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COMMITTEE ON REFORM
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REFORM OF THE PCT:
PROPOSALS BY THE EUROPEAN PATENT OFFICE (EPO)

Document prepared by the International Bureau

1. The proposals appearing on the following pages were made by the European Patent Office (EPO) in a submission to the International Bureau received on May 8, 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

PROPOSALS FOR PCT REFORM AND
EPO RESPONSE TO PCT/R/1/2

INTRODUCTION

This paper is the EPO's response to PCT/R/1/2. It is divided into two categories: Reform proposals which would require a change to the PCT regulations/time limits contained in the Articles and reform proposals which would require a revision of the PCT Articles. Comments are also included on the specific proposals contained in PCT/R/1/2. However it should be understood that this is an initial reaction paper and much will depend on the detail of the proposals and the progress made in the special body and the Assembly itself.

A. MEASURES WHICH REQUIRE PCT RULE CHANGES/APPROVAL BY THE PCT ASSEMBLY

Amendment of EPO-WIPO Agreement in order to allow the EPO to restrict its ISA and IPEA competence

1. In view of the dramatically increased workload in recent years and the need to maintain quality the EPO will be bound to limit its competence as ISA and IPEA to European applicants and Receiving Offices not acting as a PCT Authority. The present agreement between the EPO and WIPO would have to be amended by agreement between the two parties and subject to the approval of the PCT Assembly (2/3 majority).

Approximate the time limit under Article 22 PCT for entry into the national/regional phase to that under Article 39 PCT

2. Extending the Article 22 PCT time limit for national (regional) phase entry from 20 to 30 months could have the effect that, according to the EPO's experience and depending on the technical fields, up to 40% of all PCT applicants might refrain from using the PCT Chapter II procedure because they use the IPE only in order to buy time. This may also be deduced from the fact that around 30% of them do not reply to the first written communication of the IPEA. Further, approximately 20% of Chapter II cases ultimately do not enter the national phase. On the assumption that many of these applicants in the future would abstain from using Chapter II, PCT authorities would benefit from the proposed measure because they would not be obliged to handle these applications as IPEAs, ie to invest time and manpower in applications which subsequently do not become national. Consideration could also be given to changing the existing requirement that a demand be filed separately from the request. This could be achieved in the short term without a revision of Article 31(3) PCT, by way of clarification in the regulations, though in the longer term Article 31(3) should be reworded (see also B.9)

More flexible time limits for filing of demand etc.

3. The time limit for filing a demand under Article 39(1)(a) PCT and the time limit for entering the national/regional phase under Article 22(1) PCT should be linked to the date of dispatch of the ISR, if the relevant basic time limit of 19 or 20 (21) month has already expired, so as to allow time for a proper evaluation of the ISR by the applicant.

Simplification of the non-unity procedure before the ISA/IPEA

4. The non-unity procedure pursuant to Art. 17(3)(a), Rule 40.2.(c)-(e) and Art. 34(3)(a), Rule 68.3(c)-(e) PCT should be simplified and streamlined by deleting the protest system under said Rules and transferring the settling of such disputes to the national phase.

The protest procedure as provided for at present does not fit with the system of the PCT as offering a preliminary (non-binding) procedure which does not provide for any other appeal procedure. The applicant who does not agree with the finding of the Authority would still have all options as provided for under national law (e.g. Rule 112 EPC). In a later step further amendments to the Treaty with respect to non-unity should be considered.

Sequence listings (SL)

5. It is proposed in a first step to amend Rule 13ter PCT in order to provide that ISAs and IPEAs are no longer obliged to issue invitations due to missing SL and to search/examine those cases. In a later step amendment of Articles 3(2) and 14(2) PCT should be envisaged in order to provide that the filing date should be the date on which the missing SL are received by the Receiving Office (like missing drawings).

6. An increasing number of applications require SL. If the SL was missing in the application as originally filed, or does not conform to the prescribed standard, it may be filed subsequently, in particular at the invitation of the ISA. In many cases, more than one invitation is necessary to obtain a SL complying with the Standard, or the ISA is obliged to effect the required corrections to be able to use the SL. This triggers a considerable additional workload for the ISA, which can be dealt with only by expert staff. Further, it causes a delay in the establishment of the ISR. It also creates difficult problems at the stage of IPE (and during substantive examination in the national phase) since it is usually impossible to verify whether a subsequently filed SL contains subject matter which goes beyond the disclosure in the application as filed.

B. MEASURES WHICH REQUIRE A REVISION OF THE PCT ARTICLES

Move requirements from the Articles to the regulations

7. Many practical day-to-day requirements of the Treaty concerning the processing of international applications are at present contained in the Articles. Revision of the Articles is a time consuming and lengthy not to mention uncertain process, especially in view of the rapid rise in the number of PCT contracting states in recent years which now stands at 110. In order to be able to keep pace with changes in technology and applicant behaviour it is proposed to introduce more flexibility into the revision process and consideration should be given to moving wherever possible procedural and substantive requirements currently contained within the Articles to the implementing regulations. Further, amending the voting rights enshrined in Articles 53, 47(2)(b) amongst others should be considered so as to loosen up the requirements for unanimity in particular.

