E

WIPO

A/36/14
ORIGINAL: English
DATE: August 6, 2001

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

ASSEMBLIES OF THE MEMBER STATES OF WIPO

Thirty-Sixth Series of Meetings
Geneva, September 24 to October 3, 2001

AGENDA FOR DEVELOPMENT OF
THE INTERNATIONAL PATENT SYSTEM

Memorandum of the Director General

INTRODUCTION

1. A robust and dynamic industrial property system, and particularly the patent system, supports and encourages technological innovation, brings more and better products onto the market for the benefit of people, and promotes investment and technology transfer. The patent system provides conditions whereby creative potential can be released and channeled into tangible, sustainable development. The system is therefore important throughout the world for governments and policy-makers, for inventors and industry, for national and international markets, and for consumers and the general public.

2. The confidence that users have in the patent system is evidenced by unabated growth in the numbers of applications filed worldwide. Increasingly, applicants are using patent rights strategically, engaging in international licensing and building intellectual property assets to support valuation and investment. But to remain effective, the patent system must continue to develop, with particular emphasis on improved ways of obtaining patent protection for inventions in a number of countries. Recent and present initiatives for harmonization of patent laws and for reform of the Patent Cooperation Treaty (PCT) need to be pursued in a coordinated fashion, and new initiatives need to be identified and developed.

3. WIPO must continue to provide strong leadership in the development of the patent system. The international patent system[1] must operate to the maximum benefit of the countries that participate in it, taking account of their widely varying stages of technological and economic development. The system's legal and administrative framework and the range of services offered to users must be reviewed and improved so as to make the system yet more user-friendly, cost-effective and secure.

4. The purpose of this document is to draw the attention of the WIPO Assemblies to the current state of the international patent system, highlighting present challenges and on-going initiatives, and to invite Member States to discuss objectives, opportunities and priorities for change, with a view to agreeing upon an agenda for development of the system during the coming years.

THE INTERNATIONAL DIMENSION OF THE PATENT SYSTEM

Patent systems, trade and commerce, and international obligations

5. Industrial property rights as we know them, and the mechanisms for enforcing them, are essentially territorial in nature. The scope of the rights created in each country is determined by that country, and the operation of those rights is confined to the territory of the country. But trade and commerce are becoming increasingly international. Technology-based, internationally focused, export-oriented enterprises need patents in a number of countries, which in turn need to provide effective patent systems if they are to attract investment and encourage technological development. A number of regional patent systems with broader territorial operation have therefore been established by countries seeing this need.

6. The current framework of the patent system consists of a national and regional patchwork of legal, organizational and administrative arrangements for obtaining and enforcing patents. It is evident that international trade and commerce and the movement of technology are hampered by a tangle of inconsistent regulations across national boundaries. That environment has seen the successful development, albeit nearly a century apart, of the Paris Convention for the Protection of Industrial Property and the PCT, which establish principles and procedures rationalizing the patent system for a large number of countries. A more unified framework for obtaining patents worldwide would encourage more users to develop and commercialize their inventions on a truly international basis, with less fear that their work would not be evenly and effectively protected, thus fostering innovation and economic growth more effectively and at lower cost.

---

[1] The term "international patent system" is used here in a very broad sense to mean not only the legal system at all levels, including national and regional as well as the PCT, together with any future initiatives that may emerge, but also the supporting infrastructure for the administration, maintenance, exploitation and enforcement of applications and patents under the various legal regimes. This involves national and regional patent offices, the International Bureau of WIPO, partner organizations in both the public and private sectors, such as ministries of justice, trade, science and technology, other relevant government agencies, enforcement agencies, private industry, universities and research institutions, and associations of industry users, inventors and patent professionals.

The Paris Convention and the PCT

7. The Paris Convention, adopted in 1883, built the main cornerstones of today's international patent system, including the principle of national treatment for foreign applicants and the 12-month priority right for foreign filings based on a first national application. The PCT, which has attracted the membership of 112 countries since its adoption in 1970 and drew the filing of more than 90,000 applications in 2000, offers streamlined procedures, by virtue of a binding common set of formality requirements and a single international publication, for filing applications having effect in many countries.

