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PROPOSALS FOR POSSIBLE AMENDMENTS TO THE REGULATIONS UNDER THE
PATENT COOPERATION TREATY (PCT) AND TO THE REGULATIONS UNDER THE
BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT
OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

Note submitted by the Ministry of Justice of Sweden

The Annex of this document contains a note submitted by the Ministry of Justice of Sweden on the proposal for a new Rule 13bis of the Regulations under the Patent Cooperation Treaty which is contained in document PCT/A/V/2.

[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

ANNEX

Note from the Swedish Ministry of Justice

Re: Amendments to the Regulations under the Patent Cooperation Treaty (PCT)

At a joint meeting on June 13, 1980 the Assembly of the PCT Union and the Interim Advisory Committee for the preparation of the entry into force of the Budapest Treaty are expected to consider proposals for certain amendments to the Regulations under the PCT and the Budapest Treaty. The proposals concern a new Rule 13bis in the PCT Regulations and a new paragraph 5 to be added to Rule 11 of the Budapest Regulations.

This note deals with a problem connected with paragraph 6 b of the proposed Rule 13bis.

That paragraph contains provisions limiting the rights of the Contracting states to authorize under national law the release of samples from deposits referred to in international applications. The first sentence of paragraph 6 b reflects the solution proposed by the International Bureau.

According to the provision in the first sentence no furnishing of samples shall take place without the authorization of the applicant until the national processing of the international application may start. This means that, unless the applicant asks for an earlier start of the national processing or authorizes a release of a sample, a Contracting State may not give access to the deposits earlier than 20 months from the priority date, where the State is a designated State, or 25 months from the said date, if the State is an elected State.

This solution was thoroughly debated in the Joint Working Group which prepared the texts. It was pointed out that the sequences of this solution were inconsistent with basic principles of the legislation in several Contracting states. Under the Swedish Patent Law, as well as under the patent laws of many other States, it is compulsory to make a patent application available to the public at the latest 18 months from the filing date or, where priority is claimed, from the priority date. As far as Sweden is concerned this system is linked with provisions about provisional protection from the date on which the application was made available to the public. If a patent is granted, protection will be given from the day when the application was made available. The same kind of provisional protection is provided for under the legislation of many other Contracting states.

According to Article 29 of the PCT a Contracting State, which provides for provisional protection from the date of the compulsory publication of unexamined national applications, must provide the same protection for international applications from the date of the international publication. In one case, however, the Contracting States may prescribe that the protection shall be subject to certain conditions concerning the translation of the international application. The Contracting states are not allowed to make the provisional protection subject to the condition that national processing has started.

Where a deposit of a microorganism is required under national law the deposit is an essential part of the patent application. In such cases it would be very difficult or impossible for a third

party to assess the content and the scope of the application without having access to the deposit. A patent application which involves a deposit of a microorganism cannot be considered as having been made available to the public if only the documents are available and no access to the deposit is provided.

In case only the first sentence of paragraph 6 b were to be retained, it would mean that several Contracting States would be required to grant provisional protection for international applications from a date before the date when the whole application is available to the public. Granting protection from a date before that when the public have access to all relevant information about the invention comprised in the patent application would be contrary to fundamental principles of patent law.

Mainly for the reasons now given the Swedish delegation proposed to the Working Group an additional provision waiving the necessary exemption from the provision advocated by the International Bureau. This proposal was supported by a majority of the Contracting states represented in the Working Group and by the European Patent Office. This additional provision, as drafted by the majority, constitutes the third sentence of paragraph 6 b. According to this provision any Contracting state may authorize under national law release of samples as soon as, under that law, the international publication has the effects of a compulsory national publication of an unexamined national application, i.e. as soon as provisional protection is provided for.

The International Bureau argues in its comments on the new Rule 13bis that, in view of the requirements to delay processing contained in Articles 23 and 40 of the PCT, only the rule in the first sentence should be adopted. It does not follow from the principle of delaying national processing that also the access to the deposit should be delayed. The publication of the international application is not delayed until national processing may start. The access to the deposits should be looked upon as an element of the procedure for making the application available to the public.

For the reasons given in this note it is essential that also the third sentence of paragraph 6 of the proposed Rule 13bis be adopted.

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