

# PCT REFORM MOVES ONE STEP FORWARD

**The reform of the Patent Cooperation Treaty (PCT) system moved one step forward when members of the Committee on Reform of the PCT, meeting in Geneva from July 1 to 5, approved a set of proposed amendments of the PCT Regulations designed to further simplify and streamline PCT procedures, with a view to their submission to the Assembly of the International PCT Union for adoption in the fall.**

## **PCT Reform Process**

Since its adoption in Washington in 1970, the PCT has had great success in achieving its objectives. In particular, it has succeeded in simplifying and rendering more economical the obtaining of protection for inventions throughout the world. Having been in practical operation for 24 years, the PCT has enjoyed significant growth, witnessed by its 116 Contracting States and the nearly 104,000 international applications filed last year.

An important factor in the PCT's success has been the constant evolution of the system, in which particular regard has always been paid to the needs of both applicants and offices. The Treaty itself was amended in 1979 and subsequently modified in 1984 and 2001. In addition, PCT proce-

dures are revised on an ongoing basis by amendment of the Regulations and the Administrative Instructions.

Efforts aiming at a more substantial reform of the PCT began in October 2000 when the Assembly of the PCT Union endorsed an initiative by the United States of America for a concerted effort to reform the Treaty. A special body, the Committee on Reform of the PCT, was set up by the Assembly of the PCT Union to consider proposals for reform of the PCT. In two sessions, held in Geneva in November 2001 and July 2002, respectively, the Committee set out the general objectives of PCT reform and, based on preparatory work carried out by a special Working Group, agreed on a set of proposed amendments of the PCT Regulations, with a view to their submission to the Assembly of the PCT Union for adoption in October of this year. The principal features of these proposals are outlined in the following paragraphs.

## **Enhanced International Search and Preliminary Examination System**

The proposed enhanced international search and preliminary examination system is an important first step towards a more

extensive rationalization of the PCT international search and international preliminary examination procedures, with an ultimate view of achieving greater convergence of the international and national procedures.

The main feature of the proposed new system is that one of the main elements of the present international preliminary examination procedure under Chapter II of the Treaty, namely, the establishment of an examiner's opinion, would in effect be advanced and incorporated into the international search procedure under Chapter I of the Treaty. Under the new system, the International Searching Authority (ISA) would be responsible for establishing a preliminary and non-binding written opinion on the questions of whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable. That written opinion of the ISA would be used for the purposes both of Chapter I and, if the applicant files a demand for international preliminary examination, of Chapter II, thus combining the international search and international preliminary examination procedures to a much greater extent than is the case at present.

## Overhaul of the designation system

The proposal to overhaul the PCT designation system would make the operation of that system more automatic and seamless and bring it into line with the way in which most applicants and offices today perceive and use it. By filing an international application, the applicant would obtain an automatic and all-inclusive coverage of all designations available under the Treaty, including all kinds of protection as well as both national and regional patent protection, without needing, at the time of filing the application, to designate individual Contracting States, to choose certain kinds of protection or to indicate expressly whether national or regional protection is sought. Such matters would be left to be dealt with in the national phase.

## Alignment of PCT requirements with those of the Patent Law Treaty (PLT)

Proposals relating to the language of the international application and translations, to the reinstatement of rights after failure to comply with requirements for entering the national phase within the applicable time limit, and to the availability of priority documents from a digital library, would align

PCT requirements with those of the Patent Law Treaty (PLT).

## Entry into Force; Transitional Arrangements

The proposals outlined above will be submitted to the Assembly of the PCT Union for adoption in the fall of this year, together with proposals concerning proposed dates of entry into force and proposed transitional arrangements in relation to international applications which are pending at the dates of entry into force of those amendments. It is proposed that the proposed amendments relating to the language of the international application and translations and to the missed time limit for entering the national phase should enter into force, if possible, on January 1, 2003; proposed amendments relating to the enhanced international search and preliminary examination system, the overhaul of the designation system, and the availability of priority documents from digital libraries are proposed to enter into force on January 1, 2004.

## Further Work

The Committee also agreed on proposals for further work to reform the PCT system. It agreed to recommend to the PCT Assembly that two sessions of the

Working Group on Reform of the PCT should be convened between the September 2002 and September 2003 sessions of the Assembly of the PCT Union to



consider issues of two kinds. First, those proposals for reform that had already been submitted to the Committee or the Working Group, but not yet considered in detail, should be reviewed. Second, consideration should be given to options for revising the Treaty itself.

