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(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 CANADA

Document prepared by the International Bureau

1. The proposals appearing on the following page were made by Canada in a submission to the International Bureau received on April 30, 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

CANADIAN COMMENTS CONCERNING PCT REFORM

The following are Canada's preliminary observations on the proposals for PCT reform that have been put forward in the context of the decision of the Assembly of the PCT Union as presented in paragraphs 51 and 58 of document PCT/A/29/4.

GENERAL

We support the basic objectives set out in the US proposal for a first stage of PCT reform and consider it very desirable to proceed as quickly as possible to make concrete practical reforms to the PCT system.

In particular we support a first stage of reform that would encompass reforms that can realistically be brought to fruition in a five year time frame. The focus of this first stage should be on simplification and streamlining of the PCT system, helping offices handle increasing workloads, removing pitfalls and reducing costs for users, and conforming the PCT to the PLT.

In our view, the first stage of reform must include modifications to the PCT Articles. Adaptation of the PCT system over the years by changes to the Rules has resulted in an overly complex set of Rules which at times appear inconsistent with the Treaty. Any serious attempt at reform, even in a first stage, requires simplification of the Treaty itself. We recognize that having two versions of the PCT, at least during a temporary transition period, could create some difficulties but consider that this is merely one of the necessary challenges that will have to be met to obtain meaningful PCT reform. In any event, our expectation is that it will be possible to find creative ways to reduce the impact of having two versions of the PCT during a transition period including in particular by finding ways to make the current PCT effectively function, as much as possible, in the same way as the amended version e.g. by administrative practice, by using Article 47 to change time limits under the current PCT and by amending the current Rules.

With respect to the makeup of the special body to be responsible for considering proposals for PCT reform, although we acknowledge that a smaller body may be able to work more efficiently, we consider that any PCT member state that has an interest in participating should be permitted to be a member of the special body. Excluding interested member states could in our view lead to difficulties later in the process in developing the support necessary to proceed with the reforms that are ultimately recommended by the special body.

COMMENTS RE US PROPOSALS FOR FIRST STAGE OF REFORM

(1) *Elimination of the concept of designations*

We support the elimination of the concept of designations including the elimination of designation fees.

(2) *Elimination of all residency and nationality requirements*

We oppose this proposal, first because it would remove an important incentive for non-contracting parties to join the PCT and second because it could have a negative effect on the viability of smaller offices to function as receiving office, ISA or IPEA.

(3) *Conform filing date requirements to those in the PLT*

We support this proposal, even with respect to elimination of residency and nationality requirements (but we would make non-compliance with residency and nationality requirements an Article 14 defect).

(4) *Conform “missing part” -type requirements to PLT procedures*

We support this proposal.

(5) *Availability of multiple searches and examinations*

We support the idea of providing applicants with the option of multiple searches to provide applicants with as much information as possible, particularly given that there are currently often significant differences in the results of searches carried out by different offices. Consideration could be given to providing applicants with options, subject to correspondingly different fees, such as 1) simultaneous multiple searches requested at time of filing or 2) one basic search and, following that search, allowing the applicant to request one or more supplemental searches. However, although some flexibility could be given to the applicant, we consider it important that at least one search report be included in the application as published (at eighteen months from the priority date). Any additional search reports should be either included in the published application (if completed in time) or be publicly available on WIPONET.

We don't see a need to provide for the possibility of multiple examinations. Multiple examinations could create workload problems and they could also create confusion if they are contradictory.

(6) *Elimination of 20-month deadline for entry into the national stage*

We support this proposal. We agree that it is important not to foreclose early national stage entry.

(7) *Elimination of the concept of demands*

We don't agree that all international applications should automatically be subject to international preliminary examination. The applicant should have the choice as to whether to have an international preliminary examination (at least as long as PCT results are non-binding) and should only have to pay a fee for examination if it is requested. The primary benefit of an international preliminary examination is for the applicant so they should have right to choose. Key information for third parties is provided by search reports. In the national phase, offices that rely on international preliminary examinations should be able to request the applicant to have an international preliminary examination carried out at that time.

