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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

SUMMARY OF THE SESSION

prepared by the Chair

INTRODUCTION

1. The session was opened by Mr. François Curchod, Deputy Director General, on behalf of the Director General. The list of participants is contained in document PCT/R/WG/INF/1. Mr. Philip Thomas (WIPO) acted as Chair of the session and Mr. Claus Matthes (WIPO) as Secretary.

2. The matters for discussion at the session were the following, as recommended by the Committee on Reform of the PCT (“the Committee”) at its 1st session in May 2001 and agreed by the Assembly of the PCT Union (“the Assembly”) at its 30th (13th ordinary) session in September-October 2001 (see the Committee’s report in document PCT/R/1/26, paragraphs 69 to 75, and the Assembly’s report in document PCT/A/30/7, paragraphs 15 to 22):¹

- (i) the concept and operation of the designation system;
- (ii) improved coordination of international search and international preliminary examination and the time limit for entering the national phase;

¹ See WIPO’s web site at http://www.wipo.int/pct/en/reform/index_1.htm (for the Committee) and http://www.wipo.int/eng/document/govbody/wo_pct/index_30.htm (for the Assembly).

- (iii) conform filing date requirements to those in the Patent Law Treaty (PLT), conform “missing part”-type requirements to PLT procedure, and other PLT-consistent changes;
- (iv) (possibly) other proposals for general simplification and streamlining of PCT procedures.

3. The session’s proceedings were informal. All five days of the session were devoted to discussions, and there was no formal report. This summary sets out the Chair’s view of the status of the matters discussed by the Working Group, noting areas where agreement has been reached and identifying what future work needs to be undertaken. Substantive issues raised are summarized, but particular interventions are not recorded.

4. The Working Group’s discussions were based on the documents listed in the Annex,² as well as the reports of the Committee and the Assembly mentioned in paragraph 2, above.

5. Revised proposals will be prepared by the International Bureau taking into account the discussion and conclusions reflected in this document and other points of detail noted by the Secretariat.

6. It was noted that the question of the mechanism for reporting the results of the Working Group’s work to the Committee would need to be addressed at the next session of the Working Group.

IMPROVED COORDINATION OF INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION AND THE TIME LIMIT FOR ENTERING THE NATIONAL PHASE³

7. Discussions were based on documents PCT/R/WG/1/2, 3, 3 Add.1, 3 Add.2 and 7, focusing on a proposed system for an expanded international search report (EISR), which would include an opinion of the examiner in addition to the present contents of the ISR proper.

8. The general concept of the proposed EISR attracted great interest and considerable support, subject to certain comments and concerns mentioned below. As a basic consideration, it was necessary to meet the needs of certain DOs and EOs, particularly small and medium-sized Offices, including those in developing countries, for examiners’ opinions, especially in view of the recent adoption by the Assembly of a 30-month time limit for

² The working documents for the Working Group’s session are available on WIPO’s web site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

³ References in this document to “Articles” and “Rules” are, unless otherwise specified, to those of the Patent Cooperation Treaty (PCT) and of the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be. The following abbreviations are also used: “RO” (receiving Office), “DO” (designated Office), “EO” (elected Office), “IB” (International Bureau), “IS” (international search), “ISA” (International Searching Authority), “ISR” (international search report), “IPE” (international preliminary examination), “IPEA” (International Preliminary Examining Authority) and “IPER” (international preliminary examination report).

entering the national phase under Article 22. While it was recognized that other proposals for reform of the PCT search and examination system might be elaborated, none had been put forward so far, and the EISR proposal was a useful starting point for discussion.

