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ORGANIZACION MUNDIAL
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المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

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The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith ./ documents PCT/R/WG/4/4 Add.5, 4 Add.6, 12 Add.1 and 12 Add.2, prepared for the fourth session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which was held in Geneva from May 19 to 23, 2003.

The working documents are also available on WIPO's Web site (see <http://www.wipo.int/pct/en/meetings>).

June 16, 2003

Enclosures: documents PCT/R/WG/4/4 Add.5, 4 Add.6, 12 Add.1 and 12 Add.2

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PCT/R/WG/4/4Add.5

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORMOF THE PATENT
COOPERATION TREATY (PCT)

Fourth Session
Geneva, May 19 to 23, 2003

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

FURTHER CONSEQUENTIAL AMENDMENT

Document prepared by the International Bureau

1. The Annex to this document contains a proposal to amend Rule 60.1(b), c on sequential on the amendments adopted by the PCT Assembly on October 1, 2002, and due to enter into force on January 1, 2004 (see document PCT/A/31/10, Annex V).

2. *The Working Group is invited to consider the proposal contained in the Annex to this document.*

[Annex follows]

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ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

FURTHER CONSEQUENTIAL AMENDMENT

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Rule60

Certain Defects in the Demand

60.1 *Defects in the Demand*

(a) to (a-ter) [No change]

(b) If the application complies with the invitation within the time limit under paragraph (a), the demand shall be considered as if it had been received on the actual filing date, provided that the demand as submitted ~~contained at least one election and~~ permitted the international application to be identified; otherwise, the demand shall be considered as if it had been received on the date on which the International Preliminary Examining Authority receives the correction.

[COMMENT: The proposed amendment of paragraph (b) is consequential on the amendments of the Regulations as adopted by the Assembly on October 1, 2002, with effect from January 1, 2004. Under Rule 53.7 as adopted by the Assembly with effect from January 1, 2004, the filing of the demand constitutes the election of all Contracting States which are redesignated and are bound by Chapter II of the Treaty.]

(c) to (g) [No change]

60.2 *[Remains deleted]*

[End of Annex and of document]

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PCT/R/WG/4/4Add.6

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

WORKING GROUP ON REF ORM OF THE PATENT COOPERATION TREATY (PCT)

Fourth Session Geneva, May 19 to 23, 2003

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

FORM OF AMENDMENTS

Proposals submitted by the European Patent Office

1. It is proposed to change Rule 66.8 to make it mandatory for the applicant to indicate for each amendment made where there is a basis for the amendment in the originally filed documents. At the moment, this Rule only demands an indication of what has been changed (i.e., the difference between the old and new sheet) but not where the basis can be found. Considering that added matter is regarded as a very serious objection by the International Preliminary Examining Authorities (and the national Offices), and that further the burden on the examiner to sort out all the amendments made and find the corresponding basis in the originally filed documents is both unfair and extremely time-consuming (it is much more difficult to check the amendments afterwards without having any idea of what has been amended, why and where a basis is, than for the applicant to write down a list while he is anyway preparing the amendments), we are of the opinion that such a Rule change is well founded and would provide for both a more efficient examination as well as increased legal security for third parties and the applicant.

2. *The Working Group is invited to consider the proposal contained in the Annex to this document.*

[Annex follows]

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ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

FORM OF AMENDMENTS

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Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 to 66.7 [No change]

66.8 *Form of Amendments*

(a) Subject to paragraph (b), the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets , shall indicate where in the originally filed application documents a basis for each amendment can be found, and shall preferably also explain the reason for the amendment. In case of non-compliance with this Rule, the amendments concerned need not be taken into account for further examination.

