

WIPO



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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 SUGGESTED ADDITIONAL ITEMS TO BE
FORWARDED BY THE INTERNATIONAL BUREAU TO THE WORKING GROUP ON
PCT REFORM

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 the "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 the proposals. In addition, it was agreed that the International Bureau would have the authority to forward to the Working Group additional proposals that are consistent with the general objectives established by the Committee for the Working Group. Therefore, the United States would like to request that the International Bureau forward the following additional proposals to the Working Group for consideration as falling within the established objectives.

BACKGROUND

2. Prior to the establishment of the Committee on PCT Reform, the Ad Hoc Advisory Group On PCT Legal Matters held a series of meetings to discuss the continued updating of the PCT regulations. Out of these discussions, various changes to the regulations were recommended, the most recent of which were the changes implemented in March 2000 concerning the inclusion of national stage declarations as part of the International Application Request. When the Ad Hoc Group last met, additional rule changes were under consideration that, in view of the authority given to the International Bureau discussed above, appear to be proper for submission by the International Bureau to the Working Group.

PROPOSALS

Proposal to amend Rule 8.1(d)

3. Under Rule 8.1(d), the abstract is currently required to contain reference signs that correspond to the figures. Further, if an abstract is filed without such reference signs, the ISA is required under Rule 38.2(a) to rewrite the abstract, inserting the appropriate reference signs. A large percentage of applications filed under the PCT are filed without such reference signs in the abstract. This has a significant impact on the workload issues being faced by ISAs due to the fact that a large amount of time is expended to rewrite the abstracts in order to insert these signs. While in the past these reference signs were somewhat helpful, they have become largely unnecessary due to the removal of the abstract and figure from the Gazette and, with the availability of full text searching of the international publication on the Internet in the foreseeable future, their importance will be even further diminished. Therefore, it is proposed that Rule 8.1(d) be amended to remove the mandatory inclusion of these signs. (Working Group objectives i, iii, and vi.)

Proposed amended Rule 8.1(d):

(d) Each main technical feature mentioned in the abstract and illustrated by a drawing in the international application ~~shall~~ may be followed by a reference sign, placed between parentheses.

Proposal to amend Rule 26bis.1(a)

4. Currently, under Rule 26bis, if applicant mistakenly makes a priority claim which is more than one year prior to the International Filing Date (IFD), then that priority claim may only be corrected during the period which expires 4 months from the IFD. For example, under the current Rule, if an applicant was entitled to make a claim for priority of 6 months prior to the IFD but instead mistakenly indicated the priority date as being 1 year and 6 months prior to the IFD, then that applicant would be limited to a period of only 4 months from the IFD (i.e., 10 months from the correct priority claim) in order to request a correction to the priority claim. It is therefore proposed that Rule 26bis.1(a) be amended to provide that the applicant instead be permitted to correct the priority date up to 16 months from the correct priority date (i.e., 10 months from the IFD). Such an amendment to the Rule would eliminate this trap for applicants, simplify the Rule as a whole, and would not adversely affect the publication date of the application. (WG objectives i, vi, and xi.)

Proposed amended Rule 26bis.1(a):

(a) The applicant may correct or add a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date of the earliest existing, corrected, or added priority claim which is in accordance with Rule 4.10(a)(i). ~~or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16 month period expires first provided that such a notice may be submitted until the expiration of or four months from the international filing date.~~ The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

Proposal to amend PCT Rule 59.3

5. Currently, Rule 59.3 provides that when a Demand is filed in a non-competent office or authority it is to be forwarded to the IB or the competent IPEA by the non-competent office or authority. Since the implementation of the current version of Rule 59.3, applicants are increasingly taking advantage of this provision that allows them the benefit and ease of filing Demands in their own receiving offices and having those demands considered as being timely filed in the competent examining authority. As a result, this provision adds to the increasing workload burdens on offices and authorities. While Rule 59.3 provides a substantial benefit to applicants, it does not provide any relief for affected offices and authorities in order to deal with the resultant workload increases. Therefore, it is proposed that Rule 59.3 be amended to allow the non-competent office or authority that must accept, process, and forward these improperly filed Demands, to charge applicants a fee for this service. (WG objectives iii and vi.)

Proposed amended Rule 59.3:

(a) If the demand is submitted to a receiving Office, an International Searching Authority, or an International Preliminary Examining Authority which is not competent for the international preliminary examination of the international application, that Office or Authority shall mark the date of receipt on the demand and, unless it decides to proceed under paragraph (f), transmit the demand promptly to the International Bureau. Such transmittal may be subjected by the Office or Authority to the payment of a fee, for its own benefit, equal to the transmittal fee charged by that Office under Rule 14.

