

**POST-CONFERENCE
DOCUMENTS**

HISTORY OF THE PATENT COOPERATION TREATY

PCT/PCD/1
WIPO/BIRPI

October 16, 1970 (Original: English)

CONTENTS

	Paragraphs		Paragraphs
INTRODUCTION	1 and 2	THE YEAR 1969	23 to 32
THE YEARS 1966 AND 1967	3 to 13	“The Revised Drafts”	23
Origin and First Consultations	3 and 4	Consultations in April and	
First Draft Treaty (1967)	5	May, 1969	24 to 29
Committee of Experts of 1967	6 to 10	The 1969 Drafts	30 and 31
Conference of Representatives of the		Executive Committee of the Paris Union	
Paris Union (1967)	11 to 13	(1969)	32
THE YEAR 1968	14 to 22	THE YEAR 1970	33 to 49
Meetings During the First Half of		Written Comments on the 1969	
1968	14 to 17	Drafts	33
The 1968 Drafts	18	Preparatory Study Group (1970)	34 to 37
Executive Committee of the Paris Union		Alternative Proposals for the Diplomatic	
(1968)	19	Conference	38
Committee of Experts of 1968	20 to 22	Washington Diplomatic	
		Conference, 1970	39 to 49

INTRODUCTION

1. The present memorandum is a chronological account of the main decisions and consultations leading to the adoption of the Patent Cooperation Treaty (PCT) and the PCT Regulations.

2. The account is broken down into four Chapters, the first dealing with the events of 1966 and 1967, the second with those of 1968, the third with those of 1969, and the fourth with the events of 1970 up to the date of the signing of the PCT on June 19, 1970. They cover a period of three years and nine months.

THE YEARS 1966 AND 1967

Origin and First Consultations

3. On a proposal presented by the Delegation of the United States of America, the Executive Committee of the International (Paris) Union for the Protection of Industrial Property adopted, on September 29, 1966, the following recommendation (see BIRPI document CEP/II/12, paragraph 46):

“The Executive Committee of the International (Paris) Union for the Protection of Industrial Property (Second Session, Geneva, September 29, 1966),

Having noted:

that all countries issuing patents, and particularly the countries having a preliminary novelty examination system, have to deal with very substantial and constantly growing volumes of applications of increasing complexity,

that in any one country a considerable number of applications duplicate or substantially duplicate applications concerning the same inventions in

other countries thereby increasing further the same volume of applications to be processed, and

that a resolution of the difficulties attendant upon duplications in filings and examination would result in more economical, quicker, and more effective protection for inventions throughout the world thus benefiting inventors, the general public and Governments,

Recommends:

that the Director of BIRPI undertake urgently a study on solutions tending to reduce the duplication of effort both for applicants and national patent offices in consultation with outside experts to be invited by him and giving due regard to the efforts of other international organizations and groups of States to solve similar problems, with a view to making specific recommendations for further action, including the conclusion of special agreements within the framework of the Paris Union.”

4. In accordance with the above recommendation, the Director of BIRPI consulted with experts both from the six States which have the highest number of applications and from the International Patent Institute. The six States were the following: France, Germany (Federal Republic), Japan, Soviet Union, United Kingdom, United States of America. The consultations took place during the months of January to April 1967.

First Draft Treaty (1967)

5. On the basis of these consultations, a draft Treaty (“the 1967 Draft”) was prepared by BIRPI under the tentative title “Patent Cooperation Treaty.” This draft (PCT/1/3), together with related documents

(PCT/I/1, 2, 4, 5), all dated May 31, 1967, served as a basis for the discussions of a Committee of Experts, organized and convened by BIRPI at Geneva in October 1967.

Committee of Experts of 1967

6. The Committee of Experts of 1967 "on the PCT Plan" sat from October 2 to 10, 1967. Those 23 States in which, according to the latest available yearly statistics, more than 5000 applications had been filed were invited to participate as members of the Committee. They all accepted and attended. They were the following: Argentina, Australia, Austria, Belgium, Brazil, Canada, Czechoslovakia, Denmark, France, Germany (Federal Republic), Italy, Japan, Mexico, Netherlands, Norway, Poland, South Africa, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United States of America. Two States, Hungary and India, were represented by observers.

7. The following seven intergovernmental organizations were represented: United Nations, International Patent Institute, Organization of American States, Council of Europe, European Communities, European Free Trade Association, African and Malagasy Industrial Property Office.

8. Ten non-governmental organizations, representing inventors, industrialists, patent lawyers and patent agents, were invited and were represented. They were the following: Committee of National Institutes of Patent Agents, Council of European Industrial Federations, European Industrial Research Management Association, Inter-American Association of Industrial Property, International Association for the Protection of Industrial Property, International Chamber of Commerce, International Federation of Patent Agents, National Association of Manufacturers (USA), Union of European Patent Agents, Union of Industries of the European Community.

9. Representatives of governments, intergovernmental organizations, and non-governmental organizations, had equal opportunities to participate in the discussions.

10. The report of the Committee of Experts was published in document PCT/I/11.

Conference of Representatives of the Paris Union (1967)

11. The program of BIRPI concerning the Patent Cooperation Treaty, including the plan to hold a diplomatic conference in 1969 (later postponed until 1970) for the establishment of the Treaty, was considered by the Conference of Representatives of the Paris Union in its session of December 1967.

12. The Conference of Representatives was at that time the principal organ of the Paris Union. All member countries of the Union were members of the Conference.

13. The Conference expressed the view that preparatory work for the Treaty should be vigorously pursued and approved the program and budget proposals presented in relation to this preparatory work, including plans for a diplomatic conference.

THE YEAR 1968

Meetings During the First Half of 1968

14. In the first six months of 1968, numerous consultations took place with a view to preparing the new-second-draft of the Patent Cooperation Treaty.

15. First, the question of *international search* was considered in meetings, held on January 18 and 20, 1968, with representatives of the ten non-governmental organizations enumerated in paragraph 8, above; on January 23 to 25, with experts of the six States referred to in paragraph 4, above, and the International Patent Institute; and in a Working Group from March 25 to 29, 1968, to which the same 25 States and the same intergovernmental and non-governmental organizations were invited as had been invited to the 1967 Committee of Experts (see paragraphs 6, 7, 8, above). (The Japan Patent Association was also invited but was not represented.) The documents of this Working Group comprise the PCT/II series (1 to 7).

16. Then, the questions of *international application and international preliminary examination* were considered in meetings, held on April 22 and 23, and April 25 and 26, 1968, with representatives of the ten non-governmental organizations referred to above; and on April 29 to May 3, 1968, with experts of the six States referred to above and the International Patent Institute.

17. On the basis of the advice of the 1967 Committee of Experts and the advice received in the above-mentioned seven meetings, BIRPI prepared the new, *second draft of the PCT* and the first full draft of the PCT Regulations. After having submitted these drafts to a meeting, held from June 25 to 27, 1968, of representatives of the six States referred to above and the International Patent Institute, and after making a few amendments to the drafts on the basis of that meeting and holding a brief discussion in an information meeting on July 1, 1968, to which the rest of the 25 States referred to in paragraph 15 and the International Patent Institute were invited, the drafts ("the 1968 Drafts") were published as working documents PCT/III/5 and 6, on July 15, 1968.

The 1968 Drafts

18. The 1968 Drafts were communicated to all the member countries of the Paris Union and all the intergovernmental and non-governmental organizations referred to in paragraphs 7 and 8, above, plus the newly founded International Federation of Inventors Associations, which had more than four months to study them in preparation for the 1968 Committee of Experts.

Executive Committee of the Paris Union (1968)

19. The Executive Committee of the Paris Union, comprising 20 member countries, noted with approval, when it met from September 24 to 27, 1968, the progress made so far and established the program for further action, with 1969 or 1970 as the target date for the Diplomatic Conference.

Committee of Experts of 1968

20. All member countries of the Paris Union and a number of intergovernmental and non-governmental organizations were invited to the Committee of Experts which was held at Geneva from December 2 to 10, 1968. The following 41 States, 7 intergovernmental organizations and 11 non-governmental organizations were represented by a total of some 150 delegates:

States: Algeria, Argentina, Australia, Austria, Belgium, Brazil, Canada, Cuba, Czechoslovakia, Denmark, Finland, France, Germany (Federal Republic), Greece, Hungary, India, Indonesia, Ireland, Israel, Italy, Japan, Lebanon, Luxembourg, Monaco, Netherlands, Norway, Philippines, Poland, Portugal, Romania, Senegal, South Africa, Soviet Union, Spain, Sweden, Switzerland, Turkey, Uganda, United Arab Republic, United Kingdom, United States of America.

Intergovernmental Organizations: United Nations, United Nations Industrial Development Organization, International Patent Institute, Organization of American States, Council of Europe, European Communities, European Free Trade Association.

Non-Governmental Organizations: Committee of National Institutes of Patent Agents, Council of European Industrial Federations, European Industrial Research Management Association, International Association for the Protection of Industrial Property, International Chamber of Commerce, International Federation of Inventors Associations, International Federation of Patent Agents, Japan Patent Association, National Association of Manufacturers (United States of America), Union of European Patent Agents, Union of Industries of the European Community. (The Inter-American Association of Industrial Property was invited but did not attend.)

21. All participants, whether representing governments or organizations, had an equal right and opportunity to participate in the debate and propose amendments to the Drafts.

22. The Committee examined the 1968 Drafts, article by article, and rule by rule. Its deliberations, and particularly its proposals for amendments to the 1968 Drafts – whether approved, disapproved, or not voted upon – were recorded in detail in the report adopted by the Committee itself (PCT/III/31).

THE YEAR 1969

“The Revised Drafts”

23. On the basis of the deliberations of the 1968 Committee of Experts, BIRPI revised the 1968 Drafts (“the Revised Drafts”) and issued them on March 13, 1969 (PCT/R/2 and 3), to those States and organizations which it had convened to meetings in April and May 1969.

Consultations in April and May, 1969

24. Three meetings were convened by BIRPI during the months of April and May, 1969, for the purpose of considering the Revised Drafts.

25. The first was a meeting of government experts and it took place from April 21 to 24, 1969. In addition to the six States with whose national Offices the highest number of applications are filed, those members of the Council of Europe Working Group on Patents which were not among the said six were also invited in order to secure the possibility of complete coordination with the Group’s main task, the revision of the European Convention Relating to the Formalities Required for Patent Applications. Thus, altogether, nine States were invited and they all participated. They were the following: France, Germany (Federal Republic), Japan, Netherlands, Soviet Union, Sweden, Switzerland, United Kingdom, United States of America.

26. The second was a meeting held on April 28 and 29, 1969, to which the following non-governmental organizations were invited and they all participated: Council of European Industrial Federations, European Industrial Research Management Association, International Chamber of Commerce, International Federation of Inventors Associations, Japan Patent Association, National Association of Manufacturers (United States of America), Union of Industries of the European Community.

27. The third was a meeting held on May 1 and 2, 1969, to which the following non-governmental organizations were invited and they all participated: The Authorized Association of Japanese Patent Attorneys, Committee of National Institutes of Patent Agents, Inter-American Association of Industrial Property, International Association for the Protection of Industrial Property, International Federation of Patent Agents, Union of European Patent Agents.