8. The PCT also provides for substantive, but non-binding, international search and international preliminary examination.[2] Although the results of those procedures are not given full recognition or exploitation by national and regional patent offices, the PCT probably offers the best framework from which a truly international patent system can evolve, in cooperation with national and regional systems and in conjunction with other initiatives such as that for greater harmonization of patent laws. In particular, the PCT is well suited for the greater integration into the international patent system of developing countries, least-developed countries and countries in transition which wish their patent systems to provide better services and to be utilized to a greater extent.

World Trade Organization (WTO) Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement)

9. The TRIPS Agreement, which was concluded as part of the Marrakech Agreement Establishing the WTO, came into force on January 1, 1995. The link between the intellectual property system and global trade has been brought into sharp focus by the TRIPS Agreement. The TRIPS Agreement is binding on all Members of WTO, most of which are also Member States of WIPO. The modernization of intellectual property systems and the strengthening of their legislative, administrative and enforcement infrastructures have become policy priorities in many developing countries and least developed countries owing to their obligations to implement provisions of the TRIPS Agreement (a transitional period for developing countries expired on January 1, 2000, and that for the least developed countries will expire on January 1, 2006).

Special interests and needs of developing countries, least-developed countries and countries in transition

10. The interests and needs of developing countries, least-developed countries and countries in transition are already the subject of a number of special programs administered by WIPO, recognizing that intellectual property is one of the tools for technological advancement, economic growth and wealth creation for all countries. As their national economic circumstances improve, such countries need to pass through the stage of integration into the international patent system to the point where they are full participants, whose nationals gain tangible benefits not only from the importation of patented products and technology but also from ownership of patent rights.

---

[2] In 2000, PCT authorities produced a total of 83,658 international search reports and 59,201 international preliminary examination reports.

11. The preamble to the PCT contains an express reference to its Contracting States desire "to foster and accelerate the economic development of developing countries through the adoption of measures designed to increase the efficiency of their legal systems, whether national or regional, instituted for the protection of inventions by providing easily accessible information on the availability of technological solutions applicable to their special needs and by facilitating access to the ever expanding volume of modern technology." Recent significant increases in the number of the international applications filed by applicants from developing countries (an increase of 80% in 2000 compared to 1999),[3] suggests that the vision contained in the preamble to the PCT has started to become a reality.

12. A joint initiative of WIPO and the WTO[4] was launched in June 2001 to help least-developed countries maximize the benefits of intellectual property protection, recognizing that intellectual property is a tool for technological advancement, economic growth and wealth creation for all nations. Least-developed countries have until January 1, 2006, to bring their laws on patents, as well as other areas of intellectual property, into line with the TRIPS Agreement, and to provide ways of enforcing the laws effectively. The technical assistance available under the initiative includes cooperation with preparing legislation, training, institution-building, and modernizing intellectual property systems and enforcement.

13. The desire for developing countries, least-developed countries and countries in transition to gain tangible benefits from participation in the international patent system is illustrated by one of the Agreed Statements by the recent Diplomatic Conference for the Adoption of the Patent Law Treaty (PLT):[5]

> "With a view to facilitating the implementation of Rule 8(1)(a)[6] of this Treaty, the Diplomatic Conference requests the General Assembly of the World Intellectual Property Organization (WIPO) and the Contracting Parties to provide the developing and least developed countries and countries in transition with additional technical assistance to meet their obligations under this Treaty, even before the entry into force of the Treaty.
>
> "The Diplomatic Conference further urges industrialized market economy countries to provide, on request and on mutually agreed terms and conditions, technical and financial cooperation in favor of developing and least developed countries and countries in transition.

---

[3] Applicants from the Republic of Korea, China and South Africa generated the largest number of PCT filings among developing countries. The percentage increase for 2000 compared to 1999 was particularly high in India (155.8%), China (141.3%) and the Republic of Korea (91.6%). See more information in WIPO Update 124/2001, February 13, 2001, available on WIPO's web site at http://www.wipo.int/pressroom/en/updates/2001/upd124.htm.

[4] See WIPO Press Release PR/2001/276, June 14, 2001 (available on WIPO's web site at http://www.wipo.int/pressroom/en/releases/2001/p276.htm).

[5] See document PT/DC/47, page 64 (http://www.wipo.int/eng/document/pt_dc/index.htm).

[6] PLT Rule 8(1)(a) relates to the possible future exclusion of the filing of communications on paper in favor of electronic communications.