Taking full advantage of the performance of search and examination by a single examiner at the same time

8. The proposal seeks to institutionalise the current practice in most examining offices whereby search and examination are carried out by the same examiner and at the same time (already indicated in present Rule 69.1(b) PCT). It is proposed to simplify the Treaty accordingly, e.g. abolish the distinction between Chapter I and II completely, by deleting Art. 22 PCT and the requirement for filing a “separate” demand (Art. 31 PCT). As a result, all international applications would as a rule include the international preliminary examination to be performed by the specified Authority which carries out the search. Both the international search and the preliminary examination should be subject to the payment of a *combined search and examination fee*. This possibility to merge search and examination (“BEST² PCT”) will lead to the elimination of built-in inefficiencies of the current separation of Chapter I and II which as a result would contribute to improvements in the workload situation. It would also be advantageous for applicants who would have immediately an initial examination report based on a full search.

9. The proposal could be supplemented by introducing a *standard-type international preliminary examination report (STIPER)* which would consist of a streamlined procedure followed by the examiner, i.e. an evaluation of novelty, inventive step and industrial applicability based on the prior art documents cited in the search report, but without any communication with the examiner. The STIPER would correspond by and large to the current first opinion and would be attached to the ISR. Of course the right to amend the international application would remain, but such amendment would take effect before the designated/elected offices only, not for the purposes of the IPER. It should be borne in mind that currently, in some technical fields the percentage of applicants who fail to respond to a written opinion is well above the 30% average and can in fact be as high as 50%, which means that very significant examining resources are wasted on a product in which only a proportion of applicants are interested. For those genuinely interested in a more expansive IPER, the possibility of retaining a dialogue opportunity could be considered.

Abolish the non-unity procedure

10. Another step would require the amendment of Articles 17(3)(a) and 34(3) PCT. Only one invention would have to be searched or examined (the first or main invention). No additional fees would be requested, nor would there be any protest. Correspondingly, the regional/national phase could be streamlined: no extra search fees for the non-searched inventions should be requested; instead, the filing of (a) divisional application(s) (in the international or the national phase) would be required. This measure would further simplify the international phase by underlining its preliminary character.

² Bringing Examination and Search together.

C. EPO OBSERVATIONS ON POINTS RAISED IN PCT/R/1/2 WHICH ARE NOT COVERED BY THE PRECEDING PROPOSALS³

11. It should be stressed from the outset that the EPO considers any proposal aimed at *mutual recognition of search and examination* (stage 2 /1, 3) results as premature in the absence of substantive patent law harmonisation and adoption of effective quality control standards in the International Authorities. These are considered pre-requisites by the EPO to any discussion of mutual recognition of search and examination results and are by no means the only factor to be considered. For that reason there can be no question of serious discussion at present of this proposal.

12. *Elimination of the concept of designations* (Stage 1/1)

Supported: The need for designation is a source of errors on the applicant's side which implies additional administrative work in Receiving Offices and purported Designated Offices which are asked to review to negative decisions of the Receiving Office concerning their missing designation. Moreover, the maximum amount of designation fees to be paid for patent protection in all PCT contracting states already has been steadily reduced in the past 10 years.

13. *Elimination of all residency and nationality requirements* (Stage 1/2)

Not supported: See A1

14. *Conform filing date requirements* (Art. 11 PCT) and "missing part" - type requirements *to those in the PLT* (Stage 1/3-4)

In principle *supported:* However, any change in order to "simplify" should not enable applicants to file more obscure and being out of any proportion applications which cannot be reasonably searched and examined.

15. *Availability of multiple searches and examinations* (Stage 1/5)

Experience of trilateral projects not very promising so far. *However, in any case, such step would bring an increase of workload.* Therefore, discussion should be postponed until the workload problem has been solved.

16. *Elimination of 20-months deadline for entry into national phase* (Art. 22). Early national stage entry should not be excluded (Art. 23 (2)) (Stage 1/6)

Supported: See A2

17. *Demand requirement under Art. 31 should be deleted* provided that applicants would not incur additional costs (Stage 1/7)

Supported: See B9

³ The absence of any EPO comment on a proposal or element of a proposal contained in PCT/R/1/2 should not be considered as support for that proposal.

18. *Further deferral of national stage entry beyond the 30-months deadline (Art. 39); 6-month intervals against payment of deferral fee? Third parties concern of “submarine” applications to be minimised by publication and access to ISR/IPER (Stage 1/8)*

Very problematic (third parties interests!).

19. *Fee re-assessment: fees should reflect streamlined and reduced functions (result of simplification and electronic processing) (Stage 1/10)*

In principle *supported*, provided, fees for ISR/IPER remain under the competence of the Authorities.

20. *Reduction/elimination of formalities review , and/or handling of applications (depending on the progress of electronic filing and processing; in particular for functions performed at the IB). Electronic international publication (responsible IB; streamlined by electronic means). Electronic transmission of search/examination results via WIPO-net (Stage 1/12, 13, 14)*

Supported.

21. *Elimination of the distinction between national and international applications (Stage 2/2)*

Much more detail on the practicalities and modalities of this proposal and its interrelation with the other proposals would have to be forthcoming; in particular consideration would have to be given to substantive harmonisation and quality control standards in the PCT Authorities, unless the proposal were confined strictly to harmonising the formal requirements between national and international applications, in which case the practical benefit to applicants would only be modest. Any linkage between this proposal and mutual recognition of search and examination results could not be supported.

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