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INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

COMMITTEE ON REFORM  
OF THE PATENT COOPERATION TREATY (PCT)

First Session  
Geneva, May 21 to 25, 2001

REFORM OF THE PCT:  
PROPOSALS BY AUSTRIA

*Document prepared by the International Bureau*

1. The proposals appearing on the following pages were made by Austria in a submission to the International Bureau received on April 17, 2001. Background information appears in document PCT/R/1/2.<sup>1</sup>

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

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<sup>1</sup> 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](http://www.wipo.int/pct/en/reform/index_1.htm)

PRELIMINARY PROPOSALS CONCERNING  
THE PROPOSED REFORM OF THE PCT

The PCT is without doubt a real success story in the field of industrial property protection. Applicants are using the system in a constantly increasing number world-wide. The PCT has to meet the challenges of a changing world of globalisation, constant technical progress and at the same time has to face a considerable increase of applications. This situation obliges WIPO and the contracting parties of the PCT to provide the applicants with a modern and well functioning system of protection and at the same time requires reforms in the treaty itself.

Therefore Austria attaches great importance to the reform of the PCT. Such reform, however, should take place within the existing framework of the current PCT.

The treaty as it stands now has in general fulfilled its purposes and does not need to be renegotiated. Such a project would in our view create several coexisting PCT-systems, which would automatically mean legal uncertainty for the applicants and an unnecessary duplication of administrative procedures in the member states.

Without going too much into details at this early stage Austria would like to present the following main points which in our view should be taken in consideration for the reform of the PCT.

1. *Publication of the international application (Article 21)*

The Austrian Patent Office strongly supports the publication of the international application after the expiration of 18 months from its priority date. The international search report should be published at the same time. This situation has proved very useful, one for the applicant as he gets substantial information for his decision how to proceed with his application, two for the public, because it facilitates and accelerates the access to technical information contained in international applications. We therefore believe that this useful and efficient provision should be kept in the future.

2. *Entering the national phase after the expiration of 20 months*

Once the international application has been published 18 months after the priority date the applicant has, in the present situation, two options. He can either choose to submit a demand for international preliminary examination before the expiration of 19 months after the priority date (Article 31) and thus postpone the entry into national phase until 30 months after the priority date (Article 39), or he has to enter the national phase before the expiration of 20 months after priority date. In our view this time limit of 20 months should be abolished and the applicant should have the right to enter the national phase 30 months after the priority date regardless of the fact if he has submitted a demand for international preliminary examination or not. In our experience this time limit of 20 months was often fatal for international applications as applicants have not met the delay for submitting a demand for international preliminary.

3. *Establishing the international search and preliminary examination reports at the same time*

The present situation is the following: 18 months after the priority date every international application will be published. Then the International Preliminary Examination Authority has to wait if the applicant submits a demand for international preliminary examination. If the applicant submits such a demand it takes still some additional time until the examiner receives the file. In the meantime the examiner has probably already established the search report after 16 months from the priority date, time consuming re-examination and re-consideration of all relevant facts have to be made once the demand for international preliminary examination has finally been submitted. Besides that it is practically impossible to establish a second written opinion, even if it would have been highly desirable for the applicant.

Therefore the Austrian Patent Office would like the applicant to decide already at the time of filing if he wants an international preliminary examination or not. This would have also have the advantage that the receiving office could collect all fees at once and bank fees for the applicant and the authorities would be considerably reduced. Moreover it would no longer be necessary to elect countries and besides that we would no longer need a separate demand form. Especially the last point would considerably reduce the work load for the International Preliminary Examination Authorities (formality check).

Moreover the examiner could, as he establishes the search report, already send a first written opinion to the applicant, if necessary. This would give the applicant a much clearer view of the search report and for the examiner it would have the advantage that he could work continuously with a specific application, which would naturally reduce the costs for the International Preliminary Examination Authorities. As a further advantage of such a change the submission of amendments under Articles 19 and 34 could be simplified, because the applicant certainly would no longer file amendments under Article 19 with the International Bureau but with the International Preliminary Examination Authority.

4. *Multiple search*

The Austrian Patent Office is very much in favour of the concept of multiple searches. However we would deem it necessary that all requests for searches must be filed at the time of filing the international application and that all search reports must be published with the international application. We understand that this system would only be efficient if the applicant could choose any International Searching Authority he likes for additional searches. However, for the first search the applicant would be bound to the competent International Searching Authority or to one of the competent International Searching Authorities. This measure would certainly improve the quality of international searches.

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