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

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PERIOD FOR PERFORMING THE INTERNATIONAL SEARCH

Proposals submitted by the United States of America

BACKGROUND

1. In earlier proposals for integration of the search and examination stages of PCT processing, the United States has urged that the period for establishment of the International Search Report (ISR) and the Written Opinion of the International Searching Authority (WO/ISA) should be relaxed (see PCT/R/WG/1/3 and PCT/R/WG/2/9). Relaxation of the time limits is warranted due to the extension of the Article 22 time period for national stage entry from 20 to 30 months and the desire to more effectively utilize the entire time period now provided for Chapter I processing. The time limit for establishment of the ISR and the WO/ISA should be relaxed if the revised PCT system is to function as envisioned. Three areas of concern that have arisen are: (1) issues with regard to priority claim processing, (2) issues regarding unity of invention, and (3) issues concerning the processing of sequence listings.

PRIORITY CLAIM ISSUES

2. There is currently a conflict between the time limit for establishment of the search and the time limits pertaining to the priority claim. This conflict first came to light as the result of comments by the delegation of Japan in the second meeting of the Committee in July of last year. The comments of the Japanese delegation dealt with the conflict between the time limit under Rule 17.1 for providing a copy of the priority document and the time limit under

Rule 42.1 for establishment of the WO/ISA, and the fact that applicant may have difficulty providing a copy of the priority document in time for the ISA to take it into account in establishing the WO/ISA. Rather than shorten the period during which applicant could submit a copy of the priority document, a move that was viewed as being detrimental to applicants' rights, the Committee chose to resolve this conflict by making Rule 66.7 apply *mutatis mutandis* to the establishment of the WO/ISA (see document PCT/R/2/9, paragraphs 113-115).

3. However, it has come to light that there may be an even greater conflict between the Rule 42.1 time limit and the time limit under Rule 26 *bis* for correction or addition of a priority claim. Specifically, under Rule 42.1 the ISR and WO/ISA must be established by the later of three months from receipt of the search copy by the ISA or nine months from the priority date, or between nine and 16 months from the priority date (the 16 month date being based on an assumed average search copy processing time on the part of the receiving Office of 1 month). However, under Rule 26 *bis*, applicants have until 16 months from the priority date to submit any corrections or additions to the receiving Office. Assuming an average processing time of one month by the RO of any request under Rule 26 *bis*, the ISA is required to begin the international search and establish the WO/ISA during a period that can range from 1 to 8 months prior to the ISA becoming aware that a priority claim exists. In that, under Rules 43 *bis*.1(b) and 64.1, the ISA must take into account any priority claim in establishing the WO/ISA, a relaxation of the Rule 42.1 time limit would appear to be necessary in order to protect applicants' right to have all priority claims permissible under the Treaty taken into account when the WO/ISA is established.

UNITY OF INVENTION ISSUES

4. During the last meeting of the Working Group, discussions were held on several proposals concerning unity of invention, and specifically to either simplify or eliminate altogether the protest mechanism. Comments were made by the delegation of the EPO, and supported by other delegations, that the protest procedure was quite time consuming and when invoked by an applicant often led to problems in meeting the time limit under Rule 42.1. The United States would urge that a relaxation of the Rule 42.1 time limit would, in most instances, eliminate this problem by allowing ample time for protests to be properly resolved. Such a relaxation would be advantageous to applicants in that it would allow for sufficient time, prior to the deadline for establishment of the ISR and WO/ISA, for any protest to be properly and thoroughly considered.

SEQUENCE LISTING ISSUES

5. Similarly, during the last meeting of the Working Group discussions were also held on the topic of sequence listings. During these discussions the delegation of the EPO pointed out that as many as 50% of international applications containing disclosure of nucleotide and/or amino acid sequences were not accompanied by an acceptable computer readable form sequence listing. It was further pointed out that in many cases multiple invitation to provide such a sequence listing are required before an acceptable listing is submitted. Therefore, in a large number of applications requiring a sequence listing it is difficult, if not impossible, for the searching authority to carry out a meaningful international search within the Rule 42.1 time limit as a result of these delays in obtaining an acceptable listing. The United States, as with unity of invention protests discussed above, believes that a relaxation of the Rule 42.1 time limit would, in most instances, eliminate this problem by allowing ample time for proper sequence listings to be filed. The relaxation of this time limit would be beneficial to

applicants in that it would provide the necessary time for the filing of an acceptable computer readable form sequence listing thus allowing the ISA to establish a search which is as complete and accurate as possible.

PROPOSAL

6. There are various processing conflicts that arise as the result of the current limited time period for establishment of the international search under Rule 42.1. Given that the Article 22 time period for entering the national stage has been extended to 30 months from the priority date, it would be reasonable to also extend the Rule 42.1 time limit for establishment of the ISR and WO/ISA. This would allow the Authorities to take full advantage of the complete time period available for international stage processing in order to properly address these conflicts.

7. Therefore, it is the proposal of the United States that Rule 42.1 be amended as follows:

(i) to extend the time limit by which the ISA is supposed to have established the ISR and WO/ISA to 22 months from the priority date thus providing sufficient time for the resolution of all issues that must be addressed prior to the international search; and

(ii) to include a minimum period in which the ISR and WO/ISA may be established of 17 months from the priority date so as to ensure that applicants have the full time period afforded them under Rule 26 *bis* to make changes or additions to the priority claim and have those changes or additions taken into account by the searching authority as required by Rules 43*bis*.1(b) and 64.1.

8. The upper limit period of 22 months has been chosen as a date that would allow sufficient time for resolution of these search related issues as well as for any response by applicants and issuance of the International Preliminary Examination Report by 28 months. The lower limit of 17 months is based on the 16 months allowed by the Rule 26 *bis* plus an additional one month to allow for RO processing and transmission to the ISA of any such requests. Finally, the current provision that the ISR and WO/ISA be due 3 months from the date of receipt of the search copy has been retained to protect the ISA from being accountable for any delays on the part of the RO which would prevent the timely establishment of the search.

9. A review of both the existing Rules and those which are scheduled to take effect 01 January 2004 indicates that the only Rules that would need to be amended in this regard are Rules 42.1, 46.1 and 69.2.

10. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS
PERIOD FOR PERFORMING THE INTERNATIONAL SEARCH

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Rule 42

Time Limit for International Search

42.1 *Time Limit for International Search*

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be :

(i) not more than the later of three months from the receipt of the search copy by the International Searching Authority, or 22 ~~nine~~ months from the priority date ~~whichever time limit expires later~~; and

(ii) not less than 17 months from m the priority date.

Rule 46

Amendment of Claims Before the International Bureau

46.1 *Time Limit*

The time limit referred to in Article 19 shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority ~~or 16 months from the priority date, whichever time limit expires later~~, provided that any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

46.2 to 46.5 [No change]

Rule 69

Start of and Time Limit for International Preliminary Examination

69.1 [No change]

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

(i) 28 months from the priority date; or

(ii) three ~~six~~ months from the time provided under Rule 69.1 for the start of the international preliminary examination; or

(iii) three ~~six~~ months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2.

[End of Annex and of document]