> "The Diplomatic Conference requests the WIPO General Assembly, once the Treaty has entered into force, to monitor and evaluate the progress of that cooperation every ordinary session."

14. Possibilities for assisting developing countries, least-developed countries and countries in transition must continue to be explored by WIPO in cooperation with all interested parties for the benefit of the industrial property community at large and more specifically that of such countries. This will require formulation of national strategies for use of the patent system as a policy tool to gain general economic benefits for the countries concerned, while bearing in mind that a proper balance needs to be maintained between the interests of patent owners and the public.

PRESENT CHALLENGES AND THE CLIMATE FOR CHANGE

15. The beginning of the 21st century is seeing mounting pressure for more fundamental change in the international patent system. The pressure derives from a number of sources, of which the most important in a general sense is the greater internationalization of markets and obligations under the TRIPS Agreement for countries to strengthen their intellectual property systems. How to fulfil those obligations is a matter of particular concern to developing countries and least-developed countries.

16. In the context of the structure and operation of the patent system in a more narrow sense, the following sources of pressure for change are worth special mention.

Shortcomings in the services offered by the present system

17. The patent system must respond to the international nature of business activities. The problems faced by national and regional systems become critical when industry is interested in obtaining worldwide patent protection or at least protection in a significant number of countries. The PCT system provides a partial response to the need for effective means of obtaining patents internationally, but falls short of a full response.

18. One of the main problems perceived by users is unnecessary duplication in the processing of patent applications for the same invention, with resulting additional costs to applicants. The duplication involves national and regional patent offices and, in the context of the PCT, PCT receiving Offices, International Searching Authorities, International Preliminary Examining Authorities and the International Bureau of WIPO. It includes both administrative and substantive aspects of patenting procedures.

19. The common formal requirements established by the PCT have achieved a great deal of uniformity, both within the PCT procedure itself and outside it, by way of de facto harmonization and the wider applicability of the requirements by virtue of their incorporation into the PLT.

20. The processing of separate national and regional applications for the same invention in a number of patent offices obviously results in duplication of work. The following figures illustrate the magnitude of the duplication. Of the approximately 872,000 patent applications that were filed worldwide in 1998 and subsequently published, 114,000 represented parallel filings in two or more countries or regional systems (that is, 114,000 were members of patent

"families" containing two or more members), and 61,000 were filed outside the PCT.[7] There is no established international system for recognizing the search and examination results of applications in other patent offices, although some patent offices have unilaterally implemented schemes for reliance on results elsewhere. Even where the PCT route is used for filing, appropriate "faith and credit" is not given to PCT international search and international preliminary examination reports by most designated offices when the applications enter the national phase of processing.

21. Another perceived problem is the overly complex and often unforgiving nature of patenting procedures in general, which are sometimes reasonably felt to be out of step with the general objectives of the patent system to foster innovation and economic growth.

Cost of obtaining patents

22. The cost of patenting internationally has been the subject of complaint by inventors and industry at all levels. International industries find that the cost is disproportionate to the nature of the procedures in a variety of ways, not the least of which is the perceived duplication of processing mentioned above.

23. At the other end of the spectrum, individual inventors and small and medium-sized enterprises often simply cannot afford to file patent applications, and many applicants of all kinds from developing countries, least-developed countries and countries in transition find patenting costs a barrier to their participation in the system.

24. And of course, differences among the laws, practices and procedures of the various national and regional offices are themselves a source of additional cost to users of the international patent system.

Workload crisis for patent offices

25. A serious immediate challenge to the patent system is posed by the escalating growth of its use worldwide. More and more individual inventors and businesses are using the patent system to obtain protection for an ever-growing number of inventions. Statistics show a constant and sizeable increase in the workload of the patent system, with increases in both the number of users and the number of applications. Annual growth rates of 10 to 20% or more are commonplace. The PCT saw a 23% increase in filings of international applications in one year between 1999 and 2000. Doubts are being raised about whether national and regional patent offices can sustain their current level of activity, much less increase their capacities.