(b) to (e) [No change]

(f) Where an Office or Authority to which the demand is submitted under paragraph (a) decides to transmit that demand directly to the competent International Preliminary Examining Authority, paragraphs (c) to (e) shall apply mutatis mutandis. Such transmittal may be subjected by the Office or Authority to the payment of a fee, for its own benefit, equal to the transmittal fee charged by that Office under Rule 14.

Proposal to amend PCT Rule 90bis.3

6. Currently, if an application is filed with a priority claim which is outside the one year period and if applicant requests that such a claim be withdrawn as opposed to allowing the RO to declare that the claim is considered not to have been made in accordance with Rule 26bis.2(b), a literal interpretation of the Rules would result in the unduly harsh penalty of excluding from recomputation any time limits that have already expired based on the original priority date. For example, under the current rule, if an applicant mistakenly makes a priority claim with a priority date of 19 months prior to the IFD, and then upon realizing the error requests withdrawal of the priority claim, the 15 month time limit for confirmation of precautionary designations and the 19 month time limit for filing the Demand under Article 40 would not be subject to recomputation, and thus lost to applicant. While it is unlikely that any Office or Authority would take such an extremely adverse course of action, and further while such a course of action is arguably not proper under Articles 2 and 8, the Rules should be amended for clarity. (WG objective xi.)

Proposed amended Rule 90bis.3(d):

(d) Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change. The provisions of this paragraph shall not apply to the withdrawal of priority claims which are not in accordance with Rule 4.10(a)(i).

Proposal to amend PCT Rule 90bis.6

7. Currently, the Rules provide that upon withdrawal of the application by applicant all international processing shall cease, but the Rules do not carry any such provision concerning withdrawal by the Receiving Office. While this would seem to be the obvious result of withdrawal of the application by the RO, the fact that the Rules address the effect of one type of withdrawal (by applicant) while not addressing the other type of withdrawal (by the RO) gives rise to the question of the effect of the latter type of withdrawal. Rather than addressing only one type of withdrawal, the Rules should address both types for the purposes of consistency, clarity, and in order to remove any ambiguity. (WG objective xi.)

Proposed amended Rule 90bis.6:

(b) Where the international application is withdrawn under Article 14(1)(b) and Rule 26.5, or Article 14(3)(a), Article 14(4), or Rule 90bis.1, the international processing of the international application shall be discontinued.

Proposal to amend PCT Rule 91

8. Currently, Rule 91 encourages applicants to submit rectifications of obvious errors to the description, claims, drawings, and abstract. However, in many instances applicants submit rectifications that are not proper for acceptance under the provisions of Rule 91, but rather are proper for consideration under Article 34 in that they go beyond the scope of what is defined as obvious in the Rule. This results in a significant increase in the workload of the authorities as they process, review, and respond to these improper submissions, which likewise take an inordinate amount of time away from the authorities' ability to process the applications in a timely manner. This workload is further increased when applicants who, are still confused about what is proper for submission under Rule 91 versus what is proper under Article 34, ask for reconsideration of their "rectifications" which have been refused

9. Additionally, in applications where the receiving Office is different from the International Searching Authority, applicants are also often confused as to where to send the rectifications of the description, claims, drawings, and abstract. This then often leads to increased workloads on the ROs as they are forced to process and respond to rectifications which should have been submitted to the ISA, and leads to delays in having the rectification considered by the ISA.

10. Further, since the designated/elected offices rely on the publication of the international application as constituting subject matter directly corresponding to that which was originally filed, the presence of rectified sheets in the description, claims, and drawings portions of the international publication can lead to uncertainty as to what precisely constitutes the original disclosure in the international application.

11. Finally, Rule 91.1 currently allows only for rectification of obvious errors, where obvious is defined by the following: "the rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification." Therefore, since such rectifications must by definition be obvious to anyone, there is no real need to correct the error before publication, since anyone reading the publication would realize what applicant intended.

12. Therefore, in view of the above discussion, it is proposed to that Rule 91 be amended to eliminate obvious rectifications to the description, claims, drawings, and abstract. (WG objectives i, iii, vi, and xi.)

Proposed amended Rule 91.1:

(a) Subject to paragraphs (b) to (g-*quater*), obvious errors in the ~~international application~~ request or other papers submitted by the applicant (except for in the description, claims, drawings, and abstract) may be rectified.

(b) to (d) [No change]

(e) No rectification shall be made except with the express authorization:

(i) of the receiving Office if the error is in the request or in any paper submitted to that office (except for in the description, claims, drawings, and abstract),

(ii) of the International Searching Authority if the error is ~~in any part of the international application other than the request~~ or in any paper submitted to that Authority,

(iii) of the International Preliminary Examining Authority if the error is ~~in any part of the international application other than the request~~ or in any paper submitted to that Authority, and

(iv) of the International Bureau if the error is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

(f) to (g-*quater*) [No change]

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