

Updates to the PCT Rules

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I. Introduction

Copied in below are my notes from the WIPO webinar conducted June 28, 2016, providing the latest updates on PCT rules.

II. Notes

II.A. Summary

1. Languages of submission using ePCT (allowing use of language of publication, in addition to English and French)
2. Expansion of rule 82Quarter (re force majeure events)
3. Rule 9 (disparaging statements and public moral based intervention in applications)
4. Rules 48 and 94 (allowing applicants to redact inadvertent sensitive information inclusion or limit patentscope public availability)
5. Rule 26bis3 (RO request for restoration of priority; communication of documents from ROs to IB)

II.B. Details

1. Example: ePCT Article 19 amendments require cover letter, and claims and may include a statement. Cover letter may be in submission language, in addition to English or French). ePCT will continue to communicate in only English or French. Only applies to ePCT submissions.

2. 82quarter(1) - Not applicable to priority date and national stage entry dates. New ground added to allow forgiveness of other dates, called "general unavailability of electronic communication services". - Widespread geographical area outage, unforeseen, and no reasonable filing alternative. Example, regional power outage.

3. Rule 9.2

4. Rule 48 (international publication and public availability) - Non publication - Applies to the description.

Rule 94 (file held by IB) - Prevent public access - Applies to a 92Bis request.

Examples:

irrelevant information improperly in application

social security number

private address information

personal medical information
improvident references to other attorney clients

5. Rule 26bis3, restoration. RO should forward all documents including evidence in support of a request to restore priority. IB will make it available on patentscope and to designated offices. Will avoid applicant having to resubmit to designated offices. Exception: ROs should not forward in case the information fails a triparte test: relevance, harm to party, prevailing interest for access by general public.

*** Generally applicable to applications filed on or after 7/2016

II.C. Response to questions. - Some evidence in support of a power outage will be required for excusal for missing a deadline.

Rule 4.17 declaration correction - Correction under rule 26Ter, time limit is completion of preparations for publication (at least 16 months from priority date)

Address information - Name of inventor, with corporate address preceded preferably by "care of."

If inventor applicant changes corporations, then former corporate address is inappropriate. Change may be but need not be requested. No office will check address information.

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