26. National and regional systems are also under strain because of increasing workloads resulting from the ongoing internationalization of the patent system. Small offices in countries which have in recent years modernized their patent legislation to comply with the TRIPS Agreement are having difficulty in coping with massive increases in filings resulting from the improved patent protection available in their countries. Several developing countries have already experienced a similar workload problem to that of developed countries and it is

[7] Based on data extracted from the INPADOC database in July 2001 with the cooperation of the European Patent Office.

likely that the number of applications to be processed by patent offices in developing countries will exceed their capacity in the near future.[8]

Time-consuming processing systems

27. Modern information and communications technology offers many possibilities for rationalization of the international patent system, including the reduction or elimination of paper processing, rapid communication between applicants and patent offices and among patent offices, and the avoidance of errors and formal defects in the preparation of applications. Some offices have already established or are developing electronic filing and processing systems, and a number of WIPO programs aim to provide benefits on a more international scale, including WIPONET and automation of PCT procedures. The Agreed Statement of the PLT Diplomatic Conference mentioned above emphasizes the need to ensure that benefits from the use of information technology in patent procedures will flow to developing countries, least-developed countries and countries in transition.

28. The new technology offers many possibilities including, of course, the rapid transmission of electronic files between applicants and offices and among offices. It also opens up broader possibilities for restructuring the patent system itself, for example, by adopting simpler procedures whereby an applicant could decide that an application should proceed under different national and regional systems and the PCT. The ease of gaining increased international coverage through the use of simple electronic techniques would be difficult to imagine or achieve for applications filed on paper.

RECENT AND PRESENT INTERNATIONAL INITIATIVES

29. A review of the international patent system needs to take account of and build on a number of recent and present initiatives, which already offer great promise.

Patent law harmonization

30. The recently adopted PLT[9] simplifies formalities and streamlines procedures for national and regional patent applications and patents. It provides, in particular, for simple filing date requirements, a standardized set of formal requirements in line with the formal requirements of the PCT, standardized forms, simplified procedures before the offices, means for avoiding unintentional loss of rights and basic principles for electronic filing. It incorporates many of the proven formal requirements applicable under the PCT. Users filing in PLT Contracting Parties will be able to rely upon simpler and more predictable procedures for filing national and regional patent applications and for maintaining their patents.

---

[8] The following figures are the number of the international applications which entered the national phase of selected developing countries in 2000: China (15,802), Cuba (149), India (2,840), Mexico (9,589), Republic of Korea (15,133), Singapore (5,018), South Africa (1,453), Sri Lanka (220), Trinidad and Tobago (119) and Vietnam (949).

[9] See document PT/DC/47. The PLT was adopted by a Diplomatic Conference held in Geneva from May 11 to June 2, 2000. As of June 1, 2001, 53 States and one intergovernmental organization had signed the PLT. The PLT will enter into force three months after ten States have deposited instruments of ratification or accession.

31. The need for patent law harmonization going beyond formalities led WIPO's Standing Committee on the Law of Patents (SCP) to decide to initiate work on harmonization of substantive patent law. In November 2000, the SCP, at its fourth session, agreed[10] that first draft provisions for a future legal instrument should focus initially on issues of direct relevance to the grant of patents, in particular, the definition of prior art, novelty, inventive step/non-obviousness, industrial applicability/utility, the drafting and interpretation of claims, and the requirement of sufficient disclosure of the invention. Other issues, related to substantive patent law harmonization, such as first-to-file versus first-to-invent systems, 18-month publication of patent applications and a post-grant opposition system, would be considered at a later stage.

32. In May 2001, the SCP, at its fifth session, considered a first draft of the Substantive Patent Law Treaty (SPLT), with Regulations and Practice Guidelines.[11] The draft covered the six issues mentioned above, and the SCP also discussed the interface between the draft SPLT and the PLT and the PCT, and whether the scope of the draft SPLT should be limited to patentability and validity requirements, excluding issues related to the infringement of patents. At its sixth session to be held in November 2001, the SCP will consider revised texts to be submitted by the International Bureau.

