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

**PCT COMMITTEE**  
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DRAFT RULE 90bis

Comments by the European Patent Office

The present document contains comments, received from the European Patent Office, concerning proposed new draft Rules 90bis.4(a) and 90bis.5(a) and (c).

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that in such State withdrawal of a demand or of elections no longer has the consequence that the application is deemed withdrawn as is foreseen in PCT Article 37(4)(a).

In addition, proposed new Rule 90bis.5(c) provides in a general way that all processing by the International Preliminary Examining Authority shall be terminated where the demand or all elections are withdrawn. Consequently, no international preliminary examination report would be established in cases where the applicant had already requested (earlier) national processing in elected States.

This means that the proposal, in its current version, would give applicants the possibility of systematically avoiding adverse examination reports by requesting national processing before the establishment of the international preliminary examination report. In doing so, the applicant would benefit from three advantages which, pursuant to the PCT, were not intended to apply jointly: firstly, he would get the benefit of having postponed the entry into the national phase; secondly, the sanction provided for in Article 37(4)(a), that the application is considered withdrawn, could not apply for such States; finally, no adverse international preliminary examination report could be established for use in the national phase.

3. The European Patent Office, which also acts as an elected Office, considers it unjustified that proposed Rule 90bis.5(c) would allow the applicant to avoid adverse international preliminary examination reports without having to bear the legal consequences generally provided for in Article 37(4)(a).

It is to be recalled that international preliminary examination was not intended to serve the applicant only, although this may be said to be one very important aspect. In

Proposal relating to

Rules 90bis.4(a), 90bis.5(a) and (c).

Reasons given by the International Bureau in document PCT/CAL/III/3, paragraphs 3 to 5, pages 84 and 85

Effect of the withdrawal of the demand before the expiry of 30 months in an elected State in which national processing had already started earlier pursuant to PCT Article 40(2)

1. Pursuant to current Rule 75.1 and to proposed new Rule 90bis.4(a), the applicant may withdraw the demand or any or all of the elections prior to the expiry of 30 months from the priority date.

However, if he does, so, he is subject to a heavy sanction if he had filed the demand prior to the expiry of 19 months pursuant to Article 39(1)(a). Withdrawal of the demand or of any or all of the elections is then considered to be withdrawal of the international application as far as such elected States are concerned (PCT Article 37(4)(a)).

As can also be derived from the preparatory documents to the PCT, the aim of that provision clearly is that the applicant, once he has acquired the benefit of late entry into the national phase, should not be able to avoid expected adverse examination reports from the national phase by simply withdrawing the demand or any or all elections.

2. Proposed Rule 90bis.5(a) provides, *inter alia*, that the withdrawal of the demand or of any election shall have no effect in any elected Office where the processing of the international application has already started. That means

particular, in elected States which allow file inspection after the first publication, the international preliminary examination report is a valuable way for competitors to assess the patentability of the invention after the application has entered the national phase.

Moreover, establishment of an international preliminary examination report is also intended to facilitate work for the elected Offices in order to give them a basis for any examination to be carried out in the national phase.

Attention of delegations is in particular drawn to the following:

Within the framework of negotiations on harmonisation of patent law the length of time of examining procedures is heavily criticized by some delegations in view of the long lasting legal uncertainty for third parties, in particular for competitors.

It would be somewhat inconsistent with such a view in the context of harmonisation, if on the other hand one favoured PCT legislation allowing the applicant to benefit from a prolonged period before the start of national processing and examination, if any, in the elected state concerned without creating in the meantime any basis for the assessment of the application as to its patentability. The IPER is the quid pro quo for the later entry into the national phase according to Chapter II PCT. Allowing the applicant to prevent the IPER from becoming effective for a validly elected Office would have the effect of giving an option to the applicant of deferring the examination between the 20th and 30th month without giving the examination in the elected Office the proper basis foreseen in the PCT.

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#### Conclusion

4. For the above-mentioned reasons, the European Patent Organisation does not find it justified that the proposed new Rule enables applicants to prevent international preliminary examination reports from being considered in the national phase. It may be expected that once applicants become aware of the possibilities offered by the proposed new Rule, they would make considerable use of it. Therefore, the European Patent Organisation is of the opinion that, even after withdrawal of the demand, international preliminary examination should continue and an international preliminary examination report be established if national processing had already started in one or more of the elected States.

It is consequently suggested that in Rule 90bis.5, the following short passage should be added at the end:

"except where processing of the application pursuant to PCT Article 40(2) has already started in an elected State."

5. In the view of the European Patent Organisation, the necessary administrative actions to be performed to handle such cases could be introduced without putting an undue additional burden on the Authorities or Offices concerned:

If the applicant withdraws the demand or any election by notifying the International Bureau, the International Bureau informs the International Preliminary Examining Authority and the elected States concerned accordingly. (This is not a proposed additional action, but only reflects the present situation.) The only action to be taken would be that any elected State where national processing has already started would have to notify that fact to the International Bureau. The International Bureau would then inform the International Preliminary Examining Authority so that the international preliminary examination report may be established.

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- 5 -

6. It is the view of the European Patent Organisation that, if the proposed solution were not found to be acceptable by the other delegations, elected Offices should at least be given the right to stipulate that they require an international preliminary examination report in the cases referred to above and that, in such circumstances, the competent International Preliminary Examining Authorities should establish such a report.

7. Delegations are invited to present their views, in particular in their roles as elected States.

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