9. The comments and concerns expressed by various delegations as to the implications of a possible EISR system included the following:

- (i) while the heavy workload faced by some ISAs and IPEAs was an important feature in the background, proposals which merely deferred the problem or shifted workload onto applicants or other Offices were not the most satisfactory;
- (ii) any increase in fees associated with the proposed EISR system compared to the present fees for IS would be a matter for serious concern, particularly for inventors and small enterprises; suggestions made by the larger ISAs as to maintaining the present fees for EISR, or containing any increases, and offsetting any increase by a reduction of the fees for IPE were, however, encouraging;
- (iii) the proposal was seen by certain delegations as a valuable step in the direction of greater mutual recognition of search and examination results and eventually towards the development of a world patent system;
- (iv) while recognizing the efficiencies that would result from search and examination being undertaken by the same examiner at the same time, some delegations would prefer to retain a separated system, at least as an option for applicants and/or Authorities;
- (v) some delegations felt that the EISR system, if adopted, should be optional for applicants, particularly if it would involve payment of higher fees at the time of filing the application; other delegations felt that the EISR system should be mandatory, particularly having regard to the consequences of the Assembly's adoption of a 30-month time limit under Article 22;
- (vi) it was agreed that the EISR should be produced as part of the IS rather than the IPE procedure;
- (vii) while the examiner's opinion and the ISR proper should, under an EISR system, be established at the same time by the same examiner, a number of delegations felt that the two components could, and should, then be processed separately;
- (viii) delegations differed as to whether the examiner's opinion should be made public or remain confidential between the ISA, DOs and the applicant; some believed that the opinion would contain little more of substance than the ISR proper, and should therefore be published with it; others believed that public availability of a negative opinion could be unfairly damaging, particularly if the applicant had no chance to rebut it;
- (ix) the interest of DOs in receiving the EISR, particularly smaller DOs, including those in developing countries, was clearly recognized;
- (x) many delegations expressed concern at the suggestion that the EISR might not be available in sufficient time to enable the applicant to withdraw the application

before its publication if the EISR was negative; it was also noted, however, that certain ISAs are in any event finding difficulty in meeting the present time limit for producing ISRs;

- (xi) most delegations believed that IPE following the issuance of an EISR should not be mandatory but rather that it should follow only if the applicant so requested;
- (xii) while the maximum advantage from the EISR procedure would accrue if the same examiner carried out both the EISR and any subsequent IPE, it was not necessary to require that the same Authority must conduct both the IS and the IPE; it was already possible for IPEAs to declare themselves prepared to examine only those applications which they have searched as ISA, and certain IPEAs had already exercised that option;
- (xiii) while certain delegations believed that an EISR should be confined to an elaboration of details contained in the ISR, most delegations felt that it should cover similar matters to those dealt with in the present first written opinion in the IPE procedure;
- (xiv) certain delegations emphasized the distinction between, on the one hand, publication of the opinion part of the EISR as part of the published pamphlet, which could be unfairly damaging to applicants, and, on the other, making it available for public inspection like other parts of the application file;
- (xv) concern was expressed that the EISR procedure might add new burdens on the IB to prepare a translation of the opinion during the international phase and on applicants to prepare translations of comments for the purposes of the national phase;
- (xvi) the operation of the EISR procedure should be as simple as possible.

Expanded international search (EIS) system: Possible features

10. It was agreed that the International Bureau should prepare a revised proposal, along the lines of the system outlined in the following subparagraphs, for consideration by the Working Group at its next session:^{4, 5}

- (a) For all international applications, the examiner in the ISA would, as part of the IS procedure, prepare a more detailed opinion (ISO) at the same time as preparing the ISR.
- (b) The scope and contents of the ISO would be similar to the present first written opinion in the IPE procedure (see Rule 66.2(a)).
- (c) The ISR should be published, as at present, with the international application itself (that is, 18 months from the priority date). It was recognized, however, that certain ISAs are facing difficulties in meeting the present deadline for production of ISRs and that that

⁴ All references to time limits in the following subparagraphs should be understood as subject to review in the context of paragraph 10(o).

⁵ Square brackets indicate that alternatives would be included in the revised proposals.

problem may need to be addressed soon, and certain delegations felt that increased flexibility in the time limit for establishing the ISR and ISO would be necessary.

