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DIPLOMATIC CONFERENCE FOR THE ADOPTION OF THE PATENT LAW TREATY

Geneva, May 11 to June 2, 2000

ARTICLE 5(5)

Proposal by Argentina, Brazil, Colombia, Cuba, Uruguay and Venezuela

The Delegations of Argentina, Brazil, Colombia, Cuba, Uruguay and Venezuela make the following comments and propose the following amendments.

1. Comments:

In paragraph (5) of Article 5 it is provided that where, in establishing the filing date, the Office finds that a part of the description APPEARS to be missing from the application, or that the application refers to a drawing which appears to be missing from the application, the Office shall promptly notify the applicant accordingly.

The countries sponsoring this proposal consider that the wording of paragraph (5) of Article 5 is inconsistent with paragraph (1)(a)(iii) of the same Article, in view of the fact that, while in the latter it is provided that the application requires “a part which on the face of it appears to be a description,” paragraph (5) prescribes — the Article is not optional — that the Office shall examine the description of the application in order to ascertain whether part of the description is missing from the application itself, with a view to notifying the applicant if that is the case.

Moreover, analysis of the requirements specified in paragraphs (1) and (2) is a merely administrative task, but if on the other hand it is necessary to determine whether part of the

description is missing, it becomes a task to be carried out by an expert specialized in the subject matter concerned. It is therefore considered that this subverts the universally accepted patent procedure whereby analysis of the description is done superficially in the course of the preliminary examination — for the purposes of the publication of the application — and in depth only at the time of substantive examination.

Under some national legislation, for the assignment of a filing date to an application, not only is analysis of the description dispensed with, but the description is accepted even where it does not meet all the requirements of form laid down in the patent law. At the time of the substantive examination the description is analyzed, and if it proves to be so incomplete that it is not possible to understand the invention, the application is rejected. Now, if this PLT provision is accepted, the applicant whose application has been rejected in the course of the substantive examination on account of the description being incomplete could contest the rejection and put forward the argument that the Office failed to warn him in good time — which it has to do — that the description was incomplete. As a result the provision, far from streamlining prosecution, is in fact a potential source of conflict and creates an element of legal insecurity.

The countries sponsoring this proposal understand that the applicant's obligation is to disclose the invention completely at the time of the filing of the application. That disclosure forms part of the specification. It is from the disclosure that the positive elements should emerge which enable the Office to understand the invention and establish that it possesses novelty, involves an inventive step and is industrially applicable. In the interest of the applicant, and to spare him administrative obstacles to the assignment of a filing date, he is allowed to file the description even if it does not yet meet all the requirements (which is what the PLT provides), but it is not acceptable from the point of view of legal security that it should be the Office that determines at the outset whether the description of the application is complete, as it is to be hoped that the applicant will prosecute his application conscientiously and responsibly.

While the explanatory notes drawn up by the International Bureau on this provision make it clear that the paragraph in question does not oblige the Office to check, when establishing the filing date, whether part of the description or a drawing is missing, that conclusion does not follow from the non-optional character of the Article.

2. Proposal for Article 5(5):

In view of the foregoing, it is proposed that paragraph (5) of Article 5 be made optional and worded as follows:

“(5) [Notification Concerning Missing Part of Description or Drawing] Where, in establishing the filing date, the Office finds that a part of the description appears to be missing from the application, or that the application refers to a drawing which appears to be missing from the application, the Office shall promptly notify the applicant ~~may~~ provide that the applicant shall be promptly notified accordingly.”

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