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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

Fifteenth Session
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CLAIMS FEES

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1. Claims fees are a feature of the national law of many of the PCT Contracting States, including several of the International Authorities. The EPO has recently overhauled its claims fee regime to introduce sharply-increased payments for claims above a given number, according to an ascending scale. This has been necessary because, despite the fact that some provision for claims fees in the European procedure and, of course, provision for payment of a page fee in PCT have existed for some years now, this has not prevented the average number of claims per application from rising. For example, the average number of claims per European patent application (including Euro-PCT) has risen from an average of 10 per application in 1980 to 29 in 2005. Furthermore, the problem is not confined to the average number of claims, rather the number of applications containing claims in excess of 50 has also sharply risen over the same period.

2. Despite this, no provisions corresponding to the national rules on claims fees have been introduced into PCT, though some discussion on the matter has taken place amongst the International Authorities and in particular amongst the Trilateral Offices. While there is agreement in Trilateral that the increasing number of claims in PCT applications poses a challenge for the International Authorities in handling their workload, it is also acknowledged that introduction of a claims fee *per se* will not necessarily stop applicants from filing a large number of claims, that attempts to influence applicant behaviour by fiscal measures could, if not properly implemented, have undesirable side-effects, for example attempts to avoid the claims fee by including multiple alternatives within a smaller number of claims or by storing subject-matter in the description, and that such patterns would not result in an alleviation of the search burden on the International Authorities.

3. Nevertheless, the EPO remains convinced that fiscal measures do have an important role to play in steering applicant behaviour and that the claims fees which form part of the national legal systems of many PCT Contracting States should also be available during the international phase to the International Authorities. In particular the EPO would like to see a discretionary provision in PCT enabling but not obliging any International Authority which felt it appropriate to charge an excess claims fee.

4. In the EPO's view such a fee should be separate from the international search fee in order to make it clear that payment of the excess claims fee by itself does not give rise to any entitlement to have all claims searched if the number of claims still gives rise to an excessive search burden. The EPO also believes that the appropriate sanction for failure to pay the excess claims fee should be that the claims concerned are deemed abandoned or that the ISA has power not to search such claims. In addition to fiscal measures it should also be considered whether complementary provisions clarifying the circumstances under which an ISA is entitled to restrict the scope of the ISR should be introduced in PCT. For example under the EPC there is provision to restrict examination to one independent claim per category. In the EPO's view a provision explicitly addressing the scope of search might prove a useful tool for ISAs.

5. The potential problems associated with introduction of a claims fee in PCT alluded to above are well known to the International Authorities and need not be repeated here, save to say that a key feature of the EPO's thinking on this matter is that each ISA would have complete freedom to decide for itself whether it felt imposition of a claims fee during the international phase was worthwhile; if not, there would be absolutely no obligation to impose the fee. However, the EPO feels strongly that if the status quo is maintained there is a real risk that applicant behaviour may develop in such a way that many claims are included in the international application during the international phase when no claims fee is payable but the number of claims is then reduced after national phase entry in order to avoid the national claims fee. Such behaviour would undermine the effectiveness of national claims fees and in the EPO's view would represent a highly undesirable scenario for the ISAs.

6. If the International Authorities can agree in principle that the fact of increasing numbers of claims in PCT applications represents a problem for ISAs generally and that fiscal/complementary measures such as those outlined above should be considered as part of a concerted effort by the International Authorities to ensure the PCT workload remains manageable, the EPO would certainly be willing to elaborate a proposal along these lines for consideration at the next meeting of the PCT Working Group in May 2008. Since preliminary discussions within Trilateral have already shown that different approaches concerning the legal basis for introducing a claims fee, the sanction to be applied in case of non-payment and practical issues such as collection of the fee, impact on national-stage processing by the designated Offices, are possible, this document avoids making any specific legislative proposal at this stage. However, the document is intended to prompt discussion and elicit the views of the entire range of ISAs so that wherever possible a common line can be adopted by the International Authorities during any further discussions in the WIPO bodies.

7. The Meeting is invited to discuss the desirability of permitting claims fees under the PCT.

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