28. In addition to the above meetings, BIRPI received advice and suggestions in writing and orally from many persons.

29. The International Patent Institute was invited to and participated in the meetings referred to in paragraphs 25, 26, 27 and 30.

The 1969 Drafts

30. On the basis of the results of these consultations and suggestions, BIRPI once more revised the drafts of both the PCT and the PCT Regulations, and, after a two-day meeting, on June 16 and 17, 1969, with experts of the nine Governments referred to in paragraph 25, above, issued them under the date of July 11, 1969 (“the 1969 Drafts”).

31. These Drafts consisted of the Draft PCT and the Draft PCT Regulations (documents PCT/DC/4 and 5). They were accompanied by a document tracing the history of the plan for a PCT (PCT/DC/1), a document summarizing the provisions of the Drafts (PCT/DC/2), a document indicating the main differences between the 1968 Drafts and the 1969 Drafts (PCT/DC/3) as well as a document containing a PCT glossary and a subject index to the 1969 Drafts (PCT/DC/6).

Executive Committee of the Paris Union (1969)

32. The Executive Committee of the Paris Union, comprising 20 member countries, noted with approval,

when it met from September 22 to 26, 1969, the progress made so far and the plans for holding a diplomatic conference in 1970 for the negotiation and adoption of the Treaty. The Executive Committee also noted with approval the plan to hold the Diplomatic Conference in Washington, provided a formal invitation was received in time from the US Government.

THE YEAR 1970

Written Comments on the 1969 Drafts

33. All member States of the Paris Union were invited to make comments and suggestions in respect of the 1969 Drafts. The following did so and their replies were published in document form by BIRPI: Austria, Cameroon, Denmark, Finland, Germany (Federal Republic), Hungary, Israel, Italy, Japan, Netherlands, Norway, South Africa, Soviet Union, Sweden, Switzerland, United Kingdom, United States of America. A similar invitation was sent to non-governmental organizations, among which the following responded: Asian Patent Attorneys Association, Council of European Industrial Federations, European Industrial Research Management Association, International Association for the Protection of Industrial Property, International Chamber of Commerce, International Federation of Inventors Associations, International Federation of Patent Agents, Pacific Industrial Property Association, Union of Industries of the European Community (documents PCT/DC/7, 8, 9, 10, 13, 15, 36, 37, 38).

Preparatory Study Group (1970)

34. The member countries of the Paris Union and a number of intergovernmental and non-governmental organizations were invited to the Preparatory Study Group on the Draft Patent Cooperation Treaty Regulations, which was held in Geneva from March 9 to 19, 1970. The following 40 States, 9 intergovernmental organizations and 11 non-governmental organizations were represented by a total of some 130 participants:

States: Algeria, Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, Cuba, Czechoslovakia, Denmark, Finland, France, Gabon, Germany (Federal Republic), Hungary, Iran, Ireland, Italy, Japan, Lebanon, Luxembourg, Monaco, Netherlands, Norway, Poland, Portugal, Romania, South Africa, Soviet Union, Spain, Sweden, Switzerland, Syria, Turkey, United Arab Republic, United Kingdom, United States of America, Yugoslavia.

Observer State: India.

Intergovernmental Organizations: United Nations, United Nations Conference on Trade and Development, Council of Europe, Commission of the European Communities, European Free Trade Association, Intergovernmental Conference for the Setting Up of a European System for the Grant of Patents, International Patent Institute, African and Malagasy Industrial Property Office, Organization of American States.

Non-Governmental Organizations: Asian Patent Attorneys Association, Committee of National Institutes of Patent Agents, Council of European Industrial Federations, European Industrial Research Management Association, International Association for the Protection of Industrial Property, International Chamber of Commerce, International Federation of Inventors Associations, International Federation of Patent Agents, Japan Patent Association, National Association of Manufacturers (United States of America), Union of Industries of the European Community.

35. All participants, whether representing governments or organizations, had an equal right and opportunity to participate in the debates and propose amendments to the Draft Regulations.

36. The Study Group considered, paragraph by paragraph, each of the 95 rules of the PCT Draft Regulations. When the discussion made consideration or the changing of the corresponding article in the Draft Treaty necessary, the Study Group also dealt with such article.

37. The Study Group reached general agreement on a number of changes affecting some two-thirds of the Draft Rules. Its conclusions are recorded in a 57-page report which the Study Group adopted on the last day of its meeting (PCT/WGR/17).

Alternative Proposals for the Diplomatic Conference

38. On the basis of the conclusions reached in the March 1970 Working Group, BIRPI issued, under the date of May 20, 1970, two new documents (PCT/DC/11 and 12) for the convenience of the Diplomatic Conference.

Washington Diplomatic Conference, 1970

39. The "Washington Diplomatic Conference on the Patent Cooperation Treaty, 1970" took place, at the invitation of the Government of the United States of America, in Washington from May 25 to June 19, 1970. The meetings were held at the conference premises of the Department of State.

40. Member States of the Paris Union invited to the Conference had the right to vote in the Conference. States members of the United Nations and the UN Specialized Agencies which were not members of the Paris Union were invited as observers. A number of intergovernmental and international non-governmental organizations were also invited as observers.

41. The following 55 States members of the Paris Union, 23 observer States, 11 intergovernmental organizations and 11 international non-governmental organizations were represented by a total of some 300 participants

States Members of the Paris Union: Algeria, Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Cameroon, Canada, Central African Republic, Denmark, Dominican Republic, Finland, France, Gabon, Germany (Federal Republic), Holy See, Hungary, Indonesia, Iran, Ireland, Israel, Italy, Ivory Coast, Japan, Luxembourg, Madagascar, Malawi, Malta, Mauritania, Mexico, Monaco, Netherlands, Niger, Norway, People's Republic of the Congo, Philippines, Poland, Portugal, Romania, South

Africa, Soviet Union, Spain, Sweden, Switzerland, Togo, Trinidad and Tobago, Turkey, Uganda, United Arab Republic, United Kingdom, United States of America, Uruguay, Yugoslavia, Zambia.

Observer States: Barbados, Bolivia, Burundi, Chile, China (Republic of), Costa Rica, Ecuador, Ghana, Guatemala, Guyana, Jamaica, Jordan, Laos, Libya, Malaysia, Nicaragua, Panama, Paraguay, Peru, Republic of Korea, Rwanda, Saudi Arabia, Thailand.

Intergovernmental Organizations: United Nations, United Nations Conference on Trade and Development, United Nations Industrial Development Organization, International Patent Institute, International Institute for the Unification of Private Law, African and Malagasy Industrial Property Office, Commission of the European Communities, European Free Trade Association, Industrial Development Centre for Arab States, Intergovernmental Conference for the Setting Up of a European System for the Grant of Patents, Organization of American States.

International Non-Governmental Organizations: Asian Patent Attorneys Association, Committee of National Institutes of Patent Agents, Council of European Industrial Federations, European Industrial Research Management Association, Inter-American Association of Industrial Property, International Association for the Protection of Industrial Property, International Chamber of Commerce, International Federation of Inventors Associations, International Federation of Patent Agents, Pacific Industrial Property Association, Union of Industries of the European Community.

42. All participants, whether representing governments or organizations, had the right and opportunity to participate in the debates but only representatives of the member States of the Paris Union had the right to propose amendments and to vote.

43. During the Conference, amendments were proposed in writing by the following States: Algeria, Argentina, Australia, Austria, Belgium, Brazil, Canada, Denmark, Finland, France, Germany (Federal

Republic), Ireland, Israel, Italy, Ivory Coast, Japan, Madagascar, Monaco, Netherlands, Norway, Poland, Portugal, Romania, Soviet Union, Spain, Sweden, Switzerland, Togo, Uganda, United Arab Republic, United Kingdom, United States of America, Uruguay, Yugoslavia, Zambia. (See documents PCT/DC/13, 16, 17, 18, 19, 20, 21, 22, 23, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 34.Rev., 34.Rev./Corr., 35, 39, 40, 41, 42, 43, 44, 45, 46, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 76, 77, 78, 80, 81, 82, 83, 84, 85, 86, 89, 92, 94, 95, 96, 97, 98, 99, 100, 104, 105, 110, 111, 117.)

44. The Patent Cooperation Treaty and the annexed Regulations were unanimously adopted on June 17, 1970. Forty-seven Paris Union member States had the right to vote; forty-four voted for and none against. When abstentions were called for no delegation came forward.

45. The Conference also unanimously adopted a Resolution recommending certain interim measures pending the entry into force of the Treaty. This Resolution was proposed by Algeria, Germany (Federal Republic), Japan, Soviet Union and Sweden (see document PCT/DC/126).

46. The text of the Treaty, the Regulations and the Resolution, as well as the list of participants, were published in the August 1970 issue of «*Industrial Property*», the monthly review of BIRPI.

47. On June 19, 1970, the Treaty was opened for signature and on that day it was signed by the following 20 States: Algeria, Brazil, Canada, Denmark, Finland, Germany (Federal Republic), Holy See, Hungary, Ireland, Israel, Italy, Japan, Norway, Philippines, Sweden, Switzerland, United Arab Republic, United Kingdom, United States of America, Yugoslavia.

48. The Treaty remains open for signature in the US Department of State until the end of 1970.

49. A supplement to the present document will indicate the names of those States which will have signed the Treaty between June 19 and December 31, 1970.*

* Editor's Note: As a supplement to the list of Signatory States found in paragraph 47, the following 15 States signed the Treaty between June 19 and December 31, 1970: Argentina, Austria, Belgium, France, Iran, Ivory Coast, Luxembourg, Madagascar, Monaco, Netherlands, Romania, Senegal, Soviet Union, Syria, Togo.

SUMMARY AND ADVANTAGES OF THE PATENT COOPERATION TREATY

PCT/PCD/2
WIPO/BIRPI

October 16, 1970 (Original: English)

CONTENTS

PART I

	Paragraphs		Paragraphs
SUMMARY OF THE PATENT COOPERATION TREATY	1 to 83	Patent Information Services	63 and 64
<i>Aims of the Treaty</i>	4 to 13	Technical Assistance	65 and 66
Procedures	5 to 9	<i>The Treaty, the Regulations and Other Instruments</i>	67 to 73
Information and Technical Assistance	10 to 13	The Treaty and the Regulations	68 and 69
<i>Brief Summary of the Procedures Under the Treaty</i>	14 to 29	Administrative Instructions and Agreements	70 to 72
Three Main Features and Two Phases	14 and 15	Entry Into Force	73
Steps Constituting the First Phase	16 to 19	<i>The Treaty and Other Efforts for International Cooperation in the Patent Field</i>	74 to 83
Effects of the First Phase	20 to 23		
Steps Constituting the Second Phase	24 to 27		
Effects of the Second Phase	28 and 29		
<i>Some Special Features of the Procedures under the Treaty</i>	30 to 61		
Optional Character of the Treaty	30 to 32		
International Searching and Preliminary Examining Authorities	33 to 35		
Length of the Procedure	36 to 39		
Languages	40 to 45		
Fees	46 to 56		
Formalities	57 and 58		
International-Type Search	59		
Reservations	60 and 61		
<i>Brief Summary of the Information and Technical Assistance Features of the Treaty</i>	62 to 66		
Publication of International Applications and International Search Reports	62		

PART I

SUMMARY OF THE PATENT COOPERATION TREATY

1. This Part of the present document first states the aims of the Patent Cooperation Treaty (hereinafter referred to as "the Treaty") adopted and signed at Washington on June 19, 1970. It then briefly summarizes the provisions of the Treaty as to the procedures thereunder, as well as to information and technical assistance. In connection with the procedures under the Treaty, it calls attention to some special features useful for the full understanding of such procedures.

