

WORLD INTELLECTUAL PROPERTY
ORGANIZATION

世界知识产权组织

ORGANIZACION MUNDIAL
DE LA PROPIEDAD INTELECTUAL



ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE

المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

C. PCT 835

– 04

The International Bureau of the World Intellectual Property Organization
./ (WIPO) presents its compliments and has the honor to transmit herewith
documents PCT/R/WG/2/1 Add.1, 5 Add.1, 7 Add.1, 9, 10 and 11, prepared for
the second session of the *Working Group on Reform of the Patent Cooperation
Treaty (PCT)*, which was held in Geneva from April 29 to May 3, 2002.

The working documents are also available on WIPO's Web site
(see <http://www.wipo.int/pct/en/meetings>).

May 21, 2002

Enclosures: documents PCT/R/WG/2/1 Add.1, 5 Add.1, 7 Add.1,
9, 9 Corr., 10 and 11

WORLD INTELLECTUAL PROPERTY
ORGANIZATION

世界知识产权组织

ORGANIZACION MUNDIAL
DE LA PROPIEDAD INTELECTUAL



ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE

المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

C. PCT 835

- 04

Le Bureau international de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) présente ses compliments et a l'honneur de transmettre ./ ci-joint les documents PCT/R/WG/2/1 Add.1, 5 Add.1, 7, 7 Add.1, 9, 10 et 11, élaborés en vue de la deuxième session du *Groupe de travail sur la réforme du Traité de coopération en matière de brevets (PCT)*, qui s'est tenue à Genève du 29 avril au 3 mai 2002.

Les documents de travail sont aussi disponibles sur le site Internet de l'OMPI (voir <http://www.wipo.int/pct/fr/meetings>).

Le 21 mai 2002

Pièces jointes : documents PCT/R/WG/2/1 Add.1, 5 Add.1, 7, 7 Add.1, 9, 10 et 11

WIPO



PCT/R/WG/2/1 Add.1

ORIGINAL: English

DATE: April 25, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Second Session
Geneva, April 29 to May 3, 2002

PROPOSED EXPANDED INTERNATIONAL SEARCH SYSTEM: EPO RESPONSE
(ADDENDUM TO DOCUMENT PCT/R/WG/2/1)

Proposals submitted by the European Patent Office (EPO)

EPO RESPONSE TO DOCUMENT PCT/R/WG/2/1

Generally

1. The European Patent Office (EPO) supports in principle the proposal described in the working document, subject to certain points of detail which are mentioned at paragraphs 11-14 below. In fact the EPO sees an expanded international search report system as the preferred avenue for the international stage processing of all international applications in the longer term. *A model of such an expanded international search report comprising the international search report and an international search opinion is annexed to this document.* This would involve the removal of the current distinction between PCT Chapter I and Chapter II processing under PCT as has already been advocated by the US delegation in documents PCT/R/1/2 and PCT/R/WG/1/2.

2. While it appears to be recognized within the Working Group that the workload problems faced by some if not all International Authorities under PCT are “an important feature in the background” in fact the significance of this problem is much deeper; it has to be considered as a prime factor in the need for PCT reform. The intolerable burden on many

E

of the International Authorities under PCT (and here it should be borne in mind that the EPO performed over 60% of all international search work and 57% of all international preliminary examination work in 2001) represents not just a practical problem for the International Authorities concerned, rather a serious threat to the continuing viability of the PCT system as a whole.

3. The current inefficiencies in the system must be eliminated. An elaborate optional international preliminary examination system involving the issue of a first written opinion followed by an automatic right of response followed in turn by further possible written opinions followed by an International Preliminary Examination Report, all within a very narrow time limit, may have been feasible when the PCT was drafted, however, given the exponential growth in use of the system in recent years a fundamental overhaul is necessary.

Objectives of reform as seen by the EPO

4. What has to be achieved to ensure a functioning PCT system in the 21st Century is an efficient procedure for processing international applications which delivers high quality search reports and opinions on patentability which meet the needs of applicants as well as third parties and national offices and which can be delivered at reasonable cost and within a reasonable time frame. To this end the EPO considers that medium term efforts should concentrate on removing the uncertainty inherent in the current system whereby a demand for international preliminary examination may or may not be filed sometime after issue of the international search report. This has the added disadvantage that whether or not an opinion on patentability ultimately becomes available is entirely in the hands of the applicant.

5. In the EPO's view, it is both efficient and desirable to combine international search and the principal elements of international preliminary examination in an expanded international search report. This product would be available for all international applications without the need to file any demand for international preliminary examination and would represent significant added value compared with an international search report alone. The applicant would receive a preliminary opinion on patentability (ISO) at an early stage rather than as at present having to wait for a first written opinion and IPER. Third parties and national offices would have access to comprehensive information on whether a given invention meets the requirements of patentability, *without depending on the applicant to file a demand.*

Advantages of an EISR System

6. Combined with the recent change to Article 22 PCT *all applicants* would have maximum opportunity to consider the desirability of entering the national/regional phase. It could then reasonably be expected that most "dead wood" applications would be sifted out of the system during the international phase. This would also allow *national offices* to avoid the prohibition in Article 42 PCT forbidding national offices in receipt of an International Preliminary Examination Report from requiring the applicant to furnish information on the content of parallel prosecution of the application before other national offices. This would be a considerable advantage to those national offices which lack sufficient resources to examine international applications for themselves.

Procedure

7. The applicant's right to amend and/or comment on his application would not be affected under such a system. The EPO appreciates the concerns which may exist on the part of some

applicants about the effect of an ISO which is in any sense negative before certain designated offices. However, nothing would prevent applicants from filing amendments to the international application under Article 19 PCT or submitting comments on the EISR as is envisaged at Paragraph 7 of the working document. These amendments/comments would be taken into account during national/regional as opposed to international processing. The right to amend before the designated offices under Article 28 PCT would also remain unaffected.

8. It is appreciated that the opportunity for dialogue between applicant and IPEA is enshrined in Chapter II of the PCT, however it is submitted that given the availability of an ISO in all cases, the longer term need for such a dialogue based system must be reconsidered. From a practical point of view also, if, as expected, only a minority of applicants continue to make use of Chapter II, the economic sustainability of such a system must be questionable. In the EPO's view the ISO would in due course replace PCT Chapter II. Of course the opportunity for dialogue must be preserved – but is it right that this should take place during international processing when the time available for genuine dialogue is very limited? It is suggested that it would be more appropriate to shift the dialogue phase of the PCT procedure to national/regional processing, when the time pressure is not so acute.

9. Applicants would of course remain free to initiate national/regional processing before any particular national office before expiry of the usual 30/31 month time limit under Article 23(2) PCT. This could well include the national or regional office responsible in its capacity as International Search Authority for the EISR. The international phase would still be pending before the other national offices but the communications between applicant and “the early entry” national office could, under certain circumstances, give rise to a product not dissimilar in content to a current IPER susceptible to assisting prosecution of the international application before those other national offices.

10. These comments represent the EPO's general outlook on the concept of an EISR System. It is appreciated that these ideas may involve a more fundamental revision of the PCT than is envisaged in this first stage of reform. However, the EPO is firmly of the view that the current proposal for EISR should be seen as a step in this overall direction and it should be avoided so far as possible at this stage to entrench in any proposed rule changes concerning EISR references to international preliminary examination which may well become obsolete and inappropriate in light of the development of the EISR system.

As to the working document itself, the following points occur:

11. *Paragraphs 9 and 10:* the EPO fully supports the applicant's right to submit comments and make amendments in light of the ISO but a clear distinction must be drawn between the two. If the applicant wishes amendments to be taken into account during national/regional processing he must clearly indicate this and where appropriate file replacement sheets. It should be avoided at all costs that the burden of deciding whether comments incorporate amendments fall upon the national offices. With this in mind it is suggested to amend proposed Rule 43*ter*.2 (b) to exclude the possibility of filing amendments within comments – rather amendments should always be filed separately.

12. *At paragraph 25:* reference is made to a “second written opinion.” This is unacceptable since Rule 66.4 already makes provision for the issue of one or more written opinions *at the discretion of the IPEA*. Introducing an *obligation* to issue a second written opinion could only increase the workload pressure on the International Authorities and lead to delay in establishing the IPER. This would be in the interest of neither the International

Authorities nor the elected offices. If the applicant reacted to the ISO it is suggested that the IPEA proceed immediately to issue of the IPER without any interim second written opinion. Of course provision could be made for the applicant to submit comments on the IPER, along the same lines as the procedure described at Paragraphs 8 and 9 of the working document in relation to the ISO, however these comments would be taken into account only during national/regional processing, not during the international phase. In view of these remarks it is suggested that all reference to the proposed Rule 66.4(a-bis) be deleted.

13. As to the question of introducing *a fixed time limit for filing the demand*, this is supported. However the time limit should be calculated with reference to the date of issue of the international search opinion only. The suggestion to allow the demand to be filed together with the international application is not supported. The purpose of the ISO would be to provide a high value written opinion in light of which the applicant should be in a position to assess the prospects for further prosecution of the international application. It is to be anticipated that this opinion will meet the needs of the vast majority of applicants and together with the recent amendment to the time limit under Article 22 PCT future use of Chapter II is likely to diminish. It would be contrary to the underlying rationale of the EISR proposal to allow demands to be filed before the international search opinion had even issued. International Authorities could then be faced with having to process demands for international preliminary examination which had only been filed as a precaution and which, had the applicant given due consideration to the international search opinion would not have been filed; they could also be faced with the administrative burden of dealing with large scale withdrawal of demands after issue of the international search opinion. Proposed Rule 54bis.1 should be amended accordingly. The following is suggested:

“Rule 54bis.1 *Time limit for Making a Demand*

“(a) A demand may be made within two months from transmittal of the international search opinion to the applicant under Rule 43bis.4.”

14. Consideration should be given to the question of transitional provisions for applications filed and still pending before entry into force of the proposed EISR system as well as an opportunity for the International Authorities to adapt themselves to the new system.

15. The Working Group is invited to consider the proposals contained in this document.

[Annex I follows]

ANNEX I

PATENT COOPERATION TREATY (PCT)
INTERNATIONAL SEARCH REPORT (ISR) - PART 1
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

FOR FURTHER ACTION See Notification of Transmittal of ISR (Form PCT/ISA/220) as well as, where applicable, abstract information below

Applicant's or agent's file reference: AGGR/01/01
International application No: PCT/EP01/98989
International filing date: 01 April 2001 (01/04/2001)
(Earliest) priority date: 02 April 2000 (02/04/2000)
Applicant: Heath Robinson

This report has been prepared by this International Searching Authority (IPEA) and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

It consists of two parts: Part 1 contains comments on the international application. Part 2 contains the results of the search, the subject matter classification and the fields searched.

