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COMMENTS CONCERNING POSSIBLE IMPROVEMENTS IN THE PCT SYSTEM AND
IN THE PROCESSING OF INTERNATIONAL APPLICATIONS

Received from the Japanese Patent Office

The Annex to this document contains comments received from the Director General of the Japanese Patent Office in which suggestions are made as to possible changes in the PCT Regulations and possible improvements in the processing of international applications.

[Annex follows]

* Editor's Note: This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

PATENT OFFICE
JAPANESE GOVERNMENT

43, Kasumigaeski 3chome
Chiyoda-ku, Tokyo, Japan

May 19, 1980

Mr. Arpad Bogisch
Director General
World Intellectual Property Organization
34 chemin des Colombettes
1211 Geneva 20
Switzerland

Dear Mr. Arpad Bogisch:

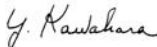
I should like to draw your attention to the proposals made by the Japanese delegate at the time of the first Session of the PCT Management and Budget Consultant Group held from March 17 to 28, 1980 in Geneva.

We are in the third year of the enforcement of the PCT now. It seems, however, that the procedures of receiving offices and the International Bureau cannot be said to be quite consistent.

From the viewpoint of fulfilling the aims of the PCT, each receiving office should carry out its tasks under the PCT by following consistent and coherent procedures and formalities, in order to achieve the satisfactory implementation of the treaty.

With such background thought, we made the proposals at the above meeting. I am enclosing the details of the same proposals with the sole wish that satisfactory administration of the PCT would be carried out and that the use of the PCT system would be further expanded in the future.

Yours sincerely,



Yoshio Kawahara
Director General

[ENCLOSED]

ADDITIONAL PROPOSALS

1. Rule 4.10 (c)

" the Receiving Office or " should be inserted between
" the International Bureau " and " prior to expiration "

2. Administrative Instruction 408

" the International Bureau " should be replaced by " the
Receiving Office or the International Bureau "

3. New Rule 91.4

(a) Subject to Article 11(2) (a) and Article 14(1) (b), where the Request, the Description, the Claims and the Drawings do not comply with the physical requirements under the provisions of the Treaty and this Rule, Receiving Office or the International Searching Authority may invite the applicant to rectify the Request, the Description, the Claims and the Drawings

(b) Rectification referred to in Paragraph (a) may be permitted until the communication under Article 20 is effected.

(c) Receiving Office or the International Receiving Authority shall promptly inform any Authority concerned of such rectification

4. New Rule 91.3

The Administrative Instructions prescribe the manner in which rectifications of obvious errors of transcription shall be made ex officio and the manner in which they shall be entered in the file of the international application.

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ANNEX

PROPOSALS

I. Re: The procedure at a receiving office

I believe that proper handling and checking of international applications by a receiving office in accordance with the provisions of the PCT and of its rules will not only alleviate the administrative burden of WIPO for international publication, but it will also prevent the occurrence of troubles in the national procedures when international applications come to the level of designated countries, thereby the protection of the right of applications being preserved. It appears that not all the receiving offices conform to the provisions of the treaty and its rules in their handling of international applications filed with their offices. I, therefore, believe that the following points may be considered for amelioration.

1. If there are errors in the entries of the name, the address, the domicile or the nationality of the applicant in a request, the receiving office, unless such errors are obvious ones, should, as a rule, invite the applicant to correct the request in accordance with the provision of Article 14 of the Treaty; and if in the entries of a request, there is an error which is considered to be obvious, the receiving office should invite the applicant to submit the correct request. In any case, any receiving office should not correct such errors ex officio.
2. Any receiving office should not add any reference for a designated state or for a regional patent.
3. When a receiving Office eliminates the indication of a designated state in accordance with the Administrative Instruction 201, such a receiving Office should delete it and enter the word "DELETED" in the right hand margin adjacent to the matter so placed in accordance with the Administrative Instruction 303.
4. As for the declaration of claiming priority provided under Article 8 of the Treaty, a receiving Office should neither insert nor correct the filing date of the earlier application or the name of the country in which it was filed ex officio. If there is not indicated the name of the country in which the earlier application was filed, the declaration should be considered to have not done in accordance with the provision of Rule 4.10(b).
5. As for the declaration claiming priority provided under Article 8 of the Treaty, the applicant is supposed to notify the International Bureau of the filing number of the earlier application by the end of the period of 16 months counting from the priority date. It seems appropriate that the Administrative Instructions be revised so that a receiving office or the International Bureau may insert or correct the filing number of the earlier application ex-officio in course of communication with the applicant.
6. In case where a request does not contain the prescribed indication(s) for inventor(s) or representative(s), any receiving office should not insert the indication(s) ex-officio.
7. If there are strong requests from receiving Offices and other competent authorities to make correction ex-officio, it is necessary to clearly define in the regulation or the like the extent that the correction can be made ex-officio (for instance for the "obvious errors" provided for in Rule 91) and the procedure that the result of the correction made ex-officio is communicated to the applicant.

II. REQUEST TO THE INTERNATIONAL BUREAU

1. The administrative processing system for international applications at the International Bureau and the standard for formality checks for the documents received by the International Bureau should be made public to a possible extent.

Further, the procedure of sending the copies of the documents cited in International Search Reports on the basis of Article 20(3) of the Treaty (the procedures under Rule 44.3) should be examined and the results of the examination made public (for instance, by publication in PCT gazettes and so on).

2. The communication under Article 20 of the PCT from the International Bureau to a designated office is defined under the new Rule 47.1(b) to be effected “after the international publication of the international application by the end of the 19th month after the priority date”. However, a case was found where the communicated documents did not contain a copy of the pamphlet because the international publication had not been effected by the end of the 19th month after the priority date. This insufficient communication causes a lack of uniformity in the documents required for the transfer to the national procedure in a designated State. Therefore, I request that the International Bureau will effect the international publication within the prescribed time period and conduct the communication using a copy of the pamphlet; otherwise such problems cannot be resolved.