



C. PCT 896
- 21.1

December 19, 2002

Madam,
Sir,

Questionnaire: Protest Procedure in Cases of Lack of Unity of Invention

1. This Circular is addressed to your Office in its capacity as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT). It concerns the protest procedure in cases where there is a finding of lack of unity of invention before ISAs under PCT Rule 40 and before IPEAs under PCT Rule 68.

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

“Unity of Invention

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

“96. Certain delegations proposed the abolition of the protest system before International Searching Authorities under Rule 40 and International Preliminary Examining Authorities under Rule 68, with a view to reducing the workload of the Authorities. The majority of delegations and representatives of users, while recognizing that the procedures under

/...

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

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

3. In order to obtain more information about the experience of ISAs and IPEAs regarding the issues outlined in paragraphs 95 to 97 of document PCT/R/WG/3/5, you are kindly requested to complete the attached questionnaire concerning the protest procedure in cases of lack of unity of invention. The International Bureau would appreciate receiving your reply by January 24, 2003, preferably by e-mail sent to pct.reform@wipo.int or by fax sent to (+41-22) 338 8780.

Sincerely yours,



Francis Gurry
Assistant Director General

Enclosure: Questionnaire concerning the protest procedure in cases of lack of unity of invention

QUESTIONNAIRE:^{*}
PROTEST PROCEDURE IN CASES OF
LACK OF UNITY OF INVENTION

Name of Office:

Country:

Person completing this Questionnaire:

Name:

Title:

Dep./Section:

Tel.:

Fax:

E-mail:

Lack of Unity of Invention before the International Searching Authority (ISA)

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

.....
.....
.....
.....
.....

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

.....
.....
.....
.....
.....

^{*} You are kindly requested to complete this Questionnaire and to return it to the International Bureau by January 24, 2003, preferably by e-mail sent to pct.reform@wipo.int or by fax sent to (+41-22) 338 8780. If you wish to receive this Questionnaire by e-mail (and return it by the same means), or for any further information, please contact Claus C. Matthes, Head, PCT Reform Section, Patent Policy Department, World Intellectual Property Organization; tel.: (+41-22) 338 98 09; fax.: (+41-22) 338 8780; e-mail: claus.matthes@wipo.int

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

- (i).....
- (ii).....

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

.....

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

- (i).....
- (ii).....

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

.....

Lack of Unity of Invention before the International Preliminary Examining Authority (IPEA)

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

.....
.....
.....
.....

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

.....
.....
.....
.....

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

.....
.....
.....
.....

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

.....
.....
.....
.....

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

- (i).....
.....
- (ii).....
.....

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

.....
.....
.....
.....

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

- (i).....
.....
- (ii).....
.....

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

.....
.....
.....
.....

[End of Annex and of Circular]