

# WIPO



**PCT/A/VII/12**  
**ORIGINAL:** English  
**DATE:** June 18, 1981

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION**  
**(PCT UNION)**

**ASSEMBLY**

**Seventh Session (5<sup>th</sup> Extraordinary)\***  
**Geneva, June 29 to July 3, 1981**

**PROPOSALS FROM ORGANIZATIONS REPRESENTING PCT USERS FOR FURTHER  
IMPROVEMENTS IN THE PCT SYSTEM**

*Memorandum prepared by the International Bureau*

1. The Assembly will have before it at its present session at least two proposals dealing with questions related to the possible making of further improvements to the PCT system in the future (see documents PCT/A/VII/4 and PCT/A/VII/11).
2. The present document contains, in its Annex, several letters containing proposals for changes in the Treaty and/or its Regulations received by the Director General from national organizations representing interested circles. These proposals are brought to the notice of the Assembly so that it may be aware of the views of at least some of the users of the PCT if it makes decisions affecting the future revision of the Treaty and/or its Regulations.
3. The contents of the Annex are as follows:
  - (a) Letter from Svenska Industrier Patentingenjörers Förening (SIPF) (Association of Patent Attorneys in Swedish Industry), dated April 6, 1981 (Annex, pages 1 and 2)

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\* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at [pct.legal@wipo.int](mailto:pct.legal@wipo.int)

- (b) Letter from Svenska Patentombudsföreningen (SPOF) (Association of Swedish Patent Attorneys), dated April 13, 1981, enclosing a document entitled “Suggestions for improving PCT.” (Annex, pages 3 and 4)
  
- (c) Letter from Danks Forening For Industries Patentingeniører (DIP) (Association of Danish Industrial Property Executives), dated April 23, 1981 (Annex, page 5)
  
- (d) Letter from The Chartered Institute of Patent Agents, London, dated June 9, 1981, enclosing documents entitled
  - (i) “Proposals for further improvements to PCT” (Annex, pages 6 and 7),  
and
  - (ii) “Comments on the letter dated 6 April 1981 to WIPO from Svenska Industries Patentingenjörers Förening” (Annex, pages 8 and 9).

[Annex follows]

Dr. Arpad Bogisch  
 Director General of WIPO  
 34, Chemin des Colombettes  
 1211 GENEVE 20 SCHWEIZ

1981-04-06

where it is uncertain which authority should be the receiver of a specific document. If a relevant document is sent to a wrong authority the applicant can lose his rights.

It would be greatly advantageous to the PCT system if the applicant would be allowed to send all documents and other communications to one and the same authority, preferably his Receiving Office. This Office could then act as a "letter box" for the competent authority, and within a specified time limit transfer the communications. The applicant should be considered as having fulfilled his obligations towards the PCT system if the communications had been received by the Receiving Office within the prescribed time, c.f. the amended Rule 17.1 (d).

Dear Dr. Bogisch,

During the fifth session (3rd extraordinary) in Geneva 1980, of the Assembly of the International Patent Cooperation Union many important decisions were taken in order to improve the PCT system. The amendments of the PCT Regulations and the PCT Administrative Instructions and particularly the willingness of the Assembly to rationalize the PCT system have certainly encouraged the users. It was encouraging to see the efforts laid down by the International Bureau in order to point out and break down the various national requirements for entering the national phase which have made the PCT system so difficult to handle from a practical point of view. In the same way the efforts of the International Bureau to encourage more countries to become parties to the PCT, especially those States being party to the European Patent Convention but not yet being party to the PCT, have been much appreciated.

Unfortunately we have not yet become aware of any results of these efforts made by the International Bureau but we strongly support and hope that the Bureau will continue its efforts and that the Governments involved will start the harmonization procedure.

Although the amendments of June 1980 referred to above have made the PCT system easier to handle, there are still many requirements which make the PCT system discouraging. There is accordingly a further need for improvements of the PCT system, and it can be questioned if not the PCT system needs a revision in order to make it more attractive to the users.

Our organization is interested in seeing the PCT system becoming more advantageous and we therefore wish to make the following comments and suggestions:

1. During the international phase the applicant often finds himself involved in correspondence with several authorities at the same time, i.e. RO, ISA, IPEA and IB. This creates situations

2. Within the PCT system situations may sometimes arise where the application is considered withdrawn without any fault from the applicant, but due to mistakes made by a PCT authority. This has no doubt discouraged many potential users from practicing the PCT system.

