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GENEVA

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)

ADDENDUM: ADDITIONAL STEPS TOWARD WORKLOAD REDUCTION

submitted by the United States of America

ADDITIONAL STEPS TOWARD WORKLOAD REDUCTION
TO BE TAKEN IN CONJUNCTION WITH THE IMPLEMENTATION OF
PCT REFORM PROPOSAL CONTAINED IN PCT/R/WG/1/3

1. In conjunction with the implementation of the PCT reform proposal contained in document PCT/R/WG/1/3, the United States currently envisions additional modifications to our own patent practice and internal procedures aimed at addressing workload concerns. These modifications are designed to specifically address the issue of duplicative work being performed in international and national applications. In order to address this issue, the United States is considering moving ahead and independently implementing one of the proposals that was set forth in the "Proposals By The United States Of America" (PCT/R/1/2) as a Stage 2 proposal, that being the combination of national and international processing. Such combined application processing would have the following characteristics:

- (a) Upon filing an international application applicants would have the ability to also indicate that the application should simultaneously be treated as a U.S. national application.
- (b) International and U.S. processing would then proceed simultaneously in a single application file wrapper with an EISR/U.S. First Action (USFA) issuing by 22 months¹ from the earliest priority date.
- (c) Applicants would have 3 months to respond to the EISR/USFA.
 - (i) If applicants respond within the three-month time limit, then an IPER/U.S. Second Action would be issued by 28 months.
 - (ii) If applicants did not respond to the EISR/USFA, the EISR would automatically issue at 28 months as the IPER and the case would go abandoned with respect to the U.S.
 - (iii) If applicants respond after the three month period via an extension under 136(a), then the EISR would automatically issue at 28 months as the IPER and a Second Action on the merits as to the U.S. filing would issue in a timely manner.

2. In order to encourage applicants to choose this simultaneous filing route, it is envisioned that the system would have several incentives built into it. The first of which being that since most PCT processing, and specifically the international search and examination, would be performed simultaneously with any U.S. processing (as opposed to prior or subsequent to the U.S. processing), it is envisioned that most, and perhaps all, of the international search and preliminary examination fees would be waived. Even though all other international and U.S. filing fees would still be required, this would still result in a substantial monetary savings to applicants (more than \$1000 based on current fees).

3. A second incentive for applicants to choose this processing route lies in the fact that these U.S. national applications, by being processed simultaneously as international applications, would be subject to the PCT time limit for issuance of the EISR. This simultaneous processing could in turn lead to earlier issuance of a patent and, based on a patent term of 20 years from the international filing date, a longer period of patent enforcement.

4. Under this scenario, in order to sufficiently address workload issues so that the United States might better adhere to this processing, it may be necessary to impose additional restrictions on applicants if they are to obtain the reduced fee and co-processing benefits discussed above. Such additional restrictions could include a requirement that the application be filed in electronic format, a requirement that it be accompanied by a request to expedite processing with a pre-examination search performed by the applicant, or other such requirements.

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¹ The time periods discussed in this document are based on those set forth in the U.S. proposal to the Working Group.