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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

TOKYO INTERNATIONAL MEETING Tokyo, May 25 to 29, 1981

EXTENSION OF TIME LIMIT FOR ESTABLISHMENT OF INTERNATIONAL PRELIMINARY EXAMINATION REPORT AND CHANGE TO THE PROVISION OF RULE 70.6 OF THE REGULATIONS UNDER THE PATENT COOPERATION TREATY (PCT)

Memorandum prepared by the International Bureau

- 1 In its Circular C. 142/PCT 211 (reproduced in Annex A), the International Bureau invited observations in connection with a study related to the desirability of providing for an extension of time limits prescribed by Rules 69.1(a) and 66.2(d) of the PCT Regulations and with a change of the form of the international preliminary examination report (Rule 70.6).
2. Annexes B to D of this document contain the observations received from
 - the United Kingdom Patent Office (Annex B)
 - the Austrian Patent Office (Annex C)
 - the Netherlands Patent Office (Annex D)
3. The observations received from the Offices listed below are contained in the observations received from these Offices on international search and international preliminary examination which are reproduced in the document referred to after the indication of the name of the Office:
 - Australian Patent Office (see PCT/TIM/I/6; page 3)
 - Royal Patent and Registration Office of Sweden (see PCT/TIM/I/5, pages 3 and 4)
 - European Patent Office (see PCT/TIM/I/3, page 6)

[Annexes follow]

C. 142
February 19, 1981
PCT 211



WORLD INTELLECTUAL PROPERTY ORGANIZATION

ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

C. 142
PCT 211

February 19, 1981

Sir,

The Assembly of the International Patent Cooperation Union (PCT Union), during its fifth session (3rd extraordinary) held in Geneva from June 9 to 16, 1980, considered an amendment to Rule 69.1(a) of the PCT Regulations which would permit the time limit for the establishment of the international preliminary examination report to be extended to expire one year (from six months as provided at present) after the start of international preliminary examination where a request for such extension is made by the applicant.

The Assembly invited the International Bureau to study the question further and, in doing so, to consult with the International Preliminary Examining Authorities. The International Bureau was also asked to study whether it would be desirable to provide for the possibility of extending the period for a reply by the applicant to a written opinion from such Authority under Rule 66.2(d). Another question which was suggested for study was whether the form of the international preliminary examination report could be improved so that the usefulness of the report would be increased and whether, in particular, the requirement under Rule 70.6 of saying "yes" or "no" in all cases should not be modified to accommodate cases where a claim may be patentable but only in an amended form. Furthermore, it was suggested

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that consideration should also be given to whether measures should not also be adopted to avoid the examination of a particular question prolonging the international procedure unduly beyond the 25th month, thus reducing the chances for the report to be taken into account in the national phase. See document PCT/A/V/17, paragraph 29; see also documents PCT/A/V/3, Annex C, page 4 and Annex G, page 3 and PCT/A/V/4, pages 60 and 61.

It is the intention of the International Bureau to hold the consultations referred to above with the International Preliminary Examining Authorities and to consult also with the elected Offices at the PCT International Meeting to be held in Tokyo from May 25 to 29, 1981. It would be appreciated if each of the International Preliminary Examining Authorities would prepare a memorandum (or include appropriate information in the memorandum they are invited to prepare for the Tokyo International Meeting (see WIPO Circular letter C.140/PCT.00 of January 27, 1981)) concerning the questions raised by the Assembly.

If the elected Offices want to make comments on one or more of the questions referred to above, they are also invited to present their views. Of particular interest would be comments concerning the extension of the time limit for the establishment of the international preliminary examination report (particularly from the viewpoint of the later national processing) and any desirable change to the provisions of Rule 70.6, (particularly from the viewpoint of the national examination procedure). The memoranda and comments may also take up other questions related to international preliminary examination and the international preliminary examination report and should reach the International Bureau preferably before the end of March.

Sincerely yours,

K. Pfanner
Deputy Director General

MEMORANDUM IN RESPONSE TO C/42/PCT 211

Following the receipt of circular C/42/PCT 211, there has not been time to consult fully with the interested circles in the United Kingdom. This memorandum therefore can only represent a preliminary United Kingdom view on the questions raised in that circular.

As indicated in paragraph 3 of the Memorandum concerning Agenda item 2(i)(a), it is the experience of the United Kingdom Patent Office, operating as an International Preliminary Examining Authority, that the rule 69.1 time limit is adequate in the majority of cases where the applicant is interested in the establishment of a "yes" Report.