The most widely known example is Article 12.3. If the Receiving Office fails to send the record copy to the International Bureau within the prescribed time limit the application is considered withdrawn.

The Assembly has improved the situation by prolonging the time limit for the record copy to reach the International Bureau from 14 to 15 months from priority date. However, the principle as such remains and Article 12.3 consequently has to be amended.

Another type of situations which might lead to loss of rights is not an actual breaking of a certain article or rule, but instead depending on a PCT authority giving the applicant wrong information.

In at least one case an international patent application has been considered withdrawn as not filed in due time in the national phase when the applicant had been given the wrong term for this from an international authority.

The knowledge of such consequences certainly does not encourage potential users of the PCT system. This could be cured if all PCT authorities would be prepared to declare that: where a PCT authority has committed an error during the processing of an international application this should not affect the rights of the applicant. That authority and any other PCT authority and the designated and elected Offices should in such cases apply to the international application, in the same manner as to national applications, whatever remedies exist for the applicant under the national law or practice applicable before such authority or Office. We refer to document PCT/A/V/10, which has not been discussed by the Assembly, but is of real importance to the users.

3. Although it might be early to draw any conclusions concerning the effect the International Search will have when the international application has entered the national phase, it seems as

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if many national examiners make a new search. Naturally a search by a new examiner reveals new prior art. It is not likely, however, that the new prior art always is better prior art. Most probably the new prior art only further elucidates the state of the art without affecting the inventive step of the invention. If all designated Offices should cite prior art of the type now discussed the applicant would find himself faced with a completely conventional national prosecution when he had left the international phase behind him. Under such circumstances all applicants must ask themselves if the costs and work laid down in the international phase have resulted in the expected advantages.

Nevertheless, it must be all examiners duty to cite documents they find relevant as prior art. This is certainly of importance both for the applicant and third parties. However, in order to avoid re-opening of the search procedure but still give the Examiner the opportunity to cite new documents, such new citations found in the national search could be classified as e.g. "document as relevant as those cited in the International Search Report". Such documents should not need to be commented upon in a response.

The above should in no way be interpreted as said in the sense of making the Examiners hesitant to cite documents which they consider more pertinent than the documents cited in the International Search Report.

4. It shall also be remembered that the international application, when entering the national phase, already has been subjected to a search according to the minimum documentation of PCT. It would then be expected that the prosecution in the national phases would be faster than for a normal national application. This would certainly encourage the use of the PCT system.

5. Uniform filing formalities and thereby reduced costs for the applicant, both with respect to his own internal work with the PCT applications as well as to the work of his foreign agents, was intended to be one concept of the PCT system.

Unfortunately, the PCT route at present, seems to be more expensive and time consuming when compared with normal national filings. This depends partly on the above discussed national requirements, which the International Bureau already has pointed out to the various national Patent Offices. There are also other national requirements which complicate the entering of the national phase and which cause the applicants further costs which are not encountered in the filing of national patent applications.

The following amendments would save the applicant and his agents time and costs and uniform the prosecution:

- 5.1. Some countries require a translation of the "international application as filed", which includes the request. If the request form was provided with the INID numbers

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for the various data, in the same manner as in the pamphlet, and designated countries were given by ICIREPAT country codes, the need for a translation seems to be superfluous. The title would not have to be translated, as this is the first part of the description, Rule 5.1 (a).

- 5.2. Some countries require a designation of inventor at entering the national phase. If the designation part of the request form was amended to include information necessary for all countries requiring a designation of inventor, there should be no need for the applicant or his agent to prepare new documents when entering the national phase. Today only Austria and Switzerland (partly) accept the designation of inventor already made in the international application
- 5.3. Rule 46.3 prescribes that amendments according to Article 19 shall be both in the language in which the international application has been filed and in that in which it is published.

It should suffice if such amendments were submitted in the language of publication. This should also apply to Rule 70.17 (b).

- 5.4. According to Rule 53.1 (d) the demand should be filed in two identical copies. As all other documents should be filed in one copy, Rule 11.1 (a), it seems reasonable that the demand also should be filed in one copy only.

We hope that your Organization will take due note of our suggestions and comments and pass relevant matter to the Assembly of the PCT Union.