2. This Part of the document also explains what kinds of provisions were written into the Treaty and

into the Regulations, and what other documents will still have to be drawn up before the Treaty becomes operational.

3. Finally, this Part examines the Treaty's relation to other existing or planned systems of international cooperation in the patent field.

Aims of the Treaty

4. The Treaty has two principal aims, one in the field of *procedures* for obtaining legal protection for inventions, the other in the field of the dissemination of technical *information* and the organization of technical *assistance*, particularly for developing countries.

Procedures

5. In the field of procedures, the Treaty has two principal aims. One is to save effort – time, work,

money – both for the applicant and the national Offices¹ in cases where patents² are sought for the same invention in a number of countries.³

6. The other is to increase the likelihood of granting strong patents,⁴ particularly in countries not having all the facilities necessary for a thorough search and examination. By “strong” patents is meant patents granted for inventions which by meeting all the conditions of patentability are likely to withstand challenge in the courts.

7. The saving of effort for the applicant consists primarily in allowing him to file one international application (in one place, in one language, for one set of fees) having – subject to certain conditions – the effect of a national application in each and all of the Contracting States in which he desires to obtain protection.

8. The saving of effort for the national Offices consists primarily in their receiving international search reports and possibly also international preliminary examination reports, both of which considerably reduce the work of examination.

9. The likelihood of granting strong patents follows from the fact that international search reports and international preliminary examination reports have to meet high standards which are internationally regulated, and that they are expected to be issued by authorities whose great expertise in the matter of searching and examining patent applications is amply proven and generally recognized and whose activities under the Treaty will be internationally coordinated.

Information and Technical Assistance

10. The informational aim, in the language of the Preamble to the Treaty, is “to facilitate and accelerate access by the public to the technical information contained in documents describing new inventions.”

11. Access to such information is facilitated not only by the publication of the international application but also by the fact that such publication is accompanied by the publication of an abstract and of the international search report. That report allows scientists and industrialists interested in the field, including the applicant’s competitors, to understand the invention more easily and assess its technical and economic significance.

12. Access to such information is accelerated by the fact that international applications are generally published upon the expiration of a fixed and relatively short period of time, namely, 18 months from the priority date.

13. Easier and more rapid access to technical information is of particular interest to developing countries, which are generally in urgent need of technology. The Treaty expressly deals with this interest of developing countries: it provides that the information services of the International Bureau must be operated “in a way particularly facilitating the acquisition by Contracting States which are developing countries of technical knowledge and technology, including available published know-how” (Article 50(3)); and it provides for technical assistance for developing countries “in developing their patent systems individually or on a regional basis” (Article 51(3)(a)).⁵

Brief Summary of the Procedures Under the Treaty

Three Main Features and Two Phases

14. The Treaty consists of three main features: international application, international search, and international preliminary examination. The first two are inseparable in the sense that the only way to international search is through the filing of an “international application” and that all international applications are subject to international search. These two features are mandatory: every State becoming party to the Treaty must apply them and no applicant choosing to use the Treaty can avoid them. These two features, together, are usually referred to as “the First Phase” (or “Phase I”) of the Treaty, or, because the provisions relating to them are contained in the first Chapter of the Treaty, as the procedure “under Chapter I.”

15. The third feature – international preliminary examination – is optional. Any Contracting State may decide not to adhere to those provisions of the Treaty which concern international preliminary examination, and each applicant may decide for himself whether he wants to take advantage of international preliminary examination. This feature is usually referred to as “the Second Phase” (or “Phase II”) of the Treaty, or, because the provisions relating to it are contained in the second Chapter of the Treaty, as the procedure “under Chapter II.” Naturally, for Contracting States or applicants choosing not to use Phase II, Phase I is the only international phase.

Steps Constituting the First Phase

16. The FIRST PHASE consists of the following steps: the applicant files an international application with his national Office (“the receiving Office”); that Office checks the international application to see whether it is in order as to form, particularly whether it complies with those minimum requirements which enable it to acquire an international filing date; the same Office sends – direct or through the applicant –

¹ “National Office,” throughout this document, means the government authority of a Contracting State or the intergovernmental authority entrusted with the grant of patents.

² “Patents,” throughout this document, should be understood as meaning all kinds of protection for inventions, including in particular inventors’ certificates (a form of protection for inventions known in the Soviet Union and some other countries).

³ This aim is stated in the Preamble to the Treaty as being “to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries.”

⁴ This aim is stated in the Preamble to the Treaty as being “to perfect the legal protection of inventions.”

⁵ The aim of assisting developing countries is expressed in the Preamble to the Treaty, in particular by the words: “desiring to foster and accelerate the economic development of developing countries through the adoption of measures designed to increase the efficiency of their legal systems, whether national or regional, instituted for the protection of inventions by providing easily accessible information on the availability of technological solutions applicable to their special needs and by facilitating access to the ever expanding volume of modern technology.”

one copy of the international application to the International Bureau (for the purposes of the record) and one copy direct to the International Searching Authority (it should be noted that the receiving Office and the International Searching Authority may be one and the same); the International Searching Authority searches the international application, that is, tries to discover any relevant prior art, and establishes a report ("the international search report") which consists of bare citations of documents believed to be relevant for the purposes of examination; the international search report and, where requested, copies of the documents cited therein are first transmitted to the applicant, who may maintain the international application as it is, withdraw it, or amend the claims, and, in the last case, file also a brief statement explaining the amendments and indicating any impact that the amendments might have on the description and the drawings; the international application, together with the international search report, is then communicated to the national Office of each Contracting State designated by the applicant. It is only then⁶ that the national fees (if any) and the translations (if there is a language difference) become due, and processing and examination by the said national Office ("the national phase") can start.

17. The international application is published by the International Bureau. Such publication generally takes place promptly after the expiration of 18 months from the priority date.⁷ It may take place earlier, that is, if the applicant so requests. On the other hand, it may take place later or not at all, that is, if the applicant seeks protection only in Contracting States which have declared that they do not require international publication. When only such States are "designated," international publication takes place promptly after the first national publication of the international application or the grant of the first patent. If neither of these two events ever occurs, the international application remains unpublished.

18. The Treaty makes no provision for the national phase except that it guarantees that it cannot start until at least the expiration of the 20th month after the priority date, and that the applicant must be given an opportunity, in each designated State, to amend the international application (claims, description, and drawings). This is true even in respect of States having a "registration system." Otherwise, each Contracting State will maintain its present patent law, or may change it as it pleases in the future, subject

⁶ However, even if the international search report is not completed by the end of the 20th month from the priority date (see the following footnote), the national fees must be paid and the translations must be furnished by that date and the national processing may start without the said report (unless any national Office wants to wait longer, which it has the right to do). But since, in all typical cases, the international search will have been completed by that time, this situation will rarely arise and the 20-month time limit merely serves the purpose of assuring designated Offices that they do not have to wait indefinitely.

⁷ "Priority date" means the filing date of any earlier application whose priority is claimed in the international application. If the international application does not contain such a claim, "priority date" means the international filing date of the international application itself.

only to the restriction that it is not allowed to prescribe different, stricter, formal requirements for the international application than the Treaty prescribes.

19. Any international search must conform to the same standards, irrespective of the identity of the International Searching Authority (see also paragraphs 33 to 35, below).

Effects of the First Phase

20. The filing of an international application has two legal effects:

(i) the international application has the effect of a national application in each and all of the designated States;⁸

(ii) the processing of the international application before the designated Offices is delayed – that is, does not start (except at the express request of the applicant) – at least until the expiration of 20 months after the priority date and, normally, until the international search report has become available.

21. Each of those legal effects has important practical consequences.

22. The consequence of the first is that the applicant can cause the existence of applications in many countries by filing *one* international application in *one* language and paying *one* set of fees.

23. The consequence of the second is that national processing starts under far more advantageous conditions both for the applicant and for the national Offices than without the Treaty: for the applicant, because he has a more informed opinion on the value of his invention; for the national Offices, because a substantial part of the examination task – namely the searching for prior art – is already completed. Upon request, the applicant and any designated Office can receive copies of the documents cited in the international search report. Furthermore the furnishing of translations (where there is a language difference) and the payment of national fees (if any) become due much later – at least eight months later – than without the Treaty.

Steps Constituting the Second Phase

24. The SECOND PHASE consists of the following steps: the applicant demands international preliminary examination; the demand must be addressed to the International Preliminary Examining Authority; that Authority conducts the international preliminary examination which is essentially directed to the questions whether the claimed invention is new, involves an inventive step (is non-obvious), and is industrially applicable; the applicant and the Authority communicate with each other during the international preliminary examination and the applicant is given at least one opportunity to amend the claims, the description, and the drawings; then the international preliminary examination report is established; this report does not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to the law of any country; it merely states – by a "Yes" or "No" – in relation to each claim whether such claim

⁸ See, however, paragraph 61, below.

seems to satisfy the said three criteria and each such statement is accompanied by citations and other explanations; finally, the report and, where requested, copies of the documents cited therein which were not cited in the international search report are communicated to the applicant and the national Offices of the States in which the applicant wishes to use the international preliminary examination report ("elected States"). It is only then⁹ that the national fees (if any) and the translations (if there is a language difference) become due, and examination and other processing in the said national Offices ("the national phase") can start.

25. The international preliminary examination report is not published. The very fact that international preliminary examination has been demanded remains confidential. Possible withdrawal of the demand and the results of the international preliminary examination are equally confidential.

26. Any international preliminary examination report has to conform to the same standards, irrespective of the identity of the International Preliminary Examining Authority (see also paragraphs 33 to 35, below).

27. The Treaty makes no provision for the national phase except that it guarantees that it cannot start until at least the expiration of the 25th month after the priority date, and that the applicant must be given an opportunity, in each elected State, to amend the international application (claims, description, drawings). Otherwise, each State may maintain its present law, whether on the substance of patentability or on the procedure, as the Treaty contains no other requirements to which the national law has to conform.

Effects of the Second Phase

28. The only legal effect of using the Second Phase is – as already indicated – that the processing of the international application before the national Offices is delayed – that is, it cannot start – at least until the expiration of the 25th month after the priority date, that is, normally, until the international preliminary examination report has become available.