- (d) The ISO would be communicated to the applicant with the ISR.
- (e) The applicant would have to choose which of the following options to pursue:
 - (i) request IPE within, say, [two months from the date of the ISO] [25 months from the priority date];
 - (ii) submit to the IB comments on the ISO (and the ISR) and/or submit Article 19 amendments and an accompanying statement;
 - (iii) withdraw the application;
 - (iv) do nothing.
- (f) If the applicant requested IPE:
 - (i) the processing of the application would be governed by Chapter II;
 - (ii) the ISO would, if the same Office acted in the capacity of ISA and IPEA, be treated as a first written opinion in the IPE procedure; if different Offices carried out the IS and the IPE, the IPEA would be entitled, but would not be obliged, to treat the ISO as the first written opinion in the IPE procedure;
 - (iii) [the ISO would remain confidential as against third parties and DOs and EOs until such time as the IPER was established and the IPE file became available to public inspection (via the EO); if the demand was withdrawn before establishment of the IPER, the application would revert to Chapter I and the ISO would be made available for public inspection accordingly] [the ISO should be available for public inspection at an earlier stage, noting the interest of third parties in having access to it, even when IPE was requested];
 - (iv) any comments responding to the ISO would be treated as being submitted as arguments and/or amendments under Article 34;
 - (v) the IPER would be established and communicated in the usual way.
- (g) If the applicant did not request IPE:
 - (i) the processing of the application would be governed by Chapter I;
 - (ii) the ISO, together with any comments, would be sent to DOs;
 - (iii) the ISO, together with any comments, would be made available for public inspection by the IB; when the IB's systems so permitted, this would be done by electronic means;

- (iv) the ISO and any comments would not be included in the published pamphlet (or its electronic equivalent);
- (v) the ISO would be made available for public inspection [at the expiry of the time limit for requesting IPE] [after the expiry of the time limit for submitting comments] [at a time corresponding to the time at which the IPER would normally issue (say, 28 months from the priority date)];
- (vi) any Article 19 amendments and statement would, as at present, be published together with the published pamphlet (or its electronic equivalent) (unless the ISR was not yet available, in which case the amendments and statement would be published later).

(h) Comments would need to be submitted at an early stage in order to be taken into account during the IPE procedure. If IPE was not requested, they should be submitted before the ISO was made publicly available if they were to be made available with the ISO, but comments submitted later in the international phase could still be made available and taken into consideration during the national phase.

(i) Possibilities for greater incorporation of the Article 19 procedure into the EIS system should be investigated.

(j) [If the applicant withdrew the application before its publication, the ISR would not be published and the ISO would not be made available for public inspection.] [If the ISR and ISO did not become available in sufficient time to enable withdrawal of the application before its publication, the ISO would not be made available for public inspection if the applicant withdrew the application forthwith after receiving them.]

(k) Provision should be made to enable the demand to be filed, if the applicant so wished, at the same time as the filing of the application; in such a case:

- (i) the IPE would not commence until the necessary fees had been paid; those fees would not need to be paid at the time of filing but would fall due at the expiration of the time limit for requesting IPE;
- (ii) new possibilities for a combination of IS and IPE, such as was presently envisaged in present Rule 69.1(b), should be investigated and improved procedures for such a combined procedure should be developed.

(l) An outer time limit should be fixed for requesting IPE; the IPEA would be entitled to refuse to proceed with the IPE if it was requested after the expiration of that time limit.

(m) A system should also be introduced to enable the IPER to be made available for public inspection by the IB, on behalf of the EOs.

(n) Appropriate provision should be made to enable applicants to give notice of proposed amendments of the description and drawings (as well as the claims) in comments filed in response to the ISO, and for those proposed amendments to be taken into account by DOs in the event that the applicant did not request IPE.

(o) The fixing of appropriate time limits would require consideration of the following issues:

- (i) special provision should be made for international applications not claiming priority (PCT “first filings”) as, for example, the time limits under present Rule 46;
- (ii) the time limit for submitting comments on an ISO should enable them to be submitted in time to be made available for public inspection together with the ISO;
- (iii) the time limits for filing a demand and for filing amendments under Article 34 should be reviewed so as to ensure optimal coordination of the EIS and IPE procedures;
- (iv) earlier time limits may need to apply in cases where the same Office did not act in the capacity of both ISA and IPEA;
- (v) the need for flexibility for applicants and Authorities in meeting various different requirements would need to be balanced against the need for a system with clear and certain operation.

(p) Further consideration needed to be given to requirements relating to the language and possibly translations of the ISO and any comments submitted on it (noting that the ISR and IPER are presently translated by the IB into English, and applicants are presently required to furnish translations of the application and annexes to the IPER for the purposes of the national phase).

