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UNITED INTERNATIONAL BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY

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PATENT COOPERATION TREATY

INTERIM ADVISORY COMMITTEE FOR ADMINISTRATIVE QUESTIONS

Second Session: Geneva, December 6 to 8, 1971

REPORT

INTRODUCTION

1. The "Interim Advisory Committee for Administrative Questions" (hereinafter referred to as "the Interim Committee") set up by the Assembly and the Executive Committee of the International Union for the Protection of Industrial Property (hereinafter referred to as "the Paris Union") in September 1970, pursuant to a resolution of the Washington Diplomatic Conference of May/June 1970 which adopted the Patent Cooperation Treaty (hereinafter referred to as "the PCT"), held its second session in Geneva from December 6 to 8, 1971.

2. The 36 States which have signed, or acceded to, the PCT are the members of the Interim Committee. The following 25 were represented: Argentina, Austria, Belgium, Brazil, Canada, Denmark, Egypt, Finland, France, Germany (Federal Republic), Hungary, Italy, Japan, Luxembourg, Monaco, Netherlands, Norway, Philippines, Senegal, Soviet Union, Sweden, Switzerland, United Kingdom, United States of America, Yugoslavia. The following 11 were not represented: Algeria, Central African Republic, Holy See, Iran, Ireland, Israel, Ivory Coast, Madagascar, Romania, Syria, Togo.

3. Greece and Mexico sent observers.

4. The following four intergovernmental organizations were represented by observers: United Nations (UN),

United Nations Conference on Trade and Development (UNCTAD), International Conference for the Setting Up of a European System for the Grant of Patents, International Patent Institute (IIB).

5. The following seven non-governmental organizations were represented by observers: International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), Council of European Industrial Federations (CEIF), International Federation of Inventors Associations (IFIA), International Federation of Patent Agents (FICPI), National Association of Manufacturers (NAM), Union of European Patent Agents.

6. The number of participants was nearly 60. The list of participants is annexed to this Report.

7. The Interim Committee unanimously elected Mr. H. Mast (Germany (Federal Republic)) as Chairman, and Mr. K. Otani (Japan) and Mr. B. Niang (Senegal) as Vice-Chairmen.

8. Mr. Klaus Pfanner, Senior Counsellor, Head of the Industrial Property Division, WIPO, acted as Secretary of the Interim Committee.

AGENDA

9. The Interim Committee adopted its agenda as contained in document PCT/AAQ/II/1.

OPTIONS FOR NATIONAL LEGISLATIONS UNDER THE PATENT COOPERATION TREATY

10. Discussions were based on document PCT/AAQ/II/2 (hereinafter referred to as "the document"). References to "paragraphs," unless otherwise specified, are references to the paragraphs of the document.

11. In connection with the Introduction of the document it was remarked:

(i) that, in a country in which the PCT would not be self-executing, the national law could not be silent on any matters offering an option to the Contracting States but must expressly provide for the solution preferred;

(ii) that the option described in paragraph 14 (whose new title should be "Obliging the Applicant to Obtain Regional Patent Instead of National Patent") might also be an option exercisable in a regional treaty;

(iii) that, at least in connection with the reservation as to the effect of the international application in respect of prior art (paragraph 25.1)--an option which is open to countries whose "national law" provides certain things in respect of prior art effect which must be exercised through a declaration cum statement filed with the Director General of WIPO--"national law" may include court decisions.

12. The next edition of the document will take into account the remarks reported in the preceding paragraph.

13. In connection with Chapters I to IV of the document, the following remarks were made or suggestions were adopted.

14. Translations of International Applications. Paragraph 8.1 should also deal with Rule 49.2. The analogous provisions (Article 39(1)(a) and Rule 76.2) concerning "Phase II" of the PCT procedure should also be covered. It was noted that no national law or regional treaty could require the applicant to furnish translation in more than one language, not even of part (for example, the claims) of the international application.

