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INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

COMMITTEE ON REFORM  
OF THE PATENT COOPERATION TREATY (PCT)

First Session  
Geneva, May 21 to 25, 2001

REFORM OF THE PCT:  
PROPOSALS BY INDIA

*Document prepared by the International Bureau*

1. The proposals appearing on the following pages were made by India in a submission to the International Bureau received on April 3, 2001. Background information appears in document PCT/R/1/2.<sup>1</sup>

2. *The Committee is invited to consider the proposals contained in this document.*

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<sup>1</sup> The working documents for the Committee's session are available on WIPO's web site at the following address: [http://www.wipo.int/pct/en/reform/index\\_1.htm](http://www.wipo.int/pct/en/reform/index_1.htm)

PROPOSAL OF INDIAN PATENT OFFICE FOR  
REFORM OF THE PATENT COOPERATION TREATY (PCT)

I. INTRODUCTION

This paper is submitted with an intention to introduce the proposal of Indian Patent Office (IPO) on reform of the Patent Cooperation Treaty (PCT), as per the decision by the PCT Union Assembly that took place from September 25 to October 3, 2000.

The present proposal is a preliminary one based on our limited experience of the functioning of PCT and that additional proposals could be submitted based on further consideration of the matter.

II. PCT REFORMS PROPOSALS OF IPO

1. *Rationalisation and simplification of request form*

Most of the Designated or Elected Offices do not require a specific form to be filed while entering the national phase as Article 22 and Article 39(1) are silent on this issue. However, certain Designated Offices/Elected Offices require submission of a form prescribed by them. The applicants desirous of entering multiple Designated Offices/Elected Offices have to keep a track of the prescribed form or to file the request on a plain paper, as the case may be. Therefore, the existing request form for filing international applications may be modified suitably to bring uniformity in the procedure of filing national phase applications.

2. *Elimination of the concept of indicating the Designated State in request form when maximum designation fee is paid under Rule 4.9(a)*

The number of Contracting States is changing frequently whereas the request form is modified twice a year (January and July). The applicants while filing designation fee under Rule 4.9(a) for six states may, due to oversight, not indicate all the Contracting States in the request form, which results in denial of entry to national phase in states whose names were not marked in the check box provided in the request form.

The said Rule and the Request form may be modified so that when maximum designation fee is paid, all Contracting States as on that date are deemed to have been designated in the said international application for patent.

3. *Modification in the Article 42*

Article 42 requires that no elected Office receiving the international preliminary examination report may require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same international application in any other elected office.

Article 42 is required to be modified to enable the Elected Office to call for status, objections taken, if any, relating to patentability, novelty and other details of the corresponding applications involving same or substantially the same invention filed in other Elected Office. This is necessary as the patent offices in developing and least developed countries are not

fully equipped with the required facilities for search and examination. Such information from the applicant will help the Patent Offices concerned to deal with the case.

4. *Preliminary Examination fee*

Rule 58.1(c) requires that preliminary examination fee shall be payable directly to the International Preliminary Examining Authority (IPEA).

This rule may be modified so as to permit the applicants to pay the preliminary examination fee in the Receiving Office in the currency prescribed by the respective IPEA on the basis of a demand raised by the Receiving Office. In most of the developing countries foreign exchange is not available easily and the applicants are required to submit declaration from a government authority for obtaining necessary foreign exchange.

5. *Handling fee*

Rule 57.1 requires that each demand for international preliminary examination shall be subject to the payment of a fee for the benefit of the International Bureau (“handling fee”) to be collected by IPEA to which the demand is submitted.

This rule may be modified so as to enable the applicants to pay the said handling fee in the Receiving Office in the currency prescribed by the respective IPEA for the reasons stated under serial number 4.

6. *Fixed Basic Fee*

As per Rule 15.2(a) the amount of Basic fee changes if the number of pages of the request form + description + claims + drawing + abstract exceeds 30 sheets.

Though many countries charge additional fee for extra claims beyond a prescribed number, but no Patent Office charges fees on the basis of number of pages of the description/specification. It will be convenient for the applicants and the Receiving Offices if the basic fee is uniform irrespective of the number of pages.

7. *Deletion of Rule 13*

Patent Cooperation Treaty is a facilitating Treaty and is concerned with procedural matters whereas in Rule 13 substantive requirement is prescribed which is to be followed by respective Designated Offices/Elected Offices, which carry out substantive examination of the application for patent. Therefore, Rule 13 needs to be deleted.

8. *International publication*

As per Article 21 International Bureau is required to publish international application. It will be convenient if the International Bureau publishes the said application in a form acceptable to the Contracting States. This will result in saving of costs, time and formality requirements for both the Patent Offices and the applicants.