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

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

**First Session
Geneva, November 12 to 16, 2001**

REFORM OF THE PCT: DESIGNATION SYSTEM; PLT-RELATED MATTERS;
INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION

Comments by the International Federation of Inventors' Associations (IFIA)

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I. THE CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM

IFIA supports the USA proposal (PCT/R/1/2, Annex, item (1))

1. IFIA fully supports the elimination of the entire concept of designation of States so that the filling of an international application would automatically constitute the filing of an international application for all PCT States.

2. The advantages for the inventor community are:

(i) Simplification of the application procedure, particularly that designations no longer serve their intended purpose of giving a guide to where a patent will be sought.

(ii) Avoiding traps and errors which could lead to missing the protection in one or another PCT member country, not to mention the additional administrative work (and costs) in the relevant Receiving Offices and Patent Offices.

(iii) Reducing the cost of filing a PCT application in a large number of countries:

- Elimination of payment of designation fees entirely (presently 840 Swiss francs (US\$492), to be reduced to 600 Swiss francs, starting January 1, 2002.)
- Hopefully reduction of patent attorney fees following less workload.

(iv) Taking a step forward towards a world patent – a long term objective of all inventors (see IFIA special webpage: <<http://www.invention-ifia.ch/WorldPatent.htm>>

IFIA supports the WIPO Secretariat compromise solution (PCT/R/WG/1/1)

3. IFIA understands the arguments put forward by the WIPO Secretariat, namely that the elimination altogether of the concept of “designation” would require a thorough review of the overall structure of the PCT system as a whole, something which can only be achieved through the revision of the Treaty itself. IFIA therefore agrees with the idea of reviewing and changing the operation of the current designation system so that such reform can be approved at a very early stage, by the PCT Assembly at its next session, in September 2002.

4. In brief, IFIA supports all the proposals for reform as outlined in the detailed Annex of the WIPO Secretariat document, the main general features of which are presented in paragraph 11 of the document itself. This support includes the elimination of the present “designation fee” and the replacement of the so-called “basic fee” by a flat “international filing fee,” irrespective of the number of designations made.

Remarks concerning the amount of the new “Filing fee”

5. Concerning the amount of the new fee, the Working Group and/or the Committee on the Reform of the PCT should, in our view, make some recommendation to the PCT Assembly. In this respect, IFIA wishes to point out the following:

First, the elimination of the designation fee implies a 0 (zero) fee.

Second, the new filing fee, which in fact replaces the present “Basic fee” (650 Swiss francs), should be reassessed so that it is commensurate with the services rendered and the simplification of the system. This amount of 650 Swiss francs could, most probably, be reduced. The “entry” fee to the PCT system should be as low as possible.

6. IFIA would also hope that the PCT Assembly decides to offer a similar 50% reduction to the “natural persons” who are applicants from all PCT countries which are not listed among those countries already receiving a 75% reduction.

II. CONFORMITY WITH FILING DATE REQUIREMENTS, AND OF “MISSING PART” - TYPE REQUIREMENTS WITH THOSE OF THE PLT

Conformity of filing date requirements with those of the PLT

7. Conformity to the PLT (mainly Article 5(1) and (2) PLT) would entail the following changes in Article 11(1) PCT:

(i) Elimination of the requirement according to which the applicant must be a resident or national of a PCT Contracting State in order to obtain a filing date;

(ii) Elimination of the language requirement for the description;

(iii) (a) Easing of the indication that the elements are intended to be an international application (“implicit” indication is sufficient);

(b) Elimination of the designation requirement;

(c) Easing of the requirement to name the applicant (“indications allowing the applicant to be contacted by the Office” are sufficient);

(e) Elimination of the claim requirement (description is sufficient).

8. The following proposed changes are clearly in favour of the inventor and are supported by IFIA:

9. Amendment (i) would allow inventors from Non-Contracting States to use the PCT system. A world-wide usage of the PCT system would be a further step in the direction of a world patent – a long-term objective of all inventors.

10. Amendments (ii) and (iii),(a), (b), (c), make the system simpler to use for the inventors and eliminate some traps that bear the danger of losing the original filing date.

Conformity of “missing-part”-type requirements with those of the PLT

11. Conformity with Article 5(4) through (7) PLT would entail some changes in Article 11(2) and Article 14 PCT.

12. These proposed changes are clearly in favour of the inventor and are supported by IFIA. They would improve and simplify the filing procedure for the inventors. Certain defects in the international application could be corrected in an easier way. The proposed changes can

also be regarded as a step forward towards a world patent since the PLT is intended to harmonize the patent legislation in the whole world.

III. IMPROVED COORDINATION OF INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION AND THE TIME LIMIT FOR ENTERING THE NATIONAL PHASE

Elimination of 20-months deadline for entry into the national phase

13. IFIA supported and is completely satisfied with the modifications of this time limit fixed in Article 22 (1) of the PCT which were recently adopted at the 13th ordinary session of the PCT Assembly. The 20-month deadline is herewith already eliminated.

Elimination of the concept of demands

14. By the elimination of the 20-month deadline, a deadline for demanding a preliminary examination as a pit fall is eliminated. IFIA however prefers the concept of giving the applicant the opportunity to demand a preliminary examination in case he feels a necessity for it.

15. This means that the search fee should not include an additional amount for an examination which the applicant will probably not demand during the international phase. Keeping the concept of demand gives highest flexibility without automatically adding additional costs.

Combination of search and examination.

16. Today the International Preliminary Examination has no binding effect on the authorities of the PCT member States. A combined search and examination can only be accepted by IFIA in case such a combined search plus Opinion Report (new proposal) would be an additional service without a delay for receiving the novelty search and without giving reason for additional costs for such an Opinion Report which does not give any additional legal safety.

17. Therefore IFIA prefers a divided procedure of search and examination as proposed in document PCT/R/WG/1/2 prepared by the WIPO Secretariat. Concerning the time limit for the demand, IFIA proposes a non-compulsory preliminary examination, where the time limit would start from the date the search has been established.

18. IFIA's opinion as stated above is based on the consideration of both documents PCT/R/WG/1/2 and 3.

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