THE CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM

11. Discussions were based on the proposed new or amended Rules set out in document PCT/R/WG/1/1 and on document PCT/R/WG/1/7.

Proposed new approach with regard to designations (see Rules 4, 49bis and 90bis)

12. The comments and concerns expressed by various delegations included the following:

- (i) the proposed new approach of Rule 4.9(a) and (b), in so far as it would enable applicants to make an automatic indication of all designations possible under the PCT, was fully supported;
- (ii) noting that the proposed Rule changes would defer to the national phase all decisions and choices by the applicant as to the countries in which protection was sought and as to the kinds of protection sought, certain delegations expressed the view that applicants should have the possibility of excluding designations at the time of filing the international application and/or of withdrawing designations later during the international phase, notwithstanding that this would retain a degree of complexity in the system; certain reasons expressed are noted in items (iii) to (vii), below;

- (iii) it was noted that Article 8(2)(b) expressly contemplated the possibility that an international application may include the designation of only one State; other Articles to be borne in mind in this context included Articles 22, 24 and 37;
- (iv) the applicable national law in certain countries would be incompatible with an automatic designation system which did not allow for exclusions of certain designations; for example, some national laws provided for the automatic withdrawal of an earlier national application if a later international application claimed priority based on that national application and designated the country concerned (“self-designation”); this was a matter of great concern to the Delegations of Germany and Japan, in particular;
- (v) applicants might be under contractual obligations not to seek protection in certain countries, although it was noted that contractual obligations could be expressed differently if the system were changed so as to operate on different principles;
- (vi) it would be necessary in some circumstances to be certain that the designation of a particular country did not have undesirable results arising from the prior art effect of the international application in that country;
- (vii) certain provisions relating to the requirement applicable in certain countries that the inventors be indicated as applicants would be burdensome to comply with in cases where the applicant had no intention of entering the national phase in those countries;
- (viii) it was noted that, where the international application was to be treated as an application for a continuation or continuation-in-part, information concerning the parent application involved was needed at the time of filing the international application;
- (ix) in the context of proposed amended Rule 4.15, most delegations expressed support for yet a further reduction of the requirement for signature of the international application; a review of the present requirements should include a review of provisions concerning the appointment of agents and common representatives;
- (x) Rule 32 should be reviewed to see whether, in the light of the proposed new all-inclusive approach to designations, successor States could not automatically be dealt with by the same kind of approach.

13. It was agreed that the approach taken in document PCT/R/WG/1/1 in connection with Rules 4, 49*bis* and 90*bis* should be retained, subject to further consideration of the matters mentioned in paragraph 12, above, and to the following:

- (i) a [transitional] reservation provision should be included which would enable applicants to exclude and/or withdraw the designation of any State whose Office had notified the IB, [subject to the timing provisions usual for such provisions,] that proposed Rule 4.9(a) and (b) were incompatible with the national law applicable in that State;

- (ii) a revised draft should include the following alternatives for consideration:
 - (1) eliminate all signature requirements;
 - (2) require the signature of only one applicant where the international application is filed by several applicants (and similarly in the case of the demand);
 - (3) provide for an RO to waive the need for signature of the international application requirements for papers filed with that Office;
 - (4) provide for an RO to waive the need for a power of attorney where the international application is filed by an agent;
- (iii) where the international application was to be treated as an application for a continuation or continuation-in-part, information concerning the parent application involved should continue to be required in the request;
- (iv) the International Bureau should study the issues mentioned above relating to Articles 8, 22, 24 and 37, prior art effect, the naming of inventors as applicants, and Rule 32, and should provide the results to the Working Group.