It is also accompanied by a copy of each prior art document cited in the report.

(1) Basis of the report

With regard to the language, the international search was carried out on the basis of the international application in the language in which it was filed.

With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international search was carried out on the basis of the sequence listing: not applicable.

(2) Certain claims were found unsearchable

This report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

Claim(s) No(s): 1,2

because they relate to subject matter not required to be searched by this Authority:

Claims 1,2 directed to an instruction manual with particular wording are considered to be mere presentations of information and is subject matter the ISA is not required to search under Article 17(2)(a)(i) and Rule 39.1(v).

(3) Unity of invention is lacking

This Authority found multiple inventions in this international application, as follows:

- *Claims 1 - 18 directed to a sealing body and an instruction manual for its use*
- *Claim 19 - 28 directed to an apparatus, but not limited to an apparatus comprising the sealing body of claims 3 - 18*

No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is restricted to the invention first mentioned in the claims; it is covered by claims Nos. 3-18

(4) Title

The text is approved as submitted by the applicant.

(5) Abstract

The text is approved as submitted by the applicant.

(6) Drawings

The figure of the drawings to be published with the abstract is Figure No: 1 as suggested by the applicant.

**** End of Part 1 of the ISR ****

PATENT COOPERATION TREATY (PCT)
INTERNATIONAL SEARCH REPORT (ISR) - PART 2

(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

(21) International application No.: PCT/EP01/98989	Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched: Not applicable
(51) CLASSIFICATION OF SUBJECT MATTER IPC⁷: G06K11/14	
(58) FIELDS SEARCHED Minimum documentation searched: IPC⁷: G06K	Electronic database consulted during the international search: EPO-Internal, PAJ, WPI Data

DOCUMENTS CONSIDERED TO BE RELEVANT

(Citation of document, with indication, where appropriate, of the relevant passage(*), followed by category and claim(s) No(s))

(1) US 5 332 238 A (BORUCKI G) 26 July 1994 cited in the application <i>*column 2, line 1-27; figures 4,5*</i> Category: Y Claims: 1,6,7,9 <i>*column 7, line 32-55*</i> Category: X Claims: 18	more other such documents, such combination being obvious to a person skilled in the art.
<hr/>	
Patent family information	
* US 4 816 811 A:	
	EP 0 196 186 A,B 01.10.1986
	JP 61223932 A 04.10.1986
	US 4 816 811 A 28.03.1989
	CA 1 270 309 A 12.06.1990
	DE 3 682 927 D 30.01.1992
	KR 9 309 671 B 08.10.1993
* EP 0 740 264 A:	
	JP 9044291 A 14.02.1997
* WO 98 52184 A:	
	AU 7 151 098 A 08.12.1998
	JP 11065765 A 09.03.1999
	EP 1 019 897 A 19.07.2000
	BR 9 809 121 A 01.08.2000
	CN 1 269 043 T 04.10.2000
	AU 732877 B 03.05.2001
	US 6 236 391 B 22.05.2001
<hr/>	
(2) US 5 784 054 A (KENT JOEL C ET AL) 21 July 1998; cited in the application <i>*column 6, line 61-65; figures 1,2,4,8, column 7, line 35-65*</i> Category: Y Claims: 1,6,7,14,15,18	
(3) US 4 816 811 A (BOGATIN ERIC L ET AL) 28 March 1989 <i>*column 4, line 57,58; figures 2-4*</i> Category: A Claims: 1,9	
(4) EP 0 740 264 A (GORE & ASS) 30 October 1996 <i>*column 8, line 7-10; figure 1; column 9, line 18-column 13, line 8*</i> Category: Y Claims: 1,6,7,9 Category: A Claims: 2, 18	
(5) WO 98 52184 A (ELO TOUCHSYSTEMS INC) 19 November 1998 <i>*page 21, line 9-1; figures 5,6*</i> Category: A Claims: 1, 18	
(6) US 5 852 433 A (TODA KOHJI) 22 December 1998 <i>*column 6, line 20-28; figure 1*</i> Category: A Claims: 1, 18	

ISA/Examiner: European Patent Office

SPIGARELLI, Alfred
 PB 5818, Patentlaan 2
 NL 2280 HV Rijswijk
 Tel. +31 - 70 340 2040
 Fax. +31 - 70 340 3016

Search completed: 24 July 2001
 ISR mailed: 28 July 2001

**** End of the ISR ****

Special categories of cited documents:

- A: document defining the general state of the art which is not considered to be of particular relevance.
- X: The claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone.
- Y: The claimed invention cannot be considered to involve an inventive step when the document is combined with one or

[Annex II follows]

ANNEX II

**PATENT COOPERATION TREATY (PCT)
INTERNATIONAL SEARCH OPINION**

International application No: PCT/EP01/98989
 International filing date: 01 April 2001 (01/04/2001)
 Priority date: 02 April 2000 (02/04/2000)
 International Patent Classification (IPC)
 or national classification and IPC: G06K11/14

This opinion contains indications relating to:

- Basis of the opinion
- Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
- Lack of unity of invention
- Reasoned statement with regard to novelty, inventive step or industrial applicability

(1) Basis of the opinion

This opinion has been drawn up on the basis of
(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as 'originally filed' and are not annexed to the report since they do not contain amendments):

The description,
 pages 1-21 as originally filed

The claims,
 Nos. 1-28 as originally filed

The drawings, sheets/figs.
 1/2-2/2 as originally filed

(3) Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The question whether the claimed invention appears to be novel, to involve an inventive step or to be industrially applicable have not been examined in respect of claims Nos. 1, 2 because:
 No ISR has been established in respect of the claim(s).

(4) Lack of unity of invention

The requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is not complied with for the reasons given in the ISR. In response to the invitation to pay additional fees due for searching under Article 17(3)(a), the applicant has not paid additional fees. Consequently, the parts of the international application relating to claims 3- 18 were the subject of this opinion.

(5) Novelty, Inventive step and industrial applicability

Novelty (N): Claim(s) 3-17 Yes

Inventive Step (IS): Claim(s) 8, 10-12 Yes
 Claim(s) 3-7, 9, 14-18 No

Industrial Applicability (IA): Claim(s) 3-18 Yes

INDEPENDENT CLAIM 3

Document US-A-5 332 238, which is considered to represent the most relevant state of the art, discloses (cf. relevant passages indicated in the ISR) a device from which the subject-matter of independent claim 3 differs in that the elongate sealing body is an elongate gel body.

The problem to be solved by the present invention may therefore be regarded as finding a suitable material for making the elongate sealing body.

The solution proposed in claim 3 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT) for the following reasons:

EP-A-0 740 264 (cf. relevant passages indicated in the ISR), discloses such a sealing body comprising a silicone elastomer, namely a sealing body made of a composition comprising a gel.

INDEPENDENT CLAIM 18

Document US-A-5 332 238 (cf. relevant passages indicated in the ISR) discloses in combination all the features defined in independent claim 18.

Therefore the subject matter of this claim is not new (Article 33(2) PCT).

DEPENDENT CLAIMS

The following dependent claims do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step:

The additional features of claims 4, 5 and 9 are known from document EP-A-0 740264 (cf. relevant parts indicated in the ISR);

the additional features of claims 6 and 7 are already disclosed in US-A-5 332 238 (cf. relevant passages indicated in the ISR);

**** End of the ISO****

[End of Annex and of document]

WIPO



PCT/R/WG/2/5 Add.1

ORIGINAL: English

DATE: April 29, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

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

Second Session

Geneva, April 29 to May 3, 2002

PROPOSED NEW RULE 12.4
(ADDENDUM TO DOCUMENT PCT/R/WG/2/5)

Proposals submitted by the Republic of Korea

Rule 12

**Language of the International Application and Translation
for the Purposes of International Search and International Publication**

12.1 [No change]

12.2 *Language of Changes in the International Application*

(a) [No change]

(b) Any rectification under Rule 91.1 of an obvious error in the international application shall be in the language in which the application is filed, provided that:

(i) where a translation of the international application is required under Rule 12.3(a), [12.4\(a\)](#) ~~48.3(b)~~ or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language of the application and the language of that translation;

(ii) [No change]

12.3 [No change]

[12.4 Translation for the Purposes of International Publication](#)

[\(a\) Where the language in which the international application is filed is not a language of publication and no translation is required under Rule 12.3\(a\), the applicant shall, within 14 months](#)

from the priority date, furnish to the receiving Office a translation of the international application into English. ~~Rule 12.3(b) shall apply mutatis mutandis.~~

(b) Paragraph (a) shall not apply to the request nor to any sequence listing part of the description.

(c) Where the applicant has not, within the time limit referred to in paragraph (a), furnished a translation required under that paragraph, the receiving Office shall invite the applicant to furnish the required translation, and to pay, where applicable, the late furnishing fee required under paragraph (e), within 16 months from the priority date. Any translation received by the receiving Office before that Office sends the invitation under the previous sentence shall be considered to have been received before the expiration of the time limit under paragraph (a).

(d) Where the applicant has not, within the time limit under paragraph (c), furnished the required translation and paid any required late furnishing fee, the international application shall be considered withdrawn and the receiving Office shall so declare. Any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 17 months from the priority date shall be considered to have been received before the expiration of that time limit.

(e) The furnishing of a translation after the expiration of the time limit under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late furnishing fee equal to 50% of the basic fee.

WIPO



PCT/R/WG/2/7 Add.1

ORIGINAL: English

DATE: April 22, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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

Second Session
Geneva, April 29 to May 3, 2002

SIGNATURE REQUIREMENTS (ADDENDUM TO DOCUMENT PCT/R/WG/2/7)

Proposals submitted by Australia

1. Document PCT/R/WG/2/7 proposes a range of changes to reduce, or eliminate, the signature requirements under the PCT. IPAustralia supports those changes.

2. IPAustralia notes that in past meetings there have been some concerns expressed in relation to the issue of withdrawals. Those concerns are perhaps well expressed in the comment provided on page 13 of Annex II of document PCT/R/WG/2/7 – namely:

“[COMMENT: Along the lines of what has been suggested in alternative (2) in paragraph 13(ii) of the first session summary, it is proposed that, where the international application is filed by two or more applicants, the signature of one of them is sufficient for a withdrawal under Rule 90*bis*. In the absence of any replacement provision, the effect of this deletion would be to permit one co-applicant to withdraw an international application, etc. without (even contrary to) the agreement of the other co-applicant(s).]”

3. IPAustralia shares concerns about the possibility of one of several joint applicants withdrawing an application contrary to the wishes of the other applicants. However, while a signature requirement is one way to address this issue, we do not believe it to always be an adequate solution. For example, it does not address the situation where signatures are forged.

