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(PCT UNION)

COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

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REFORM OF THE PCT:
PROPOSALS BY THE INTERNATIONAL FEDERATION
OF INDUSTRIAL PROPERTY ATTORNEYS (FICPI)

Document prepared by the International Bureau

1. The proposals appearing on the following pages were made by the International Federation of Industrial Property Attorneys (FICPI) in a submission to the International Bureau received on April 13, 2001. Background information appears in document PCT/R/1/2.¹

2. *The Committee is invited to consider the proposals contained in this document.*

¹ The working documents for the Committee's session are available on WIPO's web site at the following address: http://www.wipo.int/pct/en/reform/index_1.htm

INTERNATIONAL FEDERATION OF INDUSTRIAL
PROPERTY ATTORNEYS (FICPI): POSITION PAPER

FICPI has reviewed the United States proposal for reform of the Patent Cooperation Treaty (paper PCT/A/29/3) and is in general agreement with most of the reforms suggested under the heading "First Stage of Reform". FICPI endorses the objectives of simplification of the PCT system and the minimising of costs for patent applicants. FICPI also notes that with adoption of PLT there should be the possibility of significant simplification through the various receiving offices, particularly with regard to electronic filing procedures.

FICPI notes that the PCT is not concerned with patent grants per se. The PCT system is an interim step, prior to national processing and grant and is a common entry point for the patent process. FICPI therefore is of the view that the PCT system should be simplified as much as possible. FICPI is also conscious of the fact that national patent offices have an important skill base and that there will always be a need for a local patent which is pursued independent of PCT. Thus, it is important to retain examining skills and searching skills in the various national patent offices and PCT should not act in a way which reduces or weakens this skill level by delegating work to a few countries only. FICPI is also conscious of the fact that some countries have special expertise in certain areas of technology and that the patent offices in those countries have access to prior art information which is not readily available to patent offices in other countries. Thus, FICPI considers that this valuable resource should not be overlooked, and that applicants should have the possibility of requesting searches from particular countries where the special expertise and prior art records are known to be likely relevant to the subject matter in a particular patent application.

FICPI is also conscious that the trend towards a "World Patent" should not materialise until there is international agreement and harmony in relation to styles of drafting of patent claims, laws for interpretation of those patent claims, and common approaches by Courts in different countries.

Given FICPI's views in relation to the PCT being an interim step towards national patents, then the present period of 30/31 months for Chapter II National Phase processing is a period which should be utilised to locate as much relevant prior art as possible. This will place the various examining authorities/national offices in a better position to grant valid patents in the first instance.

FICPI's comments in relation to the various proposals are set out below:

It should be noted that FICPI views the proposals as a package in total and that FICPI's comments are based on the proposal in its entirety and not in relation to individual proposals being put forward to the exclusion of other of the proposals. Many of the proposals are intertwined and rejection of one proposal whilst leaving others in place will have an adverse effect on the system as a whole.

FICPI agrees that the first stage could be implemented by 2005.

1. *Elimination of the concept of designations*

FICPI agrees with the proposal for elimination of the concept of designations. FICPI notes that currently the maximum filing fee is encountered when six countries are designated. This

number has decreased from ten which was the minimum number when PCT was first introduced. Most international applications proceed with a designation of all possible countries. There does not appear to be any difficulty or disadvantage associated with eliminating the concept of designations.

Assuming that designations are eliminated, then FICPI considers there should be some mechanism for the early publication of the countries in which national applications have proceeded following the 30/31 month period. Third parties need to know at an early date that applications are proceeding in particular countries and there should be some mechanism to provide publication of this information within about two months at the latest from the 30/31 month date for national phase entry. Preferably, this information should be made available on an easily accessible database in an electronic form.

2. *Elimination of all residency and nationality requirements*

FICPI does not agree with the proposal to eliminate all residency and nationality requirements. FICPI considers that this proposal would discourage existing non member countries from joining PCT thereby excluding the possibility of applications from existing member countries of filing in those countries using the PCT route. FICPI also considers that removal of all residency and nationality requirements may have the unwanted effect of concentration of the I.P. profession in countries with well established I.P. practices to the detriment of the I.P. profession in countries without I.P. practices or with only small I.P. practices. Applicants need local I.P. professionals in their home country and PCT should not act to weaken or remove that professional base.

FICPI considers, however, that members of existing contracting states should not be required to file in their home country in the first instance, and should have the possibility of filing in any contracting state, subject to there being mutual reciprocity between the countries concerned.

3. *Conform filing date requirements to those in PLT*

FICPI agrees entirely with this proposal.

4. *Conform "missing part" – type requirements to PLT procedures*

FICPI agrees entirely with this proposal.

5. *Availability of multiple searches and examinations*

FICPI endorses this proposal. FICPI is of the view that the applicant should initially receive a first or primary search report from the searching authority within 18 months of earliest priority, as currently occurs, and the searching authority be the existing searching authority for the home country of the applicant. The applicant should then have the possibility of requesting within a further period of say 2 months, supplemental top-up type searches (i.e. not a complete re-search of already searched material) through one or more searching authorities nominated by the applicant. FICPI is of the view that appropriate fees for searches by each of the subsequent searching authorities be levied. FICPI is also of the view that requests for subsequent searching be completed and published well before the expiry of the present chapter II period of 30 months.

FICPI is therefore of the view that if supplemental searches are requested that when national applications are processed in those countries there is a reduction in the search fee component in the filing fee in those countries to take account of the fact that searching has already been conducted in those countries.

FICPI notes that some searching authorities have a greater capacity for accurate search results in selected areas of technology. FICPI therefore encourages the retention of all existing search authorities.