Proposed introduction of a single “flat” international filing fee (Rules 15, 16bis, 27, 29, 32 and 51, and Schedule of Fees)

14. The comments and concerns expressed by various delegations included the following:
- (i) the introduction of a flat international filing fee, replacing the current separate basic fee and designation fee(s), was fully supported;
 - (ii) the proposed flat fee would be appropriate even if it were decided that applicants should continue to have the possibility of excluding and/or withdrawing designations;
 - (iii) the fixing of the amount of the new fee, which would take place in the context of approving WIPO’s budget, should take into account the general objective of PCT reform to further reduce costs for applicants; certain delegations expressed the view that the new fee should be lower than the total amount of the basic fee and the maximum number of designation fees payable;
 - (iv) the representative of IFIA proposed a study of the possibility of granting a fee reduction to all those applicants who are “natural persons”, irrespective of their nationality and residence;
 - (v) there was a lack of available information for third parties as to whether and when international applications had entered the national phase; possibilities included: the (hitherto incomplete) provision of such information by DOs under Rule 86.1(a)(vi) and Section 112; a task already being undertaken in the context of WIPO’s Standing Committee on Information Technologies (see documents SCIT/6/5 and 7); and information produced as a by-product of the use by DOs of the communication-on-request (“COR”) system being developed under WIPO’s IMPACT project.
15. It was agreed that the approach taken in proposed Rules 15, 16bis, 27, 29, 32 and 51, and in the Schedule of Fees, should be retained, subject to further consideration of the matters mentioned in paragraph 14, above.

Proposed new approach with regard to elections (see Rules 53, 56 and 90bis)

16. The comments and concerns expressed by various delegations included the following:
- (i) most delegations expressed support for the proposed new approach of Rules 53 and 56 in so far as it would enable applicants to make an automatic indication of all possible elections;
 - (ii) similar considerations applied in the case of elections as in that of designations in relation to the possible need for applicants to be able to exclude and/or withdraw particular elections;
 - (iii) it was noted that Article 31(4) expressly mentioned the possibility that Contracting States may be elected later and that Article 37 expressly stated that the applicant may withdraw any election;
 - (iv) Rule 61.4 should be further reviewed with a view to aligning its current wording with the new approach with regard to elections.
17. It was agreed that the approach taken in proposed Rules 53, 56 and 90bis should be retained, subject to further consideration of the matters mentioned in paragraph 16, above.

Proposed introduction of a “communication on request” system (Rules 24.2, 47, 48, 73, 76.5 and 93bis)

18. The comments and concerns expressed by various delegations included the following:
- (i) the coming introduction of the new “communication on request” (COR) system, replacing the current systematic communication of documents to DOs, was noted with approval;
 - (ii) certain delegations representing member States with large Offices indicated that, even under the COR system, they wished to continue to receive, preferably in electronic form, all documents related to international applications in which the Office concerned was designated, irrespective of whether national phase entry had taken place; the COR system would support such systematic communication;
 - (iii) the COR system should be extended to include communications to ISAs and IPEAs as well as DOs/EOs;
 - (iv) Rule 47.1(c), which contained provisions designed to safeguard applicants’ rights having regard to Article 22 in connection with the communication of international applications to DOs, should be reviewed to ensure that the safeguards would operate satisfactorily in conjunction with the COR system;
 - (v) consideration should be given to combining Rules 47.1(b) and 47.4;
 - (vi) Rule 61.2 should be reviewed to ensure that it would operate satisfactorily with the COR system, noting that Article 31(7) expressly stated that each EO must be notified of its election.

19. It was agreed that the approach taken in proposed Rules 24.2, 47, 48, 73, 76.5 and 93*bis* should be retained, subject to further consideration of the matters mentioned in paragraph 18, above.

CHANGES RELATED TO THE PATENT LAW TREATY (PLT)

