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

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

**Fourth Session
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SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION:

REPLIES RECEIVED IN RESPONSE TO QUESTIONNAIRE

Document prepared by the International Bureau

BACKGROUND

1. At its third session, held in Geneva from November 18 to 22, 2002, the Working Group considered proposals for amendment of the Regulations under the PCT relating to changes necessary or desirable to simplify the procedures before the International Searching Authorities and International Preliminary Examining Authorities in cases where there is a finding of lack of unity of invention. The Working Group's discussions are outlined in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97:

“Unity of Invention

“95. Discussions were based on document PCT/R/WG/3/1, Annex I, items 4 (simplify the non-unity procedure before the ISA) and 10 (simplify the non-unity procedure before the IPEA), and Annex II, items 10 and 18 (eliminate unity of invention procedure).

“96. Certain delegations proposed the abolition of the protest system before International Searching Authorities under Rule 40 and International Preliminary Examining Authorities under Rule 68, with a view to reducing the workload of the

Authorities. The majority of delegations and representatives of users, while recognizing that the procedures under Rules 40 and 68 were cumbersome, opposed the proposal to eliminate the protest procedure altogether on the grounds that it would remove the applicant's right to challenge a finding of non-unity of invention by an Authority, thus increasing the burden on applicants and designated Offices in the national phase and resulting in incomplete searches and examinations of a greater number of international applications. It was suggested that the problem of non-unity in excessively complex or "mega-" applications would be better dealt with by other measures such as by introducing an additional fee based on the number of claims present in the application.

"97. The Working Group agreed that the International Bureau should prepare a proposal for simplifying the protest procedure under Rules 40 and 68. It was also agreed that, in order to discover more information about the experience of Authorities regarding this issue, the International Bureau should send out a questionnaire asking them to indicate how many invitations they issued per year under Rules 40 and 68, how many additional fees were paid under protest, and how many of the invitations were in respect of applications containing claims to more than, say, 10 inventions."

2. Proposals for amendment of the Regulations relating the protest procedure in case of lack of unity of invention are contained in document PCT/R/WG/4/4, Annex II.

3. By way of Circular C. PCT 896, dated December 19, 2002, the International Bureau sent a questionnaire concerning the protest procedure in cases of lack of unity of invention to all International Searching and Preliminary Examining Authorities. The Annex to this document contains the responses received by the date of this document.

4. The Working Group is invited to take note of the content of the Annex.

[Annex follows]

ANNEX

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION:
REPLIES RECEIVED IN RESPONSE TO QUESTIONNAIRE

LACK OF UNITY OF INVENTION BEFORE THE INTERNATIONAL SEARCHING
AUTHORITY (ISA)

Question 1: How many invitations to pay additional fees provided for in Article 17(3)(a) did your Office issue in its capacity as an ISA in each of the years 2000 and 2001? Please also indicate the number of international searches carried out by your Office in its capacity as an ISA in each of the years 2000 and 2001.

Response by Australia: “2000: 1779 searches conducted (total) with 152 invitations issued (for 267 searches). 2001: 1996 searches conducted (total) with 178 invitations issued (for 244 searches).”

Response by Austria: “In the year 2000, the Austrian Patent Office as ISA issued 4 invitations and in the year 2001, the Office issued 1 invitation to pay additional fees. In the year 2000, 706 international searches and in the year 2001, 352 international searches were carried out.”

Response by Canada: “As CIPO was only recently approved by the PCT Assembly to assume the responsibilities of an ISA and IPEA, and will not actually commence operation until July 2004, CIPO is not in a position at this time to respond to the questions asked in the questionnaire.”

Response by China: “Our office in the capacity as an ISA had received 746 International Applications in 2000 and issued 8 invitations to pay additional fees for them. Our Office in the capacity as an ISA had received 1656 International Applications in 2001 and issued 5 invitations to pay additional fees for them.”

Response by the European Patent Office: “2000: 51465 international searches, 2722 invitations; 2001: 53353 international searches, 3134 invitations.”

Response by Japan: “2000: 8468 international searches, 247 invitations; 2001: 10716 international searches, 495 invitations; 2002: 12646 international searches, 762 invitations.”

Response by Spain: “2000: 557 international searches, 4 non-unity cases, 1 invitation; 2001: 611 international searches, 6 non-unity cases, 1 invitation.”