E

Also, a requirement that all applicants sign the withdrawal does not accommodate those situations where one or more of the applicants is reasonably unavailable to sign the withdrawal.

4. IPAustralia considers that the preferable way to treat this issue is the approach adopted in the Patent Law Treaty in (for example) Articles 6(6), 8(4)(c) or 12(4), or Rules 7(4), 15(4) or 16(6). Namely, to provide that the Office with which the withdrawal is filed can ask for evidence that the withdrawal is done with the necessary authority. It may be that in many situations a signature on the withdrawal, together with other surrounding circumstances, is sufficient to satisfy the Office that the withdrawal is a ‘proper’ withdrawal. But such a provision would allow an Office to ask for evidence where, despite the withdrawal being signed, there are surrounding circumstances that suggest the withdrawal is not a ‘proper’ withdrawal. It would also allow an Office to effect a withdrawal where the surrounding circumstances give little doubt that the withdrawal is ‘proper’ despite the withdrawal not being signed.

5. Accordingly, IPAustralia suggests that Rule 90*bis*.5 should be replaced with text like the following, adapted from PLT Rule 16(6):

“An Office may require that evidence be filed with the Office [only] where that Office may reasonably doubt the veracity of the withdrawal.”

6. In addition, problems can arise in the context of recording name changes under Rule 92*bis* where applicants seek to join or remove other applicants without the approval of the applicants of record, or third parties attempt to be joined as an applicant. IPAustralia considers that a similar provision should be provided in Rule 92*bis* to facilitate dealing with these issues.

7. The Working Group is invited to consider the proposals contained in this document.

[End of document]

WIPO



PCT/R/WG/2/9

ORIGINAL: English

DATE: April 19, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Second Session
Geneva, April 29 to May 3, 2002

REVISED U.S. PROPOSAL FOR PCT REFORM;
COUNTERPROPOSAL TO DOCUMENT PCT/R/WG/2/1

Proposal submitted by the United States of America

E

BACKGROUND

1. At the first session of the Committee on Reform of the Patent Cooperation Treaty which was held from May 21 to 25, 2001, the Committee established a series of 11 objectives that the Committee and the subsequently formed Working Group were to be guided by in developing a proposal for reform of the Treaty. In November 2001, the Working Group met to discuss specific proposals for reformation of the Treaty. The discussions centered largely on a proposal by the United States of America for simplification and streamlining of the PCT system through the combining of the Search and Examination phases of PCT processing (document PCT/R/WG/1/3). During the discussions numerous concerns were raised about the U.S. proposal and various modifications to the U.S. proposal were suggested. These concerns and modifications were raised in light of the 11 objectives established by the Committee. The result of taking into account those concerns and modifications discussed at the first session of the Working Group is the proposal for reform which is currently set forth in document PCT/R/WG/2/1.

2. A review of the system as set forth in document PCT/R/WG/2/1 reveals that, in contrast to the simple streamlined procedure proposed by the United States of America, document PCT/R/WG/2/1 establishes a system that is even more complex than the current PCT system (see Flowcharts 1–3). Therefore, in view of the complexities of the system developed through the guidance of the 11 Committee-established objectives for PCT reform, it is suggested that the Working Group take a step back and look at the original reasons for suggesting reform of the Treaty and the objectives for reform that were established by the PCT Assembly in calling for reform.

3. At the meeting of the PCT Assembly in September/October 2000, a proposal for reform of the PCT was presented by the United States of America (document PCT/A/29/3). This proposal was established based on the increasing workloads being experienced by the both United States of America and other International Authorities, as well as on the continued confusion being experienced by applicants and Offices alike in dealing with the complexities of the current PCT system. In addition, reform of the PCT was raised in light of conformance with the recently completed Patent Law Treaty. The U.S. proposal suggested implementing PCT Reform in two stages, and in the first paragraph of the portion of the proposal titled “The First Stage of Reform” it is stated:

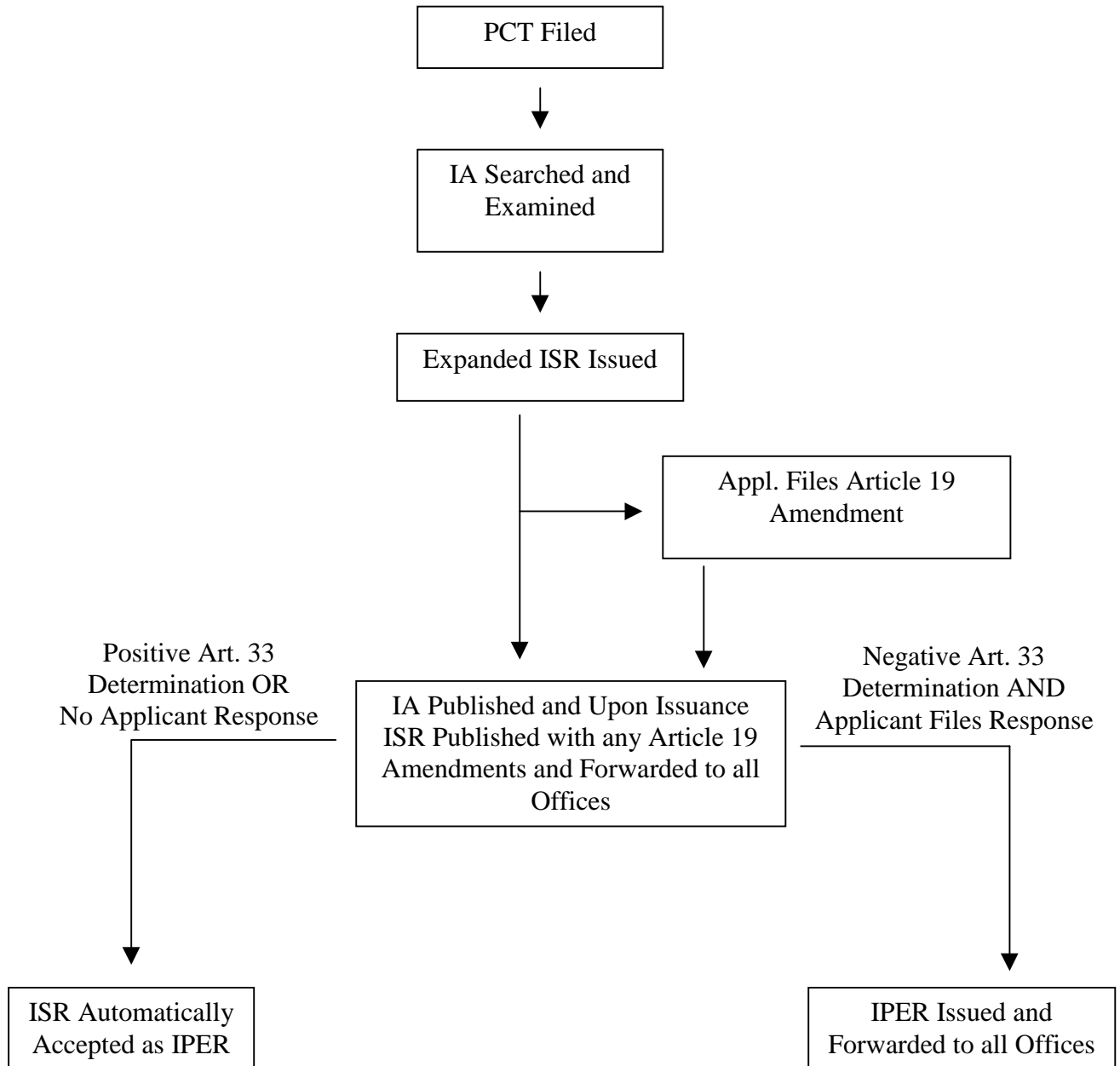
“...The first stage could include modest, *simplifying and PLT-based changes* that would be targeted for implementation in about five years. To that end, the PCT Assembly could...impose a relatively narrow mandate on a PCT revision committee to carry out this first-stage work.” (emphasis added)

4. After discussions on the matter the Assembly adopted the following decision:

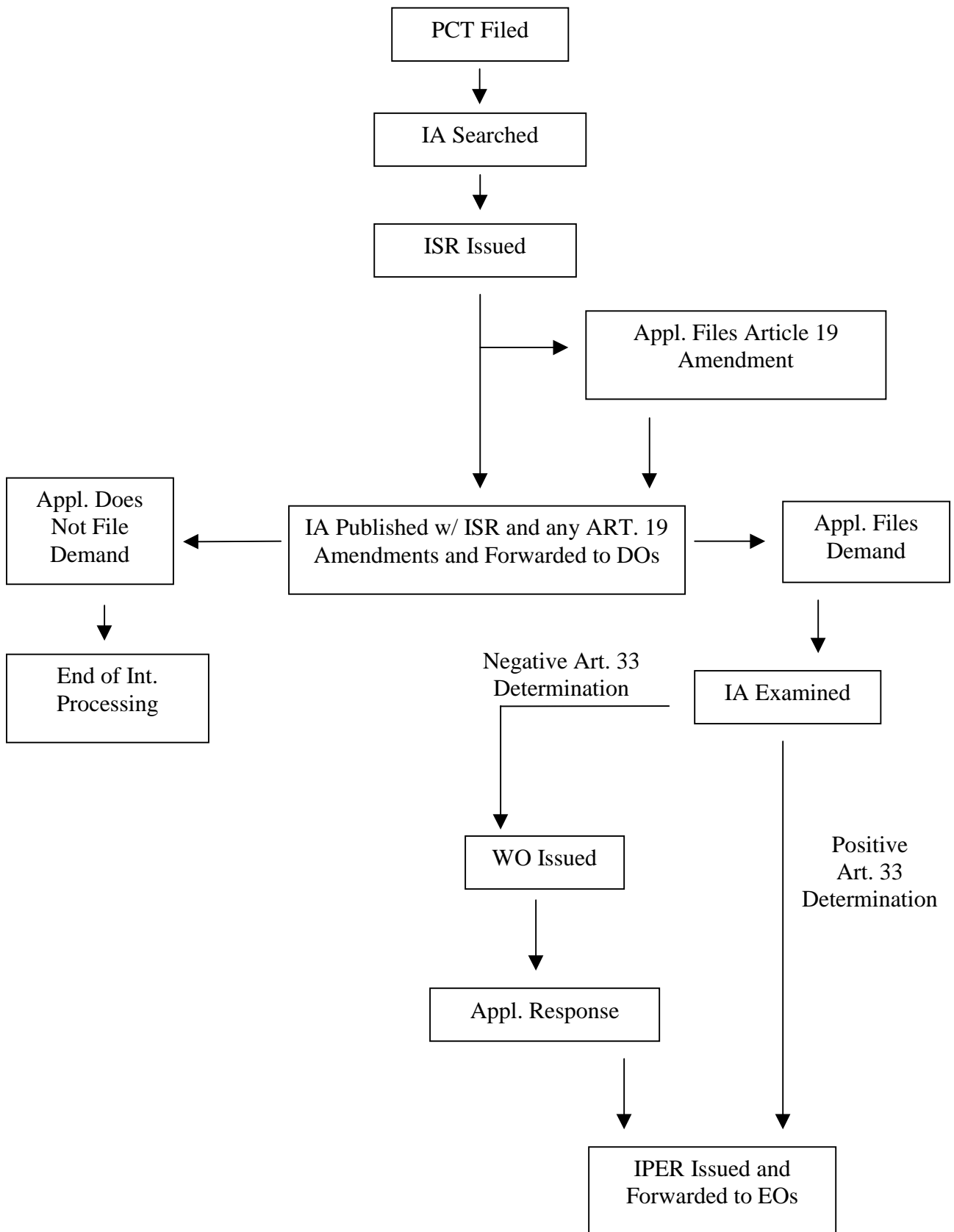
“The Assembly of the PCT Union decided:

(i) that a special body would be set up to consider, as a first step, proposals for the reform of the PCT that would pursue the same objectives as those defined under the title ‘The First Stage of Reform’ of the Annex to document PCT/A/29/3...”
(document PCT/A/29/4, para. 51)

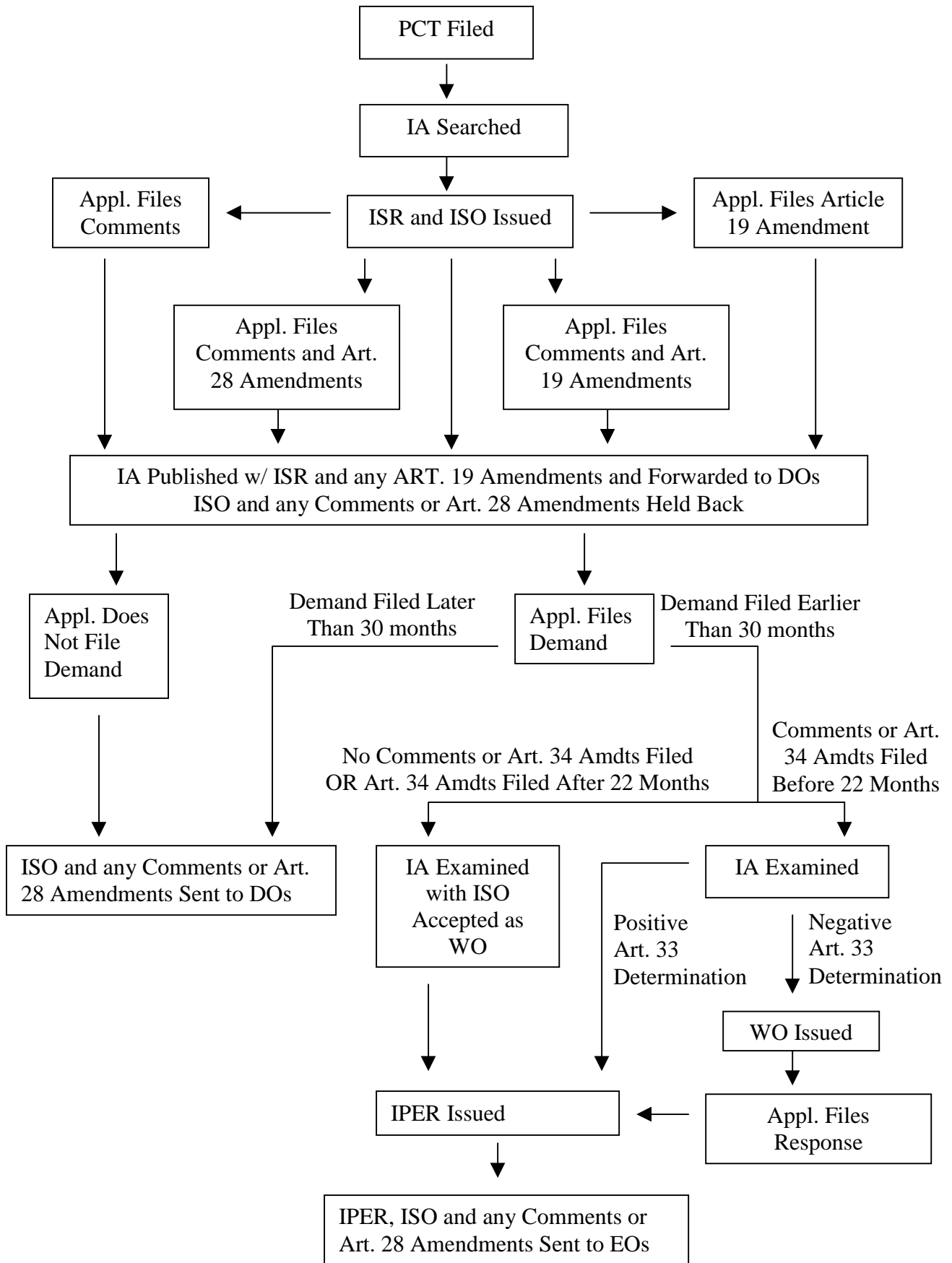
FLOWCHART #1: US PROPOSAL FOR SIMPLIFIED PCT SYSTEM



FLOWCHART #2: CURRENT PCT SYSTEM



FLOWCHART #3: PCT SYSTEM AS SET FORTH IN DOCUMENT PCT/R/WG/2/1

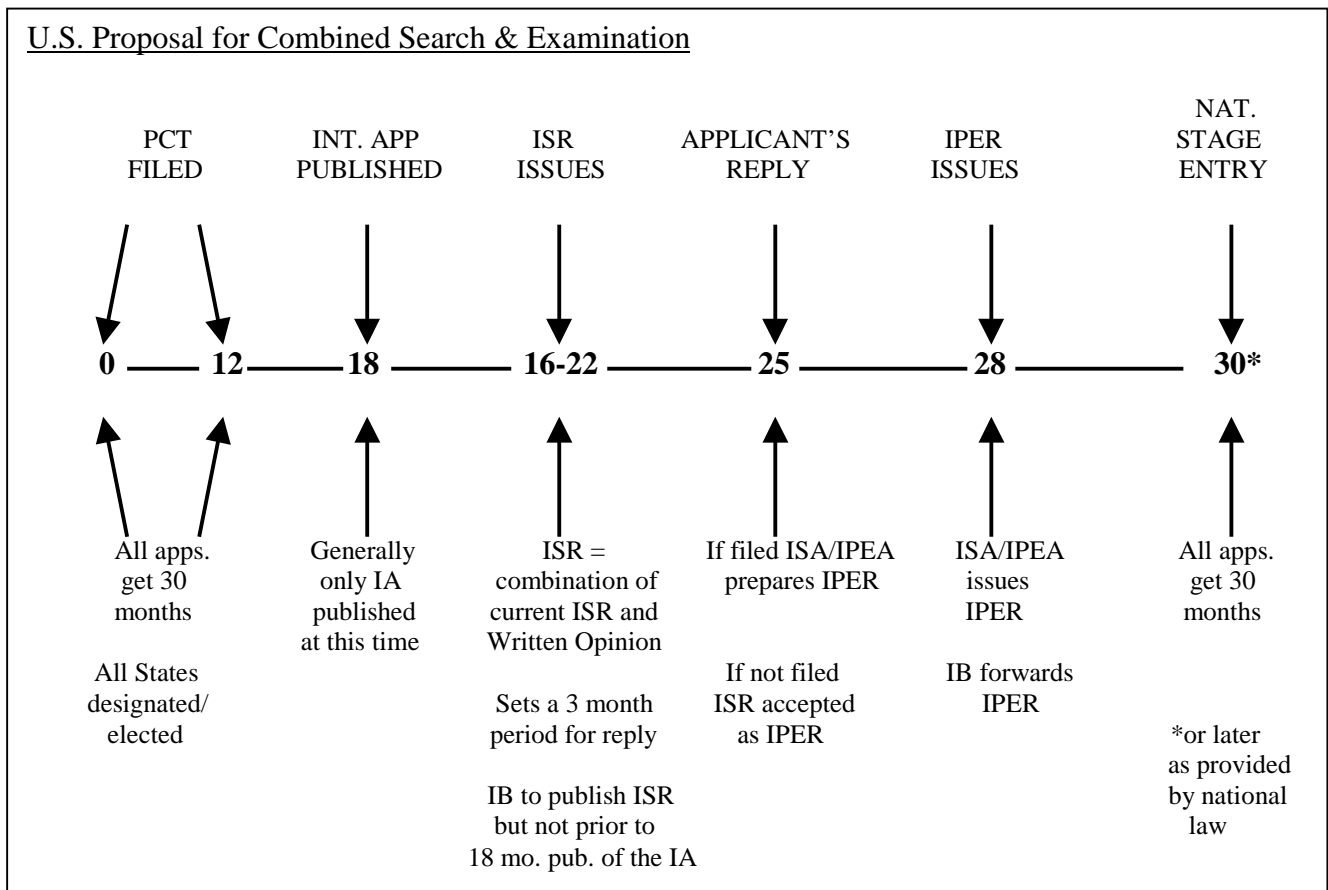


5. Therefore, it can be seen that the Committee on PCT Reform was charged with developing a reformed system based on two objectives: simplification and PLT conformance. If the result of the work of the Working Group to date is the overly complex system set forth in document PCT/R/WG/2/1, then it has clearly failed in accomplishing the task with which it was charged by the Assembly.

6. It is the position of the United States of America that if this Working Group and the Committee for PCT Reform are to accomplish the task mandated by the Assembly then it must look anew at establishing a reformed PCT processing system with primarily simplification and PLT conformance in mind. In this light, the United States of America hereby submits its revised proposal for consolidation of the Search and Examination phases of international processing.

REVISED U.S. PROPOSAL FOR PCT REFORM INCLUDING COMBINED SEARCH AND EXAMINATION

7. In general, the U.S. proposal, as set forth in the below schematic representation, sets forth a system which has the following general provisions: (1) the PCT application would be filed, (2) publication of the application would still occur at 18 months, (3) an ISR (which would be expanded from its current format to include an opinion portion) would be issued by the International Searching Authority/International Preliminary Examining Authority, (4) an IPER would be prepared ONLY if a response to a negative ISR were filed, and otherwise the ISR would be accepted as the IPER, and (5) 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)

8. Upon filing of the PCT international application, all applicants would automatically have 30 months to enter the national stage. This has initially been accomplished by means of amendment to the Article 22 time period, via an Article 47 change. However, it is envisioned that eventually this will be addressed through a merging of Chapters I and II of the Treaty.