20. Discussions were based on document PCT/R/WG/1/5.

21. There was wide agreement as to the following general observations made by various delegations:

- (i) while the international phase was in general exempt from the provisions of the PLT, the principles of the PLT should so far as possible be taken up in the PCT in order to achieve the same benefits for applicants and Offices in the filing and processing of international applications as would be available for national applications; however, particular PLT-related matters should be examined on their merits to ascertain how best to deal with them in the context of the PCT;
- (ii) certain features of the PCT system differed from national and regional patent systems, and those differences needed to be borne in mind; some aspects of the PLT were less relevant than others in the context of the PCT system; factors to be taken into account included the following:
 - the PCT system is administered by a plurality of Offices and Authorities and the IB rather than by a single national or regional Office;
 - there are certain time constraints peculiar to the PCT, such as the time limit for establishing the international search report;
 - in some practical respects, the filing of a national application bears more similarity to national phase entry under the PCT than to the filing of an international application;
 - some of these differences would result in greater complexity in terms of procedures and/or drafting when considering implementation under the PCT than was the case under the PLT, for example, provisions as to language of filing and the furnishing of translations;
 - international applications were usually filed after, and claiming priority from, previously filed national applications.
- (iii) while some provisions of the PLT could be implemented readily by changing the PCT Regulations, others would require changing the Articles of the Treaty itself; some amendments to the Regulations proposed in document PCT/R/WG/1/5 raised difficulties of possible inconsistency, to varying degrees, with the Articles, for example, in providing for the according of a filing date where no claims were present in an international application;
- (iv) while changes to the Regulations could be implemented more quickly, the formulation of proposed changes to the Articles should also be addressed at an early stage;

- (v) priority should be given by the Working Group to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities; for example, priority might be given to the following:
- provisions for restoration of the priority right in certain circumstances;
 - relief when time limits were missed, especially the time limit for entering the national phase.

Right of priority and priority claims

22. Discussions were based on document PCT/R/WG/1/5, and in particular on proposed new Rule 26bis.3, contained in Annex III to that document, which would provide for restoration of the priority right for up to two months beyond the usual 12-month priority period. The comments and concerns expressed by various delegations included the following:

- (i) there was general agreement with the idea of providing for a means of restoration of priority rights, consistently with corresponding provisions of the PLT, during the international phase of the PCT procedure;
- (ii) noting that the administration of those provisions in the national phase would be a matter for ROs, the importance of a single standard, or at least consistent practice, among the various ROs was emphasized by several delegations;
- (iii) delegations differed in their views as to the appropriate criterion which should apply in the context of the PCT (under Rule 26bis.3(a)(iii)) in cases where the applicant failed to file the international application within the 12-month priority period, noting that the PLT provided for Contracting Parties to choose between two criteria:
 - most delegations favored adopting the more liberal criterion of “unintentional” failure in the context of the PCT;
 - certain delegations favored adopting the more strict criterion of “due care”;
 - certain delegations favored giving ROs a choice as to which of the two criteria to apply, as would be the case for Contracting Parties to the PLT;
- (iv) it was recognized by the Working Group that provision for restoration of the priority right in the international phase implied that the RO’s decision would need to have effect for the purposes of the national phase;
- (v) most delegations believed that the RO’s decision should be binding on DOs (as under proposed Rule 26bis.3(f)), but certain delegations believed that the RO’s decision should be subject to review by DOs in at least some circumstances, although there was no agreement as to what circumstances should be relevant in this context;

- (vi) it was pointed out that, if the PCT were to require that one particular criterion be applied by all ROs, it would be possible for an Office to have to apply one criterion in its capacity as a PCT RO and the other criterion in its capacity as a national Office processing national applications or as a DO processing international applications entering the national phase;
- (vii) it was recognized that priority dates had two related but distinct effects:
 - “procedural” in the sense that certain important time limits under the PCT were calculated by reference to the priority date;
 - “substantive” in the sense that it was at the priority date that it would be determined whether the invention satisfied the requirements of novelty and inventive step (non-obviousness);
- (viii) the recognition in the national phase of an RO’s decision to restore the priority right was more particularly related to the procedural effect; the procedural effect was the dominant consideration in, for example, PCT Article 2(xi) and Rule 26*bis*.2(a);
- (ix) the fact that a considerable number of countries’ national laws did not presently provide for restoration of priority rights, at least according to PLT criteria, suggested that transitional reservations would need to be allowed for if restoration provisions were to be introduced under the PCT.

23. It was agreed that the International Bureau should prepare a revised proposal which would:

- (i) provide for restoration of the priority right by the RO based on the “unintentional” criterion, but identifying alternatives in the related comments or explanation;
- (ii) make it clear that it was the procedural effect of the priority right, rather than the substantive effect, that should be recognized for the purposes of the national phase.

Time limit for entering the national phase

24. It was agreed that the International Bureau should prepare a proposal which would provide in the PCT Regulations for extensions of the time limit for entering the national phase, similarly to PLT Article 3(1)(b)(i) read in the light of PLT Articles 11 and 12.

