

PCT Improper Applicant Issues

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Copied below is an email I sent to Michael Richardson, a Deputy Director, at WIPO, in response to issues raised on the Oppedahl PCT email list service and subsequently addressed by WIPO in their August 2013 issue of PCT Newsletter available at:
<http://www.wipo.int/pct/en/newslett/index.html>

Michael -

The PCT newsletter addresses a situation that was recently posted on an Oppedahl list service. I refer to the PCT newsletter advice at:

http://www.wipo.int/pct/en/newslett/2013/article_0009.html

SUMMARY

In summary, this advisory indicates that failure to name the an applicant entitled to file a PCT application is likely to result on loss of the original PCT filing date. That result is draconian since it likely effects loss of substantive patent rights. Such results are contrary to the intent of PCT; and they are a couple decades out of sync with corresponding US law. See 35 USC 111(a)(4) ("The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office."; amended in 1982). The U.S., today, would not sign a treaty that required compliance with formalities before granting a filing date. You should take whatever steps are feasible to avoid the noted draconian results.

DETAILS

The PCT newsletter's answer to the question indicates that PCT accorded filing date of a PCT application that did not name "one applicant who, at the time of filing, is a national and/or resident of a PCT Contracting State" is "the date on which any correction is received by the receiving Office, and not necessarily the date of receipt of the application (see PCT Rule 20.3(b)(I))."

The relevant PCT rule provision is 20.3(b)(I):

(b) Where, following an invitation under paragraph (a) or otherwise: (I) the applicant furnishes to the receiving Office the required correction under Article 11(2) after the date of receipt of the purported international application but on a later date falling within the applicable time limit under Rule 20.7, the receiving Office shall accord that later date as the international filing date and proceed as provided in Rule 20.2(b) and (c);

The relevant PCT article provision is 11(2)(a): " (2)(a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction."

Hence, failure to name the an applicant entitled to file a PCT application is likely to result on loss of the original PCT filing date.

This result could be avoided via a change to rule 20.3(b) and a RO construction of Article 11(2)(a). The rule could be changed to allow an RO to accord the PCT filing date of the receipt of the inventive disclosure parts (specification, figures, claims, drawings, abstract); the article 11(2)(a) could be construed by the ROs so that the RO would not "find[]" that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1)," but still issue a notice requiring correction. I think it is within the discretion of the RO to not "find" an 11(2)(a) defect and allowing the PCT application to proceed with its original filing date if the applicant responds to the notice providing a correction naming a qualifying PCT applicant.

While revision of Article 11(2)(a) is the obvious action resolve this problem, I understand that is politically nearly impossible.

cc: AIPLA PCT issues committee chair (Jay and Brooke)

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