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

WORKING GROUP ON REFORM OF THE PATENT COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

COMMENTS ON THE PAPERS FOR
THE SECOND SESSION OF THE PCT REFORM WORKING GROUP

Proposals submitted by the
Institute of Professional Representatives before the European Patent Office (EPI)

GENERAL COMMENTS

1. The Institute of Professional Representatives before the European Patent Office (EPI), conscious of the importance of the Patent Cooperation Treaty (PCT), herewith offers its comments as to the papers currently on the agenda of the PCT reform working group.

DOCUMENTS PCT/R/WG/2/1 AND PCT/R/WG/2/9

2. The current attempt to simplify and streamline the PCT system should not evolve into a "new" PCT that is even more complex that the current PCT system.

Rule 42

3. While indeed, the current time limit for establishing the search report (on average 15.5 months from the priority date) can be somewhat relaxed, the burden that would result from establishing almost all search reports after the publication of the PCT application, so that there need to be separate A3 publications of the search report in almost all cases, should not

be underestimated. As almost all PCT applications are filed at the end of the priority, the time limit of 16 months from the filing date will only apply in rare circumstances, and the time limit would generally be 22 months from the priority date. As a result, the search report would be published more than 4 months after the A2 publication of the PCT application. This is a significant deterioration with regard to the present situation in which still most of the PCT publications are A1 publications including the search report.

4. Therefore, EPI proposes to set the time limit for establishing the PCT search report at 17 months from the priority date, which (given the current possibilities for electronic communication) would allow the International Bureau to publish PCT applications as A1 publications including the search report.

Rule 43.5bis

5. The proposed text for Rule 43.5*bis*(a)(ii):

> "whether the international application complies with the requirements of the Treaty and these Regulations *in so far as checked by the International Searching Authority*;"

is vague and indefinite, as the scope of this examination is unclear. Also, paragraph (iii) does not seem to refer to anything.

6. Most importantly, in view of the proposal to let the opinion be the final IPER if the opinion is positive or if the applicant does not reply, the opinion should be based on a full examination on both the patentability requirements listed in Article 33, and the form and/or content based provisions of Articles 3 to 8 and the corresponding Rules 3 to 13. An in-depth international phase examination is also in the interest of all those national patent offices that do not have the facilities for carrying out a thorough national phase examination.

7. Therefore, EPI proposes to copy the current text of Rule 66.2 to Rule 43.5*bis*(a), *mutatis mutandis*. This would nicely fit in with the USPTO proposal (see their draft for an amended Rule 66.2) to let this opinion part of the search report constitute the first written opinion in the PCT-II procedure.

Rules 43.7bis and 53bis

8. Draft Rule 43.7*bis* says that the search report will always contain an invitation for an applicant's reply, while on the other hand, draft Rule 53*bis* is based on the presumption that a positive opinion part of the search report will constitute the international preliminary examination report (IPER), so that in such a case, a reply from the applicant would be inappropriate. It thus seems that if the opinion part of the search report is positive, the search report should not contain an invitation.

Rule 70.12

9. In view of the purpose and scope needed for the international phase examination of a PCT application as set out above with reference to Rule 43.5*bis*, it should not be optional for the IPER to contain comments as to Articles 5 and 6. Therefore, EPI proposes to redraft Rule 70.12 as follows:

"If the International Preliminary Examining Authority considers that, at the time it prepares the report:

(i) the international application contains any defect in the form or contents of the international application under the Treaty or these Regulations, especially if the international application calls for any observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description, it shall include this opinion and the reasons therefore in the report;

(ii) *[Deleted]* ~~the international application calls for any observations on the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description, it may include this opinion in the report and, if it does, it shall also indicate in the report the reasons for such opinion;~~

(iii) and (iv) [No change]

DOCUMENT PCT/R/WG/2/2

Rule 4.9

10. The end of draft paragraph (a)(ii) is not clear, as it may be interpreted as requiring that the applicant make such an indication before the receiving Office. EPI therefore proposes to delete "and to defer the express indication referred to in those Articles to the time of performing the acts referred to in Article 22(1)."

Rule 49bis.1

11. It should be clarified that such an indication is to be made before the designated Office concerned.

DOCUMENT PCT/R/WG/2/3

12. EPI believes that a restoration of the priority right only for the purposes of calculating the various PCT time limits, does not make much sense. It is also not in line with the present PCT provisions as to missed time limits: if presently a receiving Office accepts that mail was timely posted but delayed, and therefore does not declare the application to be deemed withdrawn, this has effect for all designated states. Only if the receiving Office refuses to go along with the applicant and declares the application to be deemed withdrawn, the applicant has a possibility for review in the national phase. EPI believes that the same system should apply as to the restoration of the priority right: if the receiving Offices accepts the restoration, the priority right is restored with worldwide effect, and if the receiving Office does not accept the restoration, the applicant may ask the various designated Offices to review the case in accordance with the respectively applicable provisions contained in national law. EPI therefore supports Rule 26*bis*.3(h).

Rule 26bis.3(d)(ii)

13. Evidence should only be asked for where the Office may reasonably doubt the veracity of the reasons given for the delay.

DOCUMENT PCT/R/WG/2/4

Rule 49.6

14. This Rule suggests that a designated Office may only revive a national phase application under the conditions of Article 12 PLT. It should be made clear that a Designated Office may also revive a national phase application under the conditions of Article 11 PLT. In fact, the European Patent Convention as revised in 2000 applies Article 11 PLT for this purpose.

15. As to Rule 49.6(d), evidence should only be asked for where the Office may reasonably doubt the veracity of the reasons given for the delay.

DOCUMENT PCT/R/WG/2/7

16. While EPI is generally in favor of a simplification as regards signatures as especially signatures from inventors (i.e. co-applicants for the US only) may be difficult to get, EPI feels that signatures are still needed for withdrawals or amendments. Nobody will file an application or a demand on behalf of one's competitor, but the risk should be positively avoided of withdrawing one's competitor's application (or a designation or priority claim contained therein), or to amend the claims in one's competitor's application so as to make them harmless. In view thereof, EPI prefers Annex II to Annex I.

Rule 90bis.5

17. This rule should not be amended. Generally, there is no need to make withdrawals easy. The proposed amendment may result in fatal consequences of "misunderstandings" between co-applicants.

Rule 92.1(b-bis)

18. This rule should not be adopted for the reasons set out above.

DOCUMENT PCT/R/WG/2/8

19. EPI is generally in favor of these draft amendments.

Rule 20.4(e)

20. The last word should be "sought" instead of "ought."

21. The Working Group is invited to consider the proposals contained in this document.

[End of document]