(b) [No change]

66.9 [No change]

[End of Annex and of document]

WIPO



PCT/R/WG/4/12Add.1

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORMOFTHEPATENT
COOPERATION TREATY(PCT)

Fourth Session
Geneva, May 19 to 23, 2003

ACOMMONFRAMEWORKFOR
INTERNATIONALSEARCH ANDPRELIMINARYEXAMINATION:

PROPOSED AMENDMENTS

Proposals by the United Kingdom Patent Office

INTRODUCTION

1. At the eighth session of the Meeting of International Authorities under the PCT (the Meeting), held in Washington, D.C., from May 5 to 9, 2003, the United Kingdom Patent Office, in its role as coordinator of the virtual task force on a PCT quality framework, presented the initial report of the task force (see document PCT/MIA/8/5, whose content is identical to that of document PCT/R/WG/4/12) to the Meeting. Following that presentation, the Office would like to propose the following amendments to the proposed framework set out in Annex I of document PCT/R /WG/4/12.

PROPOSED AMENDMENTS TO THE DRAFT FRAMEWORK

2. The term "testing" in paragraph 4(g) should be replaced by "assessing" so as to give Authorities greater flexibility in meeting this requirement.
3. Paragraph 5(d) should be removed, as paragraph 6(d), to fall within the "Quality Assurance" section rather than the "Resources" section.

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4. Paragraph 17, which covers Stage 2 of Reporting Arrangements, needs clarification to identify the general framework of the Reports. The paragraph should be amended to read:

Following the initial reporting in stage 1, annual reports should be prepared by each Authority, identifying the lessons learned and action taken, and making any recommendations in the light of the review.

5. There is a concern that the future development of the quality framework should be as inclusive as possible, following the principles of consultation used in preparing the report of the task force. A new paragraph 18 entitled 'Future Developments' should therefore be added, reading 'Proposals for future changes to this framework should be made available by the International Bureau for comment by interested parties prior to their adoption.'

6. The Working Group is invited to consider the proposals in paragraphs 2 to 5, above.

[End of document]

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PCT/R/WG/4/12Add.2

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORMOFTHEPATENT
COOPERATION TREATY(PCT)

Fourth Session
Geneva, May 19 to 23, 2003

ACOMMONFRAMEWORKFOR
INTERNATIONALSEARCH ANDPRELIMINARYEXAMINATION:

REPORT OF THE EIGHTH SESSION OF THE
MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT

Document prepared by the International Bureau

1. The Meeting of International Authorities under the PCT (the Meeting), at its eighth session, held in Washington, D.C., from May 5 to 8, 2003, considered a report on the results of the work so far of the virtual task force on a PCT quality framework that was established after the third session of the Working Group (see documents PCT/R/WG/3/5, paragraph 111, and PCT/MIA/7/5, paragraph 75). That report, which is set out in document PCT/R/WG/4/12 (and was submitted to the Meeting as document PCT/MIA/8/5), was presented to the Meeting by representatives of the United Kingdom Patent Office in its capacity as task force coordinator.
2. The question of quality also arose in the context of the Meeting's consideration of the draft revised PCT International Search and Preliminary Examination Guidelines appearing in document PCT/MIA/8/2 (see, in particular, Chapter 23, 'Standards for Quality Assurance').
3. The following extracts from the report of the Meeting's session concerning the question of quality (document PCT/MIA/8/6, paragraphs 105 to 115 and 118 to 121) are drawn to the attention of the Working Group:

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iPROPOSEDREVISED PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

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Chapter 23

1105. The discussion of Chapter 23 took into account the presentation at the session by representatives of the United Kingdom Patent Office of the results so far of the PCT quality assurance task force and the discussion that ensued (see document PCT/MIA/8/5 and paragraphs 118 to 121, below).

1106. The Japan Patent Office believed that the question of quality assurance systems was one for those responsible for the management of the Authorities and was not appropriate to be dealt with in the Guidelines, which were primarily directed to examiners. The questions should be addressed in a wider forum in which the views of designated and elected Offices could be expressed and would therefore be more appropriately dealt with by the Working Group, although the Office was not opposed to discussion of the issues by the Meeting.

1107. The Korean Intellectual Property Office expressed agreement with the Japan Patent Office and believed that the matters should be further discussed at the next session of the Meeting.

1108. The European Patent Office believed that quality standards and quality assurance should be addressed in the Guidelines. The Office noted that the Guidelines formed part of the common rules of international search and international preliminary examination which Authorities are obliged, by the agreements with the International Bureau under which they carry out their functions, to apply and observe, and as such their legal status was clear. The inclusion of quality management issues in the Guidelines would emphasize the Authorities' commitment to the matter and would enable rapid implementation. The draft Common Framework for International Search and Preliminary Examination contained in the interim report of the task force (see Annex I of document PCT/MIA/8/5) formed a good basis for further discussion and should be included in the next draft of the Guidelines.