Yours sincerely,

Association of Patent Attorneys in Swedish Industry

*Bengt Ohman*  
Bengt Ohman  
President

c/o ASEA AB  
721 83 Västerås  
Sweden

Dr. Arpad Bogisch  
Director General of WIPO  
34, Chemin des Colombettes  
1211 GENEVE 20  
Schweiz

Suggestions for improving PCT

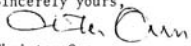
Your Ref: Our Ref: Date:  
CO/ER April 13, 1981

Dear Mr. Bogisch,

I may be wrong when regarding the Swedish profession to be pioneers in using PCT, but I think you will agree in my view that the profession here had more knowledge and enthusiasm about the system already from the beginning than our colleagues in most other countries.

With the experience we now have it is only natural that we have noticed matters that could be improved. A committee of our association has made a special study in this respect. I enclose a copy of their report, in a hope that you will take some initiatives in a PCT-improving direction.

Sincerely yours,

  
Christer Onn  
President

Encl.

The PCT system has now been in use for nigh on three years. As a patent attorney organization representing one of the contracting states which actually makes use of the PCT system, we regret to say that the PCT system so far seems not to have been as successful as it deserves, especially not when compared with the European Patent Convention which was implemented during the same time. We have established that there is a certain competition between the two systems, which we find confusing. The two systems complete one another rather than compete. By first filing an international patent application designating a regional patent for the European Patent Convention countries and other PCT contracting states the PCT applicant will enjoy maximum time benefits when entering the national procedure before the designated/elected offices. We are convinced that the PCT applicants would enjoy even greater advantages if many more states would accede to the Patent Cooperation Treaty, particularly the two EPC states Belgium and Italy.

A questionnaire has further shown that in spite of the improvements introduced many still are of the opinion that the system is too complicated. A recurrent example is that one has to work with several authorities simultaneously. Moreover, an application is lost too easily and the fact that an application is considered withdrawn if an error is committed by an authority, is wholly unacceptable. The not insignificant cost is conceived by many as a great problem since it is difficult to adduce weighty reasons for it. The additional respite obtainable by the system, of course, is valuable but what would primarily warrant the filing of an international application, viz. the simple and less expensive national prosecution, has in some cases not been forthcoming at all. It is fully understandable that one hesitates to make use of the system when noticing over and over again that the national phase of a PCT application does not in any way differ from the prosecution of an ordinary national application. This is highly regrettable and obstructs the entire PCT idea.

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During the fifth session of the PCT Assembly in Geneva 1980, many important decisions were taken, which really improved the PCT System. The willingness of the Assembly and the International Bureau to improve the system has encouraged us to forward to the International Bureau the following observations and suggestions which we hope will contribute towards the PCT system being more widely exploited around the world.

#### Proposed amendments of articles and rules

1a. The risk that an international application shall be forfeited (considered withdrawn) through no fault of the applicant himself, has to be eliminated and to this end Art. 12.3 should be revised and a provision introduced or, alternatively, a declaration issued, establishing that an applicant shall suffer no loss of right because of an error committed by an authority.

1b. The possibilities of reinstating, against payment of the prescribed fee, an international application which has been dismissed as withdrawn, should be improved upon such that they are applicable to all of the cases where the applicant has failed to satisfy the claims of an authority, e.g. by failure to reply to an Official letter pursuant to Art. 14. (1) or by failure to assign a title to the application pursuant to Art. 14.1 (a)(iii) and Rule 37.

2. The procedure as now adopted that the applicant during the international phase has to send documents now to one authority now to the other authority should be altered such that the applicant need be in touch only with his local receiving office which records and then forwards the documents to the competent authority. A series of articles and rules will be affected by such an alteration, e.g. Art. 19, 31.6 (a) and (b).

#### Desired revisions of the prosecution of an application in the national phase

There prevails in practice a considerable uncertainty regarding the documents to be filed in the individual state at the prosecution of a PCT application. We have learnt that the International Bureau is compiling a catalogue of the various wishes of the states, which of course has our full support, and we hope that the initiation of the national phase will be as simple as possible and that no state will require a greater number of documents than that indicated in Art. 22. At present, some states require a certified translation of the certified copy of the basic application, which we consider unnecessary. In this context, we should also like to emphasize that if a state requests a copy of a document which is part of the Record Copy, such a request should be directed to the International Office and not to the applicant.