Response by Sweden: “2000: 114; 2001: 97”

Question 2: How many of the invitations referred to in question 1 were issued in respect of international applications found to contain 10 or more inventions?

Response by Australia: “2000: 2; 2001: 4”

Response by Austria: “None”

Response by China: “1”

Response by the European Patent Office: “No records”

Response by Japan: “Not available”

Response by Spain: “2000: none; 2001: none”

Response by Sweden: “Not recorded”

Question 3: In response to invitations referred to in question 1: (i) how many additional fees were paid to your Office on average per international application in respect of which such invitation was issued; and (ii) how many additional fees were so paid on average per international application containing 10 or more inventions (see question 2)?

Response by Australia: “(i) 2000: 36%; 2001: 38%. (ii) 2000: 50% (1/2); 2001: 50% (2/4) (although one of these only paid partial fees).”

Response by Austria: “(i) 4; (ii) none”

Response by China: “(i) $3 \times 800 = 2400$ (CNY)”

Response by the European Patent Office: “(i) No precise records, but anecdotal evidence suggests additional fees are usually not paid; (ii) No records”

Response by Japan: “(i) Not available; (ii) Not available”

Response by Spain: (i) 2000: 1 invitation; 0 additional fees paid; 2001: 1 invitation; 0 additional fees paid; (ii) 2000: 0 containing 10 or more inventions, 0 additional fees paid; 2001: 0 containing 10 or more inventions, 0 additional fees paid”

Response by Sweden: “(i) 2000: 63.2 %; 2001: 56.7%; (ii) 2000: 0%; 2001: 0 %”

Question 4: In response to invitations referred to in question 1, in how many cases did the applicant pay additional fees to your Office under protest?

Response by Australia: “2000: 4; 2001: 6”

Response by Austria: “None”

Response by China: “1”

Response by the European Patent Office: “2000: 144; 2001: 167”

Response by Japan: “Not available”

Response by Spain: “2000: 1 invitation to pay additional fees, 0 paid under protest.
2001: 1 invitation to pay additional fees, 0 paid under protest

Response by Sweden: “(i) 2000: 18; (ii) 2001: 14”

Question 5: In how many of the cases referred to in question 4 did your Office order the (i) total reimbursement or (ii) partial reimbursement to the applicant of the additional fees because it was found that the protest was justified (see Rule 40.2(c))?

Response by Australia: “(i) 2000: 0/4; 2001: 3/6; (ii) 2000: 1/4; 2001: 0/6”

Response by Austria: “None”

Response by China: “None”

Response by the European Patent Office: “(i) 2000: 31; 2001: 47; (ii) 2000: 17; 2001: 16”

Response by Japan: “(i) Not available; (ii) Not available”

Response by Spain: “There are no cases”

Question 6: (to be answered only by ISAs which require the applicant to pay a fee for the examination of the protest (“protest fee”); see Rule 40.2(e)): In how many of the cases referred to in question 4 did your Office refund the protest fee because it was found that the protest was entirely justified (see Rule 40.2(e))?

Response by Australia: “Not applicable; the Australian Patent Office does not require a protest fee.”

Response by Austria: “None”

Response by China: “None”

Response by the European Patent Office: “2000 (after prior review of the justification of the invitation to pay additional fees (Rule 40.2 (e)) - not the protest itself): 6

Response by Japan: “Not available”

Response by Spain: “No protest fee”

Response by Sweden: “Not applicable”

LACK OF UNITY OF INVENTION BEFORE THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEA)

Question 7: How many invitations to restrict the claims or to pay additional fees provided for in Article 34(3)(a) did your Office issue in its capacity as an IPEA in each of the years 2000 and 2001? Please also indicate the number of international preliminary examinations carried out by your Office in its capacity as an IPEA in each of the years 2000 and 2001.

Response by Australia: “2000: 1393 IPEs conducted (total) with 2 invitations issued. 2001: 1853 IPEs conducted (total) with 6 invitations issued.”

Response by Austria: “In the years 2000 and 2001 the Austrian Patent Office as IPEA issued 2 invitations 1 for each year. In the year 2000, 199 international preliminary examinations were carried out.”

Response by the European Patent Office: “2000: 1591 invitations to restrict claims; 33609 international preliminary examinations carried out. 2001: 1447 invitations to restrict claims; 39388 international preliminary examinations carried out.”