Nevertheless, it may be that the other Examining Authorities find the present time limit insufficient to establish a "yes" report in all cases even where the applicant wishes it. Moreover, we accept the view previously expressed by the interests that it would be desirable to do a full examination on all cases so as to establish a "yes" report where possible and we could therefore agree to a rule 69.1 period of 1 year if that would assist other Authorities. However, we are not in favour of further written opinions if the applicant is making no real attempt to remedy the defects. The International Preliminary Examining Authority should be able to establish the report if it becomes clear that no further progress is likely.

We are not in favour of keeping the rule 69.1 period at 6 months and allowing an extension at the request of the applicant as proposed at the PCT Assembly last June. In our view the rule 69.1 time limit is for the Authority to comply with and has nothing to do with the applicant. Indeed, the applicant does not even know when it commences. Furthermore, to leave the period at 6 months would not give adequate time for multiple written opinions (in order to achieve a "yes" report in all cases) without the applicant having to apply for an extension. Indeed he may get the first action in within 6 months and would then have to apply for an extension if a further action were necessary. This, in our view, is the wrong approach unless the objective is merely to give time for a response to a single written opinion.

Change of the rule 69.1 (a) time limit to 12 months from the start of the examination would not cause any difficulty to this office as an elected office, and ought to be sufficient to enable a wholly "yes" report to be established in all cases except those where there was no possibility of agreement between the IP2A and the applicant. An inevitable consequence of such a provision would be that a greater percentage of reports would be established after the Article 39 time limit. In view of this, the suggestion made in paragraph 4 of the Memorandum concerning Agenda item 2(i)(b) is reinforced.

Whether or not the rule 69.1 period is changed, we consider that it would be useful for the International Preliminary Examining Authority to be able to extend the period allowed under rule 66(2)(d) on the applicant's request, provided he gives a good reason. As mentioned in the Memorandum on Agenda item 2(i)(a), paragraph 4, we allow a 1 month extension on a 2 month time limit, but we see no reason why an initial 3 month time limit should not be similarly extendable. So long as such an extension were limited to one month, it could be accommodated within the present period of 6 months allowed by rule 69.1 for establishing the report. However, we consider that any extension of time should be dependent upon the applicant making a bona fide attempt to remedy the defects.

We do not understand the proposal that rule 70.6 should be amended to accommodate cases where a claim may be patentable but only in amended form. This is inconsistent with Article 35(2). It may be that the intention is to amend the rule to cope with the situation in which a claim as it stands does not meet the criteria of novelty, inventive step and industrial applicability, but would do so if amended. We consider that the requirement for a "no" report to be accompanied by explanations (rule 70.3(i)) and an indication of which criteria, taken separately, are satisfied (70.6(b)) are adequate to meet the situation envisaged. Moreover, explanations are generally required even for a "yes" report (rule 70.3(ii)) and there is provision for optional observations in all cases (rule 70.6(a)).

If the proposed change is that the International Preliminary Examining Authority should suggest the form of claim that would be free from the noted defects, we could not agree. It would be inadvisable for the

Authority to indicate a form of the claim for two reasons. First, it might prejudice the applicant if he sought to have any other form of claim accepted by the elected offices and second, it would be embarrassing if a form of claim suggested by the Authority were subsequently to be held unacceptable by an elected office.

We do not altogether understand the suggestion in the sentence joining pages 2 and 3 of the circular. There is no question at present of prolonging the report unduly beyond the 25th month. If the period for establishing the report is fixed at 1 year, then this must be available in all cases with the consequent chance of the report not being available when the application enters the national phase. As stated above, we do not see any difficulty in this; we in the UK would not start examination without the report.

It is hoped that these preliminary views will be of use in the study which the International Bureau is undertaking.

bled nummer 2

uw brief en kenmerk
C. 142/PCT 211
d.d. 19-02-1981
March 30, 1981

ons kenmerk
S 81/128

bijlagen

detum

onderwerp

Mr. K. Pfanner
Deputy Director General
World Intellectual
Property Organization
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1211 GENEVA 20
Switzerland

Dear Sir,

In connection with the circular C. 142/PCT 211 from February 19, 1981 and the questions raised therein, we would like to make the following remarks:

- a. extension of the time limit for the establishment of the international preliminary examination report
- Extension of said time limit to one year after the start of the international preliminary examination will not influence the applicant's position with relation to the use of the report in the national phase in the Netherlands in view of our deferred examination system allowing deferment up to 7 years. Nevertheless, we are in general not in favour of such an extension. The examination under Chapter II of PCT is a preliminary examination and the international examiner should not go beyond that, keeping in mind that the elected Offices will have to complete the examination each having its own conditions of patentability and that they are not bound by the indications given in the report (see Art. 27(5)).

