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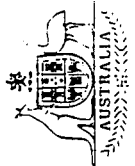
PCT COMMITTEE
FOR ADMINISTRATIVE AND LEGAL MATTERS

Third session, Second Part
Geneva, September 17 to 21, 1990

DRAFT RULES 53.2(a)(v), 53.9, 60.1(e), 69.1(a), (b) AND (c)

Comments by the Australian Patent Office

The present document contains comments received from the Australian Patent Office, concerning proposed draft Rules 53.2(a)(v), 53.9, 60.1(e), 69.1(a), (b) and (c).



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31 August 1990

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Dear Dr Bogtsch

At the meeting of the PCT Committee for Administrative and Legal Matters held in July of this year, the representative of this Office expressed some reservations about the International Bureau's proposals concerning the 'start' of international preliminary examination and related proposals concerning amendments and the requirements for the demand form.

Set out below are the conclusions that we have come to as a result of further consideration of the matter. We should be grateful if this letter be made available to the participants at the meeting notwithstanding the late stage at which we are sending it to you.

Proposals in document PCT/CAL/III/3 to amend (or include) Rules 53.2(a)(v), 53.9, 60.1(e), 69.1(a), (b) and (c)

We agree that the 'start' of preliminary examination should not be governed by the happening of one of the several events specified at present in Rule 69.1(b). It is difficult for applicants to understand the complex arrangements made by the Rule. It also gives the International Bureau a monitoring and notifying task that involves unnecessary work. The International Preliminary Examining Authorities are reasonably well provided for by the Rule at present except that the start of examination varies according to when certain events happen to occur.

The extensive changes proposed by the International Bureau to Rules (including proposed new Rules) 53.2(a)(v), 53.9, 60.1(e), 69.1(a), (b) and (c) and the inclusion of an additional Box on the demand form on the other hand are seen as providing a complicated solution, but not the best solution, to the various problems created by present Rule 69.1(b). In particular, there are disadvantages to applicants and to International Preliminary Examining Authorities.

In our view, a better solution would be simply to amend Rule 69. We suggest that the change should be based on the fact that most applicants file a demand before the end of the 19 months after the priority date. International preliminary examination could start at the end of 20 months after the priority date where the demand was filed by that time. This fixed time would, apart from exceptional circumstances, provide ample time for Article 19 amendments to be in the hands of the International Preliminary Examining Authority since the time limit for these amendments should normally have expired well before this time. The applicant would also have a reasonable, fixed time limit within which to file amendments under Article 34(2)(b) with the International Preliminary Examining Authority.

The mixing of the filing of amendments (or the making of decisions regarding them) with the filing of the demand which is involved in the International Bureau's proposal is seen as disadvantageous to the applicant and to the International Preliminary Examining Authority.

The applicant should be able to file a demand as early as possible to secure the delaying effect provided by Article 40(1). The mixing in of decisions on amendments complicates what is otherwise a simple issue for the applicant to the detriment either of the early filing of the demand or the filing of amendments before the start of preliminary examination.

Under such a system, the International Preliminary Examining Authority would probably receive less amendments from the applicant prior to the start of international preliminary examination but more at a later stage (i.e. after the first written opinion). This would involve for the International Preliminary Examining Authority and the applicant more time, effort and cost.

The suggestion by the International Bureau that its proposal provides more time for international preliminary examination is not seen as persuasive. Nor would it necessarily mean that the earlier start to examination would lead to an earlier completion date since the International Bureau's proposal provides a time limit for examination of 28 months after the priority date. The time limit is unrelated to when the start of international preliminary examination occurs.

A start at the end of 20 months after the priority date, as we suggest, would not preclude the International Preliminary Examining Authority from completing, before examination starts, those clerical and scheduling tasks that precede the examination process. The International Bureau's explanation of its proposal overlooks this aspect in implying that a start upon the receipt of the demand will provide benefits.

Proposal

Our proposal would be that Rule 69 have the following elements:-

R.69.1(a) - A time limit of 8 months from the start of international preliminary examination in all cases.

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R.69.1(b) - International preliminary examination to start -

- (a) at the end of 20 months from the priority date in all cases where the demand is filed before that time;
- (b) upon receipt of the demand in those (most exceptional) cases where the demand is filed later than the end of 20 months from the priority date.

R.69.1(c) - Alternative A - retain the present text except for the last sentence

Alternative B - delete

Alternative C - replace the present telescoped procedure by an expedited international preliminary examination procedure. This procedure would start upon a special request by the applicant and could have some of the elements of the International Bureau's proposal, i.e., an indication by the applicant as to any amendments filed under Article 19 and any amendments submitted under Article 34(2)(b). It is envisaged that this request would be in the form of a letter since it is thought that the procedure would rarely be used.

Yours sincerely



E.M. Haddrick
Deputy Commissioner

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