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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

First Session

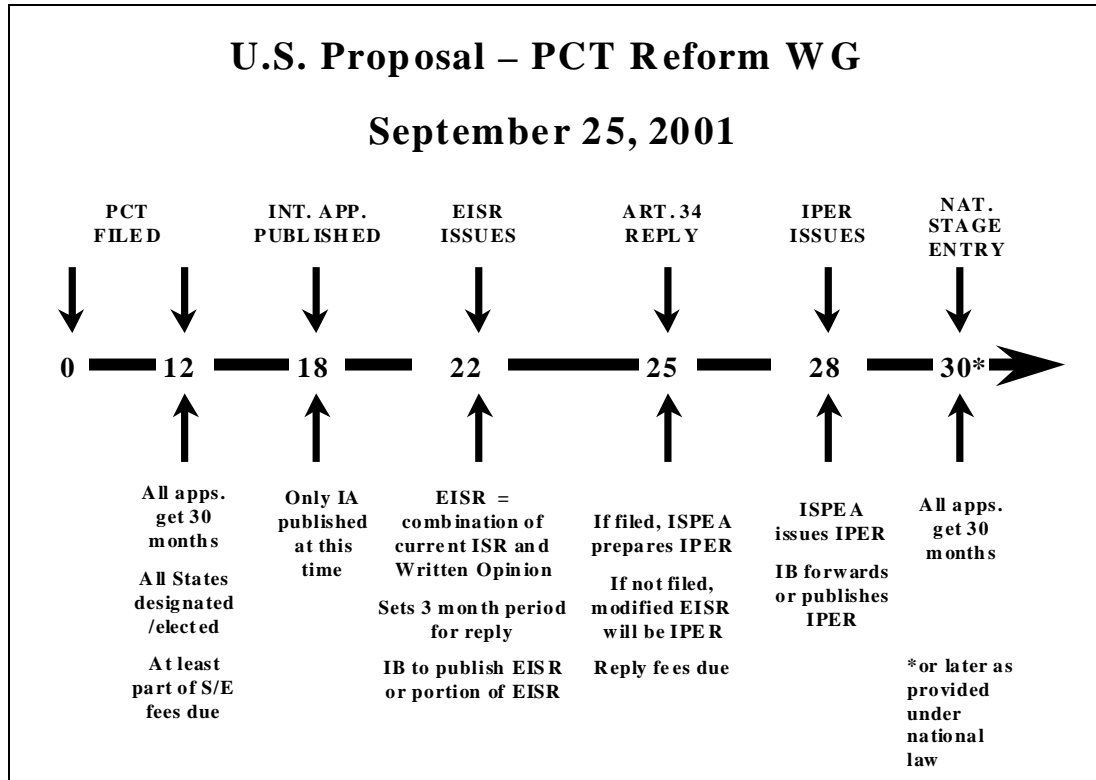
Geneva, November 12 to 16, 2001

UNITED STATES PROPOSAL FOR IMPLEMENTATION OF PROPOSALS (6), (7), & (9)
OF THE PROPOSALS OF THE UNITED STATES FOR PCT REFORM (PCT/R/1/2)

Proposals submitted by the United States of America

1. During the first Session of the Committee on Reform of the Patent Cooperation Treaty, it was agreed that, pending approval by the General Assembly, several of the proposals set forth in Proposals By The United States Of America (PCT/R/1/2) would be forwarded to a Working Group on PCT Reform for further consideration and development of the specific Article, Regulation, and procedural changes that would be necessary for implementation of those proposals. Among the proposals that were recommended for consideration by the Working Group, proposals 6, 7, and 9 (i.e., the elimination of the 20 month deadline for national stage entry, the elimination of the concept of Demands, and the combining of PCT search and examination, respectively) were forwarded for consideration as a single concept based on the schematic representation of those proposals presented during the session. (See PCT/R/1/1 Informal Paper No. 5). The following narrative sets forth the manner in which the United States currently envisions the specific implementation of those proposals and is presented for consideration by the Working Group in its November 2001 meeting.

2. In general, PCT/R/1/1 Informal Paper No. 5 sets forth a system in which: (1) the PCT application would be filed, (2) publication would still occur at 18 months and a combination search report and written opinion would be prepared, (3) an IPER would be prepared ONLY if a response to the written opinion were filed, and (4) the deadline for entry into the national stage for all PCT applications would be 30 months. This general process is envisioned as being specifically implemented by the following provisions (with time period for each provision indicated in parentheses).



