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INTERNATIONAL PATENT COOPERATION UNION
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COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

Second Session
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PROPOSAL FOR CONTINUING APPLICANTS' RIGHT
TO COMMUNICATION UNDER ARTICLE 34

Proposals submitted by
the Asian Patent Attorneys Association (APAA),
the International Federation of Industrial Property Attorneys (FICPI),
the American Bar Association (ABA) and
the Intellectual Property Institute of Canada (IPIC)

1. This proposal is made in response to the proposals made by the Working Group on PCT Reform regarding the treatment of the search examiner's opinion on patentability issued in connection with the international search report (ISR), where the applicant files a demand.

Current system

2. The current system for international preliminary examination, set out in PCT Rule 66, includes certain safeguards to ensure that the applicant has the opportunity to communicate orally and in writing with the International Preliminary Examining Authority (IPEA), as provided in Article 34(2)(a). Provided the applicant meets the time limits set out in the Rule, it is assured that its Article 19 and/or 34 amendments and comments *will* be considered in international preliminary examination.¹ In addition, under the current system, the IPEA is required to notify the applicant in writing of deficiencies in the application that would prevent the establishment of a favorable international preliminary examination report (IPER), and invite the applicant to submit an appropriate reply.²

Proposed system

3. Under the proposal for an expanded international search, the majority of voting delegates to the Working Group on PCT Reform supported a position that the search examiner's opinion on patentability would, for the purposes of international preliminary examination, be considered the first written opinion.³ This is understood by applicants to mean that the IPEA would not perform any further examination in order to issue the first written opinion pursuant to Rule 66.2.

4. Currently, Article 19 amendments are made in response to the ISR prior to, or along with filing the demand. Often Article 34 amendments and comments are also made in response to the ISR and filed contemporaneously with the demands so that they will be considered by the IPEA early in the international preliminary examination, particularly during the preparation of the first written opinion, so that the applicant can determine if further amendments and/or comments may be necessary to establish a favorable IPER. However, because the search examiner's opinion on patentability will be issued to the applicant concurrently with the ISR, it will normally be prepared before the demand is filed and before the applicant has had a reasonable opportunity to contemplate Article 19 and/or 34 amendments and comments. Establishing the search examiner's opinion on patentability automatically as the first written opinion without a subsequent examination procedure under Chapter II appears to bypass the mandatory safeguards for consideration of applicants' amendments and comments found in Rule 66.1(c) and (d).

5. While the proposal for an enhanced search and examination system, if adopted, would not permit the IPEA to commence international preliminary examination until after the set time limit of the later of 3 months from issuance of the ISR and search examiner's opinion or 22 months from the priority date,⁴ the automatic establishment of the search examiner's opinion as the first written opinion under Rule 66.2(a) prevents any notification to the

¹ Rule 66.1(c) and (d).

² Rule 66.2(a) and (c).

³ Chair's Summary of Second Session of the Working Group on PCT Reform, document PCT/R/WG/2/12, paragraph 38.

⁴ Document PCT/R/2/7, Annex, page 23 (proposals for Rule 69.1).

applicant, in the first written opinion, of the extent of the IPEA examiner's consideration of the applicant's amendments and/or comments responding to the ISR and search examiner's opinion timely filed under Rule 66.1(d). It is entirely within the IPEA examiner's discretion whether or not to provide this notification to the applicant through the issuance of subsequent written opinions.⁵

6. In addition, there are no safeguards for providing applicants an opportunity to amend or comment if the IPEA actually rejects the opinion in the search examiner's opinion on patentability, and formulates an unfavorable IPEA based on different issues.

7. It is believed that this could lead to a number of undesirable results:

(1) the applicant, who has paid for international preliminary examination, will not receive any further substantive examination beyond the search examiner's opinion on patentability (i.e., will not receive any apparent "value for money");

(2) the applicant who enters Chapter II in the hopes of establishing its rights under Article 34(2)(a) and (b) to communicate with the IPEA and influence the establishment of a favorable IPEA following a negative search examiner's opinion on patentability will, in fact, be denied this opportunity; and

(3) the workload associated with the true prosecution of the application will be shifted to the national/regional phase.⁶

8. A favorable IPEA is always of value to an applicant since it facilitates the national/regional processing of the application. There are at least two situations where a positive IPEA is critical to the applicant:

(1) where the applicant is dependent on investors for financing national/regional phase entry and exploitation of the invention; and

(2) where the invention is to be protected in a large number of countries without the resources to conduct substantive examination.

Proposal for a new PCT Rule 66.2(f)

9. Cognizant of the workload issues currently facing the international authorities, this paper proposes to reintroduce these safeguards in a limited form, through the addition of a simplified notification procedure by the IPEA which would be followed only in select situations:

(1) where required to give the applicant notice and a fair opportunity to respond to unfavorable views of the IPEA not previously communicated to the applicant in connection with the search examiner's opinion on patentability; and

⁵ Rule 66.4.

⁶ Although not subject to much discussion at the second session of the Working Group on PCT Reform, the European Patent Office has actually suggested a shift of the dialogue part of the PCT procedure (the workload associated with application examination) from the international to the national phase. See document PCT/R/WG/2/1 Add.1, paragraphs 7 and 8.

(2) to provide the applicant who has substantively responded to the search examiner's opinion, with a fair opportunity to fully understand the issues raised in examination, and to respond to them in order to influence the establishment of a favorable IPE R.

10. It is proposed to add a new PCT Rule 66.2(f) as follows:

“(f) The International Preliminary Examination Authority shall not proceed to establish an international preliminary examination report which is negative in respect of any matter referred to in paragraph (a)(i) to (vii) without first issuing a notification under paragraphs (a) to (d) if:

(i) that report would differ materially in that respect from the written opinion established by the International Searching Authority established under Rule 43*bis*.1; or

(ii) the applicant has submitted a substantial amendment and/or substantive arguments in response to that written opinion.”

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