Reform of the PCT

33. A process of reform of the PCT was commenced by the PCT Assembly in October 2000, and the Committee on Reform of the PCT was convened in May 2001. The Committee agreed to recommend to the Assembly (at its session in September 2001) that further work be undertaken by a working group on a specified range of issues. The working group would consider, as a first step, the concept and operation of the designation system, improved coordination of international search and international preliminary examination and the time limit for entering the national phase, changes consistent with the PLT, and general simplification and streamlining of procedures. This work would be based on the following general objectives (not necessarily in order of priority):

> "(i) simplification of the system and streamlining of procedures, noting also that many PCT requirements and procedures will become more widely applicable by virtue of the Patent Law Treaty (PLT);
>
> "(ii) reduction of costs for applicants, bearing in mind the differing needs of applicants in industrialized and developing countries, including individual inventors and small and medium-sized enterprises as well as larger corporate applicants;
>
> "(iii) ensuring that PCT Authorities can meet their workload while maintaining the quality of the services provided;
>
> "(iv) avoiding unnecessary duplication in the work carried out by PCT Authorities and by national and regional industrial property Offices;
>
> "(v) ensuring that the system works to the advantage of all Offices, irrespective of their size;

---

[10] See document SCP/4/6, paragraph 47 (http://www.wipo.int/eng/document/scp_ce/index_4.htm).

[11] See documents SCP/5/2 and 3 (http://www.wipo.int/eng/document/scp_ce/index_5.htm).

"(vi) maintaining an appropriate balance between the interests of applicants and third parties, and also taking into account the interests of States;

"(vii) expanding programs for technical assistance to developing countries, especially in the area of information technology;

"(viii) alignment of the PCT, to the maximum extent possible, with the provisions of the PLT;

"(ix) coordination of PCT reform with the ongoing substantive harmonization work being carried out by WIPO's Standing Committee on the Law of Patents;

"(x) taking maximum advantage of modern information and communications technology, including the establishment of common technical and software standards for electronic filing and processing of PCT applications;

"(xi) simplifying, clarifying and, where possible, shortening the wording of the provisions of the Treaty and the Regulations;

"(xii) streamlining the distribution of provisions between the Treaty and the Regulations in order, in particular, to gain increased flexibility."

Regional initiatives

34. A number of regional patent systems have been established by countries wishing to cooperate in the filing of patent applications and grant of patent rights effective in more than one country. The international agreements establishing those systems are the Agreement establishing the African Intellectual Property Organization (OAPI), the European Patent Convention, the Protocol on Patents and Industrial Designs within the framework of the African Regional Industrial Property Organization (ARIPO) (the "Harare Protocol"), and the Eurasian Patent Convention.

35. The past few years have seen the establishment of a new regional patent office under the Patent Regulation adopted by the Cooperation Council for the Arab States of the Gulf (the GCC Patent Office), an extensive revision of the European Patent Convention, and the emergence of new proposals to establish a (European) Community Patent system which would provide for the grant of a unitary patents having effect in all member countries of the European Community and provide a clear legal framework in case of dispute.

WIPONET

36. The Standing Committee on Information Technologies (SCIT), at its fifth Plenary Session, held in July 2000, approved an implementation strategy for WIPONET.[12] The initial goal of the deployment strategy is to have one intellectual property office in each Member State of WIPO connected to the Internet by the end of 2001 and to have all intellectual property offices of Member States of WIPO connected by the end of 2002.

[12] See documents SCIT/5/4 and 10 (http://www.wipo.int/scit/en/meeting/scit5.htm).

37. Systems to be developed under WIPONET, a global digital information network enabling the integration of intellectual property information resources, processes and systems of the worldwide intellectual property community, particularly the intellectual property offices of Member States, are intended to enhance communication between WIPO and the intellectual property community and provide a means by which the intellectual property community can pursue a series of new initiatives based on advances in information technology. Advantage will be taken of the new global communication infrastructure and the possibility of communicating and exchanging written and oral information. WIPONET will interconnect 332 intellectual property offices in 171 Member States of WIPO and will be largely based on existing worldwide communication infrastructures.

AGENDA FOR DEVELOPMENT OF THE INTERNATIONAL PATENT SYSTEM

General objectives

38. WIPO must provide strong leadership in developing the patent system to support the release of creative potential for economic benefit on an international scale without unnecessary hindrances. The need to find immediate solutions to some of the present difficulties (notably the workload crisis for some patent offices) must not be allowed to obscure the long-term perspective. Change in the wide sense will not be easy to achieve and will require the mobilization of political will at the highest governmental level. WIPO Member States need to focus on an agenda for development of the international patent system which keeps long-term and broader objectives to the fore.