1109. The Spanish Patent and Trademark Office, the Swedish Patent and Registration Office, the United States Patent and Trademark Office, the Austrian Patent Office, the Canadian Intellectual Property Office and IP Australia expressed general agreement with the views of the European Patent Office on this question.

1110. The United States Patent and Trademark Office stressed that it would emphasize certain other general principles relating to quality standards when revising the draft Guidelines.

1111. The Chair noted that the majority of the Authorities at the session, but not including the Japan Patent Office or the Korean Intellectual Property Office, had agreed that quality management (that is, both quality standards and quality assurance) be dealt with in the Guidelines, and concluded that the draft Common Framework suggested by the task force should be included in the next draft of the Guidelines, in Chapter 23 or as an Annex, for discussion by the Meeting at its next session, subject to possible changes

or addition to be identified in the draft. The results of the present consideration of the matter by the Meeting should be brought to the attention of the Working Group at its fourth session to be held in May 2003.

112. The following changes to the text of the draft Common Framework were suggested at the present session:

- (a) In paragraph 4(g), "testing" should be replaced by "assessing".
- (b) Paragraph 5(d) should be relocated as paragraph 6(d).
- (c) Paragraph 17 should be reviewed with a view to avoiding unnecessarily onerous reporting requirements for Authorities.

113. The representatives of the United Kingdom Patent Office offered to cooperate in the formulation of possible further changes or additions to the draft Common Framework.

114. In connection with paragraph 17 of the draft Common Framework, the United States Patent and Trade Mark Office voiced objection to reporting on results of its internal reviews as opposed to reporting on what quality practices were successful. The European Patent Office queried whether it would be appropriate to use a standard template for reporting the results of internal reviews.

115. It was noted that, while the Guidelines were addressed specifically to Authorities in the context of international search and international preliminary examination under the PCT, the section concerning quality management would, like the rest of the Guidelines, serve as a useful model for all Patent Offices which undertake search and examination work.

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REPORT OF THE VIRTUAL TASK FORCE ON A PCT COMMON QUALITY FRAMEWORK

118. As had been agreed by the Meeting at its previous session, a report on the results of the work so far of the virtual task force on a PCT quality framework established by the Working Group was presented to the Meeting by representatives of the United Kingdom Patent Office in its capacity as task force coordinator (see documents PCT/R/WG/3/5, paragraph 11, and PCT/MIA/7/5, paragraph 75). For this purpose, the Office was represented by Mr. Ron Marchant, Director of Patents, and Mr. Mike Wright, Assistant Director, Patents Legal Division.

119. The representatives of the United Kingdom Patent Office, in presenting the report, which was set out in document PCT/MIA/8/5, outlined some of the background to it:

- (a) An important aim was to establish systems making it possible to avoid re-doing in the national phase work which had already been done in the international phase.

(b) A number of representatives of users had expressed support for the proposals developed by the task force.

(c) The report took account of a number of concerns of those who took part in the work of the task force, including some of the Authorities. Those concerns, together with other views that had been expressed, were summarized in document PCT/MIA/8/5.

(d) A proposal for an independent assessment or review panel had been discussed by the task force but had since been omitted.

(e) The proposed framework was designed to operate as simply and economically as possible, avoiding unnecessary administrative burdens for Authorities.

(f) A quality management system should not only establish quality standards but also deal with how to meet them and how to keep them up to date, taking feedback from users (including both applicants and Offices) into account.

120. The representatives of the United Kingdom Patent Office also outlined particular features of the proposed framework set out in Annex I of document PCT/MIA/8/5.

121. The Chair, on behalf of the Meeting, thanked the representatives of the United Kingdom Patent Office for their contribution to the work of the task force and for presenting the report at the present session. ¹

4. The Working Group is invited to note the above extracts from the report of the eighth session of the Meeting of International Authorities under the PCT.

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