

# WIPO



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GENEVA

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

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PATENT COOPERATION TREATY (PCT)**

**Sixteenth Session  
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PCT REFORM

*Proposals by the European Patent Office*

## SUMMARY

1. This document contains proposals by the European Patent Office relating to:
  - (i) informal clarification before search;
  - (ii) compulsory reply to the international preliminary report on patentability (IPRP)
  - (iii) identification of amendments; and
  - (iv) filing of third party observations.

## INFORMAL CLARIFICATION BEFORE SEARCH

2. In order to improve the quality of the search and to enhance the usefulness of its European search reports the European Patent Office (EPO) has proposed a modification of the Implementing Regulations to the European Patent Convention (EPC).
3. Currently, when at the search stage the application contains major deficiencies impeding a proper search to be conducted, the examiner has two options. Where the file contains a fall-back position (e.g. the claims are unclear but the invention for which protection is sought

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can be understood from the application as a whole) he establishes a normal European search report, indicating in the search opinion how the claims have been construed. Otherwise, where the deficiency is so severe that a meaningful search cannot be conducted on all claims, he establishes an incomplete search report or even a declaration of no-search.

4. This is detrimental to the applicant as he cannot fully rely on the indications given in the search report when deciding how to proceed further with his application. Furthermore, this considerably affects the public legal certainty as third parties cannot assess on the basis of the published application, the search report and the written opinion what may be the protection potentially available in the application. In order to reduce the number of incomplete search reports and declarations of no-search, the EPO wants to enable examiners, where appropriate, to contact applicants during the search phase in order to seek clarification of what must be searched.

5. Therefore, the examiner will invite the applicant, when necessary, to provide clarification of the subject matter to be searched within a time limit of 2 months. As amendments cannot be filed at the search stage, this clarification can for example either be given in the form of a statement indicating how the deficient claims must be construed on the basis of the description, or by indicating how these claims could be amended in examination. Of course, should the applicant not agree with the examiner's finding, he can reply by filing counter arguments.

6. In the absence of a reply, or when the reply is not satisfactory (e.g. an indication based on elements not contained in the application as originally filed), the examiner proceeds with the establishment of an incomplete search report or a declaration of no-search as indicated in the invitation. Later in substantive examination unsearched subject matter will need to be excised from the application and cannot be used as basis for amendments, as in the case of non-unity.

7. This change of procedure allows the applicant to contribute to the establishment of a complete search or, where this is not possible, to assist the examiner in defining what can be searched. Eventually, the applicant will get an improved service, and in the worst case will not get less than what he would get now under similar circumstances. The new procedure also takes due account of the public interest as third parties are better informed about the potential scope of protection available after substantive examination, and of the related prior art. This is also important for the offices wishing to re-use the search results produced by the EPO.

8. The PCT Guidelines already contain similar enabling clauses (see paragraphs 9.34 and 9.35). These enabling clauses for asking informal clarification during the Chapter I procedure have so far never been used. The EPO believes that its new policy under the EPC can be successfully extended to the PCT. This would contribute to the same extent to raising the quality and efficiency of search work performed by International Authorities. Not only the applicants and the public would benefit from this, but also the designated Offices would have a better understanding of what has been searched. This would in addition enhance the reusability of international work by designated Offices.

9. There are further benefits for the IPEA and designated Offices. Currently what could not be searched will normally not be examined by the IPEA. Amendments for overcoming the deficiencies revealed during the search could now be filed during the international preliminary examination. They can also be filed upon entry into the national/regional phase.

10. Therefore, the EPO invites:

(i) the IB to proceed with the necessary preparatory work for enabling International Authorities to make use of the provisions contained in PCT Guidelines 9.34 and 9.35; and

(ii) the other International Authorities to consider using these provisions.

#### COMPULSORY REPLY TO THE IPRP

11. The EPO is introducing a rule change into the EPC, stipulating that for applications where the EPO was ISA, or ISA and IPEA, the applicant has to file a substantiated reply to the IPRP upon European phase entry in the event that the IPRP notes deficiencies in the application. This will not only accelerate proceedings, but will also mean efficiency gains for the office. Currently after European phase entry, where the applicant has not filed amendments and/or observations, a communication from the examining division has to be dispatched inviting the applicant to remedy the deficiencies already listed in the IPRP, meaning a duplication of work.

12. A very important further consequence of this rule change is that it will give the IPRP the same status as a first office action in substantive examination, and will therefore increase its standing before other designated Offices (DOs).

13. The change will be implemented by an amendment to Rule 161 EPC. Under current Rule 161 EPC the applicant receives a communication from the EPO after European phase entry, giving him the opportunity to file amendments to the application within a time limit of one month. Such communication will be sent irrespective of whether the applicant already filed amendments upon European phase entry.

14. In future this communication will also give applicants the opportunity to comment on the IPRP, and will invite them, where appropriate, to correct any deficiencies and to file amendments to the description claims and drawings.

15. If the applicant does not file a substantive response, either as a result of this invitation or of his own accord upon European phase entry, the application will be deemed to be withdrawn.

16. The EPO invites the other offices to contemplate whether it would be possible to introduce such a system in their national law, leading to increased standing and trust in IPRPs and to efficiency gains for the offices.

17. Furthermore, modification of the provisions governing the status of the comments which the applicant can file with the IB in response to the written opinion of the ISA (WOISA) should be contemplated. When the WOISA is negative, a reply to the WOISA should be encouraged. This would allow the designated Offices to receive the opinion of the applicant in addition to the findings of the ISA. Therefore, re-usability would be enhanced as the designated Office would have the opinion of both sides before starting the national procedure. This would also be an incentive to build on the work performed during the international phase instead of starting from the beginning in the national phase.

## IDENTIFICATION OF AMENDMENTS

18. Where the applicant files amendments in Chapter II proceedings without identification or indication of where a basis for these amendments can be found in the application documents, a considerable amount of effort is required from examiners. In particular where their basis in long applications has not been indicated, the risk of making mistakes when assessing their allowability is increased and very often leads to quality deficiencies.

19. The EPO is now introducing a rule in the EPC, obliging the applicant when filing amendments to indicate the basis for them in the application as filed. If the applicant does not do so, and the basis cannot be identified without undue effort, the examining division may request the applicant to indicate such basis within a time limit of one month. If the applicant does not respond, the application will be deemed to be withdrawn.

20. As for PCT chapter II proceedings, current Rule 66.8(a) PCT (*Form of Amendments*) merely states that the “letter accompanying the replacement sheets ... shall preferably ... explain the reasons for the amendment”.

21. The EPO proposes to amend Rule 66.8 PCT, and to introduce an obligation for the applicant to identify the basis for amendments filed. Where the applicant does not provide such an indication, the Guidelines could state that the IPEA would have the option to make a request to do so in the first written opinion. A failure to reply would allow the IPEA to ignore the amendments when drawing up the IPER. The examiner would decide when it is appropriate to make such a request. Of course where the basis for the amendments can be retrieved without substantial effort from the content of the application as filed, he would not make such a request and would have no reason to ignore the amendments.

## FILING OF THIRD PARTY OBSERVATIONS

22. A proposal to allow third parties to submit observations is included in the Memorandum by the DG of WIPO on the Future of the PCT of 6 February 2009. This proposal is strongly supported by the EPO. The EPO would like to discuss further how a system for submitting observations and communicating these observations to the IPEA and to DOs could be implemented.

*23. The Meeting is invited to comment on the proposals of the EPO put forward in this document.*

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