39. The longer term and broad objectives for the development of the international patent system should be the provision of mechanisms and programs whereby inventors and industry have access to national, regional and internationally effective patent protection systems which enable them to obtain, maintain and enforce their patents through procedures which:

(i) are simple, inexpensive, timely, and reliable, consistent with the need to afford effective protection;

(ii) support the exploitation of patented technology, whether that be by manufacture, incentives for investment, international licensing and business transactions, or other technology transfer arrangements.

40. In pursuing these broad objectives, recent and short- to medium-term work in connection with the PLT, the draft SPLT and reform of the PCT should be coordinated, incorporated and built upon. It is proposed that WIPO should commence consideration of how the international patent system might be reshaped in that context. Additionally, in the course of developing mechanisms and programs to achieve the objectives, it will be necessary to consider:

(i) the need by countries to pursue economic development and other national interests by fostering innovation through an effective patent system;

(ii) the need of third parties for reasonable certainty as to how they may be affected by pending applications and granted patents;

(iii) enabling patent offices of all sizes, including those in developing countries, least-developed countries and countries in transition, to meet the needs of users and in

particular to ensure that mechanisms and programs are available to assist small and medium-sized patent offices in the pre-grant processing of applications for patents;

(iv) the general structure of the system, including interaction and inter-reliance among the national, regional and PCT systems;

(v) greater use of modern information and communications technology;

(vi) enhanced user-friendliness;

(vii) achievement of a high quality and timely service, including search and examination;

(viii) how the resources of patent offices could best be used to alleviate workload problems, including possibilities for supplementing one another's work and for avoiding duplication;

(ix) possibilities for simpler and more accessible means of enforcing and challenging patents.

41. Detailed measures will need to be identified and studied in the process of reshaping the international patent system. There is a wide variety of possibilities, not all of which will necessarily find acceptance. It is useful even at this stage, however, to list some measures and questions which might be considered, as set out in the Annex. The list does not claim to be exhaustive, and all ideas put forward which find interest will require careful study, detailed elaboration, exploration and testing, and analysis for costs and benefits and other considerations. Discussions should be from both short- and long-term perspectives, covering the existing patent systems and on-going efforts such as PCT reform, the draft SPLT and implementation of the PLT. In respect of PCT reform, the objectives already identified in that process will continue to be actively pursued.

42. To address the issues raised in this document, it is proposed to:

(i) invite written comments on this document, including the Annex, from governments, organizations and users by the end of January 2002, such comments to be made available on WIPO's web site and, upon request, on paper;

(ii) issue a discussion paper to be prepared by the Secretariat, containing an analysis of the comments received, for discussion by the WIPO General Assembly and the Assemblies of the Paris and PCT Unions in September 2002.

43. The WIPO General Assembly and the Assemblies of the Paris and PCT Unions are invited to note and express their views on the contents of this document, and to approve the proposals contained in paragraph 42, above.

[Annex follows]

ANNEX

AGENDA FOR DEVELOPMENT OF THE INTERNATIONAL PATENT SYSTEM: MEASURES AND QUESTIONS WHICH MIGHT BE CONSIDERED

A number of measures and questions which might be considered in the process of reshaping the international patent system are listed below, loosely grouped under headings. The list is intended to be illustrative rather than exhaustive, and spans matters ranging from broad principles to procedures. Some items might have been listed under any of several headings. Several of the matters mentioned could well be taken up in the context of substantive harmonization discussions by the SCP or in the context of reform of the PCT. Comments on this document may suggest additional matters for consideration.

General policy and structure of the international patent system

1. Should the revised structure of the international patent system rely on an extended version of existing systems, and particularly the PCT procedure, or should a new structure be designed?

2. Subject to progress on substantive harmonization of patent laws, should there be an adoption of procedures where substantive rights could be granted under an internationally recognized procedure?

3. How should much wider use of the PCT system by applicants in developing countries, least-developed countries and countries in transition be promoted?

4. What role should regional patent systems have in the international patent system? Should groups of countries be encouraged to establish further regional systems? In determining the form of any regional system, matters to be considered would include the potential for responding to current workload challenges.

5. Should there be a reconsideration of the need for patent offices to subject each and every application to full pre-grant search and examination, subject to proper options for later assessment of patentability at the instigation of applicants, patent offices and/or third parties?

6. Should there be studies aimed at broader and internationally consistent coverage in new, or newly exploited, fields of technology?

7. Should an internationally acceptable system for the preparation of applications, and more particularly for the drafting of patent claims and their interpretation, be investigated?