It appears to us that an applicant should be given the choice to request an international examination in the request form at the time of filing or at a later stage. Different fees could be charged depending on when the request for examination is made, for example, a lesser fee might be charged if the request for examination is, at the time of filing, requested of an IPEA that is also selected as the ISA to take into account the efficiencies for the office of being able to carry out a combined search and examination.

(8) *Accommodate further deferral of national stage entry*

We oppose any mandatory extension of the 30 month time period because of the additional uncertainties this would cause for third parties.

We do, however, consider it important for all PCT contracting parties to provide relief where the time limit for entering the national phase is missed despite all due care. The PLT regime that applies in accordance with PLT Articles 3(1)(b)(i) and 12 should be made mandatory for all PCT contracting parties even if they are not PLT contracting parties.

We agree with FICPI's suggestion that "consideration should be given to amendment of Article 39(1) to introduce a maximum possible term within which nationalization of an International application must take place". Twelve months might be an appropriate maximum. If contracting parties are to be allowed to go beyond such a twelve month period (i.e. 42 months from priority date), we consider that they should be required to provide intervening rights to protect the interests of third parties.

(9) *Combination of search and examination*

We support the concept of permitting search and examination to be combined where possible. However, as noted above, we consider it important that at least one search report be included in the application as published (at eighteen months from the priority date), and this will necessarily impose some constraints on the extent to which search and examination can be combined.

(10) *Fee reassessment*

We support this proposal.

(11) *Reduction/elimination of formalities review or handling of applications*

We should actively seek to reduce any steps associated with formalities review or handling of applications to the extent that such steps become unnecessary as a result of electronic filing/processing.

(12) *Reenergize technical assistance under PCT Articles 51 and 56*

We agree that it would be useful to review how best to provide technical assistance to developing countries in respect of the PCT.

(13) *Electronic international publication*

We agree with this proposal. In addition, we consider that the International Bureau should expand the information that is made available electronically to offices and the public.

(14) *Electronic transmission of search/examination results*

We agree with this proposal.

(15) *Other PLT-consistent changes*

We agree with this proposal.

COMMENTS RE US PROPOSALS FOR SECOND STAGE OF REFORM

(1) *Regionalization of current search/examination authorities*

We oppose this proposal.

We do not consider regionalization to be a necessary ingredient for greater efficiency and enhanced quality. Such benefits can equally be attained by cooperation between offices enabled by information technology.

Any office that can provide a quality international search or examination should be permitted to do so, particularly because it is desirable to have as much local patent office expertise as possible to provide better support to the local innovative community (including through supporting local patent agents who in turn support the local innovative community).

(2) *Elimination of distinction between national and international applications*

We don't see a need for PCT changes in this area. Although applicants may for various reasons choose to file first a national application and then later an international application, there doesn't appear to be anything inherent in the current PCT that would lead applicants to seek the processing of essentially duplicate national and international applications. It appears to us that any difficulties in this area could be handled through changes in national laws or practices.

We do, however, support as much aligning as possible of international and national regimes including the creation of standardized request forms that can be used for filing both international and national applications.

(3) *Positive examination results in certain PCT authorities binds Contracting States*

Although this proposal might be worth exploring in a further stage of reform, it is clearly not a suitable issue for consideration in a first stage of reform particularly since significant harmonization of substantive patent law would appear to be necessary to make it workable.

- (4) *Provide further flexibilities in terms of relaxed timing requirements for national stage processing*

We oppose this proposal because of the additional uncertainties this would cause for third parties.

OTHER PROPOSALS FOR INCLUSION IN FIRST STAGE OF PCT REFORM

Elimination of Article 64(4)

We support the consideration of eliminating Article 64(4). PCT contracting parties should be required to give the same prior art effect to all international applications that enter the national phase in that contracting party as is given to national applications filed in that contracting party.

Office to which a particular document has to be submitted

We support giving consideration to drafting the Treaty to allow applicants to file (with the same effect for the purposes of meeting time limits) all documents and fees needed in the international phase with a single office (likely the receiving office), where both the office accepts to take on this role and the applicant chooses to proceed in this way.

Confidential nature of the international preliminary examination

We support giving consideration to amending Article 38 to allow all offices and third parties full access to the file of the international preliminary examination at any time after publication of the application.

Divisional applications

We support giving consideration to whether it would be feasible to provide for the filing of international divisional applications.

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