(1) The filing of the PCT International Application (0-12 months)

3. Upon filing of the PCT international application (IA), all applicants would automatically have 30 months to enter the national stage. This would initially be accomplished by means of amendment to the Article 22 time period, via an Article 47 change, as has been proposed for consideration by the PCT Assembly (PCT/A/30/4). Eventually, it is envisioned that this would be accomplished through a merging of Chapters I and II of the Treaty.

4. Filing fees, including a reduced search/examination fee, would be due upon filing of the international application. If an applicant fails to pay the required fees at filing, an invitation to pay fees plus a late fee surcharge would be mailed. This surcharge would be due regardless of whether the fees were paid prior to the mailing of the invitation. If the fees (including the surcharge) were then not timely paid in response to the invitation, the IA would be withdrawn, and withdrawal would occur regardless of whether fees were submitted prior to mailing of Notice of Withdrawal. As with this proposed simplification of the fee collection system (i.e., fees are due when they are due), it is also envisioned that the provisions of Rules 14 - 16*bis*, concerning the amount due for a given fee, could be similarly simplified so that the amount due is the amount of the fee on the date the fee is paid.

5. As indicated, a reduced search/examination fee would be due upon filing. The fee would be a “reduced” fee in two ways. First, the fee is envisioned as being reduced in the sense that, due to the workload savings realized as a result of combining the search and examination processes, the combined search/examination fee would be less than the combined amounts of the current separate search and examination fees. Secondly, the fee would be considered a reduced search/examination fee in the sense that only a portion of the total search/examination fee would be due upon filing of the IA, with the remainder being due upon filing of a response to the Expanded International Search Report (EISR).

(2) Publication of the International Application (18 months)

6. The IB will continue to publish the IA as filed at 18 months. In those instances in which the EISR is issued prior to 18-month publication of the IA, then any EISR publication would take place in conjunction with the 18 month IA publication. However, given the 22 month deadline for issuance of the EISR, as discussed below, this will not be an issue in most applications, but for those rare cases in which the EISR may be completed early (e.g., if there is no priority claim), the rules would be written to provide that nothing would be published prior to the 18 month publication of the IA.

(3) Issuance of the Expanded International Search Report (22 months)

7. The International Search and Preliminary Examining Authority would issue the EISR at 22 months. It is envisioned that the EISR will combine features currently found in the International Search Report with those currently found in the Written Opinion. The EISR will set a 3 month period for applicant to respond with an Article 34 reply which will in turn trigger the issuance of an International Preliminary Examination Report by the ISPEA.

8. Upon issuance of the EISR, the IB will publish either a) the Cited References page of the EISR, or b) the full EISR. Of the two options, option a) is closest to current practice, while option b) provides the most information to 3rd parties at the earliest point in time. The United States currently does not have a preference between these two options and sees this as an issue to be resolved within the Working Group. Again as noted in provision (2), above, if the EISR issues early, then no EISR publication would occur prior to the 18 month publication of the IA.

(4) Article 34 Reply (EISR + 3 months, 25 months)

9. Prior to the expiration of the period set in the EISR, applicant may file a response under Article 34. The timely filing of such a reply will trigger the issuance of the IPER by the ISPEA. The reply should only be filed in cases in which applicant disagrees with the findings of the EISR, and should be accompanied by applicant’s arguments to the reasoning in the EISR or amendments to overcome the references applied in the EISR.

10. The reply must be accompanied by the remaining search/examination fees. If the remaining fees are not submitted with the reply, an invitation to pay the fees and a late fee surcharge will be mailed, and if the fees and surcharge are not timely paid in response to the invitation, the Article 34 reply will be considered as not having been filed. As with the simplification of the filing fee payments, if the fees are not paid by their due dates the prescribed action for failure to pay will occur regardless of subsequent submission of the fees and surcharges.

(5) International Preliminary Examination Report (28 months)

11. If an Article 34 Reply is timely filed, the ISPEA will prepare an IPER considering the arguments and amendments submitted with the reply. If an Article 34 reply is not timely filed or is not filed at all, the information from the EISR will be transferred to, and issue as, the IPER. In this regard it is envisioned that the format of the IPER will be substantially identical to the format of the EISR. As a result, the transfer of information from the EISR to the IPER when an Article 34 Reply is not filed or not timely filed should be able to take place purely electronically; necessitating minimal expenditure on the part of the ISPEA.

12. The IB will forward the IPER to all concerned Offices upon issuance of the IPER, either as prepared by the ISPEA or as a reformatted EISR.

(6) National Stage Entry (30 months)

13. The deadline for submission of the national stage requirements to the national offices under Article 22 will be 30 months for all applications. However, each national office will retain its right to accept such requirements at the expiration of a later time period.

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