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COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

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REFORM OF THE PCT:
PROPOSALS BY CUBA

Document prepared by the International Bureau

1. The proposals appearing on the following pages were made by Cuba in a submission to the International Bureau received on January 29, 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. The [Spanish text](#) of the proposals appearing in document PCT/R/1/4, as originally submitted by Cuba, is also available at that address.

PROPOSAL BY CUBA IN CONNECTION WITH THE
AMENDMENT OF THE PATENT COOPERATION TREATY (PCT)

INTRODUCTION

The Patent Cooperation Treaty (PCT), as a system for the international filing of patent applications, is an instrument that has provided applicants in the States party to it with an efficient and economical mechanism for the processing of applications in an international procedure that conveys them to the States in which legal protection is sought.

Cuba's accession to the PCT on July 16, 1996, benefited national applicants in that it constituted the best alternative for the filing of international applications, owing to the fact that the PCT simplified the international processing of the application when protection was required in many countries. On the other hand it has made it possible to strengthen our patent applications, by relying on an international search report which added value when those applications enter the national phase.

In planning this document we solicited the views of our national applicants, especially official industrial property agents, in order that their experience might be used to strengthen our position as a country.

Consequently we propose the following amendments:

(a) *Removal of the concept of designation*

In recent years the PCT has made certain changes to the designation concept; in principle the applicant could designate every one of the Contracting States, and paid fees for 11 of them; later, designation fees were paid for ten and still later for just eight States, while the latest amendment, which came into force in January 2001, proposed the payment of designation fees for six Contracting States. All of this was to the applicant's advantage.

Consequently, bearing in mind the technological progress made in relation to the filing of an international application, which substantially lessens procedural costs, it seems that the time has come to eliminate the payment of designation fees entirely.

What is more, applicants would then have the possibility of not naming the States in which they are seeking legal protection at the time of filing the international application, but rather of deciding at the end of the international procedure, according to their business interests, whether or not to enter the national phase in the individual member States.

(b) *Availability of multiple searches and examinations*

It is essential to retain the principle of the international search prior to the date of international publication, so that applicants are promptly informed of the position of their applications in relation to the state of the art. It would also be an advantage to have a single authority conducting the search and also the international preliminary examination, and thereby to lessen the discrepancies that tend to occur nowadays between reports issued by different authorities.

The aim of this proposal is to ensure that, once the applicant is informed of a single search and examination finding, he has the option of rectifying the finding of the earlier authority and requesting it to carry out a new search and examination.

(c) *On the international preliminary examination*

Having removed the designation of States for the filing of the international application, it would be advisable to replace the entry into the national phase at 20 months with a 30-month period, and to convert the international procedure into a single stage which would culminate in the international preliminary examination, thereby providing the applicant with the option of moving into the national phase before or at 30 months, depending on his interests, even where no designations were made on the filing of the international application. It should be realized that it is not sensible to have an international application going into the national phase within a six-month grace period following the 30 months; that would have the effect of undesirably prolonging the period of uncertainty regarding entry into the country in question.

The existence of a single-stage international procedure, which we feel should be considered, would make it possible to dispense with the demand for international preliminary examination, with the result that the preliminary examination of the international application could take place automatically, with a corresponding reduction in the examination fee.

With regard to the transmittal of the international preliminary examination to national Offices, use should be made of the Internet, which would make it possible to obtain the examination findings by the appointed time.

We therefore consider it essential that substantive examination of the international application at the national offices of the Contracting States be retained, in order to preserve the principle of the independence of patents enshrined in Article 4bis of the Paris Convention for the Protection of Industrial Property; this is an established principle in our national legislation, the violation of which would have the effect of calling into question the precepts of the fundamental industrial property convention from which the PCT itself is derived.

(d) *Combination of search and examination*

With the present PCT system, it sometimes happens that the results of the search (in relation to the state-of-the art) and that of the examination do not match, even though they may have been carried out by the same authority, which means that the predictive value that the former might have is considerably lessened. We feel that, for the process to be efficient and useful to the applicant, the same authority that has carried out the state-of-the-art search should conduct the examination on the basis of the search results. As we mentioned earlier, for the results of the examination to be reliable, it has to be subjected to testing by other authorities, and their opinion has to be obtained.

In order to achieve better-quality results, there would be substantial advantages in regionalizing the Searching and Preliminary Examining authorities. On the strength of this opinion, we propose the creation of a Latin American and Caribbean Patent Office, which would acquire the status of International Authority.

(e) *Adjustment, reduction and/or elimination of fees*

Bearing in mind that one of the main objectives of the PCT has been the reduction of costs in order to streamline the filing of international applications, we feel that there is a need to readjust the fees if search and preliminary examination are combined, based on the fact that the work of the Searching Authorities would be eased and that the competent authority would be chosen at the very outset, apart from which there would be the added simplicity of electronic procedures, all of which will bring about a reduction in the functions of Searching and Examining Authorities.

With regard to the reduction of fees, we propose that, independently of the adjustments, the possibility of a 75% reduction, which some International Searching Authorities offer to applicants from developing countries with a per capita income below USD 3,000 a year, be retained.

As for the elimination of fees, we propose the elimination of the designation fee, because, once the possibility of removing the concept of designation has been accepted, there would be no sense in paying a fee for designation as at present.

With regard to the adjustment, reduction and elimination of fees in general, we propose that it remain a subject to be considered at all times, on the understanding that it would greatly benefit our national applicants who use the system, and indeed all users in developing countries.

(f) *Electronic communications*

We propose that the possibility be considered of using communication by electronic mail for certain formalities or confirmations which at present are sent by ordinary mail, occasionally involving delays that are liable to lessen the chance of responding in accordance with the time limits imposed by the Treaty. A somewhat different matter is that of Internet use, as the present situation is that our countries are suffering from limitations in that area, so that the e-mail route could be used as an alternative, and indeed already has been used on occasion and has proved efficient. One example of such use would be for the transfer of fees.

(g) *Technical assistance*

By virtue of the provisions of Articles 51 and 56 of the Treaty, it would be useful to give some thought to the possibility of affording technical assistance or engaging in an exchange of experience with users of the PCT system from other countries, with the view to learning and comparing experiences and thereby achieving better and more effective exploitation of the PCT system.

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