29. The practical effect of using the Second Phase is of the same kind – but to a greatly enhanced degree – as that of using the First Phase: national processing starts under very much more advantageous conditions both for the applicant and the national Offices than without the Treaty or with Phase I only of the Treaty. The applicant has, thanks to the international preliminary examination report, a strong indication of

his chances of obtaining patents. The elected Offices save most, if not practically all, of the effort of examination. All that remains for them to do, under normal circumstances, is to draw conclusions from the said report on the question of patentability in the light of the national laws.

Some Special Features of the Procedures under the Treaty

Optional Character of the Treaty

30. It is to be noted that no Contracting State can require that any foreign applicant seeking protection in that State seek the said protection through an international application under the Treaty rather than through a national application (as he does today where there is no international application). If protection in any Contracting State may be obtained in the form of a national patent or a regional patent, the State may decide that only a regional patent – and not a national patent – may be obtained through an international application. (Even in such a State, however, a national patent may be obtained through a national application.)

31. Furthermore, it is to be noted that, even where an applicant seeks protection through an international application, no Contracting State party also to Chapter II can require that the applicant use that Chapter, that is, no such State can require him to produce an international preliminary examination report.

32. Finally, it is to be noted that no Contracting State which is not bound by Chapter II can be forced to delay national examination and processing beyond 20 months from the priority date since no applicant could use the Phase II procedure in such a State.

International Searching and Preliminary Examining Authorities

33. It is expected that the International Patent Institute will be one of the International Searching and Preliminary Examining Authorities, that is, that it will establish both international search reports and international preliminary examination reports.

34. Furthermore, it is expected that some of the national Offices will be International Searching and/or Preliminary Examining Authorities. The Treaty prescribes criteria: minimum documentation, minimum staff, minimum language capacity. To date, the national Offices of six countries have indicated, unofficially, that they would probably wish to become International Searching and Preliminary Examining Authorities. They are: Austria, Germany (Federal Republic), Japan, Soviet Union, Sweden, United States. The United Kingdom Patent Office has indicated, unofficially, that it probably would wish to become an International Preliminary Examining Authority but not an International Searching Authority.

35. Although the Treaty aims at a single International Searching Authority, it is so drafted that the existence of several International Searching Authorities is assumed. The main reasons for this are of a practical nature: it is cheaper and easier to use the existing facilities than to boost those of the

⁹ However, if the international preliminary examination report is not completed by the end of the 25th month from the priority date, the national fees must be paid and the translations must be furnished by that date and the national processing may start without the said report (unless any national Office wants to wait longer, which it has the right to do). But since, in all typical cases, the international preliminary examination is completed by that time, this situation will rarely arise and the 25-month time limit merely serves the purpose of assuring elected Offices that they do not have to wait indefinitely. Furthermore, any country accepting Chapter II may make a reservation under which it can require the furnishing of a translation by the expiration of the same time limit as under Chapter I (i.e., 20 months from the priority date).

International Patent Institute; it is more convenient – at least to Austrian, German, Japanese, Soviet, Swedish and US applicants, as well as to applicants who are nationals of countries members of the International Patent Institute, that is, Belgian, British, French, Luxembourg, Monaco, Netherlands, Swiss and Turkish nationals – to be nearer to the International Searching Authority and to turn to services they are used to; international applications could probably not be filed either in the Japanese language or in the Russian language if they had to be searched in the International Patent Institute.

Length of the Procedure

36. The following paragraphs deal with the typical case – the case which may be expected to be the normal case. In non – typical cases, the procedure may take a shorter or a longer time than is indicated below.

37. All time limits relate to the priority date, which – it is recalled – means: (i) the filing date of an *earlier* application if the international application claims the priority of such an application, (ii) the filing date of the international application *itself* if that application contains no priority claim.

38. *Phase I.* – The international application is filed at the end of the 12th month. It is transmitted to the International Searching Authority and the International Bureau at the end of the 13th month. The international search is carried out during the next three months (the 14th, 15th and 16th), but in time for the international search report to be sent to the applicant in the course of the 16th month. The applicant has two months (the 17th and the 18th) to amend the claims, and the following two months (the 19th and the 20th) to prepare the required translations. (It is recalled that he will have to pay the national fees and furnish the translations at the earliest by the end of the 20th month.)

39. *Phase II.* – The applicant, having received the international search report by the end of the 16th month¹⁰ uses the 17th and 18th months to make up his mind whether to demand international preliminary examination. He files this demand by the end of the 18th month. The first written opinion issues two months later, by the end of the 20th month. The applicant has two months (the 21st and the 22nd) to reply to the opinion. The International Preliminary Examining Authority issues the report one month later, that is, by the end of the 23rd month. The applicant has the following two months (the 24th and the 25th) to prepare the required translations. (It is recalled that he will have to pay the national fees and generally furnish the translations at the earliest by the end of the 25th month.)

¹⁰ If international preliminary examination is demanded before the international search is started, and if it is the same International Authority which performs the international search and the international preliminary examination, the two procedures may be “telescoped” in part. The first opinion may issue at the same time as the international search report, that is, by the end of the 16th rather than the 20th month. The four months so gained may then be used to allow for a second written opinion and a second reply in the international preliminary examination phase.

Languages

40. Any *international application* has to be drawn up in a language which the competent International Searching Authority can handle. The national Offices in Moscow, Munich, Stockholm, Tokyo, Vienna and Washington would thus accept international applications drawn up in Russian, German, Swedish, Japanese, German and English, respectively. The International Patent Institute can handle international applications in Dutch, English, French and German. If Italy and a few Spanish-speaking countries become party to the Treaty, the International Patent Institute could probably undertake to handle international applications in Italian or Spanish, respectively.

41. The *international search report* and the *international preliminary examination* report are drawn up in the language in which the international application must be published.

42. *Translations* of the international application, when translations are required for the purposes of the national procedure, are prepared by the applicant. The international search report is translated into English only (it mainly consists of symbols and numbers only), whereas the international preliminary examination report is translated into any of six languages (English, French, German, Japanese, Russian, Spanish), as required by the elected Offices, under the responsibility of the International Bureau.

43. The *publication*, in pamphlet form, of the international application is effected in the language in which it was filed, if filed in English, French, German, Japanese, or Russian. If filed in another language, it is translated under the responsibility of the competent International Searching Authority and is published in English. If the international application is published in French, German, Japanese, or Russian, the abstract and the international search report appear in the pamphlet in two languages: the language of the international application and English. The first page of the pamphlet contains bibliographical data, a typical drawing (possibly reduced), and the abstract, to facilitate a quick appraisal and to make this frequently possible even when the language of the international application is unknown to the reader.

44. The *Gazette entry* in respect of each international application consists of these same three elements. The Gazette is published at least in English and French and also in additional languages for which the necessary subscriptions or subventions will be assured. German, Japanese and Russian will almost certainly, and Spanish probably, be among such languages.

45. *Availability of full translations to third parties.* – The International Bureau may obtain, upon request, from any designated or elected Office a copy of the translation of the international application furnished by the applicant to that Office. The International Bureau sells copies of such translations to third parties.

Fees

46. *First Phase.* – The filing of an international application is subject to the payment of one fee in any case, and possibly one or two additional fees.

47. The fee which is due in any case is called the “*international fee.*” It is intended to cover the expenses of the International Bureau, including the cost of preparing copies for the designated Offices, the cost of publication, and the cost of translating the abstract and the international search report, where required. Its amount depends on the number of the designated States and it increases if the international application contains more than 30 sheets.

48. The international fee consists of two parts: the “*basic fee*” amounting to US \$45.00 or 194 Swiss francs, and the “*designation fees*” amounting to US \$12.00 or 52 Swiss francs or, in certain cases, to US \$14.00 or 60 Swiss francs. As many designation fees are to be paid as there are States designated, provided that, where a regional patent is sought for certain designated States, only one designation fee is to be paid. If the international application contains more than 30 sheets, the basic fee is increased by US \$1.00 or 4.30 Swiss francs per sheet.

49. Each receiving Office may, if it wishes, charge a “*transmittal fee,*” intended to cover the expenses of formality checking and transmittal of copies of the international application to the International Bureau and the International Searching Authority.

50. The amount of such fee will probably never exceed US \$20.00 or 86 Swiss francs.

51. Each International Searching Authority may, if it wishes, charge a “*search fee*” for the work of performing the international search. Some national Offices *qua* International Searching Authorities may decide not to charge such a search fee at all. The International Patent Institute *qua* International Searching Authority will charge such a fee but whether all of it will be covered by the applicant or whether part of it may be covered by the subventions granted by the State of the applicant is a question to which the answer will probably vary from State to State”.¹¹

52. The question frequently asked is what is the minimum number of countries that ought to be designated to make the use of the possibilities offered by the Treaty “worthwhile.” It is believed that choosing or not choosing to file an international application does not generally depend on the designation of a particular minimum number of countries. It is worthwhile filing an international application if the applicant wishes to have more time for reflection, if he wishes to postpone the moment when he has to pay the cost of preparing translations and the national fees, and if he wishes to reduce or eliminate the number of national proceedings in which he would otherwise have to engage only to abandon them later if he lost interest in his international application or lost hope of its success. The essential

question is how much investment such advantages are worth. They may be worth something even if only one State is designated. For further considerations on the cost question, see paragraphs 98 to 114, below.

53. *Second Phase.* – The demand for international preliminary examination is subject to the payment of one fee in any case, and possibly one additional fee.

54. The fee which is due in any case is called the “*handling fee.*” It is intended to cover the expenses of the International Bureau, including the cost of preparing copies and translations of the international preliminary examination report for the national Offices of the various elected States. Its amount depends on the number of the languages – maximum six – into which the international preliminary examination report must be translated.

55. The handling fee is US \$14.00 or 60 Swiss francs if the said report requires no translations, and is augmented by the same amount for each of the six languages (English, French, German, Japanese, Russian, Spanish) for which, in the given case, a translation is required.

56. Each International Preliminary Examining Authority may, if it wishes, charge a “*preliminary examination fee.*” The situation is similar to that described in connection with the search fee (see paragraph 51, above).

Formalities

57. One of the most outstanding features of the Treaty is that the formalities of international application are laid down by the Treaty and the Regulations and are binding on all Contracting States. This reduces the cost to the applicant. Drawings do not have to be redrawn. The applicant knows that an international application which is good as far as form and contents are concerned in his home country is also good in any of the other Contracting States. Form and contents mean not only the physical requirements and the identification data but also the form and manner of describing and claiming.

58. It has been said that this very uniformity is dangerous as far as the form and manner of describing and claiming are concerned. The form and manner prescribed by the Treaty and the Regulations – say the same critics – may be contrary to the traditions, the judicial practice, and the idiosyncrasies of a country. (The form and manner are not, of course, contrary to the *laws* and *regulations* of any country, as every Contracting State has to accept the prescribed form and manner.) It is believed that this view is unduly pessimistic since, once the laws and regulations of a country accept the international form and manner, it does not seem to be unrealistic to presume that traditions, judicial practice, or idiosyncrasies, will adjust to the new form and manner. In any case, the applicant has the right to amend the claims, the description and the drawings before each national Office, and he may amend them before each such Office differently.