9. During the first round of discussions it was envisioned that a portion of a reduced search/examination fee would be due upon filing, but that due to the increased amount of work being performed during the search phase this fee would be somewhat higher than the current search fee. It was then felt that due to the overall workload savings realized as a result of combining the search and examination processes, the remaining portion of the fees due with the filing of the Demand would be significantly reduced such that the total combined search/examination fee would be less than the combined amounts of the current separate search and examination fees. However, upon further consideration it is envisioned that, as a result of the overall savings, the search fee could remain at its current level and the portion of the fee due with the filing of the Demand would still be reduced, only to a slightly lesser extent. Thus, those applicants who currently choose to only file under Chapter I would not bear a higher financial burden under the new PCT system for additional information which they currently choose not to receive.

10. As initially presented at the last meeting of the Working Group, this portion of the U.S. proposal included a suggestion that the fee structure as it related to the payment of the fees be greatly simplified as part of the process. However, in order to simplify this proposal and reduce the number of issues that need to be addressed by the Working Group at this time, that portion of the proposal has been dropped from this version. At the same time though, the United States of America would recommend that in the future, as part of the ongoing reform process, the Working Group consider simplification of the fee system as currently set forth in Rules 14-16*bis* and 57-58*bis*.

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

11. The IB would continue to publish the IA as filed at 18 months. The time period for issuance of the ISR under this revised proposal is the earlier of 16 months from the International Filing Date or 22 months from the Priority Date. As a result, in a number of applications (e.g., primarily those applications with no priority claim) the ISR would issue prior to the 18 month publication date of the International Application. In those instances in which the expanded ISR is issued prior to 18-month publication of the IA, then any ISR publication would take place in conjunction with the 18 month IA publication.

12. In the first round of discussions there was resistance to the idea that the expanded ISR would not be published with the IA at 18 months. This resistance seemed to be based largely on two issues: (1) getting the information out to applicants in time for the IA to be withdrawn prior to publication, and (2) getting the information out to third parties as soon as possible. With regard to the first issue, the United States of America would be interested to learn how many Offices, with regard to their national publication practice, make the same guarantee to issue some sort of report or opinion prior to publication. If, as suspected, the majority of Offices do not provide such a guarantee in their national law, then it is not seen why the PCT should be bound by such a restrictive practice. Further, it is the understanding of the United States of America that only a small percentage of applications are withdrawn after the issuance of the ISR and prior to international publication (and it's quite conceivable that a

portion of those withdrawals are related to factors other than a negative finding in the ISR). As such, given the rarity of withdrawals resulting from a negative ISR, it would seem that the desire to retain this provision is one born out of comfort with the current system rather than one of actual need. With regard to the second issue, we understand that the ISR currently publishes later than 18 months in a significant number of filings. Therefore, given that fact and given that all applications now have 30 months to enter the national stage, the additional few months in getting the search information out to third parties is seen as being of minor consequence.

13. In short, there *must* be a relaxing of the time limits under a reformed PCT system. The original time limits for establishing the ISR were based on a 20 month Chapter I time limit for national stage entry. However, now that the time limit for national stage entry in all applications is 30 months it follows that all of the time limits should be reassessed to efficiently make full use of the time now available for international processing.

(3) Issuance of the International Search Report (16–22 months)

14. The International Searching Authority/International Preliminary Examining Authority would issue the ISR by the earlier of 16 months from the International Filing Date or 22 months from the Priority Date. It is envisioned that the ISR under a reformed PCT system would combine features found in the current ISR with those currently found in the Written Opinion. If the expanded ISR contains a negative Article 33 determination, then the ISA/IPEA would set a 3 month period for applicant to respond.

15. Upon issuance, the ISR would be published in its entirety by the IB, and as noted in provision (2) above, those Search Reports which issue prior to publication of the IA would be published in conjunction with the publication of the IA.

16. In the first meeting of the Working Group there was resistance to the publication of the opinion portion of the ISR. The resistance was based on the perception that the publication of a complete opinion would be prejudicial to applicants in their dealings with third parties. Another issue raised in this regard was the confidentiality requirement of Article 38. With regard to the concern as to the prejudicial nature of publishing the complete ISR, it is the position of the United States of America that the current Search Reports already contain information that could be considered prejudicial in the form of the X and Y indications and the indications of which claims the references are relevant against. When this point was raised in further discussions at November's session of the Working Group it was admitted that while this was true, it was felt that the more cryptic nature of the current Search Report indications made them easier to explain away to potential investors. However, the fact remains that what must be accomplished by the Committee and this Working Group is simplification of the system, and in this regard that would include publication of the entire ISR as issued by the ISA/IPEA. To issue the ISR as two separate documents or to try to extract a portion of the ISR merely for publication purposes would unnecessarily complicate the overall processing of PCT applications. A negative determination is a negative determination regardless of the form in which it is expressed, and meaningful reform of the PCT system should not be held up merely because applicants find one form easier to deal with over the other in their negotiations with third parties. As to the Article 38 issue, it would appear that this in fact is a non-issue in that the opinion, while later being accepted as part of the examination process, is initially being offered as part of the search process which is not subject to the confidentiality requirement of Article 38. However, at the same time if the rest of the Working Group views Article 38 as an impediment, then the issue may be easily dealt

with via an amendment to Rule 94 to provide that the filing of an application itself is an express waiver of the Article 38 requirement as far as it pertains to the written opinion.

(4) Applicant's response to the ISR (The later of 25 months or ISR + 3 months)

17. Any response to the ISR, with the exception of those papers specifically submitted to the International Bureau which are clearly marked as a submission under Article 19, would be accepted as the filing of a Demand electing all designated states as well as a submission under Article 34. Applicant could file any such response prior to the expiration of the period set in the ISR in any application in which the ISR contained a negative opinion. The timely filing of such a reply would trigger the issuance of the IPER by the ISA/IPEA. The reply should only be filed in cases in which applicant disagrees with the findings of the ISR, and should be accompanied by applicant's arguments to the reasoning in the ISR or amendments to overcome the references applied in the ISR.

18. It was suggested in the first round of discussions (and in fact it has been adopted in the proposal set forth in PCT/R/WG/2/1) that applicants should be given an opportunity to file a response to the ISR without triggering issuance of an IPER. However, applicants do not currently have such an option at their disposal, and to add this additional layer of interaction would run counter to the Working Group's objective of simplification of the PCT system. Currently, if applicant wants to rebut a negative ISR, applicant may file comments and/or amendments during international examination to influence the issuance of a positive IPER. The system as set forth in this proposal by the United States of America is no different in this respect: If applicants want to counter a negative ISR, they must file a response to the ISR with the IPEA.

(5) International Preliminary Examination Report (28 months)

19. If a response to the ISR is timely filed, the ISA/IPEA would prepare an IPER considering the arguments and any amendments submitted with the reply. The IB would then forward the IPER to all concerned Offices upon issuance. In this regard, it has been the presumption throughout this proposal that the ISA and the IPEA would be the same for each application. The adoption of any other system is contrary to the objectives of PCT reform if the workload, efficiency, and streamlining benefits of combined search and examination are to be fully realized. Further, any concerns that might exist with regard to the Article 34 requirement that the applicant shall receive a written opinion from the IPEA would also be addressed by having the ISA and the IPEA be the same for any given application because the written opinion would have been issued by the IPEA while acting in its capacity as the ISA. However, if there is still a strong opinion within the rest of the Working Group that the ISA and IPEA do not need to be the same in spite of the lost benefits of such a separated system, an alternative would be to amend the rules to provide that the opinion issued by the ISA in the ISR shall constitute the first written opinion of the IPEA regardless of the fact that it was issued by a different authority.

20. If the ISR contains a positive Article 33 determination or if a reply is not timely filed this would be considered to be the presumptive filing of a Demand by applicant with no additional fees due. In those situations, the IB would merely forward a notice to all elected offices indicating that the ISR should also be accepted as the IPER. Another alternative, albeit less desirable from a simplification viewpoint, would be to provide that the information from the ISR be automatically transferred to, and re-issue as, the IPER with no further fee due by applicant. In this regard it is envisioned that the format of the ISR will be substantially

identical to the format of the IPER so that the transfer of information from the ISR to the IPER would take place purely electronically; necessitating minimal expenditure on the part of the ISA/IPEA.

21. The use of the above mechanism in order to allow the ISR to either be considered to be, or reissue as, the IPER would provide that an IPER would issue in all PCT applications. This result is necessary if we are to live up to the commitments that were made in connection with the passage of the 20 to 30 month change to the smaller Offices which rely heavily through their national laws on IPERs for their national stage examination processes.

(6) National Stage Entry (30 months)

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

23. The Working Group is invited to consider the proposals contained in this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

COMBINED PCT SEARCH AND EXAMINATION¹

TABLE OF CONTENTS

Rule 36	Minimum Requirements for International Searching Authorities	2
36.1	<i>Definition of Minimum Requirements</i>	2
Rule 42	Time Limit for International Search	3
42.1	<i>Time Limit for International Search</i>	3
Rule 43	The International Search Report	4
43.1 to 43.5	[No change].....	4
<u>43.5bis</u>	<i>Opinion</i>	4
43.6 and 43.7	[No change].....	5
<u>43.7bis</u>	<i>Invitation for Applicant Reply</i>	5
43.8	[No change].....	5
43.9	<i>Additional Matter</i>	6
<u>Rule 53bis</u>	<u>Filing Of The Demand</u>	7
<u>53bis.1</u>	<u>Actual Filing of the Demand</u>	7
<u>53bis.2</u>	<u>Presumptive Filing of a Demand</u>	7
Rule 59	The Competent International Preliminary Examining Authority.....	9
59.1	<i>Demands Under Article 31(2)(a)</i>	9
59.2	<i>Demands Under Article 31(2)(b)</i>	10
<u>59.2bis</u>	<u><i>Relationship between the International Preliminary Examining Authority and the International Searching Authority</i></u>	10
59.3	[No change].....	10
Rule 63	Minimum Requirements for International Preliminary Examining Authorities	11
63.1	<i>Definition of Minimum Requirements</i>	11
Rule 66	Procedure Before the International Preliminary Examining Authority	12
66.1	[No change].....	12
66.2	<i>First Written Opinion of the International Preliminary Examining Authority</i>	12
66.3	[Deleted].....	12
66.4	<i>Additional Opportunity for Submitting Amendments or Arguments</i>	12
66.4bis to 66.9	[No change].....	12
Rule 70	The International Preliminary Examination Report.....	13
70.1 to 70.11	[No change].....	13
70.12	<i>Mention of Certain Defects and Other Matters</i>	13
70.13 to 70.17	[No change].....	13

¹ While a portion of this proposal involves the automatic designation and election of all Contracting States, the rule changes necessary for that aspect of the proposal have been addressed in document PCT/R/WG/2/2 and therefore will not be addressed in this document.

