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(PCT UNION)

COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

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REFORM OF THE PCT:
PROPOSALS BY THE NETHERLANDS

Document prepared by the International Bureau

1. The proposals appearing on the following pages were made by the Netherlands in a submission to the International Bureau received on January 24, 2001. Background information appears in document PCT/R/1/2.¹

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

¹ 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

FIRST STAGE OF THE PCT REFORM

ADDITIONAL ITEMS FOR CONSIDERATION AS SUGGESTED BY THE KINGDOM OF THE NETHERLANDS

In line with the decision of the Assembly of the PCT Union as presented in paragraphs 51 and 56 of document PCT/A/29/4, the Kingdom of the Netherlands would like to submit the following additional items for consideration during the first stage of the proposed PCT Reform:

Office to which a particular document has to be submitted

At present not all documents which an applicant might like to submit during the international phase of the international application can, in accordance with the Treaty, be submitted to the receiving Office. For instance, amended claims under PCT Article 19 and later elections under PCT Article 31 are to be filed with the International Bureau, whereas the demand under PCT Article 31 is to be submitted to the competent International Preliminary Examining Authority. Regularly mistakes have been made with relation to such requirements. NL therefore suggests that the Treaty be drafted in such way as to allow the applicant to file all documents required and correspondence needed in the international phase with a single Office. The said Office will then distribute the received data to the competent international authority without loss of filing date.

Provision of a legal basis for the procedure under PCT Rule 19.4

At present PCT Article 11(2) and PCT Rule 19.4 cover the same situations, but with a completely different outcome as regards the international filing date accorded. Noting the broad acceptance of the procedure under PCT Rule 19.4, NL suggests to clarify the Treaty accordingly.

Optimal use of the available International Searching Authorities

Item (5) of the US-proposal as presented in an Annex to document PCT/A/29/3 might be looked at in a broader context. When the ISA's were to carry out an international search together, the difference in language capabilities between the various ISA's would allow a full-text search in documents for which, at present, all ISA's would under PCT Rule 34 have to rely to some extent on any availability of abstracts in the English language. The concept of a single International Searching Authority, already present in PCT Article 16, could be clarified along these lines.

Confidential nature of the international preliminary examination

The views with relation to the confidential character of a national patent examination procedure have changed considerably since 1970. Nowadays, once a patent application has been published promptly after the expiration of 18 months from the priority date, it has become accepted practice to allow third parties access to the complete file, including the front file. NL suggests that PCT Article 38 reflect this change in attitude. The Treaty might also open up the possibility for third parties to draw the attention of the International Preliminary

Examining Authority to relevant facts and disclosures, thereby enabling the Authority to take these matters into account during the international phase of the international application.

Divisional applications

In recent years the possibility of introducing under the Treaty the concept of divisional applications has been discussed in ad hoc working groups. At the time it was felt that one of the obstacles would be the manner in which the international filing date is determined under PCT Article 11(3). The first stage of the proposed PCT Reform offers an excellent opportunity to have another look at the question of divisional applications under the Treaty. The possibility to file an international divisional application may also offer relief to International Searching Authorities when trying to meet the time limit for international search in case of non-unity of invention.

Conformity with the TRIPs Agreement

The first stage of the proposed PCT Reform offers an excellent opportunity to bring PCT in conformity with the TRIPs Agreement. In connection herewith PCT Article 8 might be clarified.

Time limit for entry in the national phase

At present PCT Articles 22(3) and 39(1)(b) leave it to the national law of the designated or elected State, respectively, to grant any extension to the fixed time limits for entry in the national phase. Since 1970, however, there has been a growing tendency to allow for extension of time limits, also in the framework of the Treaty. Many designated and elected States already allow for an extension of the time limits under PCT Articles 22(1) and 39(1)(a). NL therefore suggests that the Treaty be drafted in such way as to prescribe the allowance of a modest extension of the time limit for entry in the national phase.

Duration of the budget term

PCT Articles 53(2)(a)(vi) and 53(10) mention a triennial budget. However, already in 1979 (see document AB/X/32) it was decided to change over to a biennial budget, notwithstanding the wording of the Treaty. The first stage of the proposed PCT Reform offers an excellent opportunity to bring the wording of the Treaty in line with existing and future practice as regards the budget term.

Executive Committee

Notwithstanding PCT Article 53(9) the Executive Committee never has been established. Therefore apparently there is no need to maintain the obligation mentioned in the said Article. When the establishment of the Executive Committee were to be presented as an option, there seems to be no need to describe the particulars of such Committee in the Treaty (at present PCT Article 54).

Committee for Technical Cooperation

Because of other developments with relation to technical cooperation in the framework of WIPO, the prescribed existence of the PCT/CTC has become a hindrance rather than the useful asset PCT Article 56 had in mind. The first stage of the proposed PCT Reform offers an excellent opportunity to amend PCT Article 56 and adapt the Working Group structure under the Treaty to existing and future needs.

Successor States

PCT Article 62 does not mention the possibility to become Party to the Treaty as a Successor State, i.e. a State whose territory was, before the independence of that State, part of the territory of a Contracting State which subsequently ceased to exist. NL therefore suggests that the legal basis of PCT Rule 32 be clarified in the Treaty.

Furthermore, the Kingdom of the Netherlands would like to submit with relation to the Special Body two suggestions of a procedural nature.

Size of the Special Body

For reasons of speed and efficiency the membership of the Special Body should not be too large. The composition of the PCT Member States invited to be member of the Special Body preferably reflect the varying degrees of technological development and an equitable geographical distribution.

Observers

States who have not become Party to the Treaty may have found certain obstacles making their accession, or even ratification, unattractive. By inviting such non-member States to be an observer to the Special Body, an opportunity would be created to avoid or eliminate unnecessary obstacles to becoming a Member State to the reformed Treaty.

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