15. Paragraph 8.3 should make it clear that where, because of the absence of the appropriate notification, no translation of the international application may be required--and thus the processing in the national Office will have to be based on the international application in the language in which it was filed--the national Office and the applicant will, in all other respects, use the official language of the Office.

16. Unsearched Parts of International Applications. Paragraph 9.3 should make it clear that the statement "if the national law is silent on the matter, even those parts of the international application which were not searched will not be considered withdrawn" applies only where the lack of searching of certain parts of the application is due to lack

of unity of invention and lack of compliance with the justified invitation to pay additional fees.

17. Time Limit for Furnishing Designated Office with Copy, Translation, Fee, and Data Concerning the Inventor. Paragraph 10.1 should refer also to the possibility that any designated Office may choose under Article 20(1)(a) to waive the requirement of communicating a copy of the international application and/or of the search report (or the declaration taking the place of the search report).

18. Such possibility of waiver exists in respect of the said requirement "in its entirety or in part" (Article 20(1)(a)). It was generally understood that an "in part" waiver meant waiver in respect of copies of the international applications only or copies of the search reports (or declarations) only but did not mean copies in a certain language only, or copies relating to a certain technical field only or any like differentiation among copies.

19. "Provisional Protection." Paragraph 11 should be split up into three paragraphs, each dealing separately with the three options available under Article 29(2), (3), and (4), respectively.

20. It was understood that, where the national law did not provide for provisional protection in the case of the publication of national applications, there was no obligation to provide for provisional protection in the case of the international publication of international applications.

21. Paragraph 11.3 should make it clear that if the national law provides for provisional protection in the case of the publication of national applications but the Contracting State does not exercise the option given to it by Article 29(2)--namely, that, in the case of international applications, translation into a certain language may be prescribed--provisional protection upon international publication will be governed by the same conditions as provisional protection upon national publication except that no translation may be required.

22. Time Limit for Amendments Before Designated Offices. The language of paragraph 12.1 should be slightly changed (insert a reference to Article 28(1) after the word "drawings"; replace "from the fulfillment" by "from the date on which the applicant has fulfilled"; insert "also" after "the applicant may").

23. Paragraph 12.2 should make it clear that it deals only with Contracting States in which processing and examination start without special request.

24. Obliging the Applicant to Obtain Regional Patent Instead of National Patent. This should be the title of paragraph 14.

25. Paragraph 14 should not deal also with "Phase II" aspects. They should be dealt with in that part of the document which concerns the said phase.

26. Paragraph 14.3 should be clarified and, in particular, state that it concerns only national laws of countries party to a relevant regional treaty.

27. Substantive Conditions of Patentability. Since the matters treated in paragraph 15 are not options, the next edition of the document should deal with them in a place clearly separated from the options.

28. Naming of the Inventor. In connection with paragraph 17, it was understood that, where the national law opted for requiring the naming of the inventor, absence of such naming could be a ground for rejecting the application under the national law.

29. Amendments Going Beyond the Disclosure. Paragraph 19.3 should make it clear that it applies only to amendments made under Articles 19(2), 28(2) and 41(2) within the prescribed time limits.

30. New Questions. The International Bureau should study whether Articles 24(2) and 39(3), as well as 23(2) in relation to Article 28(1), contained provisions in the nature of "legislative options" as this expression is used for the purposes of the document. If the International Bureau comes to a positive conclusion, it should deal with the said provisions in the next edition of the document.

31. Address in the Country for Receiving Notifications by the Applicant. In paragraph 23.2, the words "less great" should be replaced by "met by the appointment of such agent" and the last sentence should be deleted.

32. Reservation as to the Requirement of the International Publication of the International Application. In paragraph

24.2(ii), the words "a national application" should be replaced by "an application."

33. Reservation as to the Effect of the International Application in Respect of Prior Art. It was understood that, for the purposes of paragraph 25, "national law" may consist also of court decisions.

34. Utility Models. Rules 6.5, 13.5 and 78.3, dealing with utility models, should, in the next edition of the document, be treated as legislative options and, consequently, mentioned in that edition.