International application filed without claims

25. Discussions were based on document PCT/R/WG/1/5, and in particular on proposed new Rules 20.4(d) and 26.3*ter*, contained in Annex I to that document, which would provide for claims to be considered to be filed as a legal fiction and to be added later as a correction of a formality defect. The comments and concerns expressed by various delegations included the following:

- (i) the idea of according a filing date under the PCT to an international application without claims was widely supported, but the wording of Articles 11(1)(iii)(e)

and 58 did not support the draft Rules proposed; it would be necessary to develop a proposal to revise the Treaty itself;

- (ii) to adopt amended Regulations that were so clearly inconsistent with the Treaty itself would jeopardize the rights of applicants;
- (iii) the Treaty provided no basis for adding claims before the international search took place; a problem may also be posed by Articles 19 and 34 which provide that amendments shall not go beyond the disclosure in the international application as filed;
- (iv) the representatives of users emphasized the need to find a solution in the PCT for such cases; PCT applicants should not be at a disadvantage in this respect compared to applicants filing national applications.

26. The Working Group would be prepared to consider other ways of dealing with international applications having no claims pending revision of the Treaty itself. The International Bureau would attempt to elaborate proposals bearing in mind, in particular, the following possibilities:

- (i) the Treaty distinguishes between the “international application” on the one hand and the “record copy” on the other; different treatment may be able to be accorded to papers according to those different notions;
- (ii) advantage might be able to be taken in cases where there is “claim-like” wording appearing in the description; it was noted that the procedure under the European Patent Convention provided for the description to repeat, in effect, the wording of the claims;
- (iii) the request form could include pre-printed wording sufficient to constitute “a part which on the face of it appears to be a claim or claims” for the purposes of Article 11(1)(iii)(e);
- (iv) the international search might be able to be undertaken without the presence of formal claims, or on the basis of a “search statement” furnished by the applicant;
- (v) new possibilities being developed for combined search and examination under the PCT might allow for claims furnished under Article 34 to be taken into account for both international search and international preliminary examination.

“Reference filings”

27. Discussions were based on document PCT/R/WG/1/5, and in particular on proposed new Rule 20.4(e), contained in Annex I to that document, which would provide for a reference to another document to replace the description, drawings and claims. The comments and concerns expressed by various delegations included the following:

- (i) some delegations supported and others opposed the proposal;
- (ii) the cases requiring this kind of remedy were rare, and certain delegations felt that this issue should not have a high priority;

- (iii) any proposals in this direction should be coordinated with the EIS proposal (see above);
- (iv) user representatives expressed their support for a proposal which would permit such reference filings under the PCT.

28. The Working Group agreed that the question of reference filings should be reconsidered in substance and in terms of its priority among the other proposals before the Working Group.

OTHER PROPOSALS FOR GENERAL SIMPLIFICATION AND STREAMLINING OF PCT PROCEDURES

29. Discussions were based on document PCT/R/WG/1/4, outlining proposals for amendment of the PCT Regulations made by the United States of America, and document PCT/R/WG/1/6, outlining a proposal for amendment of the PCT Regulations made by Australia.

Proposal to amend Rule 8.1(d) (see document PCT/R/WG/1/4)

30. The comments and concerns expressed by various delegations included the following:
- (i) while some delegations expressed support for the proposal, most delegations expressed the view that Rule 8.1(d) should remain unchanged, noting that reference signs in abstracts were helpful for the purposes of search, in particular in the electronic version of the PCT Gazette on the Internet;
 - (ii) it was noted that one possible way to address the issue of workload of ISAs could be to review Rule 38.2(a) with a view to clarify the responsibility of the ISA for the inserting of appropriate reference signs where the abstract did not comply with Rule 8.

31. It was agreed that the proposal to amend Rule 8.1(d) should not be included in the revised drafts to be prepared by the International Bureau, although delegations may wish to further consider the matter in the light of the discussion.

