosed to third parties.

Annex 1

Suggested amendments to PCT Rules 20 and 26bis

Additional text is shown underlined and deleted text is shown in strike-through.

Rule 20 International Filing Date

20.2 *Positive Determination under Article 11(1)*

(a) If the receiving Office determines that, at the time of receipt of the papers purporting to be an international application, the requirements of Article 11(1) were fulfilled, the receiving Office shall accord as the international filing date the date of receipt of the international application.

(b) The receiving Office shall stamp the request of the international application which it has accorded an international filing date as prescribed by the Administrative Instructions. The copy whose request has been so stamped shall be the record copy of the international application.

(c) The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

(d) If it appears to the applicant that the international filing date is incorrect due to an error made by the receiving Office, the applicant may request that the error be rectified. Such a request shall include any relevant evidence and shall be made before the receiving Office within two months of the date of receipt of the international application by the receiving Office.

(e) If the receiving Office is satisfied that the international filing date is incorrect due to an error made by the receiving Office, it shall rectify the error within one month of receiving the request referred to in paragraph (d) and shall treat the international application as if it had been accorded the rectified international filing date.

(f) A designated or elected Office shall not review a decision of the receiving Office under paragraph (e) unless it may reasonably doubt that the receiving Office was correct to rectify the error, in which case the designated Office shall notify the applicant accordingly, indicating the reasons for that doubt and giving the applicant an opportunity to make observations within a reasonable time limit.

(g) If on [date provisions come into force] paragraphs (d)-(f) are not compatible with the national law applied by the designated or elected Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [date]. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 26bis
Correction or Addition of Priority Claim

26bis.2 Defects in Priority Claims

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds in relation to a priority claim:

- (i) that the international application has an international filing date which is later than the date on which the priority period expired and that a request for restoration of the right of priority under Rule 26bis.3 has not been submitted;
- (ii) that the priority claim does not comply with the requirements of Rule 4.10; or
- (iii) that any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document;

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim. In the case referred to in item (i), where the international filing date is within two months from the date on which the priority period expired, the receiving Office or the International Bureau, as the case may be, shall also notify the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26bis.3, unless the receiving Office has notified the International Bureau under Rule 26bis.3(j) of the incompatibility of Rule 26bis.3(a) to (i) with the national law applied by that Office.

(b) If the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim, that priority claim shall, subject to paragraph (c), for the purposes of the procedure under the Treaty, be considered not to have been made (“considered void”) and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly. Any notice correcting the priority claim which is received before the receiving Office or the International Bureau, as the case may be, so declares and not later than one month after the expiration of that time limit shall be considered to have been received before the expiration of that time limit.

(c) A priority claim shall not be considered void only because:

- (i) the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing;
- (ii) an indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document; or
- (iii) the international application has an international filing date which is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date.

(d) Where the receiving Office or the International Bureau has made a

declaration under paragraph (b) or where the priority claim has not been considered void only because paragraph (c) applies, the International Bureau shall publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Such information shall be included in the communication under Article 20 where the international application is not published by virtue of Article 64(3).

(e) If it appears to the applicant that a priority claim has been erroneously considered void by the receiving Office or the International Bureau, the applicant may request that the error be rectified. Such a request shall include any relevant evidence and shall be made before the Office which the applicant believes to have made the error within two months of the date of receipt of the international application by the receiving Office.

(f) If the receiving Office or the International Bureau, whichever has received the request under paragraph (e), is satisfied that the priority claim has been erroneously considered void, it shall rectify the error within one month of receiving the request referred to in paragraph (e) and shall treat the international application as if the priority claim had not been considered void.

(g) A designated or elected Office shall not review a decision of the receiving Office or the International Bureau under paragraph (f) unless it may reasonably doubt that the receiving Office or the International Bureau was correct to rectify the error, in which case the designated Office shall notify the applicant accordingly, indicating the reasons for the doubt and giving the applicant an opportunity to make observations within a reasonable time limit.

(h) If on [date provisions come into force] paragraphs (e)-(g) are not compatible with the national law applied by the designated or elected Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [date]. The information received shall be promptly published by the International Bureau in the Gazette.

(ej) Where the applicant wishes to correct or add a priority claim but the time limit under Rule 26*bis*.1 has expired, the applicant may, prior to the expiration of 30 months from the priority date and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, request the International Bureau to publish information concerning the matter, and the International Bureau shall promptly publish such information.

Annex 2

The following is a list of organisations and individuals to whom a copy of this consultation has been sent. The document is also available on the Intellectual Property Office website at <http://www.ipo.gov.uk/consult-live.htm>.

Sophie Broster-James, BIA
John Brown, CIPA
Roger Burt, IP Federation
Trevor Cooke, AIPPI UK
Liz Dawson, FICPI UK
Sara Draper, CBI
Sheila Draper, IP Federation
Tim Frain, Nokia
Robert Franks, Franks & Co
Richard Gallafent, ideas21
Philip Graham, AURIL
James Hayles, ABPI
Dan Hermele, Qualcomm
Jane Hollywood, BIA
Tim Jackson, CIPA
Jacqueline Jones, IPAG
Sophie Miller, ABPI
Neil Mockett, ideas21
Alastair Neill, FICPI UK
Linda Oakley, ideas21
Hannah Peachey, CBI
Michael Ralph, CIPA
Simon Rees, FICPI UK
Gwilym Roberts, CIPA
Alan Senior, FICPI UK
Andrew Serjeant, CIPA
Mark Sheahan, Institute of Patentee and Inventors
Gill Smith, IP Federation
Natascha Smith, ABPI
Kerry Tomlinson, AIPPI UK
Justin Watts, AIPPI UK
George Whitten, Qualcomm
Andrew Wilson, ICC