35. Reservation as to Chapter II of the PCT. It was suggested that paragraphs 27.2(ii) and (iii) should be telescoped (since the first three lines of each were identical).

36. Priority in the Case Contemplated by Article 8(2)(b). The next edition of the document should deal with the case contemplated in Article 8(2)(b) as a legislative option and should draw attention to the fact that absence of any provision on the matter in the national law could result in uncertainty as it would not be clear whether priority claims, in the situations contemplated, would be effective in the State whose national law is silent on the matter.

37. Unexamined Parts of International Application. Paragraph 28.1 should also deal with Article 34(3)(b). The observations made in connection with paragraph 16 apply, mutatis mutandis, also in respect of paragraph 28.

38. Time Limit for Amendments Before Elected Offices. The observations made in connection with paragraph 12 apply, mutatis mutandis, also in respect of paragraph 31.

39. Effect of the Withdrawal of the Demand for International Preliminary Examination or of the Election of a Given State. In the last sentence of paragraph 32.1, before the semicolon, insert "(see Article 37(4)(b))," and, at the end of the sentence, add "(a)."

40. Preservation of National Security and General Economic Interests. The observations made in connection with paragraph 15 apply also in respect of paragraph 36. It was understood that Article 27(8) could be applied by any Contracting State to its residents or nationals regardless of where the international application was filed.

41. Request Forms. It is to be noted, in connection with paragraph 37.2, that although any receiving Office may decide that it will not itself furnish request forms it may not decide that it will not itself furnish the demand forms referred to in Rule 53.1(b).

42. Number of Copies of International Application. Paragraph 38.1 should contain more explanation. So should also paragraph 38.3, which could read as follows: "In the absence of such announcement, the receiving Office will have to accept international applications filed in one copy (it will then have to prepare two more copies itself). It may accept two or three copies (but then it will have to check the identity of all copies) or it may refuse copies in excess of one or two (but then it will have to prepare itself two copies or one copy, respectively)."

43. Language of the International Application. Paragraph 39.3 should refer to the receiving Office not having "prescribed" a certain language.

44. International-Type Search on the Initiative of the National Office. Paragraph 44.2 should read: "Any Contracting State may decide to require that national applications must be subjected to an international-type search. Such decision must be made through provisions in the national law. The conditions to be provided for in the national law should provide for appropriate fees (if any) and appropriate time limits."

45. Paragraph 44.3 should be completed by the words "having the effects provided for in the Patent Cooperation Treaty."

46. International-Type Search on the Initiative of the Applicant. It should be noted that if a Contracting State decides to require that national applications must be subjected to an international-type search--i.e., exercises the option mentioned in paragraph 44--it would make no sense to exercise also the option mentioned in paragraph 45.

47. In paragraph 45.2, the words "(if any)" should be inserted after "fees."

48. New Edition of the Document. The Committee invited the International Bureau to prepare, for its next session, to be held in 1972, a new edition of the document, which should incorporate the changes suggested in the preceding paragraphs,

whereas, in all other respects, it should maintain what is in the document.

MODEL PROVISIONS FOR IMPLEMENTING THE PATENT COOPERATION TREATY, PARTICULARLY AS FAR AS THE BIRPI MODEL LAW FOR DEVELOPING COUNTRIES IS CONCERNED

49. Discussions were based on document PCT/AAQ/II/3 (hereinafter referred to as "document No. 3").

50, Task of the Interim Committee. The Interim Committee noted with approval the description of its task and the proposed procedure, as set forth in paragraphs 37 to 43 of document No. 3. In particular, it was emphasized:

(i) that the revision of the 1965 BIRPI Model Law for Developing Countries on Inventions would be accomplished according to the same procedure as had been followed for that Model Law, namely, on the basis of the views adopted by a committee consisting of experts from developing countries only,

(ii) that the Interim Committee's task was merely to give advice to the Director General on the possible suggestions he might wish to make to such a committee,

(iii) that, whatever advice was given, each developing country was nevertheless entirely free to follow or not to follow that advice and to adopt such law as, in its own sole judgment, it considered in its best interest and in conformity with its international commitments, if any.