International-Type Search

59. The national law of any Contracting State may permit applicants to obtain from the competent

¹¹ The national Office of each designated State may, when the international application reaches it, require the payment of the usual *national fees.*

International Searching Authority a search conforming to the criteria provided for in the Treaty but carried out on their *national* applications (“international-type search”). Moreover, the national law of any Contracting State may subject any national application filed with its national Office to an international-type search. In such cases, the said International Searching Authority must, to the extent possible, use the results of the international-type search in establishing the international search report on the *international* application. In addition, the International Searching Authority must refund the search fee to the extent to which the international search report could be based on the results of the international-type search.

Reservations

60. It has been already stated that any Contracting State may declare that it shall not be bound by Chapter II (see paragraph 15, above) and that any Contracting State bound by Chapter II may declare that it will apply, for the purposes of furnishing translations and publishing them, the 20-month rather than the 25-month time limit (see footnote 9 under paragraph 24, above).

61. Three additional possibilities of reservations are provided for in the Treaty. One allows any Contracting State to declare that it does not require the international publication of international applications. Another allows any Contracting State to differentiate between an international filing date abroad and an actual filing date at home for prior art purposes. The third allows any Contracting State to refuse to recognize the jurisdiction of the International Court of Justice.

Brief Summary of the Information and Technical Assistance Features of the Treaty

Publication of International Applications and International Search Reports

62. It has already been stated that international applications, together with the international search reports relating to them, are generally published and that such publication occurs generally 18 months after the priority date of the application (see paragraphs 17 and 43, above). It is to be noted also that an international Gazette will be published once a week in several languages and will contain the bibliographical data, abstracts and typical drawings of each published international application as well as other useful information.

Patent Information Services

63. The Treaty provides that the International Bureau may furnish services by providing technical and other pertinent information available to it on the basis of published documents, primarily patents and published applications. Such information services may be provided by the International Bureau either directly or through International Searching Authorities or other national or international specialized institutions. The details will be fixed by the Assembly of the Contracting States. Among the types of information contemplated are: identification of documents relating to a certain technical field or

problem; identification of documents issued in different countries but relating to the same invention; identification of documents showing the same person as inventor or applicant; identification of patents in force or no longer in force at a given date in any given country.

64. The information services will be operated in a way particularly facilitating the acquisition by Contracting States which are developing countries of technical knowledge and technology, including available published know-how. Governments of developing countries should receive such information services below cost if the difference can be covered from profits or grants-in-aid.

Technical Assistance

65. The Treaty provides for the organization and supervision of technical assistance to developing countries in developing their patent systems individually or on a regional basis. For example, an existing industrial property office in a developing country could be assisted in becoming a channel for technical information to local industry by selecting for and forwarding to such industry all patent documents coming from abroad which are of possible interest to that industry in keeping abreast with technological developments throughout the world. Moreover, a national or regional industrial property office could be assisted in procuring the materials and training the manpower necessary for effecting a meaningful examination of the technical aspects of inventions. The Treaty itself provides that technical assistance comprises the training of specialists, the loaning of experts, and the supplying of equipment both for demonstration and for operational purposes.

66. For financing such assistance, the International Bureau will seek to enter into agreements with international financing organizations, the United Nations and agencies thereof, particularly the United Nations Development Programme.

The Treaty, the Regulations and Other Instruments

67. The provisions establishing the system and governing its application are or will be embodied, depending on their nature and their importance, in the following instruments: the Treaty, the Regulations, the Administrative Instructions, and agreements to be concluded by the International Bureau with each International Searching and Preliminary Examining Authority.

The Treaty and the Regulations

68. The most important matters are contained in the *Treaty*: the limits to the obligations of Contracting States; guarantees of their basic rights; basic obligations and guarantees of the basic rights of the applicants; the main duties of the International Bureau, the receiving Offices, and the International Searching and Preliminary Examining Authorities. Most of the provisions of the Treaty may be amended only in the way in which treaties are usually amended: the amendments are adopted by a special conference and come into effect only for those countries which ratify them. Since ratifications are by nature slow (because, in many States, they have to be processed

through legislative bodies), the Treaty provides, in the case of certain provisions, for a simpler and faster procedure for amendment. There are two sets of such provisions. One consists of the provisions fixing time limits. These can be modified by a unanimous decision of the Contracting States. The other consists of some of the purely administrative provisions, mainly those relating to the Secretariat and the finances of the International Patent Cooperation Union, which may be amended by the Assembly of that Union. As to the latter, it should be noted that the Stockholm Conference of 1967 provided for a similar solution for the Paris Convention and the Special Agreements under that Convention.

69. The *Regulations* are about twice as long as the Treaty. They include all the details which are believed to have any possible effect on, or be of any possible interest to, the applicant, the Contracting States, and the International Searching and Preliminary Examining Authorities. The Regulations may be amended by the Assembly. Amendment requires unanimity for certain specified provisions, unanimity during a five-year transitional period for certain other specified provisions, and a three-fourths majority for all the others. For certain provisions of special concern to International Searching and Preliminary Examining Authorities, amendment can be prevented by a veto on the part of any State whose national Office is such an Authority or, as far as the International Patent Institute is concerned, by the veto of a specified member State of that Institute.

Administrative Instructions and Agreements

70. The *Administrative Instructions* will pick up those minutiae which have no effect on the rights and obligations of anybody but which are useful because they introduce order and uniformity into official procedures. Where to place a stamp, how to draft forms transmitting documents, how to route papers – these are typical subjects which the Administrative Instructions will deal with. They will be drawn up by the International Bureau under various safeguards, including the right of the Assembly of the Contracting States to impose the introduction of modifications.

71. *Agreements with International Searching and Preliminary Examining Authorities.* – These agreements will see to it that the international search and the international preliminary examination will be carried out in strict conformity with the Treaty and the Regulations. Furthermore, they will provide for other procedural and administrative details required to ensure smooth cooperation among the authorities whose joint efforts are necessary to make the system work. The agreements, as far as the International Bureau is concerned, will require approval by the Assembly of the Contracting States. As far as the other party to each agreement is concerned, the question of approval is a matter for such party. For example, the International Patent Institute will probably have to obtain the approval of its Administrative Council before it can become bound by any such agreement.

72. The Administrative Instructions and the agreements in question will be drawn up just before

the Treaty becomes operational, that is, once the required number of ratifications or accessions has been obtained.

Entry Into Force

73. The Treaty will enter into force after at least eight States have accepted it through ratification or accession. Four of these States must satisfy specified statistical conditions placing them among the States with the highest numbers of applications.

The Treaty and Other Efforts for International Cooperation in the Patent Field

74. The drafters of the Patent Cooperation Treaty found much inspiration in the plans and achievements of the last two decades in the field of international patent cooperation.

75. The International Patent Institute and the International Patent Classification are, in themselves, elements without which it would be much more difficult to imagine the system.

76. Work on the “European Patent” plan and the Nordic Patent Application System, as well as the work of the Council of Europe, were constantly kept in mind when preparing the Treaty.

77. It should be emphasized, however, that the Treaty is fundamentally different from the only existing system and all the planned systems of international cooperation in the field of patents.

78. The only existing system is that instituted by the Libreville Agreement of 1962 concerning the constitution of the African and Malagasy Industrial Property Office. Under that system, the said Office grants patents valid in all its member States (presently 13).

79. Under the Nordic System, a patent granted on a Nordic patent application by the national Office of one of the four Nordic countries (Denmark, Finland, Norway, Sweden) would be a patent also in two or three of the other Nordic countries as designated.

80. The “Intergovernmental Conference for the Setting Up of a European System for the Grant of Patents” (Conférence intergouvernementale pour l’institution d’un système européen de délivrance de brevets) plans the conclusion of a Convention under which a European patent would be granted by an international body (the “European Patent Office”) with effect in a group of European States. Whereas the effect of this European patent in the said States would be governed by national laws, the six States members of the European Economic Community (Belgium, France, Germany (Federal Republic), Italy, Luxembourg, Netherlands) intend to conclude an additional Convention which would make the European patent uniform in its effects for the territory of the said six States.

81. The African, the Nordic and the European plans have this much in common, that they provide for *the grant* of a regional patent. The additional Convention envisaged by the “Six” in Europe is expected to contain also a series of provisions for the period *after* the European patent is granted (rules on duration, nullity, compulsory and other licenses, rules on infringement and its repression). The Patent

Cooperation Treaty deals with none of these subjects. It does not provide for the grant of patents. Nor does it contain rules on matters arising after the grant. Under the Treaty, only part of the pre-grant procedure is international. The grant itself and everything that follows remain under the exclusive national sovereignty of each Contracting State.

82. Thus, the scope of the Patent Cooperation Treaty is much narrower than that of the systems which deal with regional patents. It deals only with the filing of the international application and provides for aids for the national examination to be carried out once the application reaches the Contracting States. Furthermore, for its implementation, the Treaty relies entirely on existing institutions, namely, the national Offices, the International Patent Institute, and the International Bureau of the World Intellectual Property Organization (WIPO).

83. Notwithstanding the differences between the Patent Cooperation Treaty, on the one hand, and the Libreville Agreement as well as the plans of the European and Nordic countries, on the other hand, the Patent Cooperation Treaty is not in conflict with either the Libreville Agreement or the said plans. The Libreville Agreement will continue undisturbed and the plans of the European and Nordic countries may be put into effect before or after the Patent Cooperation Treaty becomes operational.

PART II

MAIN ADVANTAGES OF THE PATENT COOPERATION TREATY

84. This Part of the present document enumerates the expected main advantages of the Patent Cooperation Treaty for examining Offices, for both examining and non-examining Offices, for the inventor or applicant, for developed countries, for developing countries, for technological information in general, for the public, and for the patent system in general.

85. Under the chapter dealing with the advantages for the inventor and the applicant, an analysis of the expected impact of the Patent Cooperation Treaty on the cost of patent prosecution is attempted.

Advantages for Examining Offices

86. Examining Offices are able to make substantial economies since the system renders superfluous, for most applications filed by foreigners, all or most of the work of searching, and also – when an international preliminary examination report issues – most of the work of examination. In the overwhelming majority of countries, such applications exceed in number applications filed by nationals. Japan and the United States are among the rare exceptions but, in these countries, the absolute number of foreign applications is in itself impressive (28,000 and 31,000, respectively, in 1969) and has been approached or exceeded in only four countries (38,000 in the United Kingdom, 34,000 in Germany (Federal Republic), 32,000 in France, and 30,000 in Canada). Some of the Socialist countries are also among the exceptions but, owing presumably to the recent

intensification of East-West trade and expanding scientific and technical cooperation, the number of foreign applications filed in those countries is constantly and rapidly growing. In the Soviet Union, for example, the number has more than tripled within the past five years.

87. Even national Offices which are distrustful – and, in the beginning, they might well be – as to the quality of the international search reports and preliminary examination reports, and which subject them to a certain control, have a “flying start” in their work, since such work is rather in the nature of completing, checking and criticizing than starting from scratch in complete isolation as national Offices do at present.

Advantages for Both Non-Examining and Examining Offices

88. Both kinds of Offices make economies in the cost of handling applications, since their work of verification as to compliance with prescriptions of form becomes practically superfluous.

