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PCT/CAL/IV/4

ORIGINAL: French

DATE: November 28, 1990

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PCT COMMITTEE FOR ADMINISTRATIVE AND LEGAL
MATTERS

Fourth Session, First Part*
Geneva, December 10 to 14, 1990

PROPOSALS TO AMEND PCT RULES 5.1, 40.2, 68.3 AND 91.1

Submitted by the European Patent Office

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EPO proposal to amend Rules 5 and 91 PCT

Title of the invention

PART I

Rule 5

“The Description”

5.1 *Manner of the description*

- (a) The description shall*:
 - (i) to (vi) [No change]
- (b) [No change]
- (c) [No change]

* The amendment consists in deleting after the word “shall” appearing after “description”, the words “first state the title of the invention as appearing in the request and shall”.

Rule 91

Obvious errors in documents

91.1 *Rectification*

- (a) to (d) [No change]
- (e) No rectification shall be made except with the express authorization:
 - (i) of the receiving Office if the error is in the request except where the error is in the title of the invention;
 - (ii) of the International Searching Authority if the error is in any part of the international application other than the request except where the error is in the title of the invention, or in any paper submitted to the Authority;
 - (iii) [No change]
 - (iv) [No change]
- (f) to (g-quarter) [No change]

PART II

1. By virtue of the introductory clause in PCT Rule 5.1(a), the description has first to state the title of the invention as appearing in the request which forms part of the international application. The title of the invention as given in the mandatory request form (Rule 4.1(a)(ii)) appears in the PCT Gazette and is printed on the title page of the international publication. It is not necessary, therefore, to mention the title again at the beginning of the description.

2. It has emerged from EPO practice which is based on legal concepts identical to those appearing in the PCT (EPO Rules 26(2)(b) and 27(1)) that some applicants fail to repeat the title of the invention, given in the request, as the first element of the description. Alternatively, it can happen that the title given in the request and that given in the heading of the description do not match. In the latter case, according to the European procedure, it is the title of the invention given in the request that appears in the bibliographic data of publication A. That is why, in the European procedure, the formalities examiners delete the title appearing in the description when they prepare the documents for publication.

3. This circumstance has led the President of the EPO to propose to the Administrative Council of the Organization, in connection with a wide-ranging revision of the EPC Regulations, to amend EPC Rule 27(1) in such a way as to remove the obligation to give the title of the invention as the first element of the description.

4. The EPO has noticed, in the course of its activity as a receiving Office under the PCT that the difficulties encountered in the European procedure are to be found in a similar form in the PCT procedure.

5. Consequently, the EPO proposes the amendment of PCT Rule 5.1 to remove the obligation on the applicant to repeat the title of the invention, already appearing in the PCT request, in the heading of the description. A draft amendment is to be found in Part I of this document.

6. The proposed amendment to PCT Rule 5.1, if accepted, will make it necessary also to amend PCT Rule 91.1, on the rectification of obvious errors in the documents making up the international application. A draft amendment to this Rule is also given in Part I of this document.

Under Rule 91.1(e)(i) and 91.1(e)(ii) respectively, any rectification calls for the authorization of the receiving Office if the error is in the request, or of the International Searching Authority (ISA) if the error is in any part of the application other than the request.

7. In view of the fact that a rectification request generally requires an examination of technical aspects, it is rather for the ISA than for the receiving Office to rule on the request.

8. Consequently, the EPO proposes the amendment of PCT Rule 91.1(e) to exclude the title from the area of competence of the receiving Office with respect to the rectification of obvious errors, and to entrust that competence to the ISA.

EPO proposal to amend Rules 40.2 and 68.3 PCT

Lack of Unity of Invention

PART I

Rule 40

Lack of unity of invention
(International Search)

40.1 [No change]

40.2 *Additional fees*

(a) to (d) [No change]

(e) Any International Search Authority may require that the applicant pay a fee for examination of the protest.

Rule 68.3

Lack of unity of invention
(International Preliminary Examination)

68.1 [No change]

68.2 [No change]

68.3 *Additional fees*

(a) to (d) [No change]

(e) Any International Preliminary Examining Authority may require that the applicant pay a fee for examination of the protest.

PART II

Argument

1. When, in the course of the international search, the International Searching Authority (ISA) notes a lack of unity of invention, it invites the applicant to pay additional fees for the performing of the international search on those parts of the international application that relate to inventions other than that mentioned first in the claims (PCT Article 17(3)(a)).
2. Under PCT Rule 40.2(c), the applicant may pay the additional fees and at the same time file a reasoned statement (protest) disputing the alleged lack of unity of invention.

At the EPO in its role as an ISA, under EPC Article 154(3), the Boards of Appeal are responsible for deciding on such protests.

The procedure before the Boards of Appeal in such cases is essentially the same as the procedure for an appeal concerning a European patent application (ex parte procedure), and so the cost of the procedure is at the same level in both cases.

The annual number of protests filed with the EPO has increased considerably in recent years (about 70 in 1990); this is consistent with the rapid growth in the number of international searches to be performed by the Office.

3. It should be mentioned that the procedure concerning a protest, provided for in PCT Rule 40.2(c), is at present the only procedure before the EPO that may be instituted by the applicant without payment of a fee. The introduction of such a fee is therefore in keeping with the general principles governing the Office's activity in connection with both the European and the international procedure, those principles being intended not only to ensure the financing of that activity by the users, but also to rule out any arbitrary recourse by applicants to the procedures made available to them.
4. For the reasons set forth above, the EPO considers it necessary to introduce, in PCT Rules 40.2 and 68.3, the possibility for ISAs and IPEAs to make the examination of any protest filed by the applicant subject to payment of a fee.
5. This view was submitted by the Office to the Harmonization Working Party of the Administrative Council of the European Patent Office at its session on September 17 and 18, 1990. The Working Party recognized the financial problem that the implementation of the procedure referred to in PCT Rules 40.2(c) and 68.3(c) raised for the Office, and expressed its support for the EPO's plan to propose a suitable amendment to the PCT Regulations.

CONCLUSION

6. The EPO therefore proposes, as part of the current revision of the PCT Regulations, the introduction of the possibility for International Searching and International Preliminary Examining Authorities to make the examination of any protest filed under PCT Rules 40.2(c) and 68.3(c) subject to payment of a fee. A draft amendment to Rules 40.2 and 68.3 is to be found in Part I of this document.

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