Rule 36

Minimum Requirements for International Searching Authorities

36.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 16(3)(c) shall be the following:

(i) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iv) that Office or organization must have been appointed as an International Preliminary Examining Authority in accordance with Article 32(3).

[COMMENT: Rule amended to provide that ISAs must also be an IPEA so that the opinion contained in the search report cannot be issued by authorities which are not IPEAs.]

Rule 42

Time Limit for International Search

42.1 *Time Limit for International Search*

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be ~~three~~ 16 months from the international filing date ~~receipt of the search copy by the International Searching Authority~~, or ~~nine~~ 22 months from the priority date, whichever time limit expires earlier ~~later~~.

[COMMENT: Rule amended to provide for an expanded time period for issuance of the ISR in accordance with the proposal.]

Rule 43

The International Search Report

43.1 to 43.5 [No change]

43.5bis Opinion

(a) The international search report shall contain a preliminary and non-binding opinion as to:

(i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;

(ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority;

(iii) as to any other matters that these Regulations provide for.

(b) The opinion shall contain substantially the same elements as an international preliminary examination report, and shall be based on the international application as filed.

(c) Articles 33(2) to 33(6), 35(2), 35(3) and Rules 64, 65, 67, 70.2(d), 70.3, 70.4(ii), 70.6 to 70.9, and 70.12 shall apply *mutatis mutandis*.

[COMMENT: New rule to provide that the ISR contain an opinion portion which corresponds in scope with the IPER.]

43.6 and 43.7 [No change]

43.7bis Invitation for Applicant Reply

(a) The International Searching Authority, in the international search report, shall invite the applicant – if he disagrees with the opinion set forth in the international search report – to submit a written reply in the form of arguments together, where appropriate, with amendments, to the International Preliminary Examining Authority.

(b) The international search report shall set a period for reply to the invitation which shall be reasonable under the circumstances. It shall normally be three months from the date of mailing of the search report. In no case shall it be less than one month after the said date.

[COMMENT: New rule to provide that the ISR contain an invitation to respond and a time limit for said response.]

43.8 [No change]

43.9 *Additional Matter*

The international search report shall contain no matter other than that specified in Rules 33.1(b) and (c), 43.1 to 43.3, 43.5 to 43.8, and 44.2 and the indication referred to Article 17(2)(b), provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. ~~The international search report shall not contain, and the Administrative Instructions shall not permit the inclusion of, any expressions of opinion, reasoning, arguments, or explanations.~~

[COMMENT: Rule amended to delete prohibition on the ISR containing an opinion.]

Rule 53bis

Filing Of The Demand

53bis.1 Actual Filing of the Demand

Any reply by applicant to the invitation provided for in Rule 43.7bis, except for those submitted to the International Bureau under Article 19, will be accepted as a demand which elects all eligible States provided that the reply is received within the period for reply set in the international search report and the situation provided for in Rule 53bis.2(a)(ii) does not exist.

53bis.2 Presumptive Filing of a Demand

(a) Applicant shall be considered to have presumptively made a demand which elects all eligible States if either:

(i) No reply to the invitation provided for in Rule 43.7bis has been received within the period for reply set in the international search report; or

(ii) The search report does not contain any negative statements in accordance with Rule 70.6 or any indications under Rule 70.12.

[Rule 53bis.2, continued]

(b) If either situation under paragraph (a) exists then the International Preliminary Examining Authority will so notify the International Bureau, which will in turn notify all elected States that the international search report is to be accepted as the international preliminary examining report under Article 35 and Rule 70.

[COMMENT: New rule to provide that (1) any timely reply to the ISR, except for those under Article 19, will be considered to be a Demand, and (2) where no reply is filed or the determination in the opinion is positive with respect to Article 33 applicant shall be considered to have filed a presumptive Demand. The rule further provides in the case of presumptive Demands, that the IB notify the elected offices that the ISR is to be accepted as the IPER.

Rule 59

The Competent International Preliminary Examining Authority

59.1 Demands Under Article 31(2)(a)

(a) Subject to Rule 59.2bis, for demands made under Article 31(2)(a), each receiving Office of or acting for a Contracting State bound by the provisions of Chapter II shall, in accordance with the terms of the applicable agreement referred to in Article 32(2) and (3), inform the International Bureau which International Preliminary Examining Authority is or which International Preliminary Examining Authorities are competent for the international preliminary examination of international applications filed with it. The International Bureau shall promptly publish such information. Where several International Preliminary Examining Authorities are competent, the provisions of Rule 35.2 shall apply *mutatis mutandis*.

(b) Subject to Rule 59.2bis, where the international application was filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), Rule 35.3(a) and (b) shall apply *mutatis mutandis*. Paragraph (a) of this Rule shall not apply to the International Bureau as receiving Office under Rule 19.1(a)(iii).

59.2 *Demands Under Article 31(2)(b)*

Subject to Rule 59.2bis, as to demands made under Article 31(2)(b), the Assembly, in specifying the International Preliminary Examining Authority competent for international applications filed with a national Office which is an International Preliminary Examining Authority, shall give preference to that Authority; if the national Office is not an International Preliminary Examining Authority, the Assembly shall give preference to the International Preliminary Examining Authority recommended by that Office.

59.2bis Relationship between the International Preliminary Examining Authority and the International Searching Authority

An International Preliminary Examining Authority shall be competent for the international preliminary examination of an international application only when that Authority has acted as the International Searching Authority with regard to that application.

[COMMENT: Rule amended to provide that in order to be competent the IPEA must have also served as the ISA.]

59.3 [No change]

Rule 63

**Minimum Requirements for
International Preliminary Examining Authorities**

63.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 32(3) shall be the following:

(i) and (ii) [No change]

(iii) that Office or organization must have a staff which is capable of examining in the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(iv) that Office or organization must have been appointed as an International Searching Authority in accordance with Article 16(3).

[COMMENT: Rule amended so that IPEAs are also ISAs.]

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 [No change]

66.2 *First Written Opinion of the International Preliminary Examining Authority*

[The rule as currently written should be deleted in its entirety and replaced by the following]

The opinion provided for in Rule 43.5bis shall constitute the first written opinion of the International Preliminary Examining Authority.

66.3 [~~Deleted~~]

66.4 *Additional Opportunity for Submitting Amendments or Arguments*

(a) If the International Preliminary Examining Authority wishes to issue one or more additional written opinions, it may do so, and Rules 43.5bis ~~66.2~~ and 43.7bis ~~66.3~~ shall apply.

(b) [No Change]

[COMMENT: Rules 66.2 to 66.4 have been amended/deleted in accordance with the fact that Rules 66.2 and 66.3 have been superseded by new Rules 43.5bis and 43.7bis.]

66.4bis to 66.9 [No change]

Rule 70

The International Preliminary Examination Report

70.1 to 70.11 [No change]

70.12 *Mention of Certain Defects and Other Matters*

If the International Preliminary Examining Authority considers that, at the time it prepares the report:

(i) the international application contains any ~~of the defects referred to in Rule 66.2(a)(iii)~~ defect in the form or contents of the international application under the Treaty or these Regulations, it shall include this opinion and the reasons therefore in the report;

(ii) the international application calls for any ~~of the observations referred to in Rule 66.2(a)(v)~~ observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description, it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;

(iii) and (iv) [No change]

[COMMENT: Rule amended in accordance with the deletion of current Rules 66.2(a)(iii) and 66.2(a)(v).]

70.13 to 70.17 [No change]

[End of Annex and of document]

WIPO



PCT/R/WG/2/9 Corr.
ORIGINAL: English only
DATE: April 26, 2002

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Second Session
Geneva, April 29 to May 3, 2002

REVISED U.S. PROPOSAL FOR PCT REFORM;
COUNTERPROPOSAL TO DOCUMENT PCT/R/WG/2/1:

CORRIGENDUM
(PAGE 5 OF DOCUMENT PCT/R/WG/2/9 – ENGLISH VERSION ONLY)

Document prepared by the International Bureau

1. There are two typographical errors in Flowchart #3 on page 5 of the English version (only) of document PCT/R/WG/2/9, which contains proposals submitted by the United States of America. In one case, the text “Demand Filed Later Than 30 Months” should read “Demand Filed Later Than 20 Months.” In the other case, the text “Demand Filed Earlier Than 30 Months” should read “Demand Filed Earlier Than 20 Months.” (Emphasis added.) The errors were made by the International Bureau in preparing the document on the basis of the original text submitted by the United States of America.