89. Both kinds of Offices can save part of the cost of publishing. If the international publication is in their national language, they can forgo republication altogether, or they can decide to publish only the abstracts in their national gazettes. This solution may be chosen even by countries which have a different language: they may find it sufficient to publish, in their national language, abstracts only, and to keep the complete translations in their files, copies of which may then be ordered by anyone who becomes interested on the basis of the abstracts or the full foreign texts.

90. The system does not reduce the revenues of the national Offices unless they voluntarily decide to give a rebate on national fees in consideration of the savings they make through the Treaty and in order to make the use of the international application route more attractive to the applicant. Such rebates would be more than offset by savings in expenditure thanks to the Treaty. In any case, the most “profitable” source of revenue of most national Offices is the annual fees or renewal fees. The Treaty does not touch those fees either, unless, again, voluntary rebates are accorded.

Advantages for the Inventor or Applicant

91. Applicants – that is, inventors or their employers or assignees – may file their applications in their own country with effect in foreign countries, have more time to make up their minds as to those foreign countries in which they want to seek protection, and in a typical case they have to spend much less money in the pre-grant (or pre-denial) stage than at present.

92. If the applicant is not following the international procedure offered by the Treaty, he must start preparations for filing abroad three to nine months before the expiration of the priority period. He must prepare translations of his application and must have them put in a more or less different form for each country. Under the Treaty, the applicant, within the priority year, makes only one

application (the international application), which may be identical both as to language and form with his own national application, or which involves one – and only one – translation and redrafting. True, the cost of further translations has to be met eventually, but not until eight or more months later than under a procedure which does not use the Treaty, and only if, having seen the international search report, the applicant is still interested in the countries concerned. Moreover, the – even greater – cost of redrafting (recasting as to form and expression) for each and every country does not arise, even later, or arises only to a limited extent (when the claims or the description are amended).

93. The international search report helps the applicant to make up his mind whether it is worth while continuing his efforts. If he decides that it is not, he saves all subsequent costs, including the fee for a demand for an international preliminary examination report.

94. The international preliminary examination report also helps the applicant to make up his mind whether to press for patents and, if the report is unfavorable, he will think twice before he does.

95. All applicants residing near an International Preliminary Examining Authority are able to conduct their dialogue concerning the issuance of the international preliminary examination report in their own *language* and with the Authority with which they are most familiar and which is geographically near.

96. Even those applicants not residing nearby will frequently be able to use an International Authority in which they have special confidence, and which may be nearer than most of the countries in which they seek protection. They will deal in a language which may not be their own but, in any case, will be a world language generally known in scientific and technological circles.

97. It is true that, where complications arise, the applicant may have to operate, as he does without the Treaty, in unfamiliar and distant Offices and in languages with which he is totally unfamiliar. But by that time he has in his arsenal an international search report and possibly an international preliminary examination report, both of international standing. He, too, has a “flying start.”

98. *Expected Impact of the Treaty on the Cost of Patent Prosecution.* – In the following paragraphs (99 to 114), an estimate is attempted of the impact of the Treaty on the cost of patent prosecution up to grant. “The PCT route” denotes using the Treaty, whereas “the traditional route” means using the method of filing separately in each country in which protection is sought.

99. For both routes, only those cost factors are considered which arise up to the grant of patents or the refusal of such grant. Consequently, costs which arise at the time of the grant (granting fees, publication fees) or after (annual fees or renewal fees) are not considered. Neither are the costs considered which may possibly arise on account of certain complications during the prosecution – such as defense in certain States in the case of opposition or, in the United

States, in the case of interference – since these costs may arise both under the PCT (in the national phase) and under the traditional route.

100. In calculating the costs, what may be regarded as the typical case will be considered and a few assumptions have to be made, although it is recognized that there will always be non-typical cases in which the calculations may yield different results.

101. Among the assumptions to be made are those concerning the amounts of the fees. Taking the fees for which amounts are specified in the PCT Regulations, the international fee (for a 30-sheet application) is \$45.00 for the basic fee and \$14.00 per country for the designation fee, as it is expected that most designated States will require the furnishing of a copy under Article 13. It is assumed that the transmittal fee (which, according to preliminary calculations, should be between \$10.00 and \$20.00, if it is to cover all the costs of the receiving Office) will be \$15.00.

102. It is more difficult to determine the probable amount of the search fee since great variations are expected. This fee may be zero in a country like the Soviet Union, or it may be relatively low (probably between \$25.00 and \$50.00) in other countries where national Offices will be International Searching Authorities, and it may be higher (perhaps between \$100.00 and \$150.00) when the International Searching Authority is the International Patent Institute. It is emphasized that these amounts are not based on any indications from the prospective International Searching Authorities – which have not yet fixed their fees – but merely on what would seem to be possible in view of their present fee structures and subsidizing policies *in the absence of* the Treaty. In the following paragraphs, a \$100.00 search fee will be assumed in order to make the calculation roughly applicable also in cases where the international search will be carried out in the International Patent Institute. Where that search is carried out in other Authorities, the figure, and the world average, would probably be much below \$100.00.

103. Furthermore, on the basis of an extensive international survey carried out by the International Bureau, it is assumed that under the traditional route the average cost of prosecuting an application up to grant is \$350.00. This cost comprises the honoraria of the patent agent or attorney for preparing the application (when it is a first application) and transforming and translating it (when it is a subsequent application). It is realized that a first application usually costs more because the creative work needed is greater but, since the cost of translation in subsequent applications is usually considerable, the average may be acceptable for the purposes of a rough calculation. It is assumed further that, whereas the honoraria under the PCT route will be somewhat higher for the international application (including its prosecution in one country), say \$400.00, mainly because of the increased responsibility of the attorney or agent, they will be lower – perhaps by as much as one-third – for the prosecution in the national phase (because some of the

work will not have to be repeated or is more in the nature of routine as it is based on common rules), say \$250.00.

104. It is also assumed, on the basis of the extrapolated results of the said survey, that an estimated 20% of the international applications will be withdrawn before they enter the national phase. Withdrawals will be prompted not only by unfavorable search reports but also by the mere passing of time, since between the 12th and the 20th month the applicant may lose interest in trying to obtain patents for various reasons, including the realization of the fact that he will not be able to exploit his invention commercially.

105. Furthermore, it is assumed that the number of designated States is seven. This, again, is based on the statistics of present averages concerning the number of countries in which protection is sought for any given invention. It does not take into account the expected impact of the availability of the PCT route, an impact which will probably mean a certain increase in the number of such countries.

106. Finally, it is assumed that the national fee (called in some countries "filing fee," and including, where such fee exists in countries having a deferred examination system, the national "search fee") is \$50.00 per country.

107. On the basis of the above assumptions – and dealing only with Phase I – the comparative cost factors are the following:

108. <i>Costs under the traditional route:</i>	US\$
108.1 Honorarium for first application	350
108.2 Honoraria for six additional applications 6 x \$350	2,100
108.3 National fee in seven countries: 7 x \$50	350

Total	2,800

109. <i>Costs and saving under the PCT route:</i>	US\$
109.1 <i>Cost:</i> Honorarium for international application and prosecution in one country	400
109.2 <i>Cost:</i> Honoraria for prosecutions in the national phases in six countries: 6 x \$250	1,500
109.3 <i>Cost:</i> Fees under the PCT (international fee: \$45 + (7 x \$14.00)= \$143.00; transmittal fee: \$15; search fee: \$100); total: 143 + 15 + 100 =	258
109.4 <i>Cost:</i> National fees in seven countries: 7 x \$50	350
(The subtotal of costs, <i>without savings</i> , is thus 400 + 1,500 + 258 + 350 = 2,508, i.e., 10% less than the costs under the traditional route.)	
109.5 <i>Saving:</i> Withdrawal, that is, 20% of the honoraria in six countries (20% of \$1,500 = \$300) (any saving in the	

honorarium in the home country disregarded) and of the national fees in seven countries (20% of \$350 = \$70): \$300 + 70 = -370

109.6 *Saving:* 8 months' interest (6% *per annum* i.e., 4% for 8 months) on the remaining 80% of the honoraria (80% of \$1,500 = 1,200) and national fees (80% of \$350 = \$280), since they will become due 8 months later than under the traditional route because of the 20-month waiting period in the PCT: 4% of 1,200 + 280 = 4% of 1,480 = . -59
(The subtotal of savings under the PCT route is thus 370 + 59 = 429.)

(Deducting the savings (\$429) from the costs (\$2,508) the result is \$2,079.)

110. <i>Difference of costs under the two routes:</i>	
Costs under the traditional route	2,800
Costs, after deduction of savings, under the PCT route	2,079

Difference	721

111. In other words, the PCT route will cost, to the applicant, approximately 26% less than the traditional route. This percentage of savings will become higher if the number of designated States increases, as it probably will, not only because of the other advantages of the Treaty but also because of the ever growing internationalization of trade.

112. The impact of the international preliminary examination will probably be similar. The international preliminary examination fee and the honorarium for the prosecution of the international application before the International Preliminary Examining Authority will be a factor increasing the cost but it will cause more savings than Phase I alone since the withdrawals will probably be more frequent and/or the honoraria in the national phases – because of the better preparation in the international phase – somewhat lower.

113. It is emphasized, once again, that the above considerations apply to a typical case or rather represent the *average* result of typical cases going through Phase I only. Any individual case may lead to other results which may sometimes be very different. For example, if any individual application is maintained in *all* the designated States and if full use is *not* made of the 20-month waiting period, some of the potential savings (savings in honoraria) will materialize, others (interest) might, and still others (savings on account of withdrawals) will not. On the other hand, if the international search report or the mere passing of the additional 8-month period available for reflection or any other circumstance (such as loss of interest in the invention, loss of potential licensees) prompts the withdrawal of the international application, the savings will affect not 20% but 100% of the national fees and honoraria, which, in the above calculation, will mean a net saving of some 85% of the cost of the traditional route.

114. Finally, it is recalled that the savings analyzed above represent only one of the several advantages which the PCT route represents for applicants and inventors.

Advantages for Developed Countries

115. Developed countries have relatively large numbers of inventors. They would constitute the majority of the applicants filing international applications. The savings achieved for the applicant described above, as well as the savings of national Offices through the utilization of the international search and preliminary examination reports accompanying the applications filed by foreign applicants, will certainly more than counter-balance expenditure for the establishment and maintenance of the services provided for by the Treaty and may even save an outflow of money from their countries.

116. By allowing stronger patents to be obtained (particularly in non-examining countries) with less effort and cost, the Treaty will induce inventors to seek protection in more countries, and for more inventions than at the present time. This would expand the export and foreign investment potential of the developed countries to which those inventors belong.

Advantages for Developing Countries

117. Most developing countries have a non-examining system. Whereas in developed countries the chances of granting worthless patents are diminished by the expertise both of the patent attorneys or agents assisting the applicant and of the courts, in many developing countries these safeguards are to a large extent missing. The need for examination is thus greater in developing countries but, because of the scarcity of technically trained persons and adequate documentation, and because of the high cost of examination, such countries are even less in a position to introduce an examining system – even if they joined efforts on a regional basis – than developed countries. In this respect the Treaty is especially helpful to developing countries in overcoming these problems so that they may develop and perfect their own patent systems.