Service for users

8. In addition to the Patent Law Treaty and the on-going program for reform of the PCT, should there be further projects aimed at the simplification and streamlining of practices and procedures, with reduction in costs, and reduction or elimination of unnecessary formalities review and handling of applications, while maintaining an appropriate quality of search and examination?

9. Should patenting services be provided that are simple and easy to use for applicants, consistent with expectations based on wide use of “one click” transactions on the Internet, and if so, how?

10. The development of timely processing, consistent with business needs and the commercial value and commercial life of inventions, including options for applicants to choose fast-track or deferred processing depending on the circumstances.

Costs

11. Can low cost, high quality, alternatives for securing patent protection be developed, accessible by those would-be users (notably, individual inventors, small and medium sized enterprises, and many applicants of all sizes from developing countries, least-developed countries and countries in transition) for whom international patent protection is presently inaccessible because it is too expensive to obtain?

Search and examination

12. Should there be studies aimed at consistency among patent offices in search and examination policy, practices and procedures?

13. What possibilities exist for greater sharing of search databases?

14. What possibilities exist for enhancement of the value of the present search and examination procedures?

15. Are there alternative ways of obtaining search results, possibly by more use of commercially available search databases, statutory requirements for applicants to disclose prior art, and enabling voluntary (and possibly anonymous, via the Internet) contributions to search work from third parties?

16. Should multiple, supplementary or combined searches and examinations by different offices be available?

17. Is it possible to simplify certain procedural aspects of search and examination, such as by combining search and examination, simplifying nucleotide and amino acid sequence application processing, and simplifying the procedure in case of lack of unity of invention?

Sharing of information and resources among patent offices

Is it feasible to consider:

18. Greater sharing of common tools (for example, search databases, computer-assisted translation techniques, search and examination reports, publication having international effect, a common register of granted patents); other offices (including small and non-examining offices) could make use of search and examination reports as non-binding opinions?

19. Programs for inter-office lending of experts to increase the flow of expertise and skills, and optimizing the use of resources among offices?

20. Specialization of patent offices' work in particular technical fields and in particular languages, of examiner expertise and of search resources; this would imply new organizational and inter-office operational policies?

21. More efficient and comprehensive monitoring of the processing of applications by the patent offices involved in the processing of applications under the various national, regional and international systems?

Avoiding unnecessary duplication of work

22. Are there ways in which there might be a reduction in duplication of work, especially in search and examination, with resulting cost savings for applicants and offices? This would imply greater recognition or exploitation of the results of the work done by other offices. Can expanded procedures be developed which would allow patent offices to use the results of work undertaken by other offices, for example, by a centralized monitoring system of all applications to allow offices to avoid duplicative work?

23. Are there ways in which positive examination results in other patent offices may be recognized?

Information and communications technology

24. How may greater use be made of modern information and communications technology in the obtaining and processing of patent rights, by both applicants and offices?

Dissemination of information to the public

25. Are there ways for ensuring that third parties are able to determine at the earliest opportunity whether a patent is likely to be, or has been, granted by any particular patent office? Issues which may be considered include electronic international publication, publishing international preliminary examination reports, greater use of computer-assisted translation, permitting access to files by all offices and third parties at any time after publication of the application, and a common register of granted patents.

Orientation towards licensing and marketing

Issues which may be addressed here include the necessity for mechanisms and programs designed to provide:

26. Support for international licensing and other business transactions, including development, manufacturing, sales, marketing and technology transfer agreements.

27. Assistance in the identification of tools necessary for assisting research and development activities and the valuation and commercialization of patented technology.

28. Reliable and certain operation of the system so as to support international investment, for example, in relation to decisions concerning patentability.

Resolution of post-grant disputes

29. Are there any new possibilities for resolving infringement and validity disputes in an international context by provision of a system of alternative dispute resolution, for example, using an expert arbitrator, as in WIPO's arbitration procedures?

Smaller patent offices

30. What sort of advice and assistance should be provided for small and medium-sized patent administrations in respect of the introduction of systems for pre-grant processing of applications for patent rights?

Cooperation for development

31. What sort of advice and assistance should be provided to provide a more focussed development orientation, in which the patent system encourages new business development, investment and the movement of technology, hence contributing to employment and wealth creation?

[End of Annex and of document]