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GENEVA

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

ASSEMBLY

**Eighteenth Session (11th Extraordinary)*
Geneva, July 8 to 12, 1991**

PROPOSED AMENDMENT TO PCT RULE 66.2(d)

Proposal by Sweden

This document contains a proposal received from the Swedish Patent Office.

* *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



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Dr Arpad Bogisch
Director General
World Intellectual
Property Organization
34, Chemin des Colombettes
CH-1211 Geneva 20

15 May 1991

Dear Mr Bogisch,

Re: Swedish proposal to amend Rule 66.2(d) PCT

The attention of the Swedish and European Patent Offices, in their capacity as International Preliminary Examining Authorities, has been drawn to a practical problem in applying Rule 66.2(d) PCT.

In certain fields of technology, primarily in chemistry, comparative tests are necessary to substantiate an invention's inventive step vis-à-vis the state of the art. In the majority of such cases the time limit of two months, even when extended to a total of three months, proves insufficient.

The current Rule 66.2(d) does not allow for any extension beyond that maximum of three months. This is unsatisfactory because if the applicant adduces inadequate arguments the case cannot be properly evaluated by the IPEA.

The Swedish Patent Office, supported by the EPO, therefore considers that in special cases an extension of the time limit for reply to the first written opinion should be obtainable provided it is requested before the time limit expires. It goes without saying that an extension, whatever its duration, should in no way prejudice the time limit under Rule 69 for establishing the international preliminary examination report.

A draft amended text of Rule 66.2(d) is enclosed herewith.

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The proposed text leaves out the second and fifth sentences of the current Rule 66.2(d) because it is felt that their content makes them more appropriate to guidelines than to a Rule. They could therefore be transferred to the PCT Preliminary Examination Guidelines.

I should be grateful if you would submit the proposed amendment to Rule 66.2(d) to the next meeting of the PCT Assembly in Geneva on 8-12 July 1991, together with the foregoing grounds.

Yours sincerely,



Jan-Eric Bodin
Deputy Head
Patents

Proposed amendment to
Rule 66.2(d) PCT

d) The notification shall fix a time limit for the reply.* The time limit shall not be less than one month after the date of notification or more than three months after that date.** In certain special cases it may be extended if the applicant so requests before the expiration of the time limit fixed in the notification.

* The amendment consists in deleting the current second sentence: “The time limit shall be reasonable under the circumstances”.

** The amendment consists in deleting the current fifth sentence: “It shall be at least two months after the said date where the international search report is transmitted at the same time as the notification”.