118. The Treaty offers a clear and simple interim solution, at least until such time as developing countries perfect their own patent systems, to the problem which a notable report of the United Nations Secretariat called the “dilemma (of the Governments of most developing countries) between the dangers of a distorted patent system and the practical difficulty, if not impossibility, of marshalling the broad range of highly qualified technicians and scientific source materials which would be needed to permit an adequate novelty search” (UN document E/4319 of March 27, 1967, page 24).

119. The solution resides in the fact that, under the Treaty, developing countries do not need the persons and materials to make a novelty search because such a search – and, even more, the international preliminary examination – will be effected by the International Searching and Preliminary Examining Authorities; the solution further resides in the fact that their patent

systems will not be “distorted” because international applications accompanied by international preliminary examination reports give a high degree of reliability to their patent grants. In fact, their patents will generally be just as reliable, justified and strong as those of the most developed countries having the most sophisticated corps of patent examiners.

120. Naturally, the system offered under the Treaty not only protects developing countries against granting patents to foreign applicants who do not deserve them and who could thus have imposed “unjustified monopoly restrictions” (*ibidem*) on their national economy, but it also ensures that their own inventors and industrialists receive patents on which they can rely and which do not crumble when foreign competitors attack them or enter the market.

121. Developing countries, by being able to offer meaningful protection to foreign entrepreneurs owning patented technology, will find such foreign entrepreneurs more willing to transfer (sell or license) the said technology and will, in general, attract more foreign investment. The industrialization of such countries will thereby be accelerated.

122. Developing countries will derive a special benefit from the Treaty as far as technical documentation is concerned. Assembling and using the world’s patent literature – a source *par excellence* of recent and valuable technological information – is costly and unwieldy and presents practically insuperable language problems. The Treaty will make available, in the form of international applications accompanied by international search reports and possibly also international preliminary examination reports and easy-to-handle technical abstracts, the cream of the inventions, classified according to branches of technology, and in world languages.

123. Provisions in the Treaty on technical services will particularly or exclusively benefit developing countries.

124. The patent information services, described above (paragraphs 63 and 64), although useful also to developed countries, will be particularly useful to developing countries as the Treaty expressly provides that they must be operated in a way particularly facilitating the acquisition by developing countries – provided they are party to the Treaty – of technical knowledge and technology, including available published know-how.

125. The technical assistance provided for in the Treaty and described in paragraphs 65 and 66, above, is, of course, for the special and sole benefit of developing countries.

Advantages for Technological Information in General

126. The problems described in paragraph 122, above, are perhaps not insuperable for developed countries. But even for them, the Treaty will, as a kind of by-product, make access to most of the patent literature very much easier and cheaper than under existing conditions.

127. Similar considerations apply to the patent information services referred to in paragraphs 63 and 64, above.

Advantages for the Public

128. The Treaty gives substance to the much quoted principle according to which applicants are granted patents in exchange for disclosure. In the present system, such disclosure frequently does not occur until many years after the date of the application, that is, at a time when it no longer reveals anything new. Under the Treaty, this can happen only in the most unusual circumstances, that is, when all of the designated States are States that have declared that they do not require the international publication of international applications. In most cases, at least one of the designated States is a State that has not made such a declaration. In all such cases, disclosure takes place in the form of the international publication of the international application in one of the world languages, with abstracts at least in English and French and probably other languages as well, promptly after the expiration of 18 months from the priority date.

129. Naturally, the patent information services provided for in the Treaty will also be available and thus of advantage to the public.

Advantages for the Patent System in General

130. The patent system, as it exists today, is much criticized. It is said to be wasteful of human talent, to be expensive and slow, and to yield in the various

countries patents of such differing value that they do not even deserve to be called by the same name.

131. No attempt is made here to form a judgement on those accusations. But it is beyond doubt that the Treaty, by eliminating considerable duplication of effort, eliminates useless operations and reduces the cost of prosecuting applications. It is also certain that the Treaty generally shortens the time required for examination and the grant of patents and thus also shortens the period during which the applicant, would-be licensees, and competitors are in a state of uncertainty, not knowing whether patents will be granted or not. It is also to be anticipated that the Treaty will make the value of patents more uniform.

132. Should the Treaty succeed – as it is designed to succeed – in making the seeking and granting of patents simpler and cheaper, and in making the value of patents granted by different countries more similar and, generally, stronger, not only will the criticisms levelled against the existing situation be answered, but the patent system itself will become more useful. It will then be accepted in countries which are skeptical about its general usefulness, and it will be put to better use in countries where it exists. All this should contribute to the development of technological progress, which is so urgently needed to improve the living conditions of most of mankind.

MAIN DIFFERENCES BETWEEN THE 1969 DRAFTS AND THE TREATY AND REGULATIONS

PCT/PCD/3
WIPO/BIRPI

October 16, 1970 (Original: English)

Introduction

1. For the purpose of the present document, “the Draft Treaty” and “the Draft Regulations” mean the Draft Patent Cooperation Treaty (PCT) and the Draft PCT Regulations as contained in documents PCT/DC/4 and 5, respectively, both of July 11, 1969, whereas “the Treaty” and “the Regulations” mean the Treaty and the Regulations as adopted by the Diplomatic Conference in Washington and signed on June 19, 1970.

2. The aim of the present memorandum is to enumerate the *main* differences of *substance* between the Drafts on the one hand and the Treaty and the Regulations on the other hand. Minor differences of substance and differences in presentation or style are not mentioned. Furthermore, if a change in one of the provisions involves one or more consequential changes, the difference is generally mentioned in connection with what is believed to be the most important *locus*, whereas some or all of the consequential changes may not be mentioned at all.

Main Differences in the Treaty

3. *Preamble.* – In contrast to the Draft Treaty, the Treaty contains a preamble. It enumerates the aims for the attainment of which the Contracting States have concluded the Treaty.

4. *Purpose of Applications.* – The Draft Treaty spoke about applications for patents (Article 1(1)). The Treaty speaks about applications for the protection of inventions (Article 1 (1)). This change was motivated by the desire to place forms of protection other than patents, particularly inventors’ certificates, on the same level as patents.

5. *Technical Services.* – Whereas the Draft Treaty spoke only about one aim, namely, cooperation in the filing, searching and examination of applications (Article 1(1)), the Treaty also speaks about the aim of rendering special technical services (Article 1(1)). The means for attaining the second aim are specified in Articles 50 and 51 of the Treaty.

6. *References to Regional Arrangements.* – Whereas the Article on definitions (Article 2) in the Draft Treaty equated regional and national institutions only as far as Offices were concerned (item (i)), the Treaty extends this equating also to the notions of application, patent and national law (items (vi), (ix), (x), and (xii)). The origins of such provisions were in Article 44 of the Draft Treaty.

7. *Significance of Abstract.* – It is the Treaty itself which provides that the abstract merely serves the

purpose of technical information (Article 3(3)). In the Drafts this idea was mentioned in the Draft Regulations and merely incidentally (Rule 8.3(ii)).

8. *Application for Regional Patents.* – The Treaty expressly deals with the possibility of asking for regional patents (Article 4(1)(ii)), whereas the Draft Treaty did not.

9. *Naming of the Inventor.* – Whereas the Draft Treaty required that the inventor be named in the international application (Article 4(1)(iii)), that requirement is maintained in the Treaty only where the national law of at least one of the designated States requires that he be named at the time of filing a national application (Article 4(1)(v)). Otherwise, the name of the inventor may be furnished later or not at all, depending on the national law of the designated State (Articles 4(1)(v), 4(4) and 22(1)).

10. *Priority Claim Based on Applications for Inventors’ Certificates.* – In connection with any priority claim based on a national application, the Draft Treaty merely referred to the Paris Convention, whereas the Treaty refers to the Stockholm Act of the same Convention (Article 8(2)(a)). It thus clearly establishes the obligation for each Contracting State to recognize priority claims based on earlier applications for inventors’ certificates (cf. Article 4, Section I, of the Stockholm Act).

11. *Persons Who May File.* – According to the Draft Treaty, the Assembly could decide to allow residents or nationals of specified States other than Contracting States to file international applications (Article 9(2)). According to the Treaty, the Assembly may make such a decision only in respect of residents or nationals of States party to the Paris Convention (Article 9(2)). (Residents and nationals of Contracting States have the right to file international applications without the Assembly’s authorization.)

12. *Effect of International Filing.* – The Draft Treaty provided that the international application had the effect of a regular national application in each designated State as of the international filing date (Article 11(3)). The Treaty contains a clarification to the effect that the international filing date is to be considered to be the actual filing date in each designated State (Article 11(3)). The same provision of the Treaty also refers to a possible exception to this principle. That exception enables any Contracting State to make a reservation with respect to the time from which the prior art effect operates and is contained in Article 64(4) of the Treaty. It appeared also, in its essence, in the Draft Treaty (Article 27(5)),

last sentence), but did not require an express reservation.

13. *International-Type Search.* – According to the Draft Treaty, an international-type search of a national application required not only the permission of the national law applied by the receiving Office but also the initiative of the applicant (Article 15(5)). Under the Treaty, the said initiative is not necessary as international-type search may also be ordered *ex officio* (Article 15(5)(b)).

14. *Reference to the International Patent Institute.* – Whereas the Draft Treaty did not refer expressly to the International Patent Institute, the Treaty does so, naming it as one of the possible International Searching Authorities (Article 16(1)).

15. *Establishment of a Single International Searching Authority.* – The Treaty speaks about the existence of several International Searching Authorities “pending the establishment of a single International Searching Authority” (Article 16(2)). It does not set any time limit for the establishment of the single Authority. The Draft Treaty contained no provision similar to that quoted above.

16. *Lack of Unity of Invention.* – The Draft Treaty provided that in case of lack of unity of invention the International Searching Authority would invite the applicant either to restrict the claims or to pay additional fees (Article 17(3)(a)). Under the Treaty, in the same situation, the Authority will search the main invention and invite the applicant to pay additional fees for the searching of the other inventions (Article 17(3)(a)).

17. *Amendments Going Beyond the Disclosure.* – Whereas both the Draft Treaty and the Treaty provide that amendments of the claims before the International Bureau may not go beyond the disclosure (Article 19(2)), only the Treaty provides that non-compliance with this prohibition has no effect in any designated State which permits amendments to go beyond the disclosure (Article 19(3)). This principle was not expressly provided for in the Draft Treaty.

18. *Availability of Copies of Cited Documents.* – The Treaty provides that, at the request of the designated Office or the applicant, the International Searching Authority will send to it or to him, respectively, copies of the documents cited in the international search report (Article 20(3)). The Treaty provides for a similar obligation for the International Preliminary Examining Authority in respect of documents cited in the international preliminary examination report and not cited in the international search report (Article 36(4)). There were no such provisions in the Draft Treaty.

19. *Consequences of Possible Loss of Effect of the International Application in a Designated State.* – The Treaty makes it clear that these consequences are the same as the consequences of the withdrawal of any national application in that State (Article 24(1)). This clarification was missing in the Draft Treaty.

