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**INTERNATIONAL PATENT COOPERATION UNION
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**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

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**EXCHANGE OF VIEWS ON INCREASING THE USEFULNESS OF INTERNATIONAL
PRELIMINARY EXAMINATION REPORTS FOR APPLICANTS AND ELECTED OFFICES**

Document prepared by the International Bureau

1. The Annex to this document contains comments by the United Kingdom Patent Office on the usefulness of international preliminary examination under Chapter II of the PCT to applicants, elected Offices and International Preliminary Examining Authorities.
2. These comments, which will serve as a topic for discussion at the fourth session of the Meeting of International Authorities under the PCT, are hereby provided to all International Authorities for information and comment.

[Annex follows]

ANNEX

Comments by the United Kingdom Patent Office

The UK attaches great importance to making the PCT more “user friendly” and has therefore been a strong proponent of the changes which have been introduced over the last few years to make the PCT easier for users and minimise the risk of applicants being unduly penalized when errors occur.

There can be little doubt that these changes have considerably improved the confidence of users and have contributed at least in part to the increasing use of the PCT in the United Kingdom. Indeed, until the UKPO ceased receiving demands last year, more demands were filed at the UKPO than any other Office apart from the USPTO and the EPO.

Although the IB and Contracting States can be well satisfied with what has been achieved, it is apparent that we should not rest on our laurels but, instead should look to improve the operation still further. With this in mind, the UK wishes to propose some further changes in procedure and in the Forms as set out below.

In addition to these changes, the UKPO would like to discuss what steps can be taken to maximise the usefulness of international preliminary examination (IPE) under Chapter II both to applicants and to the Offices of elected States, including of course, the IPEAs themselves. The reasons for this are as follows.

Where an application satisfies the requirements as to its form and contents under Chapter 1, the applicant can be confident that no objections will arise in these respects in the national phase, since this is expressly provided for in Article 27.

It is apparent that it is not possible to extend this concept to IPE under Chapter II. Accordingly Article 33(1) merely states that the objective of IPE is to formulate a preliminary and non-binding opinion on the question of whether the claimed invention appears to be novel (N), to involve an inventive step (IS) and to be industrial applicability (IA).

However, it is also apparent that to be of maximum use to applicants and elected Offices of elected States, the IPE report needs to go beyond this and give an opinion on other substantive examination matters which may be considered by elected Offices in the national phase. Such matters are already covered by items III (non-establishment of opinion), IV (lack of unity of invention), VII (certain defects) and VIII (certain observations).

It is apparent that until there is harmonisation of substantive patent law, different elected States will continue to have different requirements governing the grant of patents. It is therefore essential in the interests of applicants and of elected States whose Office is not the IPEA on any particular case that the international nature of IPE should not be diluted. This is of particular interest to the UK which paid particular attention to the international nature of IPE reports but has now ceased to accept demands under Chapter II in line with the Protocol on the Centralisation of the European Patent System and expects to issue its last IPE report not later than September 1995.

It is clearly not feasible for an IPEA to express an opinion on all matters which might be considered in any elected Office. However, there would appear little doubt that the current PCT Preliminary Examination Guidelines already provide an excellent framework for most needs.

Nevertheless, it is apparent from the comments and proposals by the USPTO in PCT/MIA/IV/2 that, in certain detailed respects, the current Guidelines do not meet fully the needs of the USPTO and US applicants. It may well be that there are other authorities which feel similarly that the Guidelines could be improved to take account of their particular needs and those of their applicants. Accordingly, as already stated above, the UKPO would like to discuss what steps can be taken to maximise the usefulness of the IPE to applicants and the Offices of elected States, including the IPEAs themselves.

[End of Annex and of document]