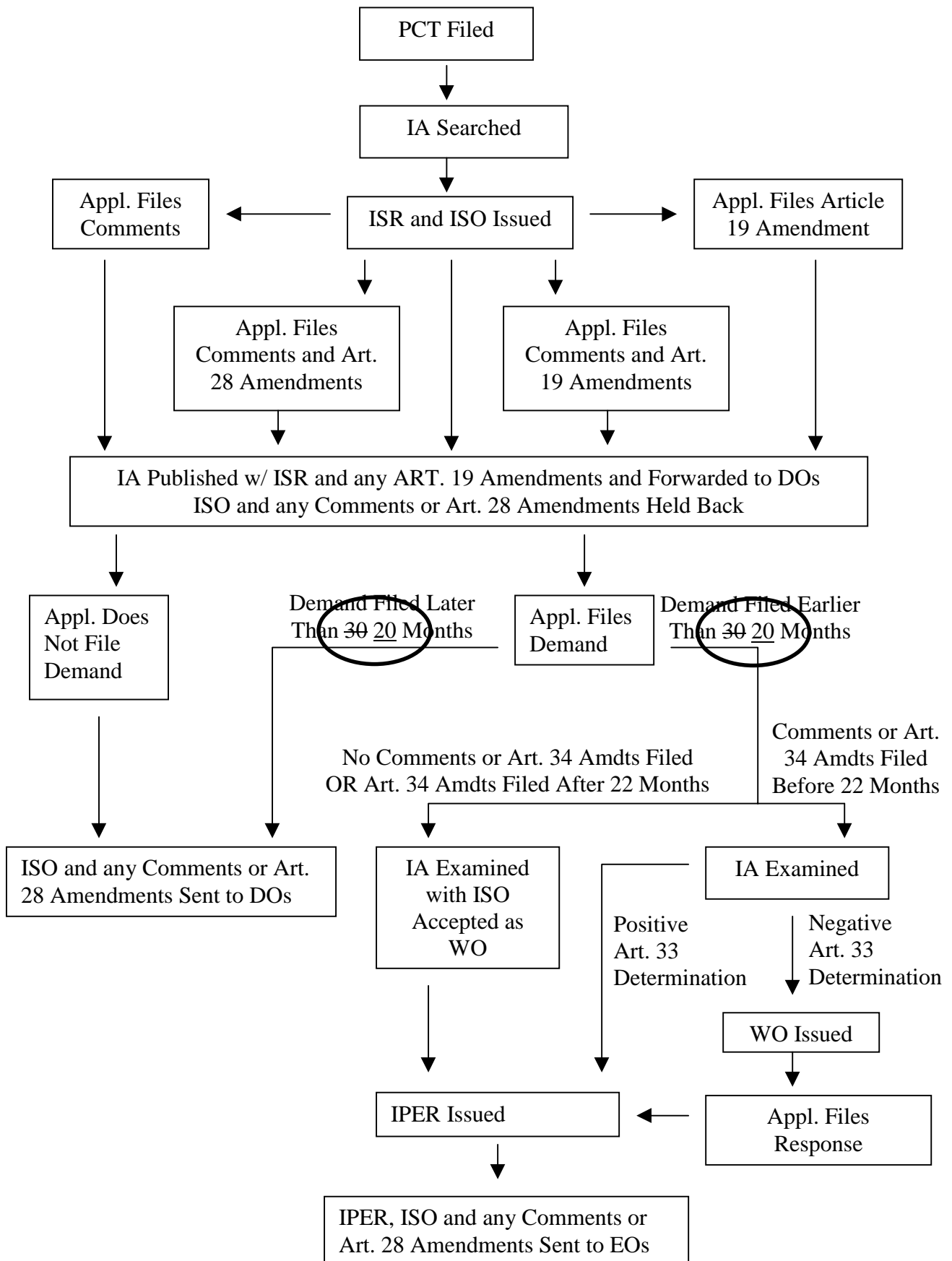
2. A corrected (marked-up) version of the flowchart appears in the Annex. The rest of document PCT/R/WG/2/9 remains unchanged. The French version of document PCT/R/WG/2/9 is not affected.

3. *The Working Group is invited to note the correction contained in the Annex to this document.*

[Annex follows]

ANNEX

FLOWCHART #3: PCT SYSTEM AS SET FORTH IN DOCUMENT PCT/R/WG/2/1
 [Corrected version of flowchart appearing on page 5 of document PCT/R/WG/2/9]



WIPO



PCT/R/WG/2/10

ORIGINAL: English

DATE: April 26, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Second Session
Geneva, April 29 to May 3, 2002

COMMENTS ON THE PAPERS FOR
THE SECOND SESSION OF THE PCT REFORM WORKING GROUP

*Proposals submitted by the
Institute of Professional Representatives before the European Patent Office (EPI)*

GENERAL COMMENTS

1. The Institute of Professional Representatives before the European Patent Office (EPI), conscious of the importance of the Patent Cooperation Treaty (PCT), herewith offers its comments as to the papers currently on the agenda of the PCT reform working group.

DOCUMENTS PCT/R/WG/2/1 AND PCT/R/WG/2/9

2. The current attempt to simplify and streamline the PCT system should not evolve into a “new” PCT that is even more complex than the current PCT system.

Rule 42

3. While indeed, the current time limit for establishing the search report (on average 15.5 months from the priority date) can be somewhat relaxed, the burden that would result from establishing almost all search reports after the publication of the PCT application, so that there need to be separate A3 publications of the search report in almost all cases, should not

E

be underestimated. As almost all PCT applications are filed at the end of the priority, the time limit of 16 months from the filing date will only apply in rare circumstances, and the time limit would generally be 22 months from the priority date. As a result, the search report would be published more than 4 months after the A2 publication of the PCT application. This is a significant deterioration with regard to the present situation in which still most of the PCT publications are A1 publications including the search report.

4. Therefore, EPI proposes to set the time limit for establishing the PCT search report at 17 months from the priority date, which (given the current possibilities for electronic communication) would allow the International Bureau to publish PCT applications as A1 publications including the search report.

Rule 43.5bis

5. The proposed text for Rule 43.5bis(a)(ii):

“whether the international application complies with the requirements of the Treaty and these Regulations *in so far as checked by the International Searching Authority*;”

is vague and indefinite, as the scope of this examination is unclear. Also, paragraph (iii) does not seem to refer to anything.

6. Most importantly, in view of the proposal to let the opinion be the final IPER if the opinion is positive or if the applicant does not reply, the opinion should be based on a full examination on both the patentability requirements listed in Article 33, and the form and/or content based provisions of Articles 3 to 8 and the corresponding Rules 3 to 13. An in-depth international phase examination is also in the interest of all those national patent offices that do not have the facilities for carrying out a thorough national phase examination.

7. Therefore, EPI proposes to copy the current text of Rule 66.2 to Rule 43.5bis(a), *mutatis mutandis*. This would nicely fit in with the USPTO proposal (see their draft for an amended Rule 66.2) to let this opinion part of the search report constitute the first written opinion in the PCT-II procedure.

Rules 43.7bis and 53bis

8. Draft Rule 43.7bis says that the search report will always contain an invitation for an applicant's reply, while on the other hand, draft Rule 53bis is based on the presumption that a positive opinion part of the search report will constitute the international preliminary examination report (IPER), so that in such a case, a reply from the applicant would be inappropriate. It thus seems that if the opinion part of the search report is positive, the search report should not contain an invitation.

Rule 70.12

9. In view of the purpose and scope needed for the international phase examination of a PCT application as set out above with reference to Rule 43.5bis, it should not be optional for the IPER to contain comments as to Articles 5 and 6. Therefore, EPI proposes to redraft Rule 70.12 as follows:

“If the International Preliminary Examining Authority considers that, at the time it prepares the report:

(i) the international application contains any defect in the form or contents of the international application under the Treaty or these Regulations, especially if the international application calls for any observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description, it shall include this opinion and the reasons therefore in the report;

(ii) ~~[Deleted] the international application calls for any observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description, it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;~~

(iii) and (iv) [No change]

DOCUMENT PCT/R/WG/2/2

Rule 4.9

10. The end of draft paragraph (a)(ii) is not clear, as it may be interpreted as requiring that the applicant make such an indication before the receiving Office. EPI therefore proposes to delete “and to defer the express indication referred to in those Articles to the time of performing the acts referred to in Article 22(1).”

Rule 49bis.1

11. It should be clarified that such an indication is to be made before the designated Office concerned.

DOCUMENT PCT/R/WG/2/3

12. EPI believes that a restoration of the priority right only for the purposes of calculating the various PCT time limits, does not make much sense. It is also not in line with the present PCT provisions as to missed time limits: if presently a receiving Office accepts that mail was timely posted but delayed, and therefore does not declare the application to be deemed withdrawn, this has effect for all designated states. Only if the receiving Office refuses to go along with the applicant and declares the application to be deemed withdrawn, the applicant has a possibility for review in the national phase. EPI believes that the same system should apply as to the restoration of the priority right: if the receiving Offices accepts the restoration, the priority right is restored with worldwide effect, and if the receiving Office does not accept the restoration, the applicant may ask the various designated Offices to review the case in accordance with the respectively applicable provisions contained in national law. EPI therefore supports Rule 26bis.3(h).

Rule 26bis.3(d)(ii)

13. Evidence should only be asked for where the Office may reasonably doubt the veracity of the reasons given for the delay.

DOCUMENT PCT/R/WG/2/4

Rule 49.6

14. This Rule suggests that a designated Office may only revive a national phase application under the conditions of Article 12 PLT. It should be made clear that a Designated Office may also revive a national phase application under the conditions of Article 11 PLT. In fact, the European Patent Convention as revised in 2000 applies Article 11 PLT for this purpose.

15. As to Rule 49.6(d), evidence should only be asked for where the Office may reasonably doubt the veracity of the reasons given for the delay.

DOCUMENT PCT/R/WG/2/7

16. While EPI is generally in favor of a simplification as regards signatures as especially signatures from inventors (i.e. co-applicants for the US only) may be difficult to get, EPI feels that signatures are still needed for withdrawals or amendments. Nobody will file an application or a demand on behalf of one's competitor, but the risk should be positively avoided of withdrawing one's competitor's application (or a designation or priority claim contained therein), or to amend the claims in one's competitor's application so as to make them harmless. In view thereof, EPI prefers Annex II to Annex I.

Rule 90bis.5

17. This rule should not be amended. Generally, there is no need to make withdrawals easy. The proposed amendment may result in fatal consequences of "misunderstandings" between co-applicants.

Rule 92.1(b-bis)

18. This rule should not be adopted for the reasons set out above.

DOCUMENT PCT/R/WG/2/8

19. EPI is generally in favor of these draft amendments.

Rule 20.4(e)

20. The last word should be "sought" instead of "ought."

21. The Working Group is invited to consider the proposals contained in this document.

[End of document]

WIPO



PCT/R/WG/2/11

ORIGINAL: English

DATE: April 26, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Second Session

Geneva, April 29 to May 3, 2002

EXPANDED INTERNATIONAL SEARCH SYSTEM;
ABSENCE OF "FORMAL CLAIMS"

*Proposals submitted by the
Intellectual Property Institute of Canada (IPIC)*

INTRODUCTION

1. The Intellectual Property Institute of Canada (IPIC) is grateful for the opportunity to again participate, as observer, in the deliberations of the Working Group on Reform of the Patent Cooperation Treaty and submits the following comments for consideration at the Working Group's second session to be held in Geneva from April 29 to May 3, 2002.
2. IPIC has had the opportunity to review the substantial amount of material prepared by the International Bureau (IB) and by the United States for discussion setting forth possible frameworks for the proposed Expanded International Search Report (EISR) and other reforms in documents PCT/R/WG/2/1 through PCT/R/WG/2/9.
3. Founded in 1926, IPIC is the only intellectual property association in Canada to which nearly all patent agents, trade-mark agents and lawyers specializing in intellectual property

belong. IPIC membership includes practitioners in private practice, corporations, academia and government.

4. The patent agent profession in Canada may have developed a unique perspective on patent prosecution from having substantial direct experience before both the European Patent Office (EPO) and the United States Patent and Trademark Office (USPTO), as well as the Canadian Intellectual Property Office (CIPO). In addition to prosecution experience on national applications before CIPO, when filing PCT applications through CIPO as the Receiving Office, the responsible International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) is the EPO. In addition, because of our country's historical links with Great Britain, a proportion of our profession (particularly senior members) are also Chartered Patent Agents or European Patent Attorneys with significant direct experience before the EPO on EPO regional applications. Finally, by treaty, many Canadian patent agents are entitled to directly prosecute patent applications (both national and PCT) through the USPTO.