Response by Japan: “2000: 106 invitations to pay additional fees; 4162 IPERs. 2001: 236 invitations to pay additional fees; 5163 IPERs. 2002: 292 invitations to pay additional fees; 6577 IPERs.

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not recorded”

Question 8: In how many cases, if any, in each of the years 2000 and 2001 did your Office find that the requirement of unity of invention was not complied with but choose not to invite the applicant to restrict the claims or to pay additional fees provided for in Article 34(3)(a)?

Response by Australia: “Data unavailable, but is believed to be significant”

Response by Austria: “Three (3)”

Response by the European Patent Office: “In 2000: approx. 2 100 (estimated). In 2001: approx. 2 900 (estimated).”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not recorded”

Question 9: How many of the invitations referred to in question 7 were issued in respect of international applications found to contain 10 or more inventions?

Response by Australia: “None (for both years)”

Response by Austria: “None”

Response by the European Patent Office: “No records; likely to be small given EPO’s attitude towards Article 17(2) (a)(ii) and Rule 66.1 (e) PCT”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not recorded”

Question 10: In response to invitations referred to in question 7, in how many cases did the applicant choose to restrict the claims rather than to pay additional fees?

Response by Australia: “2000: 0; 2001: 1”

Response by Austria: “None”

Response by the European Patent Office: “No records”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not recorded”

Question 11: In response to invitations referred to in question 7: (i) how many additional fees were paid to your Office on average per international application in respect of which such invitation was issued; and (ii) how many additional fees were so paid on average per international application found to contain 10 or more inventions (see question 9)?

Response by Australia: (i) 2000: 100% (2/2); 2001: 83% (5/6); (ii) none (no invitations issued on such applications in either year)”

Response by the Austria: “(i) 4”

Response by the European Patent Office: “(i) no records; (ii) no records”

Response by Japan: “(i) Not available; (ii) Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “(i) zero; (ii) not recorded (see question 9)”

Question 12: In response to invitations referred to in question 7, in how many cases did the applicant pay additional fees to your Office under protest?

Response by Australia: “None in either year”

Response by Austria: “None”

Response by the European Patent Office: “Approximately 10 per cent (estimated)”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “2000: 0; 2001: 0”

Question 13: In how many cases referred to in question 12 did your Office order the (i) total reimbursement or (ii) partial reimbursement to the applicant of the additional fees because it was found that the protest was justified (see Rule 68.3(c))?

Response by Australia: “(i) None (no protests filed); (ii) None (no protests filed)”

Response by Austria: “None”

Response by the European Patent Office: “(i) and (ii): no records for either, but only a relatively small percentage of cases where additional fees were paid under protest would result in total or partial reimbursement”

Response by Japan: “(i) Not available; (ii) Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “(i) 2000: 0; 2001: 0; (ii) 2000: 0; 2001: 0”

Question 14: (to be answered only by IPEAs which require the applicant to pay a fee for the examination of the protest (“protest fee”); see Rule 68.3(e)): In how many cases referred to in question 12 did your Office refund the protest fee because it was found that the protest was entirely justified (see Rule 48.3(e))?

Response by Australia: “Not applicable - the Australian Patent Office does not require a protest fee” (Please note: The Australian Patent Office notes that there are few protests compared with the number of invitations issued (despite there being no protest fee) and our experience suggests that the vast majority of protests we currently receive have some real basis. We therefore strongly support the opportunity to protest. We have however made a number of changes in internal procedures to streamline the invitation and protest process, including: 1. Where a large number of inventions have been identified, the applicant is

contacted by phone to ensure that the primary invention is identified before any search is conducted or any invitation issued. Reasons are provided in the invitation where the client has been previously contacted but these are not lengthy and detailed; 2. Protests are referred to a single reviewer who seeks independent technical advice from a high level examiner. The reviewer will make their decision based on that advice and the time taken to complete the second search but will only provide detailed reasons for the decision to the applicant if their protest is dismissed; and 3. Regardless of outcome of the protest, internal feedback about the review is provided to the examiner who issued the original invitation for quality and training purposes.)”

Response by Austria: “None”

Response by the European Patent Office: “Approximately 2 or 3 per year”

Response by Japan: “Not available”

Response by Spain: “OEPM was not IPEA at that time”

Response by Sweden: “Not applicable”

[End of Annex and of document]