

QUESTION 89 A

Requirements and time deadlines for filing patent applications

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Requirements and Time Deadlines for Filing Patent Applications

Report of the Working Committee of AIPPI

The Working Committee of AIPPI on Question 89A (the Committee) considered three main topics falling within the scope of this broad subject.

- I. Requirements necessary to establish a filing date.
- II. Procedures for correcting deficiencies in meeting requirements for establishing a filing date.
- III. Procedures for correcting deficiencies in meeting certain other requirements which may be deemed necessary to complete or perfect an application.

The Committee also discussed the requirements for establishing a filing date for an application in one country based upon the priority of an application previously filed in another country.

The Committee decided not to include the topic of "Procedures and Time deadlines for Making a Priority Claim".

The first two topics were already considered at previous meetings of WIPO Committees of Experts (WIPO document HL/CE/II/2) with an aim toward the development of acceptable standard practices for inclusion in an international treaty. The Committee decided to consider these topics not only for the purpose of defining such standard practices which may be acceptable for inclusion in a treaty at this time, but also for the purpose of defining more liberal practices, some of which are now being adopted in certain countries, which would be preferred by the members of AIPPI, and which AIPPI should encourage for adoption by all countries.

With respect to the first topic, "Requirements Necessary to Establish a Filing Date," the Committee recommended that the "maximum requirements" embodied in an international treaty be limited to seven requirements and that these seven requirements be divided into three basic and compulsory (minimum) requirements and four additional optional requirements, as follows:

(1) Basic and Compulsory Requirements for Establishing a Filing Date:

- (i) an express or implicit indication that protection for an invention is sought.
- (ii) an indication permitting an identification of the applicant.
- (iii) a part which, on the face of it, appears to be a disclosure (description) of the invention.

(2) Additional, Optional Requirements for Establishing a Filing Date:

- (i) a part which, on the face of it, appears to be a claim or claims.
- (ii) that the application be filed in a certain language or in one of certain languages
- (iii) that the applicant does not lack, for reasons of residence or nationality, the right to file the application.

(iv) in the case of an international or regional application with possible effect in several states, the designation of at least one such state.

(3) No further requirements in respect of granting a filing date that are additional to or different from these seven maximum requirements should be allowed.

These seven "maximum requirements" are equivalent to those set forth and discussed at the meeting of the WIPO Committee of Experts. However, two of the requirements, namely those pertaining to the presence of a claim and the designation of a state in a regional or international application, were moved by the Committee from the compulsory list of paragraph (1) to the optional list of paragraph (2) above.

There was considerable discussion in the Committee whether it was really desirable to divide the seven maximum requirements into compulsory and optional categories. However, a consensus was reached that for purposes of promoting harmonisation it was preferable to retain the limited compulsory category in order to identify certain basic requirements that all countries must adhere to. It was also noted that some countries now have many more requirements than the seven maximum requirements listed above and that a treaty which sets forth and limits the requirements to a maximum of the seven requirements stated above would already achieve a good measure of harmonisation.

However, the Committee felt that although AIPPI should endorse all seven of these maximum requirements for inclusion in an international treaty, AIPPI should nevertheless also adopt a resolution which encourages all countries, regions or international authorities not to adopt, or to eliminate from their laws or treaties, the four optional requirements. While it was recognised that these four optional requirements may be deemed necessary to complete or perfect an application within a short period of time after the application has been filed, there appeared to be no persuasive reason why a filing date should not be granted merely because these optional requirements are not fulfilled at the moment of filing. It is hoped that, over a time, the maximum requirements could be harmonised on the basis of the three basic and compulsory requirements of (1) a request for protection (express or implied) (2) an identification of the applicant and (3) a disclosure of the invention.

With respect to the second topic "Procedure for correcting deficiencies in meeting the requirement for establishing a filing date", the Committee endorsed the following provisions already recommended by WIPO, for inclusion in an international treaty.

"(4) (a) If the industrial property office finds that the application did not at the time of receipt, fulfil the requirements for granting a filing date under the applicable national law, it shall invite the applicant to file the required correction within a time limit fixed by the industrial property office, which shall be at least one month.

(b) If the applicant complies with the invitation, the industrial property office shall grant as the filing date the date of receipt of the required correction."

Here again, even though the Committee would endorse the inclusion in an international treaty of a deficiency-correction period of at least one month after notice to the applicant, the Committee felt that AIPPI should nevertheless adopt a Resolution which encourages all countries to provide a deficiency-correction period of at least two months after notice. In this connection it was noted that since a filing date is not established until the correction is made, it is in the interest of the applicant to make the correction as rapidly as possible, and there is no necessity to make the period unduly short in order to force the applicant to make the correction in timely fashion.

With respect to the third topic, "Procedures for correcting deficiencies in meeting certain other requirements which may be deemed necessary to complete or perfect an application," the Committee identified several requirements to which these deficiency-correction procedures would be applicable as follows:

- a) Furnishing of an abstract
- b) Naming of an inventor
- c) Assignment by the inventor, where the applicant is not the inventor
- d) Authorisation of a national representative or local agent by a foreign applicant
- e) Signature by the applicant or his representative
- f) Inventor's oath or declaration
- g) The payment of all required fees.

The committee recommended that AIPPI urge WIPO to include in an international treaty a deficiency-correction procedure applicable to the above-identified requirements whereby the industrial property office will invite the applicant to make the required correction within a reasonable period of time, which shall be at least one month; and if the deficiency is not corrected within the set time limit, the industrial property office, at the request of the applicant, shall extend the time limit for an additional period of one month with or without payment of an appropriate fee for such extension.

In addition, the Committee felt that AIPPI should also adopt a Resolution which encourages all countries, regions and international offices to adopt a deficiency correction period for the above-identified requirements which is more liberal than that set forth in the suggested international treaty - namely a two-month invitation to-correct period followed by a two month extension period at the request of the applicant upon payment of an appropriate extension fee.

The adoption of such standardised deficiency-correction time periods for all the different application-perfecting requirements would be of great benefit to the users of the world's patent systems.

With respect to the granting of a filing date to an application in one country based upon a claim to the priority of a previously filed application in another country, the Committee felt that AIPPI should adopt an appropriate Resolution urging the countries, regions and international authorities to permit streamlined procedures for this purpose. The following might be an appropriate procedure:

- an identification of a patent application filed in a foreign country (which may be in a foreign language) together with a claim to the priority of such application within the priority year, followed by the deposit of a copy of such application, (together with a translation into a prescribed local language) within a time limit of not less than 13 months from the priority date.

No discussion was held within the Committee as to the details of such an alternative procedure for the granting of a filing date.

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