51. Examination as to Substance. The Interim Committee suggested that the revised Model Law should not only provide for a system in which there was an examination as to substance after international or international-type search, but should also provide for alternatives in which there was no search and examination as to substance, or in which the examination as to substance was a deferred one, or in which the examination as to substance (preliminary or deferred) was preceded also by a preliminary examination by an international (universal or regional) authority, or--where there was no examination as to substance--the international or international-type search report or preliminary examination report was merely filed with, or merely published by, the national Office.

52. In connection with Section 18 of the proposed revision, it was noted that the provisions contained in paragraph (2) (iii)(including the Alternative) and (iv) needed further study and redrafting, including, in particular, a study of the question whether all or some of the matters dealt with in those provisions should not rather be treated in the Sections of the Model Law which deal with the substantive conditions of patentability.

53. In connection with paragraph 10 of document No. 3, it was noted that the national Office of Brazil contemplated carrying out international and international-type searches under the PCT for applications in the Portuguese and Spanish languages; furthermore, that the national Office of the Netherlands intended to be an International Preliminary Examining Authority under the PCT.

54. Form and Contents of National Patent Applications. The proposal "that the Model Law be harmonized with the PCT in so far as the form and contents of national patent applications are concerned" (document No. 3, paragraph 15) was unanimously endorsed by the Interim Committee. Subject to the following qualifications, the same is true in respect of Sections 12 to 17, appearing in Annex B of document No. 3:

(i) The International Bureau should study whether Section 12 should not provide that, where the competent International Searching Authority is ready to search applications in different languages, the applicant should be allowed to use the language which he prefers (presumably, in the light of those countries which he designates).

(ii) The International Bureau should study whether Section 12(2) should not provide that, where the declaration naming the inventor is signed by the applicant at the time the application is filed, a confirmation of that declaration, signed by the inventor, should be required before the patent is granted.

(iii) The question whether unity of invention is respected should not or not only be examined in the course of the examination of the application as to form (Section 17) but should be or should also be examined in the course of the examination of the substance of the application (Section 18).

55. The last sentence of paragraph 16 of document No. 3 should read as follows: "For example, a fund could be established by inventors' associations and research institutions to pay part or all of the national fees in the case of certain categories of applicants."

56. Taking Advantage of Certain Options Offered by the Patent Cooperation Treaty. In connection with this topic, it was once again emphasized that each country was entirely free to choose whatever it desired to choose whenever the PCT provided for options. Consequently, the Interim Committee suggested that the International Bureau should call to the attention of developing countries all the available options.

57. The specific recommendations contained in paragraphs 29 to 31, and the corresponding proposals for Rules contained in Annex C, of document No. 3 were endorsed by the Interim Committee subject to the following:

(i) as to the question what authority should be the receiving Office, all options under the PCT should be incorporated in the draft Rules;

(ii) non-exclusion of Chapter II should be recommended for developing countries having a system of examination as to substance. (Different views were expressed on the question of the non-exclusion of Chapter II for developing countries which do not have a system of examination as to substance.)

58. Inventors' Certificates. The International Bureau should examine the question whether the revised Model Law should deal with inventors' certificates in an appropriately adapted Annex or in the body of the Model Law itself.

FUTURE PROGRAM

59. The Interim Committee invited the Director General to place on the agenda of the next session of that Committee the examination of a revised edition of the document on "Options for National Legislations under the Patent Cooperation Treaty" and the study of questions concerning procedures in national Offices (see document PCT/AAQ/I/4, paragraphs 17 and 18). The latter subject may involve, to a certain extent, also the study of the questions concerning procedure in the International Bureau (see document PCT/AAQ/I/4, paragraphs 19 and 20).

60. The International Bureau announced that the next session of the Interim Committee was scheduled to take place at Geneva during the week beginning October 2, 1972.

61. This Report was unanimously adopted by the Interim Committee in its meeting of December 8, 1971.

[Annex follows]

ANNEXE/ANNEX

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