EXPANDED INTERNATIONAL SEARCH – COMMENTS ON PROPOSALS SET OUT IN PCT/WG/R/2/1 AND PCT/WG/R/2/9

5. In contemplation of the Working Group's second session, two new proposals for combining the international search in Chapter I with a preliminary opinion of the type set out in Article 33(1) have been proposed. The IB proposal, contained in document PCT/WG/R/2/1, sets out a scheme in which the establishment of an ISO (the opinion) at the time the ISR is prepared would be mandatory. A welcome aspect of this proposal is the recognition of the needs of applicants to preserve their right to maintain the confidentiality of this first examination opinion, according to Article 38, at least until an adequate opportunity to rebut negative findings on the record, has been provided. An additional important feature of the IB proposal is that at the time the ISO may be made public, it is communicated to the public in the same manner, and together with the applicant's rebuttal to encourage that they be read together.

6. A counter-proposal has been put forward by the United States in document PCT/WG/R/2/9. According to this proposal, the establishment of a preliminary opinion along with the ISR would also be mandatory, but unlike the IB proposal, the United States proposes here that the opinion cannot be separated from the ISR, but must be published with it as soon as it is established. Also, the applicant's rebuttal, if any, would come later, would not be similarly published, and presumably would not even be available to the public (pursuant to Article 38), without the applicant's express waiver, until national entry.

7. When considering the original proposal for an EISR in document PCT/WG/R/1/3 prepared by the United States for contemplation by the first session of the Working Group, IPIC membership welcomed the opportunity to receive a clear statement on novelty and obviousness expanding upon the ISR, at the earliest possible opportunity in the international phase, provided applicants were given the opportunity to rebut negative findings before the opinion was publicly disclosed. Keeping the opinion portion of the EISR as a separate, unpublished document was clearly contemplated in paragraph 8 of document PCT/WG/R/1/3:

“... 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. ...”

8. The revised “simplified” proposal of the United States in document PCT/WG/R/2/9, coupled with recent experiences of users following the EPO’s implementation of a two-stage system for international preliminary examination, fill IPIC members with unease about the purpose of the proposed expanded ISR. Is the purpose to provide applicants and Designated Offices with a useful explication of the search report, or are the reforms directed at providing the “simplest” means to move international applications out the doors of the ISAs and IPEAs as quickly as possible in order to clear up the backlog?

9. Therefore, in addition to the serious issue of maintaining the confidentiality of the opinion associated with the search report, applicants have another very real concern regarding quality control of the work product (the opinions) of the international authorities in respect of the proposed expanded international search and follow-on changes for IPE.

10. *Quality control:* In January 2002, the EPO introduced a two-stage system for conducting IPE¹. The first stage constitutes a simplified first examination opinion from the EPO focusing on the core aspects of novelty, inventive step and industrial applicability based on the ISR, without involving substantive examination of issues outside the search, such as clarity, support, etc. It is only the applicant's response that will trigger a substantive examination in these other areas, and possible issuance of a second opinion, unless a favourable IPER can be established. This first opinion essentially provides the elements under Article 33(1), and is apparently very similar in concept to the proposed opinion to be associated with the ISR. The stated purpose of these changes is to rationalise and streamline procedures to deal with increasing workload by removing from further examination international applications of applicants who demonstrate no interest in proceeding. The early experience of IPIC members with this new EPO examination system has been varied.

11. In some cases, only a form letter with no opinion has issued, apparently because the applicant did not *specifically request* detailed examination at the time of filing the demand. If the ISO is mandatory, then the payment of the search fee should constitute a request for the ISO to be formulated along with the establishment of the ISR.

12. In other cases before the EPO, the preliminary written opinion merely parrots the ISR, with no detailed articulation of the relevance of the art to the claims. Where the ISR is less favourable, the resulting “opinion” is simply a very negative statement, and this provokes anxiety in applicants who feel that inappropriate art has been broadly applied by a patent office official without any apparent justification.

13. Concerns that this level of service is also intended for an expanded ISR are fueled by the comments of the United States when discussing the content of the proposed opinion accompanying the ISR in paragraph 16 of document PCT/R/WG/2/9:

¹ See “Notice of the President of the European Patent Office dated 2 November 2001 concerning rationalisation of international preliminary examination at the EPO” from the Official Journal EPO dated 11/2001.

“... With regard to the concern as to the prejudicial nature of publishing the complete ISR, it is the position of the United States of America that the current Search Reports already contain information that could be considered prejudicial in the form of the X and Y indications and the indications of which claims the references could be relevant against. When this point was raised in further discussions at November’s session of the Working Group it was admitted that while this was true, it was felt that the more cryptic nature of the current Search Report indications made them easier to explain away to potential investors. ... *A negative determination is a negative determination regardless of the form in which it is expressed*, and meaningful reform of the PCT system should not be held up merely because applicants find one form easier to deal with over the other in their negotiations with third parties ...” (emphasis added)

14. For the expanded ISR to be of the anticipated value to applicants on receipt, and to Designated and Elected Offices at national entry, the opinion cannot merely re-state the negative determinations found in the ISR proper. Hopefully the opinion portion can specifically relate the art to the claims in a manner that meaningfully expands upon the ISR. Some means for assuring quality control in the ISAs should be established. In this respect, IPIC supports the proposal to have the search examiner prepare the ISO along with the ISR, since it is believed that a more meaningful opinion along these lines may be expeditiously prepared. However, some means to monitor quality control should be included in the reform proposals.

15. *Confidentiality/Delayed Publication of the Opinion:* In paragraph 16 of document PCT/R/WG/2/9, the United States suggests that Article 38 is either not applicable to the ISO, or that the effect of Article 38 can be easily removed with an amendment to Rule 94. As regards the applicability of Article 38, both proposals for an expanded ISR currently before the Working Group clearly treat the ISO as a segue to IPE. Therefore, IPIC submits that it is not correct to suggest the opinion is not entitled to Article 38 protection merely because it is formulated at the time of the search. The ISO is intended as a step in international examination, as contemplated in Article 38.

16. Also, it is unclear to this delegation how an amendment of a rule under the treaty (amending Rule 94 to force applicants to waive their Article 38 rights in order to use the PCT system) can provide a solution. Under the doctrine of *ultra vires*, it is believed that it is not possible to amend a treaty by amending an underlying rule.

17. However, it is submitted that the Working Group should consider maintaining the confidentiality of the written opinion pursuant to Article 38, *or at least delaying public access to the opinion until the applicant has had the opportunity to submit responsive comments* as a *policy* matter. Public access to the opinion (whether by formal publication or through access to the contents of the IB file, should include equivalent access to the applicant’s responsive comments. As submitted in oral discussion at the first session of the Working Group (see brief description in paragraph 16 of document PCT/R/WG/2/9), a categorical statement of lack of novelty or obviousness “officially” published by the IB as part of the pamphlet, may interfere with applicants’ abilities to effectively use the published application in dealing with third parties (investors, distributors, competitors, etc.). Who is this likely to damage? It is IPIC’s conclusion that while there may be an adverse effect on larger applicants, it is likely that, routinely, this will more severely impact smaller companies and independent inventors, filing a single or very few applications. It is the understanding of IPIC that SMEs and independent inventors are the very constituency that WIPO (and possibly the whole

international community) currently targets for increasing PCT awareness and use. The proposal to publish the ISO with the IA pamphlet at 18 months (or so soon as it is available) appears to be contrary to the goals for improving access and use of PCT for SMEs and independent inventors.

18. *Timing:* In document PCT/WG/R/2/9, the United States reiterates a proposal it made in document PCT/WG/R/1/3 to add flexibility to the time limits for providing the combined search and opinion. In document PCT/WG/R/2/9, the United States proposes that the expanded ISR be established by the earlier of 16 months from the filing date of the IA or 22 months from its priority date. One hope of IPIC membership is that the reduction in backlog occasioned by these reforms will permit ISAs to meet their current PCT deadlines (even with the added ISO). Otherwise, it seems that it will be impossible to ever achieve full IPE (as contemplated in Chapter II) by 28 months. However, recognising the backlog issues that continue to plague the international authorities, IPIC supports a relaxation of the time limits for the international authorities and also proposes that it would be appropriate, in these circumstances, to find a way to extend the time limits to permit applicants the option of filing Article 19 amendments and/or the demand, by tying both these time limits to the establishment of the expanded ISR (for example, are due three months after).

19. *Cost control:* A major advantage of PCT for applicants of all sizes is that it permits applicants to substantially defer costs. In addition to deferring the translation costs and multiple filing fees associated with national phase processing, the present Chapter I / Chapter II structure of the international phase of PCT also permits applicants, in theory, to defer Chapter II examination fees until after a clear statement on novelty and obviousness (the ISR) has been received. (In recent practice, however, workload issues at the ISAs is jeopardizing the critical issuance of ISRs prior to 20 months.)

20. IPIC reiterates concerns of applicants stated at the first Working Group session, to keep as low as possible, the up-front costs associated with filing an international application and proceeding through Chapter I, and in this respect, welcomes the suggestion of the United States in paragraph 9 of document PCT/WG/R/2/9 that it may be possible to maintain costs for Chapter I processing under an expanded search system at current levels, without increasing (and possibly even reducing) fees for Chapter II.

ABSENCE OF “FORMAL CLAIMS” – COMMENTS ON PROPOSALS SET OUT IN DOCUMENT PCT/WG/R/2/8

21. Document PCT/WG/R/2/8 from the IB contains a proposal to align PCT with Patent Law Treaty (PLT) claims requirement, by including, in the printed request form, a pre-printed statement containing a type of omnibus claim to be applied in the absence of applicant-submitted claims. While IPIC supports revision of PCT requirements to make the system more accessible to applicants, it is the experience of the IPIC membership that current practice before some regional and national offices could deprive applicants of rights if they were take advantage of such as provision. For example, at the EPO, the claims may not be broadened after filing. Under current EPO practice, this is being interpreted very literally; amendments are refused where word-for-word support is lacking in the written description, even where the amendment is blatantly inferable from the description and drawings.

Similarly the US *Festo*² decision has put a chill on the types of amendments that an applicant would wish to make during prosecution to avoid unduly limiting the scope of protection in its issued claims (*prosecution history estoppel*). Any amendment to introduce a significant practise change, such as permitting filing without claims, should be carefully considered in light of the effect on the rights of applicants on national/regional entry. It may be realised that some proposals for aligning PCT with PLT are premature and misleading to applicants until the PLT is fully in place and adopted into their national laws by the PCT signatories.

22. *The Working Group is invited to consider the proposals contained in this document.*

[End of document]

² *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F. 3d 558 (Fed. Cir. 2000) (*en banc*).