20. *Compulsory Representation by Local Agent.* – The Treaty makes it clear that national Offices may require that applicants be represented by agents having

the right to practice before them and have a local address for the purpose of receiving notifications (Article 27(7)). Such a clarification was missing in the Draft Treaty.

21. *Amendments in the National Phase.* – The Treaty provides, as did the Draft Treaty, that the applicant must be given an opportunity to amend his international application before the designated and elected Offices (Articles 28(1) and 41(1)). The Treaty also states a necessary corollary to this principle, namely, that no designated or elected Office may grant a patent, or refuse the grant of a patent, before the time limit allowed for amendment has expired (except with the express consent of the applicant) (Articles 28(1) and 41(1)). Furthermore, the Treaty also makes it clear that amendments in the national phase must be in accordance with the national law of the designated or elected State in all respects not provided for in the Treaty and the Regulations (Articles 28(3) and 41(3)). These clarifications were missing in the Draft Treaty.

22. *Persons Who May Demand International Preliminary Examination.* – According to the Draft Treaty, only residents and nationals of Contracting States bound by Chapter II were entitled to demand international preliminary examination (Article 31(2)). The Treaty provides that persons who are entitled to file international applications may demand international preliminary examination even if they are residents or nationals of a State not party to the Treaty or not bound by Chapter II where the Assembly of the International Patent Cooperation Union so provides (Article 31(2)(b)), and that such residents or nationals may elect any Contracting State bound by Chapter II which has declared that it is prepared to be elected by such applicants (Article 31(4)(b)).

23. *Regional Treaties Which May Provide That Regional Patents May Be Sought Through International (PCT) Applications.* – The Treaty provides, in effect, that only such regional patent treaties may provide for the application for regional patents via the PCT route as give the right of filing regional applications to all persons who are entitled to file international (PCT) applications (Article 45(1)). For example, the European Patent Conventions may allow the filing of PCT applications for the obtaining of regional patents only if such Conventions allow any person who may file PCT applications to file European patent applications. There was no such limitation in the Draft Treaty.

24. *Limiting the Use of International Applications to the Obtaining of Regional Patents Where, Through National Applications, National Patents Could Be Obtained.* – The Treaty provides, in effect, that the national law of any State party to both the Treaty and a regional patent treaty may allow the use of international (PCT) applications only for the obtaining of a regional patent and not for the obtaining of a national patent (Article 45(2)). There was no such limitation in the Draft Treaty.

25. *Patent Information Services.* – The Treaty provides that the International Bureau may furnish information services on the basis of published documents, primarily patents and published

applications, and that such services must be operated in a way particularly facilitating the acquisition of technology by developing countries. These services are provided for and several details are fixed in Article 50 of the Treaty. There were no corresponding provisions in the Draft Treaty.

26. *Technical Assistance.* – The Treaty provides for the establishment of a Committee for Technical Assistance with the task of organizing and supervising technical assistance to developing countries in developing their patent systems individually or on a regional basis. The establishment of the Committee is provided for and several details, particularly the financing of the technical assistance programs, are fixed in Article 51 of the Treaty. There were no corresponding provisions in the Draft Treaty.

27. *Financing of Information Services and Technical Assistance.* – The Treaty provides that nothing in Articles 50 and 51 shall affect the financial provisions of the Treaty (Article 52). There was no corresponding provision in the Draft Treaty.

28. *Executive Committee.* – The Treaty contains more details on the organization and the tasks of an Executive Committee to be elected by the Assembly of the International Patent Cooperation Union than did the Draft Treaty. See, in particular, Article 54 of the Treaty.

29. *Committee for Technical Cooperation: Composition.* – The Treaty provides that the Assembly shall determine the composition of such a Committee, with due regard to an equitable representation of developing countries (Article 56(2)(a)). There was no such provision in the Draft Treaty.

30. *Committee for Technical Cooperation: Tasks.* – As to the tasks of the Committee, the Treaty specifies that they will also include giving advice and making recommendations as to the solution of the technical problems specifically involved in the establishment of a single International Searching Authority (Article 56(3)(iii)). There was no such provision in the Draft Treaty.

31. *Amendment of the Regulations.* – The Draft Treaty provided that the Assembly could, in cases where no stricter requirements were prescribed, amend the Regulations by two-thirds of the votes cast (Article 54(2)(b)). The Treaty raised this proportion to three-fourths (Article 58(2)(b)).

32. *Disputes.* – The Treaty provides for the jurisdiction of the International Court of Justice (Article 59) but allows any Contracting State not to accept the stipulation of such jurisdiction (Article 64(5)). Neither provision appeared in the Draft Treaty.

33. *Initial Entry Into Force of the Treaty.* – The Treaty provides that it shall enter into force upon ratification or accession by eight States, provided at least four of them each meet certain statistical requirements as to the number of applications filed in that State, or fled by its residents or nationals abroad, according to the most recent annual statistics (Article 63(1)). The Draft Treaty provided for a smaller number of States (five or seven) and a

somewhat different combination of the statistical conditions (Article 58(1)).

Main Differences in the Regulations

34. *Declaration of Priority in Request.* – The Regulations provide that the declaration of priority referred to in Article 8(1) shall be made in the request (Rule 4.10(a)). The Draft Regulations did not contain any express provision to that effect.

35. *Description: Statement on Exploitation in Industry.* – The Regulations provide that, among other things, the description must indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry and the way in which it can be made and used, or, if it can only be used, the way in which it can be used (Rule 5.1(a)(vi)). The corresponding provision in the Draft Regulations provided that the description must indicate the way in which the subject of the invention can be made and used in industry, or if it can only be made or only be used, the way in which it can be made or used (Rule 5.1(a)(vi)).

36. *Dependent Claims.* – The provisions on dependent claims are more precise in the Regulations (Rule 6.4) than they were in either of the two alternatives of the Draft Regulations (Rule 6.4). Furthermore, the Regulations allow reference to multiple dependent claims in the alternative (Rule 6.4(a)).

37. *Claims: Utility Models.* – The Regulations provide in effect that the rules on claims may be set aside in the national phase if the international application is eventually for a utility model (Rules 6.5 and 78.3). There was no corresponding provision in the Draft Regulations.

38. *Unity of Invention.* – The question which claims of different categories may be combined without destroying unity of invention merely on account of such combination is answered with more precision in the Regulations (Rule 13.2) than it was in either of the two alternatives of the Draft Regulations (Rule 13.2).

39. *Unity of Invention: Utility Models.* – The Regulations provide in effect that the rules on unity of invention may be set aside in the national phase if the international application is eventually for a utility model (Rules 13.5 and 78.3). There was no corresponding provision in the Draft Regulations.

40. *International Search Fee: Partial Refund.* – The Regulations provide, under certain conditions, for the partial refund to the applicant of the international search fee when it is paid in respect of an invention which has already been the subject of an international search (Rule 16.3). There was no corresponding provision in the Draft Regulations.

41. *Translation of the Priority Document.* – The Regulations set a time limit (the same as that under Articles 22 and 39, that is, generally, 20 or 25 months, respectively, from the priority date) before the expiration of which a designated or elected Office cannot require that the applicant furnish a translation

of any priority document (Rules 17.2(a) and 76.4). The Draft Regulations contained no such provision.

42. *Minimum Documentation.* – The rule on minimum documentation (Rule 34) is more detailed in the Regulations than it was in the Draft Regulations, in particular as far as Japanese and Russian language patent documents, and English, French and German language patent documents of States which were not covered by the Draft Regulations, are concerned.

43. *Minimum Requirements for International Searching Authorities.* – The Regulations provide that any International Searching Authority must have at least 100 qualified searchers (Rule 36.1(i)). Under the Draft Regulations, this number was 150 (Rule 36.1(i)).

44. *Communication to Designated Offices.* – Draft Rule 47.1 has been supplemented by a new provision (Rule 47.1(e) of the Regulations) to the effect that, where any designated Office has waived the requirement of the communication to it by the International Bureau of a copy of the international application under Article 20, the International Bureau when notifying the applicant of the effected communications will, at the request of that Office or the applicant, send the copy intended for that Office to the applicant himself.

45. *Time Limit for Amendments in the National Phase.* – This time limit has been fixed in the Regulations (Rule 52.1(a)) in a way more favorable to the applicant than it was in the Draft Regulations (Rule 52.1(a)). In particular, the Draft Regulations provided that the time limit for making amendments under Article 28 before designated Offices in which processing or examination starts without special request should be the same as that applicable under Article 22 (generally 20 months from the priority date). The Regulations provide that the applicant may

make such amendments within one month from the fulfillment of the requirements under Article 22, provided that, if the communication of the international application (under Rule 47.1) has not been effected by the expiration of the time limit applicable under Article 22, the applicant may amend his application not later than 4 months after such expiration date.

46. *Copies of Publications of the International Bureau.* – Under the Regulations, any national Office of a Contracting State shall have the right to receive, free of charge, one copy of every published international application, of the Gazette, and of any other publication of general interest published by The International Bureau in connection with the Treaty or the Regulations (Rule 87.2). There was no such provision in the Draft Regulations.

47. *Amendment of the Rule on Modification of Time Limits.* – Under the Regulations, amendment of Rule 81 (Modification of Time Limits Fixed in the Treaty) requires unanimity (Rule 88.1(vi)). According to the Draft Treaty and Regulations, Rule 81 would have been amendable by a two-thirds vote of the Assembly (Articles 54(2)(b) and 50(6)).

48. *Possible Amendment of the Rules on the Description and the Claims.* – The Regulations provide that, during the first 5 years after the entry into force of the Treaty, Rules 5 (The Description) and 6 (The Claims) may be amended only by unanimous decision of the Assembly (Rule 88.2). After the transitional period, these Rules may be amended by three-fourths of the votes cast (Article 58(2)(b)). Under the Draft Treaty and Regulations, these Rules would have been amendable by a two-thirds vote of the Assembly (Articles 54(2)(b) and 50(6)).

NOTES ON THE PATENT COOPERATION TREATY

PCT/PCD/4 December 10, 1970 (Original: English)
WIPO/BIRPI

Editor's Note: *The Notes on the Patent Cooperation Treaty contained in this document are reproduced as footnotes to the text of the Articles found on pages 11 to 76.*

NOTES ON THE REGULATIONS UNDER THE PATENT COOPERATION TREATY

PCT/PCD/5 June 22, 1971 (Original: English)
WIPO/BIRPI

Editor's Note: The Notes on the Regulations under the Patent Cooperation Treaty contained in this document are reproduced as footnotes to the text of the Regulations found on pages 77 to 161.

INDEX TO THE PATENT COOPERATION TREATY AND THE REGULATIONS UNDER THE TREATY

PCT/PCD/6 February 25, 1971 (Original: English)
WIPO/BIRPI

Editor's Note: *The Index to the Patent Cooperation Treaty and the Regulations under the Treaty found in this document is reproduced in a slightly revised version as the Catchword Index to the Patent Cooperation Treaty and Regulations under the Patent Cooperation Treaty found on pages 798 to 826.*