Proposal to amend Rule 26bis.1(a) (see document PCT/R/WG/1/4)

32. The comments and concerns expressed by various delegations included the following:
- (i) while some delegations expressed concern about the current wording of Rule 26bis.1(a) being too complex and indicated that an attempt should be made to simplify the calculation of the time limit under that Rule, most delegations supported the approach of the proposal, subject to further clarification, noting that, in any event, opportunity to correct or add a priority claim should be given only prior to publication of the international application concerned;
 - (ii) it was felt that the presentation of examples as to how Rule 26bis.1 as proposed to be amended would operate would facilitate discussions.

33. It was agreed that a revised proposal to amend Rule 26*bis*.1, including examples, should be included in revised proposals to be prepared by the International Bureau in the context of PLT-related proposals concerning priority rights and priority claims, taking into account the matters mentioned in paragraph 32, above.

Proposal to amend Rule 91 (see document PCT/R/WG/1/4)

34. The comments and concerns expressed by various delegations included the following:

- (i) while some delegations expressed support for the approach taken in the proposal, others felt that the correction of obvious errors should not be limited to errors occurring in the request but should continue to be possible also with regard to such errors in the description, claims and drawings; any such requests for correction should be dealt with as early as possible during the international phase rather than by individual DOs in the national phase;
- (ii) noting the workload of Offices in dealing with requests under present Rule 91, it was recognized that a balanced solution would have to be found which would continue to give applicants the flexibility needed to correct obvious errors without putting too heavy a burden on Offices dealing with requests for rectifications;
- (iii) noting ongoing discussions in the context of the draft SPLT, some delegations expressed their desire for a review of the present definition of “obvious error” under Rule 91.1(b).

35. It was agreed that the proposal to amend Rule 91 should not be included in revised drafts to be prepared by the International Bureau, although delegations may wish to further consider the matter in the light of the discussion.

Proposal to introduce a fee for correction of defects under Article 14 (see document PCT/R/WG/1/6)

36. The comments and concerns expressed by various delegations included the following:

- (i) while some delegations expressed support for the approach taken in the proposal, most delegations expressed the view that, rather than introducing a new fee, attempt should be made to remove sources of non-compliance with Article 14, that is, by reviewing certain requirements under that Article, in particular relating to signatures and appointment of agents and common representatives, as discussed in the context of the draft proposals contained in document PCT/R/WG/1/1;
- (ii) it was noted that a possible alternative to the approach taken in the proposal would be, for example, for an RO which wished to do so to provide for a refund of part of the transmittal fee depending on the extent of compliance with Article 14.

37. In light of the discussion, the Working Group agreed that the proposal should not proceed at this stage.

MR. FRANÇOIS CURCHOD

38. The Working Group expressed its thanks and best wishes to Mr. Curchod, who would be leaving WIPO at the end of November 2001.

NEXT SESSION

39. The International Bureau indicated that the second session of the Working Group was tentatively scheduled for April 29 to May 3, 2002 (to be followed the next week by the seventh session of the Standing Committee on the Law of Patents).

40. This document was prepared under the responsibility of the Chair alone, taking into account comments made by delegations on the draft (Prov.) version of the document.

[Annex follows]

ANNEX

LIST OF DOCUMENTS

PCT/R/WG/1/1	The concept and operation of the designation system (document prepared by the International Bureau)
PCT/R/WG/1/2	Improved coordination of international search and international preliminary examination and the time limit for entering the national phase (document prepared by the International Bureau)
PCT/R/WG/1/3	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)
PCT/R/WG/1/3 Add.1	Addendum: Sample expanded international search report (proposals submitted by the United States of America)
PCT/R/WG/1/3 Add.2	Addendum: Additional steps toward workload reduction (submitted by the United States of America)
PCT/R/WG/1/4	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)
PCT/R/WG/1/5	Changes related to the Patent Law Treaty (PLT): Contents of the international application; Language of the international application and translations; Right of priority and priority claims; Time limits (document prepared by the International Bureau)
PCT/R/WG/1/6	Proposed fee for correction of defects under Article 14 (proposal submitted by Australia)
PCT/R/WG/1/7	Reform of the PCT: Designation system; PLT-related matters; International search and international preliminary examination (comments by the International Federation of Inventors' Associations (IFIA))
PCT/R/WG/1/8	Language of the international application and translations (proposals submitted by the Republic of Korea)

[End of Annex and of document]