FICPI endorses the proposal for a compilation and publication of separate search reports if the applicant elects any subsequent searching to the first or primary searching.

6. *Elimination of 20 month deadline for entry into national stage*

FICPI endorses this proposal subject there to being no abolishment of the possibility for early national phase entry as provided under PCT Article 23(2), and subject to the first or primary International Search being completed and published within 18 months of earliest priority, FICPI does not want to see elimination of the 20 month deadline being a reason to delay the first or primary International Search report.

7. *Elimination of the concept of demands*

FICPI notes that many applicants proceed by filing a Demand for International Preliminary Examination for the sole purpose of extending the due date for National Phase entry. FICPI is of the view however, that the International Examination Report is generally not acted upon, nor relied upon by the national offices when national applications are examined. Opinions expressed in relation to inventive step, industrial applicability, and multiple inventions are also generally ignored by applicants. This is because each of the national offices have different laws and requirements concerning each of these items. Where there may be a valid objection in one country, it may not present a problem in another country. Accordingly, FICPI believes that further enhancement of the PCT can be achieved by completely avoiding the issuance of a mandatory International Preliminary Examination Report. FICPI is of the view that only Novelty indications, at the International Search Report stage have any real meaning for applicants.

FICPI recognises, however, that some applicants may require International Preliminary Examination Reports. Additionally, it is observed that some national patent offices, especially in developing countries, which do not themselves provide for substantive examination of applications, rely on the results of the International Preliminary Examination procedure under the PCT as evidence of the patentability of inventions. In that event, FICPI believes that there should be an option for applicants to request International Preliminary Examination subject to the payment of an appropriate fee. The requirement for compulsory International Preliminary Examination should be abolished. If an applicant proceeds in a country that relies on an International Preliminary Examination Report, then that country may then require payment of a fee for the International Preliminary report issued from an International Preliminary examination authority

FICPI does not see that the publication of the International Preliminary Examination Report to be of any substantial benefit to third parties and accordingly considers that the proposal to

abolishment of compulsory International Preliminary Examination not to be a disadvantage to third parties. FICPI reiterates the comments made in proposal 6, that proposal 7 should not act to delay issuance of International Search Reports, and that the International Search Report should issue in the same time period that currently exists.

8. *Accommodate further deferral of national stage entry*

FICPI is not in favour of this proposal. FICPI considers that the present period of 30 months provided under Article 39 is operating adequately. FICPI is of the view that there must be a balance between the rights of applicants, and the rights of third parties and notes the “submarine” difficulty. FICPI is of the view that the current period of 30 months strikes the correct balance and has been working adequately. Third parties clearly need to know if a patent applicant intends to proceed in a particular national country, in order to make commercial decisions in relation to competing technology. The extension of 30 months to some longer period is considered inappropriate even though some applicants may wish to extend the period to defer the costs associated with national stage filing. It is FICPI’s view that requests for extension past the 30 month date are in general made by applicants without funds and without any real prospect for commercialisation of the invention. Furthermore, consideration should be given to amendment of Art. 39(1)(b) PCT to introduce a maximum possible term within which nationalization of an International application must take place.

9. *Combination of search and examination*

FICPI notes that problems would exist where multiple searches have been requested. In FICPI’s response to proposals 6 – 8 it is noted that FICPI proposes that examination should occur only upon formal request by an applicant. In this event, any examination report should be based on the prior art located in the first search report and not on any subsequently requested searching unless the subsequent search report is available at the time of the examination. It is however, expected that the results of any subsequent searching will not be available until some later date.

10. *Fee reassessment*

FICPI agrees with this proposal.

11. *Reduction/elimination of formal review or handling of application*

FICPI agrees with this proposal.

12. *Reenergised technical assistance under PCT Articles 51 & 56*

FICPI agrees with this proposal.

13. *Electronic international publication*

FICPI agrees with this proposal.

14. *Electronic transmission of search/examination results*

FICPI agrees with this proposal.

15. *Other PLT – consistent changes*

FICPI agrees with all the proposals under this heading. In particular FICPI also strongly supports that extensions of time and reinstatements of rights be available where an application lapses due to some error or omission and that the PLT provisions for these purposes be introduced into PCT with the possibility of an appeal process in respect of adverse decisions, and that any decision that issues therefrom be acceptable in all member states.

16. *Other possible changes*

FICPI also strongly supports there be some mechanism introduced to allow the subject matter of two or more related PCT International applications to be combined so that a single national phase application can proceed in elected countries, thereby avoiding the current practice of requiring a corresponding two or more national entries in an elected country.

FICPI considers that for countries considering implementing electronic filing of patent applications it would be sensible for WIPO to encourage these countries to adopt the same software program used by WIPO. This should eventually lead to a common system for both PCT and non PCT applications in those countries and discourage multiple software programs which is otherwise contrary to harmonization of International standards. This will also minimise expense to applicants by standardizing the system software knowledge and skills required.

FICPI also considers that all receiving offices must accord a filing date to an electronically lodged international application if it is filed using an electronic software program adopted by WIPO. In other words, if a receiving office adopts a particular software program for filing, it shall not exclude filing using a software program used by WIPO. Therefore each receiving office should be required to implement the WIPO software program in addition to any other software program used for electronic filing. This may also encourage the WIPO version to become an International standard, and this will assist harmonization.

FICPI also proposes that it should be possible for international applications to proceed nationally in all member states, or through a relevant Regional Patent Treaty where such exists, at the option of applicants. The present requirement for filing in a number of European countries, including Belgium, France and Italy, only via European applications has particular disadvantages for many applicants. This problem could be addressed by deletion of Art. 45(2) PCT.

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