The most important alteration of the national prosecution applies to the prosecution carried out in the Patent Offices

of the designated states. In our opinion, there exists no reason whatsoever to subject the applications to a double examination - the purpose of PCT is in fact to dispense with such a double examination. The examination effected by ISA should be approved and a complementary examination carried out in exceptional cases only. If the national prosecution is confined to a formal check and patentability assessment, respectively, in the event that one has not committed oneself to phase II, it will be possible to make rationalization profits which may be enjoyed by both Patent Offices and applicants and - last but not least - tenable reasons for the costs of an international application may be adduced.

Association of Swedish Patent Attorneys

# DIP

DANSK FORENING FOR  
INDUSTRIENS PATENTINGENØRER

ASSOCIATION OF DANISH INDUSTRIAL  
PROPERTY EXECUTIVES

Dato: 23rd April, 1981  
Ref: Ry/jm/9.05  
Svar til:

DIP - P.O. BOX 98 - DK-2750 HALLERUP

Dr. Arpad Bogsch  
Director General of WIPO  
34, Chemin des Colombettes  
CH-1211 Geneve 20  
SCHWEIZ

Dear Dr. Bogsch,

From SIFP (Association of Patent Attorneys in Swedish Industry) we have received a copy of their letter dated 6th April, 1981 to you with various suggestions and comments on the PCT system aiming at making the system still more attractive to the users.

We wish to confirm that we fully agree with our Swedish colleagues in their viewpoints, and we do hope that the Assembly of the PCT Union will look favourably upon these proposals for improving the PCT system.

Yours sincerely,  
Association of Danish Industrial Property Executives (DIP)

  
P. Rydahl Kristensen  
President

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SECRETARY AND REGISTRAR  
M. C. RALPH, B.Sc.  
ASSISTANT SECRETARY

STABLE INN BUILDINGS  
HIGH HOLBORN  
LONDON, WC1V 7PZ  
TEL: 01-405 9450

9th June, 1981.

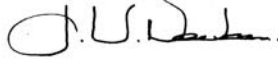
Dr. A. Bogsch,  
Director General,  
W.I.P.O.,  
34, chemin des Colombettes,  
1211 GENEVA 20.

Dear Sir,

I enclose herewith copies of two documents, the first being proposals made by the Chartered Institute of Patent Agents for further improvements to PCT, and the second containing the Chartered Institute's comments on the letter dated 6th April, 1981, to WIPO from the Svenska Industriens Patentingenjörers Forening.

It would be most helpful if both these items could be raised for consideration at the forthcoming PCT Assembly, due to be held in Geneva from 29th June, 1981.

Yours faithfully,



President.

THE CHARTERED INSTITUTE OF PATENT AGENTS

Proposals for further improvements to PCT

Time limits for entering proceedings in designated Offices

It would be desirable to establish that the applicant is never required to enter the national phase or ask that his international application be treated as a national application in any designated Office before the expiry of a uniform time limit of 20 months from the priority date (extended to 25 months for elected Offices). A shorter period can presently arise under article 22(2) or rule 51.3, where in each case the time limit for entering proceedings in designated Offices is two months from the date of a notification to the applicant. These time limits should be modified to be the same as in article 22(1).

The time limit in article 22(2), although in the Treaty and not in the Rules, may be modified by the Assembly in accordance with article 47(2) and rule 81.2. Although article 22(2) so modified would then appear to be redundant, this is no reason why the modification should not be effected. The modification would also eliminate the curious anomaly that an applicant can circumvent the two-month time limit by making an election under article 39(1).

The uniform time limit would enable the applicant to base his record and reminder systems on the priority date of his international application for determining the date of entry into the national phase, secure in the knowledge that the latter date could never be brought forward by anything that happened in the international phase.



Receiving Office

If an international application complying with article 11(1)(iii) is filed at the wrong receiving Office, rule 19 should allow it to be transferred to the correct receiving Office without loss of rights to the applicant and without payment of a further international or search fee, although he could be expected to pay a further transmittal fee to the new receiving Office and also if necessary to provide a translation of his application into the language of that receiving Office within a reasonable term (e.g. one month from the date of a notification from the original receiving Office).

Similarly, if an application is filed at the correct receiving Office but in the wrong language, the applicant should be allowed to file a translation within a reasonable term without loss of rights.

International preliminary examination

The time limits in rule 69.1 are too short to allow the applicant sufficient time under rule 66.2(d) to prepare a response in cases where experiments have to be performed. On the other hand, it is desirable that the applicant should not be obliged to enter the national phase in elected Offices until the international preliminary examination report has been established. It therefore appears to be desirable not only to lengthen the time limits in rule 69.1 but also to modify correspondingly the time limit in article 39(1). This may be effected by the Assembly under article 47(2) and rule 81.2.