In our opinion the examiner will generally be in the position to complete the international preliminary examination and to establish the international preliminary examination report when he receives the applicant's reply to the first written opinion, in particular when the suggestion under c. is adopted. Thus, no extension of the time limit given in Rule 69.1 (a) normally is necessary. There may, however, be circumstances in which an extension of the time limit given to the applicant for reply to the first written opinion could be very helpful (see our remarks under b. hereafter). In such cases, but only in such cases, the time limits given in Rule 69.1 (a) should be extended correspondingly.

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- b. extension of the time limit under Rule 66.2 (d)

It may well be that an applicant, in order to refute the arguments from the examiner, has to file new experimental evidence, for instance the results of comparative tests between the invented new compounds and known compounds having a similar type of action. Then a three-month period, i.e. the maximum time limit possible under Rule 66.2 (d), could be too short to prepare a detailed reply to the first written opinion.

In such cases, but only in such cases, we would be in favour of allowing the applicant, on his request and with the consent of the examiner, an extension of the time limit for reply to the first written opinion. The examiner should grant the extension of the time limit only when in his opinion the filing of new evidence really is essential for a good understanding of the invention. The time limit should then be 6 months after the date of notification of the first written opinion. National practice in the Netherlands shows that a six-months period is satisfactory.

Since an extension to 6 months means an extension with three months of the maximum time limit possible now under Rule 66.2 (d), it is reasonable that the time limits given in Rule 69.1 (a) in such cases should then be extended correspondingly and should be 9 or 11 months in stead of 6 or 8 months.

- c. amendment of Rule 70.6

As already implied in our remarks under a. above, we are of the opinion that the international preliminary examiner, dealing with the question whether the three criteria mentioned in Art. 35 (2) are satisfied, will have no problem in completing the international preliminary examination report after receipt of the applicants reply to the first written opinion, when the examiner can state YES with relation to the three criteria mentioned in Art. 35 (2). Problems, however, do arise in case the examiner, having to say NO at this stage, is of the opinion that the answer could be YES if the claims were amended in an appropriate way or some other condition were met, e.g. proof is submitted of an advantageous effect of the invention. In order to avoid in such cases an in our view unnecessary prolongation of the international preliminary examination, we propose that the examiner should be allowed to indicate in the international preliminary examination report the conditions which in his opinion have to be met in order to obtain a positive statement.

Obviously, such a "CONDITIONAL YES" has to be accompanied by citations, explanations and observations, showing the arguments why the answer was not simply YES or NO. Such arguments in our view may well prove to be helpful in later discussions between the applicant and an elected Office in the national phase.

We therefore are in favour of an amendment of Rule 70.6 in such a way that it accommodates cases where a claim may be satisfactory but only in amended form or under some other condition.


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d. surpassing the 25-month time limit

As regards the Netherlands, such surpassing will cause no problem. In our system of deferred examination, the applicant controls the start of the examination by having to file a request which he may delay up to 7 years after the international filing date.

Nevertheless, as can be seen from our comments given above under a - c, a surpassing of the 25-month time limit could take place only in a few cases, where the time limit under Rule 66. 2 (d) was extended. One would assume that national offices in such cases would upon request delay the start of the national examination, without special measures being required.

Yours sincerely,



J. Dekker,
President

204



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97.375/3-GR/81

Concerning the question of the "form" of the international preliminary examination report and the problem of measures to avoid the examination procedure being unduly prolonged the Austrian Office cannot make comments due to the reason stated above.

Mr. K. Pfanner
Deputy Director General
World Intellectual Property
Organization (WIPO)

34, chemin des Colombettes
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Re.: C 742/PCT 211

Dear Mr. Pfanner,

This is in reply to your Circular of February 19, 1981, concerning proposed amendments of some PCT-Rules.

Please note that the Austrian Patent Office, having not yet become active as International Preliminary Examining Authority, is not in a position to make comments on the proposed amendments based on experience. On principle we would suggest to change the PCT-Rules as few as possible. In detail:

Rule 69.1(a): A provision of the possibility to extend the time limit for the establishment of the examination report might be useful.

Rule 66.2(d): The one-month time limit might be extended to two months, but we would prefer letting the provision as it is.

Rule 70.6 : An accommodation of this Rule to cases where a claim may be patentable only in an amended form would be appreciated.

Sincerely yours

(J. Fichte)