Rule 73 should desirably include a paragraph along the lines of rule 47.2(c).

Rule 74.1 contains a trap for an applicant who has elected a State (such as Japan) which has made a reservation under article 64(2)(a)(i). The rule should be amended to say that any necessary translation of a replacement sheet filed or other amendment made during international preliminary examination need not be furnished to such State as an elected Office before the national fee is paid under article 39(1).

Claims

The last sentence of rule 6.4(a) should be augmented with a proviso like that in rule 5.1(a)(v), namely that where the national law of the designated State does not require that a multiple dependent claim shall not serve as a basis for any other multiple dependent claim, the fact that a multiple dependent claim serves as a basis for another multiple dependent claim shall have no effect in that State.

Comments on the letter dated 6 April 1981 to WIPO from Svenska Industriens Patentingenjörers Forening

1. We agree that it would be desirable to allow the applicant to file all documents and other communications at his PCT receiving Office, and that the subsequent transmission of the papers to the International Bureau, the International Searching Authority or the International Preliminary Examining Authority should be undertaken by the receiving Office without detriment to the applicant if any paper is delayed or goes astray. A new rule to permit this would probably have to contain the possibility of reservation by Contracting States where the receiving Office is unable to accept this responsibility, but such a reservation would be a hindrance only to applicants using that receiving Office (generally nationals of the Contracting State concerned) and would still allow this welcome simplification of PCT procedure to be effective for all other applicants.
2. We strongly support the principle that an error made by a PCT Authority in the processing of an application should not affect the rights of the applicant. We agree that Document PCT/A/V/10, submitted by the Swedish Patent Office to the PCT Assembly in June 1980 but not discussed at that time, is of real importance to applicants and ought to be duly considered by the Assembly at the earliest possible date. We believe that a new rule is needed to say that any procedural irregularity in a PCT Authority which is not the fault of the applicant shall be rectified without loss of the applicant's rights. We would also support an amendment to the PCT Treaty, when opportunity arises, so as to include a new article for "Restitutio in integrum" along the lines of article 122 in the European Patent Convention.
3. While we agree that subsequent national examination of an application should be simplified by the existence of the international search report, we do not see how any formal amendment to the PCT Treaty or Rules can bring this about. We think that WIPO and all interested parties should urge national Offices to allow a remission of national fees in recognition of the international search report, in the hope that national examiners will then be instructed not to spend time and effort in duplicating the search. In principle, the existence of an international preliminary examination report should similarly lead to a further remission of national fees for initial substantive examination; of course, if the report was unfavourable, the applicant could expect almost immediately to have to enter into national appeal proceedings against a decision to reject the application.
4. Prosecution of an international application in the national phase should be faster than normal if the national Office is required to spend less time and effort on it, and this ought to be a necessary consequence of any remission of fees in respect of the international search report and of the international preliminary examination report (if any).
- 5.1. We agree that the only translation required of the applicant under article 22(1) should be of the published pamphlet communicated to designated Offices under rule 47. We agree that if the request form were provided with the INID numbers for the various items a translation ought then to be unnecessary, particularly as rule 4.16 already requires at least the transliteration into the Latin alphabet of all names and addresses.
- 5.2. We believe that it is very desirable for the applicant to designate the inventor in the PCT request, although we do

not want this to be compulsory so as to cause him to lose the entire international application if he failed to do so. If the inventor is so designated, then we agree that this designation should be accepted by all national Offices which require a designation of inventorship. However, it is not true that only Austria and Switzerland currently accept the designation of inventorship in the PCT request as satisfying national law; the British Patent Office does so (Patents Act 1977, section 89(1)(e)) and so does the European Patent Office (Guidelines for Examination in the EPO, A-VII, 3.4 - "unless the inventor has already been named in the PCT request").

5.3. We agree that amendments submitted only in the language of publication ought to be sufficient. The necessary safeguard, that the scope of the international application in its original language can never be exceeded, is provided by article 46.

5.4. We agree that it seems reasonable to require only a single copy of the demand to be filed. This would be transmitted to and retained by the International Bureau, because it is the International Bureau and not the International Preliminary Examining Authority which has the task under article 36(3) of communicating the international preliminary examination report to elected Offices. If an International Preliminary Examining Authority really needs its own copy of the demand, it could photocopy the original rather than retain the presently